

THE PROTECTION  
OF  
GEOGRAPHICAL  
INDICATIONS

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LAW AND PRACTICE

MICHAEL BLAKENEY

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ELGAR INTELLECTUAL PROPERTY LAW AND PRACTICE

THE PROTECTION OF GEOGRAPHICAL  
INDICATIONS

## ELGAR INTELLECTUAL PROPERTY LAW AND PRACTICE

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# THE PROTECTION OF GEOGRAPHICAL INDICATIONS

Law and Practice

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ELGAR INTELLECTUAL PROPERTY LAW AND PRACTICE

Edward Elgar  
Cheltenham, UK • Northampton, MA, USA

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Published by  
Edward Elgar Publishing Limited  
The Lypiatts  
15 Lansdown Road  
Cheltenham  
Glos GL50 2JA  
UK

Edward Elgar Publishing, Inc.  
William Pratt House  
9 Dewey Court  
Northampton  
Massachusetts 01060  
USA

A catalogue record for this book  
is available from the British Library

Library of Congress Control Number: 2014932526

This book is available electronically in the ElgarOnline.com Law Subject Collection,  
E-ISBN 978 1 78254 672 6



ISBN 978 1 78254 671 9

Typeset by Columns Design XML Ltd, Reading  
Printed and bound in Great Britain by T.J. International Ltd, Padstow

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# ABBREVIATIONS

ACTA	Anti-counterfeiting Trade Agreement
AO	appellation of origin
AoA	Agreement on Agriculture
AOC	controlled appellation of origin
CA	Court of Appeal
CAP	Common Agricultural Policy
CBD	Convention on Biological Diversity
ccTLD	country code top level domain
CEN	European Committee for Standardization
CIS	Customs Information System
CMLRev.	<i>Common Market Law Review</i>
CN	combined nomenclature
DNS	Domain Name System
DSB	Dispute Settlement Body
DSU	Dispute Settlement Understanding
EAFRD	European Agricultural Fund for Rural Development
EAGGF	European Agricultural Guidance and Guarantee Fund
EBA	Extended Board of Appeals of the European Patent Organisation
EC	European Community
ECJ	European Court of Justice (the Court of Justice of the European Communities)
ECR	European Court Reports
EEA	European Economic Area
EFOW	European Federation of Origin Wines
EIPR	<i>European Intellectual Property Review</i>
EPO	European Patent Office
ETMR	European Trade Mark Reports
EU	European Union
FSR	Fleet Street Reports
GAC	Government Advisory Committee (to ICANN)
GATT	General Agreement on Tariffs and Trade
GI	geographical indication
GRUR	Gewerblicher Rechtsschutz und Urheberrecht: Internationaler Teil
gTLD	generic Top Level Domain
ICANN	Internet Corporation for Assigned Names and Numbers
ICC	International Chamber of Commerce
IIC	<i>International Review of Intellectual Property and Competition Law</i>
INAO	Institut National des Appellations d'Origine
INTA	The International Trademark Association



## ABBREVIATIONS

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Int.T.L.R.	International Trade Law & Regulation
IP	intellectual property
IPQ	<i>Intellectual Property Quarterly</i>
IPR	intellectual property right
ISO	International Organization for Standardization
JIPP	<i>Journal of Intellectual Property Law &amp; Practice</i>
MATRIC	Midwest Agribusiness Trade Research and Information Center
OHIM	Office for Harmonization in the Internal Market
OIV	Office international de la vigne et du vin
OJ	Official Journal of the European Communities
OriGIn	Organization for an International Geographical Indications Network
PBRs	plant breeders' rights
PDO	protected designation of origin
PGI	protected geographical indication
psr	produced in a specific region
QWPSR	quality wines produced in specified regions
RPC	Reports of Patent, Design and Trade Mark Cases
SCT	WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications
SMEs	small and medium enterprises
TJWIP	The Journal of World Intellectual Property
TMR	Trademark Reporter
TRIPS	Agreement on Trade-Related Aspects of Intellectual Property Rights
TSG	TRADITIONAL SPECIALITY GUARANTEED
UDRP	Uniform Domain Name Dispute Resolution Policy
UPOV	Union for the Protection of Plant Varieties
URS	Uniform Rapid Suspension System
USC	United States Code
USPTO	United States Patents and Trademarks Office
WIPO	World Intellectual Property Organization
WTO	World Trade Organization

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Commission Regulation (EC) No 1019/2002 of 13 June 2002 on marketing standards for olive oil (OJ L 155, 14.6.2002, p. 27) .....3.119	Commission Regulation 2253/1999 amending Regulation 881/98 laying down detailed rules for the protection of the additional traditional terms used to designate certain types of quality wine produced in specified regions (quality wine psr) (OJ L 275, 26.10.1999, pp. 8–8 ) (no longer in force) .....4.01
Commission Regulation 753/2002 of 29 April 2002 laying down certain rules for applying Regulation (EC) No 1760/2000 of the European Parliament and of the Council of 17 July 2000	Council Regulation 1493/1999 as regards the description, designation,

presentation and protection of certain wine sector products, as amended by Regulation 2086/2002 (OJ L 179, 14.7.1999) (no longer in force) ...	2.190, 4.01, 4.02, 4.03, 4.05, 4.08, 4.184, 4.185, 4.189, 4.190, 4.272, 4.357, 6.77
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Council Regulation (EC) No 515/97 of 13 March 1997 on mutual assistance between the administrative authorities of the Member States and cooperation between the latter and the Commission to ensure the correct application of the law on customs and agricultural matters (OJ L 082, 22.03.1997 pp. 1–16) .....	7.232
Commission Regulation 1107/96 on the registration of geographical indications and designations of origin under the procedure laid down in Article 17 of Council Regulation (EEC) No 2081/92 (OJ No L 148, 21. 6. 1996, p. 1) (no longer in force) .....	3.57, 3.59, 3.71, 3.85, 3.87, 3.199
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Council Regulation 2082/92 on certificates of specific character for agricultural products and foodstuffs (OJ L 208, 24 July 1992, p. 9) .....	3.03, 3.84
Council Regulation (EEC) 2081/1992 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, (OJ L 208, 24.7.1992. p. 1) (no longer in force) .....	2.20, 2.94, 2.95, 2.98, 2.99, 2.100, 3.03, 3.15, 3.40, 3.43, 3.47, 3.50, 3.57, 3.60, 3.68, 3.69, 3.71, 3.81, 3.84, 3.85, 3.88, 3.89, 3.93, 3.94, 3.95, 3.98, 3.166, 3.176, 3.177, 3.181, 3.182, 3.183, 3.184, 3.196, 3.197, 3.199, 3.202, 3.203, 3.204, 3.282, 6.48, 6.49
Council Regulation (EEC) No 1601/91 laying down general rules on the definition, description and presentation of aromatised wines, aromatised wine-based drinks and aromatised wine-product cocktails (OJ L 149, 14.6.1991, p. 1) .....	4.360, 7.108, 7.113
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Commission Regulation (EEC) No 1014/90 of 24 April 1990 laying down detailed	



