



## European IPR Helpdesk

### Case Study

# Lambrusco: protecting and enforcing a GI for wine products

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#### *Consorzio Tutela del Lambrusco di Modena*

*Consortium of wine producers*

*Wine products*

<http://www.tutelalambrusco.it/>



### Background

Lambrusco is a brightly coloured grape variety used to make sparkling red wines in Italy. In particular, the wine principally originates from four areas around the provinces of Modena, Parma, Reggio nell'Emilia, and Mantua.

In the European Union, the denomination "Lambrusco" is part of the following protected denominations of origin (PDOs)<sup>1</sup>.

PDO	Year of registration	
<i>Lambrusco di Sorbara</i>	1973	
<i>Lambrusco Grasparossa di Castelvetro</i>	1973	
<i>Lambrusco Salamino di Santa Croce</i>	1973	
<i>Lambrusco Mantovano</i>	1996	

<sup>1</sup> At European Union level, geographical indications can be protected as protected denominations of origin (PDOs) or as protected geographical indications (PGIs). Both PDOs and PGIs confer exclusive rights on geographical names but they express different level of connection with the relevant geographical area. For further information, read "Protecting Geographical Indications" in our [Bulletin n. 22](#) on page 2.

Due to their inclusion in the register of the PDOs, these designations can be used only in connection with wines satisfying the conditions and requirements of the wine specifications (origin zones' boundaries, the percentages of grapes to use in the vinification, the maximum limits of the grapes output, the natural minimum alcoholic strength, the product's final characteristics, etc.).

Consorzio Tutela del Lambrusco di Modena (hereinafter, the "Consortium") is one of the Consortia responsible for protecting the interests of producers respecting the relevant product specifications and thus entitled to use the above-mentioned geographical indications (GIs).

## 1. Problem faced

In 2009, the trademark application "*Lambrusco dell'Emilia Canottieri*" was filed before the Spanish Trademark and Patent Office (OEPM) in relation to wines falling in the international class 33.

Although the trade mark did not entirely reproduce the protected denominations, its registration would have been in conflict with the earlier PDOs. Indeed, the scope of protection of a GI is not limited to the exact reproduction of the protected geographical name but it also prevents its partial reproduction and the use of names directly or indirectly evoking the denomination.

Furthermore, the applicant was not a producer respecting the relevant PDO specifications and, as a consequence, he was not entitled to use the denomination in a label.

Although the OEPM refused to register the trademark due to the existence of earlier conflicting geographical indications, the applicant appealed the decision before the Spanish Court, insisting on obtaining the registration of the refused trademark.

## 2. Actions undertaken

Thanks to the activation of a trade mark surveillance service<sup>2</sup>, the Consortium was soon informed about the filing of the conflicting trade mark applications in Spain.

The registration and the subsequent use of such a trade mark was deemed detrimental for all those producers strictly observing the Lambrusco GI specifications. Indeed, they would have lost their competitive advantage originating by the exclusive right to use the denomination "Lambrusco" in the Spanish market.

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<sup>2</sup> Trade mark surveillance keeps proprietors informed about published applications of identical or similar trademarks and/or other distinctive signs (e.g. geographical indications) in their class in a certain territory (e.g. European Union). Private specialised companies or IP consultancy firms generally offer such services.

Furthermore, the use of this trademark would have misled consumers buying wine bottles displaying the trademark in the wrong belief that that wine possessed the same quality and characteristics of a PDO Lambrusco wine.

Therefore, the trademark attorney of the Consortium, based in Italy, decided to put in place all legal efforts in order to defend the interests of the PDO Lambrusco producers.

The Italian attorney, supervising the matter and in cooperation with the Spanish colleague, suggested intervening in the legal proceeding before the Spanish Court, arguing as follows:

1. The term “Lambrusco” is a distinctive part of the geographical indications that have been protected as PDOs for a long time. Therefore, the registration of the term “Lambrusco” in a trade mark should be prevented due to the conflict with earlier PDOs.
2. Despite what the trademark applicant argued, the term “Lambrusco” cannot be considered generic since, by law, a geographical indication already entered in the register of the GIs cannot be declared generic.

### 3. Outcome

The Spanish Court agreed with these arguments and declared the definitive refusal of the trademark applications encompassing “Lambrusco”.

This decision constitutes an important achievement for the all the PDO Lambrusco producers who will be able to use the term “Lambrusco” on an exclusive basis in the Spanish wine market.

### 4. Lessons learned and suggestions

Geographical indications (GIs) are valuable intangible assets and their protection and enforcement constitute a crucial step to retain the related competitive advantage.

In particular, as shown by this case study, in order to prevent the registration of a GI as a trade mark by a third party, **GI product producers** (generally consortia of producers on their behalf) should:

➤ Protect the GI

Protecting a GI, with a registration or an available different means<sup>3</sup>, is necessary to prevent registration of the indication as a trade mark by a third party and to avoid the indication becoming a generic term.

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<sup>3</sup> For further information on how to protect a GI, read “Protecting Geographical Indications” in our [Bulletin n. 22](#) on page 2.

➤ Monitor trade mark registries

Detecting any new trade mark application in conflict with an earlier protected GI is decisive in order for right holders to react in a timely manner. Monitoring of trade mark registries can be performed by consulting available online databases (e.g. [TMview](#)) or by activating a trade mark surveillance service provided by specialised companies who regularly inform you about conflicting trade mark applications.

➤ Enforce the GI with the assistance of an IP attorney

Protecting a GI does not only involve obtaining a right but also effectively enforcing it. In a case where a conflicting trade mark has been filed, it is advisable to contact a local IP attorney who will suggest the best way to proceed. Indeed, depending on the relevant jurisdiction and the practice of the intellectual property office concerned, different options might be available (e.g. filing a trade mark opposition).

On the other hand, in order to avoid conflicts with an earlier registered GI, **trade mark applicants** should:

➤ Perform an anteriority search on GI registries

Several online databases are available to find out if a geographical indication is protected in a certain territory. GIs registered at European Union level as PGIs<sup>4</sup> or PDOs can be accessed via four databases<sup>5</sup> maintained by the European Commission:

- [DOOR](#) for foodstuffs
- [E-BACCHUS](#) for wines
- [E-SPIRIT-DRINKS](#) for spirits
- the [file of Aromatised Wines](#)<sup>6</sup>.

➤ Be aware of the GI scope of protection

Also, a partial reproduction of an earlier registered GI could prevent the registration of a later trade mark.

<sup>4</sup> See footnote no.1.

<sup>5</sup> To have further information on how to search for protected GIs, read "*Searching Geographical Indications*" in our [Bulletin n. 22](#) on page 12.

<sup>6</sup> Aromatised wines are products obtained from products of the wine sector that have been flavoured. For further information concerning their protection as a GI in the European Union, see Regulation (EU) No 251/2014 of the European Parliament and of the Council of 26 February 2014 on the definition, description, presentation, labelling and the protection of geographical indications of aromatised wine products.

## GET IN TOUCH

**For comments, suggestions or further information, please contact**

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