

# **GEOGRAPHICAL INDICATIONS & TRADE MARKS**

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## **GEOGRAPHICAL INDICATIONS & TRADE MARKS**

- **That GI's are intellectual property has only been recently accepted in the "New World"**
- **This is in spite of the clear reference to indications of source and appellations of origin in the Paris Convention itself - Article 1 (2)**

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## GEOGRAPHICAL INDICATIONS & TRADE MARKS

- **Leading “New World” IP texts (such as McCarthy (1973) USA, Fox (1972) Canada, Shanahan (1990) Australia and Ricketson (1984) Australia) did not even mention GI’s**
- **Conversely Mathély (1984) France devotes 4 chapters to the topic**

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## GEOGRAPHICAL INDICATIONS & TRADE MARKS

- **TRIPS (ADPIC) changed the legal landscape, firmly embedding GI’s as intellectual property rights, given no less priority than traditional intellectual property rights**
- **Whether we endorse this or not, it is the reality with which GI’s must deal**

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## GEOGRAPHICAL INDICATIONS & TRADE MARKS

- Thus if GI's are now universally accepted as intellectual property rights, then logically they should abide by the basic and fundamental concept that pervades the entire IP world, namely:

**First in time, first in right  
("FITFIR")**

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## GEOGRAPHICAL INDICATIONS & TRADE MARKS

- INTA, OIV and AIPPI endorse this position
- But is it so simple? As an IP lawyer, yes
- But as a wine lawyer, there are numerous issues deserving resolution that need attention first

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## GEOGRAPHICAL INDICATIONS & TRADE MARKS

### QUESTIONS

- **Are we all talking the same language? When we talk of GI's bear in mind that:**
  - the “Old World” has a different concept of GI's than does the “New World”. With wines:
    - the Old World has a real notion of terroir associated with GI's
    - the New World focuses principally on grape sourcing

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## GEOGRAPHICAL INDICATIONS & TRADE MARKS

### QUESTIONS

- **Should the FITFIR principle apply automatically to all types of GI's?**
- **Must the usage be constituted by sales or offers to sell?**
- **Can the usage be constituted by mere “slop-over” reputation?**

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## GEOGRAPHICAL INDICATIONS & TRADE MARKS

### QUESTIONS

- **What about usage on the internet?**
  - Does that suffice?
  - Is it sufficient if there are “hits” or enquiries directed to the site by persons within the jurisdiction in question?
- **What if the adoption as a TM was lawful under TM law but was plainly parasitic?**

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## GEOGRAPHICAL INDICATIONS & TRADE MARKS

### QUESTIONS

- **Is registration critical**
  - The absence of a trade mark registration should not affect the trade mark proprietor’s rights, as the unregistered rights are still capable of ready identification
  - However, if a GI is unregistered and its boundaries not fixed by law, then even the identity of those entitled to use and protect it will be unknown

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## GEOGRAPHICAL INDICATIONS & TRADE MARKS

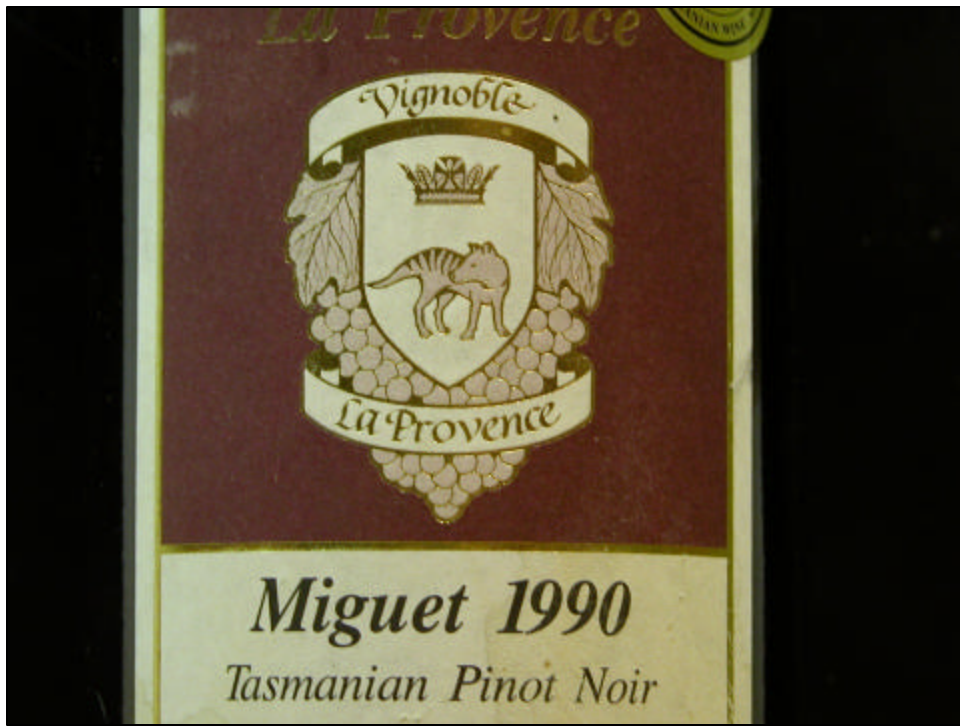
- **The consistent application of the FITFIR principle may in the wine sector well favour, on most occasions, the GI**
  - unlike most trade mark owners, GI's have usually existed, in one form or another, for many decades if not hundreds of years
  - wines were exported internationally, by reference to their GI, for hundreds of years

