



REPORT

WIPO Worldwide Symposium on Geographical Indications Bangkok, 27-29 March 2013

Report by Tom Reid, Secretary Special Committee Q220 – Geographical Indications

1. The Symposium was jointly organised by WIPO and the Department of Intellectual Property of Thailand. It was well-supported by WIPO, as demonstrated by the attendance of Wang Binying, a Deputy Director General of WIPO, Matthijs Gueze, Head of the Lisbon Registry. It was also well-supported by the host country, as demonstrated by the attendance of the Minister of Commerce.
2. The Symposium comprised two days of seminars, followed by an excursion on the third day to a local region where products protected by a geographical indication are produced. I attended the two days of seminars. A copy of the final program is attached. Copies of the speakers' presentations are available on the WIPO website at http://www.wipo.int/meetings/en/details.jsp?meeting_id=28143.
3. As a Symposium, the event was oriented towards updating attendees on developments and issues in relation to geographical indications (**GIs**) and appellations of origin (**AOs**) throughout the world. It was not a forum for direct policy-setting or advocacy.
4. The presentations generally could be divided into two types, as follows.
 - a. Presentations from speakers representing national or international law and policy organisations, including:
 - i. at an international level, WIPO, the WTO, and the United Nations Industrial Development Organization (UNIDO); and
 - ii. at a national level, the State Administration for Industry and Commerce (SAIC) of China, the Department of Intellectual Property of Thailand, the Ministry of Commerce and Industries of Panama, the Moroccan Industrial and Commercial Property Office (OMPIC), the National Intellectual Property Center (SAKPATENTI) of Georgia, and the National Institute for Industrial Property (INAPI) of Chile.
 - b. Presentations from speakers representing producer organisations who rely on GI protection. Such speakers commonly also presented on the system of registration for GIs and AOs in their country, and issues arising in that country in relation thereto. Presentations of this kind were given by speakers representing:
 - i. the Malaysian Pepper Board;

MEMBERS OF THE BUREAU:

John Bochnovic (Canada), Felipe Claro (Chile), Stephan Freischem (Germany), Thierry Calame (Switzerland), Gunnar Baumgärtel (Germany), Laurent Thibon (France), Sarah Matheson (Australia), John Osha (United States of America), Bruce Morgan (Canada)

ASSISTANTS SECRETARY GENERAL:

Renata Righetti (Italy), Sergio M. Ellmann (Argentina), Karen Abraham (Malaysia)

ASSISTANTS REPORTER GENERAL:

Kazuhiro Yoshida (Japan), Sara Ulfssdotter (Sweden), Anne Marie Verschuur (The Netherlands)

- ii. the Sri Lanka Tea Board;
- iii. the Consortium Parmigiano Reggiano;
- iv. Napa Valley Vintners;
- v. Forge de Laguiole; and
- vi. the Scotch Whisky Association.

There were also speakers from organisations that generally advocate for greater protection for GIs while not representing specific producers, being oriGIn, MARQUES (the European Association of Trade Mark Owners), and the European Communities Trademark Association.

