

# Summary Report



## Question Q191

### Relationship between trademarks and geographical indications

#### I) Introduction

This question has been selected to examine the relationship between trademarks and geographical indications ("GIs") under current national and international laws and to encourage proposals for adopting uniform rules.

The Reporter General has received 49 Group Reports from the following countries (in alphabetical order): Arab Regional Group, Argentina, Australia, Belgium, Bolivia, Brazil, Bulgaria, Canada, Chile, China, Croatia, Czech Republic, Denmark, Egypt, Estonia, Finland, France, Germany, Greece, Hungary, India, Indonesia, Israel, Italy, Japan, Latvia, Luxembourg, Malaysia, Mexico, New Zealand, Norway, Panama, Paraguay, Peru, Philippines, Portugal, Republic of Korea, Romania, Russia, Singapore, Slovenia, South Africa, Spain, Sweden, Switzerland, Thailand, United Kingdom, United States of America and Venezuela.

While the Group Reports give an excellent overview of the laws dealing with GIs in the reporting countries, the output in relation to adoption of uniform rules is somewhat limited. There is no general consensus as to the necessity or desirability of registration systems dealing specifically with GIs, both at national and international level.

#### II) Analysis of current legislation and case law

- 1) *Do your country's laws have enactments or systems dealing specifically with GIs, e.g. a registration system for GIs?*

All reporting countries which answered this question have enacted laws dealing with GIs.

Those reporting countries which are member states of the European Community (Belgium, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Italy, Latvia, Luxembourg, Portugal, Slovenia, Spain, Sweden, United Kingdom) or the European Economic Area (Norway) are subject to Regulation 510/2006/EC (formerly 2081/92/EC), which affords registered GI protection to agricultural products and foodstuffs, and corresponding Regulations for alcoholic beverages. A register of GIs is maintained by the European Commission. Some of the member states of the EC – in addition to operation of Regulation 510/2006/EC and corresponding Regulations for alcoholic beverages – provide for separate GI protection under national law. Thus, for example in Belgium and France a separate national system of recognition of GIs co-exists with the protection under EU law. In Germany and Italy national law provides for sector specific statutory protection or registration systems (in relation to cheese, olive oil, hop, wine and steel ware). In Germany, Italy, and the UK, the law of unfair competition/passing off additionally protects GIs against misleading use.

Argentina, Brazil, Bulgaria, Chile, China, Croatia, Egypt, Indonesia, Malaysia, Panama, Switzerland, and Venezuela also provide for registration systems for GIs for agricultural products and foodstuffs, wines and spirits. Australia and Canada only maintain registration systems for GIs for wines and spirits. New Zealand has so far not enacted a registration system, but has recently introduced a bill into parliament proposing to enact a registration system for wines and spirits. Peru maintains a system of recognition of GIs by means of a declaration of protection with authorisation of use. Australia, Malaysia and Switzerland – in addition to operation of a registration system – provide for protection against misleading use

of GIs by way of passing off/unfair competition law. Some reporting countries do not have any special registration system, but other enactments dealing with GIs (Japan, Paraguay, Philippines, Singapore, South Africa, USA). South Africa and the USA mainly afford protection to GIs under trademark law provisions which allow for protection of trademarks, certification marks, and collective marks.

*If so, what are the criteria of registrability?*

The criteria of registrability vary for indications of source and appellations of origins as well as, in the EU context, protected geographical indications (PGIs) and protected designations of origin (PDOs). Generally speaking, to qualify for protection, a product must be produced or processed or prepared in a specific geographical area and there must be a specific quality, reputation or other characteristic *attributable* to that area. A more demanding test is required in order to obtain an appellation of origin and, in the EU context, a PDO, namely that the specific quality, reputation or other characteristic must not only be attributable, but *essentially due* to that geographical area. In the case of the PDO it is further required that the product is produced *and* processed *and* prepared in the geographical area.

*To which national authority must an application for protection be made?*

In the EU context, an application for protection of a European GI must be made directly to the relevant national authority which in turn must notify the Commission. Where an applicant from a non-EU country seeks protection for a GI which does not originate from the EU, the application must be directly presented to the Commission or via the appropriate national application authority in that country<sup>1</sup>.

At a national level, applications for registration of a GI are made in essentially two ways: In most reporting countries applications for registration of a GI are submitted through a governmental agency or committee of the ministry of agriculture or a similar ministry. This is the case in Argentina, Australia, Belgium, Canada, Croatia, Denmark, Finland, France, Greece, Italy, Latvia, Luxembourg, Malaysia, Mexico, Norway, Panama, Portugal, Republic of Korea, Spain, Switzerland, United Kingdom, and Venezuela. In the other reporting countries which answered this question, applications for a registration are made to the national patent and/or trademark offices (Brazil, Bulgaria, Chile, China, Czech Republic, Egypt, Estonia, Indonesia, New Zealand, Peru, Romania, Russia, Slovenia, Thailand).

