

WIPO/GEO/SFO/03/4**ORIGINAL:** English**DATE:** June 27, 2003WORLD INTELLECTUAL
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COMMUNITY PROTECTION OF GEOGRAPHICAL INDICATIONS: A FULL
INTELLECTUAL PROPERTY PROTECTION

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Community protection of geographical indications :

A Full IP protection

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Why ?

- When a name becomes well-known outside its area of origin, it may find itself competing in the marketplace with an imitating products' use of the same name.
- This unfair competition not only undermines the efforts made by the producer or manufacturer to acquire the (good) name in first place,
- It leaves consumers confused as to which product is genuine and which is a copy.

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Fully IPR protection

Geographical indications :

- facilitate choice
- permit identification
- vehicle of goodwill
- IPR protection

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Objective

- To prevent unscrupulous producers imitation products under the same name
- However, it does not outlaw the manufacture and sale of similar products under other names

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Community Choice

TRIPs is free choice, so community choice for the protection of GIs is :

- A registration system of GIs (beyond TRIPs and in the Community territory)
- A positive protection (not a negative one as TRIPs which is to provide the legal means to the right holders before Courts)
- Enforcement : right holders and/or administrative authorities
- A misleading test is not a condition for protection, registered names are protected (protection is not depending confusion)
- A "voluntary" system of fully IPR protection

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Registration means

- Registration means that names are protected at Community level (as a valid alternative to the traditional country-by-country protection)
- Exclusive right : YES (sufficient protection)
- The nature of the protection is : industrial property right as a trademark

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Principles : names which can be protected

DEFINITION :

- ALL elements provided for in definition of GI must be justified via a product specification before registration (= the famous link between the product and the area)
- ! Crucial difference protection via collective trademark : elements of the definition may be defined by a regulation governing use but those elements are not an obligation for registration

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OTHER DIFFERENCES GI - TM

- only producers established in a specific area who complied with strict product rules set out in the specification may use the registered name
- no transfer (but possible license)
- no renewal
- possible invalidation or revocation (elements of the definition are not met)
- registered GIs may not become generic
- enforcement of the protection via right holder and/or competent authorities
- no fees for community registration

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Principles : names which can not be protected



GENERIC :

- Generic names are not protected (the generic character must be proved)
- Protected names do not become generic
- Generic name is a name which has become a common name (not a name already used !!!)

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CONFLICTS

Conflict with trademarks :

- case by case approach
- prior right or coexistence solution

Conflict with names already used :

- transitory periods (to change the name)

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TRIPs & Territoriality

...and European Problem? **NO!**

BOURBON WHISKEY \dashrightarrow Bourbon County, Kentucky, USA ?

Mexican Bourbon?



Canadian Bourbon?



⚡ What can be done to protect "Bourbon"?

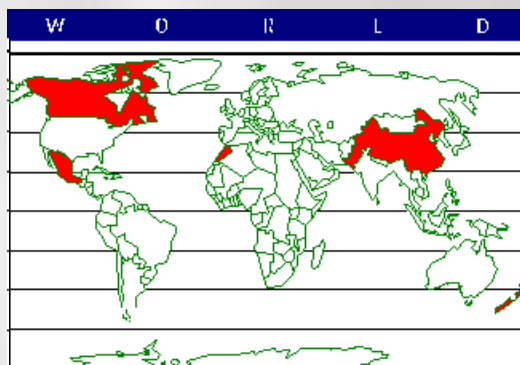
\leftrightarrow To either register your "Bourbon" or, otherwise, undertake costly and lengthy litigation in those 146 WTO countries, with 146 different registration systems and 146 individual diverse fees.

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A WTO Multilateral Register

Notification by the US: "BOURBON" \dashrightarrow 18 Month Exam
Opposition by: Canada; Mexico; Morocco; New Zealand; China.



Effects for "Bourbon"

\leftrightarrow PM- Will be presumed a GI

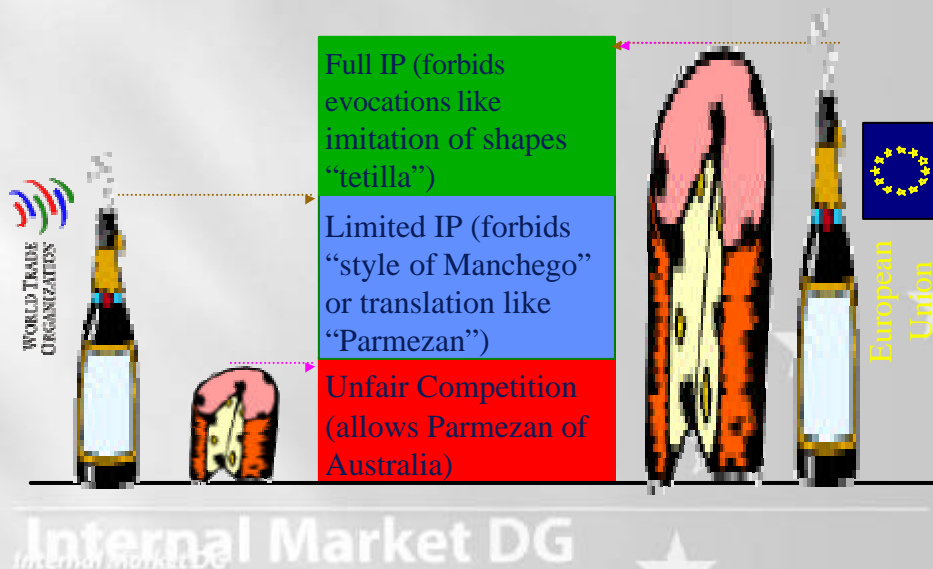
\leftrightarrow AM- E.g., no one will be able to claim that its generic

\leftrightarrow There will be a need to negotiate with "red" countries a bilateral agreement

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TRIPs & EU: comparing protection



Protecting WTO GIs in the EU (I)

~~Recognising and protecting WTO GIs: Wines & Spirits~~

- Regulation 1493/99 + MS legislation

Art. 48. forbids "the description and presentation of the products (...), and any form of advertising for such products [wines], must not be incorrect (...) even if the information is used in translation or with a reference to the actual provenance or with additions such as "kind", "type", "style", "imitation", "brand" or the like."

- Bilateral (Mexico, Chile, Australia, South-Africa, US) and plurilateral Treaties (Lisbon)

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Protecting WTO GIs in the EU (II)

~~Recognising~~ and protecting WTO GIs : Other products

- ⦿ Labelling Directive 2000/13 (direct effect) + MS Unfair competition laws
Article 2
1. The labelling and methods used must not (a) be such as could mislead the purchaser to a material degree, particularly:
(i) as to the characteristics of the foodstuff and, in particular, as to its nature, identity, properties, composition, quantity, durability, origin or provenance, method of manufacture or production.
- ⦿ Other EC + MS *ad hoc* legislation + International Treaties (Lisbon)

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Other elements

- If you want to be competitive, you must be different (origin, quality, traceability, reputation)
- Benefice : producers, consumers
- GIs = Strategy - > patrimony, source of resources
- In exchange : higher prices ("Manchego" DO 10 \$ = "Manchego" no DO 5,71 \$; Oil GI, 84% more expensive; Rise GI, 0,67 \$ K against 0,30 \$ K)
- "Toscano" (7.000 \$ = T) ; Argentina : "Aceite de Oliva de Catamarca" Do ! "experiencia piloto";
- France : billing 20.000 m euros GIs products

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