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An Agricultural Law Research Article

***Sui Generis* Protection of Geographical Indications**

by

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Originally published in DRAKE JOURNAL OF AGRICULTURAL LAW
9 DRAKE J. AGRIC. L. 359 (2004)

www.NationalAgLawCenter.org

SUI GENERIS PROTECTION OF GEOGRAPHICAL INDICATIONS

*Bernard O'Connor**

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* Bernard O'Connor, Belgium. See <http://www.oconnor.be>. This article is an adaptation of a speech presented at the Second Meeting of ORIGIN (Organisation for an International Geographical Indications Network) on November 28, 2003 in Alicante (Spain). See <http://www.origin-gi.com>. The author would like to thank his colleague Irina Kireeva for her research and comments on this article.

I. INTRODUCTION

The WTO Agreement on Trade Related Aspects of Intellectual Property Rights (“TRIPS Agreement”) does not mandate a specific system for the protection of geographical indications.¹ There is an ongoing debate as to whether specific legislation is required or whether consumer or unfair competition protection laws are sufficient. In addition, some WTO members assert that trademark law is an adequate means of providing for the protection of geographical indications.²

That being said, there is an increasing incidence of WTO member countries adopting specific legislation to define and protect geographical indications. This article will examine the common elements and differences in these *sui generis* rules. A list of the specific laws under review is found in Appendix A. At the time of writing this Article, the author is aware of twenty specific rules seeking to protect geographical indications, including the rules for the European Union (EU).³

The article is intended as a guide to various issues that can be addressed when specific rules for the protection of geographical indications are drafted and adopted. We highlight those laws that provide a comprehensive approach, addressing the issue of protecting geographical indications.

II. WHAT ARE APPELLATIONS OF ORIGIN AND GEOGRAPHICAL INDICATIONS?

Historically, the first system for the protection of geographical signs was the system for the protection of appellations of origin. A protected appellation of origin is “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

1. DANIEL GERVAIS, *THE TRIPS AGREEMENT: DRAFTING HISTORY AND ANALYSIS* 191 (2d ed. 2003); *see also* Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization [hereinafter WTO Agreement], Annex 1C, LEGAL INSTRUMENTS—RESULTS OF THE URUGUAY ROUND vol. 31, 33 I.L.M. 81 (1994) [hereinafter TRIPS Agreement]; WTO, TRIPS: A MORE DETAILED OVERVIEW OF THE TRIPS AGREEMENT, [hereinafter DETAILED OVERVIEW], at http://www.wto.org/english/tratop_e/trips_e/intel2_e.htm (last visited Mar. 21, 2005).

2. *See generally* GERVAIS, *supra* note 1, at 191 (comparing different kinds of trademark and geographical indication systems).

3. *See* WIPO, *COLLECTION OF LAWS FOR ELECTRONIC ACCESS (CLEA): REGIONAL LEGISLATION AND MULTILATERAL TREATIES, BY SUBJECT MATTER*, at http://www.wipo.int/clea/en/clea_tree_org.jsp?collapse=node1,APO#node1,APO (last visited Mar. 21, 2005).

natural and human factors.”⁴ This definition contains three elements: (1) the appellation must be the geographical name of a country, region or locality; (2) the appellation of origin must serve to designate a product originating in the country, region or locality referred to; and (3) a qualitative link between the product and the geographical area, or in other words, the “quality and characteristics” must be due exclusively or essentially to the geographical environment.⁵

If the qualitative link is insufficient because the characteristic qualities are due only minimally to the geographical environment, the name is not an appellation of origin, but merely an indication of source. The quality link includes natural factors, such as soil or climate, as well as human factors, such as the special professional traditions established by the producers in the particular geographical area.⁶

The first product that was specifically protected via legislation concerning its appellation of origin was the French cheese Roquefort, dating back to the 15th century.⁷ In addition, more general pieces of legislation were developed to provide a remedy against fraudulent commercial practices involving the origin of agricultural products and, in particular, products of the vine.

Appellations of origin and indications of source⁸ were explicitly mentioned as objects of industrial property protection under Article 1(2) of the Paris Convention of 1883.⁹ The 1958 Lisbon Agreement on Appellation of Origin was

4. Lisbon Agreement for the Protection of Origin and their International Registration, Oct. 31, 1958, *as amended* Sept. 28, 1979, art. 2(1), [hereinafter Lisbon Agreement] at http://www.wipo.int/lisbon/en/legal_texts/lisbon_agreement.htm (last visited Mar. 24, 2005); *see also* Council Regulation 2081/92 on the Protection of Geographical Indications and Designations of Origin for Agricultural Products and Foodstuffs, art. 2(2)(a), 1992 O.J. (L 208) 1, 3 [hereinafter Regulation 2081/92].

5. *See* Regulation 2081/92, *supra* note 4, at art. 2(2)(b).

6. STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHIC INDICATIONS, WIPO, GEOGRAPHICAL INDICATIONS, SCT/10/4, at 5 (10th sess. 2003), *available at* http://www.wipo.int/sct/en/documents/session_10/pdf/sct_10_4.pdf.

7. *See* JAMES T. EHLER, FOOD REFERENCE WEBSITE, FOOD FACTS & TRIVIA: ROQUEFORT CHEESE, at <http://www.foodreference.com/html/froquefortcheese.html> (last visited Jan. 21, 2005) (stating “In 1411 Charles VI of France gave sole rights to the ageing of Roquefort cheese to the village Roquefort-sur-Soulzon, and all Roquefort still must be aged in the caves there today.”).

8. “Indication of source” are signs that indicate a product originates in a specific geographical region, for example, labels saying “Made in Germany”, “Product of the USA” or “Swiss Made”. They are not protected via intellectual property rights and as such, could be used on all products; nevertheless, these signs must indicate the true origin of the good.

9. Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, art. 1(2), (as revised at Brussels (1900), Washington (1911), The Hague (1925), London (1934), Lisbon (1958), and Stockholm (1967), and amended in 1979) [hereinafter Paris Convention], *available at* http://www.wipo.int/treaties/en/ip/paris/pdf/trtdocs_wo020.pdf. As of May 15, 2004, the Paris Convention had 164 signatory states.

the first international treaty that provided a proper definition of appellation of origin and extended protection to:

“... any usurpation or imitation, 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”.¹⁰ However, this protection was based on national registration of the appellations of origin, and therefore, the protection was available only for countries that already had specific legislation in place. Thus, states that protected this form of intellectual property under unfair competition or consumer protection laws in lieu of more specific pieces of legislation were effectively locked out. In addition, the Lisbon Agreement did not make exceptions for geographical indications that had already become generic in some countries. For these reasons, the Lisbon Agreement only attracted support from twenty-two signatories.¹¹ The World Intellectual Property Organization (“WIPO”) then terminated further work on a new treaty for protection of appellation of origin and indications of source when it became apparent that revision of the Paris Convention on the Protection of Industrial Property was required.¹²

Considering the complexity of the issue and variety of concepts involved in the protection of appellations of origin and indications of source, a new term “geographical indication” was introduced. “Geographical indication” is defined by the TRIPS Agreement as:

[I]ndications 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.¹³

This definition expands the concept of “appellation of origin”, contained in Article 2 of the Lisbon Agreement, to protect even those goods that merely derive a reputation from their place of origin, without possessing a given quality or other characteristics that are due to that place.¹⁴

10. Lisbon Agreement, *supra* note 4, at art. 3.

11. As of January 4, 2005, there were twenty-three Contracting Parties to the Lisbon Agreement: Algeria, Bulgaria, Burkina Faso, Congo, Costa Rica, Cuba, Czech Republic, Democratic People’s Republic of Korea, France, Gabon, Georgia, Haiti, Hungary, Israel, Italy, Mexico, Portugal, Republic of Moldova, Serbia and Montenegro, Slovakia, Togo, Tunisia, Yugoslavia. *See id.* at art. 9.

12. WIPO provides protection of geographic indications via the Paris Convention for the Protection of Industrial Property. *See* WIPO, GEOGRAPHICAL INDICATIONS?, at http://www.wipo.int/about-ip/en/about_geographical_ind.html (last visited Mar. 21, 2005).

