



The international framework for the protection of geographical indications

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International treaties relevant to the protection of GIs

- At the international **multilateral** level, five treaties are relevant:
 - the Paris Convention for the Protection of Industrial Property, 1883 (as amended)
 - the Madrid Agreement on the Repression of False or Deceptive Indications of Source on Goods (1891)
 - the Madrid Agreement Concerning the International Registration of Marks (1891)
 - the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, 1958
 - the Agreement on Trade-related aspects of Intellectual Property Rights (TRIPS), 1994

The Paris Convention - general information

- The Paris Convention for the Protection of Industrial Property was concluded in 1883 and amended several times: the most recent act is the Stockholm Act of 1967
- Membership: 172 States (on January 15, 2008)
- The Paris Convention establishes the basic international multilateral legal framework for the protection of industrial property
- Its substantive provisions (Articles 1 to 12 and 19) are incorporated into the TRIPS Agreement by reference (TRIPS Article 2.1)



The Paris Convention - Provisions relevant to the protection of GIs (1/4)

- Indications of source, **appellations of origin** and the repression of unfair competition are expressly recognized as objects of protection of industrial property (Article 1(2))
- Obligation to refuse or invalidate the registration, and to prohibit the use without authorization, either as trademarks or as elements of trademarks, of armorial bearings, **flags**, and other **State emblems**, of the countries of the Paris Union that have been communicated to WIPO (Article 6*ter*)
 - NOTE: flags must be protected even if not communicated to WIPO



The Paris Convention - Provisions relevant to the protection of GIs (2/4)

- Goods unlawfully bearing a **false indication of the source** of the goods must be **seized on importation**. Additionally, the following **measures** should be available:
 - seizure in the country where the unlawful affixation of the false indication of source occurred
 - prohibition of importation or seizure inside the country, if the legislation does not permit seizure on importation (Articles 9 and 10)
- Seizure may take place at the request of the public prosecutor, or any other competent authority, or any interested party, in conformity with the domestic legislation of each country




The Paris Convention - Provisions relevant to the protection of GIs (3/4)

- **Standing to sue:** any producer, manufacturer, or merchant engaged in the production or trade of the relevant goods and established in the locality falsely indicated as the source, in the region where such locality is situated, in the country falsely indicated, or in the country where the false indication of source is used, must be deemed an **interested party** (Article 10)
- Federations and **associations** representing interested industrialists, producers, or merchants must be allowed to take administrative or judicial **action** to obtain repression of acts that imply the use of false indications of source or are acts of unfair competition (Article 10*ter*)



The Paris Convention - Provisions relevant to the protection of GIs (4/4)

- Obligation to assure effective protection against acts of **unfair competition**. Unfair competition is defined as: any act of competition **contrary to honest practices** in industrial or commercial matters
- The following acts, in particular, must be prohibited:
 - acts likely to create **confusion** by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor
 - false allegations in the course of trade likely to **discredit** the establishment, the goods, or the activities, of a competitor;
 - indications or allegations liable to **mislead** the public as to the nature, manufacturing process, characteristics, suitability for their purpose, or quantity, of the goods



The Madrid Agreement (Indications of Source) - general information

- The Madrid Agreement on the Repression of False or Deceptive Indications of Source on Goods was concluded in 1891 and amended several times: the most recent amendment is the Additional Act of Stockholm, of 1967
- Membership: 35 States (on January 15, 2008)
- The Madrid Agreement (Indications of Source) was concluded as a special agreement to supplement the Paris Convention
- Its purpose is to improve and expand the provisions of the Paris Convention regarding the repression of false indications of source




The Madrid Agreement (Indications of Source) - Main provisions (1/2)

- Goods bearing a **false** or **deceptive** indication by which one of the countries to which the Agreement applies, or a place situated therein, is **directly** or **indirectly** indicated as being the country or place of origin must be seized on importation
- Seizure may also be effected in the country where the false or deceptive indication of source has been applied, or into which the goods bearing the false or deceptive indication have been imported
- Alternative measure: prohibition of importation, if the laws of a country do not permit seizure upon importation
- In the absence of special sanctions in the law to repress false or deceptive indications of source, the sanctions relating to marks or trade names are applicable



The Madrid Agreement (Indications of Source) - Main Provisions (2/2)

