International Approaches to the Protection of Geographical Indications

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Prepared by Judy Winegar Goans January 2009
International Approaches to the Protection of Geographical Indications

**Definition**

A geographical indication is any indication that identifies a good as originating in a particular 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.\(^1\)

**Related concept**

The term “geographical indication” is sometimes used interchangeably with the term “appellation of origin,” a closely related concept that is defined as “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.”\(^2\) The two terms represent two different approaches to the protection of terms of origin that are associated with particular qualities or characteristics of goods based on their place of origin. The protection afforded to appellations of origin under the Lisbon Agreement is favored by the EU. The primary differences are as follows:

<table>
<thead>
<tr>
<th>Geographical indication</th>
<th>Appellation of origin</th>
</tr>
</thead>
<tbody>
<tr>
<td>- Does not require that the indication be a geographical name of a country, region, or locality</td>
<td>- Requires that the indication be a geographical name of a country, region, or locality</td>
</tr>
<tr>
<td>- Specifically includes reputation</td>
<td>- Does not mention reputation</td>
</tr>
<tr>
<td>- Relevant factors must be essentially attributable to good’s “geographic origin”</td>
<td>- Relevant factors must be due exclusively or essentially to good’s “geographical environment”</td>
</tr>
<tr>
<td>- Does not specify whether relevant factors may be attributable to “natural and human factors”</td>
<td>- Specifies that geographical environment includes “natural and human factors”</td>
</tr>
<tr>
<td>- Protection against use in the designation or presentation 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, or any use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention</td>
<td>- Protection against any usurpation or imitation</td>
</tr>
<tr>
<td>- Protection 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, only for wines or spirits.</td>
<td>- Protection even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as “kind,” ”type,” “make,” ”imitation,” or the like.</td>
</tr>
</tbody>
</table>

\(^1\) Adapted from TRIPS Article 22.1.

\(^2\) Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, Article 2.1.
Protection required under international agreements

Egypt is obligated to protect geographical indications by virtue of its membership in the World Trade Organization, where the Agreement on Trade-Related Aspects of Intellectual Property prescribes minimum conditions for protection. The relevant TRIPS provisions are shown in Annex A.

The Paris Convention acknowledges “indications of source or appellations of origin, and the repression of unfair competition” as forms of intellectual property and makes provision for the seizure upon importation or inside the country of goods “in cases of direct or indirect use of a false indication of the source of the good.” While this protection is not identical to the protection of geographical indications, its enforcement would be coextensive with the protection of geographical indications in many instances. In addition, the Paris Convention provides for protection against unfair competition, specifically prohibiting “indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods,” factors that would also effect protection for geographical indications in many instances.

Similar protection is also provided by the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods. That Agreement provides for the seizure or prohibition of importation, or other sanctions, of “[all] goods bearing a false or deceptive indication” of the country of origin. As with the protections afforded by the Paris Convention, this protection is not specifically directed toward the protection of geographical indications but will in many cases have the effect of excluding their importation or sale.

Trade-related issues related to the protection of geographical indications

Geographical indications are a factor in Egypt’s international trade, for two primary reasons. As an exporter, Egypt must satisfy the requirements of importing countries. In addition, geographical indications offer the possibility of increasing the value of exports, particularly agricultural products, by making them more desirable to consumers. This is of significant importance to a country like Egypt, for which agriculture is a major sector of its economy. Agriculture accounts for 30% of Egypt’s labor force, 14.8% of its GDP, and 30% of its commodity exports. Moreover, agricultural exports generated EGP6.3 billion in 2005 and rose to US Dollar 900 million in 2007. Rice, cotton, potatoes, and oranges have been among Egypt’s top exports in recent years. The European Union is the major importer of Egyptian products, absorbing 42 per cent of exports. Egypt’s exporters must therefore satisfy the requirements of its importing partners in the European Union to maintain its trading position.

A particular issue of concern relates to Egyptian cotton, which is highly valued around the world and should be protected as a geographical indication. In 2005, raw cotton represented $293 million, or about 20 per cent of Egypt’s total agricultural exports. The top export markets for

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3 Paris Convention for the Protection of Industrial Property, Article 1(2).
4 Paris Convention Article 10.
5 Paris Convention Article 10bis (3).
8 Id.
Egyptian cotton are India, Pakistan, and China.\textsuperscript{9} In addition to its value in exports, cotton is also important to Egypt’s own textile industry. Until “Egyptian cotton” is protected as a geographical indication, Egypt is vulnerable to losing the benefit of this valuable geographical indication. Other countries could grow long-staple cotton and label it as “Egyptian cotton,” arguing that the term is generic in their countries. The TRIPS Agreement provides a tool by which this could be prevented, but only if the geographical indication is protected in Egypt before it comes into common use abroad.\textsuperscript{10} If such a measure should occur before Egypt protects the term in Egypt, it would lose the ability to demand TRIPS-level protection from its trading partners.

