

IP Key América Latina

Conferencia regional de Centroamérica sobre Indicaciones Geográficas

*** * ***

Control y observancia de los derechos de las indicaciones geográficas

La experiencia de la DOP “PARMIGIANO REGGIANO”

27 September 2022



**Giorgio Bocedi
GB Avvocati**

PLAN

- I. Parmigiano Reggiano: Designation of Origin
- II. Parmigiano Reggiano: protection outside the EU
- III. The Consorzio del Formaggio Parmigiano-Reggiano
- IV. Practical cases
- V. Importance of GI protection in the EU
- VI. Conclusions



I. Parmigiano Reggiano: Designation of Origin

The link with the area of origin:
the necessary core of all its history



I. Parmigiano Reggiano: Designation of Origin

Eight centuries of nobility

- It is made (not just manufactured) exactly as eight centuries ago:
 - in the same places
 - with the same, natural ingredients (cow's raw milk, calf rennet and salt)
 - with the same traditional process



I. Parmigiano Reggiano: Designation of Origin

<Parmigiano Reggiano> in figures (2021)

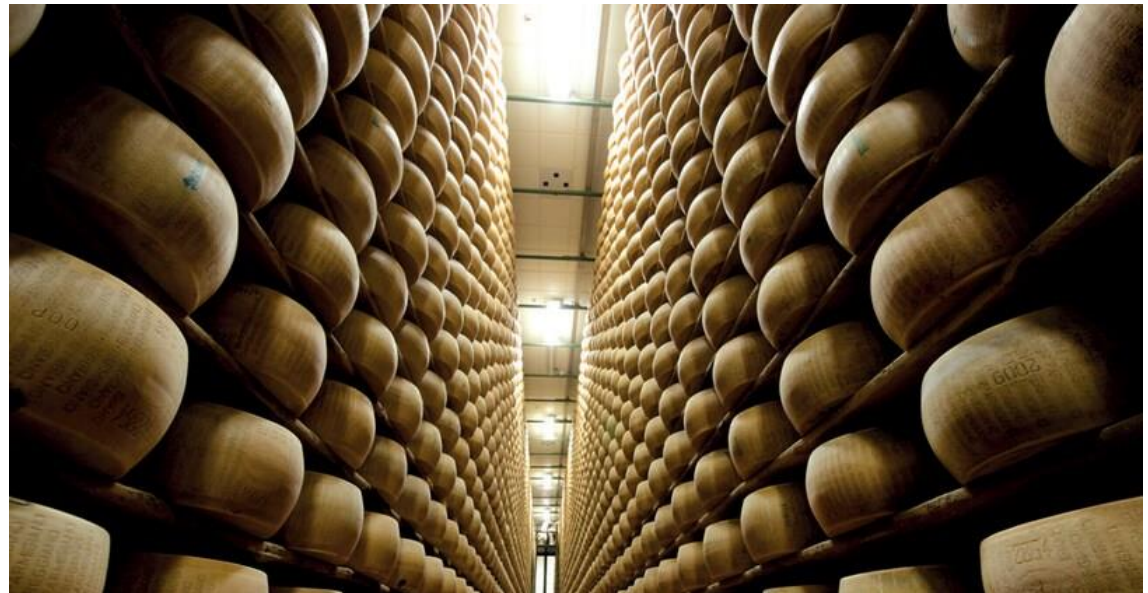
- 272,000 cows producing milk for Parmigiano Reggiano
- **2,373 milk producers**
- **310 cheese dairies**
- **50,000 workers in the production chain**
- 13.5 litres of milk to make 1 kg of Parmigiano Reggiano
- 520 litres to make one wheel
- **0 food additives**
- 39.9 Kg: average weight of a wheel
- 12 months: minimum maturation period
- 20-24 months: average maturation period
- 4,091,144: wheels produced
- 1,71 billions € (production) turnover
- **2,7 billions € (consumption) turnover**
- **export: 45% (+2,9% 2020)**



I. Parmigiano Reggiano: Designation of Origin

Year	Parmigiano Reggiano PDO: production in tons
2017	147.125
2018	144.020
2019	144.738
2020	157.481
2021	163.647

Year	Parmigiano Reggiano PDO: export in tons
2017	46.477
2018	49.274
2019	53.204
2020	60.657
2021	62.429



