



Webinar on Geographical Indications: Protecting and Enforcing GIs

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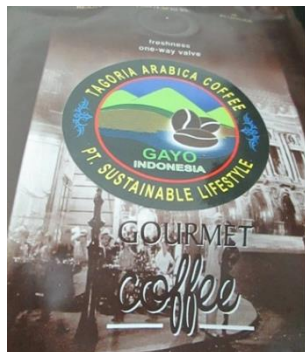
Enforcement of GIs in SEA: The Need for Adequate Enforcement Mechanisms to Protect GI Owners and Consumers

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INTRODUCTION



GI : an exclusive right of use

The GI name can only be used to designate the product
complying with the book of specifications
including labelling rules

If there is no control of the use of the GI for products that do not comply with the book of specifications, all the efforts to protect the reputation of the product are jeopardised



Control on the market ?

Before GI product IS SENT on market



Control at GI producers, processors, 1st traders sites and of product

Certification Body/ Public Control / PGS:
External control

+

Collective management organization:
Internal control

+

each producer/processor: Self-control



ON the MARKET (enforcement)



*Control of frauds, misuses and imitations of GIs on the product label in any trade places
opposition against registration of trademarks*

Public Fraud Control /Market controls
services/Customs services/GI authority/

+

Collective management organization:
alert the frauds, opposition to TM
registration and legal proceeding in
front of courts



Frauds & Infringement in the EU



INFRINGEMENT OF PROTECTED GEOGRAPHICAL
INDICATIONS FOR WINE, SPIRITS, AGRICULTURAL
PRODUCTS AND FOODSTUFFS IN THE
EUROPEAN UNION



- Frauds represent 9% OF GI PRODUCT MARKET (in value)
- (Data from 17 Member State representing approximately 82% of the EU GI product market, 100 000 products checked)

Frauds and Infringement in Asean



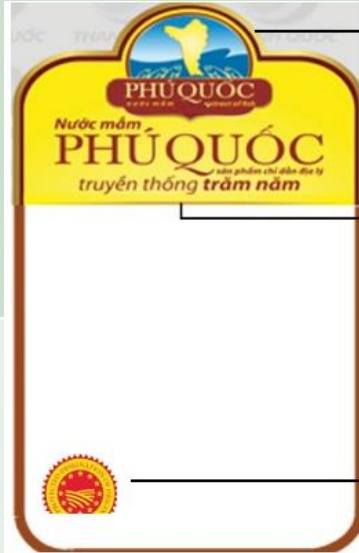



- General data about GI frauds in Asean?
 - Ex in VN: 11% of targets market place offer 'Champagne' products not from France (survey CIVC 2018)
- No single system for GI registration and enforcement in Asean
 - Enforcement at country level
 - of domestic Asean GIs as well as foreign GIs
 - According to the national legal framework or to the provisions of FTAs for foreign GIs included in the FTA
 - Scope of protection
 - Enforcement actors

SCOPE OF PROTECTION

What to enforce?

- Object of protection
 - Name registered as a GI
 - Labelling rules: depends on each GI
 - Product Logo
 - National GI logo
 - Traceability information

