

Opinion on the EU Commission's Proposals for Broader Protection in Geographical Indications Law

Citation for published version (APA):

Moerland, A., Senftleben, M., Gangjee, D., Kur, A., & Calboli, I. (2023). Opinion on the EU Commission's Proposals for Broader Protection in Geographical Indications Law. *European Intellectual Property Review*, 45(6), 307-312. <https://scholarship.law.tamu.edu/facscholar/1802/>

Document status and date:

Published: 05/05/2023

Document Version:

Publisher's PDF, also known as Version of record

Document license:

Taverne

Please check the document version of this publication:

- A submitted manuscript is the version of the article upon submission and before peer-review. There can be important differences between the submitted version and the official published version of record. People interested in the research are advised to contact the author for the final version of the publication, or visit the DOI to the publisher's website.
- The final author version and the galley proof are versions of the publication after peer review.
- The final published version features the final layout of the paper including the volume, issue and page numbers.

[Link to publication](#)

General rights

Copyright and moral rights for the publications made accessible in the public portal are retained by the authors and/or other copyright owners and it is a condition of accessing publications that users recognise and abide by the legal requirements associated with these rights.

- Users may download and print one copy of any publication from the public portal for the purpose of private study or research.
- You may not further distribute the material or use it for any profit-making activity or commercial gain
- You may freely distribute the URL identifying the publication in the public portal.

If the publication is distributed under the terms of Article 25fa of the Dutch Copyright Act, indicated by the "Taverne" license above, please follow below link for the End User Agreement:

www.umlib.nl/taverne-license

Take down policy

If you believe that this document breaches copyright please contact us at:

repository@maastrichtuniversity.nl

providing details and we will investigate your claim.

OPINION

Opinion on the EU Commission's Proposals for Broader Protection in Geographical Indications Law

Annette Kur

Irene Calboli

Dev Gangjee

Anke Moerland

Martin Senftleben*

 Competition; EU law; Geographical indications

Abstract

In spring 2022, the EU Commission launched two proposals concerning the protection of Geographical Indications (GIs): COM(2022) 134 of 31 March 2022 amending current Regulation 2012/1151 on agricultural products and foodstuff (APFP) and COM(2022) 174 of 13 April 2022 on craft and industrial products (CIPP). The aims of the proposed regulations align in that they are meant to provide a harmonised and (relatively) simpler framework for registration as well as more resilient protection, in particular on the internet. Furthermore, both aim to bolster economic incentives to invest in production and creation or maintenance of quality jobs in rural and/or less developed regions, as well as—in the case of the agrifood regulation—to stimulate sustainable ways and methods of food production. Overall, those goals are welcome, as are most of the measures proposed to implement them. However, there are a number of problematic points which concern us, which we address in this article.

In spring 2022,¹ the European Union (EU) Commission launched two proposals concerning the protection of Geographical Indications (GIs):² COM(2022) 134 of 31 March 2022 amending current Regulation 2012/1151 on agricultural products and foodstuff (APFP)³ and COM(2022) 174 of 13 April 2022 on craft and industrial products (CIPP).⁴ While the proposals are meant to operate in different institutional settings,⁵ they coincide with a number of features, including those addressed in this contribution. Therefore, the discussion below applies to both forms of GIs (APFP and CIPP), unless differences are expressly flagged.

The aims of the proposed regulations also align in that they are meant to provide a harmonised and (relatively) simpler framework for registration as well as more resilient protection, in particular on the internet.⁶ Furthermore, both aim to bolster economic incentives to invest in production and creation or maintenance of quality jobs in rural and/or less developed regions, as well as—in the case of the agrifood regulation—to stimulate sustainable ways and methods of food production.

* Annette Kur is Affiliated Research Fellow, Max Planck Institute for Innovation and Competition, Munich, Germany. Irene Calboli is Regents Professor of Law at Texas A&M University School of Law, Fort Worth, USA, Academic Fellow, Faculty of Law, University of Geneva, Switzerland, and Visiting Professor at IE Law School, Madrid, Spain. Dev Gangjee is Professor of Intellectual Property Law, Faculty of Law, University of Oxford, UK. Anke Moerland is Associate Professor of Intellectual Property Law, European and International Law Department, Maastricht University, The Netherlands. Martin Senftleben is Professor of Intellectual Property Law and Director, Institute for Information law (IViR), University of Amsterdam, The Netherlands.

