

# PROTECTION OF GEOGRAPHICAL INDICATION: A NEW CONVERGENCE OR AN OLD DIVERGENCE?

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## **Abstract:**

*Geographical Indications was conceptualized in the Trade-Related Aspects of Intellectual Property Rights in 1995 (TRIPs Agreement) and become one of the most contentious intellectual property rights issues in the World Trade Organization (WTO) and other multiple treaties. The establishment of a multilateral system for the notification and the registration of Geographical Indications has been widely debated across the world in the last decades. The TRIPs mandates for the establishment of a multilateral system of notification and registration of GIs for WTO members. However, this new evolution has not been brought into effect even though it has been a decade since the first discussions on this issue at the Fourth WTO Ministerial Meeting in Doha in November 2001. At WIPO, the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications signed in May 2015 enlarges the international registration system to GIs as defined by TRIPs, but the negotiations have not come to an end so far. After providing a brief background to the protection for GIs in WTO/TRIPs, the paper analyzes the multilateral notification and registration system mandated by TRIPs and the Geneva Act of the Lisbon Agreement and its potential impacts for the further development of GI protection globally.*

**Keywords:** TRIPs, Doha negotiation, Geographical Indication, Register System, Geneva Act 2015.

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## **1. Geographical Indication: a new legal concept**

There was a multiplicity of regional and bilateral agreements on geographical indications, until the entry into force of the TRIPs, this subject matters was officially introduced in intellectual property system in the WTO and multiple treaties. This section provides an analysis of the TRIPs provisions relating to new concept GIs through five major headings: 1) definition, (2) Scope of protection,

(3) Homonyms and Generic Names, (4) relation between GIs and trademarks.

### **1.1. Definition**

The use of mark indicating the geographical origin for products from specific region has long existed and regulated by the law in the Middle Ages (O’Cornor, 2004,p.21). But the introduction of the TRIPs in the framework of the WTO marks a highlight on geographical indications protection on a world scale.<sup>1</sup>

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<sup>1</sup> For a detailed historical analysis of the provisions on GIs in the TRIPs Agreement see e.g., UNCTAD and ICTSD (2005).

This subject matter has been internationally accepted by the countries member of the TRIPs Agreement and differentiates from previous relating concepts as Appellations of Origin (WTO, 2004, p.73)<sup>2</sup> and Indications of Source<sup>3</sup>:

*...Geographical indications are [...] indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.*<sup>4</sup>

This concept is flexible enough and has overcome the limitations set out by previous international conventions and opened greater opportunities for the protection of geographical indications. This is based on the two following points:

First, signs protected as geographical indications are broader than appellations of origin. While appellations of origin are merely direct names indicating geographical places, geographical indications may be indirect name or indirect signs, such as images, symbols. There is no requirement for indication as a geographical name<sup>5</sup>, so a name of a country (Columbia, Thai's), a territory or just a city, a region (Bordeaux (France), Sarawak Pepper

(Malaysia), even the name of a mountain (Mau Son wines (Vietnam), a valley, an island (Phu Quoc fish sauce (Vietnam) or any place that can become geographical indications. In addition, the TRIPs agreement allows one name which is not a geographical name to be used for geographical indications (Darjeling (India) or Chaiya salted eggs (Thailand)<sup>6</sup>. The TRIPs agreement do not exclude iconic symbols or images having a connection with certain locations, as the Eiffel Tower for goods produced in France, Twin towers for Malaysia goods, which can be used to indicate goods origin. In some cases, the image of an individual can also help associate product origins. For example, the image of the Cuban leader Che Guevara is commonly used for cigarette products originating from Cuba (Le Thi Thu Ha, 2011).

Such really well-known images and symbols help consumers associate quickly with a certain geographical area. However, image information may also causes consumers to associate differently. For instance, is the Twin Tower image the symbol of Kuala Lumpur or of Malaysia in general? Thus, image signs should only be the information accompanying geographical names, help improve protection ability as well as better implement the function

<sup>2</sup> The term "appellation of origin" is quoted in the Madrid Agreement 1891, and then defined in the Lisbon Arrangement 1958. According to the latter, an Appellation of origin is the geographical name of a country, a region or a territories and is used to indicate a product which originates from it and the quality and characteristics of which are exclusively or mainly due to the geographical environment, including the natural and human factors.

