University of Western Australia

University of Western Australia-Faculty of Law Research Paper
No. 2012-09

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Introduction

Article 22 of the TRIPS Agreement requires that WTO Members “shall provide the legal means for interested parties to prevent: (a) 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; (b) any use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention (1967).” It would be convenient to hypothesise that the origins of the precursor European legislation which sought to protect the commercial reputation of traders in discrete geographical localities was actuated by a concern to protect consumers from false and misleading geographical indications (GIs). However, the origin of GIs legislation can be traced back to French statutes to protect the competitive advantage of wine producers (see A. Richard, 1918, referred to in van Caenegem 2003). The mediaeval legislation of Bordeaux conferred two privileges upon the wine producers of south west France. First, the privilège de la descente prohibited the transportation by river through Bordeaux of wines produced outside the region until 11 November of each year. With the icing up of rivers consequential upon the onset of winter, this gave the local wines a competitive advantage in gaining access to the lucrative Northern Europe markets. The justification for this restriction was stated to be to provide an opportunity for the authentication of the wines of the region. As will be seen below, a similar duality exists in relation to the modern justification of geographical indications laws in which a concern with the authentication of the origin of products cohabits with a concern to preserve the competitive advantage of local producers.

The second category of privilege was the privilège de la barrique which restricted for use only for the wines of Bordeaux a barrel (barrique) of prescribed dimensions, which meant that wines from the region were better packaged and traveled cheaper than wines from competing regions. By a statute of 1764 seeking to prevent the illicit use of the Bordeaux barrique, each had to be branded with the name and parish of origin of the wine grower. The barrique brand can be seen as a precursor of the registered GI.
In seeking to resist the abolition of its commercial privileges at the time of the French Revolution, Bordeaux raised a number of the arguments which have characterized the modern debate on geographical indications. First, it argued that the privileges were essential for guaranteeing the authenticity of the crus (vintages) and, secondly, that as the land of the region was not suitable for other agricultural pursuits, viticulture had to be protected through the maintenance of these privileges.

Interestingly, echoes of the ancient privileges enjoyed by the French wine industry can be seen in Article 23 of the TRIPS Agreement. This provides in Art. 23.1 for “the additional protection for geographical indications for wines and spirits” through the prohibition of “expressions such as "kind", "type", "style", "imitation" or the like" for wines and spirits not originating in the place indicated by the GI. Article 23.4 provides that in order to facilitate the protection of GIs for wines, negotiations shall be undertaken in the Council for TRIPS “concerning the establishment of a multilateral system of notification and registration of geographical indications for wines eligible for protection in those Members participating in the system.” This book addresses the question of whether the additional protection for wines and spirits envisaged in Article 23 of TRIPS might be extended to other products. This extension debate has been occurring in the context of discussions concerning the establishment of the multilateral system of notification and registration, as well as within the negotiations envisaged within Art.24.1 of TRIPS which are “aimed at increasing the protection of individual geographical indications under Article 23.”

Definitions

**Geographical Indications**

Because of the diverse ways in which the protection of geographical indications has evolved under national laws, there is no generally accepted terminology. The following are the conventional definitions which can be found in the literature on geographical indications:

‘Indication of Source’ refers to a sign that indicates that a product originates in a specific geographical region.

‘Appellation of Origin’ refers to a sign that indicates that a product originates in a specific geographic region only when the characteristic qualities of the product are due to the geographical environment, including natural and human factors.

‘Geographical Indication’ includes both of the above concepts.

For the purposes of the discussions of reform proposals in April 2001 by the TRIPS Council, the WTO Secretariat adopted the term "indications of geographical origin" to designate the different expressions used by WTO Members to protect geographical origin of products (WTO, 2001).

**Trademarks**
In general terms, trademarks are signs, which are used in order to distinguish the goods or services of one undertaking from the goods or services of another undertaking. In the TRIPS Agreement Article 15.1 states that “Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of another undertakings, shall be capable of constituting a trademark.” It follows from that definition that the main function of a trademark is to distinguish the goods and/or services for which the trademark is used. Only trademarks that are distinctive can perform that function.