13. TRIPS Agreement, *supra* note 1, at art. 22.

14. Lisbon Agreement, *supra* note 4, at art. 2 (providing that: “In this Agreement, ‘appellation of origin’ means 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. The country

According to the TRIPS Agreement, in order to be protected, a geographical indication needs to be “an indication,” but not necessarily the name of a geographical place on earth.¹⁵ In other words, geographical indications could be iconic symbols or emblems like the Eiffel Tower to designate a French good, or the Taj Mahal to designate an Indian good, or the Statue of Liberty to designate an American good.

Moreover, designations that are not “direct geographical names”, but are instead traditional names also exist.¹⁶ For example, “Basmati” is taken to be an indication for rice coming from the Indian sub-continent,¹⁷ and “Feta” for cheese from Greece, although these names are designations of a particular place. The only condition imposed by the TRIPS Agreement is the indication in question has to identify goods as originating in a region or a locality of a member territory.

The TRIPS Agreement definition provides WTO Members three methods whereby the protected geographical indication can be linked with the product concerned. These three alternatives are: (1) a given quality; (2) a reputation; or (3) another characteristic of the good which should be “essentially attributable to its geographical origin”.¹⁸ In other words, the TRIPS Agreement provides WTO members with at least three independent criteria for the protection of a given product through a geographical indication: quality, reputation, or other characteristic of the good attributable to its geographical origin.

It is important to note that the meaning of “origin”, as used in TRIPS, goes back to the definition of “appellation of origin” set out in the Lisbon Agreement. Article 2 of the Lisbon Agreement states that to qualify for an appellation of origin, the quality and characteristic of the product originating in the

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.”).

15. See TRIPS Agreement, *supra* note 1, at art. 22.

16. See, e.g., The Geographical Indications of Goods (Registration and Protection) Act, No. 48, § 2 (1999) (India) [hereinafter India Act], available at http://www.wipo.int/clea/docs_new/pdf/en/in/in010en.pdf. It is explained that for purposes of this clause, any name which is not the name of a country, region or locality of that country shall also be considered as a geographical indication if it relates to a specific geographical area and is used upon or in relation to particular goods originating from that country, region or locality, as the case may be.

17. See *id.* (“‘geographical indication’, in relation to goods, means an indication which identifies such goods as agricultural goods, natural goods or manufactured goods as originating, or manufactured in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of such goods is essentially attributable to its geographical origin and in case where such goods are manufactured goods, one of the activities of either the production or of processing or preparation of the goods concerned takes place in such territory, region or locality, as the case may be.”).

18. TRIPS Agreement, *supra* note 1, at art. 22.

place in question must be “due exclusively or essentially to the geographical environment, including natural and human factors”.¹⁹

Experience has shown that natural and human factors are neither easy to define nor to distinguish. For this reason, this phrase has been shortened, in the TRIPS Agreement to “geographical origin”. Despite the shortened phrase, any aspect or element of geographical origin, known or unknown, physical or human, may underpin a quality, reputation or other characteristic of a product identified as originating in a particular place.²⁰

III. COMPARISON OF THE KEY ELEMENTS OF THE *SUI GENERIS* PROTECTION OF GEOGRAPHICAL INDICATIONS

In contrast to the Lisbon Agreement, the TRIPS Agreement obliges WTO Members to directly implement the Agreement provisions into existing national legislation.²¹ Even so, Members were allowed to choose the appropriate ways for implementation; as a result, the Members that did choose to introduce specific legislation did so differently. Therefore, geographical indications implementation has occurred in the most diverse and uncoordinated manner.²² The fundamental distinction among the laws relates to the distinction between registration or non-registration systems.

A. “Passive” or Non-Registration Protection

Generally, protection of geographical indications is based on registration. However, some countries, such as Singapore, do not provide for registration of geographical indications. The 1998 Singapore Geographical Indications Act gives the owner of a geographical indication automatic protection of that geographical indication, just like copyright protection.²³ Section 3 of the Geographical Indications Act states that any interested party may bring an action before a court against any person carrying out any of the following acts:

19. Lisbon Agreement, *supra* note 4, at art. 2.

20. DETAILED OVERVIEW, *supra* note 1.

21. See TRIPS Agreement, *supra* note 1, at art. 1 (proclaiming that “[m]embers shall give effect to the provisions of this Agreement. Members may, but shall not be obliged to, implement in their law more extensive protection than is required by this Agreement, provided that such protection does not contravene the provisions of this Agreement. Members shall be free to determine the appropriate method of implementing the provisions of this Agreement within their own legal system and practice.”).

22. See JAYASHREE WATAL, INTELLECTUAL PROPERTY RIGHTS IN THE WTO AND DEVELOPING COUNTRIES 264 (2001).

23. Geographical Indications Act, No. 44 (1998) (Sing.), available at http://www.wipo.int/clea/docs_new/pdf/en/sg/sg016en.pdf.

(a) the use of a geographical indication in relation to any goods which did not originate in the place indicated by the geographical indication, in a manner which misleads the public as to the geographical origin of the goods;

(b) any use of a geographical indication which constitutes an act of unfair competition within the meaning of Article 10 *bis* of the Paris Convention.²⁴

In the case of geographical indications for wines and spirits, it is possible to bring an action pursuant to the Geographical Indications Act against *any use* of a geographical indication for a product that does not come from the place indicated, even if that geographical indication is used together with the true geographical indication, “the geographical indication is used in translation”, or the “geographical indication [that is] is accompanied by any of the words ‘kind’, ‘type’, ‘style’, ‘imitation’ or any similar word or expression.”²⁵

“*Any use* of a geographical indication within the meaning” of section 3(2) of the Singapore Act is “deemed to be an act to which this section applies even if the geographical indication is literally true as to the geographical origin of the goods in question, provided that such use falsely represents to the public that the goods originate in another place.”²⁶ The “‘use of a geographical indication’ includes the use of a trade mark [that] contains or consists of the geographical indication in question.”²⁷

According to the 1999 Geographical Indication of Goods Act of India, which entered into force in September 2003, the registration of a geographical indication is not compulsory.²⁸ However, registration affords better legal protection to facilitate an action for infringement, because the registered proprietor *and* authorized users can initiate infringement actions.²⁹ In addition, authorized users can exercise the exclusive right to use the geographical indication.³⁰

Latvia takes the same approach. Latvia’s Article 40 of the Law on Trademarks and Geographical Indications provides protection for geographical indications, even in the absence of registration.³¹ As in India, this passive protection supplementary to protection provided through a registration process.

24. *Id.* at § 3(2).

25. *Id.* (emphasis added).

26. *Id.* at § 3(3). (emphasis added).

27. *Id.* at § 3(4).

28. *See* India Act, *supra* note 16, at art. 11.

29. *Id.* at art. 21.

30. *Id.*

31. Law on Trademarks and Indications of Geographical Origin, art. 40(3), (1999) (Lat.) [hereinafter *Latvia Act*], available at http://www.cipr.org/legal_reference/countries/latvia/trademarks_law2LatvEng.pdf.

B. Protection Through Registration

Most specific national rules that protect geographical indications require registration of the geographical indication before protection is afforded. There are a wide variety of registration systems, which are examined below. Specifically, protection of geographical indications and designations of origin in the European Communities ("EC") require prior registration of the names in the EC Register for Protected Geographic Indicators ("PGIs") and Protected Designation of Origin ("PDOs"), established by the Council Regulation 2081/92.³²

1. Names Which Can Be Registered

The EC rules for the protection of geographical indications, as set out in Council Regulation 2081/92, provide that the names of most foods can be registered, including meat, dairy and fish products, fruits and vegetables, beer, beverages made from plant extracts, pasta, bread, pastries, cakes, biscuits and confectionery.³³ The names of natural gums and resins, mustard paste, hay, wool, osier, essential oils (e.g., lavender oil) can also be registered as PDOs or PGIs.³⁴ However, pre-cooked meals, prepared condiment sauces, soups and broths, ice cream and sorbets, and chocolate (and other food preparations containing cocoa) may not be registered.³⁵

Regulation 2081/92 does not allow registration of the names of spirit drinks and wine-sector products, as registration of these names comes within the competence of the individual EC Member States.³⁶ Regulation 692/2003, which amends the basic rules, excludes names of mineral waters from the scope of permissible registered and protected names; however, names that are already registered can remain on the EC Register of protected names until December 31, 2013.³⁷

32. Regulation 2081/92, *supra* note 4, at Preamble.

33. *Id.* at annex I.

