

Protection of Geographical Indications

November 2019

Sponsoring Committee:
Geographical Indications Committee

RESOLUTION:

WHEREAS, the International Trademark Association (“INTA”) has reviewed the principal international treaties and agreements requiring protection of geographical indications, which are generally defined as terms that identify a product as originating in a territory, region, or locality where certain qualities, reputation or other characteristics of the goods are essentially attributable to their geographical origin;

WHEREAS, INTA recognizes that trademarks and geographical indications are separate intellectual property rights and supports the protection of geographical indications under national laws and international treaties and agreements, in line with Article 1(1) of TRIPS;

WHEREAS, any system for the registration and enforcement of rights in geographical indications should not prejudice other existing intellectual property rights such as trademarks, including collective and certification marks and trademarks with geographical significance; and

WHEREAS, names with a geographical connotation or significance may be or may become generic, and different criteria may apply depending on the jurisdiction, language, history, and marketplace circumstances in determining whether a term is or has become generic.

BE IT RESOLVED, that the International Trademark Association reaffirms its support of the principle of “first in time, first in right” 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 ;

BE IT FURTHER RESOLVED, that any regulation of geographical indications must 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;

BE IT FURTHER RESOLVED, that trademark rights holders and other relevant parties such as governmental bodies, trade associations, or individual traders with legitimate interests in the use of a geographical indication and/or prior rights, must have standing to oppose, seek

amendment,
or seek cancellation of geographical indications; and

BE IT FURTHER RESOLVED, that names with a geographical connotation or significance that are or have become generic terms in a jurisdiction should not be impaired by geographical indication protection in that jurisdiction.

BACKGROUND:

In September 1997, INTA adopted a resolution on the 'Protection of Geographical Indications and Trademarks'. The resolution focused on the potential for conflicts between the protection of geographical indications ("GIs") and trademarks and confirmed that INTA supports the principle of "first in time, first in right" priority when conflicts arise. The 1997 resolution covers mainly the 'first in time, first in right' principle but also includes, in its 'background section', the definition of a GI. Over several committee terms, the GI Committee has worked to identify new issues related to GIs and to attempt to reach consensus on INTA's current position to allow the Committee to draft a revised GI resolution that reiterates the definition of a GI, continues to recognize "first in time, first in right" principles but also recognizes the existence of both GIs and trademarks, the various existing approaches to protect them, the need for appropriate enforcement mechanisms for stakeholders and trademark owners, and fair use principles in situations where terms may be considered generic terms. INTA continues to develop a position on expanding the scope of GI protection beyond goods, the creation of an international register of recognized GI's, and the use of geonames in gTLDs but those issues are beyond the scope of this revised GI resolution.

INTA supports the protection of GIs as an intellectual property right as it does for trademarks, designs and other related intellectual property rights ("IPRs"). Both GIs and trademarks will continue to exist globally and conflicts between these rights must be resolved pursuant to the well-established principles of territoriality, exclusivity and priority.

INTA acknowledges the importance of GI protection and notes that the number of protected GIs continues to rise. Approximately 200 GIs are protected in Africa; 3000 in Asia; 70 in Central America; almost 4000 in Europe; 300 in North America; 100 in Oceania; 400 in South America¹

Geographical Indications - Definition

Geographical Indications (GIs) are protected under the Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement as an intellectual property right under the jurisdiction of the World Trade Organization (WTO). *"Geographical Indication" encompasses many concepts, including, but not limited to, "indications of source" and "appellations of origin". As defined by TRIPS, "geographical indications are ... indications which identify a good as originating in a territory... 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."* (Article 22(1)).

Appellations of origin are protected under the Lisbon Agreement for the Protection of Appellations of Origin through registration under the jurisdiction of the World Intellectual Property Organization (WIPO). Appellation of origin *"means the geographical denomination of a country, region, or locality, which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors"* (Article 2(1)). Furthermore, *"the country of origin is the*

country whose name, or the country in which is situated the region or locality whose name, constitutes the appellation of origin which has given the product its reputation” (Article 2(2)).

GIs generally protect agricultural products, foodstuffs, wines and spirits, handicrafts, and industrial products. A GI is not a trademark with geographical significance, such as NORTH POLE for Bananas or HYDE PARK for men’s suits, nor is it a generic term such as Swiss cheese.