¹ Certain amendments of the current GI system enshrined in Regulation 2012/1151 of 21 November 2012 on quality schemes for agricultural products and foodstuffs [2012] OJ L343/1 were already effected by Regulation 2021/2117 of 2 December 2021 amending Regulations 1308/2013 establishing a common organisation of the markets in agricultural products, 1151/2012 on quality schemes for agricultural products and foodstuffs, 251/2014 on the definition, description, presentation, labelling and the protection of geographical indications of aromatised wine product and 228/2013 laying down specific measures for agriculture in the outermost regions of the Union [2021] OJ L432/262, in force since 6 December 2021.

² The acronym GI is used in the following as an umbrella term for all forms of geographical indications protected under the proposed regulations (see also art.7(a) APFP). Differences between protected geographical indications (PGIs) and protected designations of origin (PDOs), as currently defined in art.5 Regulation 2012/1151 (and art.48 of the APFP) are only pointed out where necessary.

³ COM(2022) 134 of 31 March 2022 amending current Regulation 2012/1151 on agricultural products and foodstuff, amending Regulations 2013/1308, 2017/1001 and 2019/787 and repealing Regulation 2012/1151 COM(2022)134. The coverage of the proposed Regulation is extended, from agricultural products and foodstuff currently protected under Regulation 2012/1151, to wines and spirits (hereafter, agri GIs).

⁴ Proposal for a Regulation of the European Parliament and of the Council on geographical indication protection for craft and industrial products and amending Regulations 2017/1001 and 2019/1753 of the European Parliament and of the Council and Council Decision 2019/1754 COM(2022)174 (hereafter, CIP GIs).

⁵ Registration of CIP GIs shall be administered by the EUIPO, while the system for registration of agri GIs remains in the hands of the EU Commission, with the potential for the EUIPO to be entrusted with certain tasks. For the time being, these institutional redesign aspects appear to be attracting the most attention and comment from stakeholders.

⁶ In particular protection against use of GIs as domain names, see art.27(3) APFP and art.35(5) CIPP.

Overall, those goals are welcome, as are most of the measures proposed to implement them. However, there are a number of concerns, which we address below.

Introduction

Traditionally, GIs enjoy relatively strong protection as compared to trade marks or other signs used in the course of trade. The proposed regulations further expand the scope of protection conferred upon GIs once they are registered (see arts 27, 28 APFP and art.35, 36 CIPP). In our opinion, the need to differentiate between GIs and trade marks is justified insofar as both are different in their substance and goals.⁷ In particular, we acknowledge that unlike trade marks, GIs not only serve the commercial purposes of private actors, but may also strengthen rural economies and preserve local traditions as important cultural elements.⁸ While we do not doubt the importance of those goals, we are of the opinion that they do not give *carte blanche* regarding the interests of those who are negatively affected by a system which risks being imbalanced in its scope. Against this background, the following Opinion on the proposed regulations addresses three areas that give rise to concerns about insufficient checks and balances: (1) the expansion of exclusive rights; (2) the lack of appropriate limitations of protection; and (3) the rules on the seizure of goods in transit. In the following section, we discuss these points in more detail.

Expansion of exclusive rights

Protection of product appearance

Whereas GI protection only pertains to a geographical (or traditional) name, protection under the pertinent provisions extends to (elements of) its appearance, as was decided by the Court of Justice of the European Union (CJEU) in *Morbier*.⁹ This aspect has not been limited or qualified by the new proposal. In *Morbier*, the court held that reproducing the shape of a product, or some of its characteristic features, is impermissible if such use misleads consumers as to the true origin of the product, bearing in mind the overall factual context in which the product is marketed.¹⁰ The court emphasised that where

the reproduced feature ‘constitutes a baseline characteristic which is particularly distinctive of that product ... its reproduction may, in conjunction with all the relevant factors ... lead the consumer to believe that the product containing that reproduction’ is an authorised GI product.¹¹ Our concern is that this over-emphasises distinctive product characteristics without much consideration of the effects on competitors.¹² Protecting features of appearance may have negative repercussions for competition in instances where protection is extended to features that serve functional purposes, or that for other reasons should remain free for others to use.¹³