34. *Id.*

35. *See id.*

36. Council Regulation 1493/1999 of 17 May 1999 on the Common Organisation of the Market in Wine, 1999 O.J. (L 179) 16, *last amended* by Council Regulation 806/2003 of 14 April 2003 adapting to Council Decision 1999/468/EC the Provisions Relating to Committees Which Assist the Commission in the Exercise of its Implementing Powers Laid Down in Council Instruments Adopted in Accordance with the Consultation Procedure (qualified majority), 2003 O.J. (L 122) 1.

37. Council Regulation 692/2003 of 8 April 2003 amending Regulation 2081/92 on the Protection of Geographical Indications and Designations of Origin for Agricultural Products and Foodstuffs, 2003 O.J. (L 99) 1 [hereinafter Regulation 692/2003].

The names of industrial products are also excluded from the scope of the EC Regulations; however, some EC Member States do provide special protection for particular geographical names of industrial products. For example, German law protects geographical indication for cutlery, scissors, knives, and razor-blades. The “Solingen Decree” of December 16, 1994, protects such products produced in the industrial territory of Solingen that includes the cities of Solingen and Haan.³⁸

In addition to food product name protection, Switzerland has specific legislation dealing with watches, under an ordinance governing the use of the indication “Swiss Made”.³⁹ Watches are deemed to be “Swiss Made” if the movements have been assembled, checked, regulated and tested by the manufacturer in Switzerland, and if the manufacturing steps that took place in Switzerland add up to at least 50% of the value of all the parts, excluding the assembling costs.⁴⁰

Moreover, under WTO law, the use of geographical indications is not limited to agricultural products, but the use of indications extends to industrial products and handicrafts in India,⁴¹ Czech Republic,⁴² Thailand,⁴³ Russia⁴⁴ and Turkey.⁴⁵ Examples of industrial protected names are Kanchipuram silks and Kolhapuri Chappal⁴⁶ in India, Hereke silk and wool hand-made carpets, Bergama hand-made carpets, Erzincan copper handicrafts in Turkey, Jablonecká bižutérie (Jablonec Jewellery), Český křišťál (Bohemia Crystal), Vamberská krajka in the

38. *Verordnung zum Schutz des Namens Solingen*, BGBl. I S.3833) (This Decree replaced the Law for the protection of the name Solingen (German title: *Gesetz zum Schutze des Namens Solingen*) of 25 July 1938, RGBl. I, p. 953).

39. SR 232.119, art. 3 (1971) (Switz.), available at <http://www.fhs.ch/doc/osme.pdf>.

40. *Id.* at art. 4(a).

41. India Act, *supra* note 16, at art. 2.

42. Act on the Protection of Designations of Origin and Geographical Indications and on the Amendment to the Act on Consumer Protection Zákon č. 452/2001 Sb. § 2 (Czech Rep.) [hereinafter Czech Republic Act].

43. See Act on Protection of Geographical Indications, B.E. 2546 (2003) (Thail.) [hereinafter Thailand Act], available at <http://www.dsb.co.th/services/geographical.htm>.

44. Law on Trademarks, Service Marks and Appellations of Origin of Goods, No. 3520-1, art. 30 (1992) (Russ.) [hereinafter Russia Act], available at http://www.mostpatent.vvt/en/_old/texts/n3520_1.htm.

45. Decree-Law on the Protection of Geographical Signs, No. 555, art. 1 (1995) (Turk.) [hereinafter Turkey Act], available at http://www.wipo.int/clea/docs_new/pdf/en/tr/tr013en.pdf.

46. Kolhapurri Chappal is a type of traditional footwear in India.

Czech Republic,⁴⁷ Silk in Thailand, “Gzhel”,⁴⁸ “Khokhloma”,⁴⁹ “Vologodskoe Kruzhevo”,⁵⁰ “Zhostovo”⁵¹ and “Pavlo Posad Shawls” in Russia.

The current TRIPS definition has likely led to its broad use and application, protecting far more products and services than basic agricultural products. The TRIPS definition of geographical indications uses only the terms “goods” or “good” without defining them. Nevertheless, it is commonly agreed that the inclusion of services was not the original intention of the TRIPS Agreement drafters.⁵² However, it should be noted that there are a range of services that, on *prima facie* evidence, fulfil the fundamental definitional requirements, among them health services and traditional healing methods. Therefore, some countries do protect services via geographical indications, among them Latvia,⁵³ Switzerland, Liechtenstein, Peru, Morocco and Korea.⁵⁴

2. Names Which Cannot per se Be Registered

Some systems only allow for the registration of direct geographical names, i.e., indications of geographical places, districts, regions, or in exceptional cases, whole countries.⁵⁵ Other systems permit registration of traditional names and expressions, geographical or figurative representations, or any combination that conveys or suggests the geographical origin of goods. The legislation of certain countries will expressly provide the particular conditions that are required, or allowed, for registration.

For example, India prohibits the registration of geographical indications:

47. Vamberská krajka is the lace of Vamberk, that is available in the Czech Republic.

48. Gzhel is a porcelain from Gzhel, blue on white colour.

49. Khokhloma are hand-made painted articles and matryoshka dolls.

50. Vologodskoe Kruzhevo is lace that comes from Vologda.

51. Zhostovo metal painted trays that are made in Zhostovo.

52. GERVAIS, *supra* note 1, at 191.

53. Latvia Act, *supra* note 31, at art. 41(2) (stating “[i]f goods or services, that are usually marked by an indication of geographical origin, in the perception of consumers and trade circles possess a special quality or special characteristics, the use of such indications of geographical origin in the course of trade shall be permitted only in connection with such goods or services of the said origin and only if they have such qualities or characteristics”).

54. WTO Council for Trade-Related Aspects of Intellectual Property Rights, *Review Under Article 24.2 of the Application of the Provisions of the Section of the TRIPS Agreement on Geographical Indications: Replies by Morocco*, IP/C/W/117/Add.25 (Sept. 16, 2002); *Responses by Switzerland*; IP/C/W/117/Add.13 (Feb. 16, 1999); *Responses from Korea*, IP/C/W/117/Add.20 (Oct. 16, 2000).

55. See, e.g., Russia Act, *supra* note 44, at art. 30 (stating that only “the name of a country, settlement, locality or other geographic place . . . use[d] to designate the special properties of goods . . .” could become an appellation of origin of goods. In exceptional circumstances, a historical geographical name could also be considered for registration).

- a) the use of which would be likely to deceive or cause confusion; or
- b) the use of which would be contrary to any law for the time being in force; or
- c) which comprises or contains scandalous or obscene matter; or
- d) which comprise or contains any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India; or
- e) which would otherwise be disentitled to protection in a court; or
- f) which are determined to be generic names or indications of goods and are, therefore, not or ceased to be protected in their country of origin, or which have fallen into disuse in that country; or
- g) which although literally true as to the territory, region or locality in which the goods originate, but falsely represent to the persons that the goods originate in another territory, region or locality, as the case may be.⁵⁶

In addition, Thai Law prohibits registration of geographical indications that are contrary to public order, morality or public policy.⁵⁷ Moreover, EC Regulation 2081/92 prohibits registration of:

- a) names that became generic,
- b) registered plant variety names,
- c) registered trademarks.⁵⁸

3. *Generic Names and Homonyms*

Generic names and homonyms constitute an area of geographical indications that require special consideration. In general, all legislation will contain two common grounds to refuse registration of geographical indications. The first is a denomination that the indication has become generic and is no longer understood to indicate the specific origin of goods, but merely serves to denote a kind or category of product. The second ground for refusal is when the denomination has previously been registered in good faith as a trademark.⁵⁹

Although few laws provide a definition of “generic” or “homonymous” geographical indications, many laws still refer to these names. For example, definitions of these terms can be found in the Geographical Indications of Goods Act of India and European Council Regulation 2081/92. The EU regulation states:

For the purposes of this Regulation, a ‘name that has become generic’ means the name of an agricultural product or a foodstuff which, although it re-

56. India Act, *supra* note 16, at art. 9.

57. Thailand Act, *supra* note 43.

58. Regulation 2081/92, *supra* note 4, at arts. 3(2), 3(7), 14(7).

59. *Id.* at art. 3(1).

lates to the place or the region where this product or foodstuff was originally produced or marketed, has become the common name of an agricultural product or a foodstuff.⁶⁰

Compare 2081/92 with the Geographical Indications of Goods Act of India which states:

For the purposes of this section, 'generic names or indications,' in relation to goods, means the name of goods which, although relates to the place or the region where the goods was originally produced or manufactured, has lost its original meaning and has become the common name of such goods and serves as a designation for or indication of the kind, nature, type or other property or characteristic of the goods.⁶¹

There are additional laws that refer to "generic" indication. For example, according to Latvian Law, geographical names and signs, or indications of a geographical nature, that consumers and trade circles do not perceive to be connected with the specific origin of the goods or services are considered "generic" and therefore, cannot be protected.⁶² Moreover, Article 3 of EC Regulation 2081/92 states "all relevant factors" must be considered, in order to establish whether a name is generic. These factors include the existing situation in EC Member States where the name originates, the situation in the areas where the product is consumed, the existing situation in the other EC Member States, and the relevant national or community laws pertaining to that product.⁶³ Under this definition, is often difficult to prove that a name has become generic, since, the simple fact that a product is manufactured outside the area of origin does not necessarily imply that the name has become generic.

