GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS

EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

Part C

Opposition

Section 6

Geographical Indications (Article 8(6) EUTMR)

Obsolete

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1 Introduction

Pursuant to Article 8(6) EUTMR, designations of origin and geographical indications protected under Union legislation or national law may be invoked in an opposition against an EUTM application. When defining the protection given to these specific designations, the regulations refer simply to the protected/registered names, regardless of whether those names refer to a protected designation of origin (PDO) or a protected geographical indication (PGI). Moreover, the scope of protection is not affected by any distinction between PDOs and PGIs. Therefore, this section will refer to these protected names as geographical indications (GIs) without making any distinction between them.

The essential function of the protection of a GI is to guarantee to the consumer the geographical origin of the goods and the special qualities connected with that origin (29/03/2011, C-96/09 P, Bud, EU:C:2011:189, § 147).

Protection of GIs on relative grounds is complementary to the *ex officio* protection on absolute grounds (Article 7(1)(j) EUTMR). While there is interaction and overlaps with protection under absolute grounds, there are differences both in terms of procedure and substance arising from the relative grounds nature of protection under Article 8(6) EUTMR.

Article 8(6) EUTMR reads:

Upon opposition by any person authorised under the relevant law to exercise the rights arising from a designation of origin or a geographical indication, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Union legislation or national law providing for the protection of designations of origin or geographical indications:

1. an application for a designation of origin or a geographical indication had already been submitted, in accordance with Union legislation or national law, prior to the date of application for registration of the EU trade mark or the date of the priority claimed for the application, subject to its subsequent registration;
2. that designation of origin or geographical indication confers the right to prohibit the use of a subsequent trade mark.

Article 8(6) EUTMR is, therefore, a framework provision in the sense that it is the applicable EU legislation, Member State law or international agreement that determines the conditions of acquisition and scope of protection of the GI invoked. Furthermore, as will be explained below, the exhaustive nature of the EU system of protection of GIs in specific product areas determines the extent to which a GI protected under national law or international agreement is eligible to form the basis of an opposition under Article 8(6) EUTMR.

For a general overview of GIs see the Guidelines, Part B Examination, Section 4, Absolute Grounds for Refusal, Chapter 10, Trade Marks in Conflict with Geographical Indications (Article 7(1)(j) EUTMR).

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2 GIs eligible under Article 8(6) EUTMR

GIs are protected on various levels, under EU law, national law or international agreements, and cover various product areas such as agricultural products, wines, spirits or craft and industrial products.

2.1 GIs protected under EU law

As regards **EU legislation** protecting GIs, the following EU regulations are currently in place:

- Regulation (EU) 2024/1143 of the European Parliament and of the Council of 11 April 2024 on geographical indications for wine, spirit drinks and agricultural products, as well as traditional specialities guaranteed and optional quality terms for agricultural products, amending Regulations (EU) No 1308/2013, (EU) 2019/787 and (EU) 2019/1753 and repealing Regulation (EU) No 1151/2012, **which entered into force on 13 May 2024 and applies from that date**[75].
- Regulation (EU) 2023/2411 of 18 October 2023 on the protection of geographical indications for craft and industrial products and amending Regulations (EU) 2017/1001 and (EU) 2019/1753, which entered into force on 16 November 2023, but **will be fully applicable as of 1 December 2025**[76].

For more information see also the Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 10, Trade marks in conflict with geographical indications (Article 7(1)(j) EUTMR), paragraph 2.

GIs protected under the above Regulations may be a valid basis for an opposition under Article 8(6) EUTMR, to the extent that they allow the person authorised under the applicable law to exercise those rights **to prevent the use** of a subsequent mark. Their ability to prevent use is governed by Article 26(1) of Regulation (EU) 2024/1143. In this context, it is important to distinguish the latter provision **preventing use** from the one that **prevents registration** ([77]) of a trade mark, which is not a basis for opposition under Article 8(6) EUTMR (the provision preventing registration is used as a basis for absolute grounds under Article 7(1)(j) EUTMR).

