

**Using Quality Standards as an SMEs
Competitive Advantage:
the Role of GIs, Certification Trademark and
Collective Trademark**

**WIPO-ITALY INTERNATIONAL CONVENTION ON
INTELLECTUAL PROPERTY
AND COMPETITIVENESS OF MICRO, SMALL AND MEDIUM-
SIZED ENTERPRISES (MSMES)**

organized by

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PLAN

- I. Parmigiano Reggiano: designation of origin.
- II. The Consorzio del Formaggio Parmigiano-Reggiano.
- III. Parmigiano Reggiano: collective or certification trademark.
- IV. The PDO Parmigiano Reggiano in the market.
- V. The enforcement of the PDO Parmigiano Reggiano and the Consorzio del Formaggio Parmigiano-Reggiano's collective/certification trademarks.

I. Parmigiano Reggiano: a noble and historic designation of origin.

The link with the area of origin:

the necessary core of all its history



I. Parmigiano Reggiano: a noble and historic designation of origin.

Eight centuries of nobility

- It is made (not just manufactured) exactly as eight centuries ago:
- in the same places
- with the same, natural ingredients (milk, calf rennet and salt)
- with the same traditional process



I. Parmigiano Reggiano: a noble and historic designation of origin.

Parmigiano Reggiano in Figures (in 2008)

- 244.000 cows solely producing milk for Parmigiano Reggiano
- **3.855 producers of milk**
- **429 cheese dairies**
- 16 litres of milk to make 1 kg of Parmesan cheese
- 550 litres to make one wheel
- 0 additives
- 30 Kg: minimum weight of a wheel
- 38,5 Kg: average weight of a wheel
- 12 months: minimum maturation period
- 20-24 months: average maturation period
- 3.080.605: wheels produced
- 840 millones de €, turnover (a la producción)
- **1.540 millones de €, turnover (al consumo)**
- **export 23%**



**Parmigiano Reggiano:
a noble and historic designation
of origin.**

I. Parmigiano Reggiano: designation of origin.

- ‘Parmigiano Reggiano’ is a Protected Designation of Origin (PDO) in the European Union territory by virtue of the Council Regulation (EC) No 510/2006, of 20 March 2006 [which has replaced Council Regulation (EEC) No 2081/92], on the protection of geographical indications and designations of origin for agricultural products and foodstuff, as registered for ‘cheeses’ through Commission Regulation (EC) No 1107/96 of 12 June 1996;
- Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of October 31, 1958
 - Parmigiano Reggiano registered on December 23, 1969
 - Lisbon Union: 26 countries

I. Parmigiano Reggiano: designation of origin.

Product specification

- To be eligible for a PDO (Protected Designation of Origin) or a PGI (Protected Geographical Indication) a product shall comply with a product specification
- Specification elements (non-exhaustive): name of the product comprising the DO or GI; description of the product; definition of the geographical area; description of the method of obtaining the product; **details bearing out the link between the geographical environment or geographical origin;** authorities or bodies verifying compliance with specification; any specific labelling rule, etc.

I. Parmigiano Reggiano: designation of origin.

The control system under Regulation (EC) 510/06

- Any product which bears a protected geographical name shall comply with the product specification;
- Member States shall designate the competent authority/ies responsible for control of Reg. 510/2006 in conformity of Regulation (EC) 882/2004 on official controls performed to ensure the verification of compliance with feed and food, animal health and welfare rules;
- Verification of compliance with specification (before placing the product on the market): competent authority/ies or control body/ies;
- From 1 May 2010: control bodies shall be accredited in accordance with European Standard EN 45011 or ISO/IEC Guide 65;
- Any operator complying with Regulation (EC) 510/06 is entitled to be covered by a system of official controls;
- The verification of compliance with specification costs shall be borne by the operator subject to the controls.

II. Parmigiano Reggiano: designation of origin.

(ii) The control system for the PDO Parmigiano Reggiano

Control body: *DCQ-Dipartimento Controllo Qualità P.R.*

- Private body authorized by the Italian Ministry of Agriculture and in compliance with the Standard EN 45011;
- The printing of the selection marks on the rind is done by the Consorzio after the control made by the DCQ P.R. that guarantees the compliance with the specification;
- Every cheese maker established in the area of origin has a right to the marks of origin and access to the control system. Only on condition that requirements in the specification are complied with, his cheese can than bear the Protected Designation of Origin and therefore selection marks will be applied

II. The 'Consorzio del Formaggio Parmigiano Reggiano'.

- Created in 1934;

- Voluntary non-for-profit body in charge of the defence, promotion and safeguarding of the Protected Designation of Origin Parmigiano Reggiano;

Recognized by the Italian Ministry of Agricultural, Food and Forestry Policies;

- The following subjects may become members of the Consorzio, on the condition that they are established within the area of origin:

- milk producing farmers of milk directed to the production of Parmigiano Reggiano (**100%** are today members of the Consorzio);

- dairies producers of Parmigiano Reggiano;

- companies maturing and/or grating Parmigiano Reggiano that hold the product until the completion of the maturation period

The 'Consorzio del Formaggio Parmigiano Reggiano'.