Not only is the use of generic names addressed by geographical indication legislation, the use of homonymous geographical indication (namely two or more *identical* geographical indications used to designate the geographical origin of products coming from *different* towns, regions or countries) is also addressed by most legislation.

60. *Id.*

61. India Act, *supra* note 16, at art. 9.

62. Latvia Act, *supra* note 31, at art. 40(3).

63. Regulation 2081/92, *supra* note 4, at art. 3(1). The EC Court of Justice echoed Regulation 2081/92 in the famous *Feta* case, stating "in order to determine whether a name has become generic, account is to be taken of all factors, including always those expressly listed, namely the existing situation in the Member State in which the name originates and in areas of consumption, the existing situation in other Member States and the relevant national or Community laws." Case C-289/96, *Denmark v. Commission*, 1999 E.C.R. I-01541, 88, *see also* Bernard O'Connor & Irina Kireeva, *What's in a Name? The "Feta" Cheese Saga*, 2003 INT'L TRADE L. REV. 110, 110-14.

For example, in India, a homonymous geographical indication can be registered only if the Registrar is satisfied that there will be no confusion of the two indications after consideration of the practical conditions under which the homonymous indication in question can or would be differentiated from other homonymous indications.⁶⁴

Another example of homonymous indication legislation is found by following the TRIPS Agreement Article 23.3 provision where particular attention is afforded to homonymous geographical indications for wines. Additionally, the Malaysian Geographical Indications Act of 2000 provides that “in the case of homonymous geographical indications for wines, protection shall be accorded to each indication,” with a determination of the practical conditions for use of these indications.⁶⁵

C. Registration Procedure

1. Who May Apply for Registration?

In some countries, such as within the EC, only certain producers and/or processors (groups or individuals) of agricultural products and foodstuffs are eligible to apply for registration. Those producers who are determined to not fall within the original applicant group, but nevertheless, demonstrate to the nominated inspection body that their product conforms fully with registration specifications, are also allowed to apply for registered names and signs.⁶⁶

Other countries allow not only producers (natural and legal persons), but also consumer associations or public institutions, related to the product or the geographical region to apply for registration.⁶⁷ For example, the category of applicants pursuant to Thai law includes official divisions, government sectors, state enterprises, local administrations or any other government organizations, legal persons responsible for the geographical area in question, as well as all persons, who trade goods with domiciles in the geographical area in question.⁶⁸

64. India Act, *supra* note 16, at art. 10.

65. Geographical Indications Act of 2000, No. 602, § 7 (2000) (Malay.) [hereinafter Malaysia Act], available at http://www.kpdnhep.gov.my/view.php?dbIndex=0&website_id=1&id=77.

66. See Regulation 2081/92, *supra* note 4, at art. 8.

67. See, e.g., Turkey Act, *supra* note 45, at art. 7; see also Geographical Indications Act, No. 22, §8 (1998) (Barb.) [hereinafter Barbados Act], available at http://www.wipo.int/cfdiplaw/en/laws_treaties/ip/t/2003/pdf/bb_5_002.pdf.

68. See Thailand Act, *supra* note 43, at B.E. 2546.

2. What Authorities Are Responsible for Registration of Geographical Indications?

The application for registration of geographical indication must be sent to “the Member State in which the geographical area is located.”⁶⁹ In some EC Member States, such as Italy, Greece, Portugal, Ireland, Finland and Luxembourg, the competent authorities are the Ministries of Agriculture, which have a joint role with the European Commission on verifying applications.⁷⁰ The substantial examination and registration of designations of origin and geographical indications is an area of exclusive competence within the special unit of the European Commission.⁷¹

Many countries have authorized specific divisions of Patent and Trademark Offices to deal with registration of geographical indications. In Estonia, for example, the Ministry of Economic Affairs is the chief processor of registrations for geographical indications, and the Patent Office is authorized to maintain the register.⁷² In Israel, a Register of Appellations of Origin is kept by the Patent Office at the Ministry of Justice.⁷³ In India, the Registrar of Geographical Indications is appointed by the Controller General of Patents, Designs and Trade Marks.⁷⁴ The Turkish Patent Institute,⁷⁵ Bulgarian Patent Office,⁷⁶ Russian Patent

69. Regulation 2081/92, *supra* note 4, at art. 5(4).

70. For more information, see the following agency websites: MINISTRY OF RURAL DEV. AND FOOD, STRATEGIC TARGETS FOR AGRICULTURAL DEVELOPMENT AND RESTRUCTURING OF THE COUNTRYSIDE, at <http://www.minagric.gr/en/> (last visited Mar. 21, 2005) (Greece); MINISTÉRIO DA AGRICULTURA, PESCAS E FLORESTAS, at <http://www.min-agricultura.pt/> (last visited Mar. 21, 2005) (Port.); DEP'T OF AGRIC. & FOOD, at <http://www.agriculture.gov.ie/> (last visited Mar. 21, 2005) (Ir.); MINISTRY OF AGRIC. AND FORESTRY, at <http://www.mmm.fi/english/> (last visited Mar. 21, 2005) (Fin.); GOUVERNEMENT DU GRAND-DUCHÉ DE LUXEMBOURG, ANNUAIRE DES SITES INTERNET PUBLICS DU GRANDE DUCHÉ DE LUXEMBOURG, at <http://www.etat.lu/> (last visited Mar. 21, 2005) (Luxembourg government's main page, with links to various Ministry of Agriculture programs); MINISTERO DELLE POLITICHE AGRICOLE E FORESTALI, at <http://www.politicheagricole.it/> (last visited Mar. 21, 2005) (Italy).

71. See generally Regulation 2081/92 *supra* note 4, at Preamble (indicating that registration should be at the community level).

72. Geographical Indication Protection Act, 1999 RT I 102,907, § 21 (2000) (Est.) [hereinafter Estonia Act].

73. See generally MINISTRY OF JUSTICE, ISRAEL MINISTRY OF FOREIGN AFFAIRS (Apr. 25, 1999) (describing the functions of the Ministry of Justice, including the maintenance of patent registries), available at http://www.mfa.gov.il/mfa/mfaarchive/1990_1999/1999/4/ministry+of+justice.htm.

74. See OFFICE OF THE CONTROLLER GENERAL OF PATENTS, DESIGNS AND TRADEMARKS, at <http://dipp.nic.in/cgpdtn/cgpdtn.htm> (last visited Mar. 21, 2005).

75. TÜRK PATENT ENSTITÜSÜ [Turkish Patent Institute] (administers the Patents Act of 1970, the Designs Act of 2000 and the Trade and Merchandise Act 1958), at <http://www.turkpatent.gov.tr/> (last visited Mar. 21, 2005).

Office,⁷⁷ Armenian Patent Office⁷⁸ and Department of Intellectual Property in Thailand⁷⁹ are the authorities appointed for filing the registration application of geographical indications in their respective countries.

There are also a number of countries that establish specific governmental institutions that coordinate the work of the local administrations in relation to geographical indications. For example, Malaysia established the Central Geographical Indications Office, and the Minister appoints the Registrar, Deputy Registrar and Assistant Registrars of this Office.⁸⁰

3. *What Documents Should Be Submitted?*

Although the list of documents that supplements a registration application of geographical indications differs from country to country, it is generally necessary to provide information concerning:

- a) the name, address and nationality of the person making the application and the capacity in which the applicant is applying for registration;
- b) the geographical indication for which registration is sought;
- c) the geographical areas to which the geographical indication applies;
- d) the goods to which the geographical indication applies;
- e) the quality, reputation or other characteristic of the goods in respect of which the geographical indication is used.

