

COMMENTS ARIPO'S DRAFT LEGAL FRAMEWORK FOR THE PROTECTION OF GEOGRAPHICAL INDICATIONS

Introduction

The INTA GI committee, under the lead of the Existing Rights/Enforcement Subcommittee (hereinafter “the INTA Subcommittee”), supports the general approach taken in, as well as the general structure and content of, the *ARIPO Draft Legal Framework for the Protection of Geographical Indications* (hereinafter “ARIPO Draft Legal Framework”).

The provisions of the ARIPO Draft Legal Framework appear to meet the minimum protection required by Article 22 and Article 23 of the TRIPS Agreement. The minimum requirements of the TRIPS Agreement are compared with the provisions of the ARIPO Draft Legal Framework below.

About INTA:

Founded in 1878, INTA is the world’s oldest and largest brand owners association. With a membership of over 7,200 companies, INTA represents over 31,000 trademark professionals in diverse capacities: multinational corporations, businesses of all sizes, law firms and other professionals, academic institutions, and not-for-profit organizations from 190 countries. The mission of INTA is to encourage and support best practices and excellence in the field of trademarks and intellectual property, and protection of rights for brand owners and consumers, as well as foster economic growth and innovation through awareness of the importance and development of brands. INTA is dedicated to the support and advancement of trademarks and related intellectual property rights as elements of fair and effective national and international commerce. To achieve this goal, INTA recently unveiled its new Strategic Plan. The 2018-2021 Strategic plan is articulated around the following areas namely: 1) Promote the value of Trademarks and Brands, 2) Reinforce Consumer Trust and 3) Embrace Innovation and Change.

1) General comments to the ARIPO Draft Legal Framework

For a legal framework to be effective, there are certain benchmarks that should be attained. The ARIPO Draft Legal Framework obliges Member States to establish accessible and appropriate

enforcement and dispute resolution mechanisms, which include remedies to prevent and deter infringement of geographical indications.

A. Need to harmonize national laws

The first limitation is likely to be that the current laws of many Member States are not uniform and/or many Member States lack national GI policies (which means that GI protection has not been appropriately incorporated into the overall development policies and programmes). Consequently, ARIPO will need to promote and encourage Member States to develop harmonized national GI protection systems which accord with the Legal Framework.

B. Support implementation and operationalization

The second limitation is likely to be that of implementation and operationalization of the Legal Framework, particularly in so far as the requirement for Member States to provide effective enforcement frameworks nationally is concerned. Many Member States do not possess the conformity assessment and enforcement mechanisms for GI protection and monitoring. Therefore, enforcement of the existing laws remains a challenge for Member States.

By comparison, the lack of harmonization of national laws with ARIPO's legal instruments and the absence of a compulsive force by ARIPO to enforce compliance by Member States with specific legal frameworks, have been some of ARIPO's challenges. An example hereof can be found in the ARIPO trademark system (under the framework of the Banjul Protocol) which has been marred by the same challenges.

The use of GIs appears to have the potential to propel economic development in Africa, but effective GI policies and strategies face a number of challenges (limited resources, inadequate legal and institutional frameworks for GI protection) in the region. In this regard, it is therefore recommended that ARIPO undertakes a raising awareness program amongst its members, identify appropriate products and conduct cost-benefit analyses prior to bringing the well-intentioned and largely TRIPS compliant GI Legal Framework into law.

2) Specific comments to the ARIPO Draft Legal Framework

A. Article 22(1) of the TRIPS Agreement provides as follows:

22 (1) *Geographical indications are, for the purposes of this Agreement, indications which identify 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;*

A comparable provision in the ARIPO Draft Legal Framework is Section 2, read with Sections 3.2 – 3.3, which defines geographical indications as follows:

2. *“geographical indication” means an indication which identifies a good as originating in the territory of a state, 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;

- 3.2. Geographical indications may refer to agricultural and fisheries product, foodstuffs and beverages and product of the rural economy and goods whose unique characteristics are essentially attributable to a particular geographical area.
- 3.3. Indications that qualify as geographical indications include geographical names, non-geographical names [and figurative designs] or a combination thereof that meet the definition set out in Section 2.

Comments

Although the provisions in the ARIPO Draft Legal Framework appear to meet the minimum protection required by TRIPS, Section 4.1 of the ARIPO Draft Legal Framework goes further in providing greater detail about the elements considered attributes that constitute the quality, reputation or other characteristic of a good, namely:

- 4.1. *Attributes of a good that constitute a quality, reputation or other characteristic of the good within the definition of a geographical indication include:*
 - a) *physical, chemical, microbiological and organoleptic attributes;*
 - b) *know-how or savoir faire, production methods and traditional practices employed by producers;*
 - c) *renown of the product in its locality of production whether or not it is also renowned in a wider area;*
 - d) *traditional knowledge;*
 - e) *product of traditional animal breeds and of traditional plant varieties;*
 - f) *any other appropriate attribute of the good.*

