

oriGIn Report



Highlight of the month

**oriGIn V General Assembly
(Guadalajara, Mexico):
oriGIn reinforces its role
as key international opinion maker**

On 29-30 September, the members of oriGIn gathered in Guadalajara (Mexico) for the Organisation's 5th General Assembly (GA) and an International Conference on the latest trends for GIs at the global level.

The GA was the occasion to review the main results achieved by oriGIn in the biennium 2010-2011 and to renew the Organization's bodies (See: http://www.origin-gi.com/index.php?option=com_content&view=article&id=84&Itemid=60&lang=en). Meanwhile, the "Declaration of Guadalajara", which contains a comprehensive strategy to promote stronger GI protection at the global level, was adopted. In particular, oriGIn will embark in the ambitious project to create a compilation of all GIs currently protected in the world. Such a compilation will represent an invaluable source of information for producers, consumers, academic researchers, trademark offices and public authorities in charge of GIs around the world. oriGIn will also work to ameliorate the rules concerning the protection of GIs in the cyberspace. oriGIn also stressed the need to strengthen GI-related technical assistance projects so that producers in Africa might reap the full benefits of local origin products and called upon international donors to provide for targeted GI-components in development projects. The "Declaration of Guadalajara" is available at: http://www.origin-gi.com/images/stories/PDFs/English/Event/GA_Guadalajara/Anexo_IV_oriGIn_Declaration_of_Guadalajara_19_09_2011_INGLES.pdf

At the GA, Mr. Yvon Bochet, President of the 'Syndicat du Beaufort', presented the case 'Beaufort v. McDonald's, in which the latter was condemned to pay 50.000€ of damages to the French GI group for advertising and selling a sandwich ('Mac Beaufort') which did not contain the original PDO French cheese.

Mr. Bochet announced that the 50.000€ will be donated to oriGIn to pursue its battles for a more effective protection of GIs at the global level. **Our sincere thanks go to the "Syndicat du Beaufort" for this initiative, which gives us strength and motivation to continue our work in favour of GIs!**

At the GA, new members joined our Organisation: the "Associação dos Carnicutores da Costa Negra" (ACCN) from Brazil and "Longjing Cha" (Tea), "Shuijingfang" (Spirits), "Pinggu Da Tao" (Peach) and "Jinxiang Da Suan" (Garlic) from China.

During the International Conference, practical issues of common interest for producers' groups were discussed: the successful management of national GI associations, the latest trends in the legal protection and promotion of wines and spirits with GIs, the recent developments for the origin products' business in North America and the issue of GIs looked at from the point of view of sustainable development and innovation. All presentations delivered at the Conference are available on oriGIn's website at http://www.origin-gi.com/index.php?option=com_content&view=article&id=238&Itemid=116&lang=en

We would like to take this opportunity to thank our President and the Consejo Regulador del Tequila (CRT) for the warm welcome in Guadalajara and outstanding work done for the organization of these events!

International Affairs

At Global Level

Anti-Counterfeiting Trade Agreement: Eight signatories

On 1 October, the Anti-Counterfeiting Trade Agreement (ACTA) was signed by eight countries: Australia, Canada, Japan, Morocco, New Zealand, Singapore, South Korea and the USA. This signature will have to be followed by a

formal ratification. The ratification processes are ongoing in several countries, including the EU, Mexico, and Switzerland (see oriGIn's report of September for more details). The agreement needs to be ratified by at least six parties to enter into force.

USA – South Korea, Colombia and Panama: Ratification of the FTAs

On 12 October, the US Congress approved the ratification of three Free Trade Agreements (FTAs) between the USA - on the one hand - and South Korea, Colombia and Panama on the other. On 21 October, the US President signed into law the legislation implementing the USA – South Korea, USA - Colombia, and USA - Panama trade agreements. The FTAs – which will enter into force in the coming weeks – cover the intellectual property rights.

More information at: <http://www.ustr.gov/about-us/press-office/press-releases/2011/october/statement-us-trade-representative-ron-kirk-preside>

Dominican Republic: Registration of the “Cigarro Dominicano”

On 17 October, the “Oficina Nacional de la Propiedad Industrial” (ONAPI) of the Dominican Republic registered “Cigarro Dominicano” as a geographical indication.

