Protection of Geographical Indications

An Introduction
WHAT DO THE FOLLOWING PRODUCTS HAVE IN COMMON?
Toblerone – le chocolat suisse le plus connu
The Indication “Switzerland”
AND WHAT MAKES THEM DIFFERENT FROM EACH OTHER?

QUALITY? ORIGIN?

• cheese
• chocolate
• knives
• watches
Which ones do not belong to the group?

• Cognac
• Cabernet
• Scotch
• Vodka
• Havana
• Basmati
• Grappa
• Porto
• Champagne
• Bacardi
• Feta
• Darjeeling
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Geographical Indication

In a non-technical sense:

an indication that a given product originates in a given place (country, region, town, etc)
Direct Reference

• Cognac
• Scotch
• Havana
• Grappa

• Porto
• Champagne
• Darjeeling
Indirect reference
Indirect reference
Indirect reference
Indirect reference
Acquired Geographical Meaning

- Muscadet (?)
- Basmati (?)
- Vodka (?)
TERMINOLOGY
Indication of Source

“Indication referring to a country or to a place situated therein as being the country or place of origin of a product”
Appellation of Origin

“The geographical name of a country, region, or locality, which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors” (Lisbon)
Geographical Indication

“Indication which identifies 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” (TRIPS)
Relationship (i)

Indication of Source
Paris, Madrid

Geographical Indication
TRIPS

Appellation of Origin
Lisbon
Relationship (ii)

Geographical Indication
[Indication of Geographical Origin]

Indications of Source
Geographical Indication
TRIPS
Appellation of Origin
Lisbon
Generic Designation

An indication of a place where a given product was originally produced, and which has become the common name of that product.

Determination under national law.
National Protection

• in the absence of any international agreement
• appreciation in accordance with national law and perception by the local consumers
• geographical indication may be
  – distinctive
  – generic
Types of Protection

• protection against unfair competition (passing off)
• Collective or certification marks
• sui generis protection
• administrative systems of protection
Unfair Competition
Passing Off

- showing of an acquired reputation
- likelihood of confusion
  (misappropriation of reputation)
- damage
Trademark Law

- Collective Mark
- Certification Mark
Collective Mark
Certification Mark

STILTON

CERTIFICATION TRADE MARK

\[\text{WOVEN IN THE BRITISH ISLES}\]

\[\text{STILTON CHEESE}\]
Sui Generis Systems

• Protected Appellations of Origin
  – e.g., France
• Registered Geographical Indications
  – e.g., EU, Australia, Switzerland
Administrative Systems

E.g., U.S. (labeling requirements of BATF for wines and spirits)
Geographical Indications

- Collective rights
- No individual owner
- No assignment
- Enforcement
Scope of Protection

• Non-authorized use that is misleading
  – GI is understood as such
  – goods are identical or similar
  – use depends on prior regulatory approval

• Any non-authorized use
  – famous Gis
  – dilution
International Protection

International Treaties:

• bilateral treaties
• multilateral treaties
Bilateral International Treaties

• long tradition (e.g., France since 1895)
  – exchange of lists with protected g.i.
  – conditions for protection

• bind only contracting countries
Multilateral International Treaties

• Paris Convention (1883)
• Madrid Agreement (1891)
  – for the Repression of False or Deceptive Indications of Source on Goods
• Lisbon Agreement (1958)
  – for the Protection of Appellations of Origin and their International Registration
• TRIPS Agreement (1994)
Conflicts

Typical scenario:

“generic designation vs. geographical indication”
Conflicts

• Point of view of TM Law
• Point of view of Law on Geographical Indications
Trademark Law

• Geographical signs cannot constitute trademarks, unless
  – secondary meaning
  – arbitrary
Unfair Competition

“Swiss Chalet Chocolate”
Collective or Certification Marks

- Rocquefort Cheese”
- Darjeeling Tea
Sui Generis Systems

- Protected Appellations of Origin
- Registered Geographical Indications
- Different possible solutions
  - priority to TM
  - priority to GI
  - co-existence
Administrative Systems

Regulate use of geographical indications
Lisbon Agreement

- **No Co-existence** between TMs and geographical indications.
- **Refusal of Protection** (Article 5(3)) or invalidation, or prevention of use in a form different from an aao.
TRIPS Agreement

• Exclusive TM rights (Article 16)
  – exception (Article 17)

• Exclusive GI rights (Article 22 & 23)
  – exceptions referring to TMs (Article 24)
    • 24.5 (prior TM rights)
    • 24.7 “preclusion”