

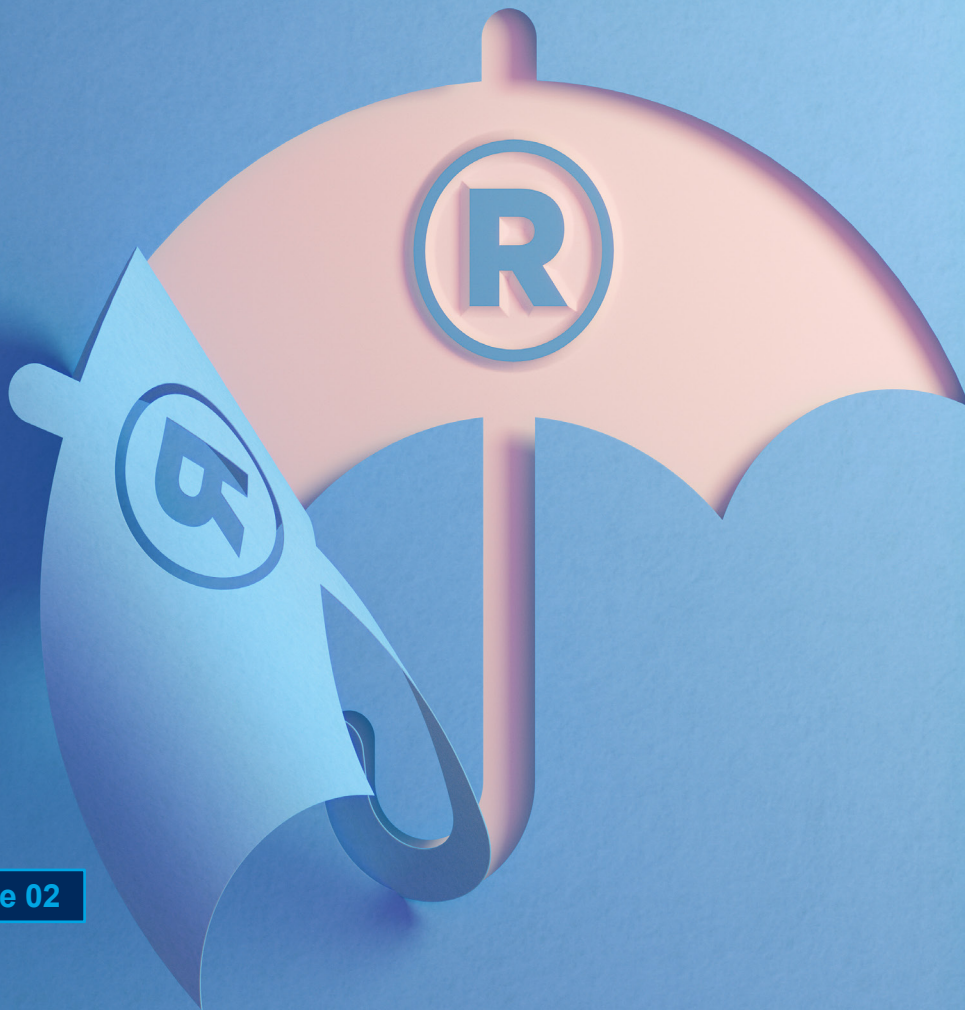
D YOUNG & CO TRADE MARK NEWSLETTER *no.131*

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Proving genuine use in the EU Michael Kors v TECOM MASTER & adp Merkur v EUIPO



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Welcome to our November 2023 newsletter and the last one for this year. We hope that the year has been a successful one for our readers and that everyone will have the chance to enjoy a well-deserved break over the festive period, fast approaching. In our September newsletter, we confirmed our attendance at the IPO and MARQUES conferences, and partner and solicitor Tamsin Holman attended the PTMG Autumn conference last month. We are grateful for the opportunity to have caught up with so many colleagues in the trade mark profession during the Autumn conference season and look forward to the opportunities to meet with clients and peers in the new year.