*Does the applicant have the right to appeal against the refusal of the national authority to register a GI? If so, to which entity?*

Where applications for registration of a GI are submitted through a governmental agency or committee, there are basically two possibilities of reviewing refusals of applications. The refusal of application may either be appealed to a superior administrative body, the ministry or an administrative board of appeal from which there is a possibility of a further appeal to an administrative court. This is for instance the case in Argentina, Switzerland, and Venezuela. The other possibility is that refusals of applications are not appealable, but judicial review of the administrative authority's decision is possible, typically on the grounds of error of law and procedural defects. Applications for judicial review must be made to the administrative courts from which there is often a possibility of an appeal to a higher court and, ultimately, the supreme administrative court. This is the case in Australia, Croatia, France, Latvia, Luxembourg, Portugal, Spain, and the United Kingdom. The position is similar with regard to protection under EU law: the Commission's decision is final subject to review by the European Court of Justice.

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<sup>1</sup> Under former Regulation 2081/92, an applicant from a non-EU country could only register a GI not originating from the EU subject to reciprocity and equivalency conditions. As mentioned in the Working Guidelines, this provision was, however, challenged by Australia and the USA in WTO dispute settlement proceedings. On March 15, 2005, a WTO panel called on the EU to clarify certain aspects of its legislation to allow producers from third countries to register their GIs in the EU. On March 20, 2006, Regulation 510/2006 was adopted, replacing Regulation 2081/92.

Where applications for registration of a GI are submitted through the patent and/or trademark offices, refusals of applications may generally be appealed to the board of appeals of such patent and/or trademark offices. This is the case in Brazil, Bulgaria, Chile, China, Czech Republic, Egypt, Estonia, Indonesia, Russia, and Thailand. In Bulgaria, China, and Romania, there is a possibility of a further appeal to the administrative courts. In Peru and Slovenia, an appeal from the patent and/or trademark office may be filed directly with an Administrative Tribunal.

- 2) *What is the status of a GI in your country? Does the registration of a GI confer a property right? Who would be the rightholder of a GI?*

Some of the Group Reports (Argentina, Chile, Czech Republic, Denmark, Egypt, Indonesia, Italy, Norway, Panama, Romania, Thailand) state that GIs are (industrial) property rights. However, the majority of Group Reports (Australia, Belgium, Brazil, Estonia, Germany, Latvia, Luxembourg, Malaysia, Peru, Portugal, Republic of Korea, Singapore, Switzerland, and UK) note that the registration of a GI does not confer a property right. Similarly, there is generally no individual "proprietor" or "right holder" in these countries. A number of Group Reports (Belgium, Brazil, France, Latvia, Luxembourg, Portugal, Russia, Slovenia, Spain, Thailand) state that a GI is best seen as a public good or a collective right. The Slovenian Group speaks of a collective property right, the French Group of a sui generis right. A number of Groups (Belgium, Bulgaria, Croatia, Germany, Luxembourg, Malaysia, New Zealand, Norway, Russia, Spain, Sweden, Switzerland, UK) point out that anyone may use a GI so long as the goods in respect of which the GI is used meet the specific geographic and quality requirements set forth by the law. The Group Reports from Mexico, Peru and Venezuela note that the GI right belongs to the state and the state may authorize the use of such right.

*Can GIs be the subject of dealings such as assignment, mortgage and licensing?*

In every country which responded to this question, save Chile and the Philippines, GIs cannot be the subject of dealings such as assignment, mortgage and licensing. In Egypt, GIs can be assigned to producers within the same geographical area. The Group Report from New Zealand notes that as GIs may be used by anyone whose goods comply with the restrictions on the use of GIs, there is no need for assignments or licensing. A number of Group Reports (Belgium, China, Germany, Republic of Korea, South Africa, Sweden, UK, USA) state that GIs may be the subject of dealings such as assignment and licensing if they are registered as collective marks or individual marks.

- 3) *Is the application for or registration of a GI made public in your country?*

In all reporting countries which provide for a registration system, save Panama and Venezuela, either the application for or the registration of a GI is made public. In the EU, the applications are first examined and published by the national authority of the member state concerned. If the national authority considers that the requirements are met, the application will be forwarded to the European Commission which will again scrutinize the application and, if the requirements are met, publish the registration in the Official Journal of the European Union.

*Is it possible to oppose such application or registration of a GI? If so, by whom and on what (absolute or relative) grounds (e.g. generic or descriptive term or prior trademark)?*

In all reporting countries which provide for a registration system, except Panama, Romania, Russia, and Venezuela, there is a procedure available to oppose an application or registration. In most reporting countries, namely the member states of the European Community, as well as Argentina, Brazil, Egypt, Norway and Peru, it is possible to oppose applications or registrations on both absolute (e.g. descriptive or generic term, deceptiveness, contrary to *ordre public* or morality) and relative grounds (e.g. prior trademark). The Group Reports from Australia and Morocco state that the opponent may only rely on relative grounds; whereas in Canada, Indonesia, Malaysia and Switzerland only absolute grounds are relevant, according to the Group Reports.