<p>Directive 98/34/EC of the European Parliament and of the Council of 22 June 1998 laying down a procedure for the provision of information in the field of technical standards and regulations and of rules on Information Society services (OJ L 204, 21.7.1998, p. 37) .....3.32</p> <p>Directive 95/46/EC of the European Parliament and of the Council of 24 October 1995 on the protection of individuals with regard to the processing of personal data and on the free movement of such data (OJ L 281, 23.11.1995 pp. 31–50) .....7.17, 7.122, 7.240, 7.243</p> <p>Council Directive 89/104/EEC of 21 December 1988 to approximate the</p>	<p>laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1) ..3.16, 3.190, 3.191, 4.131, 6.48</p> <p>Council Directive 80/777/EEC of 15 July 1980 on the approximation of the laws of the Member States relating to the exploitation and marketing of natural mineral waters (OJ L 229, 30.8.1980, pp. 1–10) .....6.60</p> <p>Council Directive 79/112/EEC of 18 December 1978 on the approximation of the laws of the Member States relating to the labelling, presentation and advertising of foodstuffs for sale to the ultimate consumer (OJ 1979 L 33, p. 1) .....6.48</p>
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# 1

## INTRODUCTION

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A study undertaken for the European Commission by Chever et al (2012 at 4) and published in October 2012 estimated the worldwide sales value of products sold under geographical indications (GIs) registered in the EU was estimated at €54.3 billion in 2010 and had increased by 12 per cent between 2005 and 2010. Over that period wines accounted for 56 per cent of total sales (€30.4 billion), agricultural products and foodstuffs for 29 per cent (€15.8 billion), spirit drinks for 15 per cent (€8.1 billion) and aromatised wines for 0.1 per cent (€31.3 million). Domestic EU sales were the main markets for these products (60 per cent), intra-EU trade accounted for 20 per cent and extra-EU trade accounted for 19 per cent. Over the period, extra-EU trade increased by 29 per cent. **1.01**

The leading Member State was France (€20.9 billion including 75 per cent for wines, 15 per cent for agricultural products and foodstuffs and 10 per cent for spirits), the second was Italy with a balance between the GIs registered in the different schemes (€11.8 billion including 51 per cent for agricultural products and foodstuffs, 48 per cent for wines and 1 per cent for spirits). The next two Member States were Germany (€5.7 billion including 59 per cent for agricultural products and foodstuffs, 40 per cent for wines and 1 per cent for spirits) and the United Kingdom (€5.5 billion including 81 per cent for spirits and 19 per cent for agricultural products and foodstuffs). **1.02**

This valuable trade is worth protecting and this book examines the detail of that protection. **1.03**

### A. SCOPE OF THE BOOK

This book examines the European laws concerning the protection of GIs and geographical trade marks and looks at the application of those laws in the UK. This introductory chapter reviews the history of GIs and grapples with definitional issues. Chapter 2 looks at the international context, in particular the **1.04**



GIs provisions of the WTO Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS Agreement), which is increasingly influencing the jurisprudence of the European Court of Justice (ECJ) on this subject. Chapter 3 examines the European legislation concerned with the protection of GIs and designations of origin for agricultural products and foodstuffs. This is based on the legal framework provided by EU Regulation No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs, which repealed and replaced Council Regulation (EC) No 509/2006 of 20 March 2006 on agricultural products and foodstuffs as traditional specialities guaranteed and Council Regulation (EC) No 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs.

- 1.05** Chapter 4 surveys the European legislation concerning wines, focusing upon Council Regulation 479/2008 of 29 April 2008 on the common organisation of the market in wine as updated by Commission Regulation (EC) No 607/2009 of 14 July 2009 and by Commission Regulation (EC) No 114/2009 of 6 February 2009. Chapter 5 deals with the protection of GIs and designations of origin for spirits in Europe and looks at the regime inaugurated by Regulation (EC) No 110/2008 of 15 January 2008 of the European Parliament and of the Council of 15 January 2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks. This chapter also examines Commission Implementing Regulation (EU) No 716/2013 of 25 July 2013, which contains rules dealing in particular with the use of compound terms, allusions, sales denominations and GIs for the presentation of spirit drinks and the application and objections process for GIs.
- 1.06** Chapter 6 is taken up with the protection of GIs by European trade marks, collective marks and certification marks legislation. It looks at the proposed amendments to the Community Trade Mark Regulation to provide for the registration of certification marks. The common law remedy in passing off is examined in its application to geographical marks and the chapter concludes with an examination of the World Intellectual Property Organization's (WIPO) Uniform Domain Name Dispute Resolution Policy.
- 1.07** Chapter 7 looks at the enforcement of GIs in Europe. This entails a detailed consideration of the Civil Enforcement Directive (Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights) and Regulation (EU) No 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property which replaced Council Regulation (EC) No 1383/2003 of 22 July 2003 concerning customs action against goods

suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights.

Despite this significant recent European legislative activism on the subject of GIs, it is to be expected that further legislation is in prospect, particularly in relation to the protection of GIs for products outside the existing schemes. The EU is currently engaged in trade negotiations with countries which have laws which protect all GIs products. These countries, such as Brazil, India and Thailand, have a significant interest in the protection of their non-agricultural GIs products at the EU level beyond the community trade mark system. It is perceived that the lack of a legal framework to protect these products could hamper the ability of the EU to secure protection of EU agricultural and wine and spirits products in these countries. At the same time, the EU is a leading advocate of the extension of the additional protection in Article 23 of the TRIPS Agreement for wines and spirits to agricultural products and handicrafts. This extension debate is examined in Chapter 2. An indication of the EU's thoughts for the future is the publication by the European Commission in 2009 of a study on the protection of GIs for products other than wines, spirits, agricultural products or foodstuffs. The Study analysed 28 non-agricultural products enjoying protection in certain EU Member States and in non-EU countries. It compared the protection systems available to these products and analysed the strengths and weaknesses of the protection systems identified. On 22 March 2013 the Commission published an updated version of this study, which was expected to 'feed into the Commission's on-going analysis of whether action at EU level is required in this area' (Insight, 2013). **1.08**