This is due to the fact that unlike trade mark law, it is not possible to address such competition-inhibiting concerns during GI registration proceedings. In trade mark law, applicants seeking to directly register shapes as marks must confront functionality exclusion scrutiny.¹⁴ By contrast, for GI applications, only product names (i.e. words) are applied for. Yet the CJEU has extended the scope of protection to GI product shapes and features through a chain of associations—where these features create potentially misleading links with the original GI product and therefore with the registered GI name, they cannot be used regardless of whether they are also functional.¹⁵ It is presently unclear how a non-GI producer may reproduce a key product feature, in order to provide consumers with a competitive substitute, without falling foul of the prohibition against misleading use. It should be noted that this is a third party *not* using the protected GI name in any way. In the absence of comparable safeguards in GI law, problematic restrictions of competition may emerge when infringement claims are raised against another product showing features similar to those to which the GI pertains. With the envisaged extension of GI protection to craft and industrial products in the CIPP, the practical relevance of the issue will further increase. For instance, if design features or motifs of traditional textiles fall within the scope of GI protection, GI law is an effective substitute for design or copyright law, offering potentially permanent protection. It should therefore be clarified that claims for GI protection aiming at prohibiting the marketing of products

⁷ For a discussion of the relationship between trade marks and geographical indications, see Dev Gangjee, “Quibbling Siblings: Conflicts between Trademarks and Geographical Indications” (2007) 82 *Chicago-Kent Law Review* 1253, 1253–1291; Burkhardt Goebel and Manuela Groeschl, “The Long Road to Resolving Conflicts Between Trademarks and Geographical Indications” (2014) 104 *The Trademark Reporter* 829; Alexandra Grazioli, “OMC—La protection des indications géographiques et des marques” (2005) *Zeitschrift für Immaterialgüter-, Informations- und Wettbewerbsrecht* 902.

⁸ See for e.g. Recitals 1–4 and arts 1, 4 of Regulation 2012/1151; Opinion of AG Čapeta on 17 March 2022 in *European Commission v Kingdom of Denmark* (C-159/20) EU:C:2022:198 at [63] (GI protection ‘enables survival of traditional businesses and ensures the diversity of products in the market... [it thereby] takes into consideration other interests besides economic interests’).

⁹ *Syndicat interprofessionnel de défense du fromage Morbier v Société Fromagère du Livradois SAS (Morbier)* (C-490/19) EU:C:2020:1043. This applies if elements of its appearance are distinctive enough to create a link in a consumer’s mind with a GI-protected product.

¹⁰ *Morbier* (C-490/19) EU:C:2020:1043 at [36]–[38].

¹¹ *Morbier* (C-490/19) EU:C:2020:1043 at [40].

¹² This concern was noted in *Morbier* by Advocate General Pitruzzella (EU:C:2020:730 at [44]), and by the referring court; however, it was not addressed (at least not explicitly) by the CJEU.

¹³ For instance, if Champagne had historically claimed its golden colours or the bubbles resulting from secondary fermentation within the bottle as distinctive features, Cava or Prosecco may never have been established.

¹⁴ Article 7(1)(e) EUTMR; art.4(1)(e) TMD. Cf. *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* (C-299/99) EU:C:2002:377; [2002] 2 C.M.L.R. 52; *Lego Juris A/S v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-48/09 P) EU:C:2010:516; [2010] E.T.M.R. 63; *Hauck GmbH & Co KG v Stokke A/S* (C-205/13) EU:C:2014:2233; [2014] E.T.M.R. 60; *Gomboc Kutato, Szolgálatok és Kereskedelmi Kft v Szellemi Tulajdon Nemzeti Hivatala* (C-237/19) EU:C:2020:296; [2020] E.T.M.R. 41.

¹⁵ It is true that the CJEU did address certain safeguards in *Morbier* at [36] and at [39]; however, they are not strong enough and fail to address the relevant point.

with a special appearance should be excluded where the relevant features are functional in the broad sense that they enhance the quality¹⁶ or usability of the goods.

