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GEOGRAPHICAL INDICATIONS AND MARKS

Paper given on behalf of the International Association for the Protection of Intellectual Property (AIPPI) by Mr. François Curchod, associate professor at the Robert Schuman University, Strasbourg, honorary member of the AIPPI

Introduction: a few words about the AIPPI

1. The International Association for the Protection of Intellectual Property (AIPPI) is the oldest and most prestigious of the international non-governmental organizations (NGOs) devoted to the development and improvement of intellectual property. Founded in 1897, it currently has more than 8,000 members in over 100 countries. These members are not only intellectual property practitioners but also teachers and judges as well as companies. Most of the members form part of national or regional “groups.”
2. On a scientific level, the results of the AIPPI’s work are given specific form as “resolutions” relating to specific “questions,” adopted at the end of the following process. On the basis of the needs which it identifies and the international negotiating timetable, the Association chooses a “question” for study. The “General Rapporteur,” who is responsible for the AIPPI’s scientific work, drafts “working guidelines,” which request national and regional groups to express an opinion on general or specific points, as regards both the status of the question at the national level and the suggestions of groups as regards the developments they seek at the international level. On the basis of the groups’ responses, the General Rapporteur draws up a “summary report” summarizing the different responses and suggestions made by the groups. A working committee – one of which exists for each “question” – then prepares the draft of a resolution which, following discussion at the sessions of the AIPPI Congress or Executive Committee, is adopted by the Executive Committee, the Association’s main decision-making body.
3. The resolutions thus adopted represent what is known as the AIPPI doctrine. Given the international nature of the Association, it is important to note that this doctrine takes account of the systems, practices and points of view which sometimes diverge widely between the different groups. The doctrine is therefore balanced and often reflects essential compromises. In my opinion, this, together of course with other elements such as the scientific quality of the Association’s work, is the reason for the great value of this doctrine with a view to the solutions sought by international legislators.
4. All the resolutions are published in paper form in the AIPPI’s “directories,” but they now also appear on the Association’s Internet site (www.aippi.org). In addition, the working guidelines, groups’ reports and summary reports are published in the Directories, and therefore constitute an extremely valuable source of information for anyone interested in comparative intellectual property law.
5. The AIPPI endeavors to operate in sync with the work of the intergovernmental organizations dealing with intellectual property, primarily WIPO, so as to be able to enlighten international legislators not only as to the needs and wishes of intellectual property users but also regarding the more theoretical aspects of the problems under discussion in these organizations.
6. During recent decades and, in particular, between 1974 and 1994, the AIPPI made an intense study of the protection of geographical indications and of the relationship between them and marks. The most recent of its works in the area led to the resolution entitled “Trade and service marks and geographical indications” (herein after “the Resolution”), which was adopted in Copenhagen in June 1994 by the Association’s Executive Committee. The full

text of the Resolution is reproduced in the annex to this document, and I will now introduce it to you with a number of comments, which will of course be short owing to time constraints.

The 1994 Resolution on marks and geographical indications

7. The Resolution contains six points, some of which are subdivided, and a conclusion.

8. In its first point, the Resolution begins by referring to terminology. When reading this point, it is noted that the AIPPI defines geographical indications in a broader manner than Article 22.1 of the Agreement on Trade-Related Aspects of Intellectual Property (TRIPS Agreement), since it includes in its definition, in order to establish clear criteria, geographical terms (“neutral geographical indication” and “generic geographical indication”), which do not form part of the definition in article 22.1 nor, moreover, of the applicable definitions which are part of other international treaties such as the Madrid and Lisbon Agreements. It is important to note this, since otherwise it is unclear why the Resolution refers later on to indications of source and appellations of origin rather than to geographical indications. Where the expressions “indications of source” and “appellations of origin” are used, the Resolution is closer to the concept of a geographical indication as enshrined by the TRIPS Agreement, even though there is no absolute equivalence (at least in my opinion, insofar as the Resolution includes in the concept of an indication of source signs which are not necessarily geographical indications under the TRIPS Agreement).

9. In its second point, the “AIPPI recognizes that special problems can arise with indications which, although not strictly speaking geographical, may nevertheless evoke a geographical connotation.”

10. The third point responds to the question as to whether a geographical indication can constitute a protectable mark and under what conditions. Owing to a lack of time, I will merely refer you to the text of this passage.

11. The fourth point of the Resolution answers the question as to whether an indication of source or an appellation of origin can be protected as a mark. In this regard, the Resolution distinguishes between firstly individual marks (point 4.1) and, secondly, collective or certification marks (point 4.2).