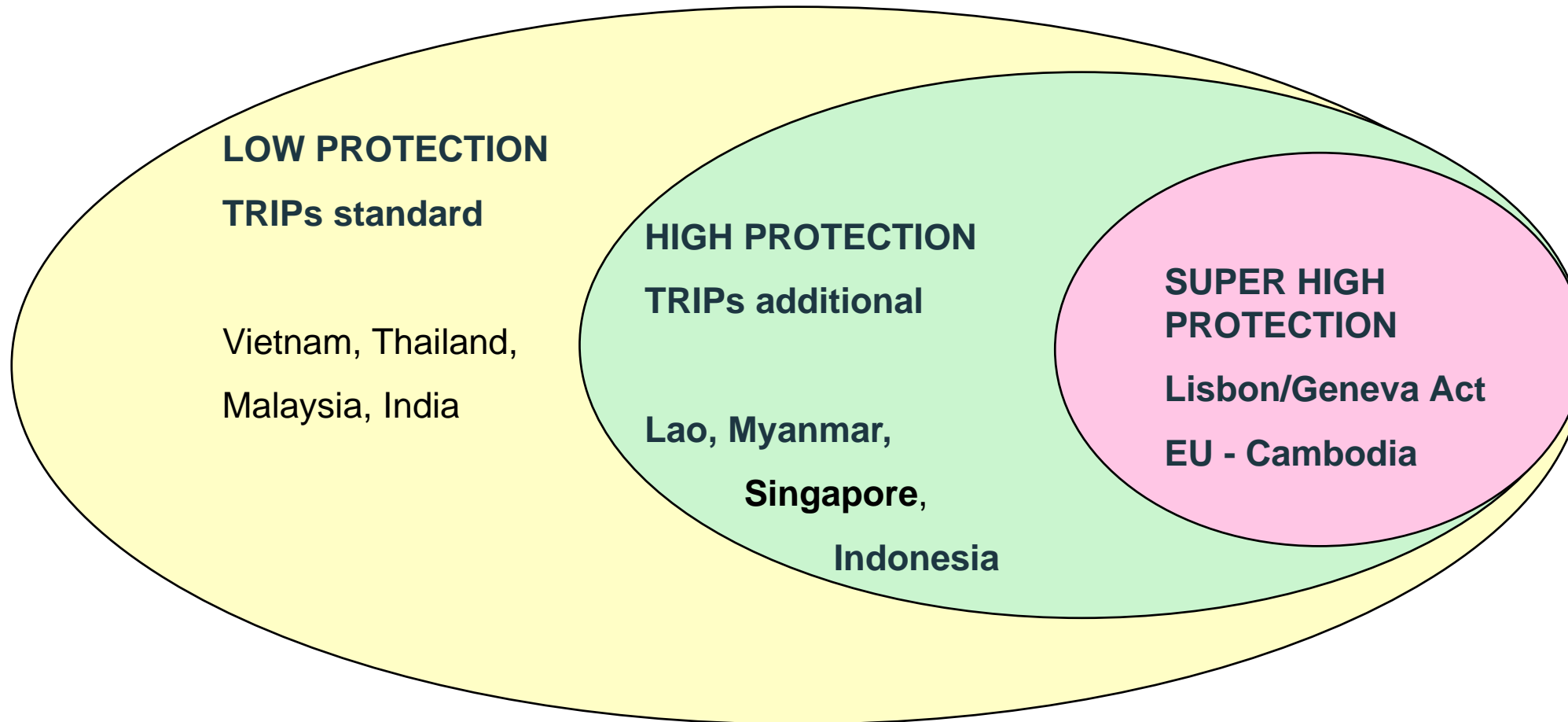
Name of the GI	Kampot Pepper	Nuoc Mam Phu Quoc	Lamphun Brocade Thai Silk
Labelling rules	 		
	'Poivre de Kampot' or in translation, font size > other letters in the packaging		indication registration number Sor,Chor. 5O1OOO21
	Individual batch number (traceability): Lot nb		silk yarn type, size of fabric, t dye used, care instruction producer's information

Need to control

- that compliant product are respecting the labelling rules
- all products, even if they use only the GI name “Kampot Pepper”, “Phu Quoc” or “Lamphun Brocade Thai Silk”

*Resist the temptation to control only the products
using the logos...*

Level of protection in Asean countries: heterogeneity



Protection against various uses

- Direct use of the GI name
- Imitation/evocation of the GI name
- Use of the GI name for different type product
- Use of the GI name when the product is an ingredient

Direct Use of GI

Lisbon/Geneva	TRIPs additional	TRIPs basic
EU Cambodia	Lao PDR Myanmar Singapore Indonesia	Vietnam, Thailand, Malaysia, India
No direct or indirect commercial use for product not complying with AO/GI requirements	No use	no use of GI only if misleads public as to origin: need to be proven

EU: direct use of the GI for non compliant product prohibited

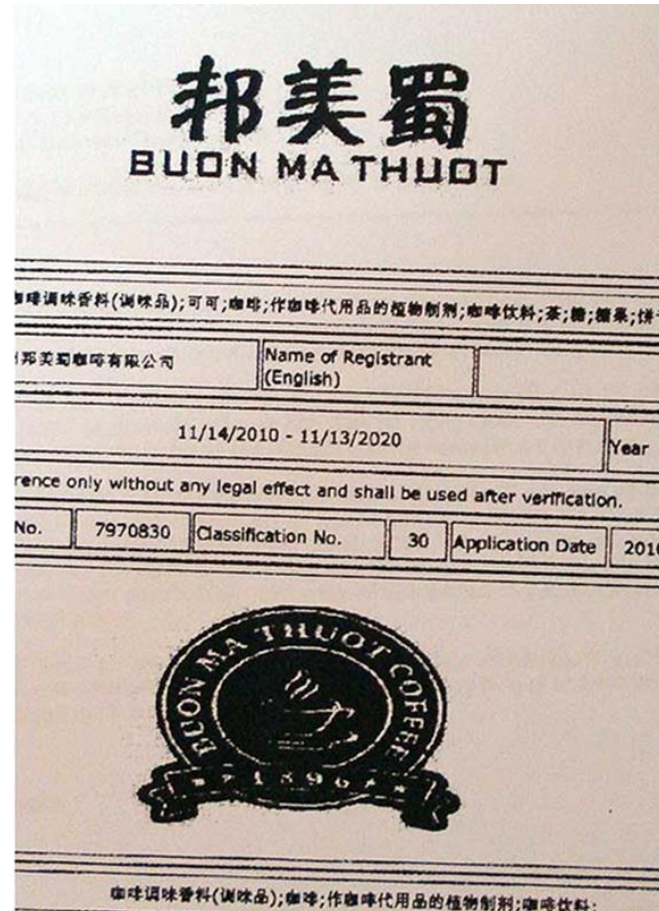
- **PDO Charolais**, a cheese
- Specification: milk production, cheese making and refining must be in the geographical area
- Case: the name Charolais was used for cheese refined outside the area = prohibited



