

WIPO Worldwide GI Symposium 2019

Geographical Indications in the WTO

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The TRIPS Regime on GIs



- Definition (Article 22.1)
- Basic level of protection (Article 22.2-4)
- Additional protection for wines and spirits (Article 23)
- Exceptions (Article 24.3-9)
- Negotiations (Article 24.1)
- National and MFN treatment (Articles 3-5)
- Procedures of acquisition & maintenance of rights if registration is foreseen (Article 62)
- Enforcement (Part III)
- Transition periods
- Dispute settlement

Dispute Settlement Case DS174/290

EC – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs



Complaints:

- by the US (WT/DS174/20) and Australia (WT/DS290/18)
- against the EU Regulation 2081/92 on GIs (foodstuffs)
- Panel Report adopted 20 April 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 (limited co-existence of TMs and GIs),
 - but the system discriminates against non-EU GI applicants and thus violates the national treatment obligation under TRIPS
- EC amended its Regulation 2081/92. New Regulation 510/2006 entered into force in March 2006.

The TRIPS GI regime



- accommodates different manners of implementation (trademark system / *sui generis* system / unfair competition)
- does not require registration as a constitutive element
- accommodates both
 - limited coexistence between earlier TMs and GIs (e.g. EU)
 - strict first-in-time first-in-right approach (e.g. US)
- covered by the WTO Dispute Settlement System

The 1995 compromise in TRIPS: Negotiation Mandates



Negotiations:

- Multilateral Register for wine and spirit GIs (Art. 23.4)
- Not deny negotiations to increase protection of individual GIs (Art. 24.1)

Negotiating Mandate: Article 23.4



*“In order **to facilitate** the protection of geographical indications for wines, negotiations shall be undertaken in the Council for TRIPS concerning the establishment of a **multilateral system** of notification and registration of geographical indications for wines **eligible** for protection in those Members **participating in the system.**”*

Members disagree regarding the **legal effect** and **participation** in a GI Register

GI Register Negotiations: The proposals on the table since 2008



- TN/IP/W/10/Rev.4 by the Joint Proposal Group (Argentina, Australia, Canada, Chile, Costa Rica, Dominican Republic, Ecuador, El Salvador, Guatemala, Honduras, Israel, Japan, Korea, Mexico, New Zealand, Nicaragua, Paraguay, **South Africa**, Chinese Taipei and the United States) (April 2011) (*Voluntary participation, commitment to consult the register, legal effects only under national law*)
- TN/IP/W/8 by Hong Kong, China (April 2003) (*Voluntary participation, certain rebuttable legal presumptions*)
- TN/C/W/52 (para. 1-3 and 9) by the “Modalities Group” (Albania, Brazil, China, Colombia, Croatia, the European Communities, Georgia, Iceland, India, Indonesia, the Kyrgyz Republic, Liechtenstein, Moldova, the Former Yugoslav Republic of Macedonia, Pakistan, Peru, Sri Lanka, Switzerland, Thailand, Turkey, **the ACP Group and the African Group**) (July 2008) (*Mandatory participation, register information is prima facie evidence for meeting the GI definition, assertions of genericism have to be substantiated*)

2011 progress – a single text



- Development of single negotiating text in consultations of a drafting group since January 2011
- *Easter Package* - Chair's report in TN/IP/21:
 - Summarizes work done
 - Publishes draft composite text (JOB/IP/3/Rev.1)

TRIPS Council Special Session: Interventions by Members



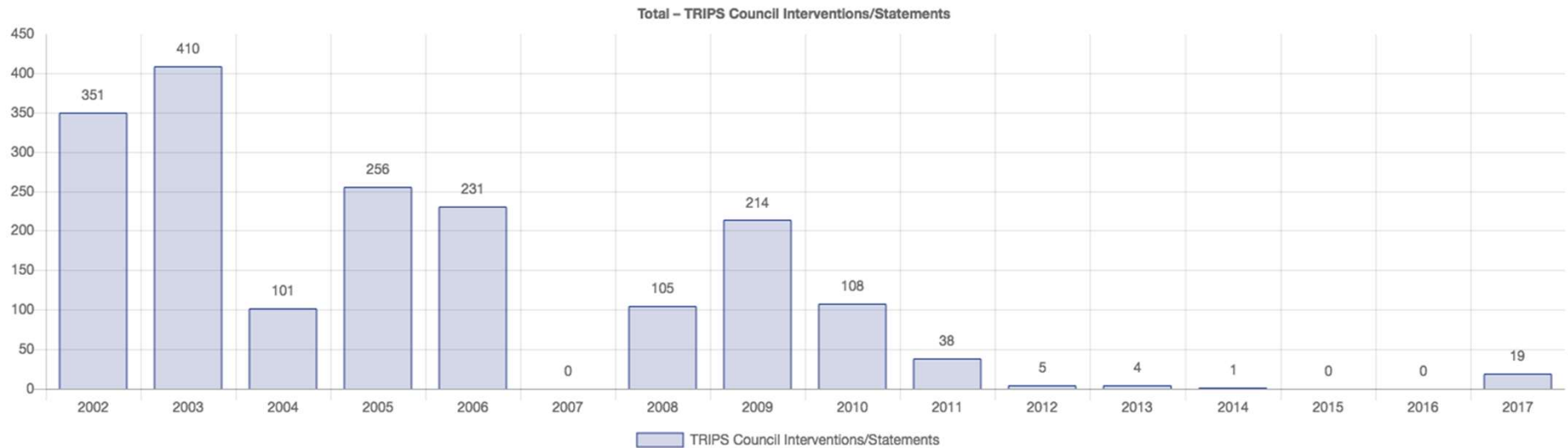
TRIPS Council (Special Session) Minutes – Graphs and Charts

