



Universität St.Gallen

GI's, trademarks and international standards (e.g. Codex Alimentarius)

AIPPI, Milan, July 2, 2008

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I. Introduction

- The importance of GI's is generally recognized and accepted
- The main questions are:
 - Is a name (geographical or not) a GI or is it generic?
 - What is exactly protected (the name, the look, the distribution system)?
- The “GI dispute” is well known as the EC–US dispute with regard to Regulation EEC 2081/92 (now 510/2006)
- More “heated disputes” are due to overlapping institutional perspectives such as the Codex Alimentarius

II. WTO framework – 1

- Articles 22 and 23 of the Trips Agreement
- Extension of Article 23 to all Products
- Multilateral Register for GIs
- „Claw back“ – Lists
- Today: standstill

- Implementation
 - By sui generis systems (EC)
 - By the existing trademark system (certification marks, USA)
 - Mixed systems

II. WTO framework – 2

- Panel Report of 15 March 2005 (WT/DS174/R) on the CO–
existence of trademarks and GI's:
- Art. 16.1 Trips states the rule of priority and exclusivity
- Art. 17 Trips entitles Members to provide for limited exceptions
to Art. 16.1 Trips, such as fair use of descriptive terms
- The right to use is limited to GI's as registered (not in translation, not in deviating versions)

III. Primary Community Law

–Is protection of GI's justified under Articles 28 and 30 EC?

Turrone de Alicante – ECJ C3/91

- Art. 30/36 (28/30 EC) do **not prohibit bilateral protection of GI's**
- „Simple“ and „neutral“ GI's fall under art. 36 (30 EC)
- Country of origin protection can be „exported“ to third countries on the basis of bilateral agreements, as long as a GI has not become generic in that third country**

Prosciutto di Parma – ECJ C–108/01

- Regulation 2081/92 must be interpreted as **not precluding** the use of a protected designation of origin from being subject to the condition that operations, such as the slicing and packaging of the product, take place in the region of production, where such a condition is laid down in the specification;
- ... this constitutes a measure having equivalent effect to a quantitative restriction on exports within the meaning of Article 29 EC, **but may be regarded as justified, and hence compatible with that provision;**
- ... the condition in question cannot be relied on against economic operators, as it was not brought to their attention by adequate publicity in Community legislation.



Grana Padano – ECJ C-469/00

–Article 29 EC must be interpreted as **not precluding** a convention concluded between two Member States A and B, concluded prior to the entry into force of Commission Regulation (EC) No. 1107/96 ... from making applicable in Member State A national legislation of Member State B, under which the designation of origin of a cheese, protected in Member State B, is reserved, for cheese marketed in grated form, the cheese grated and packaged in the region of production.

Grana Padano – ECJ C-469/00

- Regulation 2081/92 must be interpreted as **not precluding** the use of a protected designation of origin from being subject to the condition that operations, such as the grating and packaging of the product, take place in the region of production, where such a condition is laid down in the specification;
- ... this constitutes a measure having equivalent effect to a quantitative restriction on exports within the meaning of Article 29 EC, but may be regarded as justified, and hence compatible with that provision.

Grana Padano – ECJ C-469/00

- ... the condition in question **may not be relied on against economic operators, as it was not brought to their knowledge by adequate publicity in Community legislation;**
- ... the principle of legal certainty does not preclude that condition (packaging, grating) from being regarded by the national court as capable of being relied on against operators who carried on the activity of grating and packaging the product in the period prior to the entry into force of Regulation No. 1107/96 (on Article 17), should that court consider that during that period the national law was applicable by virtue of the Convention between member states A and B and capable of being relied on against those concerned by virtue of the national rules on publicity.

Rioja II – ECJ C-388/95

- The **obligation to bottle** in the region of production constitutes a measure having an effect equivalent to quantitative restrictions on exports within the meaning of Article 29 EC;
- Designations of origin fall within the scope of industrial and commercial property rights. The reputation of designations of origin depends on their image in the minds of consumers. That image in turn depends essentially on particular characteristics and more generally on the quality of the product. It is on the latter, ultimately, that the product's reputation is based;
- The requirement at issue is justified as a measure protecting the 'denominación de origen calificada' which may be used by all the producers concerned and is of decisive importance to them;
- The measure is **necessary, in that there are no less restrictive alternative measures capable of attaining the objective pursued.**

Gorgonzola – ECJ C-87/97

- The principle of free movement of goods does not preclude Member States from taking the measures incumbent upon them in order to ensure the protection of designations of origin registered under Regulation No. 2081/92;
- It is for the **national court** to decide whether the conditions laid down in Article 14(2) of Regulation No. 2081/92 allow use of an earlier trademark to continue.

