No G in the GI? Testing for genericide

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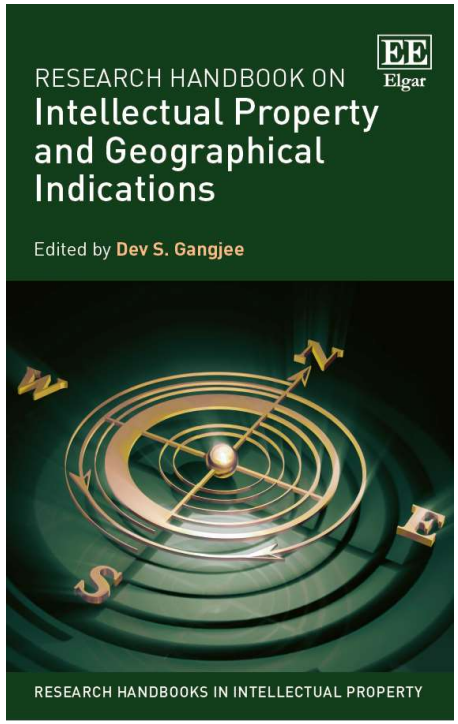
Outline

1. TRIPS – unhelpfully abstract
2. FTAs and Bilaterals: filling the gaps
3. Review of factors in legislation and tribunal decisions
   - Structural issues
   - Factors (categories of evidence)



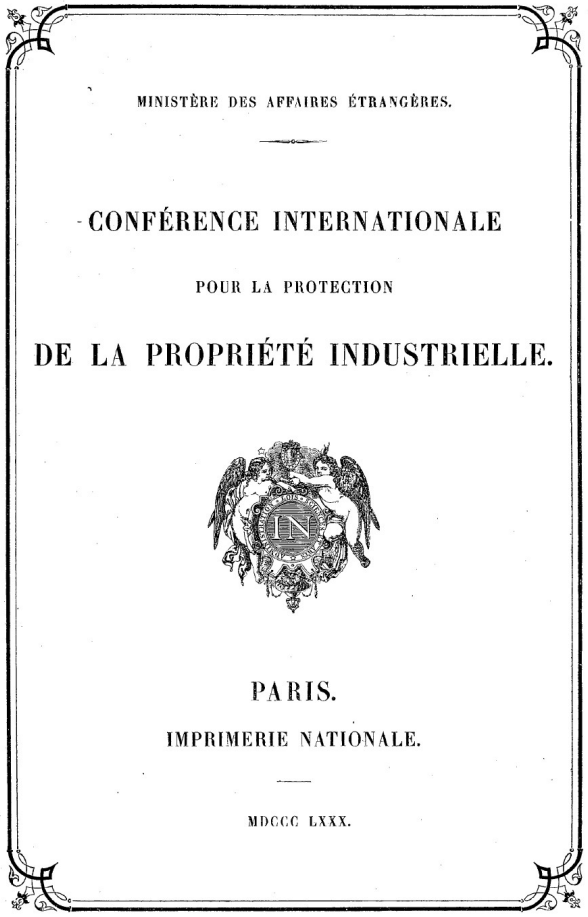
Ch 18: Genericide: The Death of a Geographical Indication?

1. A dispute of reputable vintage…

- *Actes de la Conference Internationale pour la Protection de la Propriete Industrielle* (1880) 85

M. Lagerheim (Suède) dit que, dans sa pensée, l'article 6 comporte pour les États une obligation trop grande, et que sa portée réelle n'est pas suffisamment indiquée. On pourrait, tout en réservant la législation intérieure, s'engager à prohiber. Il considère la question relative à l'indication de provenance comme très délicate. Il rappelle qu'il y a eu, à cet égard, entre l'Angleterre et la Suède, une contestation assez grave, au sujet de l'introduction de fers portant la marque *Lancashire*.

Ceci n'était cependant point une fausse indication de provenance, mais uniquement la dénomination d'une méthode spéciale de fabrication. La contestation fut résolue en ce sens que l'Angleterre admit l'entrée des fers en question, à la condition qu'il fût ajouté *Sweden* après le mot *Lancashire*.



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1a. But Art 24.6 TRIPS too abstract

- [Members are not required to protect GIs of other Members where] the relevant indication is identical with the term customary in common language as the common name for such goods or services in the territory of that Member.
- Similar rule where wine GI is 'identical with the customary name of a grape variety existing in the territory of that Member'.