In other news, we were delighted to learn that we have been ranked in the Chambers & Partners UK guide 2024 as a top tier UK patent and trade mark firm for the 13th consecutive year and the survey comments that "the firm has a leading trade mark prosecution service". Thank you to all of our colleagues and clients for their continued support.

Finally, a last reminder on the UK address for service requirement, applicable from 01 January 2024, detailed at: dycip.com/ukaddressforservice.

Jackie Johnson, Editor

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Genuine use

Proving genuine use in the EU Michael Kors v TECOM MASTER & adp Merkur v EUIPO

In September 2023 two decisions provided further guidance regarding proving genuine use of registered trade marks in the EU. These decisions present a useful reminder and some important guidelines for brand owners, who may need to consider updating their trade mark portfolios to ensure their rights are enforceable.

In cancellation proceedings initiated by Michael Kors, the Board of Appeal of the EU Intellectual Property Office (EUIPO) has confirmed genuine use of Michael Kors' registered word/figurative mark MK MICHAEL KORS for bags (class 18), clothing and shoes (class 25), shown below (figure 1).

**MK
MICHAEL KORS**

Figure 1

Conversely, in opposition proceedings brought by adp Merkur GmbH against Play'n GO Marks Ltd's EU trade mark (EUTM) application for the mark GAME OF GLADIATORS, adp Merkur failed to show use of its mark "Gladiator", registered for, *inter alia*, video games (class 9) and apparatus for games (class 28). This finding was upheld by the Board of Appeal and has now been confirmed by the General Court.

Registered mark and use variations seen as equivalents

Michael Kors submitted substantial evidence in an attempt to prove use of the aforementioned mark. Some of this evidence showed use of the mark in the form registered, but it also contained use of variations of the mark, either with additional elements, or with the element "MK" and/or the graphic stylisation omitted.

According to the Board of Appeal, the term MICHAEL KORS would be understood as a male forename and surname, which would be distinctive in relation to clothing, shoes or accessories. The letters MK would be perceived as a mere abbreviation of MICHAEL KORS.

When considering if a mark is being used in its registered form, one has to examine whether the variations alter the distinctive

character of that mark. In essence, will consumers see the registered mark and the different use variations as equivalents?

In this case, the Board of Appeal decided that the following amendments did **not** alter the distinctive character of the registered mark MK MICHAEL KORS:

- the omission of the abbreviation MK or the specific stylisation of the registered mark, using only MICHAEL KORS;
- the addition of a simple geometric shape and a different layout (see figure 2 below);
- the inclusion of an additional word MICHAEL as a mere repetition of the male first name already contained in the registered mark;
- the different size of the word elements;
- the addition of further sub-brands, other marks or elements of Michael Kors; and
- the mark being used in different colours.



Figure 2

When a mark is composed of word and figurative elements, the word elements are, as a rule, considered to be more distinctive than the figurative elements. This is based on the general principle that the relevant public will be able to refer to the goods/services in question more easily by citing the word elements of the mark, rather than describing the figurative elements. In the Michael Kors' case the figurative elements were almost imperceptible. Therefore, the use of these elements in different sizes, colours and/or layouts was not regarded as sufficient to alter the distinctive character of the registered mark.

However, this will not always be the case. When modernising word/figurative marks particular consideration must be given to

➤ **Case details at a glance**
Jurisdiction: European Union
Decision level: Boards of Appeal, EUIPO
Parties: Michael Kors (Switzerland)
International GmbH v TECOM MASTER SL
Date: 04 September 2023
Citation: R 1959/2021-1
Decision (link to pdf): dycip.com/r-1959-2021-1

Jurisdiction: European Union
Decision level: General Court
Parties: adp Merkur GmbH v EUIPO
(intervener: Play'n GO Marks Ltd)
Date: 06 September 2023
Citation: T-350/22
Decision: dycip.com/t-350-22

amendments in colour, size or position, as this may necessitate new trade mark applications. Indeed, it is good practice, if budget permits, to try and seek protection for each variation of a mark in use.