As to procedure in the EU, there is first an objection procedure at the national level where persons from the member state in which the request originated may lodge their objection. At European Commission level, there is another opposition period for any other member state, third country or person established or resident in such other member state wishing to object to the registration. Oppositions from the member state in which the request originated will only be accepted in the objection procedure at national level.

*Is it possible to cancel such registration of a GI?*

In all reporting countries which addressed cancellation, except Peru and Venezuela, there is a procedure available to cancel a registration if the requirements are no longer met. In Venezuela, GIs cannot be cancelled, but the declaration of GI protection may be suspended if the requirements are no longer met.

4) *Must use requirements be satisfied in order to maintain GI protection?*

In all reporting countries which answered this question, save Brazil, Chile, China, Estonia, Indonesia, and Sweden, there are no specific use requirements for the maintenance of the registration of a GI. In Australia, Malaysia, New Zealand, Singapore, and Switzerland, GIs can be removed from the registry if they have fallen into disuse. Similarly, in Brazil and in the Republic of Korea, the producers must effectively produce the goods to maintain GI protection. The Italian Group Report notes that use is even required to maintain protection of unregistered GIs under Article 29 of the Intellectual Property Code. Conversely, the Swiss Group Report states that use is not required to maintain protection of unregistered GIs.

*If so, is there any definition of what constitutes use?*

The Group Reports generally do not give any definition of use. Only the Malaysian Group Report states that use of a GI must be in the course of trade by producers carrying on their activity in the geographical area specified in the Register, in respect of the products specified in the Register and in accordance to the quality, reputation or other characteristics specified in the Register.

*Are the legal rules established for appraising the maintenance of a trademark registration applicable to the appraising of the maintenance of GI protection?*

In China the legal rules established for appraising the maintenance of trademark registrations are applicable to the appraising of the maintenance of GI protection. The Groups from New Zealand, Republic of Korea and Switzerland advise that the rules developed in respect of the non-use of trademarks are not applied to GIs.

5) *What is the scope of protection of a GI? Is it only protected against use of the name or also against use of elements of the specification of the GI (e.g. slicing, grating) or any other practice liable to mislead the public as to the origin of the product (e.g. use of same trade dress)?*

In the EU, GIs are protected against:

- any direct or indirect commercial use of the registered name on comparable products or if use of the name exploits the reputation of the protected name (by way of example, the use of Champagne for bubble bath, cider, sausage, and beer has been considered not permissible, according to the Belgian Group Report)
- misuse, imitation or evocation, even if the true origin of the product is indicated or if the protected name is translated or accompanied by an expression such as “type”, “style”, “method”, “as produced in”, “imitation” or similar;

- any other false or misleading indications as to the origin, nature or essential qualities of the product, on packaging, advertising material or documents relating to the product concerned, and the packing of the product in a container liable to convey a false impression as to its origin;
- any other practice liable to mislead the public as to the true origin of the product.

The Belgian and UK Group Reports stress that in the EU a PDO or PGI is protected to the extent of the specification approved with the application. Any use of a GI which does not comply with the specification infringes the GI. The specification can include for example a description of the product including the raw materials, a description of the method of obtaining the product (including provisions relating to slicing and grating of the relevant product), and information concerning the packaging and labelling. The Belgian Group Report further points out that GIs are only protected against use of these elements of the specification, if such elements had been subject of adequate advertising measures. In addition, where for example slicing, grating, or packaging operations are carried out at the stage of retail or restaurant sale, a condition in the specification that these must be carried out in the region of production will not be enforced.

For protected wine products similar rules apply in the EU but they seem to afford a more narrow scope of protection, according to the Belgian Group Report.

Bulgaria and Croatia have also adopted the EU rules even though they are formally not bound by them. A similar regime has been adopted in Switzerland and Malaysia. In France, the national system of recognition (as distinct from the EU regime) does not protect against use of the same trade dress and packing. However, unfair competition law may provide some remedy instead.

In Germany GIs are not only protected against misleading use. They are also protected against use in commerce for products which have the same origin but not the same quality as the protected goods. Finally, GIs which have gained some reputation are even protected against dilution. In Argentina, GIs are protected against use of identical or confusingly similar names, use of same design, and packing, but not against use of the same method of obtaining the product (including provisions relating to slicing and grating of the relevant product).

The Canadian Group Report notes that the scope of protection also extends to translations. In Australia GI protection for wine entered on the Wine Register extends to any use in the description and presentation of the wine; other products are only protected against use which is likely to deceive in relation to the origin or any other characteristics of the goods to which the GI relates.

