

# Protection of Geographical Indications

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A recent decision of the Federal Court deals with a geographical indication (“GI”) and illustrates the problems that can occur concerning their protection.

A GI is a type of trade-mark that is intended to designate product quality, highlight brand identity as well as preserving cultural traditions. Examples of GIs include COGNAC, BEAUJOLAIS, and PROSCIUTTO DI PARMA. Problems occur when a GI is protected in one region but is in common usage in another.

## The Facts

In the case in issue, the Ministry of Commerce and Industry of the Republic of Cypress (“Cypress”) applied to obtain a certification mark for the trade-mark HALLOUMI in association with cheese.

## Certification Marks

A certification mark is a specialized type of trade-mark used to distinguish wares which comply with a defined standard in contrast to a trade-mark which is used to distinguish wares of the owner from the wares of others. A certification mark may be adopted and registered only by a person who is not engaged in the manufacture or sale of the wares in issue. The owner of the mark may licence others to use the mark in association with wares that meet the defined standard. The licenced use is deemed to be use by the owner.

A certification mark descriptive of the place of origin of the wares may be registered by an administrative authority for a country associated with the wares. The owner of the mark must permit use of the mark in association with any wares produced or performed in the area where the mark is descriptive.

In this case, the certification mark HALLOUMI was intended to indicate the cheese with which it was used was of the following defined standard: produced only in Cypress using the historic method unique to that country, namely; traditionally, produced from sheep and/or goat’s milk or in the case of mixtures, cow’s milk is also allowed.

## The Opposition

When the application was advertised, it was opposed by a number of parties, including the International Cheese Council of Canada (“Cheese Council”). Numerous grounds of opposition were asserted, including that:

- a. The adoption of HALLOUMI as a trade-mark was prohibited because HALLOUMI had by ordinary and bona fide commercial usage become recognized in Canada as designating a kind or quality of cheese;

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- b. The trade-mark could not function as a certification mark because HALLOUMI had been used in Canada prior to the applicant's date of first use and subsequently by persons not licenced by the applicant to describe cheeses which did not meet the standard set out in the application.

The Hearing Officer said that no one could obtain a monopoly over a word on the basis that it was a certification mark if the word had been used extensively in Canada by others prior to relevant date such that it had become recognized in Canada as designating the kind, quality, value or place of origin of the wares.

On reviewing the evidence, the Hearing Officer concluded that the Cheese Council had established the ground of opposition (a) since there had been bona fide commercial use of the mark or similar terms such that it was recognized in Canada as designating a kind of cheese.

In addition, regarding ground of opposition (b), the Cheese Council had shown that at the date the statement of opposition was filed, a confusingly similar trade-mark had been sufficiently known to negate the distinctiveness of the applied-for mark. As a result, this ground of opposition was also established.

### The Appeal

Cypress appealed from this decision to the Federal Court. On appeal it was argued that the Cheese Council had not met its initial evidentiary burden before the Trade-marks Opposition Board. However, Cypress did not file any additional evidence concerning the above grounds although it could have done so.

The Judge noted that it was settled law that an opponent only had an initial evidentiary burden: at most it must submit sufficient evidence to support a *prima facie* finding in support of the grounds of opposition. Where an opponent satisfies this initial burden, it is up to the applicant to persuade the Hearing Officer that the grounds of opposition should not prevent the application from proceeding.

In order to satisfy its burden, the Cheese Council had to demonstrate that the applied-for mark or any other mark so nearly resembling it as to be likely to be mistaken for it, had been used extensively in Canada by others prior to the relevant date to designate a type of cheese and that the mark had an accepted definition or meaning in the industry.

The Cheese Council had established that it was possible to purchase cheese from various sources whose packaging bore the marks HALOOM, HALLOUM or HALOUMI in different cities in Quebec and in Ottawa. There was also evidence that a number of Canadian producers had sold substantial quantities of cheese designated as HALLOUM

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since 1995. A number of stakeholders in the industry testified that the term “halloumi” was used generically to designate a type of cheese.

In light of this evidence, the Judge concluded that the Register’s decision was reasonable and the Cheese Council had discharged its initial burden. It was open to the Hearing Officer to find that the term “halloumi” could not be used exclusively by any one person or entity. As a result, the appeal was dismissed and the trade-mark application dismissed.

### Conclusion

Different jurisdictions have come to different conclusions concerning protecting geographical designations. For example, in a similar case in Europe, it was found that producers located in Greece had the exclusive right to use the trade-mark FETA in association with cheese products, notwithstanding other European producers argued that the mark was generic.

Discussions had been ongoing to attempt to arrive at an acceptable solution for the international protection of GIs. Unfortunately to date, no solution has been agreed to.