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75 **Some provisions of Regulation (EU) No 1308/2013** of the European Parliament and of the Council of 17 December 2013 establishing a common organisation of the markets in agricultural products and repealing Council Regulations (EEC) No 922/72, (EEC) No 234/79, (EC) No 1037/2001 and (EC) No 1234/2007 and **Regulation (EU) 2019/787** of the European Parliament and of the Council of 17 April 2019 on the definition, description, presentation and labelling of spirit drinks, the use of the names of spirit drinks in the presentation and labelling of other foodstuffs, the protection of geographical indications for spirit drinks, the use of ethyl alcohol and distillates of agricultural origin in alcoholic beverages, and repealing Regulation (EC) No 110/2008 **in respect of geographical indications still remain in force**. It will be noted in these Guidelines, where applicable.**Regulation (EU) No 1151/2012has been repealed**.

76 Since the date of application of the relevant provisions of the Regulation is set for 1 December 2025, these Guidelines will be updated in due course to reflect this change.

77 Article 31(1) of Regulation (EU) 2024/1143.

2.1.1 The exhaustive nature of the EU system of protection

In the areas of *agricultural products, wines and spirit drinks*, protection at EU level is exhaustive in nature, which means that oppositions under Article 8(6) EUTMR cannot be based on national rights in these areas. This is because the EU system of GI protection **overrides and replaces** national protection of GIs for *agricultural products, wines and spirit drinks*.

Therefore, for these products, the opponent must invoke the relevant EU legislation in the notice of opposition as the reference to national law provisions will not be considered relevant.

As an example, in two oppositions based on the GI 'Vinho Verde' the national right was invoked instead of the EU GI. As a result, the oppositions had to be rejected.

Earlier GI(s)	**Comment**	Case No
VINHO VERDE in Portugal (national right)	… under Article 8(6) EUTMR the opponent may not rely on a national earlier right, but merely on the right conferred under the EU system of protection of designations of origin and geographical indications for wine. (§ 99, R 282/2020-5)	29/10/2021, R 126/2021-2 02/10/2020, R 282/2020-5

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2.2 GIs protected under the laws of Member States

GIs protected under the laws of Member States may be a basis for opposition under Article 8(6) EUTMR, but **only to the extent that no uniform EU protection is in place for the given category of goods**. This is the case, for example, for craft and industrial products (e.g. 'HEREND' for porcelain goods originating from Herend, Hungary).

In this regard, the opponent must rely on the relevant national law that provides protection for those national GIs. The substantiation requirements must be observed (see paragraph 2.4).

Regulation (EU) 2023/2411 on the protection of geographical indications for craft and industrial products lays down rules on registration and protection of, and controls in relation to, GIs designating craft and industrial products that will be applicable in the EU, providing for a new uniform and exclusive system of EU protection. Article 73 provides that the Regulation applies from 1 December 2025.

The existing national rights for GIs for craft and industrial products will cease to exist on 2 December 2026. Until that date, those GIs will be protected by the national law

of Member States and will therefore be considered for the application of Article 8(6) EUTMR as explained in these Guidelines.

2.3 GIs protected under international agreements

Notwithstanding that Article 8(6) EUTMR does not explicitly mention GIs protected under international agreements, the reference to 'Union legislation' and 'national law' naturally includes international agreements as they form part of the legal order of the European Union or the Member State that is a party to the international agreement.

In order for an opposition under Article 8(6) EUTMR to be successful on the basis of a right deriving from any international agreement, the provisions under the international agreement must be directly applicable and they must allow the beneficiary of the relevant GI to take direct legal action to prohibit the use of a subsequent trade mark.

In the latter respect, international agreements are **not always self-executing**. This depends on the characteristics of the agreement itself and on how they have been interpreted in the relevant jurisdiction. For example, the Office considers that the provisions of the Lisbon Agreement (in particular Articles 3 and 8) are not self-executing. As expressly indicated by Article 8 of the Lisbon Agreement, it is the relevant national legislation that must determine which type of legal actions may be taken, their scope and whether these legal actions include allowing the proprietor of an appellation of origin to prohibit the use of a subsequent trade mark. Therefore, in such cases, the requisite national legislation must be adduced as this is a necessary component in order for the opponent to prove that the GI in question can prevent use of the subsequent mark and that the opponent is entitled by the law governing the right to exercise this right.