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## GEOGRAPHICAL INDICATIONS & TRADE MARKS

- **The “La Provence” dispute pitched the French region of that name against an Australian producer using “La Provence” as a TM**
- **The dispute turned solely on the language of Australia’s wine legislation which gives absolute primacy to GI’s over TM’s**

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## GEOGRAPHICAL INDICATIONS & TRADE MARKS

- **However, a subsequent commentator has suggested that the unsuccessful owners of the La Provence vineyard should have argued that their trade mark predated the “Provence” GI in Australia**

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## GEOGRAPHICAL INDICATIONS & TRADE MARKS

- However, even on the FITFIR principle**
- **the various French AOC’s incorporating “Provence” were registered in France before the Australian adoption of La Provence as a TM**
  - **Provence wines had long been exported to Australia and had established a (small but discernable) reputation in Australia**

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## GEOGRAPHICAL INDICATIONS & TRADE MARKS

- If the FITFIR principle applies in the “GREAT WESTERN” dispute in Australia, then the GI should take precedence as the (grape growing) region was known by that name 5 years before that name was adopted by Seppelts as a TM

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## **GEOGRAPHICAL INDICATIONS & TRADE MARKS**

**There is, however, a problem with the simple application of the FITFIR principle to the GREAT WESTERN situation:**

- **the region was named in 1855**
- **the trade mark was adopted in 1860**
- **the GI and the TM have co-existed in fact for over 140 years**

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## **GEOGRAPHICAL INDICATIONS & TRADE MARKS**

**Thus in the GREAT WESTERN situation application of the FITFIR principle, which would mean that the GI should take primacy over the Seppelts TM would, however, plainly be inequitable for the TM proprietor even though it was not the first in time.**

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## GEOGRAPHICAL INDICATIONS & TRADE MARKS

### **Both sides**

- those who wish to give absolute primacy to GI's;  
and
- those who wish to apply the FITFIR principle

**are trying to protect differing economic  
interests**

- industries or economic sectors (generally  
agricultural)
- IP owners

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## GEOGRAPHICAL INDICATIONS & TRADE MARKS

**There an added complication that, from the IP  
perspective, consumer protection is an  
additional goal and thus justification for the  
FITFIR principle**

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## GEOGRAPHICAL INDICATIONS & TRADE MARKS

**Thus, it is not as simple as trying to impose one rule for dealing with the two differing rights and sometimes competing systems**

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## GEOGRAPHICAL INDICATIONS & TRADE MARKS

### **Food for thought:**

- **FITFIR may be the appropriate starting place for a solution to primacy debates - if GI's are TM's, they should comply with universally applied IP principles**
- **However, this should not be presumed**

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## **GEOGRAPHICAL INDICATIONS & TRADE MARKS**

**GI's are not like other IP rights. They**

- aren't capable of private ownership**
- cannot be licensed or assigned**
- attach to the land**

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## **GEOGRAPHICAL INDICATIONS & TRADE MARKS**

- Thus comparing GI's to TM's is like comparing apples to oranges. They are very different in nature**
- Perhaps GI's are not susceptible to standard IP rules**

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## **GEOGRAPHICAL INDICATIONS & TRADE MARKS**

**Even though GI's may be IP rights, perhaps principles such as FITFIR should be ignored where:**

- equity/justice demands otherwise**
- equity/justice demands co-existence (such as the GREAT WESTERN situation)**
- consumer deception is at stake**
- economic rights are at stake, be they private or national/public**

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## **GEOGRAPHICAL INDICATIONS & TRADE MARKS**

**As an IP lawyer, I support the application of the FITFIR principle for GI -v- TM disputes**

**As a wine lawyer, I am not yet convinced as there are still too many unanswered questions**

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