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Location Matters.

Understanding geographical indications and other indicators of origin in a Canadian context.

Speakers: Ekaterina Tsimberis, Olivier Jean-Lévesque

September 16, 2021

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Our Speakers



Ekaterina Tsimberis

Partner,
Barrister & Solicitor
Trademark Agent

- **Litigation Star in IP**
Benchmark Litigation 2020-21
- **Best Lawyers in IP : Best Lawyers**
2018-22
- **Co-author**
"Global Wine Law – An AIDV Guide:
Canadian chapter", Feb. 2021
- **Founding member**
Canadian chapter of AIDV (International
Association of Lawyers for Vine and
Wine Law)
- **Board member**
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Olivier Jean-Lévesque

Associate,
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Trademark Agent

- **Co-author**
"Global Wine Law – An AIDV
Guide: Canadian chapter", Feb.
2021

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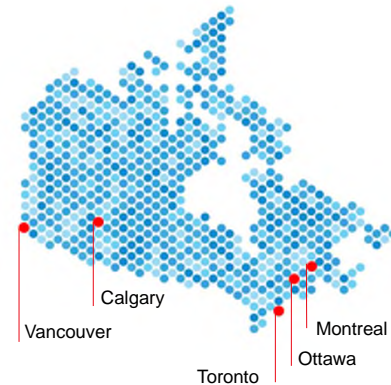
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Who we are

Canada's **leading IP law firm**

- Expertise in all areas of IP (including geographical indications)
- 130+ years serving clients
- 100+ lawyers, agents and technical consultants
- 8,000+ patents & trademarks filed annually



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Top ranked for trademarks & enforcement

- **Canada's IP Litigation Firm of the Year**
Benchmark Litigation
seven years in a row 2015-2021
- **Canada's Trademark Contentious Firm of the Year**
Managing IP – Americas Awards
Awarded in 2014-2017, 2020
- **Canada's IP Boutique Firm of the Year**
Managing IP – Americas Awards
Awarded in 2014, 2016, 2020 & 2021
- **Tier One for Trademarks Contentious & Prosecution**
Managing IP – IP Stars
since inception 2014-2021
- **Gold Tier for Trademarks & 12 leading trademark practitioners**
World Trademark Review 1000
since inception 2011-2021
- **Band 1 for IP in Canada**
Chambers & Partners
Global and Canada Guides, since inception 2010-2021

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Geographical Indications in Canada

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What is a geographical indication?

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A specific territory...



©: Comité Interprofessionnel du Vin de Champagne

...where a unique wine/spirit/agricultural product/food is produced...



...a quality, reputation or other characteristic of which is attributable to its geographical origin.



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Considerations for GI owners vs Brand owners

- How can **GI owners** protect this IP in Canada?
- What should **brand owners** know to avoid misusing others' GIs?



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How can **GI owners**
protect this IP in Canada?

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« Common law » GIs

Geographical Indication (Unregistered)

- means an indication that identifies a wine, spirit, agricultural product or food (...) if a quality, reputation or other characteristic of the wine or spirit or the agricultural product or food is essentially attributable to its geographical origin;

Protected Geographical Indication (Registered)

- means a geographical indication that is on the list kept pursuant to subsection 11.12(1);

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Enforcing an unregistered GI

- **12 (1)** Subject to subsection (2), a trademark is registrable **if it is not:**
 - **(b)** whether depicted, written or sounded, either **clearly descriptive or deceptively misdescriptive** in the English or French language of the character or quality of the goods or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or **of their place of origin**

Trademarks Act, R.S.C., 1985, c. T-13

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Enforcing an unregistered GI

- 7. No person shall
 - c) **pass off** other goods or services as and for those ordered or requested; or
 - d) **make use**, in association with goods or services, of any **description that is false in a material respect and likely to mislead the public** as to
 - i. the character, quality, quantity or composition,
 - ii. the geographical origin, or
 - iii. the mode of the manufacture, production or performance of the goods or services.
- The test for **passing off**:
 - Goodwill
 - Misrepresentation
 - Damages

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Protected GIs

Both local and foreign geographical indications can be entered onto the list of GIs by submitting a request to the Canadian Intellectual Property Office.

Example:
OKANAGAN VALLEY (no.1416990);
BORDEAUX (no. 1431142)

Foreign GIs can also enter on the list through bilateral or multilateral treaties.

