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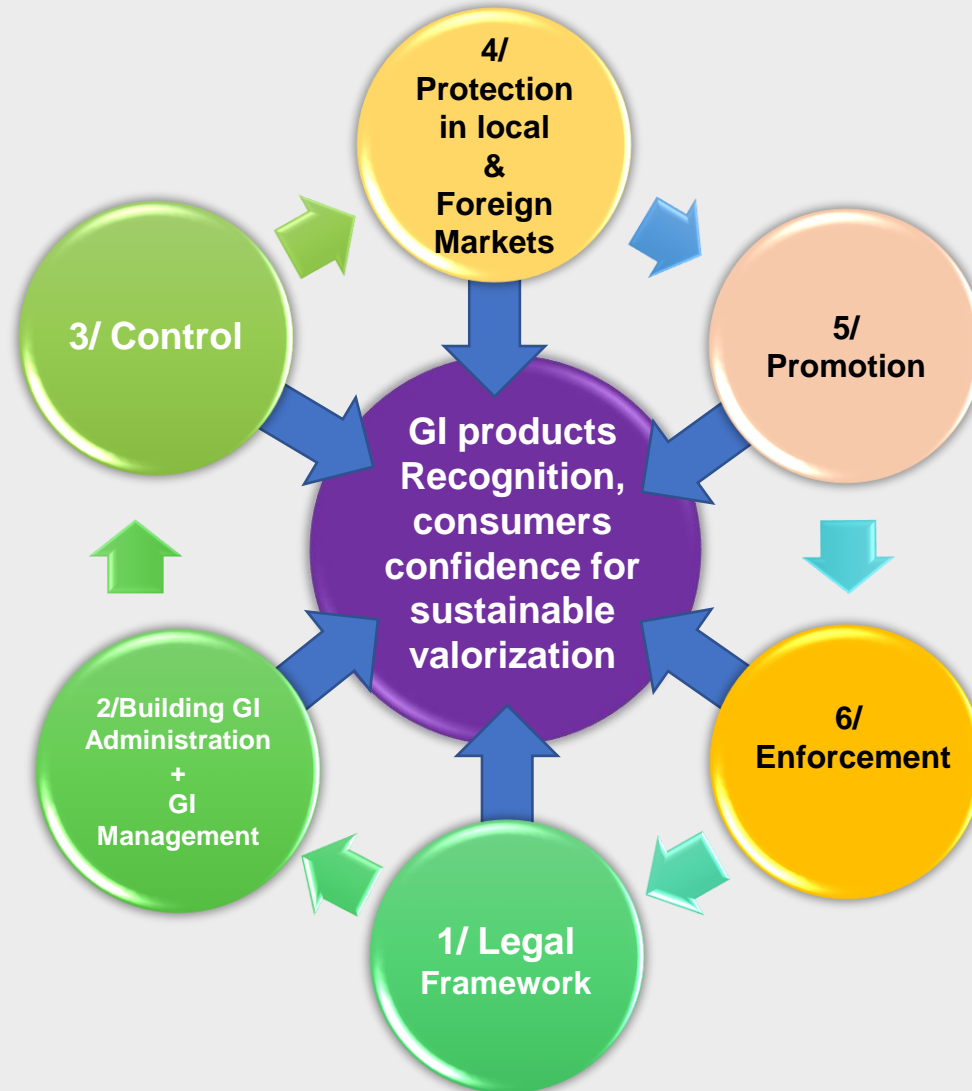
WORKSHOP ON GI MANAGEMENT AND PROTECTION FOR POST-GI REGISTRATION

GI Infringements and how to enforce your GIs right?

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GI System, a global perspective



