



Promoting Intellectual
Property Rights in the
ASEAN Region

SEMINAR ON GEOGRAPHICAL INDICATIONS

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GEOGRAPHICAL INDICATIONS AND COMPLEMENTARITY WITH OTHER INTELLECTUAL PROPERTY RIGHTS

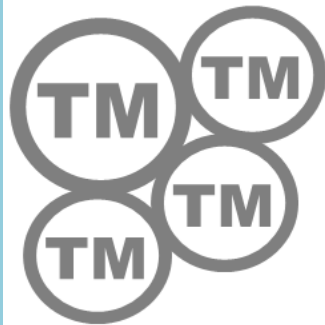
GIs, Trademarks, Collective Trademarks, Certification Trademarks

Different Concepts of IP Protection

Trademark



Collective Mark



Certification Mark



Geographical Indication



What is a Geographical Indication?

Indication which identify a good as originating in a certain territory, or a region or locality in that territory, where a given **quality, reputation or other characteristic** of the good is **essentially attributable to its geographical origin.**



Kobe beef



Registering a GI confers an

- individual right of use of the name
- to each producer complying with the GI specific Standards
- non-exclusive (applies to all compliant producers within the defined area)

What is a trademark?

Any signs capable of being represented graphically,

- Particularly words, including:

- personal names,
- designs,
- letters,
- numerals,
- the shape of goods or of their packaging

- Provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings



Collective and Certification Marks

Collective Mark

- Holder: association of producers
- Holder may use the mark
- Can only be used by members of the association
- Control by association of producers



Certification Mark

- Holder: independent entity
- Holder cannot use the mark
- Control by owner of CTM
- Can be used by all those who comply with the regulations for the use of the mark



- **Geographical Indications:**

- Geographical indications identify a product or service as originating from a particular geographical area, **independently from the company that produces it.**
- Name not reserved to a single owner: Once protected, the exclusive right to use the name belongs to **all producers in a given geographical area, who comply** with the specific technical specifications
- If sui generis:
 - Existence of a technical specification **examined by public authority**
 - Usually higher scope of protection.

- **Trademark:**

- cannot guarantee to consumers that goods are produced in a certain place and have specific qualities / characteristics as a result.
- A trade mark gives its owner the right to exclude others from using the trade mark.

Collective Marks and GIs

- Owned collectively by a group of producers
- Their association defines a set of rules
- Potential members may join as long as they comply with the norms
- Quality aspects may also be defined and be included in the set of rules.
- Collective marks can be used to register GIs if the set of rules specifies the origin, or GIs may register as a collective trade mark.

Certification Marks (EU)

- Owned by a certifying body that controls whether the mark is used following the certification standards.
- The mark is capable of distinguishing goods or services in regard to:
 - Material
 - Mode of manufacture
 - Quality, accuracy or other characteristics
- Geographical origin (in the EU) is excluded from this type of protection.

Why is registering complementary IP rights important?

- Protection over the **logo** (TMs, Designs)
- Protection over the appearance of the product of the **packaging** (Designs)
- **Trademarks:**
 - Alternative tool for products excluded from GI protection in the EU (manufactures products, services..)
 - Protection may be extended to countries with no GI legislation
 - Advisable previous step to GI registration
 - Licensing (GI may not be licensed)
 - Enhancing the protection (reputed TMs are also protected with respect to non-similar goods)

GI protects the **name**, not the graphic elements of the logo

- However, the product Specification may contain the collective logo of the GI and the labelling rules:

Example: *Book of Specification of the Geographical Indication*
Kampot Pepper

The labeling shall also include, clearly visible, the following indications:

- The collective logo (depicted below), in the corresponding language:



or



- The national logo for Cambodian Protected Geographical Indications (depicted below).



TRADEMARKS AND GIs: Overlaps / Tensions

- TMs: protect distinctive marks that indicate origin of a good, the source of a good or service. They can also be collective marks reflecting a standard of quality.
- A branding mechanism to secure market share— value diffused through advertising, not inherent to region's uniqueness
- Belongs to a company, not to a region
- Trademarks may consist of geographical terms, but must have secondary meaning (e.g., Montblanc)



Protection for GIs: Relation with trademarks

- Prior GI prevents the registration of a trade mark
- Prior trade mark which was registered and used in good faith prior to the date of protection of GI may continue to be used
- Conflicts with renowned TM prevent GI registration

Example: «Prosciutto di Parma» ham, in Canada :

- CETA (Trade Agreement) UE/ Canada, 2017
- Enables co-existence between “prosciutto di Parma” PDO and pre-existing Canadian “Parma” TM (Maple Leaf Co.) used for ham processed in Canada
- Before 2017, Parma PDO producers in Italy were forbidden to sell their product under its own name in Canada !