Protection against dilution

By amendment effected by Regulation 2021/2117, the notion of prohibiting a use which ‘exploits, weakens or dilutes’ the GI has been introduced into art.13(1)(a) Regulation 2012/1151 (corresponding to art.27(1)(a) APFP and art.35(1)(a) CIPP). In the case of trade marks, dilution in the form of producing detrimental effects on the reputation or distinctive character enjoyed by a mark with reputation is only assumed to occur if the economic behaviour of consumers has changed, or is likely to change, as a consequence of the use made.¹⁷ For clarification purposes, it should be pointed out that the same standard applies, both in art.27(2) APFP (which also explains the concept of evocation) and art.35(2) CIPP, or in the preamble to these proposals.

Absence of due cause defence

In a notable departure from trade mark law, non-misleading modes of GI infringement as set forth in art.13(1)(a) and (b) (art.27(1)(a) and (b) APFP and art.35(1)(a) and (b) CIPP) are not subject to the open-ended defence of ‘due cause’.¹⁸ This raises concerns, considering that with few exceptions,¹⁹ the scope of GI protection has been interpreted very broadly by the CJEU,²⁰ in particular in its judgments concerning the notion of evocation. In order to ensure that the effects of the codification of that jurisprudence—as envisaged in art.27(2) APFP and art.35(2) CIPP—do not result in overprotection, it is appropriate to also leave room for a defence in case of ‘due cause’ for engaging in certain actions. Providing for such a defence would be all the more important if, contrary to the arguments and proposals made here (in the section titled “Lack of appropriate limitations of protection”), the amended GI legislation should eventually not provide for an express exemption of certain forms of use in a catalogue of limitations of exclusive rights.²¹

Lack of appropriate limitations of protection

Referential use

Considering the broadening of the referential use defence in the framework of the 2015 trade mark law reform,²² it is striking that the proposed regulations remain silent on the issue of referential use in a GI context. The discussion in trade mark law has led to the insight that the exemption of referential use offers important breathing space for acts of fair competition that enhance both consumer information and consumer choice. The more reticent attitude in GI legislation is rooted inter alia in the fact that certain types of referential uses (such as use accompanied by an expression such as ‘style’, ‘type’, ‘method’, ‘as produced in’, ‘imitation’ or similar) are prohibited not only under EU law, but also under the Lisbon Agreement (Geneva Act)²³ and, with regard to wines and spirits, by the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs).²⁴ However, considering the importance of a well-developed referential use defence as an element of particular value for freedom of competition and consumer empowerment, it is advisable to strictly limit the legal barriers against truthful and relevant statements to the minimum prescribed by international norms. Doing more than that seriously risks jeopardising the reconciliation of GI protection with other fundamental rights, such as freedom of expression, freedom to conduct one’s business, and freedom of the arts.²⁵

In practice, the introduction of an explicit permission for referential use could provide a solution for issues arising from the use of GI products as ingredients, which is more adequate than what is set forth in the current and proposed legislation. Current Regulation 2012/1151 stipulates that the modalities of infringement set forth in art.13(1)(a) and (b) also apply if a product protected under the GI is used as an ingredient. The pending proposals set forth that reference to GIs as ingredients of a processed product is permitted, provided that the use is made in accordance with honest commercial practices and does not ‘weaken, dilute or detrimentally affect’ the reputation

¹⁶ One might also consider inserting wording similar to that in art.7(1)(e)(iii) EUTMR, to the effect that elements giving the product its (aesthetic) value should remain free for others to use, with protection resting only in the indication of geographic origin.

¹⁷ *Intel Corp Inc v CPM United Kingdom Ltd* (C-252/07) EU:C:2008:655; [2009] E.T.M.R. 13 at [77]; *Environmental Manufacturing LLP v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-383/12 P) EU:C:2013:741 at [37].

¹⁸ Article 9(2)(c) EUTMR; art.10(2)(c) TMD. Cf. *Interflora Inc v Marks & Spencer Plc* (C-323/09) EU:C:2011:604; [2012] E.T.M.R. 1; *Leidseplein Beheer BV v Red Bull GmbH* (C-65/12) EU:C:2014:49; [2014] E.T.M.R. 24; *Moët Hennessy/Cedric Art case A2018/1/8*, Benelux Court of Justice, 14 October 2019, *Berichten industriële eigendom* 2020, 25.