<sup>3</sup> The term "indication of source" is used in Paris Convention 1883 and Madrid Agreement 1891 but there is no definition in those two treaties. Article 1(1) of the Madrid Agreement contains language which clarifies what is meant by the term. The indication of source relates to the geographical origin of a product and not to another kind of origin, for example, an enterprise that manufactures the product. This definition does not imply any special quality or characteristics of the product on which an indication of source is used.

<sup>4</sup> TRIPs, art 22.1.

<sup>5</sup> Rangnekar, Dwijen (2003) "Geographique Indications – A Review of Proposals at the TRIPs Council: Extending Article 23 to Products other than Wines and Spirits". Complete document available on: [http://www.ictsd.org/iprsonline/unctadictsd/docs/rangnekar\\_may2003\\_final.pdf](http://www.ictsd.org/iprsonline/unctadictsd/docs/rangnekar_may2003_final.pdf) p.22.

<sup>6</sup> Latha R. Nair & Rajendra Kumar (2005) "Geographical Indications: a search for identity", 2005, LexisNexis Butterworths, p95

of geographical indications. The use of merely image and symbol signs in some cases will cause confusion for consumers (Le Thi Thu Ha, 2011).

Second, this definition clearly excludes indications of source which do not indicate any quality, reputation or other characteristic of the product but just the geographical origin of such product. This requirement for the link between product quality and the geographical origin for geographical indications is lighter than the one requested for appellation of origin. Reputation is an additional element of the two qualifiers: quality and special characteristic, however, indications having one among the three above factors can be considered geographical indications. If goods having reputation but no specific quality brought by geographical origin are not protected by an appellation of origin, they can be protected by a geographical indication. The strict regulations on appellations of origin under the Lisbon agreement do not apply to non-agricultural products, therefore, regulations on geographical indications under the TRIPs agreement opens opportunities for local initiatives like for handicraft goods or industrial goods (Rangnekar, Dwijen, 2003). Therefore, geographical indications can be used for goods the reputation of which is based on. Non Hue hat (Vietnam) or Aranyik knives, Chantaburi sapphire, Sukhotai gold (Thai Lan).<sup>7</sup>

### ***1.2. Scope of protection***

The TRIPs Agreement does not provide for any specific regulation on the method for geographical indications protection. Three legal systems in three groups of countries are recorded with regards to this matters. Certain

countries in the European Union which have a long tradition of geographical indications protection (Spain, France, Italy and Portugal) often have their own law on geographical indications protection (called *sui generis*). Countries such as the United States, Canada, New Zealand protect geographical indications through an existing system of collective trademarks and certification trademarks. In addition, geographical indications are also protected under business law and competition law.

The new step of geographical indication protection under the TRIPs agreement is the difference level of protection: the minimum standard for geographical indications related to all products (Article 22 (2), a higher level of protection for wines and spirits (Article 23 (2) and an extra-additional protection only for wines. (Article 23 (1)

#### **- Minimum standard for all GIs**

TRIPs agreement requires WTO Members to provide legal means for the prevention of “the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good” and “any use which constitutes an act of unfair competition” under Article 10bis of the Paris Convention. This general protection aims at the prevention of misleading indications and unfair competition involving the registration of a geographical indication. The legal means for obtaining defensive protection would mainly be through unfair competition laws, common law rules on passing off or case

<sup>7</sup> Quoted by Latha R. Nair & Rajendra Kumar op.cit., p99 and O’Connor, O’Connor (2004), op.cit, p21.

law (Sisule F. Musungu, 2008). According to Gopalakrishnan, et al (2007), this approach has developed historically, starting out from the limited prohibition to use false indications of source only in cases where they were used together with false trade names in the Paris Convention, evolving to a prohibition of the use of false and deceptive indications of source in the Madrid Agreement on Indications of Source and to a general prohibition of the use of geographical indication which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention.