Use as a trade mark

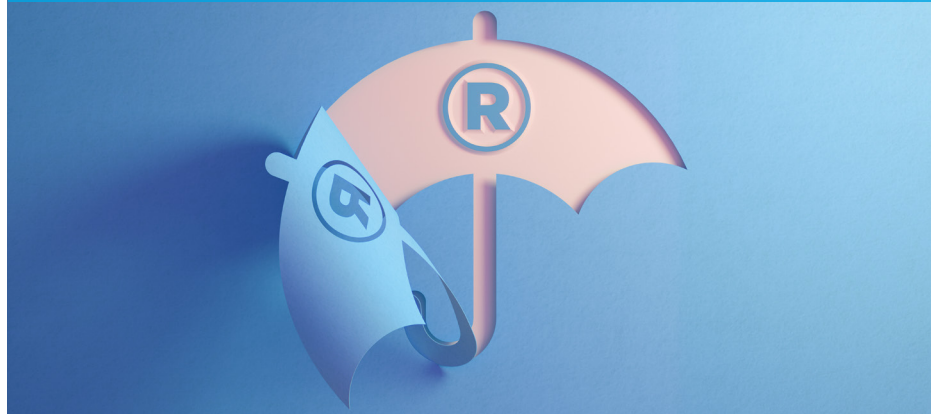
While it might seem obvious, parties invited to submit proof of use must take care to ensure that evidence submitted to show use of a mark actually contains the mark, and that it has been used as a trade mark. In *adp Merkur's* case, it was held that the evidence submitted showed very limited use of its mark and, where it was used, it was generally among large numbers of other marks rendering the mark illegible or hardly legible. This also meant the mark was unlikely to be seen as an independent mark capable of denoting origin. Although *adp Merkur* argued that the Board of Appeal failed to take into account the norms of the sector, and had, for example, not properly considered applications for approval for gaming machines containing the "Gladiator" game, the court considered these had no evidential value. Indeed, those approvals were granted only for gambling devices, and not for specific games packages.

Extent of use

As regards proving the extent of use of a mark, the Board of Appeal reminds us in the *Michael Kors' case* that it is not a requirement that the evidence provides the total sales figures under the mark in the relevant territory of sale. It is sufficient to submit evidence which shows that the minimum threshold for a finding of genuine use has been passed.

With regard to the minimum threshold for use, the General Court recaps in *adp Merkur's case* that the purpose of the requirement for genuine use is not to assess the commercial success of a product or brand. Minimal use can be sufficient, provided that such use is regarded as warranted in the relevant economic sector as a means of maintaining or creating a market share for the goods/services protected by the mark. There is no *de minimis* rule, but, within the gaming sector, the General Court considered sales volumes by *adp Merkur* of approximately €2,500 to be insufficient. There were also question marks about how much of

These cases present two different outcomes with regard to proving genuine use



these low value sales could even be attributed to games bearing the "Gladiator(s)" mark.

In general, catalogues, affidavits, various printouts from the owner's website, advertising material, social media, look books, turnover reports and invoices are admissible to prove use of a mark in the EU. Internal documents prepared by the interested party are also admissible, provided they are corroborated by additional solid evidence.

Indeed, in *adp Merkur's appeal* the General Court re-enforced that although internal documents and sworn statements by individuals internal to the relevant party are, in principle, admissible in evidence, additional supporting material is required to corroborate such evidence. Although *adp Merkur* submitted a sworn statement from an employee and an internal table of sales figures, the General Court held that the Board of Appeal was correct to exclude this from its analysis of the evidence, as it was not possible to assess the accuracy of the information. The internal table also did not indicate the territory to which the sales related, nor which part of the turnover corresponded to the "Gladiator(s)" game.

Comment

These cases present two different outcomes with regard to proving genuine use. Nonetheless, the underlying principles are the same. Evidence submitted to show use of a mark should comprise more than token use

of the mark, in the form registered, within the relevant period and within the relevant territory. Although variations in use of a mark may count as use of the registered form, it is best practice to obtain registrations for each variation in use. In this regard, brand owners might need to review and update their trade mark portfolios.