The TRIPS Agreement does not give any indication under what circumstances a sign has to be considered distinctive in respect of certain goods or services. However, it is commonly accepted that, in order to be considered distinctive, signs used as trademarks must not be descriptive or deceptive. As a general proposition, geographical indications are unlikely to be considered more than descriptive. Indeed, many trademark laws both explicitly disqualify geographic marks from protection as inherently distinctive marks and provide as a defence to trademark infringement, the fact that a mark identifies a geographic area which could be understood to constitute a reference to the origin of the relevant goods. However, it may be possible to use a geographical term as trademark in cases where that trademark, despite of being originally descriptive, has acquired distinctive character (or secondary meaning) through use.

Differences between Geographical Indications and Trademarks

As is indicated by the discussion above, a geographical indication is a generic description which is applicable to by all traders in a particular geographic location to goods which emanate from that location. A trademark is a sign which distinguishes the products of a specific trader from those of its competitors. Thus it is not likely to be descriptive and it cannot be generic. The right to protect a geographical indication from wrongful appropriation is enjoyed by all traders from the particular geographical location, whereas a trademark is protected from wrongful appropriation at the suit of the registered proprietor of that mark. Generally, geographic indications are monitored and protected by producer associations from the relevant region. Unlike trademarks, geographical indications are not freely transferrable from one owner to another, as a user must have the appropriate association with the geographical region and must comply with the production practices of that region.

International Protection of Geographical Indications

Paris Convention for the Protection of Industrial Property, 1883

The first multilateral agreement, which included "indications of source or appellations of origin" as objects for protection by national industrial property laws, was the Paris Convention. Under Article 10(1) provision is made for seizure upon importation of goods bearing false indications of the source of goods or the identity of the producer. Under Art. 10(2), any
...producer, manufacturer, or merchant whether a natural person or legal entity, engaged in the production or manufacture of or trade in such goods and established either in the locality falsely indicated as the source, or in the region where such locality is situated, or in the country falsely indicated, or in the country where the false indication of source is used, shall in any case be deemed an interested party. Article 10bis also afforded protection against false or misleading indications of source as a means of repressing unfair competition. Included under the definition of unfair competition are any acts which create confusion, or allegations, the use of which in the course of trade are liable to mislead the public, as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of goods.

**Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods, 1891**

The original form of Paris Convention prohibited the use of false geographical indications. A number of signatory nations proposed a more comprehensive form of regulation for what was considered to be a significant intellectual property abuse. The 1891 Madrid Agreement concerning the protection of geographical indications was their response. Article 1 provided that all goods ‘bearing a false or misleading indication’ to a signatory country, or to a place in that country ‘shall be seized on importation’ However, this agreement failed to attract the accession of significant trading nations such as the USA, Germany and Italy. A threshold problem with this agreement and with subsequent revisions, was the inability of nations to exempt geographical indications which had become generic within their borders.

**International Convention on the Use of Appellations of Origin and Denominations of Cheeses (“Stresa Convention”), 1951**

The parties to the Stresa Convention, which are some of the cheese producing countries of Europe, “pledge themselves to prohibit and repress within their respective territorial confines the use, in the language of the state or in a foreign language, of the “appellations d’origine”, denominations and designations of cheeses contrary to the principles stated in Articles 2 to 9 inclusive. The Convention, which entered into force on 1 September 1953, applies to all specifications which constitute false information as to the origin, variety, nature or specific qualities of cheeses, which are stated on products which might be confused with cheese. The term “cheese”, according to Art.2.1 of the Convention is reserved for “fresh and matured products obtained by draining after the coagulation of milk, cream, skimmed or partially skimmed milk or a combination of these”, or by “products obtained by the partial concentration of whey, or of buttermilk, but excluding the addition of any fatty matter to milk”. Article 3, provides that the appellations of origin of those cheeses “manufactured or matured in traditional regions, by virtue of local, loyal and uninterrupted
usages” which are listed in Annex A are exclusively reserved to those cheeses, “whether they are used alone or accompanied by a qualifying or even corrective term such as “type”, “kind”, “imitation” or other term”. Annex A lists: Gorgonzola, Parmigiana Romano, Pecorino Romano and Roquefort. Annex B lists a number of designations for cheese, which are prohibited by article 4.2 for products which do not meet the requirements provided by contracting parties in relation to “shape, weight, size, type and colour of the rind and curd, as well as the fat content of the cheese”. Listed in Annex B are Asiago, Camembert, Cambozola, Danablu, Edam, Emmental, Esrom, Fiore Sardo, Fontina, Gruyère, Pinnzgauer Berkäse, Samsøe, and Svecia.

