

## V. Descriptive elements in Community collective marks

The preceding anatomy of Community collective marks and GIs raises the issues of descriptiveness of geographical terms, the way they fit into trade mark law, especially in collective marks, and their scope of protection therein. It is widely accepted that geographical names are of descriptive character, which prevents registration in the trade mark system according to Article 7.1.c CTMR, as these terms should be kept free for everyone to use. This position holds true for conventional trade marks,<sup>121</sup> although it can be overturned if acquired distinctiveness can be proven<sup>122</sup> or on grounds of fair use.<sup>123</sup> The problem, however, is completely bypassed in the case of collective trade marks, as the CTMR itself, in Article 66.2 thereof, explicitly provides for derogation from this rule.

The rationale of this provision is the accommodation of GIs in the trade mark regime. As a matter of fact, the same holds true for collective (and certification) marks at the international level.<sup>124</sup> The provision, subsequently, is formed in a GI mentality, but the protection it offers is adjusted to the trade mark philosophy. In other words, collective marks with a geographical component are warded, in line with the general trade mark rules, against confusion likely to be created by identical or similar signs in connection to the same or similar goods or against dilution if being well-known marks, as prescribed in Article 9 CTMR. The protection is thus dependent on confusion, whereas the protection of GIs is not conditioned by that. Additionally, protection of a mark of geographical nature is excluded from the ambit of Community collective marks for dissimilar products or services, unless it is a mark with a reputation and provided of course that the rest of the requirements of Article 9.1.c are met.

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121 Alberto Francisco Ribeiro de Almeida, *Key Differences between Trade Marks and GIs*, 30(10) EIPR 408 (2008).

122 Article 7.3 CTMR.

123 Uche U. Ewelukwa, *Comparative Trade mark Law: Fair Use Defense*, 13 WIDENER LAW REVIEW 141-149 (2006). See also DEV GANGJEE, *OVERLAPS BETWEEN TRADE MARKS AND GIS* in NEIL WILKOF & SHAMNAD BASHEER (EDS.), *OVERLAPPING INTELLECTUAL PROPERTY RIGHTS*, 282 (Oxford University Press, 1st ed. 2012).

124 WIPO, *supra* n. 55 , at 8.

To that general scheme there is, however, an exception. A collective trade mark proprietor cannot prohibit the use of the geographical sign or indication by anyone who profits from it in the course of honest industrial or commercial conduct or by anyone authorised to use it.<sup>125</sup> In this case, consequently, a third party should be able to show that they operate in good faith and based on fair commercial practices and business ethics, or they have been granted a right. This principle should accordingly be reflected in the regulations governing use of the collective mark, which have to be phrased in a way as to permit membership status to persons manufacturing products in the geographical place concerned.<sup>126</sup>

If the view of inclusion of certification marks in Community collective marks is accepted, at least to the extent described in Chapter II, then other elements that can be descriptive might be quality, method of manufacturing and the like depending on what the mark is intended to guarantee. Since there is no derogation for this type of elements, as the one existing for geographical origin, these elements can be accepted in the register on condition they fulfil the requirements of the general provisions for individual trade marks. Further, their scope of protection should follow the general pattern, meaning their distinctiveness would be lower and therefore it would be more difficult to stop someone from using a similar sign.

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125 Article 66.2 CTMR.

126 Article 67.2 CTMR.