B. Articles 22(2) and (4) of the TRIPS Agreement provides as follows:

- 22 (2) *In respect of geographical indications, Members shall provide the legal means for interested parties to prevent:*
 - (a) *the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good;*
 - (b) *any use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention (1967).*
- 22 (4) *The protection under paragraphs 1, 2 and 3 shall be applicable against a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory.*

A comparable provision in the ARIPO Draft Legal Framework is Section 9, which provides that:

9. *A geographical indication entered in the Register is protected in the territories of the Contracting States against the following uses in respect of goods that are not produced in conformity with the product specification:*
 - a) *any commercial use of a registered name for comparable products, as well as other uses that exploit the reputation of a geographical indication;*
 - b) *any misuse, imitation or evocation, even if it is used:*
 - i. *in connection with an indication of the true origin of the product in question;*
 - ii. *in translation, transcription or transliteration;*
 - iii. *together with words such as "kind", "type", "style", "imitation", "method", or similar words or expressions.*
 - c) *any other false or misleading indication as to the provenance, origin, nature or essential qualities of a like product;*
 - d) *any other practice liable to mislead the consumer as to the true origin of a like product.*

In addition, sections 11.1 – 11.2 of the ARIPO Draft Legal Framework provide as follows:

- 11.1. *ARIPO and the Contracting Parties shall protect against misuse in connection with the marketing of goods the following terms and acronyms:*
 - a) *"Geographical Indication", "Geographical Indication of ARIPO" "Geographical Indication of 'State'", "GI-ARIPO" and "GI-'State'" where 'State' is the name of a Contracting State;*
 - b) *"Appellation of Origin", "Appellation of Origin of ARIPO", "Appellation of Origin of 'State'", "AO-ARIPO" and "AO-'State'" where 'State' is the name of a Contracting State.*
- 11.2. *ARIPO Office [may][shall] approve a figurative device corresponding to the terms in paragraph 1(a) and a second figurative device corresponding to the terms in paragraph 1(b), which if approved, shall be protected against misuse by the Contracting Parties.*

Comments

The provisions in the ARIPO Draft Legal Framework appear to meet the minimum protection required by TRIPS. However Section 9 a) on commercial use raises a question as to how should potential prior commercial rights – if any – in earlier trademark be considered.

C. Article 22(3) of the TRIPS Agreement provides as follows:

- 22 (3) *A Member shall, ex officio if its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in that Member is of such a nature as to mislead the public as to the true place of origin.*

A comparable provision in the ARIPO Draft Legal Framework is sections 15.1 – 15.2 which provide that:

- 15.1. *The Contracting States shall ensure that accessible and appropriate enforcement and dispute resolution mechanisms, sanctions and remedies are available where there is a breach of the provisions relating to the protection of geographical indications.*
- 15.2. *The national competent authority shall be entrusted with the task of advising and assisting holders of registered geographical indications communities who are beneficiaries of geographical indications in defending and enforcing their rights and instituting civil and criminal proceedings, where appropriate and when requested by the holders and communities concerned.*

In addition, section 12.1 provides that:

- 12.1. *A geographical indication shall not be registered, or if registered shall be cancelled, if at the date of application one of the following grounds for ineligibility applied:*
- a) *the geographical indication proposed for registration is generic, being the common name for the class of goods in one or more of the territories of the Contracting States;*
 - b) *the geographical indication proposed for registration is shown to conflict with one of the established rights listed in paragraph 2 in one or more of the territories of the Contracting States for the same type of goods, provided the said established right has used for a continuous period of not less than [10] years, and be of such renown, that, if the geographical indication were to be registered, consumers would be misled as to the identity of the product described by the proposed geographical indication.*

Further, sections 7.1 (b) and 7.2 provide that:

- 7.1. *The procedure for treatment of applications for registration of a geographical indication shall be as follows:*
- ...
- b) *Within one (1) month of receipt of a complete application the national competent authority shall notify ARIPO Office of the proposed geographical indication, the product category of the good and the country of production of the good. ARIPO Office shall publish the information as well as the date of receipt of the application by the national competent authority and invite comments on and statements of opposition to the proposed application for a period of four (4) months.*
- 7.2. *Requests for amendments or withdrawal of registered geographical indications shall follow the same procedure mutatis mutandis. In such a case, ARIPO shall amend the register and the application associated with the registered geographical indication, as appropriate.*

Comments

The provision in the ARIPO Draft Legal Framework appears to meet the minimum protection required by TRIPS. We note that Section 12.1 b) adds a 'fame' component with a very long continuous use period for a trademark owner without prior rights to prevail.