2.3.1 International agreements entered into by the EU

GIs deriving from agreements between the EU and third countries can be invoked under Article 8(6) EUTMR if the provisions of these agreements vest the GI **in a particular beneficiary or a precise class of users** that have a direct right of action.

Article 8(6)(i) EUTMR requires that a GI already be applied for and be subsequently registered. However, this provision can also be applied by way of analogy to third-country GIs protected under international agreements. In the case of international agreements to which the EU is a party, the date of entry into force of the international agreement is deemed to be the date of priority of such a GI (and in the case of a third-country GI added subsequently to the list, the date of entry into force of the relevant amendment), unless the international agreement stipulates an earlier date of priority.

The EU is a Contracting Party to the Geneva Act of the Lisbon Agreement, which entered into force on 26 February 2020. GIs originating in non-EU countries protected under the Geneva Act of the Lisbon Agreement can be relied on in oppositions under Article 8(6) EUTMR provided that they were granted protection in the EU by the

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Commission through Regulation (EU) 2019/1753 of the European Parliament and of the Council of 23/10/2019 on the action of the Union following its accession to the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications (the 'Regulation (EU) 2019/1753') and provided that the contested trade mark was applied for after the notification of WIPO to the Commission of the international registration of the GI.

If the contested mark was applied for before the notification to the Commission of the international registration but after the filing of the international registration with the International Bureau, the GI only constitutes an earlier right if the opponent proves that the trade mark was applied for in bad faith.

The substantive law on which the opposition must rely when invoking GIs protected under the Geneva Act is Article 11(1) and (3) of the Geneva Act in conjunction with Regulation (EU) 2019/1753. For further details, see paragraph 3.2 below and the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 10, Trade Marks in Conflict with Geographical Indications (Article 7(1)(j) EUTMR), paragraph 6.2.3, GI is Protected under the Lisbon System (Geneva Act).

2.3.2 International agreements entered into by Member States including the Lisbon Agreement ([78])

For the reasons set out in paragraph 2.1.2 above, a GI protected under an international agreement concluded by Member States (either among Member States or with third countries) cannot be invoked as an earlier right under Article 8(6) EUTMR if it encroaches upon the exhaustive nature of EU law in the relevant areas (currently certain foodstuffs and other agricultural products, wines and spirit drinks).

In the 'Budějovický Budvar' case (08/09/2009, C-478/07, Budějovický Budvar, EU:C:2009:521), the Court discussed the exhaustive nature of EU law as regards GIs originating from Member States. In the Office's interpretation, this also applies a fortiori to third country GIs in the relevant product fields that are protected in the territory of a Member State through an international agreement concluded between that Member State and a non-EU country ([79]).

This equally applies to the Lisbon Agreement. In principle, appellations of origin protected in a Member State by virtue of the Lisbon Agreement cannot be a basis for opposition under Article 8(6) EUTMR. The only exceptions in this regard are the following.

- International agreements that cover GIs that do not relate to agricultural products and foodstuffs, wines or spirit drinks ([80]).

78 Some Member States (Bulgaria, the Czech Republic, France, Italy, Hungary, Portugal and Slovakia) are party to the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of 1958 (as revised in Stockholm, Sweden, on 14/07/1967, and as amended on 28/09/1979).

79 To which the EU is not a contracting party.

80 The new uniform and exclusive EU system for GIs for craft and industrial products is provided for in Regulation (EU) 2023/2411. The date of application of those rules is set as 1 December 2025. These Guidelines will be updated in due course to reflect this change.

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- International agreements concluded with third countries by a Member State before its accession to the EU. This is because the obligations arising out of an international agreement entered into by a Member State before its accession to the EU have to be respected. However, Member States are required to take all appropriate steps to eliminate the incompatibilities between an agreement concluded before a Member State's accession and the Treaty (see Article 307 of the Treaty establishing the European Community, now Article 351 (TFEU), as interpreted by the Court in its judgment of 18/11/2003, C-216/01, Budějovický Budvar, EU:C:2003:618, § 168-172).
- International agreements concluded with a third country by a Member State after its accession to the EU, but before the entry into force of the uniform EU system of protection in the given product area.

