

Geographical indications and TRIPs: 10 Years Later...

A roadmap for EU GI holders to get protection in other WTO Members

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Introduction

This Guide “Geographical indications and TRIPs: 10 Years Later... A roadmap for EU GI holders to get protection in other WTO Members” is divided into two parts.

- A first part consisting of three major chapters, with the objective of providing general information on the protection of GIs internationally, as well as a summary of some of the problems faced in seeking this protection.
- A second part containing 160 country review-tables setting out the main requirements for getting protection in these countries.

The first section of Part I is an introduction to the protection of geographical indications in international law. This section explains the provisions of relevant international treaties and, in particular, the TRIPs Agreement. It also examines the role that EU bilateral agreements have for the protection of GIs.

The second section contains some examples of difficulties encountered by EU producers of products with Protected Designations of Origin and Protected Geographical Indications in protecting their names outside the EU.

The final section of the Guide provides recommendations and suggestions to all producers of products with PDO and PGI signs in obtaining protection of their names outside the EU.

Part II of the Guide contains specific information on the protection of geographical indications in almost 160 countries of the world and not only the WTO Members as indicated in the title of the Guide.

Part I

**Protection of
Geographical Indications
in 160 countries around the world**

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I. Protection of Geographical Indications in International Law

1. What are geographical indications?

Geographical indications (GIs) are signs (most usually proper names) which identify a good as originating in the territory of a particular country, or a region or locality in that country, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin. It is a separate type of intellectual property.

From this definition it can be deduced that GIs are, first of all, signs and indications, necessarily linked to a particular territory. These are mostly geographical names (such as Parma, Manchego, Roquefort, etc.). Traditional and historical non-geographical names can nevertheless be protected if they are linked to a particular place. The most famous example of such a GI is “Feta”, which is not a place in Greece but is so closely connected to Greece as to identify a typical Greek product.

There are three major conditions for the recognition of a sign as a geographical indication:

- it must relate to a good (although in some countries services are also included, for example in Azerbaijan, Bahrain, Croatia, Jamaica, Saint Lucia, Singapore and others);
- these goods must originate from a defined area;
- the goods must have qualities, reputations or other characteristics which are clearly linked to the geographical origin of goods.

Any sign, even geographical, may not be considered as a geographical indication if it does not fulfil these three conditions.

The main function of GIs is to identify the origin of goods. They point to a specific place or region of production that confers particular characteristics and qualities on the product. It is important to emphasize that the product derives its qualities and reputation from the place of origin. These signs can acquire a high reputation and commercial value and, for these reasons, may be exposed to misappropriation, misuse and counterfeiting. This is why it is generally recognised that these signs need to be protected.

GIs are given different names such as appellations of origin, designations of origin, origin signs, etc., in different national laws. In this Guide these names are as indicated in that national law (or official translation of the legal documents into English) without change.

2. The protection of geographical indications in international law

Originally, GIs were protected in accordance with national laws developed locally. As the law was national it was limited in effect to the state territory. It became quickly apparent, once commerce expanded in the 19th century, that national protection was not sufficient as products were often imitated outside of the country of origin. Therefore, international cooperation was required to ensure that GIs were also protected internationally and that there was mutual reciprocity in the level of protection between states.

2.1. International Treaties Relevant for Protection of Geographical Indications

The first efforts to adopt a common approach to intellectual property resulted in the Paris Convention on the Protection of Intellectual Property¹ which was adopted in 1883. The Convention concerned all aspects of intellectual property and not just geographical indications.

A) The 1883 Paris Convention on Intellectual Property

The Paris Convention was the first multilateral agreement, which included “indications of source or appellations of origin” as objects of protection. Article 1(2) of the Paris Convention states:

“The protection of industrial property has as its object patents, utility models, industrial designs, trademarks, service marks, trade names, indications of source or appellation of origin, and the repression of unfair competition”.

The Paris Convention identifies geographical indications as a separate intellectual property right, but does not clearly define this concept.

Article 10(1) of the Paris Convention provides for the certain remedies in respect unlawful use of indications of source on goods, meaning that no indication of source may be used if it refers to a geographical area from which the products in question do not originate.

