Geographical Indications

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Bird & Bird
GIs and TMs: Complementarities & Business Opportunities
oriGIn: The global alliance of GIs groups
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• Advocacy for the effective protection and enforcement of GIs

• Think-tank on GIs and sustainable development

• Services to members through strategic partnerships
  ▪ Information
  ▪ Legal advice
  ▪ Raise awareness on GIs among policy makers, TM offices, etc.
  ▪ List of GIs specialized law firms
GIs are a truly global concept

- Some 3,500 GIs recognized in the EU
- Some 2,000 in China
- Some 400 in Latin America
- Some 300 in the USA (AVAs for wines & geographical certification marks)
- Some 150 in Africa (mainly South African wines, but first agri GIs in OAPI)
Why does origin matter?

• **Worldwide sale value** of EU PDO/PGI in 2010: 54.3 billion EUR (Study commissioned by DG Agri, published in 2012)

• **Premium price**: GI products sold in the EU 2.23 times more expensive than non GI products of the same category

• Positive impact on **employment** (especially in poor areas): 3 times as many direct jobs created by French GI cheeses per litre of milk processed (2.8 jobs v. 1 job)
Why does origin matter?

• Sectors:
  
  i. Wines: 56% (30,4 billion EUR)
  ii. Agricultural products and foodstuffs: 29% (15,8 billion EUR)
  iii. Spirits: 15% (8,1 billion EUR)
  iv. Aromatized wines (31 million EUR)

• Countries: France (20,9 billion EUR), Italy (11,8 billion EUR), Germany (5,7 billion EUR) and UK (5,5 billion EUR)
Why does origin matter?

- Domestic sales: 60%
- Intra-EU trade: 20%
- Extra-EU trade: 20% (+ 29% from 2005)

Opportunities for promotional campaigns under Regulation (EU) No 1144/2014:

- The Commission has provisionally allocated 123 million for 2017, with a strong emphasis on third countries (64 million EUR)
- Up to 80% of EU co-financing
Why does origin matter?

• Study on increased revenues derived from quality differentiation on coffee in Colombia between 20’s and 90’s: 3.5 billion US$

• Opportunities for developing countries to escape the “commodity trap”

• Full annual economic impact of the Napa Valley industry in the Napa County: 10.9 billion US$

• Business opportunities created in other sectors such as tourisms: Ex: “Routa del Tequila” (investments through the Inter-American Development Bank)

• Sustainable development issues
In the past, (too much…) emphasis was put on GIs-TMs conflicts

Arising from:

- GIs recognition in conflict with previously registered TMs (I)
- TMs registration in conflict with previously recognized GIs (II)
- TMs and GIs in the gTLDs: UDRP policy (III)
Relevant rules to manage those conflicts

- (I)
  a. First in time, first in right
  b. Coexistence
  c. Prohibition to register descriptive and geographically deceptive TMs

- (II)
  a. First in time, first in right
  b. “Ex officio” obligation for TM offices to refuse applications conflicting with GIs
  c. Art. 22.3 and art. 23.2 of TRIPs
I. Moving from “ideological conflicts” to “pragmatic solutions”

Coexistence between the EU PDO “Prosciutto di Parma” and the Canadian TM ”Parma” in Canada through the CETA
II. Pragmatic solutions: issues to be clarified in the EUIPO practice

• Limitation to products in conformity with PDO/PGI specification: ‘[name of the product] complying with the specifications of the [PDO ‘X’]/PGI ‘X’]

   (Guidelines for Examination in the Office, Part B Examination, 2.10.4.2 Restrictions of the list of goods)

• TMs consisting or containing names similar to the PDO/PGI (evocation, imitation, etc.)
Following the introduction of new gTLDs, GIs have been accepted in the TMCH.

Recognition has been given to wine GIs in the “.wine” & “.vin” strings as a result of a private agreement.
GI, collective/certification mark, TMCH, new gTLDs and innovative partnerships
A fresh look at the issue of GIs and TMs: complementarities
A fresh look at the issue of GIs and TMs: business opportunities
Use of PDOs/PGIs as ingredients: cheese → pasta
Use of PDOs/PGIs as ingredients: PDO cheese → snacks

With genuine Parmigiano Reggiano, chips lightly browned in the oven and flavored with olive oil, without chemical ingredients.
Use of PDOs/PGIs as ingredients: NOT EASY!

- EU regulation requires the listing of ingredients (to inform consumers)
- GIs are protected against the exploitation of their reputation (similar to dilution)
- Manner of use on packaging will be a key question
- When does ingredient labelling become exploitation of the GI?
- Seek permission from the GI holder?
Use of PDOs/PGIs as ingredients: the Italian approach

Use of a PDO/PGI in the labelling, presentation and advertising of products containing such names as ingredients **is subject to authorisation** by:

- the “Consorzio di Tutela” (if present): rules, register of the authorised users

- Italian Ministry for Agriculture Food and Forests Policies (MIPAAF)
  
  https://www.politicheagricole.it/flex/cm/pages/ServeBLOB.php/L/IT/IDPagina/9795

The authorisation is required also for use PDO/PGI ingredients in non-agricultural products (e.g. perfumery, cosmetics)
Use of PDOs/PGIs as ingredients: the Italian approach

Use of a PDO/PGI in the list of ingredients is not subject to authorisation

... but check the requirements in the product specification

e.g.: transformation of the GI ingredient in the GI area of origin, use of logos, etc.
TMs and GIs: interesting partnerships
TMGs & GIs: co-marketing
Parma Ham PDO

Discover produits of excellence

READ MORE
Gls and Quality Private Labels:
GIls and Retail Chains: information and education

Informative campaign by MIPAAF in collaboration with supermarket chains and GIs