D. Article 23 of the TRIPS Agreement provides as follows:

- 23 (1) *Each Member shall provide the legal means for interested parties to prevent use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like.*
- 23 (2) *The registration of a trademark for wines which contains or consists of a geographical indication identifying wines or for spirits which contains or consists of a geographical indication identifying spirits shall be refused or invalidated, ex officio if a Member's legislation so permits or at the request of an interested party, with respect to such wines or spirits not having this origin.*

A comparable provision in the ARIPO Draft Legal Framework is section 9, which provides that:

9. *A geographical indication entered in the Register is protected in the territories of the Contracting States against the following uses in respect of goods that are not produced in conformity with the product specification:*
- a) *...*
 - b) *any misuse, imitation or evocation, even if it is used:*
 - i. *in connection with an indication of the true origin of the product in question;*
 - ii. *in translation, transcription or transliteration;*
 - iii. *together with words such as "kind", "type", "style", "imitation", "method", or similar words or expressions.*

In addition, Sections 12.2 and 12.4 of the ARIPO Draft Legal Framework provide as follows:

- 12.2. *The rights referred to in this Section, subject to such being protected in law in the territory of the Contracting State concerned, may be:*
- a) *a trade mark,*
 - b) *an animal breed name,*
 - c) *a geographical indication, or*
 - d) *a plant variety name.*
- 12.4. *The rights referred to in paragraph 2 that are applied for after the date of application for the geographical indication for the same type of product, which conflict with the protection of a geographical indication laid down in Section 9, may not be registered nor established by use, and if registered they shall be invalidated.*

Comments

Although the provisions in the ARIPO Draft Legal Framework appear to meet the minimum protection required by TRIPS, it is noteworthy that the ARIPO Draft Legal Framework does not make provision in respect of the case of homonymous geographical indications (as envisaged in Article 23(3) of TRIPS).

E. Article 24 of the TRIPS Agreement provides as follows:

- 24 (1) *Members agree to enter into negotiations aimed at increasing the protection of individual geographical indications under Article 23...*
- 24 (5) *Where a trademark has been applied for or registered in good faith, or where rights to a trademark have been acquired through use in good faith either:*
- (a) *before the date of application of these provisions in that Member as defined in Part VI; or*
 - (b) *before the geographical indication is protected in its country of origin; measures adopted to implement this Section shall not prejudice eligibility for or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication.*
- 24 (6) *Nothing in this Section shall require a Member to apply its provisions in respect of a geographical indication of any other Member with respect to goods or services for which the relevant indication is identical with the term customary in common language as the common name for such goods or services in the territory of that Member. Nothing in this Section shall require a Member to apply its provisions in respect of a geographical indication of any other Member with respect to products of the vine for which the relevant indication is identical with the customary name of a grape variety existing in the territory of that Member as of the date of entry into force of the WTO Agreement.*
- 24 (8) *The provisions of this Section shall in no way prejudice the right of any person to use, in the course of trade, that person's name or the name of that person's predecessor in business, except where such name is used in such a manner as to mislead the public.*

Comparable provisions in the ARIPO Draft Legal Framework are Sections 16.4, 12.1 – 12.3 and 12.5 which provide that:

- 16.4 *ARIPO Office may enter into negotiations with international organisations and bodies such as WIPO, OAPI and EU and foreign countries that manage systems of protection for geographical indications with a view to facilitating the protection in foreign countries of registered geographical indications of the Contracting States as well as the protection of foreign geographical indications in the territories of the Contracting States.*
- 12.1. *A geographical indication shall not be registered, or if registered shall be cancelled, if at the date of application one of the following grounds for ineligibility applied:*
- a) *the geographical indication proposed for registration is generic, being the common name for the class of goods in one or more of the territories of the Contracting States;*
 - b) *the geographical indication proposed for registration is shown to conflict with one of the established rights listed in paragraph 2 in one or more of the territories of the Contracting States for the same type of goods, provided the said established right has used for a continuous period of not less than [10] years, and be of such renown, that, if the geographical indication were to be registered, consumers would be misled as to the identity of the product described by the proposed geographical indication.*
- 12.2. *The rights referred to in this Section, subject to such being protected in law in the territory of the Contracting State concerned, may be:*
- a) *a trade mark,*

- b) *an animal breed name,*
- c) *a geographical indication, or*
- d) *a plant variety name.*

12.3. *In respect of any right referred to in paragraph 2 above applied for or registered in good faith or established by use, prior to the date of application of the geographical indication, that does not prevent the registration of the geographical indication pursuant to paragraph 1(b) above, both the said established right and the geographical indication shall coexist and may be used in accordance with the respective rights of use, provided each is used in a non-misleading manner.*

12.5. *Nothing in this Legal Framework shall prevent the use in good faith of:*

- a) *A person's name or that of a predecessor in business;*
- b) *The name of a country in conformity with rules of origin;*
- c) *fair use*

Comments

The ARIPO Draft Legal Framework appears to meet the minimum protection required by TRIPS but seems to implement a fame and extended use requirements on owners of prior existing trademarks that may be in conflict with a newer GI.

Conclusion

INTA is pleased to have the opportunity to submit comments to the ARIPO Draft Legal Framework for the Protection of Geographical Indications. If you have any questions, do not hesitate to revert to Tat-Tienne Louembe, Representative, Africa and the Middle East tlouembe@inta.org