- Seizure must take place at the instance of the **customs** authorities, who must immediately inform the interested party in order that such party may take appropriate steps
- The **public prosecutor** or any other competent authority may demand seizure either at the request of the injured party or *ex officio*
- **Advertising and communications:** obligation to prohibit the use, in connection with the sale or display or offering for sale of any goods, of all indications in the nature of publicity capable of deceiving the public as to the source of the goods, and appearing on signs, advertisements, invoices, wine lists, business letters or papers, or any other commercial communication



The Madrid Agreement (International Registration) - general information

- The Madrid Agreement Concerning the International Registration of Marks was concluded in 1891 and amended several times, most recently in 1967
- Membership: 81 States (on January 15, 2008)
- Legal framework
 - Two treaties
 - Madrid Agreement- (1891) - last revised 1967
 - Madrid Protocol - 1989 (operational since 1996)
 - Common Regulations - (1996) - 1 April 2004
 - Administrative Instructions - 1 January 2005
 - Laws and regulations of Contracting Parties



The Madrid Agreement (International Registration) - general information (cont.)

- Objectives of the Madrid Agreement and Madrid Protocol:
 - **Facilitate** the protection of marks in export markets by providing a simple, fast and economical procedure that allows the user to
 - **obtain** a trademark with effects in foreign territories
 - **administer** that registration subsequently
 - Offer trademark owners an **alternative** and **optional** route to register their marks in foreign jurisdictions

The Madrid Agreement: international registration vs. national route

National Route

Different procedures

Different languages

Different fees in
different currencies

Recording of changes:
multiple procedures

Representative required
from the outset

Madrid Route


One procedure

One language

One set of fees in
Swiss Francs


Recording of changes:
one procedure

Representative required
only in case of refusal



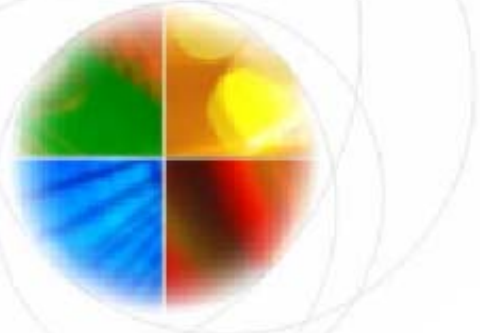
The Madrid Agreement (International Registration) – main features (1/3)

- An **international register** for marks coupled with a **procedure** for registration. The register is operated by the International Bureau of WIPO (Geneva)
- **Attachment** (link) criteria: establishment, domicile or nationality in a Contracting Party
- **Extension**: a registration extends only to Contracting Parties expressly **designated** by the applicant. **Subsequent** designations are possible
- An **alternative** system of registration - does not replace national or regional systems
- **National** or regional legislation governs the substantive rights in respect of a mark registered under the Madrid System (except the term of registration)



The Madrid Agreement (International Registration) – main features (2/3)

- Registration procedure under the Madrid System
- Basic **registration** (or **application**) of the mark in a Contracting Party (office of origin)
- **Filing** of the international application with the office of origin. The office of origin certifies conformity with the basic registration (or application) and forwards the application to the International Bureau of WIPO (IB)
- WIPO examines compliance with **formal** requirements, classification and specification of the goods and services, and payment of fees. WIPO **registers** the mark, **publishes** the registration in the Gazette and **notifies** all designating Contracting Parties
- Designated Contracting Parties can **refuse** protection by notifying WIPO within 12 (18) months. **Remedies** possible in accordance with the national law of the refusing Contracting Party



The Madrid Agreement (International Registration) – main features (3/3)

- Principles of protection
 - **Effects** of international registration : if protection is not refused, the mark enjoys in the designated Contracting Party the **same protection** as if registered directly with the office of that Contracting Party
 - **Term: 10 years renewable** on request to WIPO. Grace period for renewal (six months)
 - **Dependency**: During the first **five years** the international registration is linked to the basic registration; a “**central attack**” on the basic registration will affect the international registration. It is possible to **transform** the international registration into national or regional registrations

The Lisbon Agreement

- The Lisbon Agreement for the Protection of Appellations of Origin and their International Registration was concluded in 1958; came into force in 1966
- Membership: 26 States (on January 15, 2008) :
 - Algeria, Bulgaria, Burkina Faso, Congo, Costa Rica, Cuba, Czech Republic, Democratic People 's Republic of Korea, France, Gabon, Georgia, Haiti, Hungary, Iran (Islamic Republic of), Israel, Italy, Mexico, Montenegro, Nicaragua, Peru, Portugal, Republic of Moldova, Serbia, Slovakia, Togo, Tunisia
- 884 appellations of origin registered in the International Register, of which 810 are in force (February 15, 2008)



