

Legal update

Say “cheese” ...but not “Taleggio cheese”: CETA’s impact on geographical indications in Canada

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Intellectual property

Canada’s regulation of geographical indications (GI) on products was substantially modified when major amendments to the [Trade-marks Act](#) came into force on September 21, 2017. These amendments stem from the Comprehensive Economic and Trade Agreement (CETA) between Canada and the EU.

The amendments are set to: increase the number of GIs eligible for protection by the *Trade-marks Act*, strengthen mechanisms for protecting those GIs and create a mechanism for opposing and cancelling GIs.

What is CETA and how is it being implemented?

CETA is a trade agreement signed in October 2016. It attempts to remove barriers to trade between the EU and Canada and covers a wide range of areas, including tariffs, labour, intellectual property and the operation of marine vessels.

It is being implemented in Canada predominantly by the [CETA Implementation Act](#), which amends multiple statutes, including the [Trade-marks Act](#). Those amendments came into force on [September 21, 2017](#).

How do the amendments affect GIs?

Protected Items

Historically, GI protections have been applied to wine and spirits, but these amendments immediately introduce over 170 new protected indications (with no possibility of opposition proceedings) for numerous categories of food and agricultural products, such as cheese, olives, oils, meats, spices, nuts, fruit, hops and beer. These include Feta, Asiago, Taleggio, Tomme de Savoie, Mozzarella di Bufala Campana cheeses, Kalamata olives, and Prosciutto di Parma ham, to take a few examples among many.¹

While only Canada and the EU are parties to CETA, the amendments to the *Trade-marks Act* also extend protections to Korean indications listed in the [Canada-Korea Economic Growth and Prosperity Act](#), and open the possibility for any country to protect its GIs upon application to the designated minister. CETA itself opens the possibility for Canadian producers and associations to protect equivalent Canadian designations in Europe.

New Protections and Methods of Seeking Protection

The key protections for goods prior to these amendments only applied to wine and spirits, and only if they did not originate from a given territory. However, with these amendments, the protections have been extended to food and agricultural products, including beer. Furthermore, under these amendments, the adoption and use of a protected GI is prohibited if the goods do not originate from the territory or, if they do originate there, are not produced under the rules of the territory.² One limitation is the GI is prohibited only if the impugned product is in the same category, such that “Bordeaux,” for example, can still be used for cookies or candies. The categorization follows the Harmonized Commodity Description and Coding System of the World Customs Organization.

The amendments have also extended the protection of the Canadian Border Services Agency (CBSA) to GIs. Prior to these amendments, under sections 51.03 and 51.04, a registered trademark holder could request assistance from the CBSA in combatting counterfeits of its trademarked products. Now the amended sections 51.03 and 51.04 extend the same border protections to GIs.

As a result of these increased protections, and a streamlined process, applications for GI protection are almost certain to increase, not merely from within Canada, the EU and Korea, but also from other countries such as the US and India.

Exceptions

There are a variety of exceptions to these new protections. These exceptions help shield both incumbent and non-incumbent businesses. Incumbent businesses who have used terms such as “Feta,” “Munster” or “Asiago,” among a few others³ will be exempt from the prohibitions if they have been using those terms since before various dates (depending on the term).

Other important exceptions to the prohibitions mentioned above arise⁴:

- where the responsible authority consents;
- in comparative advertising provided it is not on the label or packaging;
- where the GI is a person’s name;
- where the GI is the common name for the product in Canada. Some common names, such as parmesan cheese and black forest ham, have already been specified in the amended *Trade-marks Act*.⁵

Transition Period

The majority of the newly listed items in the amendments received protection as soon as the amendments came into force. However, there are three indications – “Beaufort,” “Nürnberger Bratwürste” and “Jambon de Bayonne” – that under certain circumstances will be exempt from the prohibition until September 21, 2022.⁶

Application and objection process

A government, trade association, or anyone else may file an application for a new geographical indication provided it is “by reason of state or commercial interest, sufficiently connected with and knowledgeable about that wine or spirit or that agricultural product or food.” The application is filed with the Canadian Intellectual Property Office (CIPO) along with the applicable fee. A trademarks examiner will examine it much like a regular trademark application (though on different grounds) and then make a recommendation to the designated minister. Once approved, the minister will cause the GI to be published on CIPO’s website as a proposed geographic indication.

Anyone may object to a proposed GI by filing a notice of objection within two months of publication. An objection may be based on technical or trademark grounds, including, for example, that the GI does not originate from the territory or

does not function as a GI, or is confusing with a pre-existing registered or unregistered trademark or trademark application.

CIPO has released a [notice](#) regarding the mechanism for making an objection under the amendments. The CIPO notice states the existing [practice guideline](#) regarding oppositions under s. 38 will apply to objections under s. 11.13

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Footnotes

- ¹ Schedule 6 at bottom of [Amended Provisions of Trade-marks Act](#). The list essentially imports [Annex 20-A](#) of CETA.
- ² Section 11.15 of the [Amended Provisions of Trade-marks Act](#).
- ³ Section 11.17, [Trade-marks Act](#).
- ⁴ Section 11.16 of the [Trade-marks Act](#) lays out exceptions related to consent, comparative advertising and person's name. Section 11.18(2) and 11.18(4.1) provides for the exceptions regarding common names.
- ⁵ Section 11.18(4.1), [Trade-marks Act](#).
- ⁶ See section 68.1 of the [CETA Implementation Act](#), which specifies the transitional effect of the *Trade-marks Act* amendments.

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