This page allows you to consult graphs and charts in relation with the TRIPS Council (Special Session) Minutes. In particular, graphs and charts showing the total number of interventions/statements are available. You can filter the information by: (i) Statement/intervention date; and (ii) Member.

2002 - 2017

Member, observer, or international organization

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GI Extension: the proposal

= Extension of the higher protection of GIs for wines and spirits to GIs for other products

- What do proponents (GI Friends) want? (TN/C/W/52)
 - Article 23 to apply to all GIs
 - Article 24 exceptions to apply *mutatis mutandis*
 - Multilateral register (of GIs for wines and spirits) to apply to all GIs
 - Part of Single Undertaking
 - Linkage and Parallelism

GI Extension: the actors

TN/C/W/52 – Modalities Proposal

Sponsors: Albania, Brazil, China, Colombia, Croatia, Ecuador, the European Communities, Georgia, Iceland, India, Indonesia, the Kyrgyz Republic, Liechtenstein, Moldova, the Former Yugoslav Republic of Macedonia, Pakistan, Peru, Sri Lanka, Switzerland, Thailand, Turkey, the ACP Group and the African Group

TN/C/W/60 – Concrete Amendment Proposal

Sponsors: Albania, China, Croatia, European Union, Georgia, Guinea, Jamaica, Kenya, Liechtenstein, Madagascar, Sri Lanka, Thailand, Turkey, and Switzerland

Non-Demandeurs:

New Zealand, Australia, United States, Canada, Chile, Argentina, Japan, Chinese Taipei (etc.)

State of Play

- TRIPS represents the current consensus on minimum protection standards for GIs and Trademarks
 - defines *how much* GIs can be privileged vis-à-vis Trademarks
- No multilateral consensus on what kind of GI register could bridge the divide between common law and *sui generis* systems
 - currently no progress in WTO negotiations
 - WIPO Lisbon revision remains plurilateral

GI laws notified under Art. 63.2 since 2008



Laws and Regulations under TRIPS Art. 63.2 – Graphs and Charts

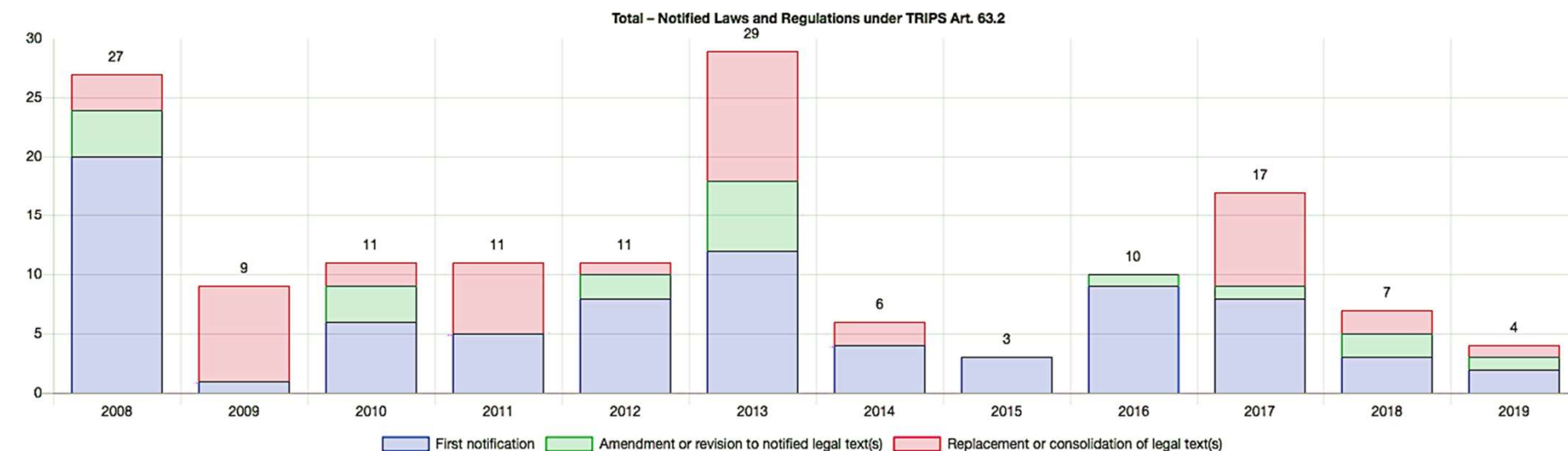
This page allows you to consult graphs and charts in relation with the notified laws and regulations under TRIPS Art. 63.2. In particular, graphs and charts showing the total number of notifications, as well as their distribution by IP subject matters, region, and development status are available. You can filter the information by: (i) dates of submission; (ii) Members; and (iii) IP subject matters.

