



Standing Committee on Geographical Indication

Report of the Italian Group of AIPPI

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I. Analysis of current legislation and case law

- 1) Are GIs and/or AOs protected under your Group's current law?

Yes, they are

- 2) If yes, please briefly describe the following:

- a) How AOs and GIs are defined and the prerequisites (in particular the type, nature and intensity of link with a territory).

Being Italy a Member State of the European Union, the EU general rules on protection of AOs e GIs fully apply in Italy (see EC Regulation No. 1151/2012 of 21 November 2012 on the protection of geographical indications and designations of origin for agricultural products and foodstuff, hereinafter referred to as *EU Regulation*; see also EC Regulation No. 479/2008 on wines and EC Regulation No. 110/2008 on spirits).

Accordingly Italy has not enacted a general national registration system for AOs and GIs. However, some specialized systems for registration, related to certain specific agricultural sectors, have been established (e.g.: cheese: Law 10 April 1954 n. 125; olive oil: Law 3 August 1998, n. 313).

Still the Italian Industrial Property Code (Legislative Decree 10 February 2005, n. 30, the "IP Code") sets forth a general protection of AOs and GIs as proprietary rights at Sections 29 and 30. In particular the Section 29 states that "*protection is granted to geographical indications and designations of origin identifying a country, a region or a place when used to describe a product originated from such place, and whose quality, reputation or characteristics are exclusively or essentially due to the geographical environment of origin*". Therefore, outside the agricultural products and foodstuff sector, AOs and GIs should be included among the so called *unregistered* intellectual property rights, namely, those rights which are not achieved through patents or other registrations, but "*in the other manners*"

provided for by the IP Code and which are “*protected, as long as the requirements provided by the law occur*”. In any case, the protection provided by the EU general rules is applicable (please refer to answer to question 2).

Italy is also party to some international conventions and bilateral treaties concerning AOs and GIs. By a recent judgment issued by the Court of Milan and confirmed by the Court of Appeal of Milan, an AO protected by the Stresa Convention of 1951 on geographical indications for cheese (“Emmentaler”) was successfully enforced against a product bearing the same name but not complying with the relevant specifications as either a violation of both the Convention and Sections 29 and 30 of the IP Code or an act of unfair competition.

- b) Whether that protection is provided by sui generis laws; solely as aspects of other laws, such as by registration as collective or certification marks; or by other (and if so, what) means.

Please refer to the Italian Report on Q 191 and to EU rules.

- c) If GIs and/or AOs are protected by sui generis laws, whether your Group's laws provide for a system of registration. If so, what are the steps of this procedure including the content of the application and the possibility of opposition by third parties.

Being Italy a Member State of the European Union, the EU general rules on protection of AOs e GIs fully apply in Italy.

- 3) If your country does not protect GIs and/or AOs, was this a deliberate decision and, if so, why?

Italy protects GIs and AOs.

- 4) What are the grounds of invalidity/loss of rights for GIs and/or AOs under your Group's law (e.g. becoming generic, lack of use, not paying fees) and where can such be invoked (which court, office etc.)? Please specify the applicable test, how such is proven (e.g. consumer surveys, expert advice, dictionaries, etc.) and who bears the burden of proof.

Being Italy a Member State of the European Union, the EC general rules on protection of AOs e GIs fully apply. In particular, it must be noted that, according to section 13 of the EU Regulation 1151/2012, “*The appellations of origin and the geographical indications do not become generic*”. Furthermore, neither Section 29 nor Section 30 of IP Code take into account the possibility that AOs and GIs may be affected by vulgarization. However, since the protection is granted only provided that the AOs and GIs meet all the requirements set forth by section 29 of the IP Code, it descends that, once such requirements are lost, the relevant GIs or AOs other than those protected by the EU rules or by international agreements lose the relevant protection too.

- 5) What is the scope of protection of GIs/AOs under your Group's current law?

The EU general rules on protection of AOs e GIs fully apply in Italy also in respect of the scope of protection (please be referred to Section 13 of the EU Regulation). The Section 30 of the IP Code states that *“the use of geographical indications and of designations of origin is forbidden when such use is likely to deceive the public, as well as the use of any means whatsoever in the designation or presentation of a product which indicate or suggest that the same product originates from a place other than the actual place of origin, or that the product possesses the qualities pertaining to the products originating from a place designated by a geographical indication”*.

- 6) Against what kind of conduct are GIs/AOs protected? For example, against use misleading consumers, parasitism and free riding.

Also in this respect the EU general rules apply (please be referred again to Section 13 of the EU Regulation). As anticipated under point 5) above, the protection specifically set forth by Section 30 of the IP Code consists of three species of forbidden conducts: a) the prohibition to mislead consumers; b) the prohibition of make reference to the appellation for like products; c) any other case of misappropriation of the reputation of the protected appellation, including parasitism and free riding.

- 7) Who has legal standing to protect a GI/AO. For example, individual producers, consortiums and associations, public bodies.

Both individual producers and consortiums/associations have legal standing to protect a GI/AO. Furthermore the Ministry of Agriculture (MIPAAF) does have.

- 8) What remedies are available in the case of violation of rights in a GI/AO?

The violation of GIs and AOs leads to the remedies provided for by Sections 2599-2600 of Italian Civil Code against acts of unfair competition as well as by Sections 124-131 of the IP Code, being GIs and AOs included among the intellectual property rights. Therefore, claims for injunction and final withdrawal from the market, damages and disgorgement of infringer's profits, assignment or destruction of the infringing products, fixation of a fine, publication of the judgment are available. Protection may be sought also by way of urgency, claiming preliminary injunction, temporary withdrawal from the market seizure of the infringing goods, fixation of a fine and publication of the relevant order.