Higher level of protection for wines and spirits Article 23 of the TRIPs Agreement requires WTO Members to provide legal means for “interested parties to prevent use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of goods is indicated or the geographical indication is used in translation or accompanied by expressions such as “kind”, “type”, “style”, “imitation” or the like.” The main difference between the two level of protection remain at notion of ‘misleading the public’. The removal of the requirement of misleading the public means that GIs owners for wines and spirits are entitled to protection even when use of the geographical name would not mislead the public or constitute an act of unfair competition; and even in cases where the true origin of the product is indicated.

In the controversy debate between WTO’s members on the different level of protection

between geographical indications for wines and spirits and those for other products. It is interesting that the TRIPS definition of geographical indications does not distinguish between products and, therefore, constitutes both a premise and a precedent of harmonious, balanced protection of all geographical indications on all products alike. For ASEAN countries, almost are non-wine producing, so they are in favour of extending protection in line with Article 23(1) to products other than wines and spirits.<sup>8</sup>

#### - **Extra-additional protection only for wines**

Article 23 provides a mandate for the Council for TRIPS to undertake negotiations on the establishment of a multilateral system of notification and registration of geographical indications for wines eligible for protection in the Members participating in the system.

In 2001 during the Doha Round of TRIPS negotiations, the WTO Member States committed to reach an agreement on the creation of the Multilateral Register by the 5th Ministerial Conference to take place in Cancun in September of 2003. While the Doha Ministerial Declaration explicitly launches negotiations on establishing a multilateral system of notification and registration of GIs for wines and spirits, WTO Members are still debating whether negotiations are also mandated for the extension of the protection of GIs for products other than wines or spirits.

Thus, the WTO meeting in Cancun came and went without any agreement on a Multilateral Register. Since Doha, there has been absolute gridlock on this issue, largely the result of the vastly divergent positions taken by the EC and US.

<sup>8</sup> WT/GC/W/546 and TN/C/W/25.

### 1.3. Homonyms and Generic Names

#### - Homonyms

Homonyms are the geographical names identical in respect of spelling or pronunciation but designate different geographical areas, within a country or in different countries. Article 22.4 requires Each Member determine the practical conditions under which the homonymous indications will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled. One prominent example, which was much referred to in the negotiation of this provision, is “Rioja”, a name identifying wines coming from important wine producing regions in both Spain and Argentina. In this kind of situation, Article 23.3 provides for coexistence of the homonymous geographical indications, subject to Article 22.4 (i.e., provided there is no false representation to the public that a wine from a place identified by one of the geographical indications comes from the place identified by the other geographical indication). In providing for such coexistence each Member is required to determine the practical conditions to differentiate the geographical indications from each other, e.g. by way of labeling or the representation of a map showing the country where the region is. Differentiation should be done in a manner that ensures equitable treatment of the producers concerned and that consumers are not misled.

#### - Generic names

The provision in Article 24.6 of TRIPS provides an exception to obligation of protecting geographical indications for WTO Members if that indication is “*identical with the term customary in common language*

as the common name” for the goods or services in question in that Member, i.e. has become the generic term for describing the goods or services in the local language. The transformation of a GI into a generic term may occur in different countries and at different times. This leads to situations where a specific indication is considered to constitute a GI in some countries (whereas the same indication may be regarded as a generic term in other countries. Generic name notion do have an internationally agreed interpretation in domestic law but the interpretations is different in Member jurisdictions. Champagne is protected as GIs in Thailand, Malaysia, Indonesia and Myanmar. While Vietnam has recognized Champagne as Gis only in Vietnam-EU FTA 2015. The question of generic GIs is addressed in BTA and countries usually undertake to phase out the generic use of GI of the other countries in return for trade advantages offered by that country.

#### 1.4. GIs and Trademark

Thus the TRIPS obligation on GIs is only to provide an effective means for the protection of GIs. Members have enough flexibility to design a system of protection in line with TRIPS, this leads to a conflict of rights between geographical indications and trademarks protections. The TRIPs Agreement provides a framework for the resolution of this conflict in Article 24.5. Because geographical indications and trademarks are two subjects of intellectual property rights that should be protected equally. Therefore, Article 24 can be interpreted as an exception of both trademarks and geographical indications. This leads to different interpretations in local jurisdictions according to their respective views on the matter.