**Approaches to protection taken in selected countries**

The TRIPS Agreement sets standards for protection that must be implemented under national law and in a few cases, mandates measures that must be taken to protect geographical indications, such as refusal or invalidation of the registration of a mark that inappropriately includes a geographical indication. However, TRIPS does not specify how countries must implement the levels of protection specified. Those decisions are left to the individual countries, and the various WTO Members have taken different approaches in implementing these obligations.

The basic approaches taken by WTO Members fall into four categories:

- Registration of geographical indications;
- Protection under another system of registration, typically either trademarks or certification marks;
- Protection under unfair competition laws;
- Legislation;

or some combination of the above.

For example, the United States’ primary approach to the protection of geographical indications is through registration of an indication as a certification mark indicating geographic origin. To be registrable, the geographical indication must meet the general qualifications for trademark registration, including the requirement of distinctiveness. Consequently, no single registrant can pre-empt the use of the geographical terms so as to prevent other legitimate producers from indicating the origin of their goods. In addition, the applicant must satisfy special criteria for the registration of certification marks, such as the existence of certification criteria. For geographical indications, the certification criteria may be as simple as noting the origin of the product or may include other criteria as well, such as a species of plant or inspection by a certification body. In addition, when geographic origin is certified, the applicant should ordinarily (but not exclusively) be either a governmental body or a body authorized to act with regard to the geographic term. Registration of the geographical indication as a certification mark thus gives the registrant the same enforcement ability as those that exist for trademarks. In addition, geographical indications are protected in the United States under laws prohibiting acts of unfair competition – both under Federal law and under various state laws. Since the United States is a common law jurisdiction, this protection can be broad and has resulted in some cases in the protection of unregistered geographical indications on the ground that their use or registration as a mark would be likely to confuse or deceive the public.

\textsuperscript{9} Id.
\textsuperscript{10} See TRIPS Article 24.4.
As another example, Australia applies several forms of protection. “Australia meets its TRIPs obligations to protect wine and spirit GIs through specific legislation, and other GIs through a range of unfair competition and consumer protection legislation, as well as the common law. Key legislation is:

- the Trade Practices Act 1974 which prevents misleading conduct, including representations concerning the place of origin of goods;
- the Trade Marks Act 1995 which allows for the registration of a GI term, provided that certain criteria are met; and
- the Australian Wine and Brandy Corporation Act 1980 which sets up a specific register of protected names for wine.”

While many common law jurisdictions rely to some extent on the ability of their courts to enforce unfair competition laws, most civil code countries have adopted a system of registration of geographical indications. As can be seen in the following table, the adoption of a registration system is by far the most common practice. In addition, certain types of indications may be singled out for protection by a decree or legislation, a system that, to be TRIPS-consistent, must also allow for the protection of foreign geographical indications.

The basis for protection of geographical indications is given for selected countries in the following table. Note that in some cases, countries may offer protection under other laws as well.

<table>
<thead>
<tr>
<th>Country or Territory</th>
<th>Geographical Indication Registration or List</th>
<th>Registration as Trademark, Collective, or Certification Mark</th>
<th>Unfair Competition or Common Law Protection</th>
<th>Product-Specific Legislation or Decrees</th>
</tr>
</thead>
<tbody>
<tr>
<td>Australia</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
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<tr>
<td>Austria</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
</tr>
<tr>
<td>Canada</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>13</td>
</tr>
<tr>
<td>Czech Republic</td>
<td>•</td>
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<td>•</td>
<td>•</td>
</tr>
<tr>
<td>Estonia</td>
<td>•</td>
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<td>•</td>
</tr>
<tr>
<td>European Union</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
</tr>
<tr>
<td>France</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
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<tr>
<td>India</td>
<td>•</td>
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<td>14</td>
<td>•</td>
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<tr>
<td>Israel</td>
<td>•</td>
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<td>•</td>
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<tr>
<td>New Zealand</td>
<td>•</td>
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<td>•</td>
<td>•</td>
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<tr>
<td>Switzerland</td>
<td>•</td>
<td>•</td>
<td>•</td>
<td>•</td>
</tr>
<tr>
<td>Trinidad and Tobago</td>
<td>•</td>
<td>•</td>
<td>16</td>
<td>•</td>
</tr>
</tbody>
</table>


12 Note: Trademark or certification mark protection is indicated in the above table only where that is a basic means of protection, not where a country’s legislation merely addresses the inclusion of protected indications in trademarks. Also note that other forms of protection may be available in some cases other than those shown above.

13 For wines and spirits.

14 A flow chart of the registration process is shown at [http://newdelhi.usembassy.gov/iprgeoind.html](http://newdelhi.usembassy.gov/iprgeoind.html).