Regional Labels – ECJ C-6/02

– „ ... by maintaining the national legal protection afforded to the name ‚Salaisons d’Auvergne‘ and to the regional labels ‚Savoie‘, ‚Franche-Comté‘, ‚Corse‘, ‚Midi-Pyrénées‘, ‚Normandie‘, ‚Nord-Pas-de-Calais‘, ‚Ardenne de France‘, ‚Limousin‘, ‚Languedoc-Roussillon‘ and ‚Lorraine‘, the French Republic has **failed to fulfil its obligations under Article 28 EC.**“

Markenqualität aus deutschen Landen – ECJ C-235/00

- „ ... by awarding the quality label ‚Markenqualität aus deutschen Landen‘ (quality label for produce made in Germany), to finished products of a certain quality made in Germany, the Federal Republic of Germany has **failed to fulfil its obligations under Article 30 of the EC Treaty (now, after amendment, Article 28 EC).**“

Emmental – ECJ 448/98

– „Article 30 of the EC Treaty (now, after amendment, Article 28 EC) precludes a Member State from applying to products imported from another Member State, where they are lawfully produced and marketed, a national rule prohibiting the marketing of a cheese without rind under the designation ‚Emmental in that Member State“.

Not harmonized national protection outside 2081/92 (now 510/06) – Warsteiner

- „Council Regulation (EEC) No. 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs **does not preclude the application of national legislation which prohibits the potentially misleading use of a geographical indication of source in the case of which there is no link between the characteristics of the product and its geographical provenance.**“

Bilateral GI-Agreements outside Regulation EC 510/2081/92 – ECJ C-216/01 Budejovicky Budvar

- Article 28 EC Regulation 2081/92 do **not preclude the application of a provision of a bilateral agreement between a Member State and a non-member country** under which a **simple and indirect indication of geographical origin** from that non-member country is accorded protection in the importing Member State, whether or not there is any risk of consumers being misled, and the import of a product lawfully marketed in another Member State may be prevented;
- Article 28 EC **precludes the application of a provision of a bilateral agreement between a Member State and a non-member country** under which a **name which in that country does not directly or indirectly refer to the geographical source of the product that it designates** is accorded protection in the importing Member State, whether or not there is any risk of consumers being misled, and the import of a product lawfully marketed in another Member State may be prevented.

Other Cases

- C–178/84 REINHEITSGEBOT for beer;
- C–407/85 ITALIAN PASTA;
- C–286/86 EDAM (minimum fat content);
- C –298/87 YOGHURT;

- C–12/00 and C–14/00 CHOCOLATE.

IV. Sui generis protection of GI's

- The goals of EU legislation
- PDO and PGI
- Scope of protection
- PDO / PGI and trademarks
- Jurisprudence

The Goals of Regulation 510/06 (2081/92)

- Part of the adjustment of the common agricultural policy
- Diversification of agricultural production
- Benefit to the rural economy, in particular to less-favoured or remote areas by improving the incomes of farmers and by retaining the rural population in these areas
- Consumers must be given clear and succinct information regarding the origin of the product
- Ensuring fair competition between producers of products bearing such indications;
- Enhance the credibility of the products in the consumers' eyes.

PDO – Designation of Origin

- The name of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff;
- originating in that region, specific place or country, and
- the quality or characteristics of which are essentially or exclusively;
- Due to a particular geographical environment with its inherent natural and human factors;
- And the production, processing and preparation of which take place in the defined geographical area.

PGI – Geographical Indication

- The name of a region, a specific place or, in exceptional cases,
a country, used to describe an agricultural;
- Product or a foodstuff:
 - origination in that region, specific place or country, and
 - which possesses a specific quality, reputation or other characteristics attributable to that geographical origin and
- The production and/or processing and/or preparation of which
take place in the defined geographical area.

Effects of Registration

- Protected names may not become generic;
- The indications PDO/PGI ... or equivalent traditional national indications may appear only on agricultural products and foodstuffs that comply with this Regulation, i.e. with the product specification.