In addition to the above, the remedies against unfair commercial practices set forth by the Consumer Code and those set forth by the Legislative Decree 2 August 2007, no. 145 (Decree against misleading advertising and unlawful comparative advertisement) are available also to violations of GIs and AOs that give rise to deception.

When it comes to GIs and AOs of agricultural products and foodstuffs, administrative

penalties are set forth by the Legislative Decree 19 November 2004 no. 297, which are implemented by MIPAAF, and also criminal penalties set forth by section 517^{quater} of the Italian Criminal Code are available.

- 9) How does your Group's law regulate the conflict between a GI/AO and a prior trademark? Does the GI/AO or the trademark prevail or do they coexist? Under what conditions?

Please refer to the Italian Report on Q 191 and to EU rules.

- 10) Is there any specific provision or practice concerning the inclusion of a GI/AO in a domain name?

No specific rules are included either in the EU rules, or by the IP Code, which, however, includes the domain names used in the economic activity among the unregistered distinctive signs, and therefore the same rules should apply to regulate the inclusion of a GI/AO in a trademark. Furthermore, the Domain Name Disputes Resolution Administrative Proceedings of the administrative entity that resolves the disputes in the matter of “.it” domains sets forth that GI/AO are to be protected not only against any commercial use of a denomination for products that do not show the features indicated in the relevant protocols of production, but also against any use of the GI/AO which illicitly exploits the reputation thereof.

- 11) Is there anybody that administers GIs/AOs in your country and/or is responsible for the verification of compliance of goods bearing a GI/AO? Please briefly describe the relevant processes, e.g. the process by which compliance with product specifications is verified before such goods are put on the market and/or the subsequent market controls on such goods?

GIs and AOs are subject to control by entities recognised by the MIPAAF, that evaluate if the products could be correctly signed with the GI/AO stamp. The Public Security forces could make the controls on the market.

- 12) Please describe any other developments in your country in relation to GIs or AOs which you consider relevant, including any proposals for reform. For example, to the extent that your country has been involved in any negotiations or discussions regarding the protection of GIs and AOs in any fora, such as multilateral, regional or bilateral agreements, please specify whether your country is negotiating or has signed any agreement with other countries that includes provisions on AOs/GIs and whether it was necessary to amend domestic legislation as a result of such agreements.

It is remarkable the recent Agreement executed on 15 February 2017 between EU and Canada (CETA).

II. Proposals for improvements and for harmonisation

- 13) Should there be harmonised definitions of AOs and GIs?

Yes, there should be.

If so, please propose appropriate definitions and prerequisites.

It is the opinion of the Italian Group of AIPPI that AOs should be defined as names identifying a country, a region or a place used to describe a product originated from such place, and whose quality and characteristics are exclusively or essentially due to the geographical environment of origin. GIs should be defined as names identifying a country, a region or a place used to describe a product originated from such place, and even only their reputation is exclusively or essentially due to the geographical environment of origin.

- 14) Should there be a registration procedure for AOs and GIs? If so, what should its key features be? For example, content of the application; examination by competent bodies; possibility of opposition by third parties.

It is the opinion of the Italian Group of AIPPI that AOs and GIs should be protected either within the framework of trade mark laws or by way of a sui generis system, or by a combination of the foregoing, as indicated in point 3 of Q191 Resolution. In case of sui generis protection, the Italian Group of AIPPI would support the establishment of systems providing for registration procedures to be implemented regionally. In the latter case, the present EU system could be a viable model. In any case, at least a voluntary multilateral system of notification of geographical indications should be established, as proposed in the Q191 Resolution.

- 15) What should the grounds of invalidity/loss of rights for GIs and/or AOs be? For example, becoming generic, lack of use, not paying fees. Please specify what the applicable test should be, how such should be proven and who should bear the burden of proof.

It is the opinion of the Italian Group of AIPPI that AOs and GIs should be protected until they are still perceived by the relevant public as linked to the geographical environment of origin. For further aspects, please refer to the Italian Report on Q191 (see in particular point 12 therein).

- 16) How should conflicts between GIs/AOs and prior trademark rights be regulated?

It is the opinion of the Italian Group of AIPPI that the solution set forth in point 4 of the Q191 Resolution could be viable, i.e. the guiding principle for settling conflicts between trademarks and geographical indications should be the first in time, first in right rule (priority in use or registration), provided that any practice which is liable to mislead the public or misappropriate the reputation, if any, of the protected geographical indication or trade mark should be forbidden.

- 17) What scope of protection should GIs/AOs have and should it matter if these are domestic or foreign? Against which conduct by third parties should they be protected?

It is the opinion of the Italian Group of AIPPI that no difference should exist between domestic or foreign GI/AOs, provided that they are perceived as such by the relevant public also in the country where the protection is sought. Protection of GI/AOs indications should aim to prevent any practice liable to mislead the public or misappropriate the reputation, if any, thereof, as stated in point 2 of the Q191 Resolution.

- 18) Who should have legal standing to protect a GI/AO and which remedies are appropriate?

It is the opinion of the Italian Group of AIPPI that the legal standing to enforce a GI/AO should be granted to each manufacturer (which, however, should be entitled to claim only the damages directly suffered), by a public entity of the relevant Country of origin and by Consortiums in charge of the protection thereof (which should be entitled to claim for the damages suffered by all their members). With respect to the remedies, the trademark protection system should be taken as an example.

- 19) Should there be a specific provision or practice concerning the inclusion of a GI/AO in a domain name?

It is the opinion of the Italian Group of AIPPI that the rules applicable in the field of trademark protection should be extended to GI/AOs.