¹ The Paris Convention for the protection of industrial property was agreed in 1883 and complemented by the Madrid Protocol of 1891. It was revised at Brussels (1900), Washington (1911), The Hague (1925), London (1934), Lisbon (1958), and Stockholm (1967), and amended in 1979. As of 1 October 2006 the Paris Convention had 169 signatory states. See on <http://www.wipo.org>, “Treaties”, “Intellectual Property Protection Treaties”, “Paris Convention”.

Article 10 of the Paris Convention does mention appellations of origin expressly. However, they are covered by the term “indications of source” as all appellations of origin are considered to be indications of the source of goods.

Article 11*bis* of the Convention gives the basis for protection against misleading indications of source, including appellations of origin. It obliges members to provide protection against unfair competition and contains a non-exhaustive list of acts, which are to be prohibited. The Paris Convention does not provide for any special remedies against infringement of this provision.

Paris Convention in Article 19 allows the parties *“to make ... between themselves special agreements for the protection of industrial property”*. Two such agreements of relevance to GIs were duly made. These are the 1891 Madrid Agreement² and the 1958 Lisbon Agreement.³

B) The 1891 Madrid Agreement on indications of source

The Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods is specific to indications of source.

Article 1(1) of the Madrid Agreement provides that:

“(A)ll goods bearing a false or deceptive indication by which one of the countries to which this Agreement applies, or a place situated therein, is directly or indirectly indicated as being the country or place of origin shall be seized on importation into any of the said countries.”

The Madrid Agreement was the first multilateral agreement to provide specific rules for the repression of false and deceptive indications of source.

The Madrid Agreement did not add much to the protection already given by the Paris Convention, but it extended protection to deceptive indications of source in

² The Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods was adopted in 1891 and revised at Washington (1911), The Hague (1925), London (1934), and Lisbon (1958). It was supplemented by the Additional Act of Stockholm (1967), and had a membership of 34 signatory states as of 1 September 2006. In the last 20 years (1982-2002) only five new states became party to the treaty: Czech Republic (1993), Republic of Moldova (2001), Slovakia (1993), Yugoslavia (2000) and Iran (2004). See on <http://www.wipo.org>, “Treaties”, “Intellectual Property Protection Treaties”, “Madrid Agreement”.

³ This Agreement for the Protection of Appellation of Origin and their International registration was concluded in Lisbon on 31 October 1958. It was revised in Stockholm in 1967 and amended in 1979. Any member of the Paris Convention may accede to the treaty. As of 1 September 2006, there were 25 states party to the Agreement. See on <http://www.wipo.org>, “Treaties”, “Intellectual Property Protection Treaties”, “Lisbon Agreement”.

addition to false indications. A deceptive indication of source can be the true name of the place where the good originates from, but nevertheless confusing the purchaser in respect to the true origin and quality of the good.

C) The 1958 Lisbon Agreement

The aim of the Lisbon Agreement for the Protection of Appellations of Origin was to provide for the protection of appellations of origin, that is,

*“The geographical name of a country, region, or locality, which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographic environment, including natural and human factors”.*⁴

The Lisbon Agreement provided a proper definition of appellation of origin and extended protection to:

*“any usurpation or imitation, even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as “kind”, “type”, “make”, “imitation” or the like”.*⁵

There are two basic requirements for an appellation of origin to be protected, in accordance with the terms of this Agreement:

- the appellation of origin should be protected in its country of origin, and
- the appellation of origin should be registered in the International Register of WIPO.⁶

According to the Agreement, countries are free to adopt their own system for designating appellations, either by judicial or administrative decision, or both. Once registered, a geographical indication is protected in other Member states.

Contracting Parties have to protect the appellation of origin to which international protection was requested, except if a Contracting Party declares, within a period of one year, that it cannot ensure the protection for a certain application. There are no specified grounds for refusal to names in the Agreement.

The duration of the protection given by international registration is coterminous with the protection as an appellation of origin in the country of origin. There is, therefore, no requirement for international renewal.

⁴ Article 2 of the Agreement.

⁵ Article 6 of the Agreement.

⁶ See on <http://www.wipo.org>, “International Register”.

There are at the moment 25 signatories of the Lisbon Agreement,⁷ with 6 EU Member States, namely France and Portugal (from 25 September 1966), Hungary (from 23 March 1967), Italy (from 29 December 1968), Slovakia and Czech Republic (from 1 January 1993).⁸ That means that appellations of origin from these EC countries registered in the International Register of WIPO are protected in all countries, parties to the Lisbon Agreement.

