

COMMENTS BY THE INVITED SPEAKER KERI JOHNSTON, VICE-CHAIR GEOGRAPHICAL INDICATIONS TEAM, MARQUES AT THE WIPO CONFERENCE ON DISPUTE SETTLEMENT WITHIN THE LISBON SYSTEM, ON FRIDAY DECEMBER 6, 2013, GENEVA, SWITZERLAND

10.20 - 11.20 TOPIC 1

What purpose could a dispute settlement mechanism within the Lisbon System serve?

On behalf of MARQUES and the Chair of the GI Team, Miguel Angel Medina, we wish to thank the Secretariat for inviting MARQUES to participate in this half-day conference, and for the Information Note prepared by the Secretariat as a background document to this morning's discussion.

As the program outline indicates, MARQUES was one of the NGOs who made written submissions to the survey on the Lisbon System in 2010. However, having reviewed the MARQUES submissions in preparation for this morning, I note that those submissions were limited to the statement that MARQUES believes that the inclusion of a settlement dispute mechanism should be considered by the current Member States, and of course it is for the Member States to determine what mechanism or mechanisms might best suit the purposes of the interested parties.

I believe that the necessity for the inclusion of a dispute settlement mechanism has been covered by my friend from oriGIn, and the mechanics of what is available from WIPO will be dealt with by the distinguished speaker from WIPO, so I propose to give you a little of my personal and professional background which highlights the learning curve that is required in order to fully understand and appreciate both the public and private interests that are the subject of the Revised Lisbon Agreement.

The basis of my knowledge comes from my association with MARQUES, my work on the MARQUES GI Team, my attendance at a number of the Lisbon Working Group Meetings since 2009 as an observer on behalf of MARQUES, and the interests of the clients I represent in Canada - some of whom are domestic clients, and some of whom are foreign clients who have chosen Canada as one of the countries in which they have decided to do business. With respect to the topic of geographical indications and/or appellations of origin - I am certain - having noted that my own views have evolved over time - that it is certainly possible to formulate a multi-lateral agreement that could facilitate settlement on the issues that are before the Working Group and with which the Revised Lisbon Agreement is concerned in such a way that the principles and objectives of the Revised Agreement can be preserved. Moreover, WIPO as the administrator of numerous multi-lateral agreements as set out in the paper prepared by the Secretariat certainly has the expertise required to shepherd it through, should the political will exist to enact such provisions.

The relevance of educating the constituents, both private and public, for whom the Revised Lisbon Agreement is intended

I am a bilingual Canadian from Toronto, Canada where I am the founding partner of a boutique intellectual property law firm, Johnston Law. I am both a barrister and solicitor. I have practiced in this area of law for 17 years. I tell you this because it has been my experience in speaking with both my Canadian clients and Canadian colleagues who are in the same area of law that their basic understanding of the issues before this Working Group is sadly lacking. This is

important because it emphasizes the difficulty in garnishing support for the initiatives of the Working Group, and it highlights the basis on which there might be a belief that the public and private interests cannot co-exist or be the subject of dispute settlement.

As a barrister in Canada, I have used court-ordered dispute settlement governed by our Federal Court Rules to achieve settlement in both patent and trade-mark infringement actions.

Settlement is always possible if the will to settle is there, and the art of compromise is practiced by both parties to a dispute. That being said, not all parties want to settle.

The topic before us today involves not just private interest rights, but also public interest rights. If the parties cannot see there is a way to a reasonable point of view, and sub-optimal bi-lateral agreements are used over the preferred multi-lateral agreements, we shall have a state of legal chaos that will serve nobody's interests. Such legal chaos cannot be justified given the long-standing co-existence of AOs and GIs together with trade-marks in Europe. Perhaps there are some lessons in that European history that may point the way forward and which can facilitate parties in better understanding where the boundaries of private and public interests can meet, perhaps collide, but where they could also be the subject of dispute settlements.

Frankly, the longer the delay in developing a system of dispute settlement, the greater the likelihood of chaos, pursuant to the different terms negotiated in the many existing bilateral agreements that have become the sub-optimal solution to a complicated political and economic issue.

