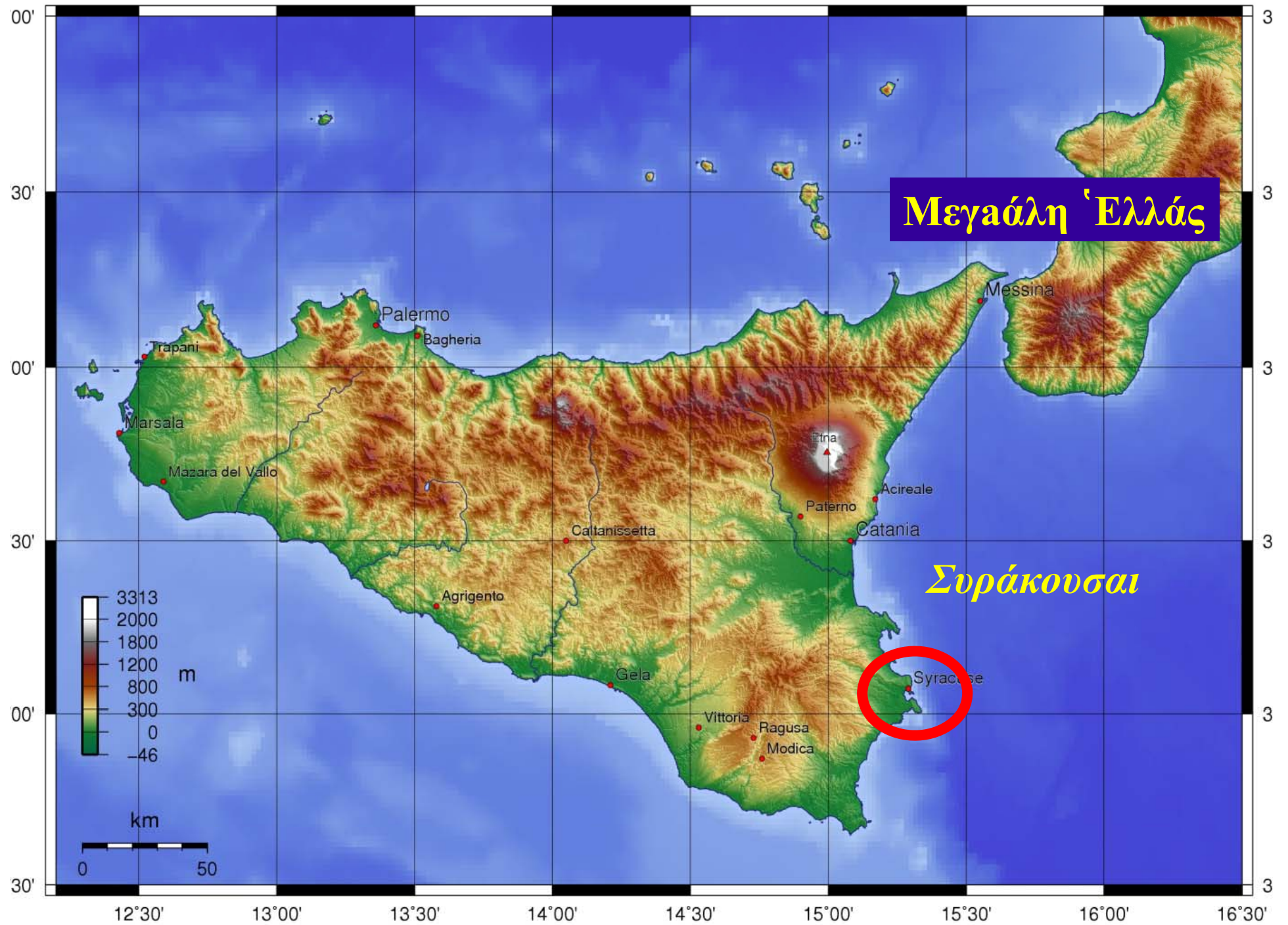




Geographical indications in the WTO:

**International Olive Council
International Seminar:
Geographical indications
in the olive oil and table olive sector**

*Villa San Giovanni,
21 October 2010*









- Ὄνομάτων οὖν στασιασάντων, καὶ τῶν μὲν φρασιόντων ἑαυτὰ εἶναι τὰ ὅμοια τῇ ἀληθείᾳ, τῶν δ' ἑαυτὰ, τίνι ἔτι διακρινοῦμεν, ἢ ἐπὶ τί ἐλθόντες; οὐ γάρ που ἐπὶ ὀνόματά γε ἕτερα ἄλλα τοῦτων·
- οὐ γὰρ ἔστιν, ἀλλὰ δῆλον ὅτι ἄλλ' ἄττα ζητητέα πλὴν ὀνομάτων, ἃ ἡμῖν ἐμφανιεῖ ἄνευ ὀνομάτων ὁπότερα τοῦτων ἐστὶ τὰ ἀληθῆ, δείξαντα δῆλον ὅτι τὴν ἀλήθειαν τῶν ὄντων.



But if this is a battle of names,
some of them asserting that they are like the
truth, others contending that *they* are,
how or by what criterion are we to decide
between them?

For there are no other names to which appeal
can be made, but obviously recourse must be
had to another standard which, without
employing names, will make clear which of the
two are right ; and this must be a standard
which shows the truth of things.

- Plato, *Cratylus*



Years of debate,
but centring on two issues ...

- Who determines whether a term has GI status?

... and ...

- Once it *is* protected, what scope of protection does a GI enjoy?



• Who determines whether a term has GI status?

- The laws of the country of origin?
- The facts in the country of origin?
- The past linguistic or trade usage in the country where protection is sought?
- Other options?



