

Resolution



Question Q191

Relationship between trademarks and geographical indications

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Q191

AIPPI

Noting that:

- 1) The AIPPI has studied the relationship between trade marks and geographical indications in previous questions, leading in particular to:
 - i) the resolution of the Executive Committee of Copenhagen in 1994 – Question Q118, Yearbook 1994/II, pages 408–412 (*Copenhagen Resolution*); and
 - ii) the resolution of the 37th Congress of Rio de Janeiro in 1998 – Question Q62, Yearbook 1998/VIII, pages 389–392 (*Rio Resolution*).
- 2) The Rio Resolution noted that geographical indications are protected under an increasing number of national laws and bilateral and multilateral treaties with divergent and sometimes contradictory results.
- 3) While the Copenhagen Resolution and the Rio Resolution recommended further study in this area, the Rio Resolution took note of the principle of “*first in time, first in right*” and considered that it could be a guiding principle for the resolution of conflicts between geographical indications and trade marks.
- 4) As this Question requires the consideration of geographical indications in the context of the TRIPS Agreement (amongst other things), the AIPPI for the purpose of this Question adopts (as did the Rio Resolution) the definition of geographical indications contained in Article 22(1) of the TRIPS Agreement, that is to say:

Geographical indications are indications which identify 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.
- 5) This Resolution does not deal with geographical indications in relation to services.

Considering that:

- 1) There is broad agreement that some protection for geographical indications is desirable.
- 2) There remains a lack of consensus as to the necessity or desirability of registration systems dealing specifically with geographical indications, both at national and international level, and therefore a lack of consensus as to the adoption of uniform rules.
- 3) The method of direct protection for geographical indications differs and includes:
 - i) protection within the framework of trade mark laws;
 - ii) protection by way of a sui generis system.

- 4) Geographical indications may also be indirectly protected by other existing legal frameworks including unfair competition, passing off and consumer protection laws.
- 5) In view of the cultural and historical context in which many geographical indications exist, alternative dispute resolution and/or bilateral negotiations may be the appropriate mode of settling conflicts.

Resolves that:

- 1) The importance of protection of geographical indications, as well as the Copenhagen Resolutions and the Rio Resolution, be reaffirmed.
- 2) Protection of geographical indications should aim to prevent practices liable to mislead the public or misappropriate the reputation, if any, of the geographical indication.
- 3) Geographical indications should be directly protected either within the framework of trade mark laws or by way of a sui generis system, or by a combination of the foregoing.
- 4) The guiding principle for settling conflicts between trade marks and geographical indications should be the *first in time, first in right* rule (priority in use or registration)
 - i) with the aim of avoiding practices which are liable to mislead the public or misappropriate the reputation, if any, of the protected geographical indication or trade mark; but
 - ii) taking into account additional factors including the reputation of the geographical indication and of the trade mark, the length of time that the geographical indication and the trade mark have been used, the extent and *bona fides* of each such usage, the likelihood and degree of any confusion, and, if applicable, acquiescence.
- 5) A voluntary multilateral system of notification of geographical indications should be established for information purposes. This should be recorded on a database which is searchable on line, free of charge and accessible to all members of the public. No inference should be drawn by participation or non-participation in the system.
- 6) The national groups should work towards harmonisation within their existing systems (for example, by interaction with governments).
- 7) Harmonisation efforts should have regard to the following:
 - a) definition of a geographical indication;
 - b) entitlement;
 - c) as applicable:
 - i) type or category of trade mark (including the meaning of collective mark and certification mark); or
 - ii) goods in respect of which protection is enjoyed; and
 - iii) criteria for registrability or other form of protection;
 - d) provision and criteria for objection/cancellation;
 - e) effect and scope of protection and enforcement procedures.
- 8) Further harmonisation and the administration of the system of notification should be discussed at both WIPO and WTO level.