Geographical Indications - Protection

Different approaches to GI protection are based on historical, economic, sociological and even philosophical considerations and often reflect traditions and local practices, especially for GIs in the foodstuffs, agriculture, wine and spirits sectors. In accordance with the territoriality principle, and in line with Article 1(1) of TRIPS that stresses that “members shall be free to determine the appropriate method of implementing the provisions of this Agreement within their own legal system and practice”, various countries and regions have adopted a variety of mechanisms for the protection of geographical indications, including sui generis registries, single-purpose laws, collective marks, and certification marks. Such rights may exist in parallel or in combination, thereby providing complementary protection, and generally prescribe the requirements for registration and the public or private persons and entities that are entitled to own and control such designations under applicable national laws.

GI protection as an IP right differs depending on the jurisdiction or region. Jurisdictions that provide a regulatory scheme to register GIs (the European Union, for example) offer an enhanced sui generis protection that requires specific labelling and certification. Other countries protect marks with geographic significance as trademarks and/or allow protection of geographic terms as collective and/or certification marks subject to specific standards and/or user requirements.

“First in Time, First in Right” Conflict Resolution

In 1981, when revisions to the Paris Convention were being proposed, the then United States Trademark Association (“USTA”) Board approved a resolution supporting a country’s ability to prohibit the use of a GI or refuse or invalidate its registration as a trademark but only where: (1) the use of the GI misleads the public as to the true country of origin; or (2) the GI is the subject of a trademark registration or application and its use is of a nature as to mislead the public as to the true country or origin.

The Association maintained this position during subsequent negotiations on TRIPS. The TRIPS Agreement addresses the conflict between trademarks and GIs by recognizing that they both exist (although “co-existence” is considered an “exception” under Article 24 “*International Negotiations; Exceptions*” – to Article 16 “Rights Conferred”) and by creating a protection mechanism (“grandfather clause”) in Article 24(5) as follows

“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”.

On May 20, 2015, the Geneva Act of the Lisbon Agreement was modified to establish a two-tiered protection: appellations of origin and geographical indications. INTA welcomes the inclusion of a clause for safeguards in respect of other rights (Article 13), including trademark rights, but maintains the position that conflicts between trademarks and GIs should be resolved based on the principle of "first in time, first in right", along with the principles of territoriality, exclusivity, priority, and good faith.

INTA supports the position that any persons or entities that meet the legal qualifications for ownership and registration of geographical indications as trademarks, collective marks, or certification marks under applicable national laws should be entitled to apply for and own such registrations. Such applicants may include natural or legal persons, governmental bodies, producers, consortia, trade associations, and membership associations, or other organizations prescribed under national law.

Enforcement of Rights For and Against Geographical Indications

INTA supports appropriate and effective enforcement of GI provisions at local, national, regional and international levels, in line with trademark enforcement mechanisms. INTA supports mechanisms to allow legitimate traders and trademark owners with prior rights to use opposition and cancellation proceedings under local legislation or international conventions against GIs.

Generic terms

Supporting and harmonizing GI protection means finding solutions to appropriately balance the need for the free availability of existing generic terms with the interest of GI holders. There also is a need to limit the risk that a GI becomes a generic term that is no longer protectable, while providing appropriate protections against misuse of GIs and allowing 'fair use' of generic terms associated with a GI (product names with a specific distinctive function referring to the geographical origin and informing consumers about product characteristics). Free use of generic terms is subject to the rules on fair use or fair market practices but should not be impaired by GI protection.

The generic character of a name is a determination that may vary according to the territory, region of origin, language, history and marketplace, and consumer perception. It is essential to determine when a name is considered to be generic and which criteria are considered.

Conclusion

In conclusion, the Geographical Indications Committee recommends that the Board adopt a resolution setting out INTA's position that:

- the Association reaffirms its position that conflicts between trademark and GI rights should be resolved under the principle of "first in time, first in right" ;
- systems for regulating the protection of GIs should have effective and transparent mechanisms in application, amendment, opposition and cancellation proceedings;
- trademark owners and other relevant parties such as governmental bodies, trade associations, or individual traders with legitimate interests in the use of a geographical

indication and/or prior rights should have standing to oppose or seek amendment or cancellation of GIs; and

- geographical terms that have become generic should not be impaired by GI protection.

1 oriGIIn worldwide GI compilation (last updated on June 7, 2019) : Africa (186) ; Asia (3084) ; Central America

(73) ; Europe (3835) ; North America (396) ; Oceania (129) ; South America (418):

<https://www.origin-gi.com/i-giorigin-worldwide-gi-compilation-uk.html>.