12. As regards the individual mark, the “AIPPI recommends that as a general rule, owing to its nature, an indication of source or an appellation of origin cannot be registered or protected as an individual mark for the goods or services to which the indication or appellation applies” but it “observes, however, that in some countries where there is no legal provision for the protection of collective or certification marks or any other suitable protection, indications of source or appellations of origin are protected as individual marks.” The latter point is an allusion to Japan.

13. As regards the protection of an indication of source or appellation of origin by way of collective or certification marks, the AIPPI firstly “observes that there are different definitions of collective and certification marks and that in certain countries collective marks are, in fact, according to the definitions hereunder, certification marks.” The Resolution then provides definitions and describes principles (see the text in the Annex) which allow the AIPPI to consider “that indications of source and appellations of origin can be protected in the form of

collective or certification marks even though they designate the geographical origin of the goods or services. In case of protection of a geographical collective or certification mark, it must be guaranteed that any local producer who complies with the requirements for the use of that mark is entitled to use the mark, in accordance with the specifications and in the case of a collective mark to become a member of the group.” This recognition of the form of protection of geographical indications which constitute collective and certification marks is finally the subject of a comment which emphasizes an important difference between the protection of geographical indications by specific means external to the law of marks and the protection of geographical indications by collective or certification marks, i.e. the latter “type of protection could lead to problems in the case of non-use which could result in the cancellation of the collective or certification mark.”

14. In its fifth point, which I consider to be the most important part of the Resolution, the text deals with the famous and very controversial problem of conflicts between, on the one hand, a mark and, on the other, an indication of source or appellation of origin. The Resolution begins by laying down a clear principle which is that, when a conflict arises, consideration has to be given as to which of the two signs has priority. However, this is where the real difficulty begins, since it is therefore necessary to determine this priority. In order to do this, the Resolution distinguishes three cases.

15. The first case (point 5.1) is that where the indication of source or appellation of origin is earlier than the mark. In this case, the AIPPI recommends firstly that “the Trademark Office should *ex officio* refuse the registration of the mark” and, secondly, that “third parties may oppose the application to register as a mark” and may “bring proceedings for cancellation of the registration of the mark and for prohibition of use thereof.” Therefore, in the first place, there is no possible coexistence between the two signs. It should also be noted that the Resolution does not define the adjective “earlier.”

16. The second case (point 5.2) is that where an indication of source or an appellation of origin of high reputation and a mark are in conflict. For this second case, the AIPPI “recommends that a mark can be refused protection if it is identical or similar to an indication of source or an appellation of origin of high reputation, even if the goods or services are not similar, if use of the mark would take unfair advantage of or be detrimental to the distinctive character or repute of the indication or appellation.” In other words, the protection, in the face of a mark, of an indication of source or appellation of origin which is of high reputation and which is earlier than the mark extends to goods or services which are not similar.

17. The third case (point 5.3) is that where the mark is earlier than the indication of source or appellation of origin. For this case, the AIPPI distinguishes two situations. The first situation is that where the mark *has not acquired* reputation or renown prior to the date the indication of source or appellation of origin has been established or recognized as such: in this first situation, the AIPPI recommends the principle of coexistence. The second situation is that where the mark *has acquired* reputation or renown prior to the date the indication of source or appellation of origin has been established or recognized as such: in this second situation, the AIPPI does not recommend coexistence but the mark will prevail with, however, the nuance that the indication of source or appellation of origin may be used to identify the geographical origin of the goods or services, but provided that this use is in good faith, solely to identify the geographical origin of the goods or services, and is not such as to be perceived as a mark.

18. The sixth point of the Resolution, which is the last before the conclusion, is a reaction to particular problems posed by a provision (article 12) of Community Regulation 2081/92. I will not, therefore, dwell on this point and refer you to the full text of the Resolution.

19. The conclusion of the Resolution commits the AIPPI to study the “marks and geographical indications” question further. In truth, the AIPPI has not yet continued this study, which is explained in the light of the progress, or rather the lack of significant progress, of the discussions on the protection of geographical indications at the intergovernmental level. At the most, the AIPPI has confirmed the validity of the Copenhagen Resolution at the occasion of its Congress in Rio de Janeiro in 1998.

Conclusion: qualified solutions to complex problems

20. The summary analysis which I have just presented to you regarding the way in which the AIPPI deals in the Resolution with the relationship between marks and geographical indications and, *inter alia*, conflicts between these two types of signs, leads me to conclude that, in view of the complexity of the problems, in question the recommended solutions are very carefully distinguished, something which in my opinion constitutes the entire value of the Resolution.

[Annex follows]