As Member States are under an obligation to eliminate incompatibilities with EU law, the Office will apply the last two exceptions (which exclusively concern third country GIs in the fields of agricultural products and foodstuffs, wines or spirit drinks) **only when the opponent expressly refers to the exception and supports it by a coherent line of argument and relevant evidence** (in particular, concerning the date of entry into force of the cited international agreement in the Member State where protection is claimed and its continued validity). General allegations by the opponent (such as merely citing the relevant international agreement) will not be sufficient in themselves for the Office to consider that one of the latter two exceptions applies.

2.4 Specifics of substantiation

Pursuant to Article 7(2) EUTMDR[81], the opponent must submit evidence of the existence and scope of protection of the earlier GI, as well as evidence of its entitlement to file the opposition. This applies to all actions, regardless of whether they are based on EU GIs, GIs protected by the laws of Member States or GIs protected by international agreements.

In particular, according to Article 7(2)(e) EUTMDR, in order to substantiate its right, the opponent must provide the Office with evidence of the existence and scope of protection of the GI invoked. The opponent must also prove its entitlement to file the opposition, namely, that it is **authorised under the relevant law to exercise the rights arising from a GI** (Article 46(1)(d) EUTMR and Article 7(2) EUTMDR). Furthermore, the opponent must prove that the applicable law confers on it a **direct right of action** to prohibit unlawful use of a GI (see the Guidelines, Part C, Opposition, Section 1, Opposition proceedings, paragraphs 4.2 and 4.2.4.4).

81 In a similar vein, Article 16 EUTMDR in relation to invalidity proceedings.

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3 Scope of protection of GIs

3.1 Situations covered by the EU Regulations

The **scope of protection of GIs protected under EU Regulations** is governed by Article 26(1) of Regulation (EU) 2024/1143. The provision preventing registration, Article 31(1) of Regulation (EU) 2024/1143, is not a basis for opposition under Article 8(6) EUTMR (12/06/2007, T-60/04 - T-64/04, Bud, EU:T:2007:169, § 78); such an opposition cannot depend on whether the opponent fulfilled the conditions required to prohibit registration under the cited provision (18/09/2015, T-387/13, COLOMBIANO HOUSE / CAFE DE COLOMBIA, EU:T:2015:647, § 40 et seq.). Therefore, under Article 8(6) EUTMR, a GI can prevail if the conditions set out in the provision preventing use are met.

Article 26(1) of Regulation (EU) 2024/1143refers to a graduated list of prohibited acts against which GIs are protected:

- any direct or indirect commercial use of the GI in respect of products not covered by the registration, where those products are comparable to the products registered under that name or where use of that GI for any product or any service exploits, weakens, dilutes, or is detrimental to the reputation of, the protected name, including when those products are used as an ingredient;
- any misuse, imitation or evocation, even if the true origin of the products or services is indicated or if the protected name is translated, transcribed or transliterated or accompanied by an expression such as ‘style’, ‘type’, ‘method’, ‘as produced in’, ‘imitation’, ‘flavour’, ‘like’ or similar, including when those products are used as an ingredient;
- any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product that is used on the inner or outer packaging, on advertising material, in documents or information provided on online interfaces relating to the product concerned, and the packing of the product in a container liable to convey a false impression as to its origin;
- any other practice liable to mislead the consumer as to the true origin of the product.

It must be emphasised that what applies are the specific conditions of the scope of protection as laid down in the applicable provisions and not, for example, the ‘similarity of signs’, ‘similarity of goods and services’ or ‘likelihood of confusion’.

Article 26(1) of Regulation (EU) 2024/1143 contemplates situations where a GI can be invoked against goods or services that may go beyond goods and services that may be objected to under the *ex officio* examination of absolute grounds (subject to the conditions of that provision).