D) The 1891 Madrid Agreement Concerning the International Registration of Marks

In some countries geographical indications could be only protected as trademarks. Therefore, the Madrid system for the International Registration of Marks as collective marks, certification marks or guarantee marks is of relevance to the protection of GIs.⁹ This means that an international registration system for trademarks, established by the Madrid Agreement of 1891 and the Protocol relating to the Madrid Agreement Concerning the International Registration of Marks of 1989,¹⁰ can also serve as a means of protection of GIs internationally. However, this system can only be used by those countries that protect geographical indications via a certification trademark regime and do not have specific (*sui generis*) rules on the protection of geographical indications.

The Madrid system comprises two treaties: the Madrid Agreement Concerning the International Registration of Marks, which dates from 1891,¹¹ and the Protocol Relating to the Madrid Agreement of 1989.¹² The Madrid system of international registration of marks is applicable among the countries party to the Madrid Agreement or the Madrid Protocol.¹³ This system gives a trademark owner the possibility of having his mark protected in several countries by simply filing one application with a single Trademark Office, in one language, with one set of fees in one currency.

⁷ Algeria, Bulgaria, Burkina Faso, Congo, Costa Rica, Cuba, France, Gabon, Georgia, Haiti, Hungary, Iran, Israel, Italy, Mexico, Nicaragua, Peru, Portugal, Moldova, Serbia and Montenegro, Slovakia, Czech Republic, Togo, Democratic People's Republic of Korea (North), Tunisia. The list of the countries with intellectual property offices contacts is available on <http://www.wipo.int/lisbon/en/members/pdf/contacts.pdf>.

⁸ This information is provided in all fishes of the Part II of the Guide.

⁹ For this reason, a reference to the Madrid Agreement and Protocol is also provided in the fishes of the Part II of the Guide.

¹⁰ The Madrid Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks as signed at Madrid on June 28, 1989, see on <http://www.wipo.org/>, “Agreements”.

¹¹ The full name of the system of treaties is “Madrid Agreement Concerning the International Registration of Marks of April 14, 1891 (as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Nice on June 15, 1957, and at Stockholm on July 14, 1967)”. The Protocol entered into force on December 1, 1995 and became operative on April 1, 1996.

¹² The Protocol entered into force on 1 December 1995 and became operative on 1 April 1996.

¹³ As of 1 September 2006 there are 56 countries Parties to the Agreement and 68 to the Protocol.

According to the Protocol, an international registration produces the same effects as an application for registration of the mark made in each of the countries designated by the applicant. If protection is not refused by the Trademark Office of a designated country within a specified period (12 or 18 months), the protection of the mark is the same as if it had been registered by that Office. The Madrid system simplifies greatly the subsequent management of the mark, since it is possible to record subsequent changes (such as a change in ownership or a change in the name or address of the holder) or to renew the registration through a simple single procedural step with the International Bureau of WIPO.

E) The WTO Agreement on Trade-Related Aspects of Intellectual Property Rights

A specific Section of the World Trade Organisation Agreement on Trade-Related Aspects of Intellectual Property Rights is dedicated to geographical indications.¹⁴ It is the first multilateral treaty dealing with geographical indications as such.

Article 22 of the TRIPs Agreement provides a definition of geographical indications. They 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”.

This definition expands the concept of appellation of origin contained in Article 2 of the Lisbon Agreement to protect goods which merely derive a reputation from their place of origin without possessing a given quality or other characteristics which are due to that place.

To be protected a geographical indication needs to be “an indication”, but not necessarily the name of a geographical place.

The TRIPs Agreement contains three distinctions in the level of protection:

- 1) for geographical indications related to all products,
- 2) for wines and spirits, and
- 3) for wines only.

A minimum standard of protection for all geographical indications, whatever the nature of the good to which it is applied, is established by Article 22 of the TRIPs Agreement. The scope of protection is limited to the prohibition of the use of

¹⁴ For this reason, each fish of the Part II of the Guide indicates whether a country a WTO Member or not.

geographical indications by producers not located in the region designated by the particular geographical indication.

The additional protection for both wines and spirits includes three elements:

- the provision of the legal means for interested parties to prevent the use of a geographical indication identifying wines and spirits, not originating in the place indicated by the geographical indication;
- the possibility to refuse or invalidate the registration of a trademark for wines or spirits which contains or consists of a geographical indication identifying wines or spirits at the request of an interested party;
- the call for future negotiations aimed at increasing protection for individual geographical indications for wines and spirits.