For countries of trademark system (United

States, Canada or Australia...), the principle “*exclusive rights of a trademark registered previously in a good faith*” in article 16.1 is applied, so the registration of a geographical indication identical or similar to an earlier registered trademark for an identical or similar product will be rejected to avoid confusion. In this case, the protection of a geographical name can be made by the registration of certification marks, provided that the use of this indication is fair and that such exceptions take into account the legitimate interests of the trademark owner and of third parties (Grevers F., 1999). This is the case of Binh Thuan for dragon and PhuQuoc for fishsauce (Vietnam)<sup>9</sup>.

The European Union countries confirm that Article 24.5 of the TRIPs Agreement on the exception of geographical indications protection over trademarks allows the coexistence of an early registered trademark and a similar or identical geographical indication protected later. A registered trademark can only prevent a geographical indication to be registered later if a trademark has been used and has achieved a certain prestige<sup>10</sup>. If the trademark has not acquired any reputation, the geographical indication is still accepted for registration, which leads to the coexistence of trademarks and geographical indications. This means that a pre-registered trademark still will be used but it loses its monopoly when a geographical indication identical or similar to a product trademark is protected<sup>11</sup>. Thus, the European Union applies the principle of the coexistence of a pre-registered trademark and a geographical indication similar or identical

to the trademark protected later.

This above disagreement has led the two Parties to a dispute before the WTO. The dispute was considered for more than one year by the WTO and on March 15, 2005, the WTO acknowledged that the Regulation of the European Union did not infringe WTO provisions<sup>12</sup>. Conclusion No. WT/DS174/R of the WTO still does not solve the disagreement between two different viewpoints on this relationship fore born by the United States and European Union. Despite of the WTO’s decision on the matter, each group of countries still explains this exception according to their own argument.

## **2. Multilateral notification and registration system: an old discussions**

The first international IP treaties, the Paris Convention in 1883, Madrid and Lisbon Agreement made considerable efforts to develop the multilateral framework for the protection of geographical indications, the results were however modeste. The TRIPs Agreement has brought that subject back to the attention of a large number of States in Doha rounds (1). Recently, the adoption of Geneva Act of the Lisbon Agreement on AO and Geographical Indications in May 2015 enlarges the issue of establishing international registration system to GIs as defined by TRIPs (2).

### **2.1. From a negotiation mandated by TRIPs**

The establishment of a multilateral system of notification and registration of geographical indications under TRIPs Agreement begun in 1997, were later included in the Doha Round

<sup>9</sup> Refer to: <http://www.uspto.gov>.

<sup>10</sup> For instance, Tabasco, a province name in Mexico is registered as the trademark of a sauce product.

<sup>11</sup> Regulation No 510/2006 of the European Union – Article 14.

<sup>12</sup> Decision No WT/DS/174/R, available at the following link: [http://www.uspto.gov/web/offices/dcom/olia/globalip/pdf/case\\_summary.pdf](http://www.uspto.gov/web/offices/dcom/olia/globalip/pdf/case_summary.pdf)

in 2001, dating back nearly 20 years and have been revived since the WTO Ministerial Conference in December 2013 as “special sessions” of the WTO Council on TRIPS. This mandate is clearly given in Article 23 (4) of the TRIPS Agreement and in the Doha Declaration.<sup>13</sup>

*“With a view to completing the work started in the Council for Trade-Related Aspects of Intellectual Property Rights (Council for TRIPS) on the implementation of Article 23.4, we agree to negotiate the establishment of a multilateral system of notification and registration of geographical indications for wines and spirits by the Fifth Session of the Ministerial Conference.”*

TRIPs agreement provides that mandate but do not set out a timeframe for the completion of the negotiations and indicates that participation in the system may be voluntary. That leads to divergent interpretation of the above paragraphs between countries. Some countries are of the view that there is no agreement to negotiate other outstanding implementation issues.<sup>14</sup> Other countries take the position that there is a clear mandate to negotiate the issue.<sup>15</sup> The 3 main different proposals put forth by the EC, US and Hong Kong focusing to clarify the two issues:

- Is protection to be granted based on registration ? Who bears the cost maintaining the multilateral register?