¹⁹ See *De Landtsheer Emmanuel SA v Comité Interprofessionnel du Vin de Champagne (CIVC)* (C-381/05) EU:C:2007:230; [2007] 2 C.M.L.R. 43 at [70], and *Comité Interprofessionnel du Vin de Champagne v Aldi Sud Dienstleistungs-GmbH & Co OHG (Champagner Sorbet)* (C-393/16) EU:C:2017:991.

²⁰ *Comité Interprofessionnel du Vin de Champagne v GB (Champanillo)* (C-783/19) EU:C:2021:731; *Fundacion Consejo Regulador de la Denominacion de Origen Protegida Queso Manchego v Industrial Quesera Cuquerella SL (Queso Rocinante)* (C-614/17) EU:C:2019:344; *Scotch Whisky Association v Klotz* (C-44/17) EU:C:2018:415; *Viiniverla Oy v Sosiaali- ja terveystieteiden tutkimuskeskus (C-75/15)* EU:C:2016:35.

²¹ It is true that in *Champagner Sorbet* (C-393/16) EU:C:2017:991, the court declared that exploitation of renown was not unfair and therefore permissible if certain requirements were met (see below, section titled “Referential use”). However, as long as that qualification is not set forth in the law itself, its application remains precarious, in particular as the solution found by the CJEU in the actual case shall be overruled by the amendments (see notes infra).

²² Article 14(1)(c) EUTMR; art.14(1)(c) TMD.

²³ Article 11(2) Lisbon Agreement (Geneva Act).

²⁴ Article 23(1) TRIPs.

²⁵ Cf. Martin Senftleben, Lionel Bently, Graeme Dinwoodie et al., “The Recommendation on Measures to Safeguard Freedom of Expression and Undistorted Competition: Guiding Principles for the Further Development of EU Trade Mark Law” (2015) 37 E.I.P.R. 337, 337–343; Martin Senftleben, “Robustness Check: Evaluating and Strengthening Artistic Use Defences in EU Trademark Law” (2022) 53 *International Review of Intellectual Property and Competition Law* 567, 567–603.

of the geographical indication.²⁶ Moreover, use of the GI in a product name shall be prohibited per se, unless it is authorised by an agreement with the relevant producer group.²⁷ The latter provision precludes the solution endorsed by the CJEU in *CIVC v Aldi*,²⁸ where the CJEU declared that using the name ‘Champagner Sorbet’ for ice cream containing champagne only amounts to (unfair) exploitation of the renown enjoyed by champagne if the taste of the product is not essentially attributable to the presence of that ingredient.²⁹ Specific Guidelines issued by the Commission in 2010 (2010/C 341/03) on the labelling of foodstuffs also allowed the referential use of GIs as ingredients, both in the ingredient lists as well as in the trade designation. In light of these precedents, the appropriateness of the more rigid solution endorsed in the two proposals appears questionable. The current proposals also run against the Commission’s 2020 Circular Economy Action Plan, which promotes the use and re-use of existing products, including GI products.

Under a referential use defence, references to GIs used as ingredients should be subject only to a flexible standard of fairness and honest practices. Further qualifications only complicate the matter, especially where new concepts are introduced such as ‘weakening’ the reputation of the GI—the contents and impact of which in relation to detriment and dilution remain unclear. A flexible referential use defence under a standard of honest practices is also the preferable solution in cases where a GI is being used as part of a product name. First, the distinction between ‘GI-product’ and ‘product made with GI’ which it implies may be very subtle, and should better be assessed on a case-by-case basis. Second, relying on fairness-related standards instead of allocating the right to authorise such uses to producer groups suits the character of GIs as non-tradeable goods much better than institutionalising a system that comes close to licensing.

Comparative advertisement

Pursuant to art.4(e) of the Directive on Misleading and Comparative Advertising (MCAD), comparisons are permitted for products with a designation of origin, if—in addition to fulfilling the other requirements listed in art.4 MCAD—they relate ‘in each case to products with the same designation’. This could be understood as indicating that products covered by a protected designation of origin (PDO) cannot be compared with other products of the same kind that are not covered by a PDO. The CJEU considered the implications of that interpretation in *De Landtsheer v CIVC*, holding that

“where all the other conditions governing whether such advertising is permissible are met, protection of designation of origin which would have the effect of prohibiting absolutely comparisons between products without designation of origin and others with designation of origin would be unwarranted and could not be justified under the provisions of [then] Article 3a(1)(f) of the directive.”³⁰

In spite of that ruling, the ambiguous wording in art.4(e) MCAD has remained unchanged, thus creating a continuous risk that entrepreneurs will be discouraged from making truthful comparisons. The current process of amending and introducing new GI legislation provides a welcome opportunity to finally change the provision so that it complies with the CJEU judgment.