An “extra-additional” protection by the TRIPs Agreement for wines only emphasizes the need to accord protection for each geographical indication for wines in the case of homonymous indications and the establishment of a multilateral system of notification and registration of geographical indications for wines eligible for protection in the jurisdictions of those WTO Members participating in the system.

2.2. Protection of geographical indications in Plurilateral and Regional Agreements

A) The African Intellectual Property Organisation (OAPI) Agreement

Some plurilateral or regional agreements are also relevant to the protection of GIs. The best example is the OAPI Agreement. The African Intellectual Property Organisation (OAPI) Agreement was signed in Bangui on 2 March 1977, replacing the first Agreement signed at Libreville on 13 September 1962, which established African Intellectual Property Organisation. The OAPI or Bangui Agreement, was revised in 1999 and entered into force in February 2002.¹⁵

Benin, Burkina Faso, Cameroon, the Central Africa, Chad, Congo, Côte d’Ivoire, Gabon, Guinea, Guinea Bissau, Equatorial Guinea, Mali, Mauritania, Niger, Senegal and Togo are Parties to the OAPI Agreement, which embodies the national laws of the Member States of the African Intellectual Property Organisation and, therefore, applies directly in each Member State. All the Member States of the OAPI are party to both the Paris Convention and TRIPs Agreement. Burkina Faso, Congo, Gabon and Togo are also Parties to the Lisbon Agreement.

¹⁵ See also information about African Intellectual Property Organisation on <http://www.oapi.wipo.net/>. The headquarter of the OAPI is in Yaounde, Cameroon.

In addition, it has become common to incorporate provisions for the protection of GIs in free trade agreements. Examples include the North America Free Trade Agreement between United States, Canada and Mexico (1992), the Free Trade Agreement between Mexico and Chile (1998), the Free Trade Agreement between the United States and Jordan (2001), between Bolivia and Mexico (1994), between Canada and Chile (1996), between the EU and Mexico (1995), between EU and South Africa, between Canada and Chile (2001) and between EU and Chile (2002). The EU bilateral agreements protecting GIs are examined in the next section.

B) The Banjul Protocol on Marks the African Regional Intellectual Property

The African Regional Intellectual Property Organization was established by the Lusaka Agreement, adopted in Lusaka, Zambia in December 1976.¹⁶ The purpose of ARIPO was to consolidate the resources of its member countries (English speaking African countries) in industrial property matters in order to avoid duplication of work.

The Banjul Protocol on Marks,¹⁷ which was adopted by the Administrative Council in 1993, establishes a trademark filing system. Under the Banjul Protocol an applicant may file a single application either at one of the contracting states or directly with the ARIPO Office and designate states where protection of the mark is sought.

The Protocol came into force on 6 March 1997 for Malawi, Swaziland and Zimbabwe. Lesotho and Tanzania joined the Protocol in 1999. It is expected that other ARIPO member states will ratify or accede to the Protocol in the near future.¹⁸ States currently party to the Banjul Protocol are: Botswana, Lesotho, Malawi, Namibia, Swaziland, Tanzania, Uganda and Zimbabwe (Total: 8 states).

Since 1997 the Protocol has been extensively revised in order to make it compatible with the TRIPS Agreement and the Trademark Law Treaty, as well as make it more user-friendly.

2.3. Bilateral agreements concluded by the EC for the protection of Geographical Indications

¹⁶ For more information on the ARIPO consult <http://www.aripo.org>.

¹⁷ The text of the Banjul Agreement can be down loaded from http://www.aripo.org/Documents/Protocols/banjul_protocol.pdf.

¹⁸ At present there are 16 ARIPO Member States: Botswana, Gambia, Ghana, Kenya, Lesotho, Malawi, Mozambique, Namibia, Sierra Leone, Somalia, Sudan, Swaziland, Tanzania, Uganda, Zambia and Zimbabwe.