Example:
PIMENT D'ESPELETTE
(no. 1858634)

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How to get a protected GI

1. Submission of Request through CIPO
2. Review of Request
3. Publication
4. Objection Proceeding(s)
5. Entry on the List

Bordeaux — 1431142

Application number
1431142

Type(s)
Word

Category
Geographical Indication

CIPO status
ENTERED ON THE LIST

Registered
2009-11-09

Responsible Authority
Institut National des
Appellations d'Origine (INAO)
Etablissement public, 135
avenue des Champs-Élysées
75008 PARIS FRANCE

Index headings
BORDEAUX

Goods
(1) Wine

GI territory description

The localities in which the wine originates are the following
communes of France: Abzac, Aillas, Ambares-et-Lagrave, Ambes,
Anglade, Arbanats, Arbis, Arcins, Arsac, Les Artigues-de-Lussac,
Artigues-Près-Bordeaux, Arveyres, Asques, Aubiac, Aubie-et-
Espisat, Autolles, Aurot, Averson, Ayguemorte-les-Graves, Bagat,
Baigneaux, Balzac, Barie, Baron, Barsac, Bassanne, Baurech,
Bayas, Bayon-sur-Gironde, Bazas, Beaufron, Begadan, Begles,
Bequey, Bellebat, Bellefont, Belvès-de-Castillon, Bernos-Beroulac,
Berson, Berthez, Beychac-et-Cailhau, Bleujac, Les Billaux, Biraç,
Blagnac, Blagnon, Blanquefort, Blossom, Blave, Bessillac,
Bommes, Bonneton, Bonzac, Bossugan, Bouliac, Bourdelles, Bourg,
Branne, Brannens, Brou-et-Saint-Louis, La Bredie, Brouqueyran,
Budos, Cabanac-et-Vilagrains, Cabars, Cadarsac, Cadoulac,
Cadillac, Cadillac-en-Fronsadas, Camarsac, Cambes, Cambianes-
et-Meynac, Camiac-et-Saint-Denis, Camiran, Camps-sur-Vie,

GI qualification

The name listed in (i) is recognized and protected as a
geographical indication for wine in France in accordance with Dé
cret of 14 November 1936. Wines bearing the geographical
indication must be produced from grapes grown in the communes
of France listed in (ii) above and must conform to the
characteristics and made to the standards defined in Décret of 14
November 1936 of France.

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List of protected GIs

The screenshot shows the Canadian Intellectual Property Office (CIPO) website. The page title is "List of Geographical Indications". There are three tabs: "View alphabetically", "View by region", and "View All". Below the tabs is a table with three columns: "Geographical Indications", "File Number", and "Date Entered".

Geographical Indications	File Number	Date Entered
Aachener Primitiv	1858540	2017-09-21
Abanilla	1278279	2008-09-18
Abondance	1858621	2017-09-21
Aceite de Terra Alta	1858578	2017-09-21
Aceite del Baix Ebre	1858569	2017-09-21
Montsila		
Aceite del Bajo	1858571	2017-09-21
Aragón		
Aceto balsamico	1858636	2017-09-21

<http://www.ic.gc.ca/cipo/listgiws.nsf/gimenu-eng?readform&sort=all&ord=1>

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Benefit: less opposition proceedings

- Prohibition **to register** a trademark consisting of a protected GI if the registration is directed **at wine/spirit/agricultural product or food not originating in the designated territory.**
 - Section 12(1)(g) of the TMA

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Benefit: additional scope of protection

- Prohibition to **use/adopt** protected GIs (or their translation) in association with wine/spirit/agricultural product or food
 - that is not originating in the designated territory; or
 - that was not produced or manufactured in accordance with the law applicable to that territory;



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Benefit: Border Security Measures

Request for Assistance (RFA)

- Prohibition on the import and export of goods bearing a protected GI
- Allows customs officers to detain suspected counterfeit goods at the border if:
 - the goods do not originate from the territory indicated by the GI
- or
- the goods were not produced in accordance with the law applicable to that territory.



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Certification marks

- A mark used to distinguish goods and services that meet predefined standards:
 - the character or quality of the goods,
 - the working conditions under which the goods are produced,
 - the class of persons by whom the goods are produced, or
 - the area within which the goods are produced;
- A certification mark may be descriptive of the place of origin. (e.g., ALIMENTS DU QUÉBEC)
- The owner of the certification mark is exclusively a licensor



TMA447026



TMA607646

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Cumulative Protection

Protected Geographical Indication

Chianti Classico — 1283792

Application number
1283792

Type(s)
Word

Category
Geographical Indication

CIPO status
ENTERED ON THE LIST

Registered
2007-12-27

Responsible Authority
Ministero delle Politiche
Agricole e Forestali Via XX
Settembre, n° 20 - 00187 ROMA
ITALY

Index headings
CHIANTI CLASSICO

Goods
(1) Wine

GI territory description
Region of Toscana in Italy; in the provinces of Firenze and Siena.

