International Trademark Association

Comments

“Geographical Indications Manual -- Preliminary Draft”

National Institute of Industrial Property of Brazil

10 April 2020

The International Trademark Association (INTA) would like to thank the National Institute of Industrial Property (INPI) for the opportunity to provide comments on its preliminary draft of the official Geographical Indications (“GIs”) Manual (“Manual”).

INTA is a global association of brand owners and professionals dedicated to supporting trademarks and related intellectual property (IP) to foster consumer trust, economic growth, and innovation. INTA’s members are more than 7200 organizations from 187 countries, including 89 in Brazil. INTA members collectively contribute almost US$12 trillion to global GDP annually. The Association’s member organizations represent some 31,000 trademark professionals and include brand owners from major corporations as well as small- and medium-size enterprises, law firms and non-profits, government agencies, academics and students.

INTA undertakes advocacy work throughout the world to advance trademarks and related rights, and offers educational programs and informational and legal resources of global interest. Headquartered in New York City, INTA also has offices in Brussels, Shanghai, Singapore, Santiago de Chile and Washington D.C. and a representative in New Delhi.

Further information about our Association can be found at www.inta.org.

INTA respectfully submits the following comments on the Manual:

I. General Comments

INTA’s position with regard to the protection of geographical indications is grounded on the principle of “first in time, first in right,” which in turn is based on the well-established principles of territoriality, exclusivity, priority, and good faith when resolving conflicts between geographical indications and trademarks, including collective and certification marks, as enshrined in INTA’s 2019 Board Resolution on ‘Protection of Geographical Indications’

INTA recommends that any regulation of geographical indications to have effective and transparent mechanisms for addressing: (i) applications for geographical indications, applications for amendments, and applications for cancellation; and (ii) effective opposition, cancellation, and notification procedures that recognize pre-existing trademark rights with which geographical indications might conflict or cause confusion.
II. Specific Comments

1. Item 2.5 of the Manual and ‘First in Time, First in Right’ Principle

Item 2.5 of the Manual extensively explains and uses several examples in order to differentiate trademarks from GIs. However, the Manual does not include a statement that the registration of GIs should not prejudice prior intellectual property rights such as trademarks, and vice-versa.

Due to the extensive differentiation between trademarks and GIs, INPI should consider that prior intellectual property rights between one of these categories shall not hinder the other category’s application.

Thus, INTA concludes that, in the end of this section, the Manual should, in line with the well-established ‘first in time, first in right’ principle, indicate that the registration and enforcement of rights in GIs should not prejudice other existing intellectual property rights such as trademarks, including collective and certification marks, and vice-versa.

2. Inclusion of a Transparent GI Registration Cancellation Mechanism

INTA welcomes that the Manual includes an express reference to the Law No. 12.527/11 (Brazilian Law regarding access to information) determining that all information regarding a GI’s registration is to be publicized on INPI’s website and Official Journal, which is the current standard applied to all IP assets. INTA also welcomes that administrative procedures for a GI application, amendment and opposition are included and clear.

However, INTA would welcome the creation by INPI of administrative proceedings (such as the administrative nullity proceedings), in order to allow any party with a legitimate interest to challenge a GI registration that was unduly granted.

In terms of specific grounds for cancellation, as with grounds for opposition, INTA believes it is important that the specific grounds of objection include the following:

1. The geographical indication conflicts with a prior trademark and therefore should be cancelled.

2. The geographical indication is identical with a term customary in common language as the common name for such goods or services in Brazil, and therefore should be cancelled (as provided by the Trade-related Aspects of Intellectual Property Rights Agreement – TRIPS).

3. The scope of protection of the geographical indication if it continued to be registered would be such that it would potentially impair the free use of a common name of a product in the market and therefore should be cancelled, or, in the alternative, continued to be registered with a clear statement that the scope of protection of the geographical indication is such that it would not impair the free use of the common name of the product.
3. Items 8-2 to 8-4 and Preliminary Examination, Publication, Objections and Merit Examination

Item 8.2 of the Manual discusses preliminary examination of the application for protection of the geographical indication. INTA highly recommends that preliminary examination includes:

1. an examination as to whether the geographical indication, if protected, would infringe or violate any third-party trademark rights; and

2. an examination as to whether the geographical indication corresponds to a common name for the goods or services.

If either of these situations occurs, it is recommended that the geographical indication be denied protection.

Item 8.3 provides for the publication of the geographical indication to allow third-parties to object to the protection of the geographical indication. This is then followed by the Merit Exam process, as described in Item 8.4 and following, where a decision is made with respect to the objections that were filed. INTA believes it is important that the specific grounds of objection would include:

1. that the geographical indication conflicts with a prior trademark and therefore should be rejected;

2. that the geographical indication corresponds to the common name of the product and therefore should be rejected;

3. that the scope of protection of the geographical indication if registered would be such that it would potentially impair the free use of a common name of a product in the market and therefore should be rejected, or, in the alternative, registered with a clear statement that the scope of protection of the geographical indication is such that it would not impair the free use of the common name of the product.

4. Item 9 and Post-Registration Amendment of Protected Geographical Indications

Item 9 deals with, in part, the possibility of amending a geographical indication following registration. It is noted that Item 9.5 anticipates that the protected geographical indication itself can be amended through the post-registration amendment process. INTA recommends, in those instances where the geographical indication itself is amended, that the preliminary examination of the amended geographical indication is made to ensure that it does not, in its amended form, conflict with a prior trademark or would consist or impair the use of a common food name. Following preliminary review, the amended geographical indication should be re-published giving third-parties the opportunity to object. The geographical indication would then undergo merit review.

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INTA would like to thank, once again, the INPI for the opportunity to provide these comments and remains at your disposal for any question it may have on the above comments or any other point. Should you wish to further discuss any of the points we have raised or additional issues, please contact José Luis Londoño, Chief Representative Officer-Latin America at jlondono@inta.org and Hadrien Valembois, INTA Policy Officer-Europe at hvalembois@inta.org.