2.3.1. EC – Australia Wine Agreement

The EC – Australia Agreement on Trade in Wine is one of the earliest examples of bilateral agreements concluded between the European Community and another country for the protection of geographical indications. The Agreement was signed in Brussels and Canberra on 25 and 31 January 1994 respectively.¹⁹

The EC – Australia Agreement provides a definition of geographical indications²⁰ and limits the scope of the protection to names specified in Annex II to the Agreement. An important condition for the protection under Agreement is the recognition of geographical indications under the laws of the contracting parties. In addition, the Agreement contains provisions relating to the mutual recognition of traditional expressions.²¹

2.3.2. EC – Canada Agreement

An Agreement between Canada and the European Community on trade in wines and spirit drinks was signed on 16 September 2003.²²

The structure of the EC – Canada Agreement is similar to the Agreement with Australia. It was agreed to end the “generic” classification in Canada of 21 European wine names in three phases: by 31 December 2013 for Chablis, Champagne, Port/Porto and Sherry; by 31 December 2008 for Bourgogne/Burgundy, Rhin/Rhine, Sauterne/Sauternes; and immediately on entry into force of the agreement for Bordeaux, Chianti, Claret, Madeira, Malaga, Marsala, Medoc/Médoc, and Mosel/Moselle. An end to the “generic” status of European spirits names Grappa, Ouzo, Jägertee/Jagertee/ Jagatee, Korn/Kornbrand and Pacharan is phased out within 2 years from the entry into force of the Agreement. In exchange, the EC will protect amongst other names “Canadian Rye Whisky” as a distinctive product of Canada.²³

¹⁹ Agreement between the European Communities and Australia on trade in wine, OJ L 86, 31 March 1994, Agreement between the European Communities and Austria on trade in wine, OJ L 208, August 1, 2001, p. 46. The EC negotiated several different wine agreements with Eastern European countries and South Africa, and the Australian one is being seen as a model for use in the other negotiations.

²⁰ Article 2 of the EC - Australia Agreement provides: “An indication as specified in Annex II, including an “Appellation of Origin”, which is recognized in the laws and regulation of a Contracting Party for the purpose of the description and presentation of a wine originating in the territory of a Contracting Party, or in a region or locality in that territory, where a given quality, reputation or other characteristic of the wine is essentially attributable to its geographical origin”

²¹ “Traditional expressions” are terms used traditionally to designate quality wines and refer to a production or ageing method, a colour, or a quality etc.

²² Agreement between the European Community and Canada on trade in wines and spirit drinks, OJ L 35, 2004.

²³ According to Article 41, the Agreement will enter into force on the first day of the second month following the date on which the Contracting Parties have exchanged diplomatic notes confirming

2.3.3. EC – Mexico Agreement

In 1997, Mexico and the EU signed an Agreement on Designations for Spirit Drinks under which both parties agreed to grant protection to the denominations of origin of certain spirits such as Tequila and Mezcal, Whisky, Grappa and Cognac. The protected names are specified in the two Annexes to the Agreement.²⁴

2.3.4. EC – Chile Agreements

Section 6 of the 2002 Agreement Establishing an Association between the EC and Chile refers to Annexes V and VI attached to the Agreement. These annexes are the Agreement on Trade in Wine and the Agreement on Trade in Spirit Drinks and Aromatised Drinks. Both of these Agreements contain provisions in relation to geographical indications and specify the names for the protection in the Appendixes.

2.3.5. EC – South Africa Agreements

In 1999, the EC and South Africa signed an Agreement on Trade, Development and Cooperation.²⁵ In the Attachment to the Annex X of the Agreement on Trade, Development and Cooperation the Republic of South Africa reconfirmed that the names “port” and “sherry” will not be used for its exports to the European Community. It agreed to phase out the use of the “port” and “sherry” names on all export markets within 5 years, except in the case on non-SACU SADC countries,²⁶ where an 8-year phase-out period would apply. For the domestic market, South Africa may use names “port” and “sherry” during a 12-year transitional period.

the completion of their respective procedures for the entry into force of this Agreement. As of May 2004 no exchange of the diplomatic notes has taken place.

²⁴ Agreement between the European Community and the United Mexican States on the mutual recognition and protection of designations for spirit drinks, OJ L 152, 11/06/1997 pp. 16-26.

²⁵ Agreement on Trade, Development and Cooperation between the European Community and its Member States, of the one part, and the Republic of South Africa, of the other part; Council Decision of 29 July 1999 concerning the provisional application of the Agreement on Trade, Development and Cooperation between the European Community and its Member States, of the one part, and the Republic of South Africa, of the other part, OJ L 311, 4 December 1999, p. 1.

