

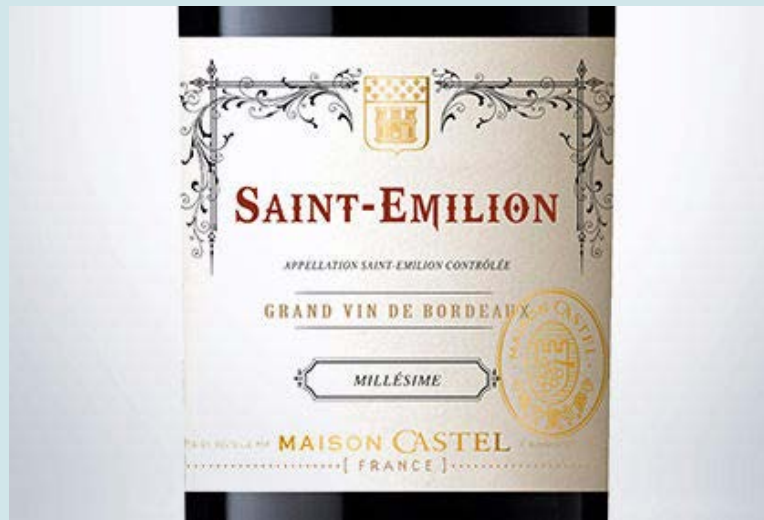
A comparison of certification marks, geographical indications and indications of source

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I - INTRODUCTION

- Attachment of wines to a particular region or tradition brings **added value** to wine producers (E.g. Saint-Emilion)
- Protecting Geographical Indications ensures protection of:
 - The **traditionnel link with the land**
 - **Consumers**



II - INDICATION OF SOURCE

- An indication :
 - ✓ Which informs consumers that the **product originates from a particular geographical location**
 - ✓ **BUT does not warrant the quality of that product**



II - INDICATION OF SOURCE

- No legal definition BUT the scope of protection is defined by international instruments:
- Paris Convention (1883) Article 10 (1):
*“The provisions of the preceding Article shall apply in cases of direct or indirect **use of a false indication of the source of the goods** or the identity of the producer, manufacturer or merchant.”*
 - Madrid Convention (1891) Article 1(1):
*“All **goods bearing a false or deceptive indication** by which one of **the countries to which this Agreement applies**, or a place situated therein, is **directly or indirectly indicated as being the country or place of origin shall be seized** on importation into any of the said countries.”*
- ⇒ Protection against false or deceptive indication of the product’s geographical origin

III - GEOGRAPHICAL INDICATIONS

- An **intellectual property right**

- Defined by article 22.1 TRIPS as:
 - ✓ A **sign**
 - ✓ Used to **identify**
 - ✓ A **good**
 - ✓ **Originating** from a **specific geographical location which could be:**
 - The territory of a country
 - A region in that territory or
 - A locality in that territory
 - ✓ Having:
 - A **given quality,**
 - **reputation or**
 - **other characteristics**
 - ✓ That are **essentially** due to that geographical origin

III - GEOGRAPHICAL INDICATIONS

➤ **More than an « *Indication of Source* »:**

- Not only an indication of the geographical origin of the product
- But also an indication that the product for which the GI is used have qualities and characteristics which are essentially due to its geographical origin

➤ Article 22.2 TRIPS **obliges** WTO Members States **to provide legal means to prevent two types of use of GIs:**

- The designation or presentation of a good indicating or suggesting that :
 - The **good originates in a geographical area other** than the true place of origin
 - In a manner which **misleads the public on the good's geographical origin**
- Any use which constitutes an **act of unfair competition**

III - GEOGRAPHICAL INDICATIONS

- Article 23 TRIPS provides **additional protection** for GIs as regards **wines and spirits**:
 - prevent use of a GI identifying wines for wines **not originating in the place indicated by the geographical indication** in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question

 - EVEN WHERE **the true origin of the goods is indicated** or the geographical indication is used in translation or accompanied by expressions such as “**kind**”, “**type**”, “**style**”, “**imitation**” or the like.

- **TRIPS does not specify any particular legal means to achieve GI protection**

- Some Members States have chosen to create a **sui generis system**

III - GEOGRAPHICAL INDICATIONS

- **National System: France**

AOC (« Appellation d'Origine Contrôlée »)

- **Regional System: European Union**

PGI (Protected Geographical Indication) protected through:

- Regulation 110/2008 of January 15, 2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks
- Regulation 1151/2012 of November 21, 2012 on quality schemes for agricultural products and foodstuffs
- Regulation 1308/2013 of December 17, 2013 establishing a common organisation of the markets in agricultural products



III - GEOGRAPHICAL INDICATIONS

□ International Instrument:

- Paris Convention (1883)

- Lisbon Agreement (1958) & Geneva Act (2015)
 - 28 Members States

 - **International system of registration** of Geographical Indications

 - Administered by the WIPO

 - Ig: Porto, Tequila



III - GEOGRAPHICAL INDICATIONS

➤ Distinction between GIs and AOs in most *sui generis* system:

