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INDUSTRIAL DESIGN AND
GEOGRAPHICAL INDICATIONS**

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GEOGRAPHICAL INDICATIONS

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I. INTRODUCTION

1. At its ninth session (Geneva, November 11 - 15, 2002), the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) took the following decision:

2. “The SCT decided to request the International Bureau to prepare a study setting out the issues generally considered with regard to the protection of geographical indications, taking into account the elements contained in the definition of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement), in particular, the elements supporting a claim for quality, reputation or other characteristics, and what is considered in evaluating a claim that these elements are “essentially attributable” to the geographical origin. The list of factors would be illustrative and not exhaustive and the purpose of the study itself would be to provide members with a general overview of issues considered by different systems of protection. In no case should this exercise be used to appreciate whether a particular system is in conformity with the TRIPS Agreement, nor would it provide a vehicle for examining whether a given geographical indication complies with the definition of Article 22.1 of the TRIPS Agreement. The study would only constitute a basis for discussion, and it would promote a better understanding of the definition in a more concrete way and provide information, especially for those members in the process of establishing their own systems. As such, it would not be an attempt to harmonize law on geographical indications, and it would not be an exercise in norm-setting or lead to a negotiation. It would simply constitute the basis for an exchange of information in a general manner without analyzing specific cases¹”.

3. This document is intended to serve as a basis for the examination by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) of “the elements supporting a claim for quality, reputation or other characteristics, and what is considered in evaluating a claim that these elements are “essentially attributable” to the geographical origin.”

II. ELEMENTS ON WHICH THE DEFINITION OF GEOGRAPHICAL INDICATIONS IS BASED

4. Article 22.1 of the TRIPS Agreement defines “geographical indications” as “*indications which identify a good as originating in the territory of a [WTO] 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.*”

5. The determination of the field of application of the definition of geographical indications, as it appears in Article 22.1 of the TRIPS Agreement, was analyzed in document SCT/9/4², based on the documents summarizing the responses to the questionnaire reproduced by the World Trade Organization (WTO)³. The variety of the systems of protection for geographical indications, the diversity of the terminology used in the legislative instruments

¹ Summary given by the Chair, document SCT9/8, paragraph 4.

² SCT/9/4, paragraphs 5 to 26

³ WTO document IP/C/W253, dated April 4, 2001

and the lack of sufficient information on the regulations and national administrative procedures make the preparation of an overall analysis of the different elements on which the definition of geographical indications and their consideration are based delicate.

6. Before considering the different elements contained in the definition of geographical indications and their assessment in the different protection systems, it is necessary to raise the following fundamental issues, insofar as they are assessed in different ways at the international level. e

Alternative or cumulative elements?

7. Should the definition of the TRIPS Agreement be interpreted as a cumulative list of factors to be taken into consideration and which constitute predefined conditions for reaching a conclusion, or as an -exhaustive list of factors representing alternative conditions, of which only one can constitute the essential factor justifying the link with the geographical origin in question? The answer to this question can, it appears, be assessed with a view to the definition of the products which may be protected as appellations of origin under the Lisbon Agreement. The TRIPS Agreement introduces an alternative (“a given quality, reputation or other characteristic”), whereas the definition of the appellation of origin under the Lisbon Agreement makes express reference to a combination of natural and human factors representing the quality and the distinguishing characteristics of the product.

8. In the same way as the list of factors contained in the WIPO Joint Recommendation on the Protection of Well Known Marks and in the Joint Recommendation on the Protection of Marks on the Internet, may it be considered for example that the *competent authority takes into consideration all of the relevant factors*, included in the definition in Article 22.1 for the purposes of determining whether a product may benefit from protection as a geographical indication? Or may one understand the elements listed in the definition in the same way as the factors contained in the above -mentioned Recommendations and may it be stated that the *guidelines to assist the competent authority to determine whether [a product may benefit from protection as a geographical indication] are not pre-conditions for reaching a determination. Rather the determination in each case will depend upon the particular circumstances of that case. In certain cases, all of the factors may be relevant. In other cases, some of the factors may be relevant* .

9. By contrast, it appears difficult to go as far as to say that “ *in [...]* other cases, none of the listed factors may be relevant and the decision may be based on additional factors that are not listed in [the definition]. Such additional factors may be relevant, alone, or in combination with one or more of the factors listed in [the definition].”

A quality or qualities?