Detailed information on the scope of protection of GIs protected under the relevant EU regulation is included in the Guidelines, Part B, Examination, Section 4, Absolute

grounds for refusal, Chapter 10, Trade marks in conflict with geographical indications (Article 7(1)(j) EUTMR) (e.g. definitions of direct and indirect use, imitation, evocation, misuse, misleading indication and practices, objectionable products).

3.1.1 Use, including exploitation of the reputation of the GI

The cases involving the use of a GI for comparable products falling under Article 26(1)(a) of Regulation (EU) 2024/1143 are normally part of the Office's *ex officio* assessment of absolute grounds. See also the Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 10, Trade marks in conflict with geographical indications (Article 7(1)(j) EUTMR), paragraph 4.

If an opponent claims in its submission that, for example, an EUTM application contains a GI and the goods applied for are comparable to those covered by that GI (or the goods constitute the specific object of services such as *retail, wholesale, import/export, provision of drink and food, production of [the product covered by the GI] for others*), the Office will, if this is indeed the case, reopen the examination on absolute grounds.

However, underthe above mentioned provision, a GI can be invoked against goods and services that would not be objected to *ex officio* under absolute grounds, subject to use of the GI in the contested EUTM application and proof that such use in relation to the contested goods and services **would exploit the reputation of the GI**. On 'use of a GI' see the Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 10, Trade marks in conflict with geographical indications (Article 7(1)(j) EUTMR), paragraph 4.1. Therefore, the provision regarding the exploitation of reputation of the protected name can only be relied upon when there is 'use' of a GI, and the opponent shows the possible exploitation of reputation of the GI for goods that are neither covered, nor comparable to those covered by the GI and services unrelated to the GI (as goods and services related to the GI would already be subject to objection under absolute grounds assessment).

The reputation of GIs depends on their image in the minds of consumers, and that image, in turn, depends essentially on particular characteristics and more generally on the quality of the product. It is on the quality of the product that its reputation is based (14/09/2017, C-56/16 P, PORT CHARLOTTE, EU:C:2017:693, § 81-82). Therefore, contrary to the situation with trade marks, where reputation is quantitatively assessed, the reputation of a GI is linked only to the quality of the product that it designates. All registered GIs offer a guarantee of quality due to their geographical provenance. Therefore, the Office considers that GIs **are intrinsically reputed** within the meaning of Article 26(1)(a) of Regulation (EU) 2024/1143 by the mere fact that they are registered. This is irrespective of whether a GI has been registered on the basis of a claim in the application to its reputation being essentially attributable to its geographical origin (Article 46(1)(b) and Article 46(2)(b) of Regulation (EU) 2024/1143, for agricultural products, Article 93(1)(b)(i) of Regulation (EU) No 1308/2013 , for wines, and Article 3(4) of Regulation (EU) 2019/787, for spirit drinks).

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Consequently, opponents **do not have to submit evidence of the reputation** of the GI. Nevertheless, opponents must submit **convincing arguments and/or evidence regarding the exploitation of the reputation of the GI**. The Court held that '[t]he incorporation in a trade mark of a name which is protected … cannot be held to be capable of exploiting the reputation of that [name] … if that incorporation does not lead the relevant public to associate that mark or the goods in respect of which it is registered with the [name] concerned or the … product in respect of which it is protected' (14/09/2017, C-56/16 P, PORT CHARLOTTE, EU:C:2017:693, § 115).

As a rule, general allegations (such as merely citing the relevant wording of the EU regulations) of exploitation of the reputation **will not be sufficient in themselves** to prove such exploitation. The opponent must adduce evidence and/or develop a cogent line of argument to demonstrate specifically how the alleged injury might occur, taking into account both the rights concerned, the goods and services in question and all the relevant circumstances.

