

QUESTION 118

Trade and service marks and geographical indications

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Q118

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Resolution

1. AIPPI observes that the terminology used internationally with respect to geographical indications varies. This leads to confusion.

For the purposes of this question, AIPPI defines a "geographical indication," whether a word or device and whether it constitutes the entire indication or is an element thereof, in its broadest sense to include:

- **indication of source**, meaning a geographical indication perceived by the public as indicating the origin of the goods or services, as used in the Madrid Agreement;
 - **appellation of origin**, meaning a geographical indication used to designate goods or services which originate from the region or place in question and whose qualities and characteristics are due exclusively or essentially to the geographical environment in the sense of Article 2 of the Lisbon Agreement, Article 22 of the TRIPS Agreement or Article 2 of the EEC Regulation No. 2081/92;
 - **neutral geographical indication** that the public does not perceive as indicating the origin of the goods or services;
 - **generic geographical indication** which has become merely descriptive for goods or services (for example "Bermuda" for a certain kind of shorts).
2. AIPPI recognizes that special problems can arise with indications which, although not strictly speaking geographical, may nevertheless evoke a geographical connotation.

3. Can a geographical indication constitute a protectable mark - meaning in this Resolution a trade mark or a service mark - and under what conditions?

AIPPI recommends that

3.1 in principle, a geographical indication can constitute a protectable mark.

However, a mark consisting of a geographical indication or containing a geographical element shall not entitle the proprietor to prohibit a third party from using the indication or element in the course of trade, provided the use is in good faith, solely to identify the geographical origin of the goods or services, and is not such as to be perceived as a mark.

3.2 The general principles as to the protectability of marks apply to this type of mark.

However, special attention should be paid to the fact that geographical indications cannot constitute a protectable mark, in particular, in the following cases:

- (1) The mark misleads the public as to the geographical origin of the goods or services;
- (2) The mark consists of a geographical indication, which is generic for the goods or services.

3.3 When a geographical indication is accepted as a mark in its country of origin, then in applying Article 6 quinquies A paragraph 1 of the Paris Convention, protection of that mark cannot be refused in other countries solely on the ground of its geographical nature in its country of origin.

4. Can an indication of source or an appellation of origin be protected as a mark?

4.1 Protection by way of an individual mark (i.e. a mark not being a collective or certification mark)

AIPPI recommends that as a general rule, because of its nature, an indication of source or an appellation of origin cannot be registered or protected as an individual mark for the goods or services to which the indication or appellation applies.

AIPPI observes, however, that in some countries where there is no legal provision for the protection of collective or certification marks or any other suitable protection, indications of source or appellations of origin are protected as individual marks.

4.2 Protection by way of collective or certification marks

AIPPI observes that there are different definitions of collective and certification marks and that in certain countries collective marks are, in fact, according to the definitions hereunder, certification marks. AIPPI endorses Resolution Q 72 adopted at the meeting of the Executive Committee in Moscow in 1982 (Yearbook 1982 III, F 56, E 107, G 163) and especially the following definitions and principles:

- (1) "'Certification marks' are marks which are used to indicate that the goods or services so identified are certified to possess certain characteristics or qualities, and"
- (2) "'Collective marks' strictly speaking are marks which are used to indicate that the goods or services so identified have been produced, distributed or performed by members of a certain group of persons."
- (3) "If goods or services have the certified characteristics or qualities, the producer, distributor or performer of these goods or services is entitled to use the certification mark to identify such goods or services."
- (4) "In the case of a registered certification mark, the nature of the characteristics or qualities certified by such mark and any conditions or restrictions imposed on the use of such mark shall be made available for public inspection."

Under these conditions AIPPI considers that indications of source and appellations of origin can be protected in the form of collective or certification marks even though they designate the geographical origin of the goods or services. In case of protection of a geographical collective or certification mark, it must be guaranteed that any local producer who complies with the requirements for the use of that mark is entitled to use the mark, in accordance with the specifications and in the case of a collective mark to become a member of the group.

AIPPI observes, however, that this type of protection could lead to problems in the case of non-use which could result in the cancellation of the collective or certification mark.

5. Conflicts between a mark and an indication of source or an appellation of origin

When a conflict arises, consideration has to be given as to which of the two has priority.

5.1 Conflicts between a mark and an earlier indication of source or an appellation of origin

When such a conflict arises, AIPPI recommends that

- (1) the Trademark Office should ex officio refuse the registration of the mark,
- (2) third parties may
 - oppose the application to register as a mark,
 - bring proceedings for cancellation of the registration of the mark and for prohibition of use thereof.

5.2 Conflicts between an indication of source or an appellation of origin of high reputation and a mark

AIPPI recommends that a mark can be refused protection if it is identical or similar to an indication of source or appellation of origin high reputation, even if the goods or services are not similar, if use of the mark would take unfair advantage of or be detrimental to the distinctive character or repute of the indication or appellation.

5.3 Conflicts between an indication of source or an appellation of origin and an earlier mark

To settle such conflicts, AIPPI recommends in principle co-existence, unless the mark has acquired reputation or renown prior to the date the indication of source or appellation of origin has been established or recognized as such. In this case protection of the indication or appellation should be denied, and registration refused or cancelled. This however does not preclude the use of the indication or appellation to identify the geographical origin of the goods or services, under the conditions specified in Paragraph 3.1 of this Resolution.

6. Principles for resolution of conflicts between marks and geographical indications

AIPPI recommends that any national or regional legislation relating to geographical indications should include provisions for the resolution of conflicts between marks and geographical indications in accordance with the following principles:

- (1) Such legislation should take into account existing bilateral and multilateral agreements.
- (2) Interested parties must have the opportunity to intervene directly in any proceedings which may affect their intellectual property rights.
- (3) If a question arises as to the validity of a mark, such question should be decided only by the competent courts or authorities according to the national or regional laws relating to marks.

Conclusion

Taking into account the above Resolution, AIPPI should further study this question and in particular the relevant provisions of the TRIPS (GATT) Agreement, the EEC Regulation No. 2081/92 (July 14, 1992) and 2392/89 (July 24, 1989) and the NAFTA Agreement.

(Earlier Resolutions concerning the same question respectively the same subject matter: Q 7/1958, NS 5, 262; Q 7/1958, NS 6, 44; Q 62/1975 III, 137; Q 62/1977 I, 145; Q 62/1980 I, 115; Q 62/1984 I, 155; Q 62/1984 III, 95; Q 62/1992 II, 341; Q 67/1978 II, 150; Q 104/1992 III, 279.)