Use of own name and address

It is a generally acknowledged principle of trade mark law that use of one’s own name and address remains legitimate in spite of an identical or similar sign being registered for identical or similar goods or services, provided that the use complies with honest practices. No such safeguard is provided in the EU GI system, although the Lisbon Agreement (Geneva Act) in art.13(2) at least permits the use of one’s personal name in business. More important than that would be the permission to indicate one’s address. Of course, however, we realise that this is a sensitive point, as it eventually would allow the indication of localities or regions designated by a GI as part of the address of producers established in the region that do not comply with the product specifications. On the other hand, it is a serious encroachment on the freedom to impart and receive information as protected under art.11 of the EU Charter of Fundamental Rights and if the right to provide truthful information to consumers about the locality of one’s establishment is denied to producers that do not fulfil particular requirements drawn up by associations that they may not be, nor want to become, a member of (‘outsiders’). This applies even more if, as decided by the CJEU,³¹ it is prohibited for an outsider to evoke an association with geographic origin, under all circumstances.

Goods in transit

The protection conferred by art.27(1) APFP and art.35(1) CIPP shall also apply to transit goods entering the customs territory of the EU without being released into free circulation (art.27(4)(a) APFP and art.35(4)(a) CIPP).

²⁶ Article 28(1) APFP; art.36(1) CIPP

²⁷ Article 28(2) APFP; art.36(2) CIPP

²⁸ See *Champagner Sorbet* (C-393/16) EU:C:2017:991.

²⁹ *Champagner Sorbet* (C-393/16) EU:C:2017:991.

³⁰ *De Landtsheer v CIVC* EU:C:2007:230; [2007] 2 C.M.L.R. 43 at [70].

³¹ *Queso Manchego* (C-614/17) EU:C:2019:344.

The parallel provision in art.9(4) EUTMR stipulates that measures taken by customs lapse in case the holder of the goods establishes in subsequent infringement proceedings that the holder of the trade mark cannot prohibit the release of the goods on the market in the country of destination. Without such a clause, the provision would most likely clash with art.V GATT (freedom of transit).³² It is unclear why such precautions were not taken with regard to GIs, in spite of the fact that use of designations protected in the EU may be perfectly legal in other parts of the world. The problems eventually caused are enhanced by the fact that, different from the current version of the transit provision inserted into Regulation 2012/1151 by Regulation 2021/2117, the proposals stipulate that the prohibition is not only targeted at products bearing a sign identical to the protected GI (corresponding to ‘counterfeit products’ in trade mark law),³³ but extends to all cases of infringement under art.27(1) APFP and art.35(1) CIPP respectively. This includes indirect use, evocation, and similar, very broadly construed infringing acts. This is not only flawed from a legal perspective, but it also exacerbates the burden placed on customs to monitor and detect such infringements, which typically require rather sophisticated evaluations.³⁴

At the international level, the proposed extensive measures against goods in transit expose the EU to potential dispute settlement actions before the WTO.³⁵ Transit seizures based on the specific EU approach to GIs is likely to raise international opposition to a larger extent than in the case of trade marks. The level of international harmonisation in the GI domain is much lower than in the case of trade marks.³⁶ Arguably, transit seizure measures based on the specific EU approach extend the impact of this particular approach to other countries that regulate GI protection differently. As a minimum, the transit provisions should therefore include all additional safeguards that have been included in trade mark law in the context of the 2015 trade mark law reform.