Objectives of the Lisbon system

- **Facilitate** the protection of **appellations of origin** (AO) in the member countries of the Lisbon Agreement through a simple, fast and economic procedure, which allows users to:
 - **obtain** a registration for an appellation of origin with legal effects in member countries
 - **administer** that registration subsequently
- Provide users of appellations of origin with an **alternative** and **optional** procedure to obtain protection for their appellations in member countries

International registrations of AO by country of origin (on February 15, 2008)

Country of origin	Total
France	564
Czechoslovakia	108
Bulgaria	50
Hungary	28
Italy	28
Georgia	20
Algeria	19
Cuba	19
Mexico	12
Czech Republic	8
Portugal	8
Tunisia	7
Dem. Peoples Rep. of Korea	4
Peru	3
Montenegro	2
Slovakia	2
Israel	1
Moldova	1
Total	884



The Lisbon System - Principles (1/2)

- Establishes an **international register** for appellations of origin and a **procedure** for their registration
- Establishes a **definition** of *appellation of origin*:
 - 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
- **Flexibility**: in practice **traditional appellations** that have the “quality link” can be assimilated to appellations of origin: e.g. MUSCADET (N° 279, wine, France), REBLOCHON (N° 458, cheese, France), VINHO VERDE (N° 564, wine, Portugal), GRAVES (N° 99, wine, France)

The Lisbon System - Principles (2/2)

- **Principles of protection**
 - **Prior recognition in country of origin.** An AO must be recognized and protected as such in its country of origin prior to international registration
 - **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
 - **Any sort of product** may be designated by an AO, ranging from natural products (e.g. mineral water, marble) to manufactured products (e.g. crystal-ware, porcelain), including agricultural, food and handicraft products



The Lisbon System - Registration (1/3)

- **Procedure for registration**

- > **Application** must be filed with WIPO (en English, French or Spanish) through the competent **authority** of the country of origin, on behalf of the holders of the right to use the appellation of origin
- > WIPO **registers** the AO in the International Register, **notifies** all the countries of the Lisbon Union and **publishes** the AO in bulletin "Appellations of Origin"
- > A country may **refuse** (totally or partially) protection of the AO if it notifies WIPO within **one year** indicating the **grounds**. Refusal is recorded, notified and published by WIPO
- > **Remedies** possible as per law of refusing country



The Lisbon System - Registration (2/3)

- **Effects of international registration :**

States that have not refused a notified AO within 12 months from receipt of the notification

- must **ensure protection** of the appellation against **usurpation** or **imitation**, even if the true origin of the product is stated, or if the appellation is used in translated form or accompanied by a disclaimer or a delocalizer (“type”, “method”, “system”)
- may **not** regard the appellation as **generic** as long as it remains protected as an appellation of origin in its country of origin



The Lisbon System - Registration (3/3)

- **Effects of international registration (cont):**
 - **Term:** Protection of the appellation of origin in each member country that has not refused protection continues as long as the appellation is protected as such in its country of origin
 - **No renewal** is required to maintain the international registration
 - **Legal proceedings** to protect the appellation may be taken **ex officio** by a competent authority, at the request of the public prosecutor, or by **any interested party** (public or private)

Procedures after registration

- **Withdrawal** of declaration of refusal:
 - at any time
 - in whole or in part (inter-party negotiation possible)
- **Period to terminate use** by third parties
 - may be granted by competent authority of country
 - maximum period two years (negotiation possible)
- **Modifications** - at request of country of origin
 - change in holder of right to use the AO
 - change in name or address
 - modification of the specified area of production
 - modification of the provisions that recognize the AO
 - renunciation of protection in one or more countries
- **Invalidation:** before the competent authorities of the country in which invalidation is sought



Fees - examples

	Swiss Fr.	US\$ (aprox.)
Registration of one appellation of origin (indefinite duration, in all member countries)	500	417
Modification of registration	200	167
Certification or extract from International Register	90	75
Attestation or information in writing on contents of International Register	80	67