*Are the legal rules established for determining the scope of trademark protection applicable to determining the scope of GI protection (e.g. in relation to reputed or well-known GIs, likelihood of confusion, infringing and non-infringing acts)?*

The Group Reports from Argentina, Chile, China, Egypt, Estonia, Indonesia, Norway, Peru and the Philippines note that the courts apply or would most likely apply the legal rules established for determining the scope of trademark protection also to determining the scope of GI protection.

The Swedish Group Report states that the legal rules established for trademarks are not directly applicable. If a GI, however, has a reputation and is well-known, the assessment of the GI's scope of protection would have considerable similarities to the scope of protection of a reputed mark. A similar position is taken in the German Group Report. The Russian Group Report states that specific provisions apply for determining the scope of GI protection. The Group Report from Singapore states that the legal rules established for determining the scope of trademark protection do not apply to determining the scope of GI protection.

*May rights in a GI be enforced even where a product which allegedly infringes those rights has been made purely for export?*

In all reporting countries which answered this question, save Brazil and Croatia, rights in a GI may be enforced even where a product which allegedly infringes those rights has been made purely for export. The Croatian Group notes that it is only in respect of wine that a GI can be enforced where an infringing product has been made purely for export.

6) *Can a GI be registered as individual trademark? If so, under what conditions?*

A number of Group Reports state that a mark consisting exclusively of a GI is barred from registration, but that this bar may be overcome by demonstrating acquired distinctiveness. This is the case in Australia, Brazil, Croatia, Japan, Malaysia, New Zealand, the Philippines, and Switzerland. A similar position applies in the EU. Article 3 (c) of Council Directive 89/104 contains an absolute ground for refusal for marks which consist exclusively of signs or indications which serve, in trade, to designate the geographical origin of goods and services. This ground for refusal shall, however, not apply if the mark has acquired distinctiveness as a result of the use made of it. Accordingly, the Group Reports of Belgium, Germany, Luxembourg, Norway, Spain, Sweden, and UK note that a GI can be registered as individual trademark if acquired distinctiveness can be established. It is generally recognized that this task is very difficult to achieve. The German Group recommends obtaining survey evidence for demonstrating acquired distinctiveness.

Despite the position in the EU, the Groups from Estonia, Finland, Hungary, Italy, and Portugal state that their laws expressly prohibit the registration of signs which consist exclusively of a registered GI. A similar position is taken in the Group Reports of Argentina, Bulgaria, Chile, China, Indonesia, Mexico, Morocco, Panama, Paraguay, Peru, Republic of Korea, Russia, South Africa, and Thailand. The Group Reports of Canada, Latvia, Romania, Republic of Korea and USA state that a GI can only be registered as certificate or collective mark. The Group Report from Singapore states that a GI in respect of wines or spirits may not be registered as individual trademark.

The Belgian Group Report notes that a mark shall not be registered if use of the trademark would deceive consumers or cause confusion. The Group Reports from Mexico and Venezuela state that a GI can only be registered as individual trademark in respect of goods and services which are not related to those to which the GI refers.

7) *Do your country's laws provide for collective or certification marks? If so, under what conditions can a GI be registered as a collective mark or a certification mark?*

All countries which answered this question, save Argentina and Chile, provide for collective or certification marks. A certification mark is generally defined as a mark which indicates that goods or services for which it is used have qualities or characteristics which are certified by its proprietor. A collective mark is similar to a certification mark except that it is owned by an association and its use is limited to members of that association.

In all reporting countries which provide for collective or certification marks, except France, Hungary, Malaysia, Thailand, and Venezuela, GIs may be registered as collective or certification marks under certain conditions to be more fully explained below. In Brazil and the Republic of Korea, a GI may only be registered as collective mark. In Canada, a GI may only be registered as a certification mark.

In the EU, member states may provide that signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute collective, guarantee or certification marks, according to Article 15 (2) of Council Directive 89/104. The reporting countries Czech Republic, Denmark, Germany, Latvia Luxembourg, and Portugal have made use of this option. The other absolute grounds for refusal nevertheless

apply. Notably, the mark must also be distinctive, but, according to the Group Reports from the Czech Republic and Germany, it suffices that the collective or certification mark is capable of distinguishing the goods and services of the holder's members as to their commercial or geographical origin, type, quality or other characteristics from the goods or services of other companies. A similar position (lower threshold of distinctiveness) applies in Croatia, New Zealand, Peru, Switzerland (at least with regard to certification marks) and USA.

In the reporting countries Finland, Greece, Sweden and UK a GI can only be registered as collective or certification mark if it meets the general requirements of an individual trademark, notably if it has acquired distinctiveness in relation to the goods concerned through use. The same position applies in Australia, Brazil, and Japan. In Romania, GIs can be registered as collective or certification mark provided the trademark applicant files a disclaimer for the words specific to the geographic region.