Furthermore, where submitted, internal evidence should be corroborated by third party sources. However, it is not uncommon for parties to hold ostensibly strong internal evidence which cannot be backed up by third party sources and it is likely this will continue to be a bone of contention.

Authors:

Leyre Barragán & Olivia Oxtan



In short

These cases serve as a useful reminder of the principles for assessing genuine use of a registered trade mark, and should prompt consideration of whether trade mark portfolios might need updating, particularly if brand owners may have difficulty in enforcing a mark due to a lack of use a) at all; and/ or b) in the form registered.

Luxury goods at discount stores

Who doesn't love a bargain?

Case details and useful links

Jurisdiction: Germany
Decision level: Higher Regional Court of Düsseldorf
Parties: Coty v ALDI SÜD
Citation: 20 U 278/20
Date: 29 June 2023

Case C-337/95, CJEU, 04 November 1997:
dycip.com/c-337-95

Case C-59/08, CJEU, 23 April 2009:
dycip.com/c-59-08

This case focuses on when damage to a reputation can constitute a legitimate reason to prevent the sale of exhausted goods. Coty is a licensee of trade marks for JOOP! and CALVIN KLEIN in the EU. Prior to Valentine's Day 2018 ALDI SÜD advertised JOOP! and CALVIN KLEIN perfumes in its brochure. However, the products had been sold in its stores at least since December 2017 up until October 2018. The perfumes were 1) original (unaltered) products and 2) placed on the EU market with Coty's consent.

Coty claimed trade mark infringement. The advertisement and sale would tarnish the marks' reputation. This would constitute a legitimate reason to prevent sales; though the trade mark rights were exhausted.

Outcome of the decisions

At first instance, the Regional Court of Düsseldorf denied any infringement claims. Coty appealed.

The Higher Regional Court of Düsseldorf overturned the decision in part and found the in-store sale to be infringing. However, it upheld the first-instance decision with regard to the advertising of the perfumes in ALDI's brochure.

Previous case law

The Higher Regional Court of Düsseldorf relied on the Court of Justice of the European Union (CJEU) decision in *Parfums Christian Dior v Evora* (C-337/95) in which the CJEU had confirmed that damage to reputation can constitute a legitimate reason to prevent the further sale and advertising of exhausted goods. The Higher Regional Court of Düsseldorf also referred to the CJEU decision in *Christian Dior couture v Copad* (C-59/08). This decision confirmed that a licensor can potentially stop the sale of its luxury goods to discount stores if the licensee is doing so in breach of the license agreement and there is damage to its reputation.

Relevant factors

Overall, whether the trade mark owner can prevent resale is a balancing act.

Coty claimed Aldi's advertisement and sales would tarnish their marks' reputation



The Higher Regional Court of Düsseldorf considered the following factors:

- the nature and level of prestige of the luxury goods in question;
- the volumes sold and usual trade channels, in particular if usually sold in discount stores;
- the nature of goods usually marketed in discount store; and
- the marketing methods usually used by discount stores.

Application to case at hand

The Higher Regional Court of Düsseldorf found that both JOOP! and CALVIN KLEIN enjoy a certain luxury aura due to their selective distribution system, which was undisputed at least in relation to Germany. Further, it was irrelevant that the perfumes could also be found in drug stores, and Coty was not objecting to these sales. In this context, the court noted that perfumes would be sold in separated sections in drug stores and, thus, differ from the sales by ALDI.

Aside from that, the fact that the perfumes are only medium-priced premium goods would not prevent their luxury aura.

Concerning the sale, in the stores, the court found that the presentation of the perfumes would lack any exclusivity, which would not do justice to the repute of the marks.