²⁶ For the purpose of the Wines and Spirits Agreement, the South African domestic market is defined to cover SACU (South African Customs Union, which includes Botswana, Lesotho, Namibia, South Africa and Swaziland).

Later in 2002, the EC and South Africa signed two specific agreements for the protection of geographical indications for wines and spirits.²⁷

Under the Agreement for wines, geographical indications, including appellations of origin, are granted better protection, for the EC, than at multilateral level under the TRIPs agreement. The Parties agreed to mutually recognize oenological practices on the basis of strict requirements such as health, consumer protection and the preservation of good wine making practices.

The Agreement between the EC and South Africa on Trade in Spirits is very similar to the Agreement on Trade in Wines. It contains a full list of geographical indications for spirits that are protected in under the terms of the Agreement.

2.3.6. EC – US Wine Agreement

On 10 March 2006, the Agreement between the United States and the European Community on Trade in Wine was signed. Since 1983, the EU has been renewing short-term derogations allowing imports of US wines made using practices not approved by the EU. The temporary nature of these derogations created continuous uncertainty for US wine exporters.

The agreement provides for:

- recognition of each other’s existing current winemaking practices;
- a consultative process for accepting new winemaking practices;
- the United States limiting the use of certain semi-generic names in the US market;
- the EU allowing under specified conditions for the use of certain regulated terms on US wine exported to the EU;
- recognizing certain names of origin in each other’s market;
- simplifying certification requirements for US wine exported to the EU.

The Agreement provides that the US will seek legislative changes to limit the use of 16 semi-generic names (Annex II to the Agreement: Burgundy, Chablis, Champagne, Chianti, Claret, Haut Sauterne, Hock, Madeira, Malaga, Marsala, Moselle, Port, Retsina, Rhine, Sauterne, Sherry and Tokay). The changes will grandfather existing uses of these semi-generic names on non-European wine

²⁷ Agreement between the European Community and the Republic of South Africa on Trade in Wine, signed on 28 January 2002 (provisionally in force), Council Decision of 21 January 2002 on the conclusion of an Agreement between the European Community and the Republic of South Africa on Trade in Wine, OJ L 28, 30 January 2002, p. 3 and Agreement between the European Community and the Republic of South Africa on Trade in Spirits, Council Decision of 21 January 2002 on the conclusion of an Agreement between the European Community and the Republic of South Africa on Trade in Spirits, 2002/51/EC, OJ L 28, 30/01/2002, p. 112.

but prohibit new brands from using these names on non-EU wine. The US will notify the EC of the date when the change in legal status would come into effect.

The Agreement contains lists of names of quality wines produced in specified regions from the EC and the US (Annex IV and V), which may be used as names of origin for wine only to designate wine of the origin indicated by such a name (Article 7 of the Agreement).

II. Difficulties for European producers in protecting GIs outside the European Union

The purpose of this Section is not to provide readers with an exhaustive list of difficulties that EU GI producers might encounter in protecting their GIs in third countries. Rather, it seeks to highlight some of the principal problems that EU GI producers have met over recent years.

European GI producers have been pushing for better protection of GIs at the international level due to the increasing number of misappropriations they face throughout the world. The abuse of EU GIs has a strong adverse economic impact. The abuses limit access to certain markets and undermine consumer loyalty. Moreover, the fight against these abuses is extremely costly. It is interesting to note that, in practice, there is a clear link between the reputation of the GI product and the number of abuses: the more famous the GI product is, the more misappropriations it faces, the more important the need for GI protection is, the more costly it becomes.

Most countries have a legal framework for the protection of GIs. However, the legal instruments and the level of protection available vary considerably from one country to another (see detailed reviews provided in Part II of this Guide).

The first difficulty for EU producers is to understand what legal framework is available in the country where protection is sought as well as the level of protection that they will enjoy. This is an important first step as the level and modalities of protection differ widely if the producers have to rely on unfair competition and consumer protection acts, passing off actions, trademark laws or a *sui generis* protection of GIs with or without registration.

Many EU GI producers have secured the protection of their name outside the EU. Wine and spirits producers have done so mainly thanks to bilateral agreements concluded between the EU and some countries²⁸. These agreements have brought positive results for EU producers, although some problems remain for famous EU GI wines which continue to face abuses in some of these countries. These GIs still struggle to secure protection in many

²⁸ See examples provided in Section 2.3 of this Part.

countries, as they are considered generic or semi-generic names, hence not entitled to protection. The other EU GIs have not been protected via bilateral agreement signed by the EU. As a result, the protection of these names outside the EU has been left entirely in the hands of producers themselves.