The Stresa Convention came into force prior to the EEC Treaty and its regime providing for the free movement of goods. In the Deserbais case the ECJ held that the EEC Treaty did not affect the duty of a Member State to respect the rights of non-member countries under the prior agreement. Similarly, in the Cambozola case the ECJ ruled that the free movement of goods principle was subordinated to the Stresa Convention and Council Regulation (EEC) No 2081/92 permitting the registration and enforcement of rights in relation to designations of origin.

**Lisbon Agreement for the Protection of Appellations of Origin and their Registration, 1958**

The Lisbon Agreement established an international system of registration and protection of appellations of origin. It adopted the French definition of appellation of origin by restricting the protected indications to cases in which the quality and characteristics of a product are ‘due exclusively or essentially to the geographical environment, including natural and human factors’.

The Agreement provided for the registration, at the International Bureau of WIPO, of appellations of origin which are ‘recognized and protected as such, in their country of origin’. Countries are thus free to adopt their own system of designating appellations, either by judicial or administrative decision, or both. Once registered, a geographic indication is protected in other member nations. The countries have to ensure that any kind of usurpation or imitation is prohibited under their laws. Finally, the Agreement, provides that no genetic indication can be deemed generic in any other country, as long as it is protected in its country of origin.

The Lisbon Agreement failed to attract support from more than a few nations. One problem was that accession was confined to those nations which protected appellations of origin ‘as such’. Thus, states which protected this form of intellectual property under unfair competition or consumer protection laws were locked out. Also the Agreement did not make exception for geographic indications which had already become generic in member states. However, it has been suggested that the Register of appellations of origin established under the Lisbon Agreement and administered by WIPO provides a convenient solution to the establishment of the multilateral register foreseen in TRIPS (Gervais, 2010).
**WIPO Proposals**

In 1975 WIPO issued a Draft Treaty on the Protection of Geographical Indications. The Draft Treaty provided for the protection both of appellations of origin and geographical indications. Unlike the Lisbon Agreement, it did not require signatories to have domestic laws for the protection of appellations of origin. In 1990 WIPO issued a memorandum asserting the continuing need for a treaty on this subject (WIPO, 1990).

In 1975 WIPO also issued a Model Law on geographical indications for adoption by developing countries. The Model Law defined ‘appellation of origin’ as

The geographical name of a country, region, or specific place which serves to designate a product originating therein, the characteristic qualities of which are due exclusively or essentially to the geographical environment, including natural factors, human factors, or both…any name which is not that of a country, region or specific place is also considered a geographical name if it relates to a specific geographical area, when used in connection with certain products.

The Model Law also defined ‘indication of source’ as ‘any expression or sign used to indicate that a product or service originates in a country or region or a specific place’. This would embrace symbols such as an Egyptian pyramid or the Eiffel Tower, as well as the birds and animals associated with a place.

The Model Law establishes a system for the registration of appellations of origin and includes an optional provision permitting national courts to determine whether particular terms are generic. Upon registration, appellations are only protected if used by producers of products carrying on business in the area described by the appellation and only if their products posses the essential characteristics associated with the appellation.

Finally, the Model Law provided that:

It shall be unlawful to use, in the course of trade, a registered appellation of origin of origin, or a similar name, with respect to the products specified in the Register or similar products, even if the true origin of the products is indicated, or if the appellation is in the form of a translation or is accompanied by terms such as ‘kind’, ‘type’, ‘make’, imitation’, or the like.

In 1990 WIPO issued a memorandum asserting the continuing need for a treaty on this subject. This has not been taken up by the WIPO Committee of Experts on the International Protection of Geographical Indications.

