



“Members’ Voice”

Germany: A new crucial success for the PDOs Parmigiano Reggiano and Asiago

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As requested - *inaudita altera parte* - by both the Consorzio del Formaggio Parmigiano-Reggiano and the Consorzio per la Tutela del Formaggio Asiago, in October 2011 the Court of Cologne had issued a cease and desist order, as well as an order to seize cheeses respectively named ‘Parmesan’ and ‘Asiago’ imported by an operator from a third country and exhibited at the international food fair ‘Anuga’ in Cologne (more information on the oriGIn Report, October 2011). The decision was based on the fact that, according to art. 13.1 of Regulation (EC) 510/06, the use of the terms ‘Parmesan’ and ‘Asiago’ infringes the PDOs ‘Parmigiano Reggiano’ and ‘Asiago’.

The operator had accepted the decision of the Court with respect to the cease and desist order. However, it had opposed the condemnation to bear all costs related to the preliminary injunctions proceedings, considering that if the two Consortia had previously sent a warning letter, the operator would have immediately withdrawn the products at issue.

On 23 February, the Court of Cologne confirmed in its ruling that the defendant has to bear all costs of the preliminary injunctions proceedings: a new crucial success for the Consorzio del Formaggio Parmigiano-Reggiano and the Consorzio per la Tutela del Formaggio Asiago!

The Court - sharing the views of both Consortia - dismissed the opposition filed by the operator. It considered in particular the fact that the Consortia had also asked the Court the seizure of the cheeses exhibited at the Anuga fair. Consequently a previous warning letter to the

operator would have put in jeopardy the possibilities to find the products at issue.

The positive outcome of this case for both Consortia as well as AICIG (Associazione Italiana Consorzi Indicazioni Geografiche), which supported the action of the Consorzio per la Tutela del Formaggio Asiago, shows once again the efficiency of the system of protection of PDOs and PGIs in the EU. It also highlights the need for GI groups of producers and associations to be proactive in the defence of GI’s rights, for the interest of both producers and consumers.

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International Affairs

At the Global Level

The USPTO: Encouraging step towards better protection of marks certifying geographical origin

On 30 January, the decision of the Trademark Trial and Appeal Board of the United States Patent and Trademark Office (USPTO) concerning the case opposing ‘American Watch International’, a distributor and reseller (the distributor), and ‘Federation of the Swiss Watch Industry’ (the Federation) was published (Swiss Watch International Inc. V. Federation of the Swiss Watch Industry, T.T.A.B., No. 92046786, 1/30/12).

The Federation owns the certification marks “Swiss” and “Swiss made” since 2006. The distributor’s application for registration of the trademarks “Swiss Watch International” and “Swiss Legend” was rejected by the USPTO on the grounds that it would create confusion with the Federation’s marks. After this rejection, the distributor asked for the cancellation of the Federation’s certification marks, on the ground - among others - that the Federation did not control the use of its marks and that the names have

become generic in the United States and, as a result, not entitled anymore to be protected in this country.

The Board dismissed the petition for cancellation. It ruled that the certification marks did not become generic, despite the use of some unregistered trademarks by third parties, because the Federation's extensive worldwide monitoring and enforcement system was adequate and because of the actions undertaken by the Federation to avoid the use of unregistered trademarks. Moreover, the Board said that the American public perceives the certification marks 'Swiss' and 'Swiss Made' as identifying the origin in which watches are manufactured. As a result, such marks cannot be deemed generic in the US.

This case (both the USPTO rejection of the marks "Swiss Watch International" and "Swiss Legend" and the Board's dismissal of the petition for cancellation of the certification marks "Swiss" and "Swiss Made") shows an encouraging evolution in the practice of the USPTO with regard to marks certifying a geographical origin. In particular, we are glad to note that the USPTO approach in this case follows one of the recommendation contained in the oriGIn Manual on American GIs, namely a more proactive role of the USPTO in rejecting application for marks that include registered certification marks (see page 39 of our Manual)!

The opinion of the Board can be found at: <http://ttabvue.uspto.gov/ttabvue/v?pno=92046786&pty=CAN&eno=92>

USA:

Creation of an association to counter oriGIn

On 26 March, the "Consortium for Common Food Names" was launched. Its members are the U.S. Dairy Export Council (USDEC), the International Dairy Foods Association, the American Farm Bureau Federation, the American Meat Institute, the American Cheese Society, the Wine Institute, as well as regional agriculture associations in the U.S., Argentina and Costa Rica. The new association currently counts 11 members.

The objective of this association is to counter oriGIn's efforts for a more effective legal

protection of GIs at the national, regional and international level (see article attached). Likewise, the "Consortium for Common Food Names" aims at resisting the EU efforts to secure strong protection for GIs through bilateral trade agreements. The members of the Consortium consider that the bilateral trade agreements the EU is negotiating – like the one with South Korea which provides an "exchange" of GI lists which were given strong protection in each partner's jurisdiction – could harm their businesses, as the misuse they do of several GI names in these countries will not be allowed any longer after the conclusion of such agreements.