## B. HISTORY

The association between the unique qualities of goods and the geographical place of their production explains the genesis of GIs as a vehicle for trade. The international reputation of Toledo steel, Korean Celadon ware, Bruges lace and Burgundy wines secured the access of those products to markets well beyond their place of production. To take advantage of the commercial attractiveness of these local reputations, merchants branded their goods with marks which designated the place of origin of these products. These brands utilised depictions of local animals (panda beer), land marks (Mt Fuji sake), buildings (Pisa silk), heraldic signs (fleur de lys butter) or well-known local personalities (Napoleon brandy, Mozart chocolates). In a preliterate society these signs indicating the geographical origins of goods could be regarded as the earliest types of trade mark as these brands were tantamount to a warranty of the quality of goods. **1.09**

- 1.10** To protect the commercial reputation of these goods, local legislators passed laws to prevent the adulteration of local produce by the addition of inferior introduced goods or ingredients. These laws punished the adulteration of goods and established systems of marking approved local goods with marks certifying their quality (eg wool marks for cloth, hallmarks, for goods made from precious metals). Where the reputation of local goods was attributable to the skills and technology of local artisans, associations or guilds of master workers grew up. The taxing authorities saw an advantage in preserving the skills and revenue-earning capacities of these guilds and conferred upon them a monopoly of manufacture. To regulate this monopoly, the guilds developed service marks, or heraldic-type designs, which were placed upon goods produced by guild members.
- 1.11** Prior to the Industrial Revolution in Britain, which commenced in the eighteenth century, industrial production was on a small scale. The corporate form of industrial organisation did not yet exist. Until this time, the principal products that entered international trade were primary products, such as minerals and agricultural produce, and simple manufactured goods, such as pottery and woven fabrics. In the competition to earn revenues from the international trade that was developing at that time, it became apparent that the products of particular regions were more saleable than comparable products from other regions, because of their superior quality. This superior quality resulted either from natural geographic advantages, such as climate and geology (eg Seville oranges, Kentish hops, Roquefort cheese); recipes and food processing techniques local to a region (eg Kyoto bean cakes, Malmesbury mead, Frankfurter sausages) or indigenous manufacturing skills (eg Delft ceramic ware, Bohemian crystal ware).
- 1.12** The historical origins of GIs laws are usually traced back to the mediaeval French laws which conferred a number of advantages upon Bordeaux wine producers (see van Caenegem, 2003). Principal among these were the *privilège de la descente* and the *privilège de la barrique*. The former excluded non-Bordeaux wines from the Bordeaux wine market until 11 November of each year. The effect of this was to give Bordeaux wines an advantage in dealings with the lucrative English and Dutch markets as end-of-year dealings were vulnerable to the icing-up of northern ports. Non-Bordeaux wines were marked as such and sequestered in designated wine cellars in the city. This had the effect of developing administrative arrangements for identifying the geographic origins of wines.
- 1.13** The *privilège de la barrique* reinforced the commercial advantage of Bordeaux wines as the only wines entitled to a barrel made of superior wood and of

specified dimensions, which gave them an advantage for transportation in the merchant vessels of the time. In 1764 the *Arret de la Cour du Parlement concernant la police des vins* obliged each wine grower to identify, by way of a red brand on the bottom of each barrique, his name and that of the parish from which the wine originated to prevent the illicit use of the Bordeaux barrique.

As with contemporary GIs, this distinctive marking actually provided an opportunity for unscrupulous traders to pass off inferior wines as having a Bordeaux provenance, and within Bordeaux wine from the lower quality parishes was mixed with or passed off as wine from parishes of higher repute. **1.14**

The privileges which Bordeaux enjoyed were swept away by the legislation of the National Constituent Assembly, which abolished feudalism and revoked the privileges of towns, provinces, companies and cities throughout France.<sup>1</sup> In seeking to preserve its privileges Bordeaux argued that as the land of the province was unsuitable for any other crops viticulture merited encouragement and protection. This foreshadowed the modern debate around *sui generis* GI systems where they are justified for the purposes of rural development and the maintenance of rural populations. **1.15**

A number of commentators have pointed out that the French appellations system has a much more modern origin than suggested by the mediaeval *privileges* and point to the opening of the railway between Bordeaux and Paris in the mid-nineteenth century as a significant development (Olszak, 2001 at 6; Hughes, 2006 at 306–7). Others point to the development of concern for consumers arising from wine adulteration, fraud and falsification (Stanziani, 2004). Stanziani points out that the establishment of the French AOC system to protect wines was the outcome of a long process in which the trade mark system was utilised with limited success in a series of nineteenth century cases concerning deceptive designations (see Stanziani, 2009). This necessitated remedial legislation. The Law of 6 May 1919 concerning *appellations d'origine* was enacted as part of a package of legislation concerning the elimination of fraudulent and misleading designations for wines and foodstuffs. This law sought to provide a methodology for designating wine regions. This was reinforced by the establishment in 1935 of AOCs, under the supervision of a Committee which, from 1947, became the INAO (Institut National des Appellations d'Origine). **1.16**

Hughes points out that of the more than 35 protected appellations for cheese in France, only 11 are more than 30 years old and that even Chianti did not **1.17**

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<sup>1</sup> Decree of 4 August 1789, discussed in Jennings, 2011 at 29.

become a protected *denominazione* in Italy until 1967 (Hughes, 2006 at 350). He suggests that the European enthusiasm for protecting GIs is more a reflection of contemporary agricultural policy than a desire to preserve historic institutions.

- 1.18** The development of large-scale industrial production, which was a feature of the Industrial Revolution, led to demands for the legal protection of the brands of individual producers as indications of the source of their goods. Large-scale production made it possible for manufacturers to produce goods of a consistent quality and their brands became a warranty of the quality of their goods. Unlike GIs which referred to the geographical place of production, manufacturers demanded a system for the protection of their reputation either as producers of goods, or later on, as standing behind the quality of the goods produced in their name. The passing off action was developed by the English courts as a means for manufacturers to protect the indicia of their commercial reputations from misappropriation by those seeking to have a free ride on those reputations. These indicia included names, marks and symbols. To secure protection under the tort of passing off, plaintiffs had first to establish the existence of a commercial reputation in the jurisdiction. A protectable commercial reputation was typically established on the basis of the evidence of others in the trade and of consumers. This tended to take up a considerable amount of court time and as a consequence the registered trade marks system was developed under which possession of a valid trade mark registration certificate replaced the necessity to prove a commercial reputation. Under the registered trade marks system individual traders could enforce the exclusive right to their marks as a private proprietary right.
- 1.19** The evolution of the private trade mark system did not result in the disappearance of geographical marks. Particularly in Europe, substantial processed foods markets and markets for alcoholic beverages remained dependent upon the continued recognition of geographical marks. Indeed, for European negotiators, the inclusion of these marks in the TRIPS Agreement was a significant achievement of the Uruguay Round of the General Agreement on Tariffs and Trade (GATT).