1. Countries with *sui generis* system of protection of GIs

In countries where there is a *sui generis* system which provides for the registration of GIs, EU producers do not encounter major difficulties. They normally need to submit all required documents translated in the local language if necessary. Often, producers must use a local agent to facilitate the registration. The key issue for EU producers relates to the scope of protection offered. They need to understand whether the protection covers names used in translation and/or names used with expressions such as “like”, “style”, etc. They also need to know if an *ex officio* procedure (a procedure by which governments take responsibility on the enforcement of the GI law) is available. If not, EU producers will have to monitor the foreign market to detect possible abuses by operators and take all necessary legal actions to assert their rights.

The difficulties arise when EU GI producers have to rely on unfair competition and consumer protection acts, passing off actions or when they seek protection via the registration of a trademark, collective mark or certification mark.

When protection is available via unfair competition and consumer protection acts, the experience shows that European producers have had to spend a considerable amount of money trying to fend off abuses on foreign markets. They had to launch costly legal actions to seek protection of their GI. In such a case, producers are often required to prove that their GI is not a generic name and that it has acquired distinctiveness. This can be done via consumer surveys which are expensive and not always conclusive. It has also been very costly for EU GI producers to seek protection via passing-off actions. Experience shows that securing protection in that context is a difficult, expensive and a largely uncertain process.

2. Countries with trademark protection of GIs

The use of a trademark²⁹ regime has also proved very complicated, costly and not always effective. Looking at the experience of EU GI producers, the following main difficulties can be highlighted.

²⁹ Please note that in this section the term “trademark” covers also collective and certification marks, except when one of these terms is specifically used.

2.1. Prior only trademark registrations

In some countries, European GI producers are confronted with registered trademarks which contain their GI names. Many EU producers of famous GI wines, spirits, cheeses, hams, etc have been confronted with such a situation. According to the principle of “first in time, first in right” applicable to trademarks, it is therefore not possible for EU producers to seek trademark registration of their name as it is already legally owned by another private party.

In such a case, European producers have only two options. They can launch proceedings to obtain the cancellation of the registered trademark. They can enter into negotiation with the owner of the trademark in order to buy it. In both cases, actions launched by EU GI producers have proved very costly and not always 100% successful!

2.2. The use of the trademark

In most countries, trademarks are protected if they are registered. However, for the protection to be effective, the trademark must be used on the market.

EU registered GIs are agricultural and food products. As a result, several EU producers have not been able to export their products to third countries as the markets are closed to imports of these products for sanitary or phytosanitary reasons. These barriers to trade pose an important problem to producers when it comes to securing protection of their GI name. Indeed, even if they register their GIs as trademarks as a preventive measure, if they do not use the name on the market, they face the prospect of a cancellation of the trademark for non-use.

2.3. The ability to register a geographical name

Most trademark laws, in general, prohibit the registration of a name with a geographical meaning. Therefore, GI names are often protected via a collective or a certification mark when such legal concepts exist. When they are not available, EU GI producers have often been forced to seek a limited protection - for their logo only - via a figurative trademark registration.

In addition, experience shows that intellectual property offices outside of the EU regularly reject registration requests from EU producers on the grounds that GI names are:

- 1) a simple indication of the place of origin of the goods (i.e., an indication of source),
- 2) a description of the product, and/or
- 3) a generic name.

Therefore, the use of the name is considered not protectable and allows false use in relation to goods not coming from the place of origin.

The difficulty for GI producers in dealing with these problems lies with the fact that the interpretation and analysis regarding the generic or descriptive character of a name varies extensively from one country to another. Moreover, in many cases, it is up to EU GI producers to prove that their name has not become generic in the market concerned. This is an expensive challenge.

One element that needs to be underlined is the fact that, if abuses of the name already exist in the country concerned, it is often more difficult to get registration.

2.4. The registration of composed GI names

Some EU GI names contain more than one term, such as Ossau-Iraty, Parmigiano-Reggiano, Jijona y Turrón de Alicante, Brunello di Montalcino, etc.

Producers of such composed names have been exposed to a specific problem when seeking protection of their name in countries outside the EU. Some intellectual property offices accepted to register a certification mark covering the composed GI name. However, the registration did not always cover the protection of the two individual terms. Consequently, the registration only helps producers to stop abuse of the composed name but does not protect against the abuse of one of the two names used on its own. This greatly limits the scope of the protection granted to the GI name.