GI qualification
The name listed in (i) is recognized and protected in Italy as a geographical indication for wine in Decreto ministero Risorse agricole del 5 agosto 1996, modified by DM 16 maggio 2002 and DM 15 settembre 2005, which replaced DPR 2 luglio 1984 (modified by DM del 8 gennaio 1996), previously recognized as DOC in DPR 9 agosto 1967, also DM 8 agosto 2001, modified by DM 20 settembre 2001, and L. No. 164 of 10.02.1992, and is accordance with European Union Council Regulation (EC) No. 1493/1999 and EC No. 753/2002.

Classification data
Disclaimer

The classification data is provided for information and searching purposes only. CIPO does not warrant the accuracy of the classes assigned to the trademark. This data has no legal value of any kind.

33 - Wines and spirits

Registered Certification Marks

CHIANTI CLASSICO
TMA873779 (words)



TMA899150 (design)

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Certification marks – Additional Scope of Protection

- **Prohibition to register a confusing trademark** (12(1)(d) TM Act)
- **Unauthorized use**
The owner of a registered certification mark may prevent its use by unlicensed persons or in association with any goods or services in respect of which it is registered but to which the licence does not extend. (Section 23(3) of the TM Act)
- **Infringement** (Sections 19 and 20 TM Act)
- **Depreciation of the value of the goodwill** (Section 22 TM Act)

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What should **brand owners** know to avoid misusing others' GIs?

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Case study 1: **PRÉ DE PROVENCE**

TMA560,539 and TMA560,538

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Case study - PRÉ DE PROVENCE

PRE DE PROVENCE &
DESIGN
TMA560538

PRE DE PROVENCE
TMA560539



Applicant
EUROPEAN SOAPS, LTD.
920 N. 137th Street
Seattle, Washington 98133
UNITED STATES OF AMERICA



IGP : Huile Essentielle de Lavande de Haute-Provence

Goods: "Cosmetics and cleaning preparations namely, soaps, bath-oils, body-oils, foam baths, shampoos, conditioners, lotions and perfumes"

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Case Study - PRÉ DE PROVENCE



Take-away



Seeking TM registration over the use of words that designate a geographical location that is known for a given product may not be advisable.

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Case study 2: **JURAMAN**

*Institut national de l'origine et de la qualité c.
Établissements Rivoire-Jacquemin, Société Anonyme*

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Case Study - **JURAMAN**



RIVOIRE
JACQUEMIN

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Case Study - JURAMAN

French region of **JURA**



BLEU DE GEX HAUT JURA



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Case Study - JURAMAN

- The mark as a whole, consisting of the terms "JURA" and "MAN," designates men or individuals from the Jura region.
- The wording of the application is not limited to the identity of the persons who produce the cheeses covered by the application and thus covers cheese produced by men in Jura and cheese not produced by men in Jura.
- The Mark is clearly descriptive or deceptively misdescriptive of the persons who produce the goods covered by the Application.



RIVOIRE
JACQUEMIN

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Case Study - JURAMAN



Take-aways



Consider whether your trademark is in whole or in part a GI (registered or not)



Consider whether your trademark is clearly descriptive or deceptively misdescriptive



Limiting the scope of the goods or services is not always sufficient

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Case study 3: LA CHAMPAGNERIE

CIVC et al. v. La Champagnerie Inc. et al. (T-1461-17)

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Case Study - LA CHAMPAGNERIE



©: FoodjunkieChronicles



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Case Study - LA CHAMPAGNERIE

LA CHAMPAGNERIE
 343 rue St-Paul Est
 H2Y 1H3, MONTREAL, QC
 514-903-9343

ADDITION #146795-1
 TABLE #17 CLIENT #6
 2016-03-03 19:47:04 BRIDYTE

#DUVEECHAMPAGNERIE	\$85.00
12 HUITRES	\$24.00
VERRE CABERNET MOUNTAIN VIZM	\$12.00
VERRE CABERNET MOUNTAIN VIZM	\$12.00
SUB-TOTAL	\$133.00
TPS (919616442 RT0001)	\$6.65
TVD (1219904149 TQ0001)	\$13.27
TOTAL	\$152.92

Le service n'est pas inclus
 Service suggère 15%: \$23.94
 Merci de votre visite
 et au plaisir de vous servir
BONNE JOURNEE