### C. DEFINITIONS

- 1.20** A number of commentators on the law of GIs note a considerable diversity in the terminology concerning GIs. Norma Dawson (2000 at 591–2) among others (eg Conrad, 1996 at 13–14) suggests that this terminological diversity might result from the various international agreements that have attempted to

deal with GIs. The Paris Convention 1883 in Art 10 provided for the seizure of imports of goods bearing ‘false indications of the source of goods’. This expression was repeated in the Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods 1891. The International Convention on the Use of Appellations of Origin and Denominations of Cheeses (‘Stresa Convention’) 1951 borrowed the term *appellations d’origine* from the French AOC legislation. This in turn was repeated in the Lisbon Agreement for the Protection of Appellations of Origin and their Registration, 1958. Article 2 of the Lisbon Agreement defined ‘appellation of origin’ to mean:

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 geographical environment, including natural and human factors.

Article 22 of the TRIPS Agreement defines geographical indications as: **1.21**

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 Lisbon Agreement concept of appellation of origin 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. Also, under the TRIPS Agreement, to be protected, a GI has to be an indication, but not necessarily the name of a geographical place on earth. **1.22**

The WTO Secretariat in a survey of national laws identified 23 different terms and as a consequence adopted the term ‘indications of geographical origin’ to designate the different expressions used by WTO Members to protect geographical origin of products.<sup>2</sup> **1.23**

Dev Gangjee suggests that the terminological diversity in this area may be attributable to the various policies to be served by GIs, such as agricultural marketing, rural development, the preservation of traditional knowledge and cultural heritage (Gangjee, 2012 at 2–18). **1.24**

It should be noted that as early as the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods 1891, most laws embrace **1.25**

2 Note by the WTO Secretariat IP/C/W/253, dated April 2001, in ‘Review under Article 24.2 of the application of the provisions of the section of the TRIPS Agreement on geographical indications. Summary of the responses to the checklist of questions (IP/C/13 and Add.1)’. For a more recent global survey of GIs legislation see O’Connor et al, 2007.

indirect GIs. The Madrid Agreement in Art 1(1) provides for the seizure on importation of '[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'. An example of such an indirect indication mentioned during the 1934 London Revision Conference was the wax from the carnauba fan palm tree which, although not an actual place name, was 'indissolubly linked' to its origins in the north-eastern savannahs of Brazil (see Gangjee, 2012 at 66). A more modern illustration is 'Basmati' as indicative of the Indian sub-continent (see Blakeney and Lightbourne, 2005).

**1.26** Advocate General Colomer, in *Budějovický Budvar, národní podnik v Rudolf Ammersin GmbH*<sup>3</sup> had to consider whether the trade mark 'BUD' was an indirect indication of the Bohemian town České Budějovice (formerly Budweis). He explained:

68. Geographical indications and even designations of origin do not always consist of geographical names. They are called 'direct' when they do and 'indirect' when they do not, provided the indication or designation at least informs consumers that the foodstuff to which it relates comes from a specific place, region or country.

...

71. Regardless of whether the Czech public can guess where 'Bud beer' comes from, it must be ascertained whether the expression 'Bud' is sufficiently clear to evoke a product, beer, and its origin, the town of České Budějovice.

72. In the same way that the words 'cava' or 'grappa' call to mind the Spanish and Italian birthplaces of a sparkling wine and of a liqueur respectively and that 'feta' identifies a Greek cheese were it to be found that 'Bud' represents a geographical indication, Czech consumers would have to associate the expression with a precise place and with the brewing of beer.

**1.27** Another example of an indirect GI in European litigation is the *Bocksbeutel* bottle, which has a characteristic bulbous shape and is used for the marketing of wine in Franconia, Baden-Franconia parts of Central Baden.<sup>4</sup>

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3 [2003] ECR I-13617.

4 *Criminal proceedings against Karl Prantl*, Case 16/83 [1984] ECR 01299.

## 2

# INTERNATIONAL GEOGRAPHICAL INDICATIONS REGIMES

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<p>A. PRECURSORS TO TRIPS <span style="float: right;">2.01</span></p> <p>1. Paris Convention for the Protection of Industrial Property 1883 <span style="float: right;">2.03</span></p> <p>2. Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods 1891 <span style="float: right;">2.11</span></p> <p>3. International Convention on the Use of Appellations of Origin and Denominations of Cheeses ('Stresa Convention') 1951 <span style="float: right;">2.16</span></p> <p>4. Lisbon Agreement for the Protection of Appellations of Origin and their Registration 1958 <span style="float: right;">2.21</span></p> <p>5. The International Wine Organization <span style="float: right;">2.32</span></p> <p>B. THE WTO TRIPS AGREEMENT <span style="float: right;">2.39</span></p> <p>1. Protection of geographical indications <span style="float: right;">2.40</span></p>	<p>2. Geographical indications and trade marks <span style="float: right;">2.53</span></p> <p>3. Additional protection for geographical indications for wines and spirits <span style="float: right;">2.63</span></p> <p>4. TRIPS revision <span style="float: right;">2.84</span></p> <p>5. The TRIPS GIs disputes <span style="float: right;">2.94</span></p> <p>6. TRIPS enforcement <span style="float: right;">2.101</span></p> <p>7. TRIPS rights under European law <span style="float: right;">2.183</span></p> <p>C. REVIVAL OF THE LISBON AGREEMENT <span style="float: right;">2.191</span></p> <p>1. Protocol to the Lisbon Agreement <span style="float: right;">2.191</span></p> <p>2. WIPO proposals <span style="float: right;">2.192</span></p> <p>D. BILATERAL AND PLURILATERAL AGREEMENTS <span style="float: right;">2.217</span></p>
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### A. PRECURSORS TO TRIPS

The GIs provisions of the TRIPS Agreement were anticipated as early as the 1883 Paris Convention on Industrial Property, which, as will be seen below imposed merely general obligations in relation to 'indications of source or appellations of origin' which were undefined terms. The Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods 1891, which was enacted as a special treaty under the Paris Convention, contained more specific obligations, but it was not until the Lisbon Agreement on the Protection of Appellations of Origin and their International Registration 1958 that at least appellations of origin were defined and elements of this definition were carried forward into the definition of GIs in the TRIPS Agreement. **2.01**

Prior to the Lisbon Agreement, the 1951 Stresa Convention proposed a system for the protection of appellations of origin and designations for cheeses contained in an annex to the Convention. The Lisbon Agreement, by way of contrast, envisaged protection of appellations of origin by their registration. The TRIPS Agreement did not prescribe a preferred method for the protection **2.02**



of GIs but leaves this to signatories to decide. The possible establishment of a system for the registration of GIs was left to subsequent negotiation and as will be seen below, after more than 15 years of deliberations, the TRIPS signatories have yet to reach agreement on this subject.