Earlier GI(s)	Contested sign	Case No
CÍTRICOS VALENCIANOS / CÍTRICS VALENCIANS (PGI-ES-0152) for *orange, mandarin and lemon fruit*	AROCiVAL aromes cítrics valencians EUTM application No 17 878 444 for *essential oils and food flavourings* (Classes 3 and 30)	24/03/2020, B 3 058 243 (exploitation of reputation)
Assessment: Taking into account the presence of the terms 'citrics valencians' in the contested sign and the nature of the goods for which protection is sought (the protected citrus fruit may be ingredients of oils and aromas), and the efforts made in promoting the GI that are accredited by the opponent, when faced with the contested sign, the relevant consumers will probably associate it with the PGI 'Cítrics Valencians' and the goods it covers. It will thus take advantage of the repute and power of attraction of the latter. The remaining elements of the contested trade mark do not prevent the association with the earlier right; on the contrary, they reinforce the association in the sense indicated by the opponent.		

3.1.2 Evocation, imitation, misuse and misleading indications and practices

For 'evocation', 'imitation', 'misuse' and 'misleading indications and practices' see Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 10, Trade marks in conflict with geographical indications (Article 7(1)(j) EUTMR), paragraph 4, and more precisely paragraphs 4.2 and 4.3.

The Court of Justice has clarified that the concept of 'evocation' extends to all uses that take unfair advantage of the reputation enjoyed by the GI through association with it (09/09/2021, C-783/19, Champanillo, EU:C:2021:713, § 50, see also the Opinion of the

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Advocate General Pitruzzella of 29/04/2021, C-783/19, Champanillo, EU:C:2021:350, § 36-37). This is particularly relevant in cases based on Article 8(6) EUTMR where the opponent can submit the relevant evidence establishing the extent of its GI's reputation and its potential exploitation.

Moreover, the Court of Justice clarified that the legal provisions on 'evocation' must be interpreted in the sense that they protect registered GIs against conducts/practices relating to both products and services, and, moreover, that there is no prerequisite that the product covered by the protected GI and the goods or services covered by the EUTM are identical or similar in order to establish evocation (09/09/2021, C-783/19, Champanillo, EU:C:2021:713, § 52, 61, 66).

The following example illustrates this point:

Earlier GI(s)	**Contested sign**	**Case No**
PROSECCO (PDO-IT-A0516) for *wines*	PERISECCO EUTM NO 12 788 907 registered for *alcoholic beverages (except beer and wine)* in Class 33	28/10/2021 R 1101/2019-1 (confirmed C 15 225, evocation)
Assessment: There is clearly a close visual and phonetic proximity between the PDO PROSECCO and the contested mark PERISECCO (para. 63). The probability that the element PERISECCO […] will directly bring to the mind of the average European consumer the PDO PROSECCO when seeing it used for the applicant's alcoholic beverages is particularly high (para. 65). This probability is not reduced following the partial surrender of the contested mark to -alcoholic beverages *except beers and wines*-. As reminded by the Court in the 'Champanillo' case (09/09/2021, C-783/19, Champanillo, EU:C:2021:713), Article 103(2)(b) of Regulation No 1308/2013[82](unlike part (a)), does not refer to comparable products. Thus, the concept of 'evocation' does not require that the product covered by the PDO and the product or service covered by the disputed name be identical or similar (para. 67). Bearing in mind all the circumstances of the case, in particular the outstanding reputation of the PDO PROSECCO and the various additional circumstances regarding the marketing of the EUTM proprietor's goods, underlined by the applicant in its submissions and in the contested decision, there is a very high probability that consumers, throughout the European Union, will establish a sufficiently clear and direct link between the term used to designate the EUTM proprietor's products 'PERISECCO' and the PDO PROSECCO (para. 71). The evocation in the mind of an average European consumer is enhanced by the fact that 'PROSECCO' is the name that has been used for centuries to refer to a wine originating from the area of Prosecco in the region of Trieste, and which nowadays enjoys an outstanding reputation for its wines that are now protected by the PDO 'PROSECCO' (para. 72).		

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In cases based on Article 8(6) EUTMR, therefore, the assessment is not limited to identical and comparable goods and related services as it is in the *ex officio* examination, which is based on the absolute grounds. Should the opponent claim in its submission that, for example, an EUTM evokes a GI and the goods applied for are comparable to those covered by the GI (or the goods constitute the specific

82 Now, Article 26(1)(b) of Regulation (EU) 2024/1143.

object of services such as *retail, wholesale, import/export, provision of drink and food, production of [the product covered by the GI] for others*), the Office will, if this is indeed the case, reopen the examination on the absolute grounds.