I. Parmigiano Reggiano: Designation of Origin

- **Italy**

- D.P.R. 30 October 1955, n. 1269

- **European Union**

- **Regulation (EU) No 1151/2012 of the European Parliament and of the Council 21 November 2012 on quality schemes for agricultural products and foodstuff** (replacing Council Regulation (EC) No 510/06, of 20 March 2006 [which has replaced Council Regulation (EEC) No 2081/92], on the protection of geographical indications and designations of origin for agricultural products and foodstuff)
- **<Parmigiano Reggiano> is a Protected Designation of Origin (PDO) for “Cheeses” within the European Union by virtue of the Regulation (EU) No 1151/12, as registered for ‘cheeses’ through Commission Regulation (EC) No 1107/96 of 12 June 1996**

I. Parmigiano Reggiano: Designation of Origin

- **European Union protection**

- Case C-132/05

European Commission vs Federal Republic of Germany

ECJ (Grand Chamber), Judgment of 26 February 2008, par. 48/49:

“That proximity and the phonetic and visual similarities referred to in paragraph 46 above are such as to bring to the mind of the consumer the cheese protected by the PDO ‘Parmigiano Reggiano’, when he is confronted by a hard cheese, grated or intended to be grated, bearing the name ‘Parmesan’.

In those circumstances, the use of the name ‘Parmesan’ must be regarded, in the sense of Article 13(1)(b) of Regulation No 2081/92, as an evocation of the PDO ‘Parmigiano Reggiano’

II. Parmigiano Reggiano: protection outside the EU

- **International legal framework for the protection of Geographical Indications**
 - Paris Convention for the Protection of Industrial Property of 20 March **1883**
 - ❑ art. 1.2
 - International Convention on the Use of Appellations of Origin and Denominations of Cheeses (Stresa Convention) of 1 June **1951**
 - ❑ 4 countries: Italy, Switzerland, France, The Netherlands
 - Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of October 31, **1958**
 - ❑ **Parmigiano Reggiano** registered on 23 December **1969**
 - ❑ 30 contracting parties (Italy, France, **Costa Rica, Cuba, Haiti, Mexico, Nicaragua, Peru**, etc.)
 - Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPs) of 15 April **1994**
 - Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications, adopted **May 20, 2015**, entered into force on **February 26, 2020**
 - ❑ 14 contracting parties (EU, Peru from 18 October 2022, etc.)

II. Parmigiano Reggiano: protection outside the EU

i) Registration of GIs in third countries having “*sui generis*” system to register and protect GIs

Possibility for GIs groups of submitting applications for the registration of GIs in third countries where there is a GI “*sui generis*” system of protection

- ❑ Countries where ‘**Parmigiano Reggiano**’ is registered as a DO: Chile, Norway, Turkey, Singapore, Mongolia, Belarus, etc.
- **Chile:** DENOMINACIÓN DE ORIGEN **PARMIGIANO REGGIANO** – n. 1306008 (Decision of 14 August 2019)

ii) Registration of collective marks or certification marks in third countries

Possibility for GIs groups of seeking protection of GIs via registration of collective marks or certification marks in third countries

- ❑ e.g.: Countries where ‘**Parmigiano Reggiano**’ is registered as certification mark or collective mark: El Salvador, Bolivia, etc.
- El Salvador, 25 November 2016  certification mark (Reg. No 180 Book 295)
- Bolivia, 13 June 2013:  collective mark (Reg. No 144217-C)

II. Parmigiano Reggiano: protection outside the EU

(iii) FTAs between EU and third countries or Communities including GIs protection (over the last years)

➤ In force or provisionally applied

e.g.:

❑ **Association Agreement between the European Union and Central America (Costa Rica, El Salvador, Guatemala, Honduras, Nicaragua, Panama)**

- ❖ Provisionally applied since 01/08/2013 (Honduras, Nicaragua, Panama) - 01/10/2013 (Costa Rica, El Salvador) – 01/12/2013 (Guatemala)
- ❖ Decision No 5/2014 of the EU-Central America Association Council of 7 November 2014 on the geographical indications to be included in Annex XVIII of the Agreement (in force since 05/08/2015)
- ❖ Among others, <**Parmigiano Reggiano**> is recognized and protected as Geographical Indication (GI) of the EU under the Agreement in all Central America countries

❑ Colombia, Perù and Ecuador; Canada; Japan; China; South Africa, etc.

