

# Geographical Indications & Internet issues

& Bird & Bird

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# Main issues

- the violation of trademarks is the most common form of abuse
- lack of harmonization
- fair and legitimate use
- ownership/entitlement

## ...the scenario has changed

- an increasing number of countries and jurisdictions recognize GIs through sui-generis laws
- bilateral agreements setting forth clear rules the protection and recognition of GIs
- GI databases
- Geneva Act: opened the Lisbon system to countries where GIs can be protected through trademark system only

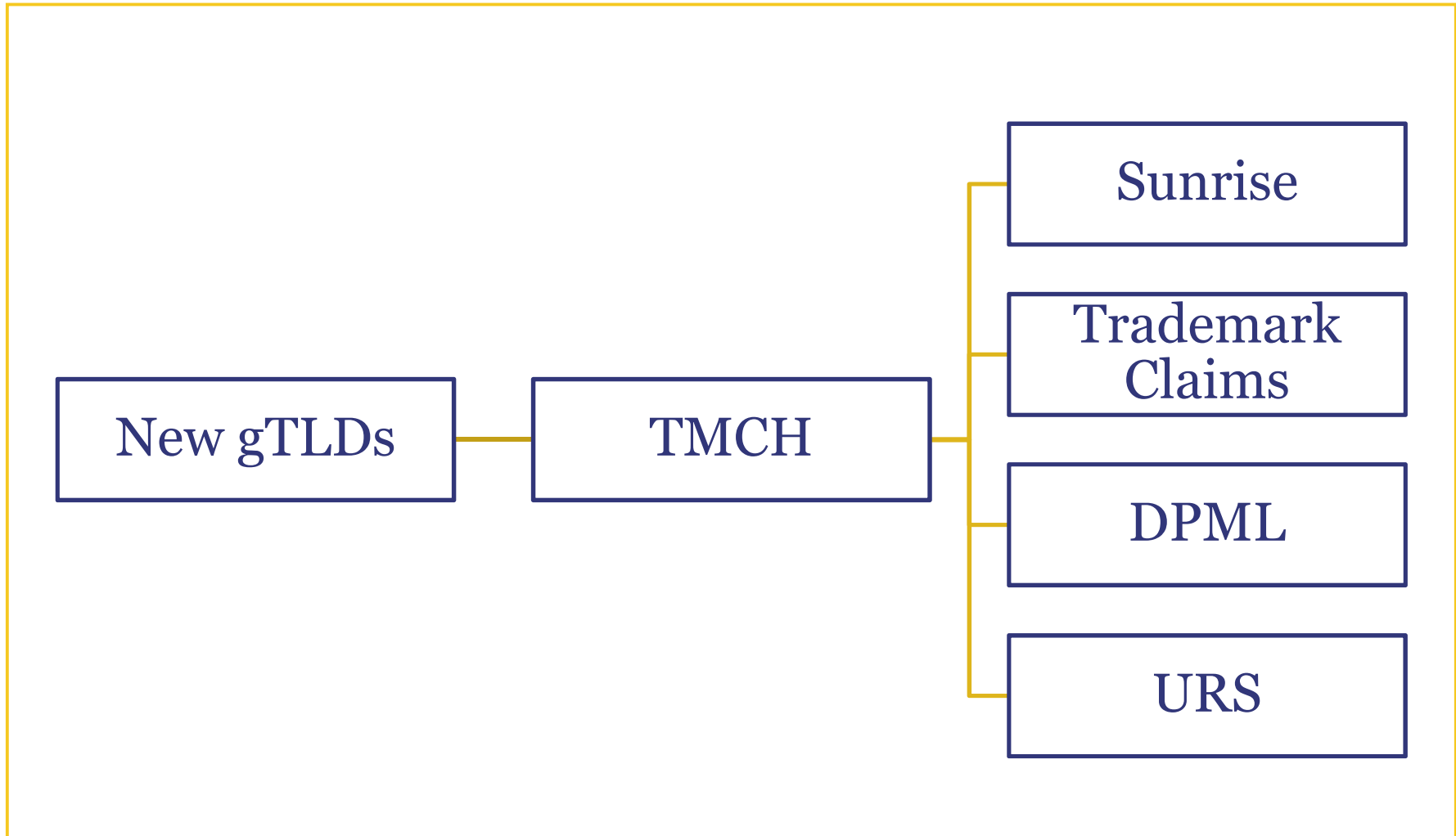
## ...the scenario has changed

- GIs in TM laws (absolute/relative grounds)
  - entitlement to bring action
- GIs can be the legal basis for customs monitoring and enforcement

## ...also on the Internet

- Safeguard mechanisms for GIs in new gTLDs (.bio, .wine, .vin)
- GIs are amongst the rights that can be invoked in e-shop/auctions (example: eBay VERO program) platforms to support take down requests
- GI as IP titles to recover/challenge ccTLDs

## ...also on the Internet



# GIs & TMCH

## 2.4. Marks protected by statute or treaty

### 2.4.1. General

For marks protected by statute or treaty, the relevant statute or treaty must be in effect at the time the mark is submitted to the Clearinghouse for inclusion. These marks may include but are not limited to: geographical indications and designations of origin.