The creation of this association confirms that our work around the world is being effective as the food industry has been feeling some pressure! oriGIn will watch carefully the work of the new association and respond to their campaigns with our arguments in favour of a fair and predictable international legal system which gives protection to GIs from all over the world!

WIPO:

Rise in "cybersquatting" cases in 2011

In 2011, the number of "cybersquatting" cases at the Arbitration and Mediation Center of the World Intellectual Property Organization (WIPO) reached a record high, with 2764 cases filed by trade mark owners.

"Cybersquatting" can be defined as the registration of a domain name (the name used to identify a website "before the dot" – on the structure of the Domain Name System, please see the oriGIn Report of February 2012) consisting of, or containing a registered trademark. This is done in bad faith, so the "cybersquatter" then offers to sell the domain to the person or company which owns the trademark at issue at an inflated price.

The WIPO panels, which worked on such cases, found evidence of "cybersquatting" in 88% of the cases filed last year. The top five areas with the most number of complaints were retail, internet and information technology, biotechnology and pharmaceuticals, fashion, and banking and finance. The cases included many well-known names. 77 % of these cases concerned

registrations in the .com domain and 16% concerned country code top-level domains (e.g. .eu for the European Union).

These statistics show once again the urgent need to extend the rules to fight “cybersquatting” to GIs. Currently, the possibility to obtain the cancellation of a domain name in a case of “cybersquatting” before the WIPO Arbitration and Mediation Center is limited to cases of conflict with a trademark. oriGIn is pushing ICANN and WIPO to extend those rules to GIs!

Meanwhile, WIPO expressed concerns over the potential impact on “cybersquatting” of the ICANN move underway to add more generic top level domains (the part of the domain name “after the dot”, see oriGIn report of February 2012).

More information at:
http://www.wipo.int/pressroom/en/articles/2012/article_0002.html

oriGIn - CTA practical manual on GIs is now available in French

On 15 December 2011, oriGIn and the Technical Centre for Agricultural and Rural Cooperation (CTA) had launched a “Practical Manual on Geographical Indications for ACP countries”. The manual aims to serve as a practical tool for GI producers and policy makers in ACP countries.

The French version of the book has been published in March and is now available at:

http://www.origin-gi.com/index.php?option=com_content&view=article&id=253:ctaaorigin-practical-manual-on-gis&lang=fr

WTO: Discussion on the Australian Act on plain packaging for tobacco products

On 28 February, the WTO committee responsible for intellectual property rights discussed the Australian law on tobacco plain packaging.

It is worth recalling that the law requires the removal of all elements of branding, including logos and trademarks, from all tobacco packs, which will be standardised. The law permits manufacturers to print the brand name in a

mandated size, font and place on the pack, in addition to the health warnings and any other legally mandated information such as toxic constituents and tax-paid stamps.

At the WTO, the Dominican Republic, amongst others, raised questions about the compliance with Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). During previous meetings of the Committee, Cuba, Dominican Republic, El Salvador, Honduras, Mexico, Nicaragua, Nigeria, Ukraine, and Zimbabwe has spoken against the law. New Zealand, Norway and Uruguay had supported Australia. Brazil, Chile, China, India, the EU and Switzerland had spoken in favour of the right to use flexibilities in the TRIPS Agreement for public health purposes including tobacco consumption control.

The tobacco industry has already filed two lawsuits against Australia, one through Australia's Bilateral Investment Treaty with Hong Kong signed in 2003, and another one in Australia.

On 13 March 2012, Ukraine requested consultations with Australia under the WTO dispute settlement system concerning its plain packaging law for tobacco products. Ukraine claims that Australia's measures, especially viewed in the context of its comprehensive tobacco regulatory regime, appear to be inconsistent with a number of obligations under the TRIPS Agreement, the TBT Agreement, and the GATT 1994. This consultation will give Ukraine and Australia an opportunity to discuss the matter and to find a satisfactory solution without proceeding further with litigation. After 60 days, if consultations have failed to resolve the dispute, the complainant may request adjudication by a panel. On 4 April Honduras followed Ukraine in challenging the Australia law at the WTO.

More information at:
http://www.wto.org/english/news_e/news12_e/ds434rfc_13mar12_e.htm

WTO negotiations: A new chairperson for the multilateral register

On 23 March, Nigerian Ambassador Yonov Frederick Agah was elected chairperson of the

WTO negotiations on a multilateral register for GIs for wines and spirits.

Following his election, Ambassador Agah said that he will initiate a process of informal consultations with the delegations and that he will report back to the WTO members.

ACTA: Debate at the WTO TRIPS Council

On 28-29 February, the WTO Council on Trade-Related Aspects of Intellectual Property Rights (TRIPS) discussed the Anti-Counterfeiting Trade Agreement (ACTA).

Developing countries raised concerns about the Agreement and its potential impact on innovation. The European Commission explained the aim of the ACTA (which is not to establish additional rules on the protection of intellectual property rights, but just to facilitate a better enforcement of the TRIPS rules) and that it would have preferred to negotiate the ACTA with all the WTO members, but this would have proved impossible.

