

ABOUT BRANDS UNDER ATTACK

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Alternative to the Madrid Protocol in Canada:

DESCRIPTIVE GEOGRAPHICAL INDICATIONS OF ORIGIN

"There is more than one way to skin a cat" (so the proverb goes). Like the proverb, there is more than one way to secure a geographical descriptive mark. In this edition, we look at the obstacles faced by brands for wine, spirit, food, or other agricultural products that use the Madrid Protocol.

Background

The Consorzio del Prosciutto di Parma is responsible under Italian law to regulate the production of prosciutto di parma and the use of the PARMA mark.

However, in Canada, it was unable to stop others from using the PARMA mark for meats that did not originate in Parma, Italy. Those meats did not meet the standards for use of the mark.

The Consorzio unsuccessfully over a period of 10 years sought to register the mark PARMA in Canada to no avail.

At each turn of its application, it was blocked by a previous owner.

Lessons Learned

A national or international application has limitations when it comes to geographical descriptive marks.

To solve its issue, The Consorzio applied

for geographical indication.

This case illustrates a key business strategy which brand owners must keep in mind in case of brand warfare: Once entered on the list of Geographical Indications, a Geographical Indication is a powerful tool that can circumvent international and national limitations. Subject to prior existing rights, it has the same force as registration granting exclusive rights.

For more information on this, please contact a member of our team at:
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This briefing note is not legal or professional advice.

ABOUT US

OLLIP P.C. is an intellectual property agency and law firm with offices in Ottawa and Toronto, Canada.

We are the authors of the leading treatise *Odutola on Canadian Trademark Practice: Vol. I Prosecution and Vol. II Opposition, Summary Cancellation and Appeals*, published by Carswell, a Thomson Reuters Business. Now in its 16th year, it is relied on by the Courts, the Trademarks Office and the trademark profession.

OLLIP P.C. has one of the few lawyers who have been certified by the Law Society of Ontario as dual specialists in trademark and copyright law.

From advice, creation to enforcement - from brands, technology to copyrights - for over 24 years, successful businesses and their counsel have relied on us.

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