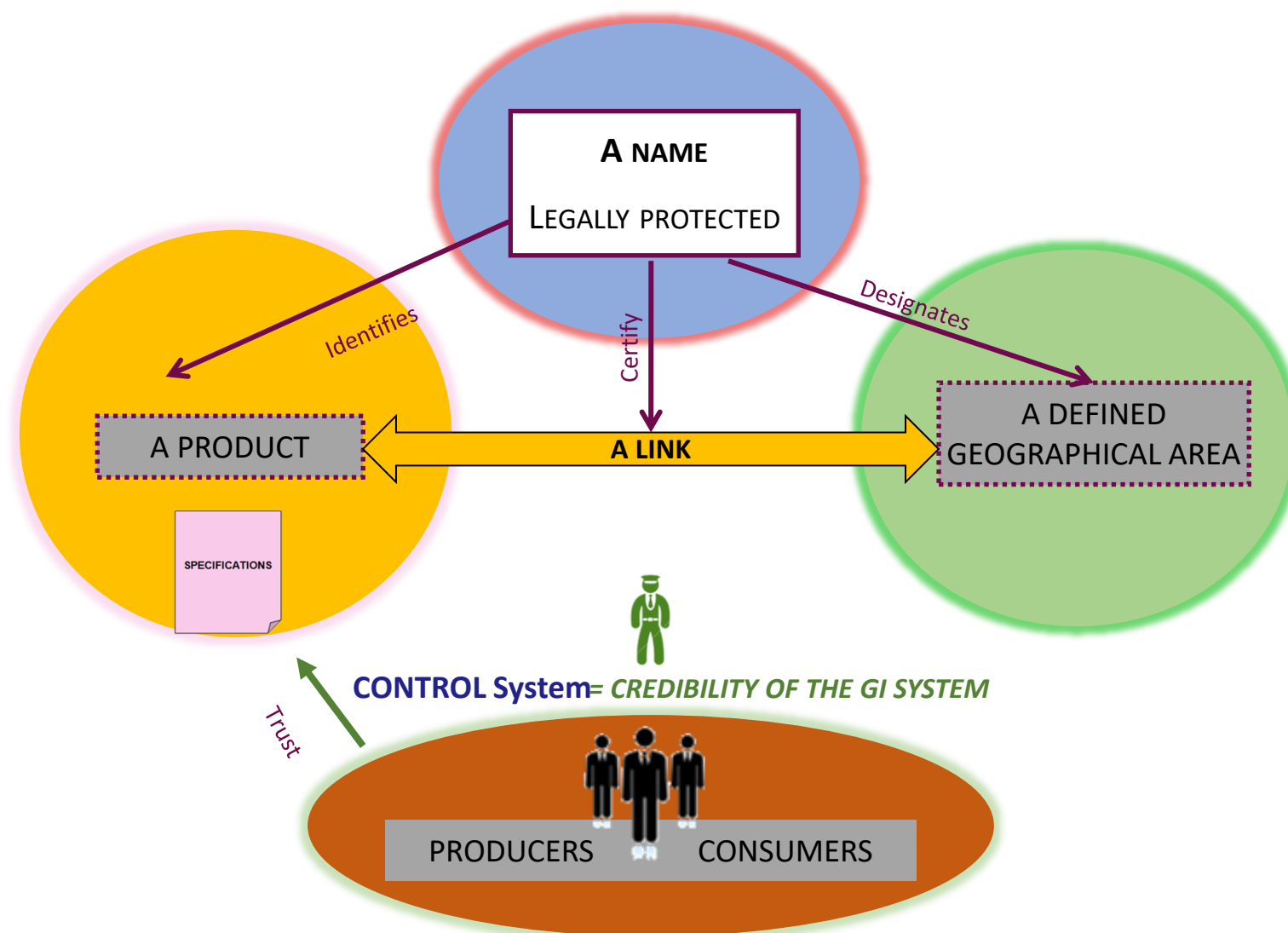
What type of legal protection available?

- *Sui generis* GI system

But also :

- Trademark system (Collective or certification marks)
- Legislation on unfair competition
- Administrative systems (labelling, etc.)