3.1.3 Limits to the scope of protection of GIs on relative grounds

The scope of protection of GIs under EU regulations cannot exceed what is required to safeguard the function of the GI, which is to designate goods as being from a particular **geographic origin** and as having the **special qualities connected therewith**. Unlike other signs, GIs are not used to indicate the commercial origin of goods and afford no protection in this regard.

Therefore, where the specification of an EUTM application **is limited, in relation to goods identical to the product covered by the GI, to goods in conformity with the specification of the relevant GI**, the function of the GI in question is safeguarded in relation to those products. This is because the EUTM application only covers products from the particular **geographic origin and the special qualities connected therewith**. Consequently, an opposition against an EUTM application that has been appropriately limited will not succeed. In this regard, see Article 36 of Regulation (EU) 2024/1143. For general information on limits to the scope of protection of GIs, see the Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 10, Trade marks in conflict with geographical indications (Article 7(1)(j) EUTMR), paragraph 4.5.

Earlier GI(s)	**Contested sign**	**Case No**
CAVA (PDO-ES-A0735) for *wines*	 EUTM No 16 564 271 applied for *wines, sparkling wines, all in conformity with the specifications of the PDO "Cava".*	16/10/2020, B 2 935 669 (exploitation of reputation)
Assessment: Where the specification of an EUTM application is limited, in relation to goods identical to the product covered by the GI, to goods in conformity with the specification of the relevant protected GI, which is the case of the contested mark, **the function of the GI in question is safeguarded** in relation to those products because the EUTM application only covers products from the particular geographic origin and the special qualities connected therewith.		

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3.2 Scope of protection of GIs protected under national law or international agreements

The scope of protection of GIs protected under national law or international agreements, including agreements concluded by the EU with third countries, is **governed by the relevant provisions** (e.g. Hungarian GI 'HEREND', by Article 109 of Act XI of 1997 on the protection of trade marks and geographical indications; for the GI 'Mezcal', by the relevant provisions of the Agreement between the European Community and the United Mexican States on the mutual recognition and protection of designations for spirit drinks (OJ L 152, 11.06.1997, page 16). The substantive provisions of the agreement concerned may for instance include specific requirements or authorisation for the use of the protected term. See also the Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 10, Trade marks in conflict with geographical indications (Article 7(1)(j) EUTMR), paragraph 6.2.

As regards the scope of protection of GIs protected under the Geneva Act to which the European Union is a contracting party, and in particular its Article 11, please see the Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 10, Trade marks in conflict with geographical indications (Article 7(1)(j) EUTMR), paragraph 6.2.3, GI is protected under the Lisbon System (Geneva Act).

The Office considers that in spite of the different wording of Article 11(1) of the Geneva Act, the scope of protection corresponds to that of the GIs protected under the EU Regulations (i.e. against direct and indirect use of the GI for the same and comparable products, exploitation, weakening, dilution and detriment of/to reputation of the GI, misuse, imitation or evocation or other misleading indications and practices). In addition, the Office considers that the notion of 'goods that are not of the same kind' is analogous to the notion of 'non-comparable goods' under the EU Regulations providing for the protection of GIs. The Office will therefore apply the same standard to GIs protected under the Geneva Act and will examine potential conflict with earlier GIs, bearing in mind, *mutatis mutandis*, the rules contained above in the Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 10, Trade marks in conflict with geographical indications (Article 7(1)(j) EUTMR), paragraph 4.

Finally, unlike in the *ex officio* examination of absolute grounds of refusal, an opposition based on Article 8(6) EUTMR can be successful against goods and services that are not comparable to those for which the GI is protected, provided that the opponent submits evidence and arguments to prove that either Article 11(1)(a)(ii) or Article 11(1)(b) of the Geneva Act apply to such non-comparable goods or services. In this regard the Office will apply the same standard as in the examination of cases based on Article 8(6) EUTMR and invoking EU GIs as basis (see paragraph 3.1 above).

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