- 8) *Does inclusion of a protected GI as part of a trademark qualify as legal bar to the registration of such trademark?*

In Argentina, Bulgaria, the Czech Republic, China, Egypt, Indonesia, Latvia, Panama, Paraguay, Slovenia, and Thailand inclusion of a GI as part of a trademark qualifies as legal bar to the registration of such mark. In Luxembourg, Peru, the Republic of Korea and Singapore, the same rule applies with regard to spirits. A similar rule applies in Spain. The German Group Report notes that bilateral treaties between Germany and Cuba, France, Greece, Italy, Spain and Switzerland may prohibit inclusion of a GI as part of a trademark.

In Australia, Finland, Greece, Luxembourg, Malaysia, New Zealand, and the Republic of Korea, inclusion of a GI as part of a trademark may qualify as a legal bar, but this legal bar may be overcome by establishing distinctiveness acquired through use. In China the legal bar can only be overcome if the trademark qualifies as collective or certification mark.

In the EU, Regulation 510/2006/EC (formerly 2081/92/EC) does not allow for registration of a trademark which infringes a GI that has an earlier priority date and is protected at European level pursuant to this Regulation. Inclusion of such protected GI as part of a trademark may result in a case of infringement and, therefore, qualify as legal bar to registration. The Danish Group Report specifies that this legal bar is not applicable if the trademark applicant is lawful owner/authorised user of the protected GI. A similar rule applies in Croatia and Russia.

In Canada and Romania, GIs can be registered as part of a mark if the GI is disclaimed from the trademark. In Singapore, inclusion of a GI as part of a trademark will not qualify as legal bar if such GI has fallen into disuse in its country of origin. The Group Reports from Belgium, Brazil, Chile, Estonia, France, Italy, New Zealand, Norway, the Philippines, Portugal, the Republic of Korea, Spain and Venezuela note that inclusion of a GI as part of a trademark will qualify as legal bar if use of the trademark would deceive consumers or cause confusion.

In Switzerland, inclusion of a registered GI as part of a trademark may qualify as legal bar if the trademark application imitates or misappropriates the GI or exploits its reputation or if the list of goods and services is not restricted to the GI specification.

The Group Report from Mexico states that a GI can only be registered as part of a trademark in respect of goods and services which are not related to those to which the GI refers.

- 9) *Do your country's laws, e.g. trade or merchandise legislation, require the application of correct designations of origin/source on agricultural products and food-stuffs?*

All reporting countries which answered this question, save Mexico, require the application of correct designations of origin/source on agricultural products and food-stuffs, either through national trade and merchandise legislation or EU regulations.

- 10) *How are conflicts between trademarks and GIs resolved under your country's laws? Do they co-exist or does either the trademark or GI prevail? Is there a rule for determining whether the trademark or GI should prevail, and what are the criteria to take into account (e.g. the "first in time, first in right"-rule, the reputation of the geographic region or the reputation of the trademark, the length of time that the name has been used to indicate the geographic region and the extent of such usage, the length of time that the trademark has been used and the extent of such usage)?*

Conflicts between trademarks and GIs are resolved on the basis of the "first in time, first in right"-rule in Australia (for GIs other than registered GIs for wine), and Bulgaria. A modified rule ("first to file, first in right") is applied in Chile and, similarly, in Brazil. A number of reporting countries also rely on the "first in time, first in right"-rule, but apply additional criteria (including, among others, reputation, length of time and extent of use, potential deception of consumers or confusion, geographical extent of use, number of goods sold bearing GI or mark). This is the case in Argentina, China, and New Zealand.

In Japan, Panama, Peru, Republic of Korea, and Thailand, no rule for resolving conflicts exists.

The Australian Group Report summarizes the conflict rules as follows:

- In a conflict between an unregistered GI and a registered trademark, the trademark registration will prevail except where the GI has a reputation preceding the use or registration of the trademark, the trademark registration may be subject to attack on the ground that it is not distinctive.
- In a conflict between an unregistered trademark and a registered GI for wine, the GI will generally prevail
- In a conflict between a registered GI and a prior registered trademark, the GI probably prevails (not decided)

The Group Reports from Egypt, Philippines, Romania, and Venezuela, state that GIs generally prevail over trademarks. This is also the case in Mexico if the GI and trademark cover related products, but they co-exist if they cover different products.

In Malaysia, the GI also generally prevails over the trademark. The use of the trademark is, however, lawful and the proprietor may continue to use it (co-existence) if the trademark has been applied for or registered in good faith or where rights to a trademark have been acquired through use in good faith before August 15, 2001 or before the protection of the GI in the country of origin. A similar rule applies in Singapore where the cut-off date is January 15, 1999. In addition, a trademark shall not be refused registration if the prior GI has ceased to be protected or has fallen into disuse in its country of origin.

In Indonesia, in a conflict between a registered GI and a prior registered trademark, the trademark proprietor is granted a period of 2 years from the date of the registration of the GI to continue using the trademark; after the 2 years period the trademark will be cancelled.