**TRIPS Agreement**

Section 3 of the TRIPS Agreement, which is concerned with GIs (see Blakeney, 2001) covers six topics: (i) Definition and scope of a geographical indication; (ii) Minimum standards and common protection provided for geographical indications corresponding to all kinds of products; (iii) the interrelationship between trademarks and indications of origin; (iv) Additional protection for geographical indications for wines and spirits; (v) Negotiation and review of
section III on geographical indications; and (vi) Exceptions to the protection of geographical indications.

Article 22 defines geographical indications 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.

This definition expands the Lisbon Agreement concept of appellation of origin to protect goods which merely derive a reputation from their place of origin without possessing a given quality or other characteristics which is due to that place. Also, under the TRIPS Agreement a geographical indication to be protected has to be an indication, but not necessarily the name of a geographical place on earth. Thus, for example, “Basmati” is taken to be an indication for rice coming from the Indian sub-continent, although it is not a place name as such. The indication has to identify goods as originating in the territory of a Member, a region or a locality of that territory. This definition also indicates that goods to be protected should originate in the territory, region or locality to which it is associated. This suggests that licenses for the use of geographical indications cannot be protected under the TRIPS Agreement.

The TRIPS definition permits Members protect geographical indications of goods where the quality, reputation or other characteristic of goods are attributable to their geographical origin. The TRIPS Agreement does not specify the legal means to protect geographical indications. This is left for Members to decide.

The interrelationship between the protection of trademarks and of appellations of origin is accommodated by Art.22.3 of the TRIPS Agreement which permits a Member, ex officio if its legislation so permits or at the request of an interested party, ‘refuse or invalidate the registration of a trade mark which contains or consists of a geographical indication with respect to goods not originating the territory indicated, if the use of the indication in the trademark for such goods in that Member is of such a nature as to mislead the public as to the true place of origin’.

Cognizant of the fact that for most countries the protection of geographical indications will be an innovation, Art 24.4 exempts from this form of protection trademarks which have been ‘applied for or registered in good faith’ or where the rights to the trademark ‘have been acquired through use in good faith’ either before the implementation of the TRIPS provisions, or before the geographical indication is protected in its country of origin.

Article 24.7 provides that a Member may provide that any request made under the section in connection with the use or registration of a trademark must be presented within five years after the adverse use of the protected indication has become generally known in that Member, or after the date of registration of that trademark, provided the registration has been published and ‘provided that the geographical indication is not used or registered in bad faith’.

Similar to the analogous provision in most trademark laws, Art.24.7 preserves ‘the right of a person to use, in the course of trade, that person’s name or the
name of that person’s predecessor in business, except where such name is used in such a manner as to mislead the public’.

Finally, Art.24.9 provides that there is no obligation under the TRIPS Agreement to protect geographical indications ‘which are not or cease to be protected in their country of origin, or which have fallen into disuse in that country.

In addition to the general protection for geographical indications for wines and spirits within the general context for the protection of geographical indications contained in Art.22, additional protection is accorded geographical indications for wines and spirits by Art.23. This additional protection has two components: (i) protection for each geographical indication for wines in the case of homonymous indications; and (ii) the establishment of a multilateral system of notification and registration of geographical indications for wines eligible for protection in those Members participating in the system.

These provisions give geographical indications for wines and spirits stronger protection than that provided in Article 22 for all products. For some countries, this additional protection is regarded as an unacceptable discrimination against all other products and they have agitated for an extension of that protection to all kinds of geographical indications.

Article 24.1 obliges Members ‘to enter into negotiations aimed at increasing the protection of individual geographic indications under Art.23’. Although Art.24 contains a number of paragraphs excepting certain matters from protection as geographical indications, Art.24.1 disallows Members from using these exceptions as an excuse for the refusal to conduct negotiations. Also in implementing this negotiation obligation, Art. 24.3 requires that a Member ‘not diminish the protection of geographical indications’ which existed in that Member prior to the date of the entry into force of the WTO Agreement. Nevertheless a group of countries considers the above interpretation constitutes to be a very legalistic approach. They believe that this provision permits negotiations to extend the additional protection for geographical indications for wines and spirits to all kