

GIs protection at international level:

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oriGIn: The global alliance of GI groups



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- Advocacy for the effective protection and enforcement of GIs
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 - Information
 - Legal advice
 - Raise awareness on GIs among policy makers, TM offices, etc.
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Introduction: Why Geographical Indications?

- GIs are place names used to identify the origin and quality, reputation or other characteristics of products - a **collective tool for producers** to promote the products of their territory, that can acquire a high reputation and, therefore, turn into valuable commercial assets for local producers.
- They also represent a **factor of national economic development** and sustainability of traditional products.
- They are often exposed to misappropriation or counterfeiting by unauthorized third parties, for unrelated products, and their protection is highly desirable both at the national and international level.

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)



Introduction: Definition

- GIs are place names used to identify the origin, quality, reputation or other characteristics of products. Thus, a GI has historically been, and still is today, **a way to create value through exclusivity**.
- Several countries have developed effective legislation to protect GIs, even though there is still a lack of harmonization.
- A single term can be protected in different ways, depending on the country: as an **individual mark**, a **collective mark**, a **certification mark**, an **appellation of origin (AO)** or a **GI**.



GIs protection in the EU

- As regards **food names**, the EU has introduced a series of Regulations to **standardize the protection** available to within the European Union. The first EU Regulation that regulated geographic designations was introduced in 1992 and was then replaced by new Regulations in 2006 and in 2012.
- Moreover, EU adopted the Regulation (EC) No 110/2008 for **spirit drinks** GIs, Regulation (EU) No 1308/2013 which provides explicit provisions for **wine** GIs, and Regulation (EU) No 251/2014 for aromatized wine product GIs.
- EU does not yet ensure a harmonization or unified protection for **non-agricultural GIs**, but it is currently working on one or more regulations on this matter.

Agri-GIs protection in the EU

- The current EU legislation, based on the PDOs and PGIs model introduced by Reg. EC 2081/1992, was recently reformed by Reg. EU n. 1151/2012 of 21st November 2012 on quality schemes for agricultural products and foodstuffs.
- There are two types of GIs:
 - a) **Protected Designation of Origin (PDO)**, which requires that all stages of the food production process are conducted in the concerned area;
 - b) **Protected Geographical Indication (PGI)**, which requires that at least one stage of the food production process must be carried out in the concerned area;
- The different types of Geographical Indications reflect the strength of the link with the geographical area of origin: while such link is very strong for PDOs, it is at an intermediate level for PGIs.

Characteristics of GIs system protection for quality products

- GIs can **never become generic**
- **No duty of use**
- Possible **coexistence** (good faith)
- **No temporal limits** of protection and no extra costs for renewals
- The registration process is managed by Institutions and the GI is a **public certification**
- **GIs counterfeiting approach:** situations prohibited under GIs relevant Regulations:
 - ✓ any commercial use (direct or indirect) of a name registered as GI for other products;
 - ✓ any usurpation or imitation, even by the use of terms that may evoke protected GIs (i.e. “like”, “type” “make” or “imitation”);
 - ✓ use of any other practices or false information which can mislead consumers regarding the origin, the nature or the quality of the product in relation to its origin.

GIs protection at International level

➤ The revision of the Lisbon System and the Geneva Act

➤ Bilateral Agreements

Various countries from all over the world have entered into bilateral agreements for the protection of GIs. Such agreements add to the existing set of rules on the handling of GIs, stipulated in other legislative instruments. For example:

- EU-South Korea FTA (entered in force in July 2011)
- EU-Central America Association Agreement (entered in force in 2014)
- Comprehensive Economic Trade Agreement (CETA), EU-Canada (will enter in force in 2016/2017)



International system: the revision of the Lisbon System and the Geneva Act

- On May 21th, 2015, in Geneva, the conclusion of the Diplomatic Conference regarding the revision of the Lisbon Agreement for the international protection and registration of Appellations of Origin led to the Adoption of the **Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications**.
- After several years of working groups for the new Agreement, 13 participants signed the Geneva Act of Lisbon Agreement on Appellations of Origin and Geographical Indications; as of today, 15 Countries signed the Act.
- The aim of the revision of the Lisbon Agreement was to create a larger system - being able to attract more countries than the original agreement - for the strengthening and extension of the protection of Appellations of Origin and Geographical Indications registered in the countries of origin or at regional level.

A compromise between different interests

- The Diplomatic Conference has seen the active participation of all the delegations, both Lisbon Member States and Observers, who suggested proposals, compromises and alternatives in order to reach a text agreed between members.
- During the meetings, **two different orientations have emerged:**
 - one aimed at reaching the **maximum level of protection for appellations and indications** (UE, Italy, France, Moldova, Mexico, Costa Rica, China, Algeria...)
 - one aimed to limit their scope of protection, **seeking to propose the adoption of some principles of the trademark system in order to safeguard the local markets from the overwhelming strength of AOs and GIs** (USA, Australia, Republic of Korea, Japan...)
- The interests of producers of AOs and GIs, and their consumers, have been taken into consideration. However, the strength granted to AOs and GIs is balanced by the rules that safeguard prior existing rights in each Contracting Party.

The effects of the revision 1

- **KAŠKAVAL BALKAN:** a type of cheese derived from ewe's milk, produced in Bulgaria.
- **The Appellation has been refused by several Members, BA, CZ, SK, ME, RS, MD, MK**
- The grounds for refusal were the following:
the term BALKAN is the name of the Balkan Peninsula, where there are many countries, as well as the name of a mountain range touching Bulgaria and Serbia.
- This circumstance would fit within **Art. 2(2)** and **Art. 5(4)** of the Geneva Act:
 - ✓ These Articles allow applications for an AO or a GI referring to a trans-border geographical area, or a part thereof, if the Contracting Parties concerned file a joint-application through a commonly designated Authority.

(678) KAŠKAVAL BALKAN

Number	678
Date	24.03.1980
Holder	1. Dържавно-stopansko obedinenie "Mlečna promišlenost", 9, boulevard Al. Stambolijski, Sofia
Appellation	KAŠKAVAL BALKAN
Publication	N° 13 : 07/1981
Country of Origin	BG
Nice Classification	29
Product	Cheese
Area of Production	The entire territory of the People's Republic of Bulgaria
Refusal	<u>BA</u> - 19.06.2014 <u>CZ</u> - 18.09.1981 <u>SK</u> - 18.09.1981 <u>ME</u> - 17.05.2000 <u>RS</u> - 17.05.2000 <u>MD</u> - 01.04.2002 <u>MK</u> - 30.09.2011

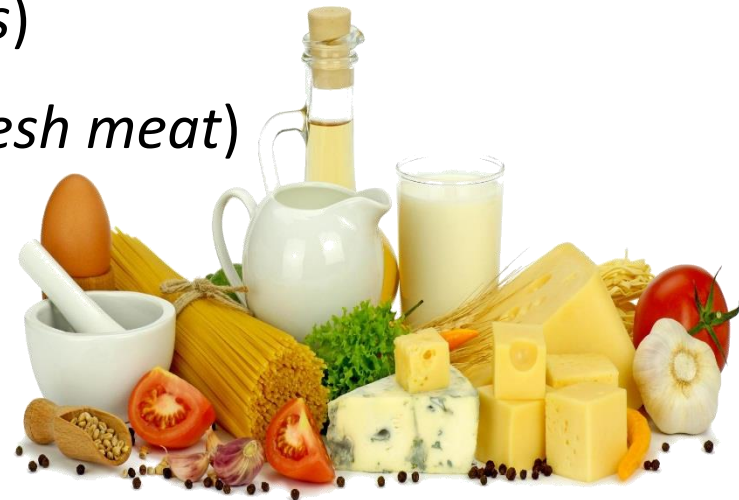
The effects of the revision 2

➤ **A broader scope of protection:**

- The Geneva Act now applies to Geographical Indications, then opening up to many more typical products. Just as AOs, GIs require a qualitative link between the product and its place of origin. Therefore, the Geneva Act offers an increased protection to those whose products are already covered by GIs.

Therefore, it will be possible to register more products, such as:

- ✓ Arancia rossa di Sicilia (Italian PGI, *oranges*)
- ✓ Szentesi paprika (Hungarian PGI, *spices*)
- ✓ Capão de Freamunde (Portugal PGI, *fresh meat*)



- In the EU *sui generis* system, a **trademark can preclude the registration of a GI** if such registration could **mislead consumers** about the identity of the product, taking into account the reputation, the notoriety and the duration of use of the mark.
- According to Article 6, par. 4 of the Regulation 1151/2012:
*[...] 4. A name proposed for registration as a designation of origin or geographical indication shall not be registered where, **in the light of a trade mark's reputation and renown and the length of time it has been used, registration of the name proposed as the designation of origin or geographical indication would be liable to mislead the consumer as to the true identity of the product.***

Conflicts between GIs and TMs in the Regulation 1151/2012 2/2

- Likewise, an application for registration of a **trademark** contrary to the protection granted to the GI **must be rejected** if there is a **registered GI** and the trademark application has been filed after the date on which the application for the protection of the GI is submitted to the Commission (art. 13).
- Moreover, also a coexistence of the two rights is possible , in case of application/registration/use of the mark in **good faith** within the EU, before the date on which the application for the protection of the GI is submitted to the Commission.
- In this case, the mark may continued to be used and renewed for the covered products and/or services, notwithstanding the successive registration of a GI (except whether grounds for invalidity or revocation of the mark exist, pursuant to art. 51 and 52 of the new EUTMR).