## 1. Paris Convention for the Protection of Industrial Property 1883<sup>1</sup>

### (a) Scope

**2.03** The first multilateral agreement, which included ‘indications of source or appellations of origin’ as objects for protection by national industrial property laws, was the Paris Convention. According to Art 2(2) the objects of protection of industrial property include ‘indications of source or appellations of origin’. However, the Paris Convention does not define these terms and does not expressly require Member States to provide for protection of indications of source and appellations of origin.

**2.04** Article 2(3) of the Paris Convention provides that ‘industrial property shall be understood in the broadest sense and shall apply not only to industry and commerce proper, but likewise to agricultural and extractive industries and to all manufactured or natural products, for example, wines, grain, tobacco leaf, fruit, cattle, minerals, mineral waters, beer, flowers, and flour’.

### (b) Seizure of goods bearing a false indication of source

**2.05** Article 9(1) of the Paris Convention provides for the seizure upon importation of all goods unlawfully bearing a legally protected ‘trademark or trade name’. Article 9(3) provides that ‘seizure shall take place at the request of the public prosecutor, or any other competent authority, or any interested party, whether a natural person or a legal entity, in conformity with the domestic legislation of each country’.

**2.06** Article 10(1) provides for the application of the provisions of Art 9 ‘in cases of direct or indirect use of a false indication of the source of the goods or the identity of the producer, manufacturer or merchant’. Unlike Art 9(1), which catches misleading indications, Art 10(1) requires that the indications be factually false and not misleading. Although the provision only speaks of ‘indications of source’, it is understood that it includes ‘appellations of origin’, as referred to in Art 1(2) (Pflüger, 2011 at 274). As Art 10(1) refers to any direct or indirect use, the false indication does not have to be expressed in words and

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<sup>1</sup> The Paris Convention 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. The Paris Convention as of September 2013 had 175 contracting parties.

appear on the product. It would include also the use of a false indication in advertising or on business documents.

The only sanction referred to in Art 10(1) is seizure of the goods concerned but no further civil or criminal sanctions are envisaged. Also the obligation to seize goods on importation only applies to the extent that such a measure has been adopted under national law. **2.07**

Under Art 10(2), any **2.08**

producer, manufacturer, or merchant whether a natural person or legal entity, engaged in the production or manufacture of or trade in such goods and established either in the locality falsely indicated as the source, or in the region where such locality is situated, or in the country falsely indicated, or in the country where the false indication of source is used, shall in any case be deemed an interested party.

*(c) Repression of unfair competition*

Article 10*bis* also affords protection against false or misleading indications of source as a means of repressing unfair competition. Article 10*bis* (2) defines as an act of unfair competition ‘any act of competition contrary to honest practices in industrial or commercial matters’ **2.09**

The ECJ, in its various trade marks determinations has observed that the requirement to act in accordance with honest practices in industrial or commercial matters ‘constitutes in substance the expression of a duty to act fairly in relation to the legitimate interests of the trade mark proprietor’.<sup>2</sup> **2.10**

2. Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods 1891<sup>3</sup>

*(a) Seizure of goods bearing a false or misleading indication*

The original form of the Paris Convention prohibited the use of false GIs. A number of signatory nations proposed a more comprehensive form of regulation for what was considered to be a significant intellectual property abuse. The 1891 Madrid Agreement concerning the protection of geographical indications was their response. Article 1(1) provided that all goods ‘bearing a **2.11**

2 See Case C-63/97 *Bayerische Motorenwerke AG v Deenik* [1999] ECR I-905 at [61], Case C-100/02 *Gerolsteiner Brunnen GmbH & Co v Putsch GmbH* [2004] ECR I-691 at [24], Case C-245/02 *Anheuser-Busch Inc v Budejovický Budvar np* [2004] I-10989 at [82], Case 228/03 *Gillette Co v LA-Laboratories Ltd Oy* [2005] ECR I-2337 at [41] and Case C-17/06 *Céline SARL v Céline SA* [2007] ECR I-7041 at [33].

3 The Madrid Agreement 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 as of September, 2013 had 36 contracting parties.

false or misleading indication' to a signatory country, or to a place in that country 'shall be seized on importation'. Article 1(2) provided for seizure also 'in the country where the false or deceptive indication of source has been applied, or into which the goods bearing the false or deceptive indication have been imported'. Where the laws of a country do not permit seizure upon importation Art 1(3) provides that such seizure shall be replaced by prohibition of importation. In the absence of any special sanctions ensuring the repression of false or deceptive indications of source, Art 1(5) provides that 'the sanctions provided by the corresponding provisions of the laws relating to marks or trade names shall be applicable'.

- 2.12** Article 2(1) provides that seizure shall take place at the instance of the customs authorities, who shall immediately inform the interested party, whether an individual person or a legal entity, in order that such party may, if it so desires, take appropriate steps in connection with the seizure effected as a conservatory measure. However, the public prosecutor or any other competent authority may demand seizure either at the request of the injured party or *ex officio*; the procedure shall then follow its normal course. Excluded from seizure by Art 2(2) are goods in transit.

*(b) Prohibited use of deceptive indications in advertising, etc*

- 2.13** Article 3*bis* provides that signatory countries undertake to prohibit the use, in connection with the sale or display or offering for sale of any goods, of all indications in the nature of publicity capable of deceiving the public as to the source of the goods, and appearing on signs, advertisements, invoices, wine lists, business letters or papers, or any other commercial communication.

*(c) Exception of indications of name and address*

- 2.14** Article 3 provides that the Madrid provisions shall not prevent the vendor from indicating his name or address upon goods coming from a country other than that in which the sale takes place; but in such case the address or the name must be accompanied by an exact indication in clear characters of the country or place of manufacture or production, or by some other indication sufficient to avoid any error as to the true source of the wares.

*(d) Generic indications*

- 2.15** Article 4 permitted the courts of each signatory to decide what appellations, on account of their generic character, do not fall within the provisions of the Agreement. However, this article excluded from this reservation regional appellations concerning the source of products of the vine. This provision apparently explained why this Agreement failed to attract the accession of significant trading nations such as the USA, Germany and Italy.