In jurisdictions where the registration is subject to certain fees, the original receipt for the application fee payment must also be provided.⁸¹

Some countries require product description, technical information, and documents explaining the physical, chemical and micro-biological characteristics

76. PATENT OFFICE OF THE REPUBLIC OF BULGARIA, STRUCTURE OF THE PATENT OFFICE, at <http://www.bpo.bg/en/index.html> (last visited Mar. 21, 2005) (demonstrating geographic indicators are within the responsibilities of the Patent Office).

77. ROSPATENT, [Russian Agency for Patents and Trademarks], at <http://www.fips.ru/ruptoen/index.htm> (last visited Mar. 21, 2005).

78. REPUBLIC OF ARMENIA INTELLECTUAL PROPERTY AGENCY, at <http://www.armpatent.org/english/index.html> (last visited Mar. 21, 2005) (having authority pursuant to Government Decree No. 54 and Decree No. 645 to manage intellectual property law).

79. See SAY SUJANTAYA & PIYAWAT KAYASIT, TILLEKE & GIBBINS, THAILAND'S FIRST GEOGRAPHICAL INDICATION ACT 1 (2000), available at http://www.tillekeandgibbins.com/Publications/pdf/geographical_indication_act.pdf.

80. Malaysia Act, *supra* note 65, at § 8.

81. See, e.g., Law on Trademarks, Service Marks, and Appellations of Origin, art. 6(7) (2000) (Arm.) [hereinafter Armenia Act]; Barbados Act, *supra* note 67, at art. 8; Russia Act, *supra* note 44, at art. 8(5); Law of Georgia on Appellations of Origin and Geographical Indications of Goods, art. 9 (1999) [hereinafter Georgia Act], available at <http://www.sakpatenti.org.ge/eng/e-goods.htm>.

of the product.⁸² If necessary, a description of the raw materials and specific conditions of the production methods used and, if relevant, the authentic local techniques and conditions should be included.⁸³ A map of the territory of the county, region, or locality in the country, in which the goods originate or are being manufactured, is also often requested for application.⁸⁴

As one of the important elements of the protection of geographical indications is control of registered names, the information detailing the inspections structure is also required by the laws of some countries. Some countries provide for state control over the quality and origin of products with registered geographical names.

4. *The Examination by the Competent Authorities*

Under EC rules, after registration applications are submitted, preliminary examinations are carried out within a fixed period to ensure the necessary documents are available, and the documents comply with the applicable legal requirements.⁸⁵ Based on the results of this examination, the applicant is informed of either the acceptance or rejection of the application.

The national registration authority further checks whether the name is capable of protection as a geographical indication. If it concludes that the name satisfies the conditions for protection, it advertises the main elements of a registration proposal in the manner prescribed. If, after examination, the national authority concludes that the name does not satisfy the conditions for protection, it rejects the application for registration. Should the applicant disagree with the decision of the national authority in relation to the application, it can challenge the decision in court⁸⁶ or via a specific Appeal Board.⁸⁷ Normally, the applicant also has the option to withdraw the application at any stage of the examination.

82. See, e.g., Regulation 2081/92, *supra* note 4, at art. 4.

83. See, e.g., *id.*; India Act, *supra* note 16, at art. 11; Estonia Act, *supra* note 72, at § 23.6.

84. See, e.g., India Act, *supra* note 16, at art. 11.

85. Regulation 2081/92, *supra* note 4, at art. 6 (providing that within a six month period, the Commission, through a formal investigation, will verify whether the registration application includes all the particular information provided for in Article 4).

86. See, e.g., Barbados Act, *supra* note 67, at § 19; Malaysia Act, *supra* note 65, at § 18.

87. Russia Act, *supra* note 44, at art. 34.

5. *Opposing Registration*

The laws of many countries provide for the possibility to oppose the proposed geographical indication registration within a certain period.⁸⁸ Any natural or legal person with legitimate concern may file an opposition by sending a duly substantiated statement to the competent authority, and a copy of the opposition notice is sent to the applicant.

Different solutions for dealing with registration opposition are evidenced in the different laws.⁸⁹ Usually, the applicant is expected to reply to the opponent with a counter-statement, within the prescribed period (usually between two to six months) and in the prescribed manner, complete with the grounds on which the application is based. However, even if the opponent abandons the statement of opposition, it is usually the responsibility of the registration authority to nevertheless consider the opposition and to make a final decision regarding the registration. In doing so, the registration authority can usually request scientific or technical assistance of various independent bodies.

6. *Registration Periods and Fees*

If there has been no objection to the geographical indication registration within the prescribed period or the objection has been overruled, the national authority registers the geographical indication, issues a certificate of registration to the applicant, and publishes a notice of the registration in an official journal.⁹⁰

The period for application of registration depends on the complexity of the registration procedure and possible opposition procedure. The whole procedure can last for six months in some countries, while in Malaysia or Georgia, the opposition to registration is limited to two and three months, respectively.⁹¹ In Russia or India the procedure can be as long as three to five years, however, due to the opposition procedures there that can lead to court action.⁹² However, the normal period for registration is about one year from the date of application for registration.

In some countries, the protection resulting from the registration of a geographical indication is of unlimited duration; therefore, it is not necessary to request renewal.⁹³ On the other hand, registration can be for a definite period, like

88. Czech Republic Act, *supra* note 42, at § 20.

89. *Id.*

90. *See, e.g., id.* at § 7.

91. *See* Georgia Act, *supra* note 81, at art. 8; Malaysia Act, *supra* note 65, at art. 14.

92. *See* India Act, *supra* note 16, at art. 14; Russia Act, *supra* note 44, at art. 13.

93. *See, e.g.,* Regulation 2081/92, *supra* note 4. Other examples include Georgia and Hungary.

in India and Israel, where a ten-year renewable period is in place. In other nations, such as Malaysia, the period of time for protection varies and is specified for each individual geographical name, depending on the application and product in question.⁹⁴

The registration of geographical indications is free of charge only in some European countries. Most countries require payment of prescribed application fees to register a geographical name, to renew protection, and to file an opposition to registration.⁹⁵

7. Amendment and Revocation of Registered Geographical Indications

According to the legislation in most countries, the registered proprietor of a geographical indication may apply to the competent authority, in the prescribed manner, for additions or alterations to the registered product.⁹⁶ The procedure can be similar to the registration procedure, or a simplified opposition procedure. Every registered proprietor and every authorized user of the geographical indication must receive notice of any proposal to amend a registered geographical name. This use of notice to registered proprietors and authorized users is typically used for changes to production specifications. Thus, any accepted amendments must also be advertised in the prescribed manner. In addition, in cases where the registration contains trivial mistakes or inaccuracies, the registration authority may, upon its own notice or upon receipt of the applicant's request, order a correction of such mistakes or inaccuracies.⁹⁷

Some laws provide the possibility to cancel a registered geographical indication because the indication no longer qualifies for protection, is not used by the proprietor for a certain period of time, or the proprietor failed to pay the registration fee when due, as part of the registration maintenance or extension.⁹⁸ Where a geographical indication has been removed from the register for failure to pay the renewal fee, it may nevertheless be deemed to be a "geographical indication already on the register" for the purpose of any new application within a fixed period of time.⁹⁹

94. See Malaysia Act, *supra* note 65, at §§ 16(4)(c), 19, 19A.

95. See, e.g., *id.* at § 12.

96. See, e.g., *id.* at § 22.

97. See, e.g., *id.* at § 23.

98. See, e.g., *id.* at § 22(1); India Act, *supra* note 16, at art. 18.

99. India Act, *supra* note 16, at art. 19.

8. Possibility to Register Foreign Geographical Indications

The law of most countries allows legal entities and natural persons to register their geographical indications abroad and allows foreign names to be registered within their own registration systems.¹⁰⁰ For example, India, Thailand, and Czech Republic allow registration of foreign geographical indications, subject to formal reciprocity.¹⁰¹ If the application is filed by a foreign legal entity or a natural person, the applicant has to submit a certificate, whereby the appellation of origin is recognized in the country of origin and issued in the name of the applicant.¹⁰² According to the Indian Geographical Indications of Goods Act:

[w]here any country or a country which is a member of a group of countries or union of countries or any Inter-Governmental Organisation . . . does not accord to citizens of India the same rights in respect of the registration and protection of geographical indications as it accords to its own nationals, no nationals of such country or a country which is a member of a group of countries or union or countries or Inter-Governmental Organisations, as the case may be, shall be entitled to apply for the registration of, or be registered as the proprietor of geographical indication [in India or] to apply for registration or be registered as an authorised user under . . . a geographical indication.¹⁰³

In Thailand, a foreign geographical indication can be registered only if: (1) it comes from countries that are parties to International Treaties or Agreements concerning protection of a geographical indication to which Thailand is a party, (2) it comes from a country that has a domicile or active place of business in Thailand, or, (3) it comes from a contracting state to a convention or international treaty.¹⁰⁴ Additionally, a foreign geographical indication must clearly evidence that it is the geographical indication protected under the law of that country, and it has been continuously used in that country, until the date of application in Thailand.¹⁰⁵

In Malaysia, where the applicant's ordinary residence or principal place of business is outside the country, the applicant must appoint an agent domiciled in Malaysia and constituted under the Malaysian laws to represent him and act on his behalf in the registration proceedings.¹⁰⁶

100. See, e.g., *id.* at art. 85; Malaysia Act, *supra* note 65, at 31.

101. See India Act, *supra* note 16, at art. 85; Czech Republic Act, *supra* note 42, at § 5(7); Thailand Act, *supra* note 43, at B.E. 2546.