While the perfumes may have been in glass cabinets, these were mixed in with the normal assortment and not highlighted in any

way. In addition, the court noted that ALDI customers understood the glass cabinets to be a means to theft prevention and did not stand out from the rest of the interior. A further factor was the sale of the goods not just for Valentine's Day, but a prolonged period.

As regards the advertisement, the court observed that the brochure highlighted the perfumes as special Valentine's Day gifts. This was separated from other goods. The page only included references to other cosmetic products, such as mirrors and hair trimmer sets. Therefore, it did not consider this to tarnish the trade marks' reputation.

Author:

Yvonne Stone



In short

Whether or not one can prevent the sale of exhausted goods depends on the facts of the individual case. That said, the Higher Regional Court of Düsseldorf confirmed that damage to reputation can constitute a legitimate reason to prevent resale of exhausted (luxury) goods and provides a useful list to take into account. It seems the more "love" and outstanding position a discount store provides to its luxury items, the more likely it will be allowed to sell them.

Larsson strikes again UKIPO deems LARSSON mark to be invalid

Case details at a glance

Jurisdiction: United Kingdom

Decision level: UKIPO

Parties: Henrik Larsson v Global

Trademark Services Limited

Citation: O/0872/23

Date: 14 September 2023

Decision: dycip.com/larsson

The LARSSON mark:



Celtic legend Henrik Larsson has successfully had a LARSSON mark declared invalid on the grounds of passing off. The LARSSON mark (shown above right) was registered by Mr James Dear, covering approximately 3,500 clothing-related goods in class 25. Henrik Larsson, a Celtic Football Club legend who also had stints at Barcelona and Manchester United, applied for a declaration of invalidity of the LARSSON Mark on the grounds of passing off and bad faith.

Passing off

Whilst Mr Larsson's argument that the retail of various memorabilia bearing his name and image demonstrated goodwill failed, his exceptional career at Celtic and time spent as an ITV pundit contributed to the hearing officer finding that he held goodwill in his name in relation football, and by extension, football-related clothing.

In arguing against any misrepresentation, Mr Dear sought to rely on "Larsson" being a common surname in the UK. The hearing officer not only disagreed with this but also pointed out that Mr Dear had in fact contacted Mr Larsson before filing the LARSSON mark, which itself demonstrated his intention to exploit the name. Hence, there could be no argument of coincidence in using the LARSSON name. This, coupled with the LARSSON mark giving the overall impression of Mr Larsson scoring a goal, led to the finding of misrepresentation on the part of Mr Dear.

Damage to Mr Larsson was found to follow as a direct consequence of the misrepresentation. Hence, all three heads of the passing off ground were established and the ground succeeded in relation to football-related clothing (which formed approximately sixty percent of the original list of goods).

Bad faith

Mr Larsson argued Mr Dear had no intention of using the marks on three different grounds:

1. Overly broad specification

Over 3,500 terms were listed in the specification of the LARSSON mark,

which, together with the fact that Mr Dear transferred the LARSSON mark to a dormant company when made aware of the opposition proceedings, Mr Larsson argued showed a lack of intention to use the LARSSON mark in relation to the listed goods.

While finding that this was insufficient to demonstrate a prima facie case of bad faith, the hearing officer suspended their decision on this point pending the Supreme Court's judgment in SkyKick UK Ltd and another v Sky Ltd and others.

2. Stockpiling

Mr Larsson argued that as the proprietor of other trade mark registrations incorporating the names of famous sportspersons Mr Dear's company was stockpiling marks. This ground was, however, robustly rejected.

3. Opportunistic blocking/squatting

Despite initially claiming that Mr Dear contacted him offering to let him pay to acquire rights afforded by the registration, Mr Larsson later stated that Mr Dear had in fact offered him a percentage of sales if he agreed to the exploitation of his name. Taking this inconsistency into account, the hearing officer rejected this ground.

