



Reconciling the Protection of GIs and Trademarks

The Point of View of GI Producers

Stefano Fanti

Consorzio del Prosciutto di Parma

oriGIn General Assembly

Teruel, 25th June 2009

Key Starting Points



GIs and TMs are 2 distinct but complementary intellectual property rights concepts

Whereas the geographical indication relates to the specific geographical origin and qualities or reputation of a good due to that place of origin, trademark puts the focus on the enterprise or organization that owns the good or service

GIs and TMs are very often used in combination on the labels of products

Key Starting Points



- TM protection is relatively straightforward:
 - Largely harmonized legal frameworks for TM protection available in almost all countries
 - International agreement to facilitate international protection of marks (Madrid system)
 - GI protection is much more challenging:
 - Legal instruments available for GI protection vary considerably from one country to another:
 - while more and more popular, sui generis protection systems do not exist in all jurisdictions => need to rely on trademark regimes, unfair competition and consumer protection laws, court decisions, etc.
 - No truly international instrument available to facilitate GI recognition and protection
-

Prosciutto di Parma's experience with GI and TM protection



- Prosciutto di Parma: a designation of origin in Italy since 1970 and a Protected Designation of Origin (PDO) in the EU since 1996
 - The Consorzio also registered 2 EC trademarks – “Prosciutto di Parma” and its translation in the official languages of the EC + the Ducal Crown logo including the name Parma – with the European Trademark Office (OHIM)
 - Outside the EU, very few export markets provide for a specific system of GI protection => The Consorzio del Prosciutto di Parma has sought protection of its designation of origin through trademarks, but this has proved extremely difficult and costly, if not impossible
-

The challenge of protecting GIs via the trademark route



- Impossibility to register GI names as trademarks in some countries as they prohibit the registration of descriptive names (which GIs are by definition!)
 - Collective or certification mark registration:
 - Refused: name considered as “generic”
 - Limited:
 - ex: covers combined GI name (e. g. Parmigiano Reggiano), but not the two terms individually
 - the certification mark can only be used to certify the product but not on promotional material for instance (for fearing of losing it)
 - does not protect from the proliferation of similar marks used in evocations, or in combination with other words or on different products
 - does not protect in relation with the indication of the source/origin of products
 - Product not allowed in the country for (phyto)sanitary reasons... => no defensive name protection available
 - Name already registered as trademark = one is forced to seek cancellation or to purchase a registered trademark
 - Subsequent trademarks’ registrations containing identical or similarly confusing names: need for producers to file requests for cancellation (high legal costs)
-



PROPOSALS ON HOW TO RECONCILE GI AND TM PROTECTION



How to prevent conflicts between GIs and TMs



- When a geographical name is involved, trademark offices should accept to register only collective or certification marks (refuse individual trademarks)
 - In order to prevent problems, trademark offices need to:
 - Be better informed about GIs (training required)
 - Have access to databases of GIs (publication of lists of registered GIs necessary)
 - Have regular exchange of information with public bodies in charge of GIs (coordination crucial)
 - Monitor and refuse requests of registration by non authorized parties identical or confusingly similar to protected GIs or registered CM
-

How to prevent conflicts between GIs and TMs



- Encourage all countries to establish a sui generis GI protection system to facilitate GI protection and avoid issues relating to the use of the TM system for GI protection
 - Provide for a truly multilateral (WTO) legal framework for the registration and protection of all GI products which would:
 - Facilitate the international protection of GIs
 - Provide important information to all trademark and GI offices on the protected GI names
-

How to prevent conflicts between GIs and TMs



- Much less conflicts between GIs and TMs than between TMs themselves!
 - Principles established for the resolution of TM disputes not appropriate to resolve conflicts with GIs that are a different concept as they do not take into account the specificities of GIs.
-

How to prevent conflicts between GIs and TMs



- Principles to tackle conflicts should be take into account the following elements:
 - All GIs should enjoy the same level of protection around the world (the trademark protection is the same for all products)
 - ⇒ Extension of Article 23 TRIPS protection required
 - ⇒ WTO multilateral register on GIs should be open to all products
 - Like trademarks, GIs should benefit from the Uniform Domain Name Dispute Resolution Policy of WIPO
-

How to prevent conflicts between GIs and TMs



- The trademark principle «first in time, first in right» is not appropriate as:
 - GI is a new legal concept in most countries (although there is a long history of GI names and products used)
 - This would put GI producers in an unfair weak legal situation
 - The USA use the «**first to invent, first in right**» in the patent area
 - A principle that could apply to resolve conflicts between GIs and TMs could be the « **first to use, first in right** » as GIs are the result of a tradition that combines a geographical environment, natural and human factors. This concept should be recognized at the international level
-



Thank you for your attention
