The TRIPS Regime on GIs

- Definition (Article 22.1)
- Basic level of protection (Article 22.2-4)
- Additional protection for wines and spirits (Article 23)
- Exceptions (Article 24.3-9)
- Negotiations (Article 24.1)
- National and MFN treatment (Articles 3-5)
- Procedures of acquisition & maintenance of rights if registration is foreseen (Article 62)
- Enforcement (Part III)
- Transition periods
- Dispute settlement
Complaints:

- by the US (WT/DS174/20) and Australia (WT/DS290/18)
- against the EU Regulation 2081/92 on GIs (foodstuffs)

Result:

- EU’s treatment of relationship between GIs and TMs is not in violation of TRIPS (limited co-existence of TMs and GIs),
- but the system discriminates against non-EU GI applicants and thus violates the national treatment obligation under TRIPS
The TRIPS GI regime

- accommodates different manners of implementation (trademark system / *sui generis* system / unfair competition)
- does not require registration as a constitutive element
- accommodates both
  - limited coexistence between earlier TMs and GIs (e.g. EU)
  - strict first-in-time first-in-right approach (e.g. US)
- covered by the WTO Dispute Settlement System
The 1995 compromise in TRIPS: Negotiation Mandates

Negotiations:

- Multilateral Register for wine and spirit GIs (Art. 23.4)
- Not deny negotiations to increase protection of individual GIs (Art. 24.1)
In order to facilitate the protection of geographical indications for wines, negotiations shall be undertaken 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 Members participating in the system.

Members disagree regarding the legal effect and participation in a GI Register.
GI Register Negotiations: The proposals on the table since 2008

- **TN/IP/W/10/Rev.4** by the Joint Proposal Group (Argentina, Australia, Canada, Chile, Costa Rica, Dominican Republic, Ecuador, El Salvador, Guatemala, Honduras, Israel, Japan, Korea, Mexico, New Zealand, Nicaragua, Paraguay, South Africa, Chinese Taipei and the United States) (April 2011) *(Voluntary participation, commitment to consult the register, legal effects only under national law)*

- **TN/IP/W/8** by Hong Kong, China (April 2003) *(Voluntary participation, certain rebuttable legal presumptions)*

- **TN/C/W/52** (para. 1-3 and 9) by the “Modalities Group” (Albania, Brazil, China, Colombia, Croatia, the European Communities, Georgia, Iceland, India, Indonesia, the Kyrgyz Republic, Liechtenstein, Moldova, the Former Yugoslav Republic of Macedonia, Pakistan, Peru, Sri Lanka, Switzerland, Thailand, Turkey, the ACP Group and the African Group) (July 2008) *(Mandatory participation, register information is prima facie evidence for meeting the GI definition, assertions of genericism have to be substantiated)*
2011 progress – a single text

- Development of single negotiating text in consultations of a drafting group since January 2011

- *Easter Package* - Chair’s report in TN/IP/21:
  - Summarizes work done
  - Publishes draft composite text (JOB/IP/3/Rev.1)
GI Extension: the proposal

= Extension of the higher protection of GIs for wines and spirits to GIs for other products

● What do proponents (GI Friends) want? (TN/C/W/52)
  ● Article 23 to apply to all GIs
  ● Article 24 exceptions to apply mutatis mutandis
  ● Multilateral register (of GIs for wines and spirits) to apply to all GIs
  ● Part of Single Undertaking
  ● Linkage and Parallelism
GI Extension: the actors

TN/C/W/52 – Modalities Proposal

**Sponsors:** Albania, Brazil, China, Colombia, Croatia, Ecuador, the European Communities, Georgia, Iceland, India, Indonesia, the Kyrgyz Republic, Liechtenstein, Moldova, the Former Yugoslav Republic of Macedonia, Pakistan, Peru, Sri Lanka, Switzerland, Thailand, Turkey, the ACP Group and the African Group

TN/C/W/60 – Concrete Amendment Proposal

**Sponsors:** Albania, China, Croatia, European Union, Georgia, Guinea, Jamaica, Kenya, Liechtenstein, Madagascar, Sri Lanka, Thailand, Turkey, and Switzerland

**Non-Demandeurs:**

New Zealand, Australia, United States, Canada, Chile, Argentina, Japan, Chinese Taipei (etc.)
State of Play

- TRIPS represents the current consensus on minimum protection standards for GIs and Trademarks
  - defines *how much* GIs can be privileged vis-à-vis Trademarks
- No multilateral consensus on what kind of GI register could bridge the divide between common law and *sui generis* systems
  - currently no progress in WTO negotiations
  - WIPO Lisbon revision remains plurilateral
GI laws notified under Art. 63.2 since 2008
WTO - Trade Policy Reviews (TPRs)

Detailed questions on geographical indications protection in recent TPRs:

- June 2019  Canada
- July 2018  China
- February 2018  Malaysia
- May 2017  Switzerland and Liechtenstein
- April 2017  Mexico
- March 2017  Japan
Questions in Trade Policy Reviews

Detailed scrutiny of national systems:

- relationship between trademarks and GIs
  - how are third-party rights recognized during the registration process?
  - is coexistence possible?
  - what procedures for opposition/cancellation regarding GIs protected and introduced under bilateral treaties?