- If a multilateral register is established, should it extend to all GIs and not only wines and spirit ?

### **The EC and Hungary proposals**

As a complementary to Article 23.4 of TRIPS, the EC proposal<sup>16</sup> on a multilateral system of notification and registration of geographical indications for wines, spirits and other products allows WTO Member to decide whether or not to participate in the register. The proposal aims to provide full protection of registered GIs for wines in all WTO Member States and to ease the way regional producers of wines to enforce their rights based on registration and presumption of rights.

Furthermore, EC proposal elaborated on three basic grounds for which protection for wines should be extended to other products: first, prevention against dilution and free-riding on the reputation by others; second, enhancement of economic structure in farming communities and upgrading quality, thus benefiting developing nations; third, guaranteeing “product safety” as a result of raising identity and awareness of producers on their product quality.

Nevertheless, the main drawbacks of such proposals include first, non-participating members would be bound by legal consequence and second, the system requires huge costs which are left on the shoulders of notifying countries.

### **US, Canada, Chile and Japan proposals**

Under US proposal, Members are free to

<sup>13</sup> Paragraph 18 of the Doha Declaration.

<sup>14</sup> See Communication from Argentina regarding paragraphs 18 and 12 of the Draft Ministerial Declaration, 12 November 2001, WT/MIN.(01)/W/8 see <http://www.wto.org/>

<sup>15</sup> See Communication from Bulgaria, Czech Republic, EU, Hungary, Liechtenstein, Kenya, Mauritius, Nigeria, Pakistan, The Slovak Republic, Slovenia, Sri Lanka, Switzerland, Thailand and Turkey regarding paragraphs 18 and 12 of the Draft Ministerial Declaration, 14 November 2001, WT/MIN(01)/W/11 see <http://www.wto.org/>.

<sup>16</sup> EC proposal was under review in June 2000 with some feedback from other WTO Members. Based on EC regime, subsequently, Hungary also submitted a proposal on opposition procedures in the registration system.

decide on participating in the system, either. In principle, non-participating Members are encouraged to get involved in database consultation process even though such consultation would have no binding legal effect. The system does not engender financial burden as instead of governments, geographical indication owners take liability to enforce their rights.

Notwithstanding its convenience facilitation especially for developing nations, US proposal has drawn some severe condemnation. For one thing, the system does not confer GI a reasonable protection in the sense that even in the presence of mandatory database consultation, the incorporation of geographical indications in the database shall not accord it with any presumption of right. For another, there is not yet a clarification on how names falling outside either the scope of GI protection laid down in Article 22.1 or exceptions in Article 24 would be filtered out. Such inadequacies would somehow lessen the efficiency of the proposal.

On a different standpoint, US proposal opposed to EU's recommendation on extension of GI protection to products other than wines and spirits. It submitted that many names of food products originating from a geographical location have actually become generic. Thus the so-called "claw-back" of geographical indication would confer exclusive rights to local producers to use such names, which would go against free competition. It is buttressed by the historical fact that over the past centuries, Europeans have emigrated to Australia and the US and produced and used the term for goods with European origin for so long that those names have developed into generic terms. On that basis, EU Regulation on *sui generis* protection extended to GIs for

agricultural products and foodstuff was also criticized. Additionally, such extension in scope of application just underpinned EU trade protectionism creating a barrier to emerging industries. The cost incurred in re-labelling and re-packaging would also be substantial while it is very likely that consumer confusion still increases. Lastly, the scope extension would even ignite more raging debates among WTO Members.

### **Hong Kong proposal**

Hong Kong also submitted a proposal which combines some characteristics of both EC and US predecessors. Accordingly, registration allows presumption of right but participation is on a voluntary basis. Hong Kong proposed establishing an administering body which is in charge of formality examination and in particular, notification and registration of GIs on WTO website. Those Members desiring to participate in the system should notify the administering body of its domestic GIs for wines and spirits. The period of protection is ten years but it can be renewed subject to payment of certain amount of fee.