2.5. The authorised use of a registered certification mark

A certification mark certifies the origin, quality, mode of manufacture or other elements of a good. As a result, some countries have made it clear that the use of a certification mark on product other than the GI product itself is prohibited. More importantly, such use – on promotional materials, for instance, such as pens, hats, etc. - can lead to the invalidation of the registration.

2.6. The scope of the protection given by a trademark registration

The use of a trademark regime to protect a GI name does not provide for a protection as comprehensive as the one offered by the EU GI system.

EU GI producers must pay attention to the scope of the protection given. In general, trademark registration does not cover translation, nor does it prevent the

use of the name with “de-localisers” (i.e. “Californian Champagne”) or expressions such as “like”, “style”, etc.

2.7. The costs associated to the registration of a trademark

The experience of EU GI producers shows that it is, in general, more costly to obtain legal protection of GIs via trademark systems than via a *sui generis* regime. In addition, legal costs increase significantly due to problems met with local patent and trademark offices. As stated above, it is very expensive for GI producers to demonstrate that a name is neither generic nor descriptive.

2.8. Effective protection under a trademark regime

Although a trademark registration provides for an exclusive right on the registered name, EU producers sometime forget that, in most countries, they must continue to assert their rights. They need to carry out a regular monitoring of the markets where the trademark is protected. They need to be ready to launch all necessary legal actions (opposition to trademark registration for instance) to protect their intellectual property right. Failure to do so would significantly undermine the right.

3. Conclusion

The experience of many EU GI producers shows that it is extremely difficult and often very costly for GI producers to protect their GIs via trademark systems, passing off actions or on the basis of unfair competition and consumer protection acts.

It is important to note that in the past years more and more countries around the world have established *sui generis* protection systems for GIs. This process is ongoing and will certainly facilitate the protection of EU GIs outside the EU.

III. Recommendations and suggestions to all producers of products with PDO and PGI signs

This Section is not intended as a comprehensive answer to the problems faced by the EU GI producers on the registration of their names in the countries examined in Part II. Each producer will have different requirements and problems to be resolved. Each country is different. However, there are some basic steps that an EU GI producer can take to limit the practical difficulties that they may face in protecting their GIs in third countries.

- Get good advice from experts in GI and TM law and practice. Experience shows that it is often easier to identify and work with a law firm from your country that will manage all the necessary contacts and take the required steps on your behalf. This is an option that can be cost-efficient and can simplify the work of the GI holder (dealing with a number of different third country systems).
- Consider a double registration: both as a GI and as a trademark. You should try to register the basic geographical name as a GI and logos, combinations of colours, figures, etc. as trademarks.
- Remember that registration of GIs as certification trademarks may prevent you using the registered names on promotional materials. Therefore, for the use of the names on promotional materials also advisable to register a figurative trademark containing the geographical indication.
- Conduct a preliminary trademark search if registration as a trademark is sought.
- Producers of composed GI names (for example, Parmigiano Reggiano, Ossau-Iraty, Jijona y Turrón de Alicante, Brunello di Montalcino, Imokilly Regato, etc.) need to be aware of the specific problems in seeking trademark protection, as it does not always cover individual terms of the composed name.
- When the language of origin of the GI is different from the official language of the place of registration, translation is needed. In most of the countries with a *sui generis* system of protection, the required documents for the application are similar to those used for the registration in the European Union. Therefore, these documents could form the basis of a new application to the extent that the requirements are similar.
- Do not hesitate to contact Intellectual Property Offices for further information in the countries where the protection is sought. Often the standard application forms are available on line or upon the request. Most administrators are helpful and welcome practical enquiries.
- Consider the timeframe of registration and protection granted, you might have to renew your registration at least a few months before the expiry date, as protection may only be provided for a limited number of years.
- In those countries where no *ex officio* protection is provided, institute a regular monitoring of the markets and the registers where your name is protected.

*Part I of the Guide “Geographical indications and TRIPs: 10 Years Later...
A roadmap for EU GI holders to get protection in other WTO Members”*

- Be prepared to launch all necessary legal actions (opposition to trademark registration for instance) to protect your intellectual property right.
- Search existing registered GIs in the country where protection is sought.