102. See Czech Republic Act, *supra* note 42, at § 2.

103. India Act, *supra* note 16, at art. 85.

104. See Thailand Act, *supra* note 43, at B.E. 2546.

105. *Id.*

106. Malaysia Act, *supra* note 65, § 11(2).

EC Regulation 2081/92 provides a very detailed procedure for foreign geographical indications registration.¹⁰⁷ Article 12 gives an opportunity to register the names from non-EC States.¹⁰⁸

If a protected name of a third country is identical to a Community protected name, registration [is] granted with due regard for local and traditional usage and the practical risks of confusion. Use of such names [is] authorized only if the country of origin of the product is clearly and visibly indicated on the label.¹⁰⁹

EC Regulation 692/2003 amended EC Regulation 2081/92 by adding Section 12(3), which states the Commission will examine, at the request of the country concerned, whether a third country satisfies the conditions of the Regulation.¹¹⁰ If the Commission's decision is affirmative, the procedure set out in Article 12a applies.¹¹¹ This procedure is similar to the registration procedure established by the EC Regulation for EC Members. However, it has some specific features.

First, when a group or a natural or legal person in a third country wishes to have a name registered under this Regulation, it has to send a registration application to the authorities in the country where the geographical area is located.¹¹² Applications must be accompanied by the specification, which includes all the Regulation 2081/92 Article 4 required elements, showing that the proposed name fulfills the necessary requirements with regard to the designation of origin or geographical indication definition.¹¹³ "If the application concerns a name that also designates a border geographical area or a traditional name connected to that geographical area in [the EC] Member State, the third country to which the application was sent [has to] consult the Member State concerned before transmitting the application."¹¹⁴ Following consultations, if "the groups or natural or legal persons from the [countries] concerned agree on an overall solution," these countries "may submit a joint application for registration to the Commission."¹¹⁵ If no agreement is reached among the countries, specific provisions may be adopted by the Article 15 procedure.¹¹⁶

107. Regulation 2081/92, *supra* note 4.

108. *Id.* at art. 12.

109. *Id.*

110. Regulation 692/2003, *supra* note 37, at art. 1(10).

111. *Id.*

112. *Id.* at art. 1(11).

113. *Id.*

114. *Id.*

115. *Id.*

116. *Id.* Under Article 15, the Commission is assisted by a regulatory committee, composed of Member State representatives and chaired by a representative of the Commission.

After examination of the application, if third country authorities consider it satisfactory, they will transmit the registration application to the EC Commission. The application must be accompanied by:

- (a) a description of the legal provisions and the usage on the basis of which the designation of origin or the geographical indication is protected or established in the country,
- (b) a declaration that the [appropriate inspections structures] are established on its territory, and
- (c) other documents on which it has based its assessment.¹¹⁷

There is a requirement for the application and all documents forwarded to the Commission to be in one of the official Community languages or accompanied by a translation into one of the official Community languages.¹¹⁸

Within six months, the Commission will verify whether the registration request sent by the third country contains all the necessary elements, informing the country concerned of its conclusions.¹¹⁹ If the Commission decides that the name satisfies the conditions for protection, it will then publish the application in the Official Journal.¹²⁰ If the Commission, after consulting the country that transmitted the application, decides that the name does not satisfy the conditions for protection, it will not proceed with publication.¹²¹

Within six months of the date of publication, "any natural or legal person with a legitimate interest may object to the application."¹²² To meet the Article 22 TRIPS Agreement obligation, a procedure parallel to an objection procedure, provided in Article 7 of the EC Regulation, was created for nationals of WTO Member countries.¹²³ Article 12(d) provides that any legitimately concerned natural or legal entity that is a national of a WTO Member country, or of a third country recognized under the procedure provided for in Article 12(3), may object to the proposed registration.¹²⁴ A duly substantiated statement and all relevant documents, in one of the official Community languages or accompanied by a translation, should be sent to the EC Commission.¹²⁵ The Commission will examine admissibility in accordance with the criteria set out by the Article 7(4) Regulation.¹²⁶ Those criteria must be examined in regard to the territory of the Com-

117. *Id.*
118. *Id.*
119. *Id.*
120. *Id.*
121. *Id.*
122. *Id.*
123. *See id.*
124. *Id.*
125. *Id.*
126. *Id.*

munity, and from that point, the procedure is identical to the registration procedure of the names for EC Members.¹²⁷

There are also some countries that do not register foreign geographical indications, but do recognize the registration of the country of origin. Algeria, Bulgaria, Burkina Faso, Congo, Costa Rica, Cuba, Czech Republic, France, Gabon, Haiti, Hungary, Israel, Italy, México, Portugal, Republic of Moldova, Serbia and Montenegro, Slovakia, Togo and Tunisia are parties to the Lisbon Agreement.¹²⁸ As a result, once there is a notification of a geographical name to the International Register, the country in question has one year from the date of receipt of the notification to examine the possibility to protect the name in question.¹²⁹ If the name is not eligible for protection, a reasoned notification of the inability to ensure protection of that appellation of origin should be sent to the International Bureau.¹³⁰

D. *Effect of Registration*

The protection of a registered geographical indication usually takes effect on the date of *application* for registration and not from the date of registration.¹³¹ Only producers of products possessing the use, quality, reputation or other characteristic specified in the register, and who are carrying on their activity in the geographical area specified in the register, may use a registered geographical indication in the course of trade.¹³² A geographical indication would be considered as “used” if it is affixed to goods or packages via leaflets, invoices, forms, and other documents having to do with commercial introduction of goods.¹³³

Some countries follow the scope of protection provided for geographical indications in the TRIPS Agreement.¹³⁴ First of all, any use of geographical indications which, in accordance with Article 10*bis* of the Paris Convention, may be

127. *Id.*

128. See Lisbon Agreement, *supra* note 4. For a list of participating countries, see Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration, Oct. 31, 1958, *revised* at Stockholm, July 14, 1967, *amended*, Sept. 28, 1979, status on Feb. 16, 2005, at <http://www.wipo.int/treaties/en/documents/pdf/j-lisbon.pdf> (last visited Mar. 21, 2005).

129. See WIPO, LISBON SYSTEM FOR THE INTERNATIONAL REGISTRATION OF APPELLATIONS OF ORIGIN (2004), available at <http://www.wipo.int/lisbon/en/general>.

130. *Id.*

131. See, e.g., Estonia Act, *supra* note 72, at § 22; Armenia Act, *supra* note 81, at art. 31; Georgia Act, *supra* note 81, at art. 8 (emphasis added).

132. See Regulation 2081/92, *supra* note 4, at art. 2.

133. See Russia Act, *supra* note 44, at art. 40.

134. Compare Barbados Act, *supra* note 67; Malaysia Act, *supra* note 65; Thailand Act, *supra* note 43, with TRIPS Agreement, *supra* note 1.

qualified as an act of unfair competition, is not permitted.¹³⁵ Second, use of geographical indications in any manner which “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”, is deemed unlawful.¹³⁶

The use of a geographical indication, accompanied by the indication of true place of origin, does not mislead the public and therefore, is not considered an infringement of the legal provisions.¹³⁷ The declaration of the true place of origin of goods includes any use of the terms “type”, “form”, “category”, or any wording or anything similar to accompany the geographical indication used with the goods.¹³⁸

There are specific provisions in relation to wines and spirits. The use of a geographical indication identifying wines or spirits not originating in the place indicated by the geographical indication is prohibited, even where the true origin of the wines and spirits is indicated, or the geographical indication is used in translation or accompanied by expressions such as “kind”, “type”, “style”, “imitation” or the like.¹³⁹

135. TRIPS Agreement, *supra* note 1, at art. 22(2)(b); Paris Convention, *supra* note 9, at art. 10*bis*. Article 10*bis* of the Paris Convention provides:

“1. The countries of the Union are bound to assure to nationals of such countries effective protection against unfair competition.

2. Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition.

3. The following in particular shall be prohibited:

i) all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor;

ii) false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor;

iii) 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.”

136. TRIPS Agreement, *supra* note 1, at art. 22(2)(a).

137. *See id.* art. 22(4).

138. *See generally id.* (TRIPS specifies that use of such terms is not allowed for wines and spirits under art. 23, but does not bar them generally under art. 22).

139. *Id.* art. 23.

In Thailand, this type of protection may be announced by issuing Ministerial Regulations in relation to any particular type of goods.¹⁴⁰ Other countries, among them the EC, Georgia, Armenia, go further and in general prohibit:

a) any direct or indirect commercial use of an appellation of origin or geographical indication registered in respect to the goods not covered by the registration, insofar as those goods are similar to the registered good under that name or insofar as using the name exploits the reputation of the protected name;

b) any use of the registered appellation of origin and geographical indication, which word for word designates the real place of the goods' manufacture, processing or preparing of the raw material, but is likely to mislead the public as to the true origin of the goods; or

c) any use of such a name or indication, which is the imitation or evocation of registered appellation of origin or geographical indication, even in translation, or accompanied with such words as "type", "style", "similar", "as produced in", "method", etc.;

d) any use of misleading indication as to the origin, essential qualities and features of the goods on the packaging, on an advertising material, or on documents relating to the goods;

e) any packaging or presentation of a good which can convey false impression as to its origin.¹⁴¹

Most of the laws examined also clearly state protected geographical indications cannot be transformed into generic names.

E. Control of Registered Geographical Indications

Generally, any association, irrespective of its legal form, of producers or processors of a product which has been registered must possess sufficient qualified staff, equipment and resources to inspect the production, marketing, and labeling details of the product bearing the protected geographical sign.¹⁴²

For example, according to EC Council Regulation 2081/92, all products registered under the designations "Protected Geographical Indications" and "Pro-

140. See generally VIPA CHUENJAIPANICH, TILLEKE & GIBBINS INT'L LTD., DRAFT GEOGRAPHICAL INDICATION ACT: A SUMMARY (2002) (stating that use of geographical indications shall be in accordance with Ministerial Regulations), available at http://www.tillekeandgibbons.com/Publications/pdf/IP_bulletin_may02.pdf.

141. See Regulation 2081/92, *supra* note 4, at art. 13; Armenia Act, *supra* note 81, at art. 41; Georgia Act, *supra* note 81, at art. 11(c).

142. See The Implementing Regulations Under the Decree-Law No. 555 Pertaining to the Protection of Geographical Signs, art. 14 (1995) (Turk.), available at <http://www.paragon.com.tr/law/GeographicalSignsRegulation.pdf>.

ected Designations of Origin” are subject to inspection to ensure that the requirements of the registered specification are met.¹⁴³

In a registration application, applicants have to nominate either a public or private inspection body. Under the EC legislation, private inspection bodies are required to be accredited to European Standard EN 45011, equivalent to ISO Standard 65.¹⁴⁴ According to Regulation 2081/92 Article 10, designated inspection authorities and/or approved private bodies must offer adequate guarantees of objectivity and impartiality with regard to all producers or processors subject to their control and have permanently at their disposal the qualified staff and resources necessary to carry out inspection of agricultural products and foodstuffs bearing a protected name.¹⁴⁵

If an inspection structure uses the services of another body for some inspections, that body must offer the same guarantees. In that event the designated inspection authorities and/or approved private bodies shall, however, continue to be responsible *vis-à-vis* the Member State for all inspections The costs of inspections . . . shall be borne by the producers using the protected name.¹⁴⁶

The EC Regulation is implemented into Italian law by Law 128/98.¹⁴⁷ Article 53 of Law 128/98 provides that for every registered product there must be an inspection body, public or private, formally authorized by the Ministry of Agricultural Policy.¹⁴⁸ The *Ispettorato Centrale Repressioni Frodi* and the relevant local authorities oversee the inspection work conducted by these independent bodies.¹⁴⁹ Section 14 of Law 526/1999 clarifies this area.¹⁵⁰ However, the Ministry of Agriculture remains the national authority in charge of co-coordinating inspection activities. Inspections are carried out by a formally appointed public body or a private body authorized by ministerial decree. Each body may be in charge of inspecting one or more products of designated origin. The Ministerial Decree of April 12, 2000, provides for cooperation rules between the private consortia for the protection of PDOs and PGIs with the *Ispettorato Centrale Repressioni Frodi*.¹⁵¹

143. Regulation 2081/192, *supra* note 4, at art. 10.

144. See Gunnel Nycander Axelsson, *Toward a Level Playing Field in Organic Farm Trade*, I.C.T.S.D., Aug. 2000, available at <http://www.svenskakyrkan.se/lutherhjalpen/spel/thefoodgame/lankar/gunnelbridges.htm> (stating that EN 45011 places “strict demands on the documentation of procedures”).

145. Regulation 2081/92, *supra* note 4, at art. 10.

146. *Id.*

147. Law 128/98 of 24 April 1998, 104 Gazz. Uff. 88 (7 May 1998).

148. *Id.* at art. 53.

149. *Id.*

150. Law 526, 1999 of 21 December 1999, 13 Gazz. Uff. 15, § 14 (18 January 2000).

151. See Ministero delle Politiche Agricole e Forestali, 97 GAZZ. UFF., April 27, 2000, available at <http://www.politicheagricole.it/ICRF/home.asp>.

In Spain, the authorities in charge of inspections and controls are the “*Consejos Reguladores*” (“Regulatory Councils”). Councils also protect and promote designations of origin, and their members are chosen among producers and processing bodies every four years.¹⁵² Protected products must not only comply with the applicable horizontal standards but also with product specifications mentioned in the relevant registration. Thus, products are subject to double control. Regulatory Councils monitor compliance with the specifications and each regulatory authority has its own inspection service.¹⁵³ The Central Administration can also make inspections at the request of producers or manufacturers in case they observe any anomaly in the behaviour of the Regulatory Council.

According to Article 134(1) of the German Law on the Protection of Trade Marks and Other Signs, compliance is carried out by competent bodies under the Federal Länder law.¹⁵⁴ Both public inspection authorities and private bodies carry out inspections in Germany, as permitted under Article 10(2) of Regulation 2081/92.¹⁵⁵ The inspection bodies can carry out the following operations in accordance with Article 134(2) of the Law on the Protection of Trade Marks and Other Signs: (1) visit and inspect the offices, premises and means of transport; (2) take samples for analysis purposes, whereby a second sealed sample may be handed out to the inspected person/undertaking; (3) examine and analyze documentary material; and (4) interview representatives of the inspected undertaking.¹⁵⁶

152. Councils also protect and promote designations of origin and geographical indications. Regulatory Council members are chosen every four years among producers and traders of the product in question. For example, Rioja Regulatory Council consists of a president, 28 members and 4 representatives of the Public Administration (from the Ministry of Agriculture and the Autonomous Communities of La Rioja, Navarra and the País Vasco), who attend the sittings and are allowed to speak during the meetings but have no right to vote. The members are elected every four years and must be linked with the sector they represent (14 linked with the grape-growing sector and 14 with the marketing sector in the current mandate - 2001/2004). *See* <http://www.riojawine.com> for more information. The President is elected by a qualified majority of two-thirds of the members of the Plenary and appointed by the Ministry of Agriculture for four years.

153. *See, e.g.*, CONSEJO REGULADOR DE LA DENOMINACIÓN DE ORIGEN CALIFICADA RIOJA, CONTROL BOARD (2004) (referring to the functions and regulations of the Board, along with the development of the Consejo Regulador), *available at* <http://www.riojawine.com/en/consejo/index.htm>.