2008 - 2019

Members:

Subject matter:

Apply filters



WTO - Trade Policy Reviews (TPRs)



Detailed questions on geographical indications protection in recent TPRs:

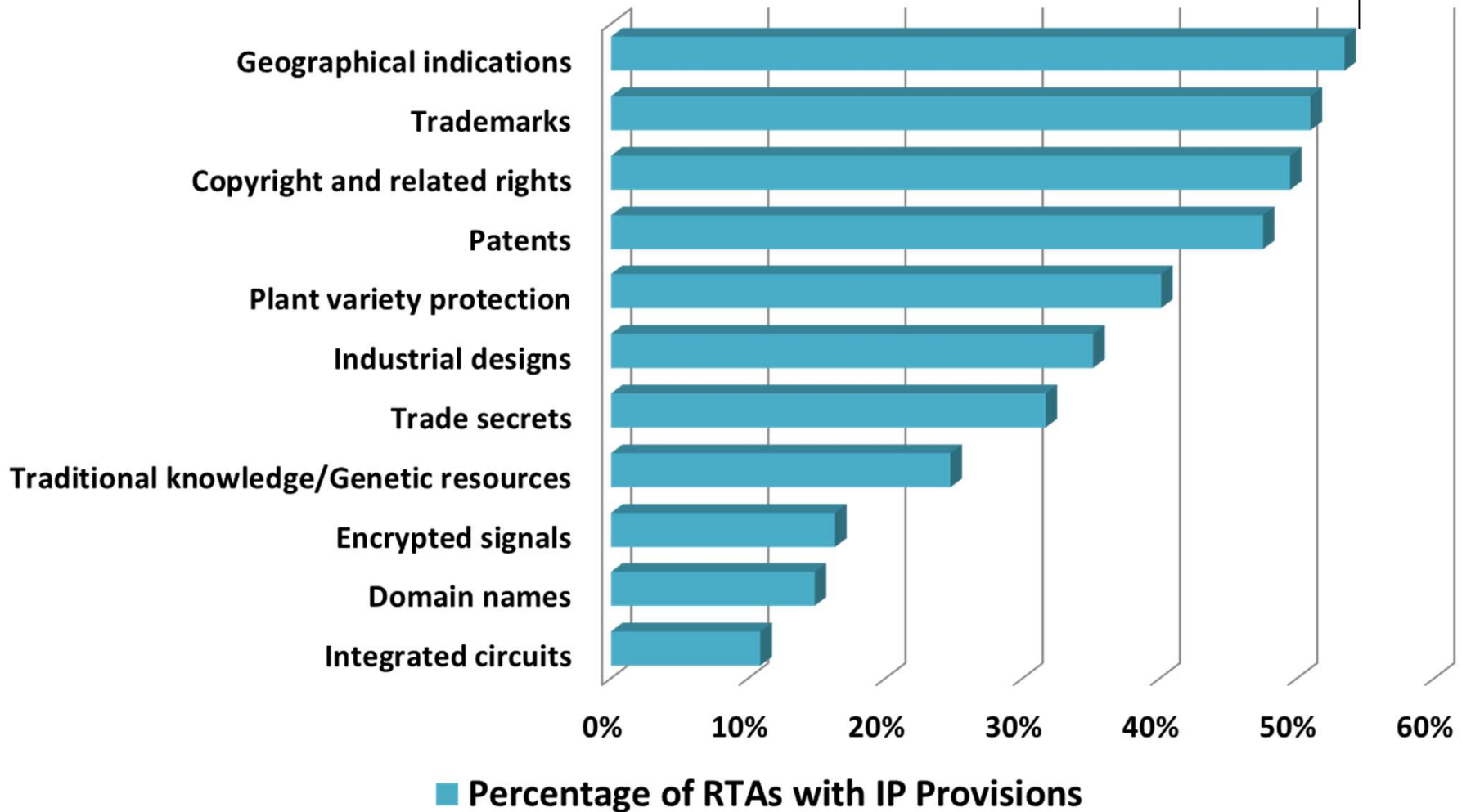
June 2019	Canada
July 2018	China
February 2018	Malaysia
May 2017	Switzerland and Liechtenstein
April 2017	Mexico
March 2017	Japan