For information, the new Chair of the TRIPS Council is Dacio Castillo, the ambassador of Honduras to the WTO.

Bilateral / Regional Issues

EU – Peru & Colombia Free Trade Agreement should be signed in May

On 16 March, the EU Trade Ministers authorised the signature of Free Trade Agreement between the EU and Colombia and Peru. The signature should take place in May after the European Parliament ratifies the Agreement.

180 EU GIs for wines, sprits and agricultural products will be protected under the Agreement. Likewise, 2 Peruvian GIs for agricultural products ('Maiz Blanco Gigante Cusco' and 'Pallar de Ica'), 1 for spirits ('Pisco') and 1 for non agricultural products ('Chulucanas') as well as 2 Colombian GIs, 1 for agricultural products ('Cholupa du Huila') and 1 for non agricultural products ('Guacamayas'), will be protected under the Agreement (see Annex XIII; the text of the

Agreement can be found at:
<http://trade.ec.europa.eu/doclib/press/index.cfm?id=691>

The Agreement remains open for signature to Ecuador and Bolivia (the other two members of the Andean Community), under the principle of regional integration within the Andean Community.

EU – USA: New Partnership on organic products

On 15 February, the EU and the USA announced that, from the 1st of June, organic products certified in the EU or in the USA will sold as organic in the other region.

This partnership will cover the two largest organic-producers and market in the world. Before this partnership, farmers had to obtain separate certifications to two standards in order to sell their products on both markets. The partnership will allow easier access to the EU or US market, as well as less bureaucracy, fees and inspections. It also improves transparency on organic standards and enhances consumers' confidence.

More information at:
http://ec.europa.eu/agriculture/organic/home_en

EU Affairs

GI Policy

European Observatory on Infringements of Intellectual Property Rights

In February, the European Parliament approved the proposal to transfer the 'European Observatory on Counterfeiting and Piracy' to the Office for Harmonization in the Internal Market (OHIM) and to change its name to the 'European Observatory on Infringements of Intellectual Property Rights'.

On 22 March, the transfer was formally adopted by the Council of the European Union.

The Observatory will ensure, among others, the collection analysis and dissemination of relevant,

objective and reliable data regarding the value of IP rights and the infringements of those rights.

For further information, please consult:

<http://europa.eu/rapid/pressReleasesAction.do?reference=M/EMO/12/207&format=HTML&aged=0&language=EN&guiLanguage=en>

News on GI Registrations

Registration of GIs

- "Alföldi kamillavirágzat" (PGI) Hungary – 25/02
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2012:053:0004:0009:EN:PDF>
- "Koufeta Amygdalou Geroskipou" (PGI) Cyprus – 03/03
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2012:064:0001:0002:EN:PDF>
- "Melon de Guadeloupe" (PGI) France – 03/03
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2012:064:0003:0004:EN:PDF>
- "Armagh Bramley Apples" (PGI) UK – 08/03
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2012:069:0001:0002:EN:PDF>
- "Tolminc" (PDO) Slovenia – 08/03
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2012:069:0005:0006:EN:PDF>
- "Susina di Dro" (PDO) Italy – 08/03
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2012:064:0003:0004:EN:PDF>
- "Schwäbische Spätzle / Schwäbische Knöpfle" (PGI) Germany – 08/03
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2012:069:0003:0004:EN:PDF>
- "Cinta Senese" (PDO) Italy – 15/03
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2012:075:0001:0002:EN:PDF>
- "Béa du Roussillon" (PDO) France – 15/03
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2012:075:0003:0004:EN:PDF>

- "Sel de Guérande / Fleur de Sel de Guérande" (PGI) France – 20/03
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2012:080:0004:0008:EN:PDF>

Modification request

- "Provolone Valpadana" (PDO) Italy – 03/03
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2012:064:0019:0024:EN:PDF>
- "Carne Marinhosa" (PDO) Portugal – 09/03
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2012:071:0033:0036:EN:PDF>
- "Coppia Ferrarese" (PGI) Italy – 14/03
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2012:075:0013:0017:EN:PDF>
- "Cecina De León" (PGI) Spain – 20/03
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2012:081:0006:0010:EN:PDF>

Registration request

- "Abensberger Spargel" / "Abensberger Qualitätsspargel" (PGI) Germany – 24/02
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2012:055:0025:0028:EN:PDF>
- "Cordeiro Mirandês" / "Canhono Mirandês" (PDO) Portugal – 29/02
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2012:060:0016:0019:EN:PDF>
- "Aischgründer Karpfen" (PGI) Germany – 03/03
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2012:064:0016:0018:EN:PDF>
- "Aceituna Aloreña De Málaga" (PGI) Spain – 07/03
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2012:069:0010:0014:EN:PDF>
- "Newmarket Sausage" (PGI) UK – 07/03
<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2012:069:0015:0018:EN:PDF>