- It is in charge with the protection, safeguard and promotion of the PDO Parmigiano Reggiano, towards every one;
has promotion tasks, the right to apply for changes to specification;
- In the production, especially it:
 - establishes the modalities/conditions for the use of the marks and their correct use by the cheesemakers, according to the specification;
 - applies the oval mark 'Parmigiano Reggiano Consorzio Tutela', only on wheels that pass control made by inspection structure.
- In the commercialization:
 - it is in charge with the protection of the Designation of Origin against any exploitation of its reputation, against any misuse, imitation or evocation, etc. (article 13 of Regulation 510/06);
 - in Italy, its supervisory agents have the qualification of policemen

I. Parmigiano Reggiano: collective or certification trademarks

(i) Specification for the PDO Parmigiano Reggiano

Marking Regulation

- marks of origin (applied by the individual dairy)
(the pin-dot writing on the rind ‘Parmigiano Reggiano’:
the dairy number, production year and month,
casein plate with the words ‘Parmigiano Reggiano’
or ‘CFPR’ and the codes identifying the wheel;
- the selection marks (applied by the Consorzio)
(oval mark with the year of production and the writing
‘PARMIGIANO REGGIANO CONSORZIO TUTELA’):
its printing with fire is made by the Consorzio, where the
the necessary inspection operations have been successful);



Production standard

- packaging of grated Parmigiano Reggiano cheese must take place
in the area of origin since 1991
- Reglamento de marcación

III. Parmigiano Reggiano: collective or certification trademark.

(i) Consorzio del Formaggio Parmigiano Reggiano' trademarks Madrid system

640268



PARMIGIANO
REGGIANO

International Reg. number

10/05/1995



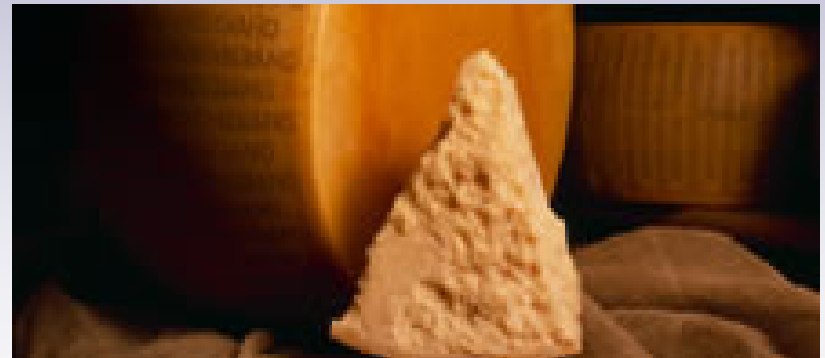
International Reg. Number 516950*

21/10/1987

- * Owner: Consorzio del Formaggio Parmigiano-Reggiano;
- * 29 Cheese Parmigiano Reggiano;
- * Indication to the effect that the mark is a collective mark, a certification mark or a guarantee mark;

IV. The PDO Parmigiano Reggiano in the market.

(i) The Parmigiano Reggiano wheel



IV. The PDO Parmigiano Reggiano in the market.

(i) The pre-packaged Parmigiano Reggiano

- The Consorzio authorizes, by written agreements, the use of the collective mark exclusively to distinguish the pre-packaged Parmigiano Reggiano, grated or in portions
- Since 1 May 2009: the indication ‘Protected Designation of Origin’ (or PDO) or the Community logo is compulsory (Regulation 510/06)



IV. The PDO Parmigiano Reggiano in the market.

(ii) The pre-packaged Parmigiano Reggiano

Madrid system

International Reg. Number 477182*

31/05/1983



- * Owner: Consorzio del Formaggio Parmigiano-Reggiano
- * 29 Cheese Parmigiano Reggiano;
- * Indication to the effect that the mark is a collective mark, a certification mark or a guarantee mark;

IV. The PDO Parmigiano Reggiano in the market.

(ii) The pre-packaged Parmigiano Reggiano

An example of coexistence
between PDO and trademarks

Consorzio' collective/certification mark

PDO community symbol

Individual trademark

Protected Designation of Origin



IV. The PDO Parmigiano Reggiano in the market.

(iii) The PDO Parmigiano Reggiano promotion

The Consorzio approved a specific logo for promotion and advertising (Nice classification: 35)



IV. The PDO Parmigiano Reggiano in the market.

(iv) Conclusions

Possibility for PDOs/PGIs to go hand in hand in the market with (Collective/Certification) trademarks and individual trademarks

V. The enforcement of the PDO Parmigiano Reggiano and the Consorzio del Formaggio Parmigiano-Reggiano' trademarks.

- (i) A different counterfeiting approach
 - PDOs/PGIs: private and/or public enforcement
[Italy: Legislative Decree 297/04 laying down administrative sanctions on implementation of Regulation (EC) 2081/92]
 - TM counterfeiting approach: comparison of signs, comparison of goods, likelihood of confusion
 - PDOs/PGIs counterfeiting approach: situations prohibited under PDOs/PGIs Regulation [i.e. article 13.1 of Regulation (EC) 510/06]

V. The enforcement of the PDO Parmigiano Reggiano and the Consorzio del Formaggio Parmigiano-Reggiano's trademarks.

(ii) Case law of the Court of justice of the European communities under PDOs/PGIs scope of protection

- Case C-87/97
PDO Gorgonzola vs Cambozola (trademark)

ECJ, Judgement of 4 March 1999, par. 26:

“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”.

