



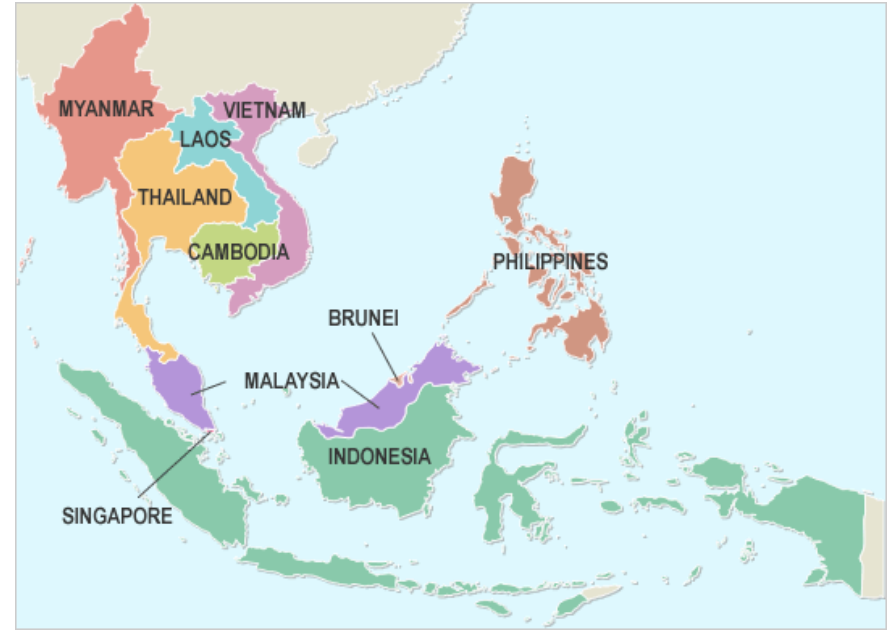
Strategies for protecting and enforcing GIs in ASEAN and EU through cases study

Fabrice Mattei, partner, consultant to WIPO on GI.

ASEAN ECONOMIC COMMUNITY

AEC community & ASEAN IP Framework 2011-15

- ASEAN single market integration
- Localization of cars, parts and suppliers in AEC
 - Employees' invention benefits
 - Local innovation enhancement
 - Protection of natural resources
 - Merger and acquisition
 - Local creativity
- Streamlining IP examination and granting procedure
- Awareness and use of regional and multilateral treaties to protect patents and designs
- Prosecution highways (ASPEC, PPH) increases
- TTPA draft Agreement (Agricultural Chapter)



enforcement

Awareness, education & research

LOCALIZATION OF PRODUCTION				SAFETY OF GOODS		QUALITY OF GOODS	
AEC's innovation		AEC's branding		1 AEC market = 1 AEC's safety standard		AEC's competitiveness	
Manufacturer position	AEC's opportunities	manufacturer position	AEC's opportunities	Manufacturer position	AEC's opportunities	Manufacturer position	AEC's opportunities