Questions in Trade Policy Reviews

Detailed scrutiny of national systems:

- relationship between trademarks and GIs
 - how are third-party rights recognized during the registration process?
 - is coexistence possible?
 - what procedures for opposition/cancellation regarding GIs protected and introduced under bilateral treaties?
- What are the criteria for establishing genericism?
- Discussion on new forms of protection

Percentage of FTAs with Specific IP Provisions



Momentum in bilateral agreements

The multilateral divide is also reflected in different approaches to bilateral agreements on GIs:

- e.g. EU bilateral treaties focus on registration systems and protection of lists of GIs
 - EU-China „100-plus-100 project“: reciprocal recognition and registration of 100 GIs from each side
 - List approach to bilateral agreements
- e.g. US bilateral treaties focus on safeguarding trademark rights and maintaining generic terms
 - US-China Joint Commission on Commerce and Trade:
 - generic terms are not eligible for protection
 - relationship GIs-TMs handled in accordance with TRIPS
 - Legal means for interested 3rd parties to object to and cancel GIs
 - Adopt disclaimer practice for generic components of GIs

GI provisions (1) – List approach



DMC

<p>European Union – Korea, Rep. of</p>	<p>Article 10.18</p> <p>3. Having examined a summary of the specifications of the agricultural products and foodstuffs corresponding to the geographical indications of Korea listed in Annex 10-A, which have been registered by Korea under the legislation referred to in paragraph 1, the European Union undertakes to protect the geographical indications of Korea listed in Annex 10-A according to the level of protection laid down in this Chapter.</p> <p>4. Having examined a summary of the specifications of the agricultural products and foodstuffs corresponding to the geographical indications of the European Union listed in Annex 10-A, which have been registered by the European Union under the legislation referred to in paragraph 2, Korea undertakes to protect the geographical indications of the European Union listed in Annex 10-A according to the level of protection laid down in this Chapter.</p>
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GI provisions (2) – List approach



WTO OMC

**European Union
– Korea, Rep. of**

Article 10.18

6. The European Union and Korea agree that the elements for the registration and control of geographical indications referred to in paragraphs 1 and 2 are the following:

- (a) a register listing geographical indications protected in their respective territories;
- (b) an administrative process verifying that geographical indications identify a good as originating in a territory, region or locality of either Party, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin;
- (c) a requirement that a registered name shall correspond to a specific product or products for which a product specification is laid down which may only be amended by due administrative process;
- (d) control provisions applying to production;
- (e) legal provisions laying down that a registered name may be used by any operator marketing the agricultural product or foodstuff conforming to the corresponding specification; and
- (f) an objection procedure that allows the legitimate interests of prior users of names, whether those names are protected as a form of intellectual property or not, to be taken into account.

Geographical Indication provisions in the CP Trans-Pacific Partnership Agreement



Detailed provisions on IPRs, including geographical indications, with respect to, *inter alia*:

- administrative procedures for filing, recognition and protection of GIs:
- interested parties must have opportunity to object to protection
 - of GIs applied for under national procedures, and
 - for GIs recognized through bilateral treaties
- grounds for refusal must include genericism or confusion with prior trademarks and applications (incl. guidelines for determining genericism)
- Multi-component terms

GI provisions – safeguarding trademark rights



CPTPP	<p>Articles 18.30 – 18.36</p> <p>Article 18.30: Recognition of Geographical Indications</p> <p>Article 18.31: Administrative Procedures for the Protection or Recognition of Geographical Indications</p> <p>Article 18.32: Grounds of Opposition and Cancellation</p> <p>Article 18.33: Guidelines for Determining Whether a Term is the Term Customary in the Common Language</p> <p>Article 18.34: Multi-Component Terms</p> <p>Article 18.35: Date of Protection of a Geographical Indication</p> <p>Article 18.36: International Agreements</p>
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Conclusion



Origin branding of products and services in trade has increasingly been recognised as valuable across the globe in the last two decades

... but considerable differences persist between countries over the legal means for such origin branding, the relationship with trademarks, and how best to create a truly global framework for GI protection.

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Consult the website
www.wto.org