### 3. International Convention on the Use of Appellations of Origin and Denominations of Cheeses ('Stresa Convention') 1951

The parties to the Stresa Convention, which are some of the cheese-producing countries of Europe,<sup>4</sup> 'pledge themselves to prohibit and repress within their respective territorial confines the use, in the language of the state or in a foreign language, of the "appellations d'origine", denominations and designations of cheeses contrary to the principles stated in Articles 2 to 9 inclusive. The Convention, which entered into force on 1 September 1953, applies to all specifications which constitute false information as to the origin, variety, nature or specific qualities of cheeses, which are stated on products which might be confused with cheese. The term 'cheese', according to Art 2.1 of the Convention, is reserved for 'fresh and matured products obtained by draining after the coagulation of milk, cream, skimmed or partially skimmed milk or a combination of these', or by 'products obtained by the partial concentration of whey, or of buttermilk, but excluding the addition of any fatty matter to milk'. **2.16**

Article 3 provides that the appellations of origin of those cheeses 'manufactured or matured in traditional regions, by virtue of local, loyal and uninterrupted usages', which are listed in Annex A, are exclusively reserved to those cheeses 'whether they are used alone or accompanied by a qualifying or even corrective term such as "type", "kind", "imitation" or other term'. Annex A lists: Gorgonzola, Parmigiana Romano, Pecorino Romano and Roquefort. Annex B lists a number of designations for cheese that are prohibited by Art 4.2 for products which do not meet the requirements provided by Contracting Parties in relation to 'shape, weight, size, type and colour of the rind and curd, as well as the fat content of the cheese'. Listed in Annex B are Asiago, Camembert, Cambozola, Danablu, Edam, Emmental, Esrom, Fiore Sardo, Fontina, Gruyère, Pinnzgauer Berkäse, Samsöe and Svecia. **2.17**

The Stresa Convention came into force prior to the EEC Treaty and its regime providing for the free movement of goods. **2.18**

In the *Deserbais* case<sup>5</sup> the Court had to construe Art 234 (now Art 307) of the EC Treaty which provided that the application of the Treaty did not affect the duty of the EC Member State in respect the rights of non-member countries under a prior international agreement. The Stresa Convention had been signed **2.19**

4 The Stresa Convention was ratified by Austria (12 June 1953); Denmark (2 August 1953); France (20 May 1952); the Netherlands (29 October 1955); Norway (31 August 1951); Sweden (27 January 1951) and Switzerland (5 June 1951).

5 [1988] ECR-4907, 22 September 1988.

before the EEC Treaty entered into force and only Denmark, France, Italy and the Netherlands were parties to it. The Court found on the facts that in this case, the rights of non-Member countries were not involved, and therefore, a Member State could not rely on the provisions of a pre-existing international agreement to justify restrictions on the marketing of products coming from another Member State, where the marketing was otherwise lawful by virtue of the free movement of goods provided for by the Treaty.

- 2.20 Similarly, in the *Cambozola* case<sup>6</sup> the ECJ ruled that the free movement of goods principle was subordinated to the Stresa Convention and Council Regulation (EEC) No 2081/92 permitting the registration and enforcement of rights in relation to designations of origin.

#### 4. Lisbon Agreement for the Protection of Appellations of Origin and their Registration 1958<sup>7</sup>

##### (a) Introduction

- 2.21 The Lisbon Agreement established an international system of registration and protection of appellations of origin among members of the Lisbon Union, which comprised signatory states. Article 1(2) obliged parties to the Agreement to protect on their territories ‘the appellations of origin of products’ of signatory countries, ‘recognized and protected as such in the country of origin’ and registered at the International Bureau of WIPO. Article 4 of the Agreement provides that the Agreement does not exclude the protection already granted to appellations of origin in each of the countries of the Lisbon Union by virtue of other international instruments, such as the Paris and the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods, ‘or by virtue of national legislation or court decisions’.

- 2.22 The Lisbon Agreement failed to attract support from more than a few nations (only 28 signatories by September 2013). Gervais (2010 at 79) observed from an examination of all current appellations on the Lisbon register that 11 countries hold 97.5 per cent of all entries, with the top three holding over 78 per cent, of which France holds 62.5 per cent (almost 90 per cent of which was for wines and spirits). One problem was that accession was confined to those nations which protected appellations of origin ‘as such’. Thus, states which

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6 [1999] ECR-1, 4 March 1999.

7 This agreement was concluded in Lisbon on 31 October 1958. It was revised in Stockholm in 1967 and amended in 1979. As of September 2013 there were 28 contracting parties.

protected this form of intellectual property under trade mark, unfair competition or consumer protection laws were locked out. Also the Agreement did not make an exception for GIs, which had already become generic in Member States.

*(b) Protected indications*

Article 2(1) of the Agreement defined ‘appellation of origin’ to mean ‘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 geographical environment, including natural and human factors’. The country of origin is defined in Art 2(2) as ‘the country whose name, or the country in which is situated the region or locality whose name, constitutes the appellation of origin which has given the product its reputation’.

*(c) Breadth of protection*

Article 3 of the Lisbon Agreement requires that ‘[p]rotection shall be ensured against 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’. As will be seen below, this language was included in Art 23 of the TRIPS Agreement, to provide for additional protection for wines and spirits. The Acts of the Lisbon Conference define usurpation as the ‘illicit adoption’ or counterfeiting of an appellation.<sup>8</sup>

*(d) Registration*

Article 5(1) provided for the registration of appellations of origin at the International Bureau of WIPO, at the request of the IP offices of the countries of the Lisbon Union, ‘in the name of any natural persons or legal entities, public or private, having, according to their national legislation, a right to use such appellations’. Thus international protection is based upon the existence of a national registration.

Article 5(2) requires the International Bureau, without delay to notify the relevant offices of the various countries of the Lisbon Union of such registrations and for these to be published in a periodical.

Article 5(3) provides for an IP office of a Member country to ‘declare that it cannot ensure the protection of an appellation of origin whose registration has been notified to it’ provided that this is notified to the International Bureau of

<sup>8</sup> *Actes de la conférence réunie A Lisbonne du 6 au 31 octobre 1958* BIRPI, Geneva, 1963.

WIPO, together with an indication of the grounds therefor, within a period of one year from the receipt of the notification of registration and 'provided that such declaration is not detrimental, in the country concerned, to the other forms of protection of the appellation which the owner thereof may be entitled to claim under Article 4'. Article 5(4) provides that such declaration may not be opposed by the Offices of the countries of the Union after the expiration of the period of one year from receipt of the notification. Article 5(5) requires the International Bureau of WIPO, as soon as possible, to notify the office of the country of origin of any declaration made under Art 5(3) by the office of another country. Article 5(5) provides that 'the interested party', when informed by the national office of the declaration made by another country, 'may resort, in that other country, to all the judicial and administrative remedies open to the nationals of that country'. The Lisbon Agreement does not define what is meant by 'interested party', although Art 8 envisages that legal action required for ensuring the protection of appellations of origin may be taken in each of the countries of the Lisbon Union 'by any interested party, whether a natural person or a legal entity, whether public or private'.