➤ Agreements concluded “in principle”

e.g.: **Mexico** (21/04/2018), **Mercosur**, New Zealand, etc.

➤ Under negotiations

e.g.: Chile, Australia, etc.

III. The 'Consorzio del Formaggio Parmigiano-Reggiano'

- Created in 1934
- Voluntary non-for-profit body in charge of the defense, promotion and safeguarding of the Protected Designation of Origin Parmigiano Reggiano
- Recognized by the Italian Ministry of agricultural, food and forestry policies
- The following entities may become members of the Consorzio, provided that they are established within the area of origin:
 - **farmers** producing milk for the production of Parmigiano Reggiano;
 - **diaries** producing Parmigiano Reggiano (currently, **100%** is member of the Consorzio);
 - **operators** maturing Parmigiano Reggiano holding the product till the end of the minimum maturation period and operators engaged in the portioning and/or grating and packaging of cheese bearing the name Parmigiano Reggiano

<https://www.parmigianoreggiano.com/it/>

IV. Practical cases

Mexico

- Mexico (Lisbon Union Member)

Usurpation and imitation, even if the appellation is used in translated form (cheese made in Germany and then exported to Mexico; labeled in Mexico)



IV. Practical cases

Mexico

MIPO, Decision of 23 February 2009

Preliminary injunctions concerning the infringement of the Appellation of Origin 'Parmigiano Reggiano' cannot be granted because of art. 229 IP Law

- Administrative law-suit brought by the Consorzio
- Judgment of the Administrative Court: refusal
- Administrative appeal law-suit brought by the Consorzio
- Administrative Court of Mexico City, Judgment 28 September 2009
- National Justice Supreme Court, Judgment 24 March 2010: art. 229 IP Law is not applicable to Designations of Origin protected in Mexico under the Lisbon Agreement

IV. Practical cases

Mexico

- The Consorzio del Formaggio Parmigiano-Reggiano has filed an **opposition** against the trademark application filed by a Spanish company for registration of the trademark 'NOCHEHBUENA DELI QUESO **PARMESANO**' [- The Mexican Trademark Office has issued a **Provisional Refusal** of the trademark application on 13 July 2020 on the basis of the following grounds:
 - the term **PARMESANO** part of the opposed trademark is the **translation of the Designation of Origin 'PARMIGIANO REGGIANO'** protected in Mexico through the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of October 31, 1958;
 - there is a **risk of confusion** between the trademark 'NOCHEHBUENA DELI QUESO PARMESANO' [earlier n. 4 trademarks of Consorzio.
- The applicant filed its observations against the Provisional Refusal of the Mexican Trademark Office on 5 October 2020.
- The Mexican Trademark Office issued a **Final Refusal** of the trademark application on 5 April 2021


IV. Practical cases

Mexico

- The Consorzio del Formaggio Parmigiano-Reggiano filed **oppositions** against two trademark applications filed by a Mexican company for registration of the following trademarks in class 29 (goods “quesos”) in Mexico on 8 February 2021:
 - ❖ ‘XXXXXXXXXX XX **PARMESANO**’ (figurative)
 - ❖ ‘XXXXXXXXXX **PARMESANA**’ (figurative)
- The Mexican Trademark Office issued **Provisional Refusals** of the trademark applications on 7 June 2021 on the basis of the following grounds:
 - the opposed trademarks reproduce the **Designation of Origin ‘PARMIGIANO REGGIANO’** protected in Mexico through the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of October 31, 1958;
 - there is a **conflict** between the opposed trademarks and the **earlier n. 5 trademarks of Consorzio**.