PROTECTION OF ASEAN GI IN EU

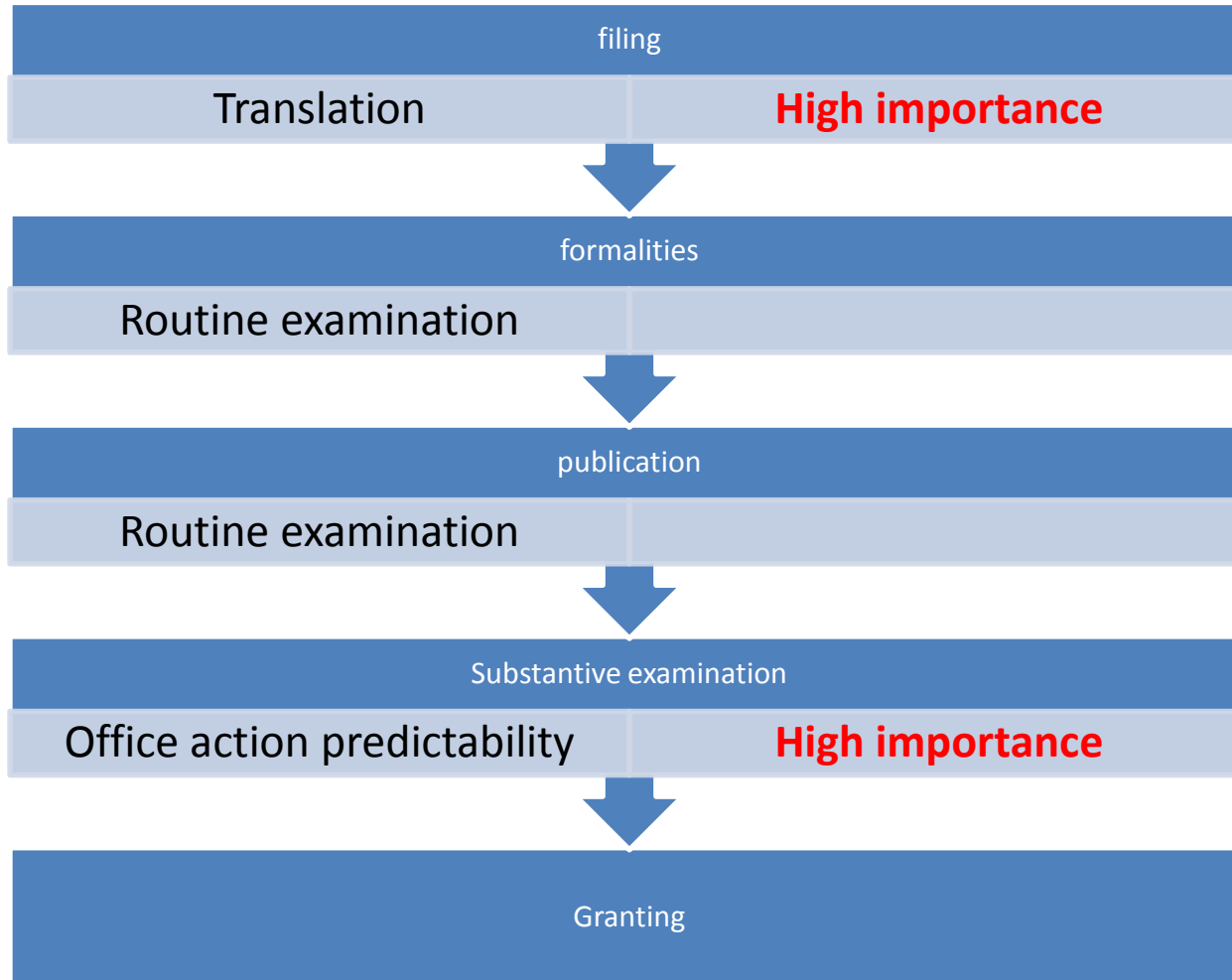
How ? Why? How long? How much? Who to contact?

- Simple and straightforward procedure
- Relatively inexpensive
- Already some ASEAN GIs have registered successfully in EU
- Provide protection in all EU Member States
- No requirements for "nationalization" of the GI in each EU member states
- "One Stop Filing"
- Two filing routes
- No requirement for renewal unlike in some ASEAN countries (e.g. Malaysia)



Anatomy of GI prosecution : risk assessment and required skills

GI PROSECUTION ANATOMY



Deadlines



RECENT LEGAL CHANGES

Recent legal changes in EU which impact the protection of Geographical Indications