4.4.2012  EN Official Journal of the European Union C 101/13

**Publication of an application pursuant to Article 6(2) of Council Regulation (EC) No 510/2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs**  
(2012/C 101/05)

This publication confers the right to object to the application pursuant to Article 7 of Council Regulation (EC) No 510/2006 (1). Statements of objection must reach the Commission within six months from the date of this publication.

SINGLE DOCUMENT  
COUNCIL REGULATION (EC) No 510/2006  
‘SCOTTISH WILD SALMON’  
EC No: UK-PGI-0005-086-07.03.2011  
PGI ( X ) PDO ( )

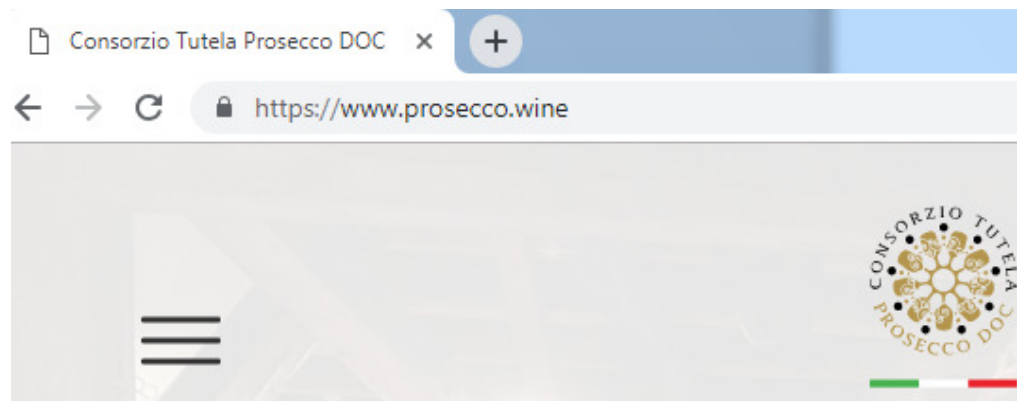
1. **Name:**  
‘Scottish Wild Salmon’

2. **Member State or third country:**  
United Kingdom

Source: <https://www.trademark-clearinghouse.com/sites/default/files/files/downloads/TMCH%20guidelines%20v1.2%20comm.pdf>

# Examples: GIs & New gTLDs

- .WINE, .VIN



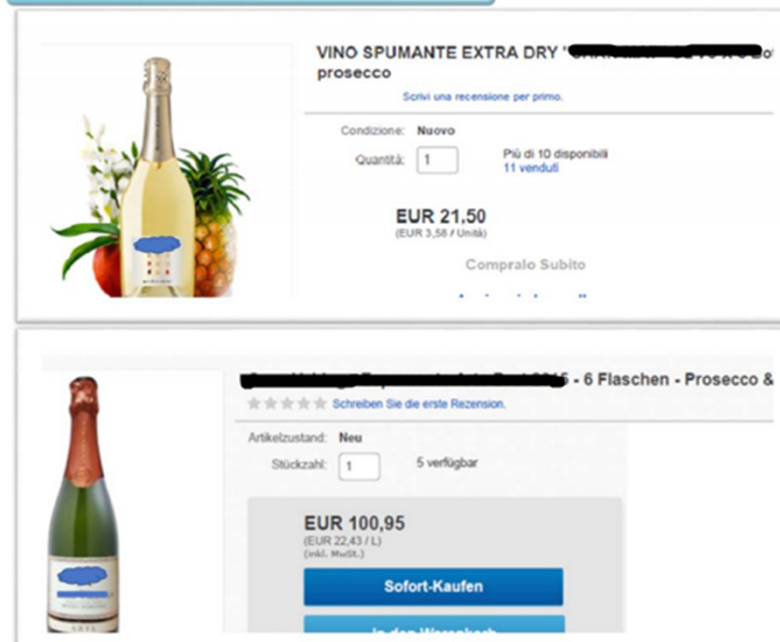


# Examples: GI enforcement on the web

ICQRF 2014-2018	Total	Web cooperation	Ex officio
Prosecco	963	276	687

## Examples of irregular listings removed by ICQRF in 2018

### Generic wine sold as "Prosecco" on eBay



Source: ICQRF data, ICQRF 2018 report

<https://www.politicheagricole.it/flex/cm/pages/ServeBLOB.php/L/IT/IDPagina/13602>

# Other tools

- Domain names watching
- Web monitoring
- UDRP (based on collective/certification marks)

Thank you & Bird & Bird

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