Worldwide Symposium on Geographical Indications
Bangkok, March 27 to 29, 2013

Marketing and Protecting Geographical Indications Around the World

Miguel Angel Medina
mam@elzaburu.es
MARQUES Council Member, Chair GI Team
ELZABURU
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].
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.
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)
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)
Advantages of using a “SUI GENERIS” GI System

- GIs cannot become generic
- Unlimited duration (few exceptions) (TMs need a watch service for maintenance).
- No renewal taxes and often no registration taxes
- They cannot lapse or revoked based on lack of use*
- 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”)
- 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*
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*;
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;
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)
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 hallintoikeus (KONJAKKI, KONJAKKIA)
Spanish Tm appln. 3032645, Class 43 Restauration services (SPTO)

HOW far must the protection against evocation get?
Which way to follow?
If possible:
“USE DIFFERENT WEAPONS FOR DIFFERENT BATTLES”
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.
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
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”
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
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”
Thank you for your attention

Miguel Angel Medina
mam@elzaburu.es
MARQUES Council Member, Chair GI Team
ELZABURU