

# **Geographical Indications**

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# What differentiates a wine from another?

**Trademarks** : name, logos

**Certification Marks:** eg:  
Organic; VQA, Marque Quebec

BC VQA OKANAGAN VALLEY



**Geographical Indications**

**Geographical Indications**



**Labelling:** Grape Varietals, Name, Year

# Champagne only comes from...Champagne



# Champagne only comes from...Champagne

## THE WORLD'S LEADING WINE AOC BY VALUE



Source: Comité Interprofessionnel du Vin de Champagne



# What is a geographical indication?

**A specific territory...**



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



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



Pictures: Comité Interprofessionnel du Vin de Champagne

# How are GIs protected in Canada?

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## Federal

- Trademarks Act
- Food and Drugs Regulations
- Spirit Drinks Trade Act

## Provincial

- Quebec: Act Respecting Reserved Designations and Added-Value Claims
- Ontario: Vintners Quality Alliance Act and the Rules Of Vintners Quality Alliance Ontario Relating To Terms For VQA Wine
- British Columbia: Food and Agricultural Products Classification Act and the Wines of Marked Quality Regulation
- Nova Scotia : Agriculture and Marketing Act and the Nova Scotia Wine Standards Regulations

# Protection Regimes under the Canadian *Trademarks Act*

- Geographical Indications
  - Sections 11.11-11.24 of the TMA
- Unfair competition
  - Section 7 of the TMA
- Certification marks
  - Sections 23-25 of the TMA



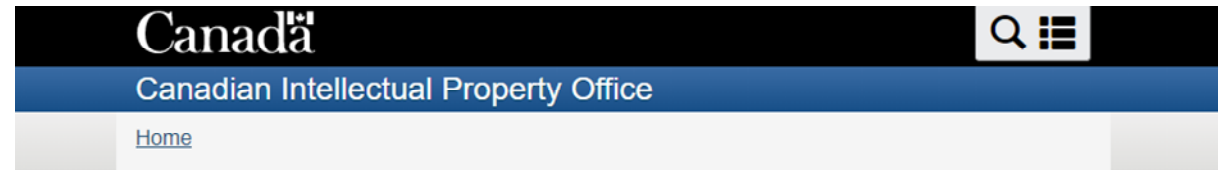
# GI and Protected GI

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- ***geographical indication*** means an indication that identifies a wine (...) 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*** means a geographical indication that is on the list kept pursuant to subsection 11.12(1);



# List of protected GIs



## List of Geographical Indications

[View alphabetically](#)

[View by region](#)

[View All](#)

**Geographical Indications** ▼

**File Number** ▼

**Date Entered** ▼

<a href="#">Aachener Printen</a>	1858540	2017-09-21
<a href="#">Abanilla</a>	1278279	2008-09-18
<a href="#">Abondance</a>	1858621	2017-09-21
<a href="#">Aceite de Terra Alta</a>	1858578	2017-09-21
<a href="#">Aceite del Baix Ebre-Montsía</a>	1858569	2017-09-21
<a href="#">Aceite del Bajo Aragón</a>	1858571	2017-09-21
<a href="#">Aceto balsamico</a>	1858636	2017-09-21

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

# Protected GIs

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- Both local and foreign geographical indications can be entered onto the list of GIs by submitting a request to the Canadian Intellectual Property Office.
  - Ex: OKANAGAN VALLEY (no.1416990); BORDEAUX (1431142)
- Foreign GIs can also enter on the list through bilateral or multilateral treaties.
  - Ex: PIMENT D'ESPELETTE (no. 1858634)

# 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 138,  
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, Arzac, Les Artigues-de-Lussac, Artigues-Pres-Bordeaux, Arveyres, Asques, Aubiac, Aubie-et-Espessas, Auriolles, Auros, Avensan, Ayguemorte-les-Graves, Bagas, Baigneaux, Balizac, Barie, Baron, Barsac, Bassanne, Baurech, Bayas, Bayon-sur-Gironde, Bazas, Beautiran, Begadan, Begles, Beguey, Bellebat, Bellefond, Belves-de-Castillon, Bernos-Beaulac, Berson, Berthez, Beychac-et-Caillau, Bieujac, Les Billaux, Birac, Blaignac, Blaignan, Blanquefort, Blasimon, Blaye, Blesignac, Bommes, Bonnetan, Bonzac, Bossugan, Bouliac, Bourdelles, Bourg, Branne, Brannens, Braud-et-Saint-Louis, La Bredé, Brouqueyran, Budos, Cabanac-et-Villagrains, Cabara, Cadarsac, Cadaujac, Cadillac, Cadillac-en-Fronsadais, Camarsac, Cambes, Camblanes-et-Meynac, Camiac-et-Saint-Denis, Camiran, Camps-sur-l'Isle,

### GI qualification

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

# Scope of Protection – Protected GI

- 1) Prohibition to use/adopt protected GIs (or their translation):
  - in association with wine
  - that is not originating in the designated territory.



# Scope of Protection– Protected GI

2) Prohibition to register a trademark consisting of a protected GI if the registration is directed at wine not originating in the designated territory.

