Protecting GIs through EU collective marks

Worldwide Perspectives on Geographical Indications

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Overview

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II. Shortcomings of the EU collective mark system
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   b. No causal link required
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Part I
EU collective mark protection for GIs
EU geographical collective marks

• Art. 74.2 EUTMR: collective marks
  - Derogation from absolute ground of refusal Art. 7.1.c EUTMR (indications that designate geographical origin)

• Very **limited** number (ECTA 2021)

• Protection of **figurative signs**

• **Goal**: enhanced protection against counterfeit products in markets beyond the EU (Wirsig, Heisrath 2021)
Part II
Shortcomings of EU collective mark systems
Associations of producers

• **Art. 74.1. EUTMR**: “associations of manufacturers, producers, suppliers of services, or traders [...] as well as legal persons governed by public law”

• **Guidelines** Part B Chapter 15:
  - private associations with a common purpose or interest
  - own legal personality and capacity to act
  - private companies cannot be the owner of an EU collective mark unless it shows that its internal structure is of an associative nature

• **Consequence**
  - No guarantee that applicant group represents the entire producer group of the product/services concerned
No causal link required

• Regulations governing use (Art. 75.1 EUTMR, Art. 16 EUTMI R) do not require establishing link with origin
  - “given quality, reputation or other characteristic is essentially attributable to geographical origin” (Art. 5 Reg 1151/2012)

• Consequences
  - Collective marks cannot guarantee a close link between the product and geographic origin
  - Non-compliance with TRIPS Agreement (definition of the link) and Geneva Act (protection against evocation, prohibition for GIs to become generic)
Function of collective marks

“a Community collective mark is a sign allowing goods or services to be distinguished according to which association is the proprietor of the mark and not according to their geographical origin”

(CJEU Darjeeling para. 41)

• Scope of protection limited to confusion against commercial origin
  - GIs: guarantee to consumers geographic origin and qualities inherent in them
  - Collective marks: distinguish goods from members of association from those of other association or members

• Genuine use in relation to trade marks function – not to certify certain standards (CJEU Grüne Punkt)
Distinctive geographical collective marks

- CJEU Darjeeling, Halloumi v Bbqloumi: a geographical collective mark has weak distinctive character

- Important **determining factors**
  - “elements which enable the consumer to distinguish the goods or services of its members from those of other” *(Halloumi v Bbqloumi)*
  - Distinctive character **through use** (where applicable)
  - Need for **composite** marks

- **Consequences** for scope of protection
  - CJEU: all factors including similarity of goods/services need to be taken into account
  - Weak distinctive character nevertheless reduces likelihood of confusion
Recommendations
Recommendations

• Collective marks currently do not serve as an alternative to GI protection but as **additional protection**
  - Focus on figurative and composite marks
  - Protection for geographical names instead of causal link

• **For alternative protection**, changes would be needed:
  - Require **evidence** of representation of entire producer group
  - Add requirement for geographical collective marks to show **link** with origin

• Otherwise, allow **certification marks** for geographical indications
  - Guarantee **function** – different from collective marks
Thank you for your attention!

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