

GIs and Trademarks – resolving the conflict

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INTA

- Members in 190 countries
- 6,500 corporates and professional firms
- 30,000 trade mark practitioners

Trademarks and GIs

- INTA supports the protection of GIs provided other IPRs are not prejudiced
- First in Time, First in Right
 - Territoriality
 - Exclusivity
 - Priority

WTO IPR implementation issues

- Multilateral register for wines and spirits – TRIPS Art 23.4
- Other “implementation” issues
 - Extension of TRIPS Art 23 protection (wines and spirits only) to all products
 - Disclosure by patent applicants of origin of genetic material and traditional knowledge used in inventions
- Deadlock since Doha Ministerial Conference (November 2001)
- Effect on wider WTO negotiations and other international agreements (e.g. TTIP, TPP)

New Act of the Lisbon Agreement

- A lost opportunity
 - New Act not acceptable to many countries with trademark based protection systems
 - Could have formed basis of TRIPS multilateral register but cannot now do so
- Another registration system therefore necessary – but deadlock must be overcome
- Implications for completion of Doha round

Principles for a Multilateral Register

- Notification through WIPO to participating members
- Examination in country of protection rather than origin
- Opposition by interested parties, including on basis of prior rights, non-conformity with definition of GI and genericness
- Ability to challenge in courts
 - Link to detailed proposal: -
<http://www.inta.org/Advocacy/Documents/INTAProposalforMultilateralGIRegister.pdf>

Possible future action

- Inventory of bilateral agreements on protection of GIs to establish what is protected, where and how
- Review by SCT of the different systems for protection of GIs as directed by WIPO GA should include analysis of developments in the international framework for such protection introduced by Geneva Act of Lisbon Agreement

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