The Geographical indication (GI) Protection



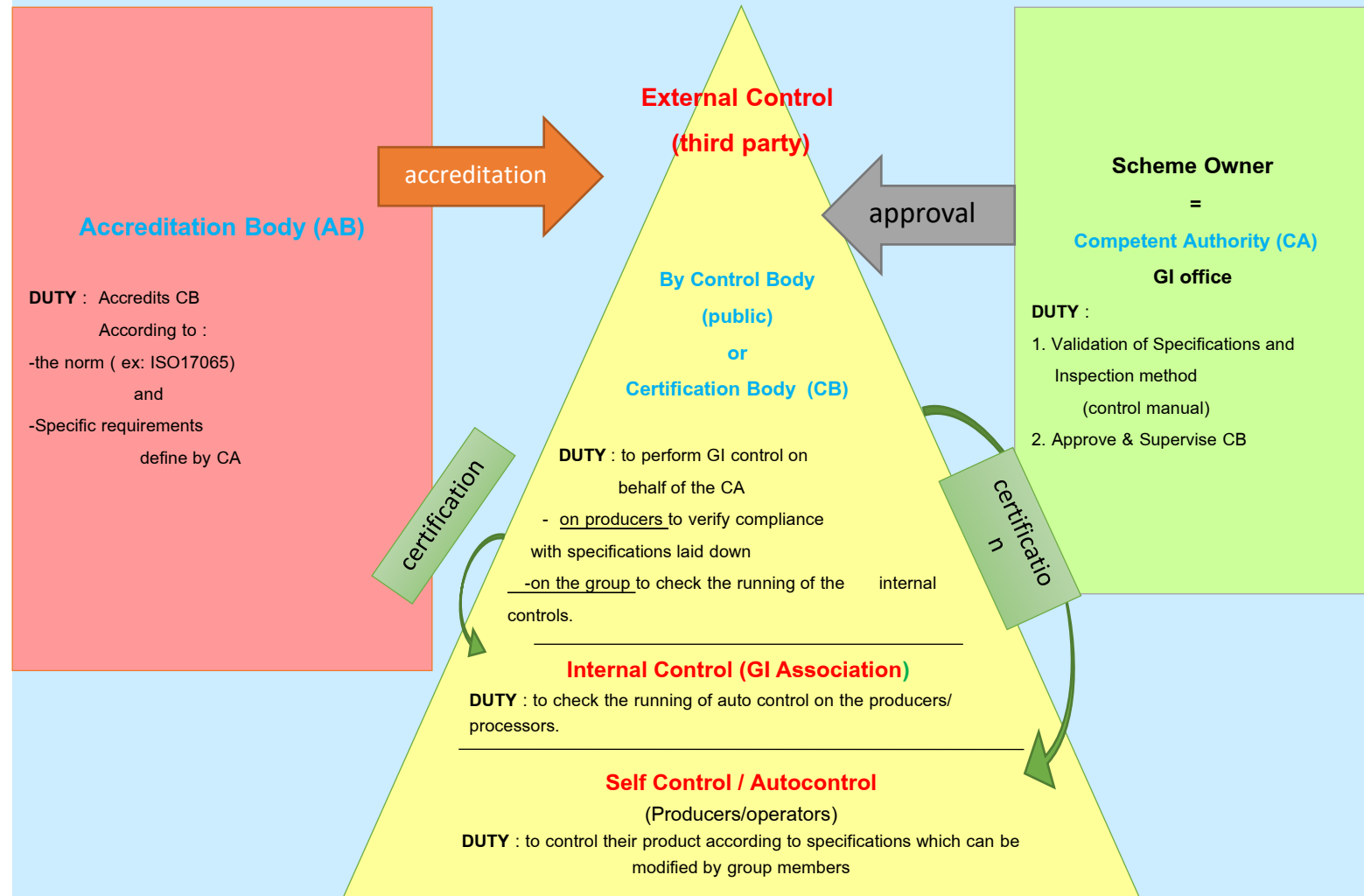


Rights Conferred

- When GI registered in accordance with the provision in National legislation, only producers handling products possessing the quality, reputation or other characteristics specified in the Register who are carrying their activity in the geographical area specified in the Register, who are complying with the GI specifications, have the right to use the registered GI in the course of trade, with respect to products covered by the GI
- This right is not transferable

- A GI right holder shall have the right to institute a complaint to the competent court/authority either against any person who used the GI without authorization or against any member of the GI Association/group who infringed a GI
- A list of GI users should be established and maintained by the GI right holder. All operators handling the product under the GI in accordance with the specifications have the right to use the GI

GI control



Internal infringement

- In case of non-compliance with the specifications by any producers/users, the control body shall take appropriate measures and sanctions to correct the non-compliance as follows:
 - 1/Remarks and advice
 - 2/Warning
 - 3/ Disqualification of the operator/producer for any of its products
 - 4/Temporary revocation of the rights of the operator/producer in relation to the use of the GI
 - 5/Permanent revocation of the rights of the operator/producer in the relation with the use of the GI

Internal versus external infringements

Internal infringements (among producers/operators) :

- Non compliance with specifications (willingly /unwillingly)
- GI user not registered

Internal versus external infringements

- **Types of external infringements**
 - Fake products, imitations and/or counterfeited products present on the market
 - Use of evocation of the name
 - Use of the specific products' pattern by an infringer
 - Cheap and poor quality copycat sold over the internet
- **Impact**
 - Negative perception of the product
 - Loss of revenue, market share and export market; lower profits
 - Consequences on enterprises' innovation and investment activities
 - Costs of actions taken to fight against infringements (campaigns; legal actions to protect rights)

GI Prunes of Agen – USURPATION – Case of packaging



Original

Protection of the notoriety



TGI Paris, 1984



Cour d'appel de Paris, 1993

Champagne – different products



- ***Champagne* for biscuits (Argentina)**



- ***Champagne* for biscuits (France)**

Evocation - Cognac cases



External Infringements : Prohibition against improper use of GI

No person shall:

- in the designation or presentation of goods, by any means, indicate or suggest that the goods originate in a geographical area other than the true place of origin in a manner that misleads the public as to the geographical origin of the goods;
- use a registered GI for direct or indirect commercial misuse in respect of goods that are identical or comparable to those of the registered GI where the misuse benefited or would benefit from the reputation of the GI;
- use a registered GI for direct or indirect commercial misuse in respect of goods that are non-identical or non-comparable to those of the registered GI where the misuse benefited or would benefit from the reputation of the GI;



External infringements: Prohibition against improper use of GI

No person shall:

- use a registered GI identifying products not complying with the specifications or not originating in the place indicated by the GI in question even where the true origin of the goods is indicated or the GI is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation", "method" or the like, including imitation, evocation or translation of the registered GI;
- engage in conduct which constitutes an act of unfair competition, being an act of competition contrary to honest practices in industrial or commercial matters, including:
 - - all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor;
 - false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor;
 - indications or allegations, the use of which in the course of trade, is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quality, of the goods.

External infringements: Prohibition against improper use of GI

- A person who contravenes subsection to GI rights is guilty of an offence and is liable on summary conviction to a fine not exceeding or to imprisonment for a term not exceeding years or to both such fine and imprisonment.
- Specific provisions concerning the implementation of such offences shall be determined by prescribed regulations.
- To above could apply to:
 - the uses of the geographical indication as an ingredient;
 - the uses of the geographical indication on the Internet, including uses in domain names.

External infringements: Prohibition against improper use of GI

Civil remedies

-An interested person may institute proceedings in the Court to prevent, in respect of GI, any under the relevant act referred to .

-The Court may, in proceedings under the above, in addition to granting an injunction, award damages and grant any other remedy or relief the Court thinks fit.

Administrative protection

The NAME OF THE RELEVANT AUTHORITY shall take appropriate administrative and judicial steps to prevent or stop the unlawful use of protected GI that are produced or marketed in the country.



External infringements: Prohibition against improper use of GI

Detention and Confiscation

- The competent courts shall have the authority to order the detention of goods if there is suspicion that the goods are infringing the rights of the GI.
- This applies also to the materials and core equipment where there is suspicion they are used in the production of goods to infringe the rights of the GI.
- The infringing goods which are imported, exported, sold or offered for sale shall be confiscated by the competent authorities through the courts' decision whether or not anyone has been convicted of the offence.

Enforcement

At National Level

**Ex Officio action
(Authorities)**

At International Level

Collective Action (GI Association)

Individual stake-holder(s) action
(Producers Processors /Company, other stakeholders)

GI: a flagship for the protection of national products

National labels for GI

Thailand



Cambodia



Lao PDR



China



Indonesia



Japan



India



European Union





What is the strategy ?

- Respect of internal rules – Control plan/Monitoring system
- Protection against usurpations
- Maintaining the reputation
- Anti-counterfeiting activities
- Improvement of the protection

What is the strategy ?

- GIs do not function alone



Accompanied by active promotion and various branding strategies (GI + other IPRs)

- Where to protect ? Nationally and internationally
- Use all means available for enforcement

How to protect GIs at the international level?

- Applying for GI registration in foreign countries
- Joining International Treaties : WIPO Geneva Act of the Lisbon International Agreement on Appellations of Origin and Geographical Indications: (members such as EU, Lao PDR, Cambodia, DPRK etc.)
- Exchange of GI lists/fast track : examples such between Vietnam and the EU with EU-Vietnam Free Trade (FTA) , Japan and EU (EU-Japan FTA) , Singapore –EU FTA and between China and EU (Exchange of over 100 GI), etc.





Overview of the other legal means of protection available

- **Trade mark law**

In practice, registration of a word mark with a geographical name appears difficult to secure. Many producers have raised concerns with the costs of enforcing trade mark rights

Collective mark

- Holder: association of producers
- Holder may use the mark
- Control by association

certification marks

- Holder: independent entity
- Holder cannot use the mark
- Control by independent entity

Regulations of use



Overview of the other legal means of protection available

Unfair competition and consumers deception laws

- Available in many countries
- No full harmonisation : differences with regard to evidence to be brought up, timeframe for action, remedies, competent authorities and their ability to act *ex officio*
- In practice, consumer deception or unfair commercial practice can be difficult to prove.

Passing off (misrepresentation of the origin of a product can be condemned by a Court)

- Rel

- GIs & TMs are subject to different rules
- GIs & TMs can collaborate or enter into competition sometimes
 - Need to understand the reasons of possible conflict

Some examples of additionnal/complementary protection







Actors of the protection

- GI Producers and their associations
- The GI competent authority
- The State (for example : Fraud department) + procedure ex officio
- Consumers



Thank you

For further information, please contact:

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