The TRIPS Agreement - general information

- The Agreement on Trade-Related aspects of Intellectual Property Rights (TRIPS) was concluded in 1994 (as an Annex to the Agreement establishing the World Trade Organization (WTO))
- It came into force in 1995, and in 2000 for developing countries generally (with exceptions for certain provisions and for LDCs)
- Membership: 151 Members (on February 15, 2008)
- The TRIPS Agreement is the first comprehensive international multilateral agreement covering all major areas of intellectual property



The TRIPS Agreement - Provisions relevant to the protection of GIs (1/5)

- Recognition of **geographical indications** as a specific object of protection (Article 22(1), defined as:
 - “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”
- Obligation to provide the legal **means to prevent**:
 - 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
 - any use that constitutes an act of **unfair competition** within the meaning of Article 10*bis* of the Paris Convention
- Freedom for Members to determine the method of implementing provisions on GIs under their legal systems (Article 1.1)



The TRIPS Agreement - Provisions relevant to the protection of GIs (2/5)

- Obligation to refuse or invalidate the registration of a **trademark** that 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 **may mislead the public** as to the true place of origin (Article 22.3)
- **Homonymous GIs**: protection of a GI is applicable against another 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 22.4)
 - Homonymous GIs for **wines** (at least) must be allowed to **coexist** (except if public confusion is unavoidable). Each Member can determine the practical conditions to differentiate the homonymous indications (Article 23.3)



The TRIPS Agreement - Provisions relevant to the protection of GIs (3/5)

- **Objective** (stronger) **protection** for GIs for **wines** and **spirits** (Article 23):
- Obligation to provide legal means to prevent use of a GI identifying wines or spirits used for wines or spirits not originating in the place indicated by the GI, even where the true origin of the goods is indicated (e.g. a disclaimer or delocalizer) or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like
- The registration of a **trademark** for wines or spirits that contains or consists of a GI identifying such goods must be **refused** or invalidated with respect to goods not having the indicated origin



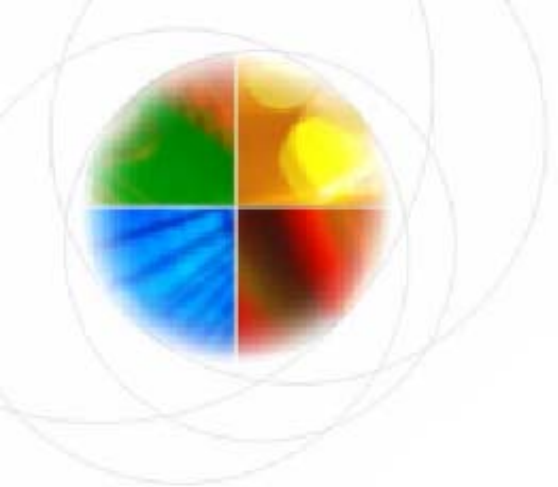
The TRIPS Agreement - Provisions relevant to the protection of GIs (4/5)

- **Exceptions and limitations** (Article 24) :
- No obligation to protect GIs that are not or cease to be protected in their **country of origin**, or which have fallen into disuse in that country
- **Generic names:** No obligation to protect a GI of another Member for goods or services for which the indication is a customary term or the common name
- **Acquired rights:** No obligation for a Member to prevent **continued and similar use** of a GI of another Member for wines or spirits in connection with goods or services by its nationals or domiciliaries who used that GI continuously, with regard to the same or related goods or services in the territory of the Member, in good faith prior to 15 April 1994, or (regardless of good faith) for at least 10 years preceding that date



The TRIPS Agreement - Provisions relevant to the protection of GIs (5/5)

- **Exceptions and limitations** (continuation) :
- **Acquired rights:** A mark that is identical with, or similar to, a GI may not be refused protection nor prevented from being used, if rights in it were **acquired in good faith** before the date of application of TRIPS provisions on GIs in the Member, or before the GI was protected in its country of origin
- **Statute of limitations** to stop the use or invalidate the registration of a mark that is in conflict with a protected GI: time limit of not less than **five years** after the use of the protected GI has become known or after the date of registration of the mark, provided the GI was not used or registered in **bad faith**
- **Coexistence of later GI with earlier mark:** e.g. EU Regulation on GIs -- possible exception to exclusive rights in marks (TRIPS Article 17): see WTO panel report in case EU vs. US and AU (March 2005)



Concluding remarks

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