Such a hybrid system in Hong Kong proposal may cast some doubt on the multilateral efficiency as participation in the system is optional for Members. Even so, compared with EC and US proposals, Hong Kong version does balance the extremes and thus, provides a better chance of turning the hard goal into reality.

### ***2.2. To an international registration system under the Geneva Act of the Lisbon Agreement***

Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, signed in 1958, offers a means of obtaining protection for an appellation of origin through a single registration process



(administered by the International Bureau of WIPO), and ensures that in all contracting States, appellations of origin receive protection when they are protected in their Country of origin. Because, the “appellation of origin” concept does not have a counterpart in the legislation of many countries, the Lisbon Agreement had failed to attract many members. As of today, only 28 European states are party to the agreement.<sup>17</sup>

Taking consideration of shortcomings of Lisbon Agreement, Geneva Act, as adopted in May 2015, expands the application of the system to geographical indications as well. It also allows intergovernmental organizations (national office of intellectual property...) to apply for international registration. Furthermore, the scope of application of Geneva Act is on the GIs and AOs for all types of speciality products, not just confined to wines, spirits, agricultural products and foodstuffs. Such expansion is regarded as a TRIPS-plus provision.

Definition of AO sets higher criteria for recognition than those for GI defined in TRIPS<sup>18</sup>. However, for both GIs and AOs,

Geneva Act elaborates that registration and recognition in the country of origin are required. Also, from the definitions of GIs and AOs laid down in Article 2.1, it seems that Geneva Act as shifted the perception on “geographical location” in question. Accordingly, any words “*consisting of or containing the name of geographical area, or another denomination known as referring to such area*” would be eligible for being defined as geographical indication/ appellations of origin (GI/AO). It means GI/AO does not necessarily contain exclusively name of a geographical area but such name could also be used along with other words (for instance, “*Made in Roquefort*” or “*Product of Bordeaux*”). The flexibility is even buttressed in the sense that GI/AO does not necessarily designate a real place but just a name “*known as referring to*” such place.

With respect to the scope of protection of GI/AO, Article 11<sup>19</sup> of Geneva Act aims to establish another standard much higher than TRIPS provision in that additional protection is now applied to all products bearing GI/AO instead of limiting only to wines and spirits. But in principle, the particular legal means for providing such protection are placed at

<sup>17</sup> They are mainly Mediterranean countries of the European Union and their former colonies, former Communist states of Eastern Europe, and a few outliers such as North Korea, Iran and Cuba

<sup>18</sup> Article 2.1(i) of Geneva Act defines AO is “any denomination protected in the Contracting Party of Origin consisting of or containing the name of a geographical area, or another denomination known as referring to such area, which serves to designate a good as originating in that geographical area, where the quality or characteristics of the good are due exclusively or essentially to the geographical environment, including natural and human factors, and which has given the good its reputation”

<sup>19</sup> Article 11 stipulates that Parties are obliged to provide the legal means to prevent: (a) use of the AO/GI in respect of goods of the same kind as those to which the AO/GI applies, not originating in the geographical area of origin or not complying with any other applicable requirements for using the appellation of origin or the geographical indication; and (b) use of the AO/GI in respect of goods that are not of the same kind as those to which the AO/GI applies or services, if such use would indicate or suggest a connection between those goods or services and the beneficiaries of the appellation of origin or the geographical indication, and would be likely to damage their interests, or, where applicable, because of the reputation of the appellation of origin or geographical indication in the Contracting Party concerned, such use would be likely to impair or dilute in an unfair manner, or take unfair advantage of, that reputation; and (c). any other practice liable to mislead consumers as to the true origin, provenance or nature of the goods; and (d) any of the above uses amounting to the imitation of an AO/GI, even if the true origin of the goods is indicated, or if the AO/GI is used in translated form or is accompanied by terms such as “style”, “kind”, “type”, “make”, “imitation”, “method”, “as produced in”, “like”, “similar” or the like.

each Member's disposal. More concretely, Article 11.1 of Geneva Act establishes content of protection of registered GI/AO which is beyond the scope of corresponding Article 22.2 of TRIPS in that Article 11.1 prohibits the use of GI/AO not only in respect of same/similar goods (11.1.a) but also those "*not of the same kind*" - the unrelated goods (11.1.b) provided that such use on the unrelated merchandises suggests a connection with the beneficiaries of the GI/AO or is likely to impair or dilute or take unfair advantage of that reputation.

