



## GI registrations for “*Prosciutto di Parma*”

Nami Togawa (partner/patent attorney)

Miwako Takimura (attorney-at-law)

Seiwa Patent & Law (Tokyo, JAPAN)

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### Abstract

The Japan Geographical Indication (GI) Law, which came into force in 2015, newly provides protection for GIs via registrations. Seiwa acted as representative in applications for GI registrations of indications “*Prosciutto di Parma*”, etc., which became registered in September 2017 as the first non-Japanese geographical indications successfully registered in Japan. This article summarizes the characteristics of the GI system in Japan.

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### 1. GI registrations for “*Prosciutto di Parma*”

The Japan Geographical Indication (GI) Law came into force on June 1, 2015. The GI system protects, as intellectual property, names of “*foods*”, “*beverages*”, and “*agricultural and marine products*” whose specific features are closely related to their production areas. The GI protection system in Japan was established in accordance with the TRIPS agreement, which came into effect in 1995.

Indications “*Prosciutto di Parma*” and “*Parma Ham*”, each of which originates from Parma, Italy, along with Japanese transliterations thereof, received GI registrations in Japan

on September 15, 2017 (Registration No. 41)<sup>1</sup>. Represented by Seiwa, these are the first GI registrations granted in Japan for non-Japanese geographical indications.



(Example of package of sliced *Prosciutto di Parma*)



(An official ceremony to award the registration certificates was held in September 2017.)

## 2. Advantages of obtaining GI registrations in Japan

The main advantages of obtaining GI registrations in Japan are as follows:

### (1) GI registration is cost-effective

The only official fee necessary for receiving a GI registration is a registration tax of JPY90,000, which is to be paid to the Ministry of Agriculture, Forestry and Fisheries (MAFF). Once registered, a GI registration remains valid without renewal, unless it is cancelled. Thus, a GI registration is cost-effective in the long run.

### (2) GI registration enables a GI holder to exclude unqualified products more easily from the Japanese market.

<sup>1</sup> [http://www.maff.go.jp/e/policies/intel/gi\\_act/register.html](http://www.maff.go.jp/e/policies/intel/gi_act/register.html)

If an unauthorized third party illicitly uses a registered GI, the MAFF issues an injunction order to prevent the illicit use of the registered GI. If the infringer does not cease use of the GI, the MAFF can impose a penalty on the third party. Therefore, in order to exclude unqualified or counterfeit products bearing a registered GI, the GI holder does not have to send a cease and desist letter to, or file a lawsuit against, the infringer.

### (3) GI registration proves the quality of the product

A GI holder must state, in the specification attached to the application for GI registration, the quality standard of the product which must be satisfied. In addition, the MAFF regularly monitors the production process management so as to determine whether is conducted appropriately. Therefore, GI registration proves that the product satisfies a specific quality standard in the market.

## 3. Level of protection provided under the Japanese GI system

After registration, the registered GI enjoys protection against (a) indications identical to the registered GI and (b) indications similar to the registered GI, in connection with (i) forestry and fishery products and foodstuffs which belong to the same classification as the registered products, and (ii) forestry and fishery products and foodstuffs manufactured or processed using the registered product as a main raw material or ingredient (Article 3(2) of the GI Law).

Examples of “*indications similar to the registered GI*”, or “*similar indications*”, are indications which make it difficult to distinguish the products with such indications from the product according to the GI registration. According to Article 2 of the Enforcement Regulations of the GI Law, “*similar indications*” include:

- GIs on the product according to the GI registration, but with indication of a production area other than the production area according to the GI registration;
- Indications of a “type” or “style” of the registered GI, indications of being an imitation product, or indications accompanying expressions similar to the registered GI; and
- Translations of the registered GI.

For example, in a case where “*TOKYO APPLE*” is registered under the Japan GI Law, use of indications “*Tokio Apple*”, “*Tokyo Style Apple*” and “*Tokyo Ringo*” (“*Ringo*” is a translation of “*Apple*”), etc., will be prohibited by the MAFF.

## 4. GI logo

After registration, the producers group can enjoy protection of the GI and should use the following GI logo on their product.





Affixing the GI logo on a product indicates that the GI has been registered.

Under the Japan GI Law, the MAFF issues a correction (deletion, etc.) order against illicit use of the GI logo (Article 5 of the GI Law). Those who do not obey the order are subject to the following penalties (Articles 39 and 40 of the GI Law).

- In a case of illicit use of a registered GI: imprisonment of up to 5 years or a penalty of up to JPY 5 million for an individual, or a penalty of up to JPY 300 million for a group.
- In a case of illicit use of the GI logo: imprisonment of up to 3 years or a penalty of up to JPY 3 million for an individual, or a penalty of up to JPY 100 million for a group.

When a producer attaches a registered GI to a registered agricultural product or on its packaging, it must also attach the GI logo to the product or packaging. The MAFF regularly monitors producers of a group having a GI registration to determine whether they appropriately attach the GI logo to their products, and whether they conduct the production process and control the quality of the product in accordance with their guidelines.