Use/Imitation of GI

EU	Lisbon/Geneva	TRIPs additional	TRIPs basic
No direct or indirect commercial use	No use not complying with AO/GI requirements	No use	no use only if misleads public as to origin: need to be proven
No misuse, imitation, evocation	No imitation		X
even if true origin is indicated, if in translation, if use of delocalisers: style, type, method, as produced in, imitation or similar			X

Evocation



- Gorgonzola: PDO (Italy)
- But use of Cambozola for other cheese
- EU + Lisbon
= evocation of Gorgonzola
= prohibited (case C87-97 EU Court of Justice)



- TM applied for fish
- 2 PGI
- Scottish farmed salmon and Scottish Wild salmon
- Rejected by EUIPO

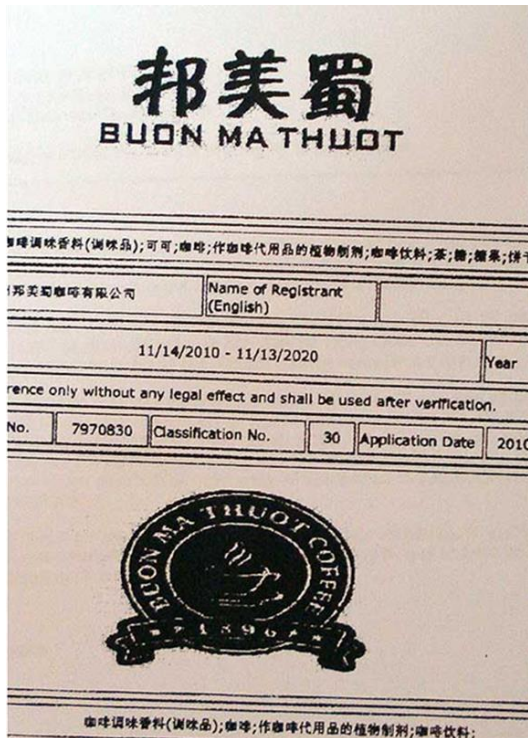
Relation with prior and posterior trademarks on same name as GI

EU	Lisbon	TRIPs additional	TRIPs basic
<p>Prior TM: Co-existence with PDO/PGI + if prior TM registered in good faith</p>	<p>Prior TM: Co-existence possible if prior TM registered in good faith</p>	<p>Prior TM: Grandfather clause Co-existence possible in domestic legisl.</p>	
No Posterior Trademark			<p>No posterior TM only if misleads the public</p>

Posterior trademark

Buôn Ma Thuột coffee, Việt Nam

- GI in Vietnam:
Registered in 2005



- TM registered in China in 4/2011:
- Cancelled in 5/2014 following action of Association and Vietnam government

Branding products with a combination of GIs and Trademarks

Use of GI combined with individual trademarks



GI Labeling: “Unity in Diversity”



Cheese GI (Italy): Parmegiano

Protected Name of Geographical Indication

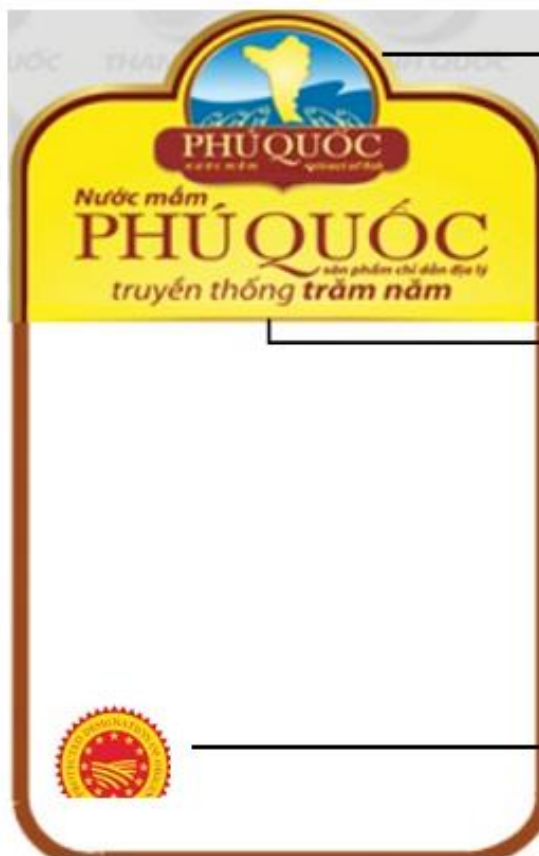
+

Individual company name

+

Official GI Stamp
(European Union)

GI combined with producers' trademark



Nuoc Mam Phu Quoc logo (Vietnam)

Section 1: compulsory requirement for both front and rear label, occupying 1/3 area of the label

Limit line

Section 2: Company trademark. 2/3 area of the label

PDO logo of EU

GI

Individual trademark



EU GI symbol →



GI

Individual trademark



GI

Individual trademark



GI

Individual trademark



Trademarks and GIs: Example of Champagne

CHAMPAGNE

French PDO

Different Trademarks used
by different producers



GI

Individual trademark





Complementarity of TM Registration as a previous step to registering GI



Banana from Canarias Islands

- Collective TM :
 - Applied for in 12/ 2002
 - Registered in 7/ 2004

in the name of the “Association of Banana Growers’ Organizations of Canarias”

- Geographical Indication :
 - Applied for in 3/ 2011
 - Protected in 11/2013
- The collective TM acquired reputation on the market which later supported the GI Application.

Conclusions

Trademarks and GIs: Complementary but different

GIs

- Refer to quality / reputation of a good given by its geographical origin
- Production **necessary linked to a territory**
- Guarantee the geographical origin of the goods
- Collective right of **all the producers** of a given good that are located in the geographical area defined by the GI.

Trademarks

- Distinguish the goods of one from goods of another producer
- Shall not be descriptive
- **May** guarantee a geographical origin (≠ obligation)
- Individual right approach (principle)
- Certification TM cannot be used by its right holder
- May be produced everywhere.

Registering complementary rights is important. Geographical Indications (uniqueness), Collective Trademarks (for logos..), Designs (for packaging..) and individual Trademarks (producer's commitment) **can harmoniously coexist and reinforce each other.**



Thank you for your attention

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THANK YOU



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