154. *See* Gesetz über den Schutz von Marken und sonstigen Kennzeichen [Law on the Protection of Trade Marks and Other Signs] § 134(1) (1998) (F.R.G.), *available at* http://www.wipo.int/clea/docs_new/pdf/en/de/de057en.pdf.

155. *Id.*; *see* Regulation 2081/92, *supra* note 4, at art. 10(2).

156. *See* Gesetz über den Schutz von Marken und sonstigen Kennzeichen [Law on the Protection of Trade Marks and Other Signs] § 134(1) (1998) (F.R.G.).

Depending on the controlled product and the federal Land, control is carried out by federal administrative bodies (*Regierungspräsidenten*), federal Ministries (*Landesministerien*), by the agencies for agriculture and food of the Länder (*Landesanstalten für Ernährung*) and, in the Federal State of Baden-Württemberg, by a private body.¹⁵⁷

F. *Special Provisions in Relation to Trademarks and Prior Users*

Practically every legislative act that deals with the registration of geographical indications has specific provisions relating to misleading trademarks. The registration authority, on its own motion or at the request of an interested party, may 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.¹⁵⁸ Sometimes this can only happen if use of the indication in the trademark for such goods is of such a nature as to mislead the public as to the true place of origin. These provisions are identical to those of the TRIPS Agreement that provide the minimum level of protection to all geographical indications and more specific for geographical indications for wines.¹⁵⁹

The validity of registration of a trademark is not prejudiced where a trademark has been applied for or registered in good faith, or where rights to a trademark were acquired through good faith use before legislation on geographical indications registration was enacted or before the geographical indications were protected in its country of origin.¹⁶⁰

The laws of some countries provide various solutions to the conflicting situations between trademarks and geographical indications. For example, Article 14 of the EC Council Regulation 2081/92 regulates conflicts between trademarks and geographical indications and identifies three distinct situations. First, a designation of origin or geographical indication may not be registered where, in light of a trademark's reputation and the length of time it has been used, its registration could mislead the consumer as to the true identity of the product protected by the trademark. Second, a trademark that was registered in good faith before the registration application date for designation of origin or geographical indication was lodged and does not meet the conditions of Article 14(3) of the Regula-

157. See Lancon Qualität, *Inspection and Certification Abroad: Organic Production, Processing and Shipment*, at http://www.Lacon-institut.com/en_start.php (last visited Nov. 22, 2004) (Lacon GmbH has head offices in Austria and Germany and offers certifications in a wide range of areas pertaining to food quality and organic foods).

158. See generally TRIPS Agreement, *supra* note 1, at arts. 22-23

159. See generally TRIPS Agreement, *supra* note 1, at arts. 22-23 (describing protection provided by TRIPS for GIs).

160. See *id.* at art. 24.

tion may, in principle, co-exist with a previously registered designation of origin or geographical indication. Third, a trademark registered on or after the filing date of the registration application for the geographical name, may no longer be used. However, the trademark will only be cancelled (or registration of the trademark refused) in the cases referred to in Article 14(1).¹⁶¹

Often the provisions of trademark law concerning the validity of the trademark with geographical reference are reproduced in the geographical indications acts.

G. Offences and Penalties

Most of the laws contain penal provisions and provisions as well as concerning the confiscation of goods that are illegally marked with a geographical indication. There is a generally recognized rule that the holder of the right to use a geographical indication is authorized to bring an action against an infringing party and seek: prevention of the acts of infringement; compensation in damages; confiscation of illegally produced goods and the equipment used for production of the said goods; destruction of all those labels, tags, drawings, imprints, packing materials and advertisements, including the registered name.¹⁶²

However, some countries have more severe punishments for unlawful use of geographical indications. For example, in India, the court may impose a sentence of imprisonment for a maximum term of six months or a maximum fine of fifty thousand rupees for applying false geographical indications, for selling goods to which false geographical indications are applied, or for falsely representing geographical indications as registered.¹⁶³ In the case of a second (and for every subsequent) offense, the punishment increases to one year in prison and double the amount of money.¹⁶⁴ Any person found guilty in falsification of entries in the register, or in improper description of businesses as connected with Geographical Indications Registry, would be punished with imprisonment for a term extended to two years and with a fine.¹⁶⁵ If an offense is committed by a company, this company as well as every person in charge of, and responsible to, the company for the conduct of its business at the time of the commission of the offense, will be deemed guilty of the offense and will be liable and punished ac-

161. Regulation 2081/92, *supra* note 4, at art. 14 (explaining that under Article 14(1), a trademark will be cancelled or its registration refused if the application for the trademark is submitted after the date to register a geographical name, or if the trademark has been registered after such publication).

162. *See, e.g.*, Georgia Act, *supra* note 81, at art. 16.

163. *See* India Act, *supra* note 16, at arts. 39-46.

164. *Id.* at art. 41.

165. *Id.* at arts. 43-44.

cordingly.¹⁶⁶ By way of example, in Thailand, a person who uses a geographical indication without a right, or uses it contrary to the specifications, is liable to imprisonment not exceeding one year or a fine not exceeding 20,000 Baht, or both.¹⁶⁷

III. CONCLUSION

An article of this type can only give an overview of the issues arising in the protection of geographical indications. This overview can, however, be important in understanding what is needed in a *sui generis* system for the protection of geographical indications and the range of possibilities to facilitate this protection, found by different legislatures. It is clear that the base model of protection is the one that has been developed in the European Community and promoted in the WTO. However, as can be seen, many countries have moved further, providing comprehensive protection for geographical indications.¹⁶⁸

APPENDIX A

Country	Name of Act	Where to Locate
Armenia	Law on Trademarks, Service Marks and Appellations of Origin, of 20 March 2000; Part II "Appellations of Origin"	http://clea.wipo.int
Barbados	Geographical Indications Act, of 14 September 1998 - 22	http://clea.wipo.int
Bulgaria	Law on Marks and Geographical Indications, of 1 September 1999, Chapter 3, "Geographical Indications"	Published in State Gazette No.81 of 14 September 1999, in force as of 15 December 1999, http://clea.wipo.int
Czech Republic	Act on the Protection of Designations of Origin and Geographical Indications and on Amendment to the Act on Consumer Protection No. 452, entered into force on 1 April 2002	http://www.upv.cz , "Appellations of Origin", "Law".
Georgia	Law on Appellations of Origin and Geographical Indications of Goods, entered into force on 1 November 1999	http://www.sakpatenti.org.ge/eng/e-goods.htm
India	Geographical Indications of Goods Act, 1999, No. 48	The Gazette of India, Extraordinary Part II, December 30, 1999, No. 61

166. *Id.* at art. 49.

167. Thailand Act, *supra* note 43.

168. See Bernard O'Connor, *The Legal Protection of Geographical Indications*, 1 INTELL. PROP. Q. 1, 35-57 (2004).

Russia	Law of the Russian Federation No. 3520-1 of September 23, 1992, "Trademarks, Service Marks and Appellation of Origin of Goods"	http://www.mospatent.ru
Israel	Appellations of Origin (Geographical Indications) Protection Law, No. 5725, 1965, as amended in January 2000	http://clea.wipo.int
Estonia	Geographical Indications Protection Act, passed on 15 December 1999, entered into force 10 January 2000 (RT I 1999, 102, 907)	http://www.epa.ee/geogr/geoact.htm
Latvia	Law of the Republic of Latvia on Trademarks and Indications of Geographical Origin, 16/16/99	http://clea.wipo.int
Malaysia	Geographical Indications Act 2000, Act 602	http://www.mipc.gov.my/
Turkey	Decree-Law No. 555 on the Protection of Geographical Signs	http://clea.wipo.int
New Zealand	An Act to Provide for the Registration and Protection of Geographical Indications in Relation to Goods, 1994, No. 125, An Act to Amend the Geographical Indications Act 1994, 1996, No. 126	http://clea.wipo.int
Thailand	Geographical Indications Protection Act 2003	Draft
Singapore	Geographical Indications Act 1998, No. 44	http://clea.wipo.int
Hungary	Law No. XI of 1997 on the Protection of Trademarks and Geographical Indications, Part V "Protection of Geographical Indications"	http://www.mszh.hu
Slovak Republic	Law Concerning the Protection of Appellations of Origin of Products (No. 159 of December 12, 1973)	http://www.indprop.gov.sk
Romania	Law on Marks and Geographical Indications	http://www.osim.ro
Slovenia	Law on Industrial Property of March 20, 1992	http://www.sipo.mzt.si
EC	Council Regulation 2081/92	http://www.europa.eu.int