GIs (TRIPS definition, Art. 22.1)

- **Indication** (E.g. Symbol)
- Identify a good with a specific quality, reputation, or other characteristic
- **Essentially** attributable to its geographical origin

AOs (Lisbon definition, Art. 2)

- **Geographical denomination**
- **Recognized** as referring to quality or characteristics of a specific product
- Due **exclusively or essentially** to the geographical environment (natural or human factors)

⇒ A specific category of GI

⇒ E.g. AOC in France and PDO in the EU



III - GEOGRAPHICAL INDICATIONS

➤ Common features:

- **Registration process :**
 - Application by a **group of producers**
 - **Product specifications** which include:
 - ❖ **Name** to be protected
 - ❖ Description of the product (E.g. analytical and organoleptic characteristics)
 - ❖ **Delimitation** of the geographical area
 - ❖ **Description of the link** between the product and its geographical origin
- May be **used by any producers** which **met the criteria set forth in the specifications**
- **Perpetual** protection

III - GEOGRAPHICAL INDICATIONS

- **Scope of protection:**
 - Protection against unauthorized:
 - ✓ Direct or indirect commercial **use**
 - ✓ **Imitation** or
 - ✓ **Evocation** of the GI (broader than imitation as it does not require any visual/phonetical similarities between the signs)

 - Regarding:
 - ✓ **Identical** or **Similar** products
 - When:
 - ❖ The product is **not originating from the relevant geographical area**
 - ❖ The product **does not comply with the specifications**
 - ✓ **Different** products if the GI is well-known
 - When:
 - ❖ Undue **exploitation of the reputation** of the registered GI (E.g. Use of « Champagne » for designating a sorbet)

IV - CERTIFICATION MARKS

- **Some countries use CTMs to protect GIs (E.g. USA)**

- **Guarantee that products have specific qualities**

- A CTM is a **trademark**:
 - Registration system

 - Only the trademark owner may take action against infringement

 - 10 years protection renewable

IV - CERTIFICATION MARKS

- BUT a **special type** of trademark:
 - CTM certifies that the goods and services **have specific qualities** (may include **geographical origin**)
 - Prohibition of geographically descriptive marks **does not apply to CTM** (depends of the country)
 - Applicant files **detailed regulations governing the use of the CTM** (characteristics certified by the CTM, certification and control process)
 - **Collective use** of the CTM
 - **CTM owner shall not exploit** the goods designated by the CTM (« *anti-use by owner rule* »)
 - CTM owner **controls compliance with the criteria** set forth in the regulations

IV - CERTIFICATION MARKS

➤ Scope of protection:

- Protection against unauthorized:
 - ✓ **Reproduction** or
 - ✓ **Imitation**

- Regarding:
 - ✓ **Identical or similar** products
 - ✓ **Different** products if the CTM is **well-known** (in countries in which renowned TMs benefit from a larger protection)

- When:
 - ✓ The product **does not comply with submitted regulations**

V - COMPARISON

- *Sui generis* GI and CTM have common features:
- **Identification of the geographical origin** of the product
 - **Guarantee of quality**
 - **Collective use** of the sign

BUT are they really the same?

V - COMPARISON

➤ Guarantee of quality

- The link between the product's quality and its geographical origin is not necessarily guaranteed by CTMs

Example :

- **RECIOTO** U.S Registration No. 3225233
- **Goods** : Alcoholic beverages, namely wines
- **Certification statement** :
« *The certification mark, as used by persons authorized by the certifier, certifies a wine produced in the Valpolicella region of Italy.* »
- **CTM does not guarantee that this wine has special qualities essentially due to its origin**

=> Merely works as an « *Indication of source* »



V - COMPARISON

➤ Enforcement

- GIs can be enforced by any person entitled to use the GI
- CTMs can only be enforced by their owner

V - COMPARISON

➤ Scope of protection:

- GIs and CTMs are both protected against unauthorized:
 - ✓ **Reproduction** or
 - ✓ **Imitation**

- Regarding:
 - ✓ **Identical** or **similar** product
 - ✓ **Different** products (if the GI or CTM is well-known)

- When:
 - ✓ The product does not comply with submitted specifications

BUT GI's scope of protection is broader since GI is also protected against evocation

V - COMPARISON

➤ Example:

GI: Scotch Whisky

Litigious utilisation: **Glen Buchenbach** for a whisky



An infringement of the GI « Scotch Whisky » ?

- Glen Buchenbach **may constitute an evocation** of the GI « Scotch Whisky » if the public makes a link between “Glen” and Scotland
- According to the ECJ (*June 8, 2018, C-44/17*), an evocation may be found to exist even though there is no visual/phonetic similarity between the signs

An infringement of the CTM « Scotch Whisky » ?

- **Very unlikely** as there is no visual nor phonetic similarity between the signs

Key contacts



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Thank you for you attention

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