5. Matthijs Geuze provided an update on negotiations in the Working Group to revise the Lisbon Agreement. At present, there are 27 states members of the Lisbon Agreement. There have been 914 registrations in the International Register of AOs administered by WIPO, of which 809 are currently in force. By far the largest source of registrations is France, with 509 of the 809 current registrations. The next largest source is the Czech Republic, with 76.
6. Notable countries that are not members of the Lisbon Agreement include the USA, the UK, Germany, Canada and Australia. The mandate of the Working Group is to identify revisions that might attract wider participation in the Lisbon Agreement.
7. The principal areas of focus are refinement and modernisation of the legal framework, the ability for intergovernmental organisations to accede to the Agreement, and extending protection to GIs. To that end, the Working Group has produced a draft revised text of the Lisbon Agreement. Notable issues highlighted by Mr Geuze in relation to the draft text on which AIPPI may wish to have input are as follows.
 - a. Protection for GIS: the draft revised text defines GIs and AOs, and for the first time extends protection to GIs. Mr Geuze noted, however, that in practice member states have been registering and protecting what are treated at the national level as GIs (in that the goods they protect do not have the requisite connection to the geographical environment such that the GI would qualify as an AO under the Lisbon Agreement definition). The definition of GI generally reflects that in Article 22(1) of TRIPS.
 - b. Trans-border GIs and AOs: Article 5(4) of the draft revised text permits the member states concerned to file separate applications for registration of a GI or AO applying to a trans-border geographical area, or to file a joint application.
 - c. Prior use: Mr Geuze discussed Article 17 of the draft text. Where a third party has been using a GI or AO in respect of which registration is now sought as a generic term, Article 17 which permits the member state to grant to the third party a phase-out period. Mr Geuze's view is that a phase-out period would not apply in respect of terms comprising or contained in trade marks, which are protected by Article 13 (see below) unless the term is disclaimed in the trade mark registration on the basis that it is generic. Article 17 is expressly without prejudice to the possibility of refusing the application to register the GI or AO altogether. AIPPI's Resolution Q191 – Relationship between trademarks and geographical indications does not deal directly

with terms in generic use in a country. There is an opportunity for AIPPI to express its view here.

- d. Conflicting trade marks: Mr Geuze discussed provision in respect of both applications for trade mark registration sought before the registration of a GI, and applications sought after such registration.
 - i. Article 13 of the draft text requires member states to:
 1. 'respect' pre-existing trade mark rights, including unregistered rights acquired through use;
 2. 'take into account the legitimate interests of the owner of the prior trademark as well as those of the beneficiaries of the rights in the appellation of origin or the geographical indication'; and
 3. 'not prejudice the eligibility for, or the validity of, the registration of the trademark, or the right to use the trademark, on the basis that such a trademark is identical with, or similar to, the denomination or the indication'.

In my opinion, this is consistent with paragraph 4 of AIPPI's Resolution Q191. However, see paragraph ii below.

- ii. Where registration of a trade mark that would conflict with an existing registered GI or AO is sought, two options are under consideration:
 1. the registration of a trade mark containing or consisting of a registered GI or registered AO will be refused in respect of goods not originating in the relevant geographical area, and may be refused in respect of goods originating in the relevant geographical area that do not comply with any other requirements for use of the GI or AO; or
 2. the registration of a trade mark will be refused where its use would correspond to the scope of protection offered in respect of a registered GI or AO.

These options will be considered at the Working Group's seventh session. In my opinion, there is an opportunity for AIPPI to be involved in defining when a later trade mark will conflict with an existing registered GI or AO such that registration of the trade mark should be refused, bearing in mind the principles in paragraphs 2 and 4 of Resolution Q191 that the aim of protecting GIs should be to prevent practices liable to mislead the public or misappropriate the reputation of the GI (if any), taking into account (i) the respective reputations of the GI and the trade mark, (ii) the length of time for which each case been used, (iii) the extent and *bona fides* of each usage, (iv) the likelihood and degree of any confusion, and (v) any acquiescence.

I note also that in both options, the draft text requires the member state to 'refuse or invalidate' the registration of the trade mark (emphasis added). It appears the intent is that member state will revoke trade mark registrations that were incorrectly obtained after the registration of a relevant GI or AO. Strictly,

though, the draft text could be said to require member states to 'invalidate' even pre-existing trade mark registrations, which would potentially conflict with Article 13.