Summary and conclusions

We therefore propose:

- to clarify that prohibiting marketing of products showing certain features of appearance cannot be based on GIs if the

features concerned are functional in the sense that they enhance the quality or usability of the goods;

- to clarify that dilution in the form of producing detrimental effects on a GI is only assumed to occur if the economic behaviour of consumers has changed, or is likely to change, as a consequence of the use made;
- to complement the list of non-misleading modes of GI infringement as set forth in art.13(1)(a) and (b) (art.27(1)(a) and (b) APFP and art.35(1)(a) and (b) CIPP) by an open-ended defence of ‘due cause’;
- to provide a catalogue of limitations of the rights conferred by a GI, including:
 - referential use, in particular concerning ingredients or recipes,
 - use in comparative advertisement, together with a deletion, or change of the wording of art.4(e) MCAD,
 - use of one’s name and address, provided that such uses are compatible with honest business practices;
- to ensure that measures against goods in transit are:
 - limited to products bearing a sign identical with (or indistinguishable from) the protected GI,
 - provide for procedural safeguards in case marketing of the goods cannot be prohibited by the GI owners in the country of destination.

Signatures

Group of experts contributing to the drafting of the Recommendation

Annette Kur

Affiliated Research Fellow, Max Planck Institute for Innovation and Competition, Munich, Germany

³² Henning Große Ruse-Khan, “An international trade perspective on transit seizures” (2013) 39 *BMM Bulletin* 142, 148. Cf. Vincenzo Di Cataldo, “Goods in Transit and Trade Mark Law (and Intellectual Property Law?)” (2018) 49 *International Review of Intellectual Property and Competition Law* 436, 436–451; Henning Große Ruse-Khan, *The Protection of Intellectual Property in International Law*, (Oxford: Oxford University Press, 2016), p.309; Martin Senftleben, “Wolf in Sheep’s Clothing? Trade Mark Rights Against Goods in Transit and the End of Traditional Territorial Limits” (2016) 47 *International Review of Intellectual Property and Competition Law* 941–959.

³³ Cf. the definition of ‘counterfeit trademark goods’ in fn.14(a) of the TRIPS Agreement, accompanying art.51 TRIPS.

³⁴ For instance it took over a decade of litigation for the CJEU to finally determine that the EUTM PORT CHARLOTTE for whisky was not a prohibited evocation of the protected PDO Port and validly registered: *EUIPO v Instituto dos Vinhos do Douro e do Porto* (C-56/16 P) EU:C:2017:394.

³⁵ As to an earlier WTO dispute settlement in this area, see WTO Panel, 15 March 2005, WTO Document WT/DS174/R, “European Communities—Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs”, based on a complaint by the US and the twin report WTO Document WT/DS290/R dealing with a parallel complaint by Australia. Cf. Martin Senftleben, “Towards a Horizontal Standard for Limiting Intellectual Property Rights?—WTO Panel Reports Shed Light on the Three-Step Test in Copyright Law and Related Tests in Patent and Trademark Law” (2006) 37 *International Review of Intellectual Property and Competition Law* 407, 407–438.

³⁶ As to the ongoing international debate on the protection of geographical indications, see Michael Handler and Robert Burrell, “GI Blues: The Global Disagreement over Geographical Indications”, in Kathy Bowrey, Michael Handler and Dianne Nicol (eds), *Emerging Challenges in Intellectual Property*, (Oxford: Oxford University Press, 2011), p.126, pp.126–144; Justin Hughes, “Champagne, Feta, and Bourbon: The Spirited Debate about Geographical Indications” (2006) 58 *Hastings Law Journal* 299, 299–386; Molly Torsen, “Apples and Oranges (and Wine): Why the International Conversation Regarding Geographical Indications is at a Standstill” (2005) 87 *Journal of the Patent and Trademark Office Society* 31, 31–61; José Manuel Cortés Martín, “The WTO TRIPS Agreement—The Battle Between the Old and the New World over the Protection of Geographical Indications” (2004) 7 *Journal of World Intellectual Property* 287, 287–326.