- *But when is a term 'customary in the common language'?*

E.g. cheddar ➔ type of cheese

2. FTAs and Bilaterals: Filling the gaps

2. TTIP: EU's proposed text in 2016

Transatlantic Trade and Investment Partnership (*stalled but…?*)

7. General rules

- criteria for establishing genericness, based on the principle of territoriality [existing situation in areas of consumption and relevant legal acts]
- prohibition of subsequent genericness in the non-originating country [Freezing of meaning]

Reflects equivalent provisions in EU Regulation 1151/2012 (Arts 41, 13)

2a. USMCA (new NAFTA) of 30 Nov 2018

Art 20.31 **Grounds of Denial, Opposition, and Cancellation**

1(c) [The GI of one country is] a term customary in common language as the common name for the relevant good in the territory of the Party

Parts of GIs can be generic

- Exclusive claims to generic designations within compound GIs can be disclaimed, as a means of overcoming an objection
- A term customary in common language as the common name may refer to a single-component term or individual components of a multi-component term.

2b. USMCA cont.

Art 20.32 **Guidelines for determining when a term is customary in CL**

- Assessing authority has 'to take into account **how consumers understand** the term in the territory of that Party.'
- Is the term used to refer to the type of good in question?
  - As indicated by competent sources such as dictionaries, newspapers, and relevant websites
- How the product is marketed and used in trade?
- Is term used in relevant international standards to refer to a type of product (e.g. Codex Alimentarius)?
- Is the good imported into the territory in significant quantities and the imports use the term generically?

3. Review of factors in legislation and tribunal decisions

3a. Structural Issues

i. Which regime? Sui generis GI or trade mark system?

- EU: 'only when there is in the relevant territory no significant part of the public concerned that still considers the indication as a [GI]'. (*Feta, Parmesan, Bavaria*)
- US: 'Primary significance' of the term to consumers ➔ genus (*Darjeeling; Tequila* (TTAB 2017))

ii. Which factors favoured?

- Region of consumption (how local producers use it)?
- Or extent to which foreign importers use term generically?
- Does status in the Codex Alimentarius reflect consumer understanding?

iii. Burden of Proof?

- Empirically very demanding;
- e.g. at the time of application, if the assessing authority alleges generic status, who has to then prove this either way? (*Bavarian Blockmalz*)

3b. Factors: Consumer understanding

- Customary in the common language ➔ consumers of the product category in question
- Widely consumed products (e.g. cheese) = general public (*Feta*)
- 'Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications.' (*Tequila*)
- Textual sources: lower case or upper case (Champagne or champagne)
- Degree of consumer attention or sophistication?
- Probative value of surveys (impartial and objective design)? (*Darjeeling*)
- Split in understanding: some generic; some geographically specific?

3c. Other factors

- Trade Opinion:
  - Bias in either direction (*Halloumi*)
  - May diverge from consumer opinion (so does trade perception shape consumer perception?)
- Expert opinion
  - Linguistic experts; food critics; sommeliers – testify as to retail perceptions (WIPO Model Law for DCs)
- Market Conditions
  - Quantity sold under generic label on the market as a ratio to GI use, or as an absolute quantity (*Halloumi*)
  - Method of distribution and extent to which intermediaries play a role
  - Extent of home country protection and respecting the specification
  - Labelling of products and publicity material (*Feta, Parmesan*)

3d. Cont.

- Status in legislation or official classification
  - Marketing rules; customs legislation (but how helpful in measuring consumer perception?)
  - E.g. US FDA or FTC rules referred to in disputes on whether a term is misleading or generic (*Roquefort, Chablis*)
  - Parmesan gambit at the Codex Alimentarius Commission (2005)
- Action (or inaction) of rights holders
  - Have rights holder been vigilant? Or acquiesced? (*Camembert; Sherry; Darjeeling*)
  - Or helpless in the face of misuse abroad? No remedy available? (*Feta*)

A ‘final’ word on a never ending saga… Brexit

- If the UK leaves with a deal ➔ EU GIs are protected in the UK
- No deal ➔ EU GIs may need to re-register in the UK
  - Be opposed on the basis of being generic
- Since the UK is considering FTAs with the US, Aus, NZ
- US-style generic use may be coming to the UK via FTAs(!!!)

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Follow

Britain is right to hold firm on EU GIs. Why should we ban e.g. feta cheese from the USA, which tastes at least as good as EU feta & was introduced into the US by Greek-Americans & with same cultural heritage. #FreeTradeUK