In the EU, registered GIs generally prevail over trademarks unless the GI was misleading when it was registered (for example because of a prior trademark with a reputation), in which case the registration of the GI is invalid. Conversely, registered trademarks prevail over the protection of unregistered GIs by unfair competition law unless the trademark was misleading at the priority date of the application (for example because of the reputation of the GI), in which case the registration of the trademark is invalid. The German, Spanish and UK Group Reports summarize the conflict rules in the EU context as follows:

- A trademark is unregistrable/invalid if it conflicts with a prior GI
- A GI is only unregistrable/invalid if it conflicts with a prior trademark with a reputation and provided that the use of the GI would deceive consumers or cause confusion because of the reputation of the trademark and the length of time that the trademark has been used and the extent of such use



- The use of (even a prior) trademark is generally unlawful if it conflicts with a GI except where the trademark was registered in good faith before the application for the GI was filed, or before January 1, 1996, and there are no grounds for revocation of the trademark – in which case the use of the trademark is lawful and the proprietor may continue to use it (co-existence).

Similar conflict rules apply in Croatia and Switzerland.

### **III) Proposals for adoption of uniform rules**

#### *11) Should countries provide for registration systems dealing specifically with GIs?*

A small majority of the Groups that responded to this question think that countries should provide for registration systems dealing specifically with GIs (Brazil, Chile, Czech Republic, Croatia, Egypt, Estonia, France, Greece, Indonesia, Malaysia, Mexico, Panama, Spain, Switzerland).

A number of Groups do not consider specific registration systems are necessary to afford protection to GIs (Finland, Germany, Japan, Luxembourg, Republic of Korea, UK and USA). The German Group believes that unfair competition law is preferable as protection system. The Groups from Finland, Luxembourg, UK and USA think that rather than creating a specific registration system, GIs should be included in the collective mark system. This possibility is also mentioned by the Swiss Group. The Group from Luxembourg notes that protecting GIs as collective marks would have the advantage that conflicts could be resolved according to well established principles of trademark law.

The Group from New Zealand thinks it is not appropriate to categorically state that countries should implement registration systems because this issue will necessarily involve political, social, historical and economic considerations that are peculiar to each country in question.

*If so, what should the key features of such system be?*

The Belgian, French, Hungarian, Italian and Norwegian Groups are of the opinion that the key features of such registration system should mirror the EU protection system relating to GIs. The Estonian Group thinks that the GI registration system should be modelled after the trademark system.

The Group from New Zealand proposes that if national systems are put in place, they should include provisions for:

- An examination procedure allowing for a case by case analysis of each application
- Transparency: publication of application, easy access to information contained on Register
- Recognition of prior rights, ability to refuse/oppose registration on the basis of prior rights
- Ability to appeal decisions, including access to national courts

*Should a multilateral system of registration of GIs be established?*

The majority of the Groups who responded to this question, think that a multilateral system of registration of GIs should be established (Argentina, Bulgaria, Brazil, Chile, Croatia, China, Denmark, Egypt, France, Greece, Hungary, Italy, Latvia, Malaysia, Mexico, Norway, Philippines, Portugal, Slovenia, Spain, Switzerland, Thailand, Venezuela). The Groups from Luxembourg and UK favour a multilateral system for collective marks.

The Groups from Australia, Canada, Germany, Japan, and USA do not consider it necessary to establish a multilateral system of registration. The Groups from Australia, New Zealand, and USA, more specifically, oppose any proposals to strengthen rights in relation to GIs. Their view is that a system of compulsory implementation places unnecessary burden on countries. Australia and New Zealand are not averse to adopting a voluntary multilateral system if it is limited to wines and spirits, if participation is voluntary, if it acts as source of information only, if it preserves existing balance of rights and obligations in TRIPs and territoriality of IP rights.

Australia is a co-sponsor of the Joint Proposal for a Multilateral System of Notification and Registration of Geographical Indications for Wine and Spirits which proposes the establishment of a voluntary multilateral system of notification and registration of GIs for wines and spirits.

*If so, what should the key features of such multilateral system be?*

The Spanish Group advise to adopt a new International Agreement (Lisbon II) with the following key-elements:

- Uniformity, universally applicable principles, minimum standards of protection
- Priority of GIs over ordinary distinctive sign
- Principle of co-existence between the GI and an earlier trademark, unless the trademark has acquired a reputation before the date of registration of the GI (Copenhagen Resolution)
- Establishment of an Office or Central Bureau

The Groups from New Zealand and the Philippines propose to model the multilateral system after the PCT system for patents. Specifically, the Group from New Zealand mentions the following key-elements of such multilateral registration system:

- International notification and/or registration based on a national application or registration
- Pro forma examination of the application for compliance with application formalities.
- Notification of the international application through an international body to participating states
- Substantive Examination at the national level
- Notification of application at national level
- Ability of third parties to challenge application and/or registration before national offices on the basis of prior rights, including appeals to national courts

Alternatively, the Groups from Croatia, Egypt, France, Hungary, New Zealand, Norway and Switzerland think that the concept and design of the multilateral system could be similar to the Madrid system for trademarks. Specifically, Switzerland proposes the following key-elements of such multilateral registration system:

- One single application
- Specification requirement
- International protection
- Product neutral protection, i.e. registration system should not be limited to foodstuffs, wines and spirits, but extend to handicraft, glass, etc. (also mentioned by Swedish Group Report)
- Mutual recognition (also mentioned by Italian Group Report)
- No protection for generic terms in country of origin
- Prohibition of additions such as kind, type, imitation
- compliance with laws, in particular prior rights
- Ability of third parties to challenge application and/or registration before national offices on the basis of prior rights, including appeals to national courts (also mentioned by Slovenian Group Report)

*Specifically, which international body should be tasked with establishing such system?*

All Groups who responded to this question, save Brazil and Switzerland, think that WIPO should be tasked with establishing such system. Brazil and Switzerland are of the opinion that WTO should be assigned this task. Switzerland mentions that WIPO should instead be tasked with operating the registry. The Danish, Peruvian and Latvian Groups think that either WTO or WIPO could be tasked with establishing a multilateral registration system.

*How should the application for or registration of a GI be notified/made public (either in your country or at a multilateral level) in order to avoid that a trademark may conflict with a GI previously unknown to the trademark owner*

There is no general consensus. Some of the Groups are of the opinion that the application for or registration of a GI should be notified to local trademark office and made public locally (Argentina, Greece, Peru). Other Groups think that the application for or registration of a GI should be made public at a multilateral level (China, Denmark, Latvia, Norway, Spain). A number of Groups believe that the application for or registration of a GI should be made public both locally and at a multilateral level (Croatia, Hungary, Malaysia, Panama, Philippines, and Venezuela). The Groups from Croatia, Egypt, France, Hungary, and Norway think that it should be published similar to the Madrid trademark system (i.e. notification to member states and publication in International Gazette). The Groups from Australia, Estonia, Malaysia, and Switzerland, propose the use of a database which is searchable online, free of charge and readily accessible to the public.

- 12) *Do you have any suggestions as to the acquisition, maintenance, scope and enforcement of GI protection? What should the scope of protection of a GI be?*

The South African Group believes that GI protection should generally be aligned with trade mark protection.

The Brazilian Group thinks that due to the nature of GIs the requirements for acquisition and maintenance should be more stringent than for trademarks, but in return the scope of protection should also be more extensive. The Danish Group is also of the opinion that more stringent requirements should be made for acquisition and maintenance of GIs. Specifically, the Danish Group proposes to require proof of continued use in accordance with the specification every 5 to 10 years in order to maintain GI protection. The Portuguese Group discusses the possibility of introducing compulsory renewal fees.

As to scope of protection, the Malaysian Group thinks that GIs should be protected against misleading use. The UK Group is of the opinion that GIs should also be protected against dissimilar use.

As to enforcement, the Swiss Group notes that if the WTO were tasked with establishing a multilateral system, the WTO dispute settlement procedure could be used to settle GI disputes. Alternatively, WIPO arbitration procedures could be used for enforcement.

*Should the legal rules established for appraising the acquisition, maintenance, scope and enforcement of trademark protection apply to the appraising of the acquisition, maintenance, scope and enforcement of GI protection?*

The Groups from Croatia, China, Hungary, and Mexico think that the legal rules established for appraising the acquisition, maintenance, scope and enforcement of trademark protection should also apply to the appraising of the acquisition, maintenance, scope and enforcement of GI protection. The Chinese and Croatian Groups emphasise the importance of taking into account the peculiarities of GIs. The Groups from Brazil, Czech, France, Indonesia, Panama,

Peru, Romania, Russia, and Spain think that the trademark rules should not apply to the appraising of the acquisition, maintenance, scope and enforcement of GI protection. The Malaysian Group is of the opinion that the trademark rules should only provide guidance.

The German Group thinks that the trademark rules should only be applicable to the appraising of the acquisition, maintenance, scope and enforcement of collective and certification marks.

13) *Should a protection of GIs by individual and/or collective or certification marks be possible?*

The Groups from Australia, Belgium, Brazil, Canada, Croatia, Czech Republic, Japan, New Zealand, the Philippines, Romania, Slovenia, Republic of Korea, Singapore, Slovenia, Switzerland, Thailand, and USA think that a protection of GIs by individual marks should be possible. The Spanish Group is of the opinion that a protection of GIs by individual marks should be possible if the trademark applicant also holds GI protection. The Russian Group Report takes a similar position. The Groups from Argentina, Denmark, France, Germany, Hungary, Indonesia, Malaysia, Mexico, New Zealand, Norway, Panama, Paraguay, Peru, Portugal, Slovenia, South Africa, UK, and Venezuela, think that a protection of GIs by individual marks should not be possible.

