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**GEOGRAPHICAL INDICATIONS AND TRADEMARKS:  
HARMONY OF CONFLICT**

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Community protection of  
graphical indications :

**A Full IP protection**



## Why ?

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- When a name becomes well-known outside its area of origin, it may find itself competing in the marketplace with an imitating products' use of the same name.
- This unfair competition not only undermines the efforts made by the producer or manufacturer to acquire the (good) name in first place,
- It leaves consumers confused as to which product is genuine and which is a copy.



# Fully IPR protection

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## Geographical indications :

- facilitate choice
- permit identification
- vehicle of goodwill
- IPR protection



# Objective

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- To prevent unscrupulous producers imitation products under the same name
- However, it does not outlaw the manufacture and sale of similar products under other names



# Community Choice

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TRIPs is free choice, so community choice for the protection of GIs is :

- A registration system of GIs (beyond TRIPs and in the Community territory)
- A positive protection (not a negative one as TRIPs which is to provide the legal means to the right holders before Courts)
- Enforcement : right holders and/or administrative authorities
- A misleading test is not a condition for protection, registered names are protected (protection is not depending confusion)
- A “voluntary” system of fully IPR protection



# Registration means

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- Registration means that names are protected at Community level (as a valid alternative to the traditional country-by-country protection)
- Exclusive right : YES (sufficient protection)
- The nature of the protection is : industrial property right as a trademark



# DEFINITION OF GI

## Comparing definitions :

EU designation of origin	EU geographical indication	TRIPs GIs
geographical name (or not geographical)	geographical name	indication
identifying an agricultural product		identifying a good
quality or characteristic	quality, <i>reputation</i> or other	quality, reputation or other
essentially or exclusively due	attributable to that origin	essentially attributable to the origin
full manufacture in the area	only one phase in the area	unqualified





# Principles : names which can be protected

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## DEFINITION :

- ALL elements provided for in definition of GI must be justified via a product specification before registration (= the famous link between the product and the area)
- ! Crucial difference protection via collective trademark : elements of the definition may be defined by a regulation governing use but those elements are not an obligation for registration



## OTHER DIFFERENCES GI - TM

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- only producers established in a specific area who complied with strict product rules set out in the specification may use the registered name
- no transfer (but possible license)
- no renewal
- possible invalidation or revocation (elements of the definition are not met)
- registered GIs may not become generic
- enforcement of the protection via right holder and/or competent authorities
- no fees for community registration



# Principles : names which can not be protected

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## GENERIC :

- Generic names are not protected (the generic character must be proved)
- Protected names do not become generic
- Generic name is a name which has become a common name (not a name already used !!!)



# How are protected Community GIs ?

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 In which circumstances can the protected name not be used ?

- any direct or indirect commercial use of the protected name
- any misuse, imitation or evocation
- even if the true origin is indicated or the protected name is translated or the protected name is accompanied by “type”, “method” or similar
- any other false or misleading indications as to the provenance, origin, nature or essential qualities of the product



# CONFLICTS

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## Conflict with trademarks :

- case by case approach
- prior right or coexistence solution

## Conflict with names already used :

- transitory periods (to change the name)



# Procedure

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- **Application : a specification defined by producers**
- **Verification by competent authorities (definition)**
- **Publication : right to objection**
- **No objection : registration / Objection : community procedure (comitologie)**



# The key questions

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- Only available to EU GIs (It is difficult for community authorities to assess whether a non EU GI has fulfilled definition)
- What can you do to benefit from this TRIPs + level protection available in the EU ?:
- You can seek recognition for your country before the EU based on the fact that you have a system reciprocal to that of the EU. If your system protects GIs similarly (enforcement, level of protection), our registration system will open to your GIs
- You can conclude a bilateral agreement with the EU and all your GIs will be protected in Europe at once. EU authorities will take care of the defense of your GIs (as well).



# Proposal amending Regulation 2081/92 OJ 181 E/275 30.7.2002

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- Right for non EU holders to oppose registration of a GI under the normal registration procedure
- Coexistence between GIs and TM : including TM established by use (not only registered TM)
- Right to register non EU geographical indications under an precise procedure but conditional upon a Commission decision which would recognize the reciprocity
- Eliminate the fast track procedure