8. Timing: Mr Geuze said that the Working Group is working towards finalising the draft text in time for it to be adopted in 2014 or 2015. While that timeframe may be ambitious (in my opinion, having regard to the reports from Ms Collada and Mr Sironi of their attendance at recent sessions of the Working Group), AIPPI should nonetheless act quickly if it wishes to ensure it will be heard.
9. A debate in the final session of the Symposium highlighted some of the difficulties in achieving a harmonised approach to GIs worldwide. The session was chaired by Marcus Höpferger of WIPO and included Craig Thorn (Senior Advisor, Consortium for Common Food Names, USA) and Loretta Dormal-Marino (Deputy Director General, International Affairs, Directorate-General for Agriculture and Rural Development, European Commission). Mr Thorn generally represented the 'new world' perspective and Ms Dormal-Marino the 'old world' perspective in relation to terms that are said to be 'generic' in the new world country. Mr Höpferger pointed out that while GIs sometimes involve 'clawing back' terms that have been in common generic usage in a country, that is not necessarily a bad result if there is a quid pro quo in the form of better market access. Mr Thorn agreed that in the case of wines and spirits, the EU had something to offer in return, in the form of better access to EU markets for for US winemakers. He queried, though, whether the EU can offer the same benefit in respect of other products, such as cheese. All representatives agreed, however, that the number of terms in dispute is relatively small, and that there ought to be avenues to resolve the present difficulties. An example relates to 'Emmenthal' cheese – the EU allowed a concession to certain French producers who had established a tradition of making cheese under that name to continue doing so, albeit that the cheese originates from Emmenthal in Switzerland (query, though, whether the same would have occurred if Switzerland were a member of the EU).
10. Other matters of interest coming out of the Symposium are as follows.
11. It remains the case that systems for protection of GIs are patchy and not at all harmonised. Many countries that are not members of the Lisbon Agreement nonetheless offer protection for GIs through *sui generis* legislation (such as Malaysia and Thailand). Others offer protection through trade mark and unfair competition law (such as China). As an organisation that has as its objective the harmonisation of intellectual property law, there is significant potential work for AIPPI in this area.
12. While WIPO speakers acknowledged that there is little empirical research on GI protection around the world, and so comprehensive data are lacking, it also remains the case that generally speaking, the great majority of registrations protecting GIs in countries outside the EU relate to GIs of the country concerned. For example, in Thailand only 8 of 46 registrations and 14 of 93 pending applications for registration are for non-Thai GIs. In China, only 42 of 1,754 GIs protected through China's trade mark system are for non-Chinese GIs.
13. Negotiations in the WTO in relation to GIs are in difficulties. According to Thu-Lang Tran Wasescha, Counselor, Intellectual Property Division of the WTO, GIs are one of the most emotional issues. There is a fundamental disagreement as to whether TRIPS provides any mandate for extending higher levels of protection to products other than wines and spirits, which has held up negotiations in relation to a multilateral register. (Recent news reports

have suggested negotiators will attempt to separate negotiations for a multilateral register in relation to wines and spirits from other negotiations in an effort to achieve some progress. Also, the fate of negotiations in relation to TRIPS are linked to the fate of the Doha Round generally.)

14. WIPO has been running a pilot development program to assist producers to protect their GIs. The countries selected for the pilot program were Panama, Thailand and Uganda. The UNIDO has also assisted with the establishment of projects to assist producers in developing countries to protect their GIs. For example, Italy assisted producers in Peru under the auspices of UNIDO.
15. There were some 'success stories' of 'new world' countries that have benefited from extending protection to GIs. For example, Panama recently introduced protection for certification trade marks as a result of a free trade agreement with the US. GIs registered in Panama as certification trade marks include Café de Palmira for coffee, Mola Kuna for particular handicrafts, and Pina de la Chorrera for pineapples. Another example is Chile, which as a result of entering into an agreement with the EU in relation to GI, has had success protecting its own in the EU (the example given was a GI concerning lemons grown in areas of the Atacama Desert).
16. SAKPATENTI, the National Intellectual Property Center of Georgia, takes an interesting approach to GIs. Georgia is a member of the Lisbon Agreement and also party to a relevant treaty with the EU. SAKPATENTI registers and enforces Georgian GIs in Georgia and elsewhere on behalf of Georgian producers, and bears the costs of doing so. It considers this use of taxpayer funds to be a good investment in the Georgian economy, bearing in mind that in many cases the producers themselves would not have the funds, or the necessary degree of organisation, to take registration and enforcement action themselves.

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