



MARQUES

Worldwide Symposium on Geographical Indications 2013

# Worldwide Symposium on Geographical Indications

Bangkok , March 27 to 29, 2013

## Marketing and Protecting Geographical Indications Around the World

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Annex 1C Agreement on Trade-related aspects of Intellectual Property Rights (TRIPs)

## Scope of protection (art. 22.2):

- a) the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner **which misleads** the public as to the geographical origin of the good;
- b) any use which constitutes an act of **unfair competition** within the meaning of Article 10bis of the Paris Convention (1967)” [11].

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The background of the slide is a dark red world map. The letter 'O' in the word 'MARQUES' is replaced by a white fingerprint graphic. The map is overlaid with a grid of thin white lines representing latitude and longitude.

Annex 1C Agreement on Trade-related aspects of Intellectual Property Rights (TRIPs)

## Additional Protection for GIs for Wines and Spirits (art. 23)

against:

- *use* of a GI identifying wines/spirits for wines/spirits not originating in that place, even with “**delocalisers**” (**kind, type, style, imitation, etc.**) or **translation**.
- the *registration* of a trademark for wines/spirits which **contains or consists** of a geographical indication or identifying wines/spirits (respectively) with respect to such wines/spirits not having this origin.



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## *SYSTEMS OF GI PROTECTION (I):*

- Unfair competition and similar inespecific legislation
- Trademark Systems
- "*SUI GENERIS*" Systems

## *SYSTEMS OF GI PROTECTION (II):*

### Trademark Systems

#### □ Types:

- As Individual Trademarks
- As Certification Marks
- As Collective Marks

#### ■ Protection:

- Likelihood of confusion
- Dilution and taking advantage without due cause (well-known trademarks)

## *SYSTEMS OF GI PROTECTION (III):*

### Advantages of using a TMs SYSTEM for GIs

- The system is **already working and known** by those who intervene
- **Respectful with prior rights**
- Protection available for **any kind of product or service**
- Governments do not have to commit additional enforcement resources to ensure compliance. The owner can determine when to take action
- Easier to accommodate GIs which are not merely **names** (but “**signs**”: e.g., designs, slogans, designs, 3-D, colors, or even sounds)
- Widely accepted **International registration System** (Madrid System)



## SYSTEMS OF GI PROTECTION (IV):

### Advantages of using a “SUI GENERIS” GI System

- o GIs cannot become generic
- o Unlimited **duration** (few exceptions) (TMs need a watch service for maintenance).
- o **No renewal taxes** and often nor registration taxes
- o **They cannot lapse** or revoked based on **lack of use\***
- o Usually, there is a **public action**, and this is stronger, in the systems where there is provision for registration of GIs as such (“sui generis”)
- o **No need to prove use** in proceedings against third parties

## Systems of GI protection at EU level:

### Goods covered:

- Agricultural products and foodstuffs
- Wines, except wine vinegars
- Spirit drinks

### Kinds of GIs:

- Protected Geographical Indication (PGI)
- Protected Designation of Origin (PDO)



## Systems of GI protection at EU level:

Common features of PDO/PGI:

- same level of legal protection
- same registration procedure
- practically same legal requirements
- registration is a *sine qua non* requirement
- cannot become generic
- can be cancelled if compliance with the conditions no longer ensured

\*Difference: the definition which implies that the link between product and place is stronger in PDO and they are considered as more appreciated by consumers

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Protection of GIs (PDOs/PGIs) in the EU (I)

any **direct or indirect commercial use** in respect of **comparable products** or **where** using the name **exploits the reputation** of the protected name, including when those products are used as an ingredient\*;



Austria



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## Protection of GIs (PDOs/PGIs) in the EU (II)

any **false or misleading indication** as to the provenance, origin, nature or essential qualities of the product **on the (inner or outer) packaging, advertising material or documents** relating to the product concerned, and **the packing of the product in a container** liable to convey a false impression as to its origin;

Cocktails de Champagne

140	<b>Copa de Cava Brut</b> glass of champagne	5,50 €		192	<b>Kir Framboises</b> cava, crema de frambuesas champagne, raspberry liqueur	5,75 €
189	<b>Copa de Cava Rose</b> glass of pink champagne	5,50 €		193	<b>Kir Fraises</b> cava, crema de fresas del bosque champagne, strawberry liqueur	5,75 €
191	<b>Kir Royal</b> cava, crema de cass champagne, blackberry	5,75 €		194	<b>Kir Mure</b> cava, licor de mora champagne, blackcurrant	5,75 €
203	<b>Saussalito</b> cava, melocoton, fresas, limón champagne, peach, strawberries, lemon	8,75 €		197	<b>Mimosa</b> cava, naranja natural champagne, fresh orange	7,40 €
196	<b>Pretty Woman</b> cava, vodka, curaçao, sorbete de limón champagne, vodka, curaçao, lemon sorbet	8,65 €		201	<b>Agua de Valencia</b> cava, cointreau, ginebra, azúcar de caña, naranja natural champagne, cointreau, gin, cane sugar, fresh orange	7,90 €
806	<b>Calin</b> cava, sorbete de limón, frambuesa, mango champagne, lemon, raspberry, mango sorbet	7,60 €		202	<b>Jarra Agua de Valencia</b> jug of "agua de Valencia"	19,40 €
200	<b>Crazy</b> cava, vodka, fresas, limón champagne, vodka, strawberries, lemon	8,75 €		199	<b>Love Story</b> cava, cointreau, frambuesa, naranja natural champagne, cointreau, raspberry, fresh orange	8,90 €
			198	<b>Pick me Up</b> cava, brandy, grand marnier, naranja natural, granadina champagne, brandy, grand marnier, fresh orange, grenadine	8,90 €	
			809	<b>Sangría con Cava</b> sangría with champagne	8,10 €	

Chamagne

IVA INCLUIDO / VAT INCLUDED



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Protection of GIs (PDOs/PGIs) in the EU (III)

any **misuse, imitation** or **evocation**, even if the true origin of the products or services is indicated or if the protected name is translated or accompanied by “delocalizers”, including when those products are used as an ingredient\*;

“Evocation’ covers a situation where the term used to designate a product incorporates part of a protected designation, so that when the consumer is confronted with the name of the product, *the image triggered in his mind* is that of the product whose designation is protected.

It is possible for a protected designation to be evoked where there is no likelihood of confusion between the products concerned and even where no Community protection extends to the parts of that designation which are echoed in the term or terms at issue.”

*EUCJ 43/1999 (C-87/97) (Cambozola vs Gorgonzola)*

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Protection of GIs (PDOs/PGIs) in the EU (IV)

OHIM (Community Trade Mark Office):

- ✓ RONCARIFORT evoked (PDO) ROQUEFORT
- ✓ CAZORLIVA evoked (PDO) SIERRA DE CAZORLA

CJEU:

- ✓ C-87/97 CAMBOZOLA evoked GORGONZOLA
- ✓ C-132/05 PARMESAN evoked (PDO) PARMIGIANO REGGIANO
- ✓ C-4/10 and C-27/10 COGNAC vs Korkein hallinto-oikeus (KONJAKKI, KONJAKKIA)

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Spanish Tm appln. 3032645, Class 43 Restauration services (SPTO)

The logo for 'LeCham' features the brand name in a simple, lowercase, sans-serif font. To the right of the text is a stylized graphic of a champagne glass with three small bubbles rising from the top.

HOW far must the protection against evocation get?







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**Which way to follow?**

**If possible:**

**“USE DIFFERENT WEAPONS FOR DIFFERENT BATTLES”**

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*Some challenges that can be met in the enforcement of the protection of GIs (I):*

- Problems in the **registration procedure of a GI** abroad
- Lack of protection of GIs **in trademark registration procedures**
- *Understanding/recognizing when there is a local infringement when working in different countries/cultures.*

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*Some challenges that can be met in the enforcement of the protection of GIs (II):*

- Problems with the semi-generic (Wine accords and CALIFORNIA CHAMPAGNE)
- GIs as an *ingredient*
- **A worldwide registration system for GIs**





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*Some challenges that can be met in the enforcement of the protection of GIs (III):*

In the hands of producers:

**“AN OUNCE OF PREVENTION IS WORTH A POUND OF CURE”**

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*Some challenges that can be met in the enforcement of the protection of GIs (IV):*

In the hands of producers:

- ❖ Preliminary Search
- ❖ Monitor the market
- ❖ Using a design trademark with the GI name
- ❖ Educating consumers (recognition of the product)
- ❖ Educating officials



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*Some challenges that can be met in the enforcement of the protection of GIs (V):*

In the hands of producers:

**“SOMETIMES A GOOD EDUCATION (consumers & officials) IS THE BEST ENFORCEMENT OF YOUR PROTECTION”**





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**Thank you for your attention**

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