15 For wines and spirits.

16 Trinidad and Tobago provides for registration of geographical indications but provides that protection is available regardless of whether an indication has been registered.
How countries determine whether to grant protection

As with the basic procedures for granting protection, there is considerable variety in the way countries determine whether to grant protection to a proposed geographical indication. A number of countries apply some aspect of the trademark system. These include Australia (trademark), Austria (certification mark), Belize (certification mark), Canada (trademark), Grenada (collective mark), United Kingdom (certification and collective marks), and the United States (certification mark). In such countries, the determination is straightforward: the application must be made by a proper party, and the indication for which protection is sought must meet the requirements, including distinctiveness, that apply to trademarks generally.

In the case of certification mark protection in the United States, the applicant must also supply a copy of the certification standards, which are examined to determine that the application actually relates to a certification mark as opposed to a trademark, and the applicant must assert that it does not supply the types of goods that are to be certified. In this latter case, there is no need to examine the certification standards to identify a scientific basis for the claim since a claim of geographical indication can be based on reputation as well as other characteristics or quality, and for marks certifying geographic origin, the only necessary "standard" is the product’s geographic origin.

In some places, opposition is a feature of the system of determining whether to protect a proposed geographical indication. This is the situation where geographical indications are protected as trademarks or certification marks. It is also a feature of the systems of registering geographical indications in India, Israel, Trinidad and Tobago, and the EU.\(^{17}\)

A few countries require a determination based on a scientific rationale. For example, Serbia sends applications to its Ministry of Agriculture for a determination. The Australian Wine and Brandy Corporation has a statutorily created Geographical Indications Committee whose purpose is "to make determinations of geographical indications for wine in relation to regions and localities in Australia".\(^{18}\) New Zealand recently changed its law so that its Geographical Indications Committee would not sit to consider every application.\(^{19}\) While including a scientific evaluation in the registration process may be appropriate under the European system of appellations of origin, it appears pointless where the primary basis for protection is the product’s reputation, as opposed to its scientific characteristics.

Virtually all countries include a provision denying protection to geographical indications that have become the generic term for a product. These decisions seem to be made on the same basis as the equivalent determination for trademarks, regardless of whether the basis for protection is registration as a geographical indication or on some other basis.


Finally, enforcement is carried out in almost all countries through the courts. Both in civil code countries and common law jurisdictions, this leaves a great deal of interpretation to judges, who must apply such terms as "good faith" or "generic." The effect of most reported cases has been to strengthen the protection of geographical indications.
ANNEX A

TRIPS PROVISIONS ON GEOGRAPHICAL INDICATIONS

SECTION 3: GEOGRAPHICAL INDICATIONS

Article 22

Protection of Geographical Indications

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.

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).

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.

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.

Article 23

Additional Protection for Geographical Indications for Wines and Spirits

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.  

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.

3. In the case of homonymous geographical indications for wines, protection shall be accorded to each indication, subject to the provisions of paragraph 4 of Article 22. Each Member shall determine the practical conditions under which the homonymous indications in question will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled.

4. In order to facilitate the protection of geographical indications for wines, negotiations shall be undertaken in the Council for TRIPS concerning the establishment of a multilateral system of notification and registration of geographical indications for wines eligible for protection in those Members participating in the system.

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 ARTICLE 24

**International Negotiations; Exceptions**

1. Members agree to enter into negotiations aimed at increasing the protection of individual geographical indications under Article 23. The provisions of paragraphs 4 through 8 below shall not be used by a Member to refuse to conduct negotiations or to conclude bilateral or multilateral agreements. In the context of such negotiations, Members shall be willing to consider the continued applicability of these provisions to individual geographical indications whose use was the subject of such negotiations.

2. The Council for TRIPS shall keep under review the application of the provisions of this Section; the first such review shall take place within two years of the entry into force of the WTO Agreement. Any matter affecting the compliance with the obligations under these provisions may be drawn to the attention of the Council, which, at the request of a Member, shall consult with any Member or Members in respect of such matter in respect of which it has not been possible to find a satisfactory solution through bilateral or plurilateral consultations between the Members concerned. The Council shall take such action as may be agreed to facilitate the operation and further the objectives of this Section.

3. In implementing this Section, a Member shall not diminish the protection of geographical indications that existed in that Member immediately prior to the date of entry into force of the WTO Agreement.

4. Nothing in this Section shall require a Member to prevent continued and similar use of a particular geographical indication of another Member identifying wines or spirits in connection with goods or services by any of its nationals or domiciliaries who have used that geographical indication in a continuous manner with regard to the same or related goods or services in the  

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20 Notwithstanding the first sentence of Article 42, Members may, with respect to these obligations, instead provide for enforcement by administrative action.
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.

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.

7. A Member may provide that any request made under this Section in connection with the use or registration of a trademark must be presented within five years after the adverse use of the protected indication has become generally known in that Member or after the date of registration of the trademark in that Member provided that the trademark has been published by that date, if such date is earlier than the date on which the adverse use became generally known in that Member, provided that the geographical indication is not used or registered in bad faith.

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.

9. There shall be no obligation under this Agreement to protect geographical indications which are not or cease to be protected in their country of origin, or which have fallen into disuse in that country.