Award of costs

In this instance, the hearing officer considered Mr Dear's behaviour to be exceptional enough to warrant awarding off-scale costs on a compensatory, rather than contributory, basis. Some of the factors taken into account in reaching this decision include:

- Mr Dear's unnecessarily high volume of disorderly correspondence and the subsequent work this created for Mr Larsson's representatives and the tribunal.
- Mr Dear's refusal to comply with a disclosure order made in relation to his prior contact with Mr Larsson.
- The disrespectful tone used by Mr Dear in much of his correspondence, for example describing the UK Intellectual Property Office (UKIPO) as "a law unto itself...acting against my company and my trade marks".

Litigants in person

It is worth noting that, while awarding off-scale costs against Mr Dear for his conduct, the hearing officer highlighted the unfairness of inconsistencies between Mr Larsson's written submissions, pleadings and skeleton arguments, as to the number of headings under which the bad faith claim was brought. The purpose of this was to emphasise the particular importance of represented parties being clear and consistent with their pleadings, particularly when acting adverse to litigants in person.

Conclusion

This opposition highlights various points that represented parties must have in mind when the other side is a litigant in person. Not only should they be prepared to deal with the unconventional but they should also be aware of the potential impact this has on cost awards.

Author:

Laurie Ford



Celtic legend Henrik Larsson has successfully had a LARSSON mark declared invalid



LAAVA v EUIPO

Interpreting characters within signs

Case details and useful link

Jurisdiction: European Union

Decision level: General Court

Parties: Gürok Turizm ve Madencilik

Anonim Şirketi v EUIPO (other parties:

Gábor Darvas, Dorina Pap)

Citation: T-473/22

Date: 13 September 2023

Decision: dycip.com/t-473-22

LAAVA, EUTM file information, EUIPO,

12 March 2020: dycip.com/eutm-018209861

The General Court agreed that there was no likelihood of confusion between LAV and LAAVA for identical goods, but the reasoning behind the decision differed to that of the Board of Appeal. One of the differences concerned the interpretation of the characters within the sign LAAVA.

Background

The figurative mark LAAVA (see image below) was applied for as a European Union trade mark (EUTM) in classes 14 and 21.



An opposition was filed against “glass bottles containing mineral stones”, being all goods in class 21.



Figure 1

Figure 2

The opponent claimed a likelihood of confusion with its two earlier figurative EUTMs for LAV (figure 1) and Lav (figure 2), which covered goods including “glassware not included in other classes” in class 21.

At first instance, the opposition was rejected. The Board of Appeal agreed that there was no likelihood of confusion. The case was then appealed to the General Court.

Same outcome: different reasoning

As the earlier marks were EUTMs, the relevant territory was the EU in its entirety. In all instances, the Opposition Division, the Board of Appeal and the General Court held that the marks were similar only to a low degree and the goods were identical. This did not suffice to assume a likelihood of confusion. However, their reasoning differed. The primary points of difference were:

Why the level of attention of the relevant public was average to high

- The Opposition Division, Board of Appeal and General Court agreed that the relevant

public would be the general public and the professional public in the EU. In addition, the level of attention of the relevant public was agreed to be higher than average.

- On the one hand, the Board of Appeal agreed with the Opposition Division that this was because glass bottles do not normally contain mineral stones and the stones could be precious or semi-precious. Therefore, the goods would be more expensive than ordinary glass bottles and purchased occasionally for long-term use.
- Conversely, the General Court considered the higher than average level of attention was because the relevant public only purchased bottles with mineral stones occasionally and for decorative purposes, or to obtain positive effects from the mineral stones. The court decided that mineral stones are not necessarily expensive.

How to perceive the characters within the contested mark LAAVA

- The Opposition Division described the contested sign LAAVA as containing the verbal element “LAAVA”, with the letter “A” depicted as an inverted letter “V”.
- The Board of Appeal however considered that LAAVA would not be perceived as “LAAVA”, but as containing a combination of both Greek and Latin letters including the Greek capital letter “Λ”, lambda.
- The General Court acknowledged that the part of the relevant public that speaks Greek would understand the symbol “Λ” as lambda, and that letters from the Greek alphabet are used in mathematics, science and engineering. But overall the General Court held that most consumers in the EU do not know the Greek alphabet. Therefore, the relevant public would perceive “Λ” as a stylised capital “A”, and would pronounce the contested sign as “LAA” “VA”. In support of this analysis, the General Court noted that the trade mark application form described the mark as “laava”.