Scope of Protection

- Any **direct or indirect commercial use** of a registered name in respect of products not covered by the registration in so far as those **products are comparable** to the products registered under that name **or** insofar as using the name exploits the **reputation** of the protected name
- Any **misuse, imitation or evocation, even if the true origin of the product is indicated** or if the protected name is translated or accompanied by an expression such as ‘style’, ‘type’, ‘method’, ‘as produced in’, ‘imitation’ or similar
- Any other **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 other **practice liable to mislead the consumer** as to the true origin of the product



Feta I – ECJ C-289/293/299/96

–In the context of procedures for registration of a name of a product under the basic regulation, **account must be taken of the existence of products which are legally on the market and have therefore been legally marketed** under that name in Member States other than the State of origin by which registration is applied for.

Spreewälder Gurken – ECJ C-269/99

- A statement of objection to a registration cannot come from the Member State which has applied for the registration. The objection procedure established by Article 7 is not intended to settle disputes between the competent authority of the Member State which has applied for registration and a natural or legal person resident or established in that Member State;
- It is for the national courts to rule on the lawfulness of an application for registration of a designation.**

Epoisses de Bourgogne – ECJ C-129/130/97

–As regards a **‘compound’ designation of origin**, the fact that there is no footnote specifying that registration is not sought for one of the parts of that designation does not necessarily mean that each of its constituent parts is protected.

- FETA: Joined Cases C-465/02 and C-466/02: how to establish (or not) the generic character of a name

Parmigiano Reggiano

- Parmigiano Reggiano: C-132/05: how to establish (or not) the generic character of a name and the burden of proof

V. GI's in trademarks – rules of coexistence

- Prior PDO/PGI registration is absolute ground of refusal for TM;
- Prior TM may continue to be used notwithstanding the registration of a PDO/PGI, provided that no grounds for its invalidity or revocation exist as specified in TM-Directive, Directive 89/104/EEC and Council Regulation (EC) No 40/94 , if applied for, registered, or established by use
 - in good faith
 - before either the date of protection in the country of origin or the date of submission to the Commission of the application for registration of the PDO/PGI.
- So, there are rules of co-existence!**

V. GI's in trademarks – Misleading and generic character of a name

- Absolute grounds for refusal:
 - if misleading
 - Chiemsee – ECJ C-108/9/97

Collective trademarks – necessary regulations

- T-291/03 Grana Padano/Biraghi (Grana Biraghi as CTM?)

VI. Overlapping institutional perspectives: Codex Alimentarius

- The Codex Alimentarius has been a point of reference (of indicative value):
 - in C-286/86 Deserbais (for the characteristics of a product)
 - in C-53/80 Nisin (Codex not relevant for antibiotics in melted cheese)
 - C-178/84 Deutsches Bier (supplements in beer)
 - in C-448/98 Guimont (for the characteristics of a product)
 - in C-196/05 Pizza Mozzarella (for the tariff classification)
 - in T-291/03 Grana/Biraghi (for the generic character)
- It was also a “battlefield” in the Parma case

Role and function of the Codex Alimentarius

- The Codex Alimentarius Commission (CAC)
- Goals:
 - “protecting the health of the consumers
 - ensuring fair practices in the food trade
 - promoting coordination of all food standards work undertaken by international governmental and non-governmental organization
 - finalizing standards
 - publishing them in the Codex Alimentarius”
- Point of reference in SPS and TBT

Implications of the Codex Alimentarius for IP and especially GI's?

- The role of IP in Codex Standard–setting, according to FAO/WHO:
 - CX/EXEC 72/18/11
 - ALINORM 04/27/41, Appendix X
 - Exchange of correspondence between FAO/WHO and WIPO: CAC/28 INF/16, Annex C
- Codex Standards can be adopted by non–consensual procedures

Enforcement of Codex Alimentarius Standards against (existing) IP rights?

- More than questionable because of some basic principles in international law, IP and GI law:
 - “pacta sunt servanda” (Art. 26 Vienna Convention on the Law of Treaties)
 - existing bi- and multilateral treaties, e.g. on cheese names
 - Art. 22 Trips (GI definition)
 - Art. 24.6 Trips (generic terms)
 - Principle of territoriality
 - Country of protection principle (Exportur; if not agreed otherwise in bi- or multilateral agreements)

VII. Conclusions

- The EC “GI world” is well established
 - as a sui generis system (Regulation 510/2006)
 - within the trademark framework (relationship trademark–GI),
 - but
- the use of technical standards, e.g. the Codex Alimentarius as points of reference for the characteristics and/or the generic nature of a product/name must better take into account the specific function of the Codex Alimentarius (which is not IP) and its limits compared to basic principles of international law, IP and GI law.