Irene Calboli	Visiting Professor, IE Law School, Madrid, Spain, Academic Fellow, University of Geneva, and Regents Professor of Law Texas A&M University School of Law
Dev Gangjee	Professor of Intellectual Property Law, Faculty of Law, University of Oxford, UK
Anke Moerland	Associate Professor of Intellectual Property Law, European and International Law Department, Maastricht University, The Netherlands
Martin Senfleben	Professor of Intellectual Property Law and Director, Institute for Information law (IViR), University of Amsterdam, The Netherlands

First Signatories

Lotte Anemaet	Assistant Professor of Intellectual Property Law, Vrije Universiteit Amsterdam, The Netherlands
Davide Arcidiacono	Associate Professor of Commercial Law, University of Catania, Italy
Enrico Bonadio	Reader in Intellectual Property Law - City, University of London, UK
Lavinia Brancusi	Adiunkt, Institute of Law Studies, Polish Academy of Sciences, Warsaw, Poland
Bernardo Calabrese	Associate Professor of Commercial Law, University of Verona, Italy
Vincenzo Di Cataldo	Professor of Commercial Law, University of Catania, Italy
Jennifer Davis	Member, Centre for Intellectual Property and Information Law (CIPIL), Faculty of Law, University of Cambridge, UK
Graeme Dinwoodie	Global Professor of Intellectual Property Law & University Distinguished Professor IIT Chicago-Kent College of Law, USA
Mireille van Ee-choud	Professor of Information Law, Institute for Information Law (IViR), University of Amsterdam, The Netherlands
Ilanah Fhima	Professor of Intellectual Property Law, University College London, UK
Christophe Geiger	Professor of Law, Luiss Guido Carli University, Rome, Italy
Stef van Gompel	Professor of Intellectual Property, Vrije Universiteit Amsterdam, The Netherlands
Claes Granmar	Researcher and Associate Professor, Faculty of Law, Stockholm University, Sweden
Henning Ruse-Khan	Professor of Law and Co-Director, Centre for Intellectual Property and Information Law (CIPIL), Faculty of Law, University of Cambridge, UK
Reto Hilty	Director, Max Planck Institute for Innovation and Competition, Munich, Germany
Robin Jacob	Sir Hugh Laddie Chair of Intellectual Property Law, Faculty of Law, University College London, UK

Sabine Jacques	Associate Professor of Intellectual Property Law, University of East Anglia, UK
Marie-Christine Janssens	Professor Intellectual Property Law, University of Leuven (KU Leuven), Belgium
Bernd Justin Jütte	Assistant Professor in Intellectual Property Law, Sutherland School of Law, University College Dublin, Ireland
A n a s t a s i a Kyrylenko	Affiliated Researcher, University of Alicante, Spain
Nari Lee	Professor of Intellectual Property Law, Hanken School of Economics, Helsinki, Finland
Matthias Leistner	Chair of Private Law and Intellectual Property Law, with Information and IT-Law (German Association for the Protection of Intellectual Property (GRUR) Chair), Faculty of Law, Ludwig Maximilian University, Munich, Germany
Luigi Mansani	Professor of Intellectual Property Law, University of Parma, Italy
Guido Noto La Diega	Associate Professor of Intellectual Property and Privacy Law, University of Stirling, UK
Ansgar Ohly	Professor of Intellectual Property Law, Ludwig Maximilian University, Munich, Germany
Luminita Olteanu	Fellow, London School of Economics and Political Science, London, UK
João Pedro Quintais	Assistant Professor, Institute for Information Law (IViR), University of Amsterdam, The Netherlands
Marco Ricolfi	Professor, Department of Jurisprudence, University of Turin, Italy
Eleonora Rosati	Professor of Intellectual Property Law and Director, Institute for Intellectual Property and Market Law (IFIM), Stockholm University, Sweden
Jan Rosen	Professor, Stockholm Centre for Commercial Law (SCCL), Stockholm University, Sweden
Jens Schovsbo	Professor, Center for Information and Innovation Law (CIIR), University of Copenhagen, Denmark
Caterina Sganga	Associate Professor of Comparative Private Law, Scuola Superiore Sant'Anna (Pisa), Italy
Jaap Spoor	Professor (emeritus) of Intellectual Property Law, Vrije Universiteit Amsterdam, The Netherlands
Anna Tischner	Professor, Intellectual Property Law Chair, Jagiellonian University, Krakow, Poland
Paul Torremans	Professor of Intellectual Property Law, University of Nottingham, UK
Charlotte Vrendenburg	Assistant Professor of Intellectual Property Law, Leiden University, The Netherlands
Andrea Zappalaglio	Lecturer in Intellectual Property Law, University of Sheffield, UK
Łukasz Żelechowski	Associate Professor, Department of Intellectual Property Law, University of Warsaw, Poland