Furthermore, Geneva Act has expanded the additional special protection, which is granted to GIs for only wines and spirits in TRIPS, to all types of goods. Article 23.1 of TRIPS specifies that Member States shall prohibit the use of GIs identifying wines and spirits not originating from place indicated by the GI in question even if the true origin of the goods is indicated or the GIs are translated or accompanied with expressions 'kind', 'types', 'style', 'imitation' or the like. The same rule is laid down in Article 11.2 of Geneva Act but the scope covers the GIs identifying any goods, not limited to wines and spirits. Also, Geneva Act has added to the non-exhaustive list of expressions a number of specific terms 'method' and 'as produced in'. Regarding this provision, the Agreed Statement, however, provides that where some elements of the denomination/indication constituting AO/GI have a generic character in the Contracting Party of origin, their protection under this provision shall not be required in other Contracting Parties. This interpretation is specifically applied in the sense that a refusal or invalidation of a trademark, or a finding of infringement in the Contracting States under Article 11 shall not be based on the component that has a generic character.

In addition, pursuant to Article 11.3 of Geneva Act, Contracting Parties shall, either *ex officio* or at the request of an interested third party, refuse or declare a later trademark invalid if the use of such marks is detrimental to the right holders of AO/GI in question. Interestingly, some problematic issues have been raised regarding the high-level protection provided in Article 11.3. For example, how trademark authorities determine if the registration for unrelated goods may suggest a connection with AO/GI and when such connection may be prejudicial to the legitimate interest of the AO/GI beneficiaries.

With respect to the relationship between AO/GI and prior trademark rights, Article 13.1 appears to affirm the "*first in time, first in right*" rule, which means that the protection of AO/GI under this Act shall not prejudice the rights conferred by a previous trademark applied for or registered in good faith or acquired through use.

It is almost certain that the Geneva Act will attract a broader membership than its parent, the Lisbon Agreement. 52 countries and 2 intergovernmental organizations supported the adoption of the Geneva Act, including China, Russia, Mexico and the European Union. While this does not make them signatories, it is highly likely that many of those countries and organisations will be giving favourable consideration to becoming parties to the agreement.

The reach of existing Lisbon Agreement protections is already surprisingly broad. A glance over the 1000 or so registrations shows that they cover everything from wine, spirits and dairy products to tea, coffee, fresh and preserved produce, fencing blades, hand-woven carpets, chandelier pendants, percussion instruments, tapestries, tobacco

products, ceramics and much more – even, somewhat inexplicably, mud!

In a scenario where a major GI holder becomes a party to the Geneva Act – such as the European Union which has more than 1400 registered food AOs/GIs, 1600 registered wine AOs/GIs and 340 registered spirits GIs – it is not difficult to see that the scope for conflicts between GIs and other rights could escalate very rapidly.

### 3. Conclusion

The countries had GIs protections for products long before the TRIPs, but the new legal

concept GI have been adopted after the WTO's creation. The TRIPs Agreement, which provides a comprehensive definition of a GI, is the first truly multilateral agreement for the international protection of GIs.<sup>20</sup> However, the TRIPs has raised different viewpoints on the negotiations within the WTO framework on building an international communication and registration system for geographical indications protection. Even Geneva Act of the Lisbon Agreement has signed, that enlarges the international registration system to GIs as defined by TRIPs, but the negotiations have not come to an end so far. □

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9. WTO (2004), p. 73. For a detailed historical analysis of the provisions on GIs in the TRIPs Agreement, UNCTAD and ICTSD (2005)

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<sup>20</sup> WTO (2004), p. 73. For a detailed historical analysis of the provisions on GIs in the TRIPs Agreement see e.g., UNCTAD and ICTSD (2005).