D.Marie-Vivien 25 November 2020

Vietnam/China: direct use as a trademark of the GI prohibited

- GI in Vietnam
- Registered in 2005



- TM registered in China in 2010, cancelled following action of VN government

Thailand: direct use of the GI TRIPs basic protection



- FETA is a PDO (Greece) for cheese made out sheep milk
- Product sold in Thailand : basic protection (if GI registered)
- Need to demonstrate the misleading of consumers : as the true mention of origin Thailand is mentionned, not an easy task!

Imitation/evocation of GI

Lisbon System	TRIPs additional	TRIPs basic
EU Cambodia	Lao PDR, Myanmar Singapore, Indonesia	Vietnam, Thailand, Malaysia, India
No misuse, imitation, evocation		X
even if true origin is indicated, if in translation, if use of delocalisers: style, type, method, as produced in, imitation or similar		X

EU: Evocation of a GI



- Gorgonzola: PDO (Italy)



- Trademark Cambozola for other cheese
- EU prohibited
- case C-87/97 in the EU

Singapore : Imitation of a GI



- GI = Champagne
- Trade mark ChamPengWine for “Sparkling wines from Chile”
- Opposed by Comité Interprofessionnel du Vin de Champagne and Institut National de l’Origine et de la Qualité
- Rejected: copy of the GI + bad faith of TM applicant
- Ipos, 6 August 2020

Use of GI for Dissimilar Goods

Lisbon/Geneva		TRIPs additional	TRIPs basic
No use which exploits reputation	No use which indicate connection with AO/GI, damage interests, take unfair advantage of reputation; even if true origin is indicated, if in translation, if use of delocalisers: style, type, method, as produced in, imitation or similar	X	X

Direct use of GI in posterior trademark

Dissimilar goods



- GI « Darjeeling tea » (India, EU) + collective TM in EU
- TM Darjeeeling for woman underwear
- Tawain: prohibited (Supreme Administrative Court, December 8, 2011)
- EU accepted (because Tea Board based its action on the collective TM and not on the GI, C-673/15 P to C-676/15 P, CJEU)

Direct use of GI product as an ingredient

EU

All the protection of the GI is conferred even if the product is used as an ingredient.

But a complex issue...if the GI product used as an ingredient is not essential to the final product

Direct use of GI product as an ingredient



- Sorbet made of Champagne GI (12%), sold by Aldi
- But GI Champagne only for sparkling wine, not for sorbet
- If
 - legitimate interest in the use of the GI,
 - no exploitation of the reputation,
 - the taste imparted by that ingredient constitute the essential characteristic
 - the name of the GI can be used in the name of the foodstuff

ENFORCEMENT ACTORS & ACTIONS

Various actors and actions

	Control on the Market	Legal proceedings Civil/criminal	Surveillance of TM applications
Market controls authorities - customs	In the domestic and at borders - inspection Detention of goods	Send case to prosecutor	
IP/GI authorities	Send alert to market control authorities Provide IP expertise	Support plaintiff?	Examine trademarks, can reject on their own
GI users Management authority	Send alert to market control authorities	Lodge legal action	Oppose a TM application
Sanctions	Sanctions the fraudster no compensation to GI user	Sanctions of the fraudster + compensations to GI user	Refusal of registration of TM

Control on the market: EU

- In the EU by the State (ex officio, art.38, art.13.3):
 - carry out checks, based on a risk analysis,
 - shall take appropriate administrative and judicial steps to prevent or stop the unlawful use of the name of products that are produced or marketed in the State.
- Enforcement Database
 - For information exchange, the Observatory of the EUIPO has developed EDB for Customs and Police (i.e., borders and market controls)

EDB
Enforcement
Database



Control on the market: France

The General Directorate for Competition Policy, Consumer Affairs and Fraud Control DGCCRF

