

# Recent Developments at the International Level

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Before TRIPS, trademark systems protected GIs

- ✓ as regional certification and collective marks complete with standards, including specified areas of production within the named geographic area, that informed the quality, characteristics or reputation of the product
- ✓ respecting the intellectual property tenet of first-in-time, first-in-right
- ✓ preserving common names
- ✓ providing for an objection process
- ✓ ensuring transparency for all interested parties

# TRIPS changed things

Even though the trademark system was a means of protection for GIs, WTO members now could introduce a new system where -

- ✓ limitations on prior trademark rights could be imposed
- ✓ refusals were no longer mandated based on the geographic term being the common name of the goods in the member where protection was sought
- ✓ no third party objection procedure (or ex officio examination) was required
- ✓ transparency took a back seat to bilateral trade deals

# Where do GIs belong? WIPO or WTO?

- GIs are included as subject matter in WIPO's Standing Committee on Trademarks, Industrial Designs and Geographical Indications (SCT).
- But any attempts to discuss GIs in the SCT (and work at WIPO more broadly) were countered with the argument that these discussions were to be held at the WTO.
- But then why was WIPO's Lisbon Union – with a mandate restricted to Appellations of Origin (a subset of GIs) – allowed to dictate the terms of the international agreement for GIs?

# The Geneva Act in WIPO

- The Lisbon Union began through working group discussions to make technical amendments to the Lisbon Agreement on Appellations of Origin.
- The end result, however, was an expansion of the subject matter of the treaty to include GIs. (Weren't GIs to be discussed at the WTO only?)
- Objections to the impropriety of this expansion were ignored and, in May 2015, the Geneva Act – agreed to by only 28 members of WIPO (out of 189) – attempted to dictate the future of GIs.

# Problems with the Geneva Act – Creation of the SUPER IP right

- GI requires no renewal documentation, local use, or renewal fee to exist in perpetuity.
- Unless refused protection, each member must protect registered AOs and GIs.
- Once protected, a country cannot allow the GI (unlike a trademark) to become generic
- GIs may co-exist with prior trademarks

# Assurances?

- We are told not to worry because each member of the Geneva Act will apply their national law to determine whether a GI protected in its country of origin is also to be protected in the member.
- But are members able to apply their national laws? By examining, allowing for objections, requiring disclaimer of common names....
- Or will members just accept the terms on the list without due process and transparency?

# Protection for Lists of GIs has become a trade demand

- The EU has been conducting bilateral negotiations that include exchanging list of GIs.
- A main concern is that the ability to provide due process for the applicant and interested third parties is compromised when governments negotiate GI protection on behalf of their nationals.
- Such bargaining over GIs can also result in decisions that prejudice the validity of previously-registered trademarks, raising concern over consistency with international obligations as to trademarks.



# Problems for Two Sets of Stakeholders

## US GI Owners

- Can't get US certification marks recognized in other countries with GI or appellation of origin systems because they are not protected "as such".
- They have a need for an international filing system that does not require government substantiation of the GI or a special form of protection.

## Generic Term Users

- Aren't provided with an opportunity or grounds to object in foreign markets to protection of GIs that conflict with generic terms already in use in that market.
- They have a need for a mechanism at the national level that allows them to bring evidence of prior generic use to the attention of relevant officials.

# Way forward

- To assist these stakeholder groups, the US is seeking to advance important principles to be adhered to at the national level.
- The US advocates for any protection of GIs to require GI applications or requests for protection via international agreements to be subject to:
  - Examination for pre-existing trademarks and common names
  - Publication
  - Pre-registration opposition
  - Post-registration invalidation
- Also, protection should not be contingent on the type of protection available in the GI producers' home country.
- The US looks forward to expert discussions in the SCT to address these issues.

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