## 5. Requirements for obtaining GI registrations

In order to obtain a GI registration, a GI must consist of a “name of a region” and a “name of a product”.

An applicant must be a group of producers, but does not have to be a legal entity. “*Foods*”, “*beverages*”, “*agricultural and marine products*” are eligible for GI registrations, while medicines, cosmetics, or alcoholic beverages are ineligible for GI registrations under the GI Law. Further, the products according to a GI registration must have been produced in the region for a certain period of time, i.e., around 25 years.

An applicant must identify and specify the “*production area*”, “*manufacturing process of the products*”, “*specific features of the products*”, “*quality control method*”, etc., in an application for GI registration. If a GI according to an application is identical or similar to a registered trademark in terms of “*mark*” and “*goods*”, the applicant must obtain permission from the holder of the trademark in order to receive a GI registration.

The process for registering a GI is as follows:

- A producers’ group in a geographical area decides on a quality standard of the product via discussion.
- The group then files an application for a GI, specifying the geographical scope, manufacturing process of the products, specific features of the products, etc., at the MAFF.
- The MAFF examines the application, seeking experts’ or other interested parties’ opinions.
- If the application satisfies the requirements under the GI Law, the MAFF then publishes the application in a gazette during a few months for any possible opposition.
- If the MAFF finds no grounds for refusal, the MAFF registers the GI.



## 6. Comparison between the GI Law and the Trademark Law in Japan

Since before the GI Law came into effect, there had already been a regional collective trademark system, which was established in 2006 under the Trademark Law in order to protect regional branding. The regional collective trademark system allows a trademark consisting solely of a region name and a product name to be registered as a “regional collective trademark”, provided that it meets several requirements prescribed under the Trademark Law.

However, the regional collective trademark system does not directly protect geographical indications in Japan, and entails several limits in terms of quality control and prevention of free-riding. The GI Law was newly introduced in order to overcome such limits.

One of the requirements for registration of a regional collective trademark is that a mark must be well-known among consumers in Japan as indicating the goods or services pertaining to the business of the applicant or its members, as a result of use of the mark. On the other hand, such a requirement does not exist under the GI Law.

	GI Law	Regional Collective Trademark
Scope of protection	Agriculture products, foods, beverages (other than alcoholic beverages)	All goods and services
Entities eligible as applicants	Groups of producers	Industrial business corporative associations, associations established under a special law, non-profit organizations (NPOs), etc.
Relation to the production area	It is necessary for the product to have specific features closely related to the production area.	It is only necessary for the product to be produced in the area.
Publicity	It is necessary for the product to have been produced for a certain period.	It is necessary for the trademark to be well-known through its use in Japan.
Quality control of the product	Necessary	Not necessary



	GI Law	Regional Collective Trademark
Labeling	It is mandatory for the GI registration holder to attach the registered GI and the “GI Mark” to the product or its packaging.	It is not mandatory for the trademark right holder to indicate that the trademark is registered.
Enforcement	The Minister of MAFF issues an injunction order against an illicit use of the registered GI.	A right holder can demand an injunction and damages against an illicit use of the registered trademark.
Examination	The Ministry of Agriculture, Fisheries and Food (MAFF)	The Japan Patent Office (JPO)
Nature of registration	GI registration is not a right of the GI registration holder.	Trademark registration is an exclusive right for the trademark registration holder to use the trademark.
Duration of protection	Indefinite	10 years (renewable)
Protection in non-Japanese countries	If mutual GI protection with a partner country is accomplished, the GI will be protected in the partner country as well.	Registration must be obtained in each country

## 7. Comparison between GI Law and Unfair Competition Prevention Law in Japan

The Unfair Competition Prevention Law also provides protection against unfair competition acts. Unfair competition acts prescribed in Article 2(1) of the Unfair Competition Prevention Law include:

“(i) acts causing confusion by using indications well-known among consumers as one’s own”;

“(ii) unjustifiable use of a famous indication as one’s own”; and

“(xiii) acts of misrepresenting information on goods or services, etc., in a manner that is likely to mislead the public as to the place of origin, quality, contents, manufacturing process, use or quantity of such goods, etc.”.

Under the Unfair Competition Prevention Law, if a third party’s use of a GI falls under the above acts (i), (ii) or (xiii) prescribed in Article 2(1), the producer of the product can demand an injunction against, and/or compensation as damages from, the third party’s use of the GI, provided that some requirements are met. On the other hand, under the GI Law, a registered group of producers can only expect the Minister of MAFF to issue an injunction order.



## 8. Conclusion

As summarized above, geographical indications were protected in Japan only by the Trademark Law and the Unfair Competition Prevention Law in the past. However, the newly-introduced GI Law can provide broad protection of GIs and assurance of the quality of products more cost-effectively and more efficiently.

Seiwa also obtained successful registration of the regional collective trademark for “*Prosciutto di Parma*”, which was the first regional collective trademark registered for a non-Japanese entity in Japan. We are proud of successfully obtaining the first GI registration granted in Japan for a non-Japanese producers’ group.

We will continue monitoring administrative measures taken by the MAFF against illicit use of registered GIs, and will share the information on any important cases with our clients.

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