- checks carried out on products at all stages of marketing
 - producers, processors, importers, wholesalers, distributors and restaurateurs,
 - including on the internet
- Breaches
 - use of GI for non compliant product
 - lack of traceability documents
 - lack of use of EU PDO/PGI logo
- 2016-2017 :
 - 200 PDO / PGI (pasta, honey, oils, seafood, cheese, etc.),
 - including 40 from the EU or third countries (Switzerland, Norway, **Cambodia**, Colombia, India)
 - 2017 : twice more checks, and twice more sanctions than 2016



Control on the market: Vietnam

- Five IPR enforcement bodies:
 - National Steering Committee 389 for fighting against smuggling, commercial frauds and counterfeit goods;
 - Inspectorate of Ministry of Science and Technology;
 - Market Surveillance Agency and Units, Ministry of Industry and Trade;
 - Anti-smuggling investigation department, Customs, Ministry of Finance;
 - Economic Police Department, Ministry of Public Security
- Coordinate with National office of IP
 - To clarify what is protected
 - NOIP also rejects trademarks infringing GIs, ex of GLENSILVER'S for alcoholic beverages, connected with Scotland and Scotch Whisky



Control on the market: Cambodia

- Specific action for Kampot pepper:
Committee of Infringement of Kampot pepper in the domestic market
 - Directorial General Dept of Consumer Protection and Fraud Repression
 - Economic Police (Mol)
 - Provincial Dpt of Commerce
 - DIP, MoC

The image shows a formal registration document for the 'Kampot Pepper' Geographical Indication (GI) in Cambodia. The document is issued by the Ministry of Commerce (MoC) and the Department of Intellectual Property Rights. It includes the following details:

- Kingdom of Cambodia / ព្រះរាជាណាចក្រកម្ពុជា**
- Ministry of Commerce / ក្រសួងពាណិជ្ជកម្ម**
- Nation Religion King / ជាតិ សាសនា ព្រះមហាក្សត្រ**
- Department of Intellectual Property Rights / វិស័យកម្មសិទ្ធិបញ្ញា**
- Registration No: KH/GI/00001/10**
- Date Registered: 02 APR 2010**
- Principal Register / បញ្ជីដើម**
- Geographical Indication Name: Kampot Pepper**
- Application No: KH/GI/00001/09**
- Filing Date: 21-10-2009**
- Class/Goods: 30-Pepper**
- Applicant: Kampot Pepper Promotion Association**
- Address: Angkor Chey I Village, Dammak Kantiut, Khang Tboung Commune, Kampong Trach District, Kampot Province**
- Registered for a term of 10 (ten) years from 21-10-2009 to 21-10-2019**
- Examiner: VAR ROTH SAN**
- Agent for service: Angkor Chey I Village, Dammak Kantiut, Khang Tboung Commune, Kampong Trach District, Kampot Province**
- Signature: CHAM PRASIDH**
- Seal: National Geographical Indication Logo**

Control on the market : Singapore

- Controls at the borders: GI Act 2014 (art 56.1) > EU-Singapore FTA



- Request to Customs to detain suspected infringing goods which are to be imported or exported from Singapore by:
 - Producers, associations of producers
 - Traders, associations of traders.

CHALLENGES & RECOMMENDATIONS

Expertise of enforcement authorities awareness of GI holders



- Limited awareness of right holders and consumers about infringement
- Limited willingness of IPR holders to fight against counterfeits not to damage their reputation
- Limited expertise and resources of enforcement agencies, of judicial courts : need of training
 - Ex Vietnam: Champagne CIVC trained customs officers and officers from the Market Surveillance Agency to understand better about the authentic product.



Clarity & information of object of protection

- Enforcement authorities need to know what to control:
 - GI Specification: should be written very clearly
 - Lamphun Brocade Thai Silk, not very clear which steps of production are mandatory in the area: only weaving or sericulture?

- Create an enforcement database?
 - At national and Asean level (update the Asean GI database)
 - name of the GI and labelling rules
 - contact of right holders
 - pictures of the product and the authorised labelling?
 - level of protection in each country



Sanctions

- Administrative action
 - cost-effective and time-efficient for IPR holders but with penalties not as severe as those available in civil litigation or criminal prosecution
- Limited number of infringement cases handled by courts
 - too expensive, long duration of litigation process, unpredictable outcome, difficulty in proving and calculating actual damages



Conclusions

- Very important to fight against frauds to protect the reputation:
 - include enforcement in the ASEAN IPR Action Plan ?
 - Any objective of an homogeneous level of protection in Asean?
- Controls should not only focus on products bearing the product logo or national GI logo but also using the GI name
 - otherwise the mere concept of GI is disappearing
- Role of the State agencies:
 - importance of coordination at national, regional and international level
- Cooperation with the GI right holders :
 - importance of a collective management organisation for the defence of the GI



Thank you

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In memory of Quyen Dao, lecturer at FTU, Hanoi