- Once it *is* protected, what scope of protection does a GI enjoy?
 - Against all usage on a product label?
 - Evocative and descriptive use?
 - Use that misleads the consumer
 - In general?
 - Or about where the product came from?



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comes from Champagne

Unmask the truth at
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CHARMAT METHOD SPARKLING WINE SECONDARY FERMENTATION PRIOR TO BOTTLING



World Trade Organization: Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS Agreement, 1995)

PART II STANDARDS CONCERNING THE AVAILABILITY, SCOPE AND USE OF INTELLECTUAL PROPERTY RIGHTS

1. Copyright and Related Rights
2. Trademarks
3. Geographical Indications
4. Industrial Designs
5. Patents
6. Layout Designs (Topographies) of Integrated Circuits
7. Protection of Undisclosed Information
8. Control of Anti-Competitive Practices in Contractual Licences

PART III ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS

1. General Obligations
2. Civil and Administrative Procedures and Remedies
3. Provisional Measures
4. Special Requirements Related to Border Measures
5. Criminal Procedures

PART IV ACQUISITION AND MAINTENANCE OF INTELLECTUAL PROPERTY RIGHTS AND RELATED INTER-PARTES PROCEDURES

PART V DISPUTE PREVENTION AND SETTLEMENT

PART VI TRANSITIONAL ARRANGEMENTS

PART VII INSTITUTIONAL ARRANGEMENTS; FINAL PROVISIONS

First multilateral standards
on GI protection
(but building on the existing
WIPO legal foundations
– Paris Convention)





● **Definition (TRIPS 22.1):**

GIs 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.**



● **Scope of protection** (*TRIPS 22.2*):

legal means ... to prevent:

(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 Paris 10bis**.


But for wines and spirits...

- ... legal means ... to prevent use of a GI: identifying wines for wines not originating in the place indicated by the geographical indication in question [same for spirits]
- even where the true origin of the goods is indicated or
- the GI is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like

(Article 23.1 of TRIPS)



Goods in general

- 
- General definition of protectable GI
 - Protection against misleading suggestion that product comes from region indicated;
 - other unfair competition
 - Trademarks refused or invalidated including GI if public misled on origin
 - Exceptions for past use, generic use, prior TM

Wine and spirits


- Same definition of protectable GI
- Protection against use of the GI without a test for consumer deception;
- Protection against translation and descriptive uses
- Trademarks refused or invalidated if include GI and product not from region indicated
- Optional exception for grape varieties



‘Legal means’ ... ?

- TRIPS requires the availability of ‘legal means’ for GI protection
- The types of legal means WTO Members have notified reflect the wide range of interests engaged:
 - Sui generis registration system for GIs
 - Direct government regulations to protect GIs
 - trade practices/consumer protection/unfair competition legislation
 - trade mark legislation (protection against registration of recognised GIs as trade marks, registration of GIs as certification/collective marks)
 - industry-specific regulatory systems (e.g. wine industry)
 - food labelling and standards regulations
 - non-legislative common law remedies such as ‘passing off’

current TRIPS processes

- 
- Article 24.2 - TRIPS Council ‘review of the application’ of GI provisions, including
 - any matter affecting compliance
 - agreed action to facilitate operation/further objectives of GI provisions
 - Article 23.4 - TRIPS Council negotiations on a multilateral register for wines
 - somewhat ambiguously extended by 1996 Singapore Ministerial to spirits
 - Article 24.1 - Members agree to negotiate ‘aimed at increasing the protection of individual GIs under Article 23’
 - exceptions to GI protection no bar to negotiations, or bilateral or multilateral agreements
 - Members should be willing to consider continued application of exceptions to individual GIs under negotiation



And at present...

- TRIPS Special Session negotiations on a **multilateral register** for wine and spirit GIs
 - Under the existing TRIPS 23.4 mandate, reaffirmed by Doha and Hong Kong ministerials
- **‘GI extension’** as an ‘implementation issue’ ensuing from Doha
 - No agreement on mandate to renegotiate TRIPS Article 23, but high level consultations continue
- Many countries seek progress on both GI issues (and TRIPS CBD) as part of Doha Round
 - No consensus for the present ...



July 2008:

Modalities Proposal TN/C/W/52

● **GI Register:**

- mandatory participation
- legal effect (consult and take into account, prima facie evidence for definition, genericism only if substantiated)

● **GI Extension:**

- extend Art. 23 level protection to GIs for all products
- extension of Register

● **TRIPS/CBD:**

- disclosure requirement for country of origin/source
- extent of reference to PIC and ABS to be determined

Supported by over 100 Members (including EC, Switzerland, India, China, Brazil, ACP, African Group)


Opposed by others on substance and on process (no linkages)

WTO Dispute Settlement:



- US (DS174) and Australia (DS290) pursue complaint against **EU Regulation on GIs** (foodstuffs)
- Panel Reports circulated in 2005 (WT/DS174/R and WT/DS290/R). No Appeal.
- Result: EU's treatment of relationship between GIs and TMs is not in violation of TRIPS, but the system discriminates against non-EU GIs and thus violates the national treatment obligation under TRIPS
- Clarifies that GI protection may be a legitimate exception under trademark law
- EC Regulation 2081/92 replaced by EC regulation 510/2006

Implementation

- 
- Since 1995, a major overhaul of GI and trademark legislation in the wake of TRIPS
 - Even under existing rules, many avenues for protection of GIs in over 130 jurisdictions, relatively uncontroversial for GIs without generic or descriptive use or trademark significance
 - Developing countries active in their use of the system, exploring all options under TRIPS
 - Indian – many traditional products protected
 - Ethiopia – protection of traditional coffee origins