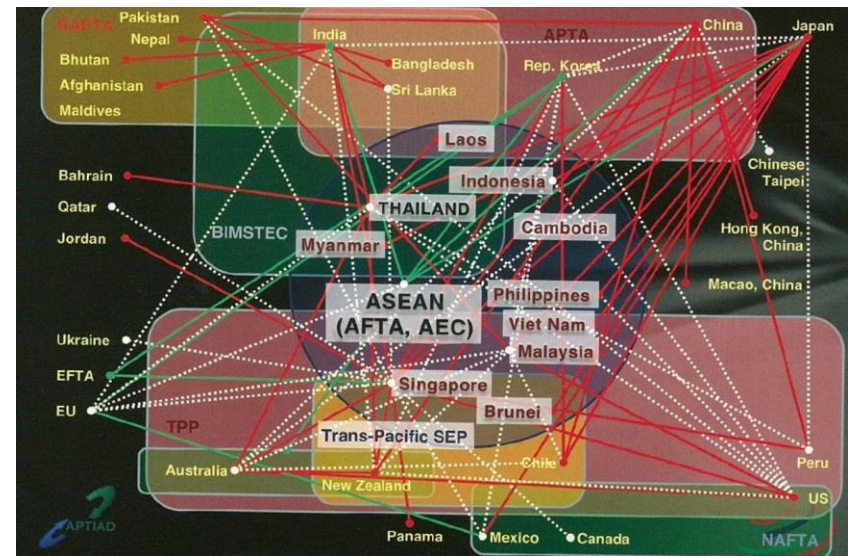
- EU Regulations **509 & 510/2006**
- EU Regulation **1151/2012** on Quality Schemes for agricultural products and foodstuff + implementing rules (EU) nos. **664/2014** of 18 December 2013, **665/2013** of March 11, 2014 and **668/2014** of 13 June 2014
 - *Faster registration procedures, the period for objections is reduced from six to three months.*
 - *The rules on controls are clarified.*
 - *Creation of a legal basis for inserting third country GI protected products through bilateral agreements into the EU register.*
 - *Creation of a legal basis for financing the defense of the EU logos.*
 - *The role of producer groups is better recognized.*
 - *Amendment procedure is clarified .*

The main change is the definition of PGI which has been modified to read as follows: “‘geographical indication’ is a name which identifies a product ... whose given quality, reputation or other characteristics is essentially attributable to its geographical origin”. The word “essentially” was not present in the previous legislation, raising a question as to whether the Regulation intends to loosen the required link between PGI and geographical origin?

FILING ROUTES

Questionable recognition of non EU Member States' originating PGI and PDO through bilateral agreements with EU

- legal basis for inserting third countries' PGI and PDO through bilateral agreements with the EU into the EU Geographical Indication registry.
- Article 11(2) provides that “Geographical indications pertaining to products of third countries that are protected in the Union under an international agreement to which the Union is a contracting party may be entered onto the register.



The informal system for objections to the protection in the EU of third country GIs under Article 11(2) seems **questionable**.

The Commission, on the basis of informal practice, simply publishes in the Official Journal a list of the PGI and/or PDO, which have been included in the annexes of a concluded international agreement, and gives objectors two months to raise objections as to why they should not be protected in the EU. Up to now there has been no legal basis for this objection procedure, making the protection of third country GIs based on bilateral agreements **legally weak**.

PRODUCERS' GROUP

The role of producers' group as applicant is finally fully recognised.

- The Regulation provides producer organisations and inter-branch organisations with a number of rights, including the **right to enforce** a PGI, PDO or TSG before national courts. This formalises the position reached by the Court of Justice of the European Union, which first recognised these organisations' role in **enforcing European quality regimes**.
- Article 3 (2) of the Regulation 'group' means any association, **irrespective of its legal form**, mainly composed of producers or processors working with the same product. Chapter II, Section 1, Article 122 also refers to "producer organization". The addition of "irrespective of its legal form" is particularly relevant many producers' groups are **not incorporated as a legal entity**.



CASES STUDY

**Disclaimer & generic term;
Packaging in the defined GI area;
Formats.**

- Disclaimer?
 - Announcement by the GI holder that it does not have an exclusive right for the use of any portion of that GI.
 - Example "**Coffee** Of Indonesia"
- **Khao Hom Mali** Thung Kula Rong Hai
 - 1st ASEAN GI filed in EU under 510/2006

Critical to resist to disclaimer when we see reasons to claim exclusive rights in key terms/expressions which compose the geographical indication name.

PACKAGED FOOD VS. BULK

Packaging in the defined geographical indication area

- Product Specification & Single Document : labeling & packaging
- Whether it is necessary that goods produced in the defined geographical indication area are also packaged in the same area?
- EU Treaty Articles 29 & 30 deal with quantitative restrictions to the circulation of goods and services.