The Dominican cigars are produced in 11 provinces of the island and are an important source of employment. The “Instituto del Tabaco”, which regulates the sector taking into account environmental factors, elaborates an annual program of plantation and harvest. More information is available at (only in Spanish) at: <http://onapi.gob.do/index.cfm?objectid=17F8174A-C09F-31A8-CE74D83865A37F1F>

“Darjeeling”: a controversial decision of the Calcutta High Court

The Tea Board of India regulates the national tea industry. It is the registered owner of the GI “Darjeeling Tea.” The Tea Board of India also owns certification marks for “Darjeeling” and for its corresponding logo.

In 2005, the Tea Board of India opposed the application for the registration of the trademark

‘Darjeeling Lounge’ by ITC Limited, a hotel chain. ITC abandoned the application but continued to use the name ‘Darjeeling Lounge’ for its executive lounge in one of its luxury hotel in Calcutta. In April 2011, the Tea Board of India initiated a legal action in the Calcutta High Court seeking injunction against ITC for infringement, passing off and dilution under the Trade Marks Act, 1999, and the GI Act, 1999. A single bench of the Calcutta High Court refused to grant injunction to the Tea Board on the ground that it could not establish a *prima facie* case against ITC. The Tea Board filed an appeal against this decision.

In October 2011, the division bench of the Calcutta High Court ruled against the Tea Board of India on the grounds that the statutory remedy of trademark infringement is not available to the proprietor of a certification mark. Furthermore, it considered that, as the Tea Board is not a trader of tea, consumers cannot be misled and there is no case of passing off. Finally, it judged that the right conferred by the registration under the GI Act is in respect of ‘tea’ and does not confer any right over the geographical name ‘Darjeeling’ itself.

The Tea Board has the option to appeal against such judgment before the Supreme Court of India.

At EU Level

EU – Georgia: Ratification of the Agreement on GIs

On 21 September, the Council decision of 12 July 2011 on the signing, on behalf of the Union, of the Agreement between the European Union and Georgia on protection of geographical indications of agricultural products and foodstuffs was published in the Official Journal of the European Union. This means that the Agreement will enter soon into force.

EU – Switzerland: a step towards the ratification of the Agreement on GIs

On 13 September, the European Parliament adopted a legislative resolution authorising the conclusion of the Agreement between the European Union and the Swiss Confederation on

the protection of designations of origin and geographical indications for agricultural products and foodstuffs. Such resolution (available at <http://www.europarl.europa.eu/sides/getDoc.do?pubRef=-//EP//TEXT+TA+P7-TA-2011-0352+0+DOC+XML+V0//EN>) allows the Council to ratify the Agreement.

EU – Ukraine: Negotiation of a Free Trade Agreement

The EU and Ukraine are currently finalising an FTA which will cover, inter alia, all the GIs protected in the EU and two Ukrainian wines with GI.

Based on the text of the Agreement currently negotiated, a transition period of 10 years for 12 wines and spirits, and 7 years for 3 cheeses (Parmigiano Reggiano, Roquefort and Feta) will be provided. This means that the Ukrainian producers using such GIs will have respectively a phasing-out period of 10 and 7 years to implement the FTA and stop using the names at issue.

EU Issues

Policy Developments

GI Policy

“Darjeeling”: the 1st Indian GI to be registered in the EU

On 21 October, “Darjeeling” was registered as a PGI in the EU, with respect to the tea grown in the district of Darjeeling, situated in the state of West Bengal, India. It is the 1st Indian product name to be protected in the EU under Regulation 510/2006. **oriGIn congratulates the producers of Darjeeling tea!**

The specifications can be read at: <http://ec.europa.eu/agriculture/quality/door/registeredName.html?denominationId=1900&locale=en>

Quality Package: oriGIn met the Cabinet of the President of the European Commission M. Barroso

On 6 October, an oriGIn delegation met Mrs Vannini, in charge of agriculture within the Cabinet of M. Barroso, President of the European

Commission, and Mrs Vatanen, in charge of agriculture in the General Secretariat of the European Commission.

oriGIn presented its position on the management of volumes' growth and explained the reasons of such reform. The exchange of views was very constructive. Mrs Vannini explained that it is difficult to obtain an ex ante exemption which cover several sectors. It is easier to justify an exemption on a sector by sector basis. She suggested to meet the Cabinet of the Commissioner on Competition to move the file forward.

oriGIn's position is available (only to oriGIn members) at:

http://www.origin-gi.com/index.php?option=com_content&view=article&id=38&Itemid=85&lang=en

France: Law proposal concerning the protection of non agricultural IG

On 11 October, a law proposal on the protection of non agricultural GIs was adopted by the French National Assembly. The proposal was subsequently sent to the Senate to be adopted. The adoption of the text should take place before the end of the year.