Conflicts between GIs and TMs in the new EUTMR

- The new European Union Trademark Regulation n. 2424/2015 (approved on December 2015 and entered into force on March 23rd, 2016) contains provisions related to GIs.
- In particular, it explicitly **includes GIs among the absolute grounds for refusal of EUTM registrations, as well as a relative ground of refusal.**
- Therefore, the Regulation provides for the possibility to submit an opposition against an application for EUTM registration on the basis of a PDO or PGI.

Conflicts between GIs and TMs in the TRIPs Agreement

- TRIPS deals with these conflicts by prescribing that **previously registered trademarks containing a protected GI can, under certain circumstances, be invalidated**. Such circumstances include the situation when the use of a trademark “is of such a nature as to mislead the public” about the origin of the goods carrying it. The burden of proof lay on the producer claiming that an illegitimate use of the GI is taking place.
- If the GI relates to wine or spirits, no proof regarding risk of misleading is needed; the trademark shall be invalidated anyway.
- However, Article 24, par. 5 of TRIPs Agreement provides for the so-called “**grandfather clause**” which allows the use of trademarks containing GIs which have been applied for, registered or used in **good faith** in other TRIPs member States, **before** the entry into force of the TRIPs and/or before the geographical indication is protected in its country of origin.

Conflicts between GIs and TMs in the new Geneva Act

- The Geneva Act provides for a system of coexistence between the earlier mark and subsequent GIs. In particular, trademark rights can be limited, under certain circumstances, in order to ensure the recognition and free use of the GI.
- According Article 14 of the Geneva Act: “ it ***shall not prejudice a prior trademark applied for or registered in good faith, or acquired through use in good faith, in a Contracting Party. Where the law of a Contracting Party provides a limited exception to the rights conferred by a trademark to the effect that such a prior trademark in certain circumstances may not entitle its owner to prevent a registered appellation of origin or geographical indication from being granted protection or used in that Contracting Party, protection of the registered appellation of origin or geographical indication shall not limit the rights conferred by that trademark in any other way.***”

[...]

- (4) *[Safeguards in the Case of Notification of Withdrawal of Refusal or a Grant of Protection]* Where a Contracting Party that has refused the effects of an international registration under Article 15 on the ground of use under a prior trademark or other right, as referred to in this Article, notifies the withdrawal of that refusal under Article 16 or a grant of protection under Article 18, ***the resulting protection of the appellation of origin or geographical indication shall not prejudice that right or its use, unless the protection was granted following the cancellation, non-renewal, revocation or invalidation of the right.***”

Are there any differences between trademarks and GIs systems?

YES!



TM

VS



Trademark protection for quality products?

- Trademarks can become **generic** (i.e. vulgarization)
- “**First in time first in right**” principle
- **Decadence** for non use
- **Time limits** of registration (i.e. renewals and payment of related fees)
- The registration process is managed by the trademark Office and a trademark is a **private law instrument**
- **TM counterfeiting approach**: comparison of signs, comparison of goods, likelihood of confusion

Nevertheless, there are situations where the two systems create synergies, rather than being adversarial.

In the past, (too much...) emphasis was put on GIs-TMs conflicts

➤ Arising from:

- GIs recognition in conflict with previously registered TMs;
- TMs registration in conflict with previously recognized GIs;



GIs and Trademarks – synergies and future development

- Both concepts enable producers to **distinguish their products in the market**, although GIs are used on a collective level rather than individual (like trademarks).
- They also serve the same purposes – **identifying to consumers the origin of the goods, and providing exclusivity for producers**.
- The advantages of trademark protection for GI names lies in **generally easier and more cost-efficient registration procedures and in its ability to shape consumer perceptions**, unlike GIs, which rely on the past experience of consumers.
- Producers may utilize both a trademark and a GI, as long as both are used legitimately, obtaining a two-layer protection. Such **combined use** will provide consumers better information regarding both commercial and geographical origin of the good.

