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STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS

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GEOGRAPHICAL INDICATIONS

prepared by the International Bureau

I. INTRODUCTION

1. With respect to the law of geographical indications, the WIPO Program and Budget for 1998-1999 provides for:

“Geographical Indications: Study of the desirability and feasibility of establishing guiding principles on topical issues concerning protection of geographical indications, covering the definition of the subject matter to be protected, whether protection should be based on registration and, if so, the desirable essential features of the registration procedure (including the extent to which applications for registration should be examined), as well as possible solutions for conflicts between trademarks and geographical indications.”¹

2. At its first session (July 13 to 17, 1998), the SCT decided that the question of geographical indications would be revisited at the second session and that, in the meantime, the International Bureau would monitor developments in the field of geographical indications and continue preparations for a world-wide symposium to be held in the biennium.² At its second session, second part (June 7 to 11, 1999), the SCT requested that the International Bureau submit, at its third session, a report on the Symposium on the International Protection

¹ See WIPO document A/32/2, page 90.

² See WIPO document SCT/1/6, paragraph 31.

of Geographical Indications (hereinafter referred to as “the Symposium”), which took place in Somerset West, Republic of South Africa, on September 1 and 2, 1999.³

3. This document contains a report on the Symposium, describes developments with regard to the protection of geographical indications within the World Trade Organization (WTO), and suggests ways of implementing the part of the WIPO Program and Budget for 2000-2001 dealing with geographical indications.

II. THE 1999 SYMPOSIUM ON THE INTERNATIONAL PROTECTION OF GEOGRAPHICAL INDICATIONS

4. In accordance with the WIPO Program and Budget for 1998-1999, the International Bureau organized, in cooperation with the South African Patents and Trademarks Office, a two-day international symposium on the protection of geographical indications. The Symposium took place in Somerset West, Cape Province, South Africa, and was attended by some 100 participants from 50 countries.

5. The program of the Symposium comprised nine international experts speaking on eight subjects. There were three categories of presentations:⁴ protection of geographical indications on the international level (multilateral and bilateral agreements and negotiations), protection of geographical indications on the national and regional level (including the specific issue of conflicts between trademarks and geographical indications) and the use of geographical indications in a collective marketing strategy. As regards the first category, the present situation of the international protection of geographical indications and prospects for future developments, recent developments in the Council for TRIPS of the World Trade Organization (WTO) and the bilateral discussions concerning geographical indications between the European Union and South Africa were presented. The situation concerning the protection of geographical indications in South Africa, the European Union and the United States of America, and the particular problem of conflicts between geographical indications and trademarks, were dealt with under the second group of issues. Finally, the examples of the South African wine industry and the French protected appellation of origin for “Cognac” were presented in order to illustrate the successful use of geographical indications in a collective marketing strategy.

6. The symposium provided an opportunity for the speakers and the audience to express and discuss their opinions. The deliberations displayed a great variety of concepts and national and regional approaches to the protection of geographical indications. It was pointed out, in particular, that the issue of protection of geographical indications is at present the subject of international trade negotiations within the WTO (see in particular the following paragraph). The documents made available for the Symposium will be edited and compiled by WIPO and will be issued as a WIPO publication.

³ See WIPO document SCT/2/12, paragraph 18.

⁴ See WIPO documents in the WIPO/GEO/CPT series of documents.

III. DEVELOPMENTS WITHIN THE WORLD TRADE ORGANIZATION

7. Questions relating to the protection of geographical indications on the international level are currently being discussed within the Council for TRIPS of the WTO. Those discussions concern mainly the application of TRIPS Article 24.2 (i.e., review of the application by WTO Members of Part II, Section 3 of the TRIPS Agreement) and of TRIPS Article 23.4 (i.e., negotiations 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 Member participating in the system). Discussions concerning geographical indications within WTO may also be undertaken at the WTO Ministerial Conference, third session, which will be held in Seattle from November 30 to December 3, 1999.⁵

IV. FUTURE WORK

8. In respect of geographical indications, the WIPO Program and Budget for 2000-2001, as adopted by the WIPO General Assembly during the thirty-fourth Series of Meetings of the Assemblies of Member States of WIPO, held from September 20 to 29, 1999,⁶ provides, *inter alia*, for the following:

“Preparation of studies on important issues relating to the law of trademarks, industrial designs and geographical indications, that might not yet be ready for consideration by the SCT, including the following:

- the desirability and feasibility of establishing guiding principles on topical issues concerning the protection of geographical indications, covering the definition of the subject matter to be protected, whether protection should be based on registration and, if so, the desirable and essential features of the registration procedure (including the extent to which applications for registration should be examined), as well as possible solutions for conflicts between trademarks and geographical indications and homonymous geographical indications.”⁷

9. With regard to the implementation of the item concerning geographical indications of the WIPO Program and Budget for 2000-2001, the following suggestions may be considered by the SCT:

- (i) it is suggested that a study be prepared by the International Bureau, for consideration by the SCT, concerning possible solutions for conflicts between trademarks and geographical indications and homonymous geographical indications;

⁵ See for example WTO documents WT/GC/W/282, 294 and 302.

⁶ See WIPO document A/34/16 Prov., Paragraph 141.

⁷ See WIPO document A/34/2, page 82.

- (ii) concerning the issue whether protection for geographical indications on the national or regional levels should be based on registration and, if so, the desirable and essential features of the registration procedure (including the extent to which applications for registration should be examined), the question arises whether a study should also be prepared on that subject;
- (iii) with respect to questions relating to the protection of geographical indications which are currently under discussion in the WTO and, in particular, the definition of the subject matter to be protected, it seems to be appropriate to postpone work on those issues in order to avoid duplication of efforts.

10. The SCT is invited to express its opinion concerning the implementation of any of the suggestions outlined in the preceding paragraph, or on any other solution which it may find fit in order to implement the portion of the WIPO Program and Budget for 2000-01 relating to geographical indications.

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