All countries which responded to this question, save Argentina, France, Indonesia, Mexico, New Zealand, Norway, Panama, Paraguay, and Venezuela, think that a protection of GIs by collective or certification marks should be possible. The Swiss Group notes that a lower threshold of distinctiveness should apply to collective and certification marks.

14) *How should conflicts between trademarks and GIs be resolved? Please propose a specific rule for determining whether trademark or GI should prevail, which is likely to be broadly accepted. If co-existence is contemplated, should such co-existence be limited to the country of origin or relate to the relevant markets?*

The Groups from Argentina, Australia, Brazil, Croatia, Germany, Hungary, Latvia, Luxembourg, Portugal, Slovenia, South Africa, Sweden, Switzerland, and USA think that conflicts should be resolved on a "first in time, first in right" basis. Many of these Groups note that each case should be considered in light of the specific facts and that some exceptions to this general rule may apply. For example, the Swiss Group notes that a prior trademark should not prevail over GI if it has become generic. Conversely, a prior GI which is no longer seriously used should not prevail over a subsequent trademark. The Latvian and Swedish Groups think that the only acceptable exception to the "first in time, first in right"-rule would be if the trademark misleads the public. The Brazilian Group is of the opinion that an exception from the "first in time, first in right"-rule should be made for a notorious GI, whereas Luxembourg thinks an exception should be made for a famous or well known trademark. The Groups from Estonia and Latvia believe that an exception should be made for trademarks relating to wines over which GIs should prevail. A similar position seems to be taken in the Australian Group Report.

The Group from Argentina notes that if an exception is made from the "first in time, first in right"-rule and a GI prevails over a prior trademark, the trademark owner should be indemnified and a phase out period foreseen. A similar position is taken in the Swiss Group Report.

The Groups from Greece, Egypt, Panama, and Venezuela think that GIs should generally prevail over trademarks. The Greek Group is of the opinion that an exception from this rule should be made for a notorious trademark. The Malaysian Group thinks that GIs should prevail over trademarks except where such trademarks were used or registered in good faith before the GI was protected in its country of origin in which case co-existence should be contemplated.

The Groups from Argentina, Paraguay and the USA think that co-existence could in no event be justified. The US Group notes that co-existence undermines exclusivity and the "first in time, first in right"-rule. The South African Group is of the opinion that honest concurrent use or other special circumstances may permit co-existence. The Swedish Group seems to take a similar position. The Groups from Greece, Egypt, Czech Republic, and Panama think that where GIs do not prevail over trademarks, the two should at least co-exist.

If co-existence is contemplated, the Czech, Greek, Egyptian and Italian Groups think that such co-existence should be limited to the country of origin. The Groups from Croatia, Denmark, Malaysia, Norway, Panama, Romania, Slovenia, and Switzerland think such co-existence should be limited to the relevant markets.

The French, Norwegian, Spanish and UK Groups basically favour resolving conflicts on the basis of the current EU system. The Spanish and UK Group Reports propose the following conflict rules:

- A trademark is unregistrable/invalid if it conflicts with a prior GI
- A trademark for dissimilar goods is unregistrable/invalid if it takes unfair advantage of a prior GI (The Spanish Group Report makes reference to the previous AIPPI resolution Q 62 adopted in Rio de Janeiro)
- A GI is only unregistrable/invalid if it conflicts with a prior trademark with a reputation and provided that the use of the GI would deceive consumers or cause confusion because of the reputation of the trademark and the length of time that the trademark has been used and the extent of such use
- The use of (even a prior) trademark is generally unlawful if it conflicts with a GI except where the trademark was registered in good faith before the application for the GI was filed, or before January 1, 1996, and there are no grounds for revocation of the trademark – in which case the use of the trademark is lawful and the proprietor may continue to use it (co-existence).

### **III) Conclusion**

There is no general consensus among the Groups as to adoption of uniform rules. To some extent, this result mirrors the debates within the WTO TRIPS Council to establish a multilateral system of notification and registration of GIs for wines and spirits and extending the higher level of protection beyond wines and spirits, where currently little progress is made. AIPPI should nevertheless take on the challenge to put together a Resolution on this Question addressing all relevant issues as addressed in above questions 11–14. Specifically, AIPPI should address these issues, irrespective of whether national and/or multilateral registration systems are put in place on a mandatory or voluntary basis. In putting together a Resolution AIPPI should also take into account the previous work of AIPPI, notably the Resolution Q118 adopted in Copenhagen in June 1994 (Yearbook 1994/II, pages 408–412) as well as the deliberations of Q62 in Rio de Janeiro in May 1998 (Yearbook 1998/VIII, pages 389–392).