- What are the criteria for establishing genericism?

- Discussion on new forms of protection
Percentage of FTAs with **Specific** IP Provisions

- Geographical indications
- Trademarks
- Copyright and related rights
- Patents
- Plant variety protection
- Industrial designs
- Trade secrets
- Traditional knowledge/Genetic resources
- Encrypted signals
- Domain names
- Integrated circuits

Source: WTO RTA Database
Momentum in bilateral agreements

The multilateral divide is also reflected in different approaches to bilateral agreements on GIs:

- e.g. EU bilateral treaties focus on registration systems and protection of lists of GIs
  - EU-China „100-plus-100 project“: reciprocal recognition and registration of 100 GIs from each side
  - List approach to bilateral agreements

- e.g. US bilateral treaties focus on safeguarding trademark rights and maintaining generic terms
  - US-China Joint Commission on Commerce and Trade:
    - generic terms are not eligible for protection
    - relationship GIs-TMs handled in accordance with TRIPS
    - Legal means for interested 3rd parties to object to and cancel GIs
    - Adopt disclaimer practice for generic components of GIs
European Union – Korea, Rep. of

Article 10.18
3. Having examined a summary of the specifications of the agricultural products and foodstuffs corresponding to the geographical indications of Korea listed in Annex 10-A, which have been registered by Korea under the legislation referred to in paragraph 1, the European Union undertakes to protect the geographical indications of Korea listed in Annex 10-A according to the level of protection laid down in this Chapter.

4. Having examined a summary of the specifications of the agricultural products and foodstuffs corresponding to the geographical indications of the European Union listed in Annex 10-A, which have been registered by the European Union under the legislation referred to in paragraph 2, Korea undertakes to protect the geographical indications of the European Union listed in Annex 10-A according to the level of protection laid down in this Chapter.
European Union – Korea, Rep. of

<table>
<thead>
<tr>
<th>Article 10.18</th>
</tr>
</thead>
<tbody>
<tr>
<td>6. The European Union and Korea agree that the elements for the registration and control of geographical indications referred to in paragraphs 1 and 2 are the following:</td>
</tr>
<tr>
<td>(a) a register listing geographical indications protected in their respective territories;</td>
</tr>
<tr>
<td>(b) an administrative process verifying that geographical indications identify a good as originating in a territory, region or locality of either Party, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin;</td>
</tr>
<tr>
<td>(c) a requirement that a registered name shall correspond to a specific product or products for which a product specification is laid down which may only be amended by due administrative process;</td>
</tr>
<tr>
<td>(d) control provisions applying to production;</td>
</tr>
<tr>
<td>(e) legal provisions laying down that a registered name may be used by any operator marketing the agricultural product or foodstuff conforming to the corresponding specification; and</td>
</tr>
<tr>
<td>(f) an objection procedure that allows the legitimate interests of prior users of names, whether those names are protected as a form of intellectual property or not, to be taken into account.</td>
</tr>
</tbody>
</table>
Geographical Indication provisions in the CP Trans-Pacific Partnership Agreement

Detailed provisions on IPRs, including geographical indications, with respect to, *inter alia*:

- administrative procedures for filing, recognition and protection of GIs:
- interested parties must have opportunity to object to protection
  - of GIs applied for under national procedures, and
  - for GIs recognized through bilateral treaties
- grounds for refusal must include genericism or confusion with prior trademarks and applications (incl. guidelines for determining genericism)
- Multi-component terms
## GI provisions – safeguarding trademark rights

<table>
<thead>
<tr>
<th>CPTPP</th>
<th>Articles 18.30 – 18.36</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>Article 18.30: Recognition of Geographical Indications</td>
</tr>
<tr>
<td></td>
<td>Article 18.31: Administrative Procedures for the Protection or Recognition of Geographical Indications</td>
</tr>
<tr>
<td></td>
<td>Article 18.32: Grounds of Opposition and Cancellation</td>
</tr>
<tr>
<td></td>
<td>Article 18.33: Guidelines for Determining Whether a Term is the Term Customary in the Common Language</td>
</tr>
<tr>
<td></td>
<td>Article 18.34: Multi-Component Terms</td>
</tr>
<tr>
<td></td>
<td>Article 18.35: Date of Protection of a Geographical Indication</td>
</tr>
<tr>
<td></td>
<td>Article 18.36: International Agreements</td>
</tr>
</tbody>
</table>
Conclusion

Origin branding of products and services in trade has increasingly been recognised as valuable across the globe in the last two decades ….

… but considerable differences persist between countries over the legal means for such origin branding, the relationship with trademarks, and how best to create a truly global framework for GI protection.
wolf.meier-ewert@wto.org

Consult the website
www.wto.org