TPS: 6,65 \$ TVQ: 13,27 \$
Total : 152,92 \$

FACTURE ORIGINALE

 2016-03-03 19:47:04
 LA CHAMPAGNERIE INC.
 343, RUE SAINT-PAUL E MONTREAL
 514-903-9343



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Case Study - LA CHAMPAGNERIE

(v) a declaration that the Defendants' advertising and performance in Canada of bar and restaurant services in association with the trademark and/or trade name LA CHAMPAGNERIE and its variations described at paragraph 18 below, the performance of which involves the sale and service of wines that do not conform to the CHAMPAGNE protected geographical indication, constitute:

- (i) adoption, in connection with a business, of the protected geographical indication CHAMPAGNE in respect of a wine not originating in the territory indicated by that protected geographical indication, contrary to section 11.14(1)(a) of the *Trade-marks Act*;



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Case Study - LA CHAMPAGNERIE

- Confidential Settlement
- TM applications abandoned in Canada and worldwide
- Name of the restaurant was changed to **MAISON ST-PAUL**
- Federal Court issued judgement on consent September 18, 2019



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Case Study - LA CHAMPAGNERIE

1. A declaration that the Defendants had **infringed** the Plaintiffs' **protected GI**;
2. A declaration that the Defendants had **directed public attention to their bar/restaurant services/wines to cause confusion** between their services/ products and those of **bar/restaurants/producers of wines that offer services/wines that conform to the CHAMPAGNE protected GI**;
3. A declaration that the Defendants had **passed off** their services as those who **serve wine that conforms to the CHAMPAGNE protected GI**;
4. A permanent injunction restraining the Defendants from using CHAMPAGNE;



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Case Study - LA CHAMPAGNERIE



Take-aways



Consider whether your trademark incorporates a protected geographical indication.



Be extra prudent if your products or services relate to wine/spirit/food, even indirectly.
(In the case of LA CHAMPAGNERIE, restaurant/bar services featuring sparkling wines)

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Case study 4: Sunwing's Champagne Flights

INAO et al. v. Sunwing Travel Group Inc. et al. (T-532-17)

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Case Study - Sunwing



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Case Study - Sunwing

The Plaintiffs claimed, notably:

1. A declaration that the Defendants had infringed the Plaintiffs' protected GI;
2. A declaration that the Defendants had passed off their services as those who serve wine that conforms to the CHAMPAGNE protected GI;
3. A permanent injunction restraining the Defendants from using the CHAMPAGNE protected GI, and;
4. Damages.

↳ a declaration that the Defendants' sale, distribution, advertising and performance in Canada of airline services, hotel services, airline booking services, hotel booking services, vacation booking services and other hospitality services, the performance of which involves the service of wine that does not conform to the CHAMPAGNE protected geographical indication constitutes:

- (i) adoption, in connection with a business, of the protected geographical indication CHAMPAGNE in respect of a wine not originating in the territory indicated by that protected geographical indication, contrary to section 11.14(1)(a) of the *Trade-marks Act*;

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Case Study - Sunwing

- Confidential Settlement
- Federal Court issued a judgement on consent

↳ THIS COURT ORDERS THAT:

1. A permanent injunction is hereby effected enjoining and restraining the Defendants by themselves or by their officers, directors, shareholders, employees, licensees, representatives, agents, person or any company, partnership, business entity, associate, affiliate under their authority or control, from directly or indirectly using, as a trademark or otherwise, the word CHAMPAGNE, or any variation thereof that is false in a material respect and likely to mislead the public as to the character, quality, composition, geographical origin, mode of manufacture and mode of production of products and services, in association with wine or with their airline services, hotel services, airline booking services, hotel booking services, vacation booking services and other hospitality services, as defined in the Statement of Claim, including but not limited to the expressions CHAMPAGNE FLIGHT, CHAMPAGNE VACATION, CHAMPAGNE SERVICE, VACANCES D'HIVER AU CHAMPAGNE and SERVICE AU CHAMPAGNE, except only to describe a wine that benefits from the protection of the CHAMPAGNE protected geographical indication.

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Case Study - Sunwing



Take-aways



Be wary of using a protected GI in any unauthorised manner without permission



Do not assume that your use of a well-known protected GI in an expression like CHAMPAGNE SERVICE will not be actionable

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Case Study - Sunwing

- ***MacDuff v. Vacances Sunwing inc. – Ongoing Class Action***
 - Did the Defendants contravene the Quebec *Consumer Protection Act* by describing and promoting their service by using the word "champagne" but not serving champagne?



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Case Study - Sunwing



Take-aways



Consider whether your marketing practices refer to a geographical indication



Be wary of using a protected GI and not offering that product to consumers

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Questions?

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