Following the rise of counterfeiting of handicraft and industrial products, lawmakers decided to protect traditional non agricultural product names as GI. The adopted definition is the following: “constitutes a geographical indication the name of a region or a specific place used to describe an agricultural product, other than an agricultural product, a foodstuff or a product from the forest or the sea, which originates from this place, and which possesses a specific quality, reputation or other characteristics attributable to that geographical origin, and the production or processing, preparation or manufacture which take place in the geographical area defined in the specifications” (Art. L. 115-1-1). This definition corresponds to the one of PGI for agricultural products in the EU. The French National Institute of Origin and Quality, which already manages the applications for agricultural products, will be in charge of the requests of registration of non-agricultural products.

The articles of the law proposal on GIs are at page 34 of the document available (only in French) at: <http://www.senat.fr/leg/pjl11-012.pdf>

Green Paper on information and promotion for agricultural products

On 14 July, the European Commission published a Green Paper on promotion measure and information provision for EU agricultural products. This publication opened a public consultation, which ended on 7 October. A report summarizing the contributions will be published by the end of 2011. The Commission will present concrete options in a Communication in mid-2012, followed by regulatory proposals by the end of 2012.

oriGIn replied to this consultation and highlighted that information and promotion should be focused on the EU quality systems. In the internal market, information should focus on increasing consumers' awareness on the existing schemes (PDO and PGI) and building visibility for the EU logos. In the external market, the EU should keep on focusing its action on the promotion of the quality (PDO, PGI and TSG). oriGIn thinks that the beneficiaries of the programs should remain professional or inter-professional organisations representing the sector concerned. Individual enterprises should not become direct beneficiaries of the programs because it would undermine the key concept of the promotion European campaigns, which is based on a "collective" approach.

oriGIn's position is available (only to oriGIn members) at: http://www.origin-gi.com/index.php?option=com_content&view=article&id=227&Itemid=118&lang=en

Legal Affairs

Germany: fake "Parmesan" seized in Cologne

On 12 October, during the international food exhibition "Anuga" in Cologne, fake "Parmesan" was seized (fake "Asiago" was seized as well).

The representatives of the "Consorzio del Parmigiano-Reggiano" noticed counterfeited products bearing the name "Parmesan".

Following a complaint filed by the Consorzio, in few hours the Court of Cologne decided to seize the products at issue. This quick action shows the efficiency of the system of protection of PDO and PGI in the EU. This follows the seizure of "parmesano" and "reggiano" cheeses from South America during the 2009 Anuga exhibition.

More information at:

http://www.parmigianoreggiano.com/news/2011/fake_parmesan_seized_anuga_cologne.aspx

"Bud" saga: CJEU decision on the protection of 'Budweiser' as a trademark in the UK

As a background, 'Budweiser' is used in the United Kingdom (UK) since 1973 by Budvar, the Czech association of producers, and since 1974 by Anheuser-Busch, an American Company. Between 1976 and 2000, both parties asked the registration of 'Budweiser' in the UK Trade Marks Registry and opposed the demand of the other party. Moreover, during the 1970s, Budvar had obtained the registration of the word 'Bud'. In 2000, the Court of Appeal dismissed the oppositions' and held that Budvar and Anheuser-Busch could each have that word 'Budweiser' registered as a trademark. The Court of Appeal applied the UK legislation on trademarks, which allows concurrent registration of the same or confusingly similar marks, in circumstances where there was honest concurrent use or other special circumstances. As a result, on 19 May 2000, each party was entered in the UK Trade Marks Register as a proprietor of the trademark "Budweiser" in relation with 'beer, ale and porter'..

In 2005, Anheuser-Busch lodged at the UK Trade Marks Registry an application for a declaration that Budvar's registration was invalid on the grounds that Anheuser-Busch owns an earlier trade mark, and did not tolerate the simultaneous use of the two identical trademarks. The UK Trade Marks Registry affirmed that the Budvar's trademark was invalid. Budvar appealed the decision and the High Court of Justice confirmed the invalidation of the trademark. Budvar brought an appeal against that judgment before the Court of Appeal, which sent a reference for a preliminary ruling to the Court of Justice of the European Union (CJEU).

On 22 September, the CJEU declared that the EU legislation provides that a later registered trademark is liable to be declared invalid where it is identical with an earlier trademark, where the goods of the two trademarks are identical and where the use of the later trademark has or is liable to have an adverse effect on the essential function of the trademark, which is to guarantee to consumers the origin of the goods. In the present case, the CJEU noted that the use by Budvar of 'Budweiser' in the UK neither has nor is liable to have an adverse effect on the essential function of the identical trademark owned by Anheuser Busch. The circumstances of the dispute are exceptional because both enterprises market their beers for almost 30 years under the same word sign and were authorised to register concurrently their trademarks,.. Furthermore, both parties have from the beginning used their 'Budweiser' trade marks in good faith. Finally, although the names are identical, UK consumers are well aware of the difference between the beers of Budvar and those of Anheuser-Busch, since their tastes, prices and get-ups have always been different. The CJEU thus considered that it follows from the coexistence of the two trademarks on the UK market that, even though the trademarks were identical, the beers of Anheuser-Busch and Budvar were clearly identifiable as being produced by different parties. Consequently, the CJEU concluded that a long period of honest concurrent use of two identical trademarks designating identical products does not have an adverse effect on the essential function of the trademark, which is to guarantee to consumers the origin of the goods or services.

The judgment is available at:
<http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=EN&Submit=Submit&numaff=C-482/09>

News on GI registrations

Registration of GIs

- "Jabłka grójeckie" (PGI) Poland – 05/10
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2011:260:0001:0002:EN:PDF>
- "Κατσικάκι Ελασσόνας (Katsikaki Elassonas)" (PDO) Greece – 05/10
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2011:260:0003:0004:EN:PDF>
- "Cordero de Extremadura" (PGI) Spain – 05/10
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2011:260:0005:0006:EN:PDF>
- "Vinagre del Condado de Huelva" (PDO) Spain – 05/10
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2011:260:0007:0008:EN:PDF>
- "Vinagre de Jerez" (PDO) Spain – 05/10
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2011:260:0009:0010:EN:PDF>
- "Queso Casín" (PDO) Spain – 05/10
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2011:260:0011:0012:EN:PDF>
- "Nanoški sir" (PDO) Slovenia – 05/10
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2011:260:0013:0014:EN:PDF>
- "Kabanosy" (TSG) Italy – 19/10
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2011:275:0016:0022:EN:PDF>
- "Darjeeling" (PGI) India – 21/10
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2011:276:0005:0012:EN:PDF>

Registration request

- "Kraški Pršut" (PGI) Slovenia – 28/09
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2011:284:0025:0029:EN:PDF>
- "Bratislavský Rožok" / «Pressburger Kipfel»/«Pozsonyi Kifli" (TSG) Slovenia – 30/09
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2011:286:0024:0030:EN:PDF>
- "Tomate La Cañada" (PGI) Spain – 30/09
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2011:286:0018:0023:EN:PDF>
- "Vadehavsstude" (PGI) Denmark – 01/10
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2011:289:0015:0018:EN:PDF>
- "Kalocsai Fűszerpaprika-Őrlemény" (PGI) Hungary – 14/10

- <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2011:303:0016:0020:EN:PDF>
- “Nostrano Valtrompia” (PDO) Italy – 15/10
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2011:304:0015:0018:EN:PDF>
 - “Squacquerone Di Romagna” (PDO) Italy – 15/10
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2011:304:0019:0022:EN:PDF>
 - “Uva Di Puglia” (PDO) Italy – 15/10
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2011:304:0023:0025:EN:PDF>
 - “Kraški Zašink” (PGI) Slovenia – 21/10
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2011:309:0013:0016:EN:PDF>
 - “Szőregi Rózsató” (PGI) Hungary – 22/10
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2011:310:0017:0021:EN:PDF>

Amendment application

- “Berenjena De Almagro” (PGI) Spain – 27/09
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2011:283:0016:0020:EN:PDF>
- “Thüringer Rostbratwurst” (PGI) Germany – 22/10
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2011:310:0014:0016:EN:PDF>