- Rioja case (C 388/95) Parma case (C 108/01), Grana Padano case (C 469/00)
- "Integral part to the quality and characteristics of the product" ... "integral to the organoleptic characteristics of the product".
- Rioja case - ECJ "compatible with community laws despite its restrictive effects on trade if it is shown that it is necessary and proportionate and capable of protecting the reputation associated with the region" "transportation is a factor that can affect the quality..." "prevent the wine from being exposed to deteriorating factors, packaging or bottling does not involve merely filling empty bottles but entails before filling complex oenological operations (filtering, clarifying etc).
- PGI vs. PDO
- Rice:
 - Riz de Camargue
 - Arroz Carolino Das Lezirias Ribatejanas (2007/C 258/08)

- Clearly explain the risk of contamination/alteration, protects aroma/flavor "when plain boiled it smells

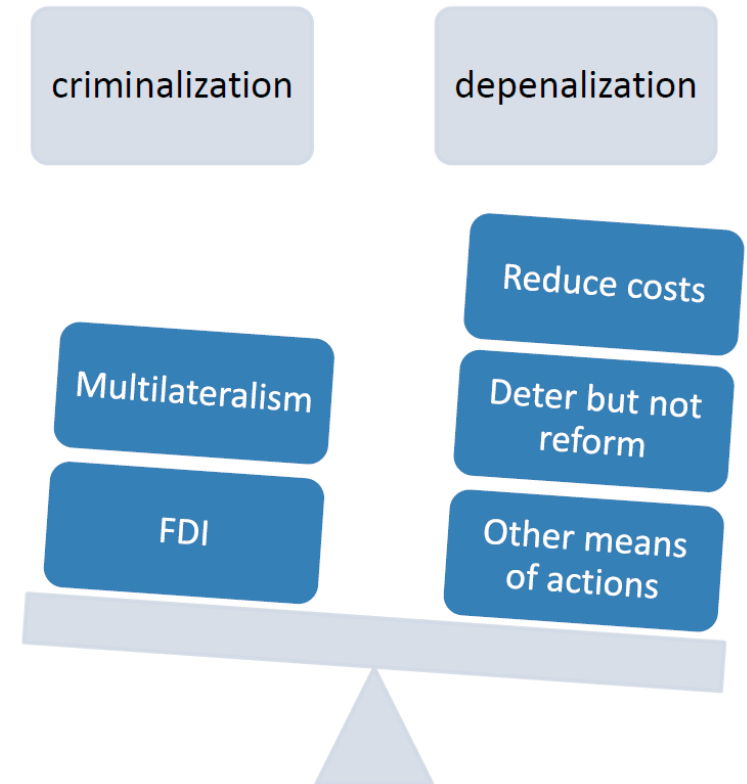
ENFORCEMENT

- Any **direct** or **indirect commercial** use of a registered GI in respect of products not covered by the registration where those products are **comparable** to the products registered under that name or where using the name **exploits the reputation of the protected name**, including when those products are used as an **ingredient**.
- Any misuse, imitation or **evocation**, even if the true origin of the products or services 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, including when those products are used as an ingredient.
- Any other false or misleading indication as to the provenance, origin, nature or **essential qualities** of the product that is used 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.
- Where a PDO or PGI contains within it the name of a product which is considered to be generic, **the use of that generic name is not to be considered contrary to the Regulation**.

ENFORCEMENT IN ASIA

Depenalization of IPRs - Impact on the enforcement of GIs

- VIETNAM
- THAILAND
- MYANMAR



VIETNAM

GI system

Recordation procedure

Criminal, civil and administrative remedies

Article 157 of the Vietnam Penal Code provides: “Manufacturing and/or trading in **fake goods being food, foodstuffs**, curative medicines, preventive medicines:

1. Those who produce and/or trade in fake goods being food, foodstuffs, curative medicines, preventive medicines shall be sentenced to **between two and seven years of imprisonment**.
2. Committing the crime in one of the following circumstances, the offenders shall be sentenced to between five and twelve years of imprisonment:
 - (a) In an organized manner;
 - (b) In a professional manner;
 - (c) Dangerous recidivism;
 - (d) Abusing positions and/or power;
 - (e) Abusing the names of agencies or organizations;
 - (f) Causing serious consequences.
- (3) Committing the crime, which results in **very serious consequences**, the offenders shall be sentenced to between twelve and twenty years of imprisonment.
- (4) Committing the crime, which results in particularly serious consequences, the offenders shall be sentenced to **twenty years** of imprisonment, life imprisonment or capital punishment.
- (5) The offenders may also be subjects to a fine of between five million dong and fifty million dong, the confiscation of part or whole of property, a ban from holding certain posts, practicing certain occupations or doing certain jobs for one to five years.”