Comparison of the marks

- The Opposition Division found the marks were similar only to a low degree.

- Reading the sign as containing both Latin and Greek characters led the Board of Appeal to conclude that the marks were similar visually and phonetically only to a low degree, and that conceptually a comparison was either impossible or the marks would be dissimilar.
- Reading the sign as containing only Latin characters led the General Court to conclude that the marks were similar only to a low degree, visually and phonetically. Again, conceptually the marks were either not comparable or dissimilar. It was noted that the earlier marks for “LAV” were short and the contested mark did contain stylisation that reduced the overall similarities.

Overall, the General Court confirmed there was no likelihood of confusion. Therefore, the appeal was dismissed.

Author:

Jennifer Heath



In short

It is important to carefully consider the relevant public and their awareness of local language characters. Keep in mind that describing a word element on an application form can influence the likelihood of confusion assessment.

Where key marks contain (rare) local language characters it may be useful to also hold registrations in the relevant local language territory of the EU. These registrations can then be relied on in EU opposition proceedings, with the relevant public being the local language territory.

BICC disappointment in passing off dispute

IPEC examines chain of title, goodwill and folk memory

Case details at a glance

Jurisdiction: United Kingdom

Decision level: High Court (IPEC)

Parties: PRYSMIAN CABLES & SYSTEMS LIMITED (claimant) and M/S APPLE INTERNATIONAL, RAJESH MANHARLAL SANGHVI, BICC COMPONENTS LIMITED, SPECIALISED WIRING ACCESSORIES LIMITED and TERMINATION TECHNOLOGY LIMITED (defendants)

Citation: [2023] EWHC 2176 (IPEC)

Date: 07 September 2023

Decision: [dycip.com/prysmian-apple-int](https://www.dycip.com/prysmian-apple-int)

In a recent Intellectual Property Enterprise Court (IPEC) case, recorder Amanda Michaels dismissed Prysmian Cables & Systems' passing off claim in respect of M/S Apple International's use of the name BICC COMPONENTS in the UK.

The claimant alleged that it owned goodwill in the BICC name and was successful in proving misrepresentation and damage. However, its passing off case ultimately failed because the available evidence did not demonstrate that goodwill in the BICC mark had been validly transferred to the claimant, following the sale of BICC Plc's cables business in 1999.

The IPEC also found that the claimant could not rely on residual goodwill in the BICC brand.

Background

The claimant's case was as follows:

- by February 2000 the BICC cables business (including goodwill in the BICC name) was transferred from BICC plc to General Cable Corporation;
- the BICC cables business was subsequently acquired by Pirelli SpA through a share purchase agreement (at which point the cables business was rebranded to BICON); and
- shares in the Pirelli cables business were sold in 2005 to a company which would later become the claimant.

The defendants challenged the claimant's chain of title, and further argued that even if the goodwill had been validly transferred it was abandoned or extinguished through 17 years of non-use and the rebrand from BICC to BICON.

Chain of title

The judge examined in detail the sales and purchase agreements between BICC plc, GK Technologies and General Cable Corp in 1999 (GCC agreement), and between General Cable Corp and Pirelli SpA.

Having construed the contracts, the judge

found that the GCC agreement provisions were inconsistent with a transfer of goodwill:

- the BICC name and trade marks were not included in a schedule of BICC Plc's IP rights which were being transferred to the purchaser;
- a condition of sale was that the purchaser would remove BICC from the name of each of its group companies;
- even if the purchaser was given a limited licence to use the BICC name, that licence only applied to members of the GK Technologies group. Thus, if there was a licence to GCC it would have ceased following the share sale of GCC to Pirelli;
- finally, Pirelli's rebrand from BICC to BICON in 2000 was indicative that at the relevant time the Pirelli/the claimant did not believe it had the right to use the BICC mark, and therefore chose to adopt the BICON mark in the hopes that it would link to the BICC mark's heritage.