- 2.28** Where an appellation which has been granted protection in a given country pursuant to notification of its international registration has already been used by third parties in that country from a date prior to such notification, Art 5(6) provides that the competent office of that country 'shall have the right to grant to such third parties a period not exceeding two years to terminate such use', on condition that it advises the International Bureau accordingly during the three months following the expiration of the period of one year provided for in Art 5(3).

*(e) Duration of protection*

- 2.29** The Lisbon Agreement makes an unclear reference to the duration of protection of a registered appellation of origin. Article 7, which is sub-headed 'Period of Validity', provides: '(1) Registration effected at the International Bureau in conformity with Article 5 shall ensure, without renewal, protection for the whole of the period referred to in the foregoing Article.' Article 5 makes no specific reference to a time period for protection; its only reference to time periods relates to the process of declaring that certain appellations cannot be protected. However, since Art 7(1) refers to an absence of renewals, the assumption is that an appellation is protected for as long as it remains an appellation in the relevant country of origin.

*(f) Generic appellations*

- 2.30** Article 6 provides that an appellation which has been granted protection in one of the countries of the Lisbon Union pursuant to the procedure under Art 5

cannot, in that country, be deemed to have become generic, as long as it is protected as an appellation of origin in the country of origin.

(g) *Enforcement*

Article 8 of the Lisbon Agreement provides that legal action required for ensuring the protection of appellations of origin may be taken in each of the countries of the Lisbon Union under the provisions of national legislation: **2.31**

1. at the instance of the competent Office or at the request of the public prosecutor;
2. by any interested party, whether a natural person or a legal entity, whether public or private.

## 5. The International Wine Organization

The idea for an international organisation to represent the interests of the wine industry were prompted by the nineteenth century phylloxera epidemic. In 1922 the French Society for Encouraging Agriculture suggested the establishment of the International Wine Organization. International conferences were held in Genoa in 1923 and in Paris in 1924, and on 29 November 1924 Spain, Tunisia, France, Portugal, Hungary, Luxemburg, Greece and Italy signed an agreement establishing the 'International Office of Vine and Wine' (OIV) in Paris. The OIV came into existence on 3 December 1927 after ratification of the agreement by five countries. According to its constituent instrument of 1924, the OIV was responsible for ensuring the protection of appellations of origin. In 1947 it adopted an initial definition of appellation of origin. **2.32**

On 4 September 1958 the organisation's name was changed to the International Vine and Wine Office (*Office Internationale de la Vigne et du Vin*) (OIV). **2.33**

In 1992, the OIV adopted two definitions 'Recognised Geographical Indication (RGI)' and 'Recognised Appellation of Origin (RAO)'. In 1994 the OIV adopted a resolution on the relationship between RAO and RGI and the brands, which provides for an equal level of protection for brands, recognised appellations of origin, recognised GIs and recognised traditional names. This protection is determined by priority (of recognition, registration or usage depending on the type of distinctive brand) while taking into account the distinctive character and reputation. **2.34**

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<sup>9</sup> <http://www.oiv.int/oiv/info/entableaucomparatifs>.



- 2.35** During its General Assembly in Germany, the OIV added to its recommendations through the section on homonyms and a resolution on principles regarding GIs and the Internet.
- 2.36** Following a 35-nation agreement on 3 April 2001, which came into effect on 1 January 2004, the International Vine and Wine Office was replaced by the International Organisation of Vine and Wine. The responsibility to protect appellations of origin was included in the Agreement of 3 April 2001 establishing the International Organisation of Vine and Wine. The 2012 International Standard for the Labelling of Wines represents the deliberations of the Member States between 1983 and 2011 and concerns ‘the compulsory information which appears on the labelling of pre-packed wines in view of their sale to the consumer, as well as optional information left to the discretion of manufacturers or Member States’.<sup>10</sup> The chapter on compulsory information includes the following standards on denominations:

## 2. COMPULSORY INFORMATION

### 2.1. The denomination of the product

#### 2.1.1 The use of the word ‘wine’.

The use of the word ‘wine’ or, (without prejudice to article 2.1.2.2) other substitutive recognised indication, is obligatory in the labelling of the product which respects the definition quoted in article 1.2.1. It may be completed by mentioning its type or particular classification. Subject to the provisions which the Member States make compulsory for their own production, no opposition can be made to the release onto the market of the product which respects this definition and which is presented under the single name ‘wine’.

Without prejudice to the particular provisions made for certain products which bear in their name the word ‘wine’ alongside complementary information, the word ‘wine’ used alone can only apply to the product defined in article 1.2.1.

#### 2.1.2. Recognised appellation of origin or recognised geographic indication

##### 2.1.2.1 Definitions

###### Recognised Geographic Indication

It is the name of the country, the region or the place used in the designation of a product originating from this country, region, place or area defined to this end under this name and recognised by the competent authorities of the country concerned.

As far as wine is concerned, the recognition of this name:

- is linked to a quality and/or to a characteristic of the product attributed to the geographic milieu including natural or human factors; and

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10 [www.oiv.int/./OIV%20Wine%20Labelling%20Standard%20EN\\_2012](http://www.oiv.int/./OIV%20Wine%20Labelling%20Standard%20EN_2012).

- is subordinate to the grapes being harvested in the country, region, place or defined area.

As far as spirits of a vitivincultural origin are concerned, the recognition of this name:

- is linked to a quality and/or a characteristic that the product acquires as a result of a decisive phase of its production; and
- is subordinate to this decisive phase being carried out in the country, region, place or defined area.

#### Recognised Appellation of Origin

It is the name of the country, region or the place used in the designation of a product originating from this country, region, place or area as defined to this end, under this name and recognised by the competent authorities of the country concerned.

As far as wine and spirit beverages from a vitivincultural origin are concerned, the recognised appellation of origin

- refers to a product whose quality or characteristics are due exclusively or essentially to the geographic milieu, including natural and human factors, and
- is subordinate to the harvest as well as its transformation in the country, region, place or defined area.

2.1.2.2 When a wine benefits from a recognised appellation of origin or from a recognised geographic indication such as defined above, and figures on a list published by the International Organisation of Vine and Wine, the use of this recognised appellation of origin or the recognised geographic indication on the label, conforming to the laws of the producer country, is obligatory.