10. In the same way as the taste itself, the criterion of quality conveys an eminently subjective dimension, left to the appreciation of each individual. In fact, the determination of the quality of a specific product cannot be undertaken in overall terms at the global level according to harmonized and exhaustive criteria which would take account of the cultural diversity of the international community. This appreciation therefore appears to stem from a factual approach and from the prerogative of the competent national authorities, based on the

criteria which are specific and individual to them. In this regard, the WTO study⁴ indicates that the reference to “quality” is formulated in a different manner, sometimes in the plural, in the various definitions appearing in different national legislations. For example, “established quality,” “particular quality,” “given quality,” “specific quality,” “special quality characteristics,” “special outstanding quality distinguishing the product from generic products,” “superior quality/quality of the highest grade as determined in accordance with standards specified in the law for the product concerned or, as determined through customary use in the respective industry. Thus, the term “quality” appears less to imply a certain quality of the product – qualitative criterion – than a characteristic – legal criterion – allowing a product to be distinguished as a result of its geographical origin.

11. If the qualitative link is not sufficient, can it therefore be concluded that there is no geographical indication? Generally speaking, this approach prevails in relation to appellations of origin; i.e., if the characteristic qualities are not essentially, but only to a slight extent, due to the geographical environment, protection cannot therefore be granted in the form of an appellation of origin. However, can the same approach be applied to geographical indications?

12. The qualitative link between a product and its geographical origin will be all the more difficult to evaluate since it will involve, for identification purposes, other subjective factors such as the quality of the ingredients used or the manufacturing process. Thus, the fact that a product is produced by a traditional method or that its production, preparation and processing has occurred in a particular geographical area can contribute to its “quality,” but these factors may, in another specific case, not be decisive for another product.

13. Finally, the requirement for a qualitative link between the geographical environment and the product as part of a cumulative interpretation of the elements of the definition would lead to a disadvantage for the countries whose geographical indications apply not to agricultural or crafts products but to industrial products. This link, which may have existed at the beginning of the manufacturing of an industrial product, may subsequently be broken to the extent that its existence is henceforth difficult to prove. Moreover, manufacturing traditions and human skills can be transferred from one geographical area to another, taking into account in particular increasing professional mobility and economic globalization.

Reputation or notoriety?

14. As regards the “reputation,” the countries which have adopted the Lisbon model do not generally refer to it in their national legislation as an element linked to the geographical origin of the product, whereas the countries that base themselves on the TRIPS model do so systematically. In fact, the Lisbon model does not mention reputation as an element linking the product to the place. It appears rather that the reputation of the geographical location is based on the quality and characteristics of the product for which it is best known. As regards the countries whose legislation follows the TRIPS model, the study shows that several of them have adopted various forms of qualification standards such as “general reputation,” “given reputation,” “specific reputation,” etc.⁵

⁴ idem: paragraphs 40 – 41.

⁵ idem paragraph 42

Which other characteristics?

15. Little information has been received from the governments which responded to the WTO questionnaire concerning what is covered by the expression "other characteristic" included in Article 22.1 of the TRIPS Agreement⁶. It may, however, be envisaged that the other characteristics of the geographical environment can be understood to include natural factors such as soil and climate, and human factors such as the particular professional traditions of the producer established in a given geographical area.

16. In the absence of international consensus on the points listed above, unilateral responses cannot be provided in this document as to the interpretation to be given to the definition contained in Article 22.1 of the TRIPS Agreement. It is more appropriate to highlight the different elements which are evaluated by the competent authority responsible for determining whether a product can be protected as a geographical indication, by focussing on the very purpose of the definition, i.e. demonstrating that a product originating from a certain locality possesses specific features due to this origin and which help to distinguish it from the others.

II. ELEMENTS OF THE DEFINITION TO BE TAKEN INTO ACCOUNT

17. The different elements of the definition of geographical indications, set forth in Article 22.1, are taken into account in different ways depending on the countries and systems. Certain protection systems require it to be demonstrated that the product for which protection as a geographical indication is claimed actually covers the required characteristics, within very precise specifications including the different elements of the definition and requiring very specific forms of proof. The factors used to support the case can often be taken up to determine several elements of the definition. Other systems emphasize to a much greater extent geographical criteria (area, delimitation) without necessarily implying some kind of quality criterion linked to the factors present or used in the particular geographical zones. Depending on the system of protection for geographical indications in force, the verification of elements will be more or less thorough and will be made on the different elements, or on only one of them, and will be based on documentation (specifications for example) which will be more or less precise and detailed. Whatever the case may be, the justification for the criteria provided in order to determine whether the protection should be granted will be assessed on a case-by-case basis, in the same manner for geographical indications than it is for the examination of trademark applications. Thus, verification can be carried out either by the body responsible for geographical indications or the product certification body.

