



MINISTRY OF INDUSTRY, FOREIGN TRADE AND SERVICES
NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY
PRESIDENCY
COORDINATION OF INTERNATIONAL RELATIONS
Rua Mairink Veiga, 09, 25º andar, Centro, Rio de Janeiro, RJ, CEP 20090-010

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Rio de Janeiro, March, 2nd, 2018.

MR.

Senior Director
SCT Services Department
World Intellectual Property Organization
34, Chemin des Colombettes
CH-1211 Geneva 20
Switzerland

Subject: C.8707 – SCT/38.

Dear Senior Director,

We write regarding the circular C. 8707 relating the Workplan on Geographical Indications (GIs) adopted at the thirty-eighth session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT/38/5).

The circular C. 8707 requested that member States should propose questions referred to in the workplan on GIs adopted in the last SCT.

Please, find bellow our proposed questions, according to the topics established in C. 8707:

1) Basis for protection:

In the case of Brazilian national legislation, unlike the definition of geographical indication found in item 1 of art. 22 of the Trade-Related Aspects of Intellectual Property Rights Agreement (TRIPS) ¹, the legislature chose to use as a geographical indication two definitions of distinct natures: an indication of origin

¹ Geographical indications are, for the purposes of this Agreement, indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.



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and a designation of origin, both referring exclusively to geographical names of a country, city, region or locality within its territory.

The indication of origin refers to the geographical name which has become known as the center of extraction, production or manufacture of a given product or service, while the designation of origin refers to the geographical name which has been designated as a product or service whose qualities and characteristics are due exclusively or essentially to the geographical environment.

The definition of indication of provenance in the current Brazilian Law goes back to the definition of indication of provenance already provided for in the Brazilian Industrial Property Code of 1971 - CPI / 71, which is closely related to the protection provided for in the Paris Convention and the Madrid Agreement with regard to repression of false indications of provenance.

The definition of appellation of origin is very similar to the definition of the Lisbon agreement on the protection of designations of origin. The Brazilian legislation is more restrictive when compared to the TRIPS Agreement, regarding the indication to be protected. It restricts the indications to only geographical names, but it becomes broader by not discriminating the economic activity related to the geographical indication, when it allows the indications for services, which is not provided for in the TRIPS agreement. In this way, a question to be raised in the SCT forum would be the forecast for the recognition of geographical indications related to economic activities other than those already consolidated internationally (agri-food products, wines and distilled beverages). In this sense, an adequate question would be the following:

- What measures would allow the recognition of geographical indications at the international level related to non-agricultural products, such as products from nature, manufactured goods, handicrafts and services?

Argument: With the expansion of international trade, regional products and services originating specially from developing countries could benefit from recognition as geographical indications for incorporating biodiversity products together with traditional knowledge with a high degree of distinctiveness provided by local culture.

2) Applications and registration:

The different concepts and diversity of protection mechanisms (especially national legislation) sometimes lead to difficulties in registering and protecting geographical indications amid countries. In the Brazilian case, the impossibility of registering indications other than geographical names is an example. Likewise, the restriction on the registration of geographical indications only for



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agri-foods, wines and distilled beverages, as provided for in the European Union, for example, make it difficult to recognize non-agricultural products and services as geographical indications, as explained above.

Many countries protect geographical indications by sui generis mechanisms.

In these cases, it would be appropriate to check within the SCT discussion forum the following:

- **What would be the efforts to approximate national legislation in order to make it easier to protect this intellectual property asset at the international level?**

- **What are the forecasts for the extension of the concept of geographical indications to the other economic sectors not restricted to agri-food products, wines and distilled beverages, such as handicrafts, manufactured products, minerals and miscellaneous services?**

3) Scope of protection and enforcement:

In Brazilian law, geographical indications are considered as a distinctive sign that identifies the geographical origin of a particular product or service when the place became known or when it became a product or service whose quality or characteristic is due to the geographical environment. It is therefore a distinctive sign of trade. In the case of indications of origin, there is no intrinsic relation with the quality of the product, since the reputation is linked to the place.

In the case of protection of geographical indications of products and services, the limits of protection remain. **Is protection limited only to the distinctive sign or to related goods and services? For example, regarding a product that holds specific forms of preparation involving traditional knowledge, would it be in some way protected by geographical indications? Are the specifications or use regulations also part of the scope of protection?**

As to ownership, much has been discussed about the nature of the right of geographical indications as a collective good. In this case, the protection of the geographical indication is a complex subject that involves the nature of the registry.

In many countries the geographical indication is taken as a declarative and therefore pre-existing register. **In this case, it remains to know if the right is retroactive to registration and how much retroactive is the right?** This is for the purpose of nullifying trademark registrations by third parties, prior to the registration of IG, if the legislation so permits.



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In the case of ownership of geographical indications, is the right to exclude third parties restricted only to the small group of organized producers or to all those established in the region? What role would the State play in enforcing this right, especially when products circulate in international trade?

The issue of enforcement is directly related to ownership and the extent of protection in relation to the other distinctive signs of trade. The relationship between geographical indications and trademarks is observed in item 3 of art. 22 of TRIPS²:

In countries of European colonization there is sometimes evidence of bona fide trademarks which refer to recognized geographical indications in Europe. In these cases, clearer rules on the coexistence between these two distinctive signs are necessary in order to avoid confusing the consumer. For example, many producers in countries with a strong tradition of colonization sometimes use rectifying terms such as type or similar to refer to products that refer to known geographical indications.

In this case, an important issue for discussion in the SCT forum would be:

- Is there already an agenda for the development of clearer rules on product labeling in order to inform their real origin, avoiding unfair competition and consumer confusion?

Should you have any queries, please get in contact with Mr. Daniel Oliveira through dfranca@inpi.gov.br or +55 21 30373530.

Respectfully,

Leopoldo Coutinho
Coordination of International Relations

² “A Member shall, ex officio if its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in that Member is of such a nature as to mislead the public as to the true place of origin.”