THAILAND

GI system

Recordation procedure

Criminal & civil remedies



MYANMAR

No GI system

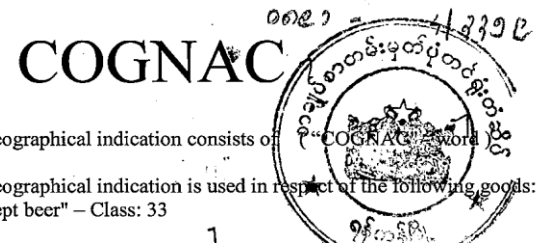
No Recordation procedure

Criminal and civil remedies

DECLARATION OF OWNERSHIP OF TRADEMARK / GEOGRAPHICAL INDICATION

I, *Catherine Le Page* (name of Officer)
Principal Officer of the **Bureau National Interprofessionnel Du Cognac** (name of Company)
a Company incorporated in **France** (name of Country)
carrying on business as **Interprofessionnal body representing all the producers and
trade houses of the geographical indication Cognac in respect of French law** (type of Business)
and having its principal office at **23 allées Bernard Guionnet - BP 18 - 16101**
..... **Cognac Cedex, France** (address)
(hereinafter referred to as "the Company") do solemnly and sincerely declare as follows: ↴

(1) That the Company is the Owner and Sole Proprietor of the trademark/ geographical indication
of which the following is representation: -



(2) That the said trademark/ geographical indication consists of
(3) That the said trademark/ geographical indication is used in respect of the following goods:
"Alcoholic beverages, except beer" – Class: 33

Geographical Indication CAUTION

NOTICE is hereby given that **Bureau National Interprofessionnel Du Cognac** a company organized under the laws of France and having its principal office at 23 allées Bernard Guionnet - BP 18 - 16101 Cognac Cedex, France is the owner and sole proprietor of the following geographical indication:-

COGNAC

(Reg: No. IV/3359/2013)

in respect of :- "Wine Spirit"- Class: 33

Any fraudulent imitation or unauthorized use of the said geographical indication or other infringements whatsoever will be dealt with according to law.

MYANMAR

NOTICE is hereby given that **Comité Interprofessionnel du Vin de Champagne (CIVC)** a legal entity under the laws of France and having its principal office at 5 rue Henri Martin, Epernay Cedex, France is the Owner and Sole Proprietor of the following trademark:-

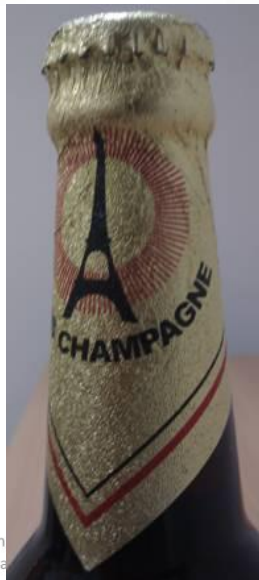
CHAMPAGNE

(Reg: No. IV/13428/2012)

in respect of:-

“Sparkling wines, alcoholic beverages” – Class: 33

Any fraudulent imitation or unauthorized use of the said trademark or other infringements whatsoever will be dealt with according to law.



China | Hong Kong
United Kingdom | Vietnam

Philippines | Russia |
e

*“Quality is not an
act, it is a habit.”*
- Aristotle -





Thank You!

Fabrice Mattei

Executive

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Offices in the Rouse Group: Australia* | China | Hong Kong | India+ | Indonesia | Myanmar | Philippines | Russia | Saudi Arabia+ | Thailand | UAE | United Kingdom | Vietnam | * Liaison office | + Associated office