Originating in the territory, a region or a locality in that territory

18. The description of the geographical area chosen for the request for protection as a geographical indication should generally be made in the most possibly precise terms. The delimitation of the geographical area can be made in many different ways, according to the existing political, administrative etc. divisions. In this regard, complete correspondence does not necessarily exist between the area of the geographical indication and the administrative zone whose name it bears. In each case, it should be demonstrated that the geographical area concerned is situated in a region, sub-region, zone, district and so on, the borders of the

⁶ idem paragraph 43

claimed zones should be specified and precise maps of the zone provided. Where the geographical location of a product depends on the nature of the soil and the climate, a pedoclimatic map will sometimes be required. The delimitation of the claimed zone will also be justified in close connection with the specific nature of the product, if productions also exist outside the proposed zone. Finally, it is also possible to list the different operations (origin of the raw material, different stages of production, packaging and so on) located in the zone.

Quality

19. The quality of a product may be established on the basis of a precise description of the product or on the method for obtaining it. Depending on the protection systems, this description should be precise, or more or less complete, so that the application is acceptable. The main emphasis will often be placed on the organoleptic aspects of the product. Under certain systems, without a precise definition of the organoleptic characteristics of the product, with recognized descriptors, the search to define the product's specific nature is illusory.

20. The description of the product may/should include the raw material, the main physical (Q2 value⁷, pH, shape, weight, appearance, consistency), chemical (presence/absence of additives, residues and so on), microbiological (use of such products such as ferments, presence of germs) and/or organoleptic (smell, taste, texture, color, visual and sensory... profile) characteristics of the product. The actual presentation of the product (fresh, frozen, preserved) may also be the subject of a description.

21. Where they are recognized, the methods for manufacturing and obtaining the product should/may also be the subject of a precise description. This description must help to identify the product's personality. Thus, the description of the methods for obtaining the product should/may contain the description of the techniques implemented as well as the quality criteria of the final product, by demonstrating the particular features linked to the product. The descriptions should relate to all the stages concerned with the location of a case including, where necessary, the packaging. For animal breeds, the following will therefore be mentioned: the breed, breeding practices (feeding, grazing, suckling), age of slaughter, maturation, classification of carcasses, pH, and so on. For plant productions, the varieties, dates of seeding and harvesting, harvesting periods, harvesting method, storage, dispatch, firmness, sugar level, etc. will be mentioned. Finally, for manufactured products, the description of the raw materials (type of product, part of the selected product, etc.), the description of the manufacturing process (preparation, drying, salting, etc.) may be noted.

22. In the description of what contributes to the quality of the product, it is important to highlight why the location gives rise to a different quality and to explain the influence of the location of the product on these specific characteristics.

Reputation

23. Reputation is closely linked to the history and historical origin of the product. Consequently, the history of the product should be described in order to demonstrate its historical existence in the geographical area and thereby its reputation. The production of a

⁷The Q2 value is the ratio of the water content to the total protein content.

file, containing the key elements of the history of the product, will provide proof of the use of the name and reputation of the product. The first uses of the name, accompanied as far as possible by the first descriptions of the product, and its conversion method will therefore serve as particularly useful initial information to be entered in the file. As for the description of the product, the file should be detailed. In this regard, bibliographical reference, including literary quotations and references which bind the product to the place and historical terms, especially in its human skills dimensions should be used as basis. In the absence of written references, it is possible to cite oral testimony. The proof of the origin of the product will sometimes be grouped around the concept of traceability of the product (ascending and descending, i.e. from production to marketing).

24. Reputation is also based on the distinctive character of the product, i.e. its capacity to distinguish itself from other products. The stronger a product's identity, the more it will be able to display its established reputation, which should prove that the product is recognized as distinct in a family of products and that it therefore has specific features. This is because its features have enabled it, from a particular point in time and up to the present, to bear a geographical name in its sales designation and to acquire an identity which has been transformed into an established reputation. The analysis of the link between the reputation and the product will therefore be assessed on a case-by-case basis, especially since it will entail subjective criteria.

25. Reputation is based, *inter alia*, on the consumer's perception of the geographical indication, i.e. on the consumer's ability to distinguish the protected product as a geographical indication in relation to the other products of the same type or a different type. In certain systems, emphasis is placed on the economic value of the reputation, insofar as the reputation is based largely on the investments which have been necessary on the part of the producer to obtain it. The corollary of these investments will consist, as for any intellectual property right, of the need to provide appropriate and sufficient protection. Thus, the consumer will be prepared to pay more for a protected product as a geographical indication, insofar as the product enjoys a certain reputation.