IV. Practical cases


El Salvador

- The Consorzio del Formaggio Parmigiano-Reggiano submitted an **opposition** against the trademark application filed by a company of Guatemala for registration of the trademark  in class 29 (goods “productos lácteos”) in El Salvador on 25 August 2009, published on May 2019
- The Trademark Office of El Salvador has issued a **Resolution** on **10 March 2020** which grants the opposition on the basis of the following ground:

I. ACOGESE la oposición presentada por CONZORCIO DEL FORMAGGIO PARMIGIANO REGGIANO a través de la abogado [REDACTED] por considerar que en el público consumidor se generaría confusión o riesgo de asociación con respecto a la Denominación de Origen notoria y marcas de certificación PARMIGIANO REGGIANO, en cuanto al origen o procedencia de los productos a amparar con la marca solicitada, pues a pesar de la diferencia gráfica y fonética con respecto a las anterioridades registradas, la incorporación del término PARMA en la marca solicitada, sugiere que los productos lácteos provienen de Parma, Italia, área geográfica reconocida por la fabricación de quesos (producto lácteo).
- The applicant appealed the Trademark Office Decision and the Consorzio filed its reply
- Pending resolution before the Board of Appeals

IV. Practical cases

El Salvador

- The Consorzio del Formaggio Parmigiano-Reggiano submitted an **opposition** against the trademark application filed by a company of El Salvador for registration of the trademark  in class 30 (goods “Salsa sabor ajo con queso parmesano para acompañar (pero no unicamente) alas de pollo frito y medallones de pollo empanizado”) in El Salvador on 24 June 2021
- The Trademark Office of El Salvador issued a **Resolution** on **19 July 2022** which grants the opposition on the basis of the following ground:

I. ACOGESE la oposición presentada por CONZORCIO DEL FORMAGGIO PARMIGIANO REGGIANO a través de la abogado [REDACTED] por considerar que en el público consumidor se generaría confusión o riesgo de asociación con respecto a la Denominación de Origen notoria y marcas de certificación PARMIGIANO REGGIANO, en cuanto al origen o procedencia de los productos a amparar con la marca solicitada, pues a pesar de la diferencia gráfica y fonética con respecto a las anterioridades registradas, la incorporación del término PARM en la marca solicitada, sugiere que los productos provienen de Parma, Italia, área geográfica reconocida por la fabricación de quesos (producto lácteo).

IV. Practical cases

Panama

- The Consorzio del Formaggio Parmigiano-Reggiano submitted an **opposition** before the competent Court against the trademark application filed by a US company for registration of the trademark '**PARMESAN XXXX**' (figurative) in class 29 (goods "queso") in Panama on 29 December 2020
- Hearing on 9 August 2022
- Pending decision

IV. Practical cases

Oppositions against trademark application “XXXXX PARMESAN CHEESE”

The Consorzio del Formaggio Parmigiano-Reggiano submitted **oppositions** against several trademark applications filed by a US company in 2019 for registration of the word mark ‘XXXXX **PARMESAN** CHEESE’ in Class 29 in the following Countries:

➤ Ecuador

- The Trademark Office of Ecuador issued on 15 February 2022 a **Decision** which grants the opposition on the basis, among others, of the following ground:

el signo solicitado le evoca al consumidor medio de forma directa la idea de la denominación de origen, encontrándose en el signo solicitado incluido íntegramente la denominación de origen “**Parmigiano Reggiano**”, siendo susceptible de causar un riesgo de confusión o de asociación con la denominación de origen señalada.

➤ Uruguay

➤ Argentina

➤ Paraguay

➤ Chile

V. Importance of GI protection in the EU

- **In a nutshell...EU GIs system**

- “... *is intended, inter alia, to meet consumers’ expectations as regards products of quality and an identifiable geographical origin and to enable producers, in conditions of fair competition, to secure higher incomes in return for a genuine effort to improve quality*” (ECJ, 8 September 2009, Case C 478/07, point 109)
- GIs producers as a “community”, in condition of fair competition
- Protection against «evocation» (ECJ, 8 September 2009, Case C 478/07, 109)
 - ❑ the image triggered directly in his mind (of the average European consumer) is that of the product whose geographical indication is protected
 - ❑ beyond the likelihood of confusion (ECJ, 4 March 1999, Case C-87/97, 26)
 - ❑ it does not require, as a prerequisite, a similarity between the products concerned (ECJ, 9 September 2021, Case C-783/19, 61)
- Private and/or public enforcement (obligation of EU Member States)

VI. Conclusions

- **Protection of the GI name in third countries**

- Great importance of protection of the name as a GI in other countries
 - ❑ through FTA Agreements
 - ❑ through “*sui generis*” registration system
 - ❑ through Lisbon Agreement or Geneva Act
- Great importance of “groups” of producers

MUCHAS GRACIAS!