Expertise in this area of the law needs to be developed by those who have not been educated in the co-existence of private rights and the public rights that will be protected by a greater understanding of AOs and GIs. Frankly, there is no reason why these rights can't co-exist, and there may even be opportunities to enhance a private interest right through association with an AO or GI.

In 2004 I went to a session on GIs at the INTA Annual meeting. I only went as a favor to friend who was speaking. I had no idea what a GI was. I had never heard of GIs. I knew that we couldn't use "champagne" on sparkling wine, but that was about all. I was typical of many of my Canadian colleagues.

As a Canadian, where other than the multiple First Nations peoples, everyone is an immigrant – my first reaction at my first INTA committee meeting was one of surprise at the thought of the many cultural traditions (including names of places, foods etc.) that had been imported into Canada by European and other immigrants who left everything to establish lives and businesses in Canada – being what I saw of as "clawed back" under a system that I was told would place the rights of GI holders over the rights of trade-mark owners. Now that IS a possibility, and to say it isn't is to ignore another cultural reality than that with which some people in this room might be familiar with.

BUT

I began to educate myself about all the issues, and all the points of view, and I was fortunate to engage with some of the leading minds in this area in the world, some of whom have been here this week. I joined the MARQUES GI Team in 2006 under the leadership of our Chair Miguel Angel Medina. When I joined the GI Team at MARQUES, we were sort of tiny and perhaps some thought the issue somewhat irrelevant. I quickly understood that it was far from irrelevant, and is an area where public, government, and diplomatic policy considerations intersect with private legal rights in a way that will not become less important over time, but more important. In light of that, I helped moderate table topics across Canada on GIs with other members of the then GI INTA committee in Canada – maybe we were still ahead of our time.

Concurrently I sensed that the EU had adopted a policy whereby they were prepared to enter into bilateral agreements as a means of establishing legal recognition for the growing economic importance in the EU economy of AOs and GIs. We should all be aware that there are now over 40 bilateral agreements, and more underway between the EU and various countries, including with Canada, which was announced in October 18, 2013.

GIs have also recently found their way into multi-lateral agreements like the doomed ACTA agreement, undoubtedly at the insistence of the EU negotiators. I would argue that the importance of that step should not be underrated because the US and the EU had a meeting of the minds on the inclusion of GIs as a legitimate, and protectable intellectual property right under the terms of the agreement.

I have observed over the years the hard work of excellent minds working on this topic towards a fair resolution of a public interest issue. This is not simply a private interest as we all know. From my work with MARQUES I observed that many of my European colleagues understood and accepted the co-existence of GIs (AOs), trade-marks and even certification marks through their exposure to foreign legislation on trade-mark law. It became clear to me that extreme views on either side had polarized the discussion to the point that a sub-optimal bilateral agreement solution has been adopted and pursued by the EU in the face of an impasse between the major trade negotiating parties.

However, the bilateral agreements present issues such as:

1. Are governments prepared to take on the private interests of existing rights holders whose interests those same governments may have already compromised in bilateral agreements that form the basis of those dispute settlement procedures?
2. What provisions in the numerous bilateral agreements limit the ability of the contracting states to participate in a system under a Revised Lisbon Agreement?

MARQUES represents trade-mark owners who have long co-existed with AOs in Europe. It is not that there haven't been battles (some very long and well-documented), but there has also been co-existence.

As a Canadian, I see opportunities for local industry and other interests to maximize our uniqueness through GIs and a recognition of those rights. I see opportunities for First Nations and indigenous peoples to become more involved in intellectual property rights, and I see that a multi-lateral agreement is always preferred as the best legal, political and diplomatic solution.

The work of the Working Group, and proposals that are being presented in the REVISED LISBON AGREEMENT may provide a step in the right direction, particularly if the means of dispute settlement are included.

Previously there were limited means to resolve the disputes that arose.

The issues are maturing to the point that clearly a multi-lateral agreement is in the best interests of both trade-mark owners who will benefit from greater legal certainty, and the public interests of groups who have an important economic and cultural role to fulfill in their respective countries and geographical regions.

The MARQUES proposal was cognizant of all those factors as the proposal was drafted and submitted to WIPO.

Thank you for taking the time to listen this morning. Thank you.