26. The assessment of the reputation differs according to the systems and the products, and can be made on a local, national or international basis. A local reputation should therefore be sufficient for protection to be granted. The reasoning used under this heading – often the most detailed and most voluminous in the application for protection as a geographical indication – can thus be based on the history of the actual product, and the former and current reputation.

Other characteristics

27. The link between the product and its geographical origin can also be established in terms "of characteristics other" than quality and reputation. Among the most frequently used are, *inter alia*, human and natural factors (*terroir*), which are used either in isolation under this heading, or repeated from the previous headings. These factors are more commonly used in the systems protecting registered geographical indications and appellations of origin.

28. In these systems, the region demonstrates the interaction between the physical (natural) and human factors built up over time. The link to the “*terroir*” will therefore be manifold and will vary according to the products. Consequently, the basis of the relationship between the region and the typical characteristics of the product, at the different stages of manufacturing, conversion and production, should be accurately described. The typical characteristics of the product linked to the region include any objective or subjective characteristic which discriminates the product within its reference family, and refers both to the characteristics of the final product, the practices linked to the manufacturing of the raw materials, the conversion and production of the product, and the social and cultural representation which the producers and consumers of the product have. The analysis of these factors should define, in objective terms, the different components of the products such as the color, shape, texture, composition and so on. For manufactured products, this definition is made firstly on the raw agricultural material and, secondly, on the product resulting from manufacturing. The means used to define these characteristics may be bibliographical, through the interrogation of the producers themselves, or through physical, chemical and sensory analysis work (testing panels).

29. As an example of components of the typical characteristics of a product, as regards the raw material, reference can be made to the pedoclimatic unit of the production zone, the particular species or breed, the feeding method, the method of use of the grasslands, the nature and origin of the food supplements, prohibited foodstuffs, method of storage and collection, as well as the specific composition of the raw material. For manufacturing purposes, the storage, duration of conversion, specific equipment, skills, ingredients (origin, type of cultivation), additives, shapes and sizes, etc., will be assessed. Finally, for production purposes, the conditions and length of the maturing process, drying and manufacture, and maturation, sensory profile of the product, as well as its texture etc., will be taken into account.

30. It is often important to demonstrate that the components of the typical features have been constituted by faithful and continuous local methods and have been proven through use, i.e. collective, or potentially collective use of the name relating to a given product with specific characteristics recognized by manufacturers, processors, producers and consumers.

The link with the geographical origin

31. The link with the geographical origin demonstrates the correlation between the place and one or more elements of the definition, emphasizing the fact that such a factor produces such a characteristic or rather, *by contrast*, that other factors yield other characteristics. In this regard, the criteria and/or the elements of the definition and the proofs supporting these elements should be distinguished.

32. Identifying element(s) which can be used to justify the link between the product in question in a precisely delimited geographical area will therefore represent a key part of a given individual case. It is important for the justification of the elements of the definition to be made in the most objective manner possible with a view to giving the link a precise and specific form, since this constitutes the basis for the protection of a geographical indication. The grant of an exclusive right to a denomination is made only insofar as this right is justified by objective elements and forms of proof. These elements and proof help to make the subject matter for which protection is sought and the reason for such protection understandable, while

using, for example, specifications containing these elements in methodological and concrete terms.

33. As regards proof, a flexible approach is imposed, and the link can generally be proven by any useful means. In most cases, it is the responsibility of the producer to provide the justification for the link. It is important to have the link clearly defined so as to verify whether the factors determining such a link are always present. In addition, this verification provides a guarantee for the consumer that the product in question is a geographical indication, thereby ensuring the presence and continuity of the link in the product placed in the market.

34. The traceability of the product forms part of this demonstration. Traceability means the system used to monitor the product from the production to the marketing stage. The “specifications” defining a zone and proof of the geographical origin of the product should be provided.

35. The link between the geographical location and quality does not form part of all protection systems. Certain systems require, for example, the zones concerned to differ in geological terms from the surrounding areas but do not require a particular distinction to affect the product produced therein. Similarly, the provisions concerning certification marks, which require that marks should certify the origin or quality, do not necessarily require both. A mark holder can give a quality criterion to the mark’s certification of origin, in particular for marketing purposes relating to consumers, but there is no obligation to do so. Nor is it necessary to establish a link between the place and the manufacturing method, since the quality of the final product prevails over the manner in which it is produced. The link with the geographical origin will constitute the essential point on which an application for registration of a product as a geographical indication will be based.

36. The link should be made between the product, its specific and particular features on the one hand, and the geographical name applied for on the other. It will therefore be necessary to explain how the quality, reputation or other characteristics are linked to the geographical area and thus to determine the delimitation criteria and the specifications of the product resulting therefrom.

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