In this case the recognised appellation of origin or the recognised geographic indication can constitute the denomination of the product and take the place of the word ‘wine’.

To avoid confusion with other designations it is recommended that the use of a complementary mention characterising the product, such as ‘Appellation of Origin...’ is made compulsory.

The OIV Extraordinary General Assembly approved the 2009–2012 Strategic Plan at its meeting in October 2008. Point M of the Strategic Plan (Designation and labelling), states in Action M.6 to ‘draw up an inventory for wines and spirits of viticultural origin, on the Denomination of Origin and Geographic Indications in OIV Member States including their respective national legislations’. This list is a compilation of the names of vitivincultural GIs or appellations of origin which are legally protected and recognised. The list provides information based on notifications by the relevant authorities in each State. The list carries no rights or legal obligations. **2.37**

**2.38** The OIV resolution on geographical indications and homonyms<sup>11</sup> defines the homonymy of a geographic indicator as used to designate a wine or spirit beverage of viticultural origin as used in several countries with a common spelling and/or identical pronunciation and recommends that Member States of the OIV should, when setting differentiation rules for these homonymous names:

- consider the official recognition used in the country of origin,
- consider the length of time the name has been in use,
- consider whether the usage is in good faith,
- consider the importance of presenting the homonymous labels to marketing,
- encourage mentioning sufficient distinguishing information to avoid confusion of consumers.

## B. THE WTO TRIPS AGREEMENT

**2.39** The protection of GIs was a key demand of European negotiators at the Uruguay Round of the GATT. The competing positions were those of the EU and Switzerland, which proposed a French style of protection, and the USA, which favoured the protection of GIs through a certification mark system. In the result, section 3 of Part VII of the TRIPS Agreement covers four main topics: (a) protection of GIs; (b) GIs and trade marks; (c) additional protection for GIs for wines and spirits; and (d) review of section 3. These topics are examined below together with an account of GIs disputes under the TRIPS Agreement.

### 1. Protection of geographical indications

#### (a) *Definition*

**2.40** Article 22.1 of the TRIPS Agreement defines geographical indications for the purposes of the Agreement as ‘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 Lisbon Agreement concept of appellation of origin to protect goods which merely derive a reputation from their place of origin without possessing a given quality or other characteristics which is due to that place.

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<sup>11</sup> Resolution ECO 3/99 at <http://www.oiv.int/oiv/info/enresolution>.

In its only determinations to date on GIs under the TRIPS Agreement the WTO dispute panel ruled that a ‘designation of origin’ and ‘geographical indication’ as defined in EC legislation in different terms were a subset of geographical indications as defined in Art 22.1.<sup>12</sup> **2.41**

Under the TRIPS Agreement a GI to be protected has to be an indication, but not necessarily the name of a geographical place on earth. Thus, for example, ‘Basmati’ is taken to be an indication for rice coming from the Indian subcontinent, although it is not a place name as such. The indication has to identify goods as originating in the territory of a Member, a region or a locality of that territory. This definition also indicates that goods to be protected should originate in the territory, region or locality to which they are associated. This suggests that licences for the use of GIs cannot be protected under the TRIPS Agreement. **2.42**

The TRIPS definition permits Members to protect the GIs of goods where the quality, reputation or other characteristic of goods are attributable to their geographical origin. **2.43**

*(b) Permitted methods for the protection of geographical indications*

Article 22.2 of the TRIPS Agreement requires that ‘in respect of geographical indications’, Members of the WTO shall provide the ‘legal means’ for ‘interested parties’ to prevent: **2.44**

- (a) 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;
- (b) any use which constitutes an act of unfair competition within the meaning of Article 10*bis* of the Paris Convention (1967).

*(i) ‘In respect of’*

In *EC – Trademarks and Geographical Indications (Australia)* the Panel interpreted the obligation to provide certain legal means ‘in respect of’ GIs as an obligation to provide for the protection of GIs and rejected a claim concerning **2.45**

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12 European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs, Complaint by the United States, Report of the Panel (hereinafter ‘*Panel Report, EC – Trademarks and Geographical Indications (US)*’), WT/DS174/R, 15 March 2005, para 7.738; European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs, Complaint by Australia, Report of the Panel (hereinafter ‘*Panel Report, EC – Trademarks and Geographical Indications (Australia)*’), WT/DS290/R 15 March 2005, para 7.711.

situations where geographical indications might have an impact upon trade mark protection.<sup>13</sup>

(ii) 'Legal means'

**2.46** In relation to (a) Art 22.2 does not specify the legal means to protect GIs. This is left for Members to decide. Thus GIs could be protected under consumer protection laws or as an aspect of trade marks laws, such as by a certification or collective mark. In relation to (b) GIs could be protected under unfair competition laws or under actions such as passing off.

(iii) 'Interested parties'

**2.47** In *EC – Trademarks and Geographical Indications (US)* the Panel explained that the obligation in Art 22.2 is to provide certain legal means to 'interested parties' who are nationals of other Members in accordance with the criteria referred to in Art 1.3. The interested parties must qualify as 'nationals of other Members' in accordance with the criteria referred to in Art 1.3. The Panel pointed out that these persons can be private parties, which is reflected in the fourth Recital of the preamble to the agreement, which reads '[r]ecognizing that intellectual property rights are private rights'.<sup>14</sup>

**2.48** Although the term 'interested party' is also used in Art 10(2) of the Paris Convention (1967) as incorporated in the TRIPS Agreement, by Art 2(1) of the TRIPS Agreement, in *EC – Trademarks and Geographical Indications (US)*, the Panel observed that Art 10(2) of the Paris Convention (1967) did not set out a criterion for eligibility for protection for the purposes of the TRIPS Agreement although it may provide guidance on the interpretation of Articles 22 and 23 of the TRIPS Agreement.<sup>15</sup>

(c) *Non-protection of expired geographical indications*

**2.49** Article 24.9 provides that there is no obligation under the TRIPS Agreement to protect GIs 'which are not or cease to be protected in their country of origin, or which have fallen into disuse in that country'.

(d) *Non-diminution of geographical indications protection*

**2.50** Article 24.3 of the TRIPS Agreement requires that in implementing the GIs provisions a WTO Member shall not diminish the protection of GIs that existed in that Member immediately prior to the date of entry into force of the WTO Agreement.

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13 Panel Report, *EC – Trademarks and Geographical Indications (Australia)*, para 7.714.

14 Panel Report, *EC – Trademarks and Geographical Indications (US)*, paras 7.742–7.743.

15 Panel Report in *EC – Trademarks and Geographical Indications (US)*, para 7.170.