The evidence before the IPEC indicated that Pirelli/the claimant had never used the BICC mark and, therefore, if any goodwill in BICC had indeed been validly transferred the claimant abandoned it in favour of its new BICON mark.

Folk memory

The judge considered whether, had the goodwill been validly transferred, it would have been lost by attrition, or whether the claimant could still have relied on residual goodwill, or "folk memory", in the BICC name (notwithstanding the non-use and rebrand).

It was significant that the claimant had never informed the market that the BICC brand was being discontinued, but had sought to trade off BICC's legacy and heritage through use of the BICON mark.

It also informed consumers that BICON products satisfied the same standards.

While the claimant had made some efforts to retain BICC's reputation, the judge pointed out that:

- reputation is not the same as residual goodwill/folk memory;
- there was insufficient evidence showing that consumers perceived there to be an association between BICC and the claimant; and
- the claimant could not rely on a predecessor's residual goodwill in a sign which it had not used post-acquisition.

As a result, the claimant did not own the goodwill in BICC, resulting in the dismissal of its passing off claim.

It is worth mentioning that, if the chain of title and abandonment issues had been overcome by the claimant, the IPEC would have found that the remaining goodwill was capable of protection, and that the defendants' attempts at gaining a commercial advantage, through references to BICC's heritage, would have amounted to a misrepresentation that caused damage to the claimant's business.

Author:

Agnieszka Stephenson



In short

To avoid chain of title disputes and costly litigation, it is strongly advisable to keep contemporaneous records where IP rights are being transferred, fully document such transfers in assignment agreements, and, where appropriate, record changes of ownership before the UK Intellectual Property Office (UKIPO). In so doing brand owners can safely rely on and protect their valuable IP rights.

D YOUNG & CO INTELLECTUAL PROPERTY

And finally...

Geographical indications

Geographical indications EU expands to craft and industrial products

The Council of the European Union recently formalised the EU regulation on geographical indications (GIs) for craft and industrial products. A GI signifies that a product possesses distinct qualities or characteristics linked to a specific geographical origin, such as champagne from France and Parmigiano Reggiano cheese from Italy. GIs have traditionally served as economic catalysts, enabling producers to command premium prices and ensuring product authenticity for consumers. The regulation expands GI protection to craft and industrial products categorised as “non-agricultural GIs.” The criteria for non-agricultural GIs consider a product’s quality or reputation, not just its geographical origin or its “terroir”. This marks a shift from the conventional approach to GIs, where the product’s connection to a region significantly influences its character.

The use of the protected geographical indication (PGI) logo on non-agricultural GIs has sparked debate, as industry players fear it may dilute the logo’s significance, since PGIs are traditionally associated with food and alcoholic drinks subject to stringent processes. Registering a non-agricultural GI involves a self-declaration of compliance, which traditional GIs cannot easily do. The registration process for non-agricultural GIs includes two steps: the national phase and the union phase. EU member states with few non-

agricultural GIs may skip the national phase. Notably, shifting from the European Commission’s traditional oversight of GIs, the council has designated the EU Intellectual Property Office (EUIPO) to manage non-agricultural GIs, and examinations and oppositions will be heard in the new “GI Division” of the EUIPO.

The revised framework enables holders of traditional GIs and non-agricultural GIs further protection:

- **Domain names:** rights to challenge unauthorised GI use of a domain name.
- **Goods in transit:** rights over products passing through the EU.
- **Online sales:** rights over goods sold by means of distance selling, such as e-commerce.

The regulation also defines “evocation” as a legally enforceable right related to unauthorised use that consumers associate (“direct and clear link”), with a product possessing a registered GI.

The regulation awaits signatures from both institutions’ presidents. Twenty days after publication in the Official Journal of the European Union it will enter into force and will be applicable in two years.

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