V. The enforcement of the PDO Parmigiano Reggiano and the Consorzio del Formaggio Parmigiano-Reggiano' trademarks.

(ii) Case law of the Court of justice of the European communities under PDOs/PGIs scope of protection

- Case C-132/05
European Commission vs Federal Republic of Germany

ECJ (Grand Chamber) Judgment of 26 February 2008, par. 48/49:

“That proximity and the phonetic and visual similarities referred to in paragraph 46 above are such as to bring to the mind of the consumer the cheese protected by the PDO ‘Parmigiano Reggiano’, when he is confronted by a hard cheese, grated or intended to be grated, bearing the name ‘Parmesan’.

In those circumstances, the use of the name ‘Parmesan’ must be regarded, in the sense of Article 13(1)(b) of Regulation No 2081/92, as an evocation of the PDO ‘Parmigiano Reggiano’

V. The enforcement of the PDO Parmigiano Reggiano and the Consorzio del Formaggio Parmigiano-Reggiano' trademarks.

(iii) The PDO Parmigiano Reggiano enforcement in the UE

Germany

- Consorzio del Formaggio Parmigiano Reggiano vs Allgäuland-Käsereien GmbH

Berlin Court, Commercial Sect., 22 April 2008:

“The defendant is condemned to abstain from producing, selling and placing on the market a cheese under the names ‘Parmesan’ or ‘Parmigiano’ whether such cheese does not comply with the specification for Parmigiano Reggiano”

- Consorzio del Formaggio Parmigiano Reggiano vs Inc.

Colonia Court, 14 October 2009

The Court authorizes the seizure of cheese originating in Argentina exhibited at Anuga food fair

IV. The enforcement of the PDO Parmigiano Reggiano and the Consorzio del Formaggio Parmigiano-Reggiano's trademarks.

(iii) The PDO Parmigiano Reggiano enforcement in the UE

Spain

- Evocation, exploitation of the reputation;
Agreement



V. The enforcement of the PDO Parmigiano Reggiano and the Consorzio del Formaggio Parmigiano-Reggiano's trademarks.

(iv) The PDO enforcement outside of the UE

- Mexico (Lisbon Union Member)

Usurpation and imitation, even if the appellation is used in translated form (cheese made in Germany and exported to Mexico, labeled in Mexico)



V. The enforcement of the PDO Parmigiano Reggiano and the Consorzio del Formaggio Parmigiano-Reggiano's trademarks.

(iv) The PDO enforcement outside of the UE

Mexico

- MIPO, Decision of 23 February 2009

Preliminary injunctions concerning the infringement of the Appellation of Origin Parmigiano Reggiano cannot be granted because of art. 229 MIPL

- Administrative law-suit brought by the Consorzio

- Judgment of the Administrative Judge: refusal

- Administrative appeal law-suit brought by the Consorzio

- Administrative Court of Mexico City, decision of 28 September 2009

the file is sent to the Nation Justice Supreme Court for a constitutional question

IV. The enforcement of the PDO Parmigiano Reggiano and the Consorzio del Formaggio Parmigiano-Reggiano's trademarks.

(iv) The PDO enforcement outside of the EU

- Regulation (EU) 510/06: not applicable
- Lisbon Agreement: 'only' 26 Members
- Art. 22 TRIPs: not enough

- Alternative path: collective/certification trademarks

V. The enforcement of the PDO Parmigiano Reggiano and the Consorzio del Formaggio Parmigiano-Reggiano's trademarks.

(v) The Consorzio's collective/certification marks enforcement

- Mexico

MIPI, Decision 3224 of 23 February 2009

Preliminary injunctions are granted with regard to the infringement of the Consorzio's collective trademarks registered in Mexico



V. The enforcement of the PDO Parmigiano Reggiano and the Consorzio del Formaggio Parmigiano-Reggiano' trademarks.

(v) The Consorzio's collective/certification trademarks enforcement

- Italy

Agreement



V. The enforcement of the PDO Parmigiano Reggiano and the Consorzio del Formaggio Parmigiano-Reggiano's trademarks.

(vi) Conclusions

- Possibility for PDOs/PGIs to go hand in hand with (Collective/Certification) trademarks and individual trademarks
- A very wide protection is granted to the DO (i.e. EU GIs Regulations, Lisbon Agreement, art. 23 TRIPs)
- Future:
 - necessity to extend protection provided for to GIs for wines and spirits in art. 23 TRIPs to GIs for all products;
 - necessity to include GIs in the Anti-Counterfeiting Trade Agreement
 - necessity to have more countries in Lisbon Agreement

GRAZIE

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