- Section 12(1)(g) of the TMA

❖ Benefit of a registered GI: less opposition proceedings



# Scope of Protection.

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## CASE STUDIES



# Scope of Protection – case study 1



# Scope of Protection – case study 1

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



# Scope of Protection – case study 1

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

- La Champagnerie launched a house wine, "Cuvee Champagnerie" which was a Spanish wine of the "Cava" appellation and, as such, does not conform to the CHAMPAGNE protected GI (contrary to section 11.14 of the Act)

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 BRIGYTE

#CUVEECHAMPAGNERIE	\$85.00
12 HUITRES	\$24.00
VERRE CABERNET MOUNTAIN VIEW	\$12.00
VERRE CABERNET MOUNTAIN VIEW	\$12.00
<hr/>	
SUB-TOTAL	\$133.00
TPS (819616442 RT0001)	\$6.65
TVQ (1219904149 TQ0001)	\$13.27
<b>TOTAL</b>	<b>\$152.92</b>

Le service n'est pas inclus  
 Service suggéré 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 19:55:33 MEV:13827801-10070322  
 LA CHAMPAGNERIE INC.  
 343, RUE SAINT-PAUL E MONTREAL  
 38 1 1 5 4 1 77 4 8 5 =



# Scope of Protection – case study 1

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

43a) 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*;



# Scope of Protection – case study 1

- ***CIVC et als. v. La Champagnerie Inc. et al.*** (T-1461-17)
  - Confidential Settlement
  - Name of the restaurant was changed to MAISON ST-PAUL
  - Justice Annis of Federal Court issued judgement on consent September 18, 2019



# Scope of Protection – case study 1

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

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 theirs 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;

**L  
À  
CHAMPAGNERIE**

BAR À SABRAGE





# Scope of Protection – case study 2



**sunwing**  
AIRLINES

Experience our  
**Champagne Service**  
Weekly direct flights to Punta Cana, D.R.

The advertisement features a bright blue sky background. In the top left, the Sunwing Airlines logo is displayed in white on an orange rectangular background. Below the logo, a palm tree stands on a sandy beach next to a thatched-roof gazebo. In the center, a Sunwing airplane is shown in flight. In the bottom right, two champagne flutes filled with bubbly champagne are prominently displayed.



**sunwing**

**CHAMPAGNE  
FLIGHTS TO PARIS**  
WITH SUNWING FROM TORONTO

All flights operating on wide-body Boeing 767's. Experience Elite service and enjoy complimentary Bon voyage glass of Champagne, choice of hot meals with wine, soft beverages, hot towels, pillows, leather seating, kids backpack with games and toys, headphones and first run movies.

The advertisement features a bright blue sky background. In the top left, the Sunwing logo is displayed in white on an orange background. In the top right, a Sunwing airplane is shown in flight. In the center, the Arc de Triomphe in Paris is visible. In the bottom right, two champagne flutes filled with bubbly champagne are prominently displayed.

# Scope of Protection – case study 2

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

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) 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*;

# Scope of Protection – case study 2

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

- 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.

# Scope of Protection – case study 3

- ***MacDuff v. Vacances Sunwing inc. – 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 wine?
  - Ongoing



# Unfair Competition – In the absence of registered rights

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## 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



# Scope of Protection – Case study 4

- **INAO v Mosti Mondiale (2001)**
- Mosti Mondiale: Supplier of grape juice and winemaking kits referring to various GIs (e.g.: Saint-Emilion, Bourgogne, etc.)
- Superior Court of Quebec issued an order prohibiting Mosti from using these GIs



## BAROQUE RED

Tels les vins français de **type bordeaux**, il présente une robe d'un rouge grenat assez foncé. Ses discrètes fragrances florales et de baies rouges mûries au soleil ainsi que sa légère touche de sous-bois font de lui un vin chaleureux et raffiné. L'attaque est marquée d'un goût enveloppant de boisé et de cuir. Tanins vaporeux et parfaitement équilibrés ainsi qu'une belle acidité.

## BOURG ROYAL RED

Apparenté au fameux **bourgogne**, il se caractérise par sa couleur rubis clair et ses arômes de fruits à profusion. Son nez léger aux arômes de cerises, sa bonne tenue en alcool et ses tanins procurent une attaque fraîche en bouche, une longueur soutenue et une bonne charpente. Un vieillissement en fût de chêne lui permet une saveur relevée avec le temps.



# 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

# Certification marks – Scope of Protection

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## 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)

Also available: infringement (Sections 19 and 20 TM Act) and depreciation of the value of the goodwill (Section 22 TM Act)

# 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 (ii) 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 in 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)

# Update – CETA (Comprehensive Economic and Trade Agreement)

- Trade agreement signed in October 2016
- Came into force on September 21, 2017



# Update – CETA (Comprehensive Economic and Trade Agreement)

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- GI protection expanded to food and agricultural products
- Introduced new protected geographical indications for food and agricultural products, for example:
  - Prosciutto di Parma ham
  - Lentilles Vertes du Puy

# Update – CETA (Comprehensive Economic and Trade Agreement)

- **Border Security Measures Expanded to GIs**
  - Prohibition on the import and export of goods bearing a protected GI, 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.





# Update – CETA (Comprehensive Economic and Trade Agreement)

- **Request for Assistance (RFA) applications :**
  - Allows customs officers to detain suspected counterfeit goods at the border if the GI rights holders have applied to participate in the RFA process.



# Update - USMCA

- New trade agreement signed on December 10, 2019 (to be ratified)
- Provides a number of provisions relating to the protection of GIs. Canada is already in compliance with these provisions.
- Worth noting : GIs for wines and spirits may continue to be automatically protected through bilateral or multilateral agreements (without first providing the possibility of opposing)



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# THANK YOU!

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