GIs and Trademarks – synergies and future development

- The registration of individual/collective/certification trademarks, can **increase the recognition, by foreign consumers, of high quality food products** and **strengthen their protection worldwide**.
- For example, the registration of several marks – started in the 90s and implemented in recent years – that distinguish the **TALEGGIO cheese** (in addition to the Community DOP TALEGGIO), allowed *Consorzio Tutela Taleggio* to start and successfully conclude several actions to protect its trademarks. The *Consorzio Tutela Taleggio* also registered a mark on the package and one on the rind of the cheese in several countries.

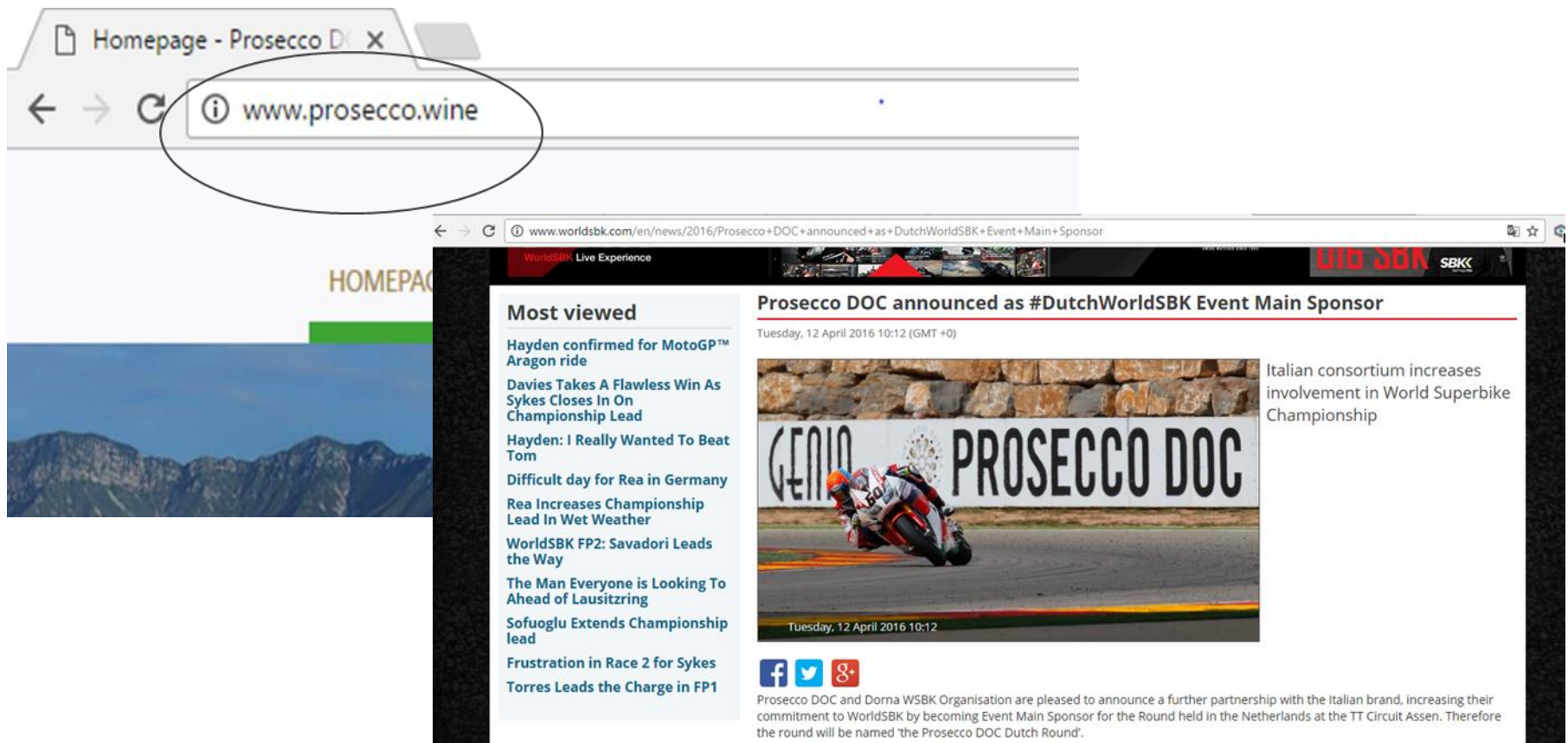


GIs: innovative approach to protection and promotion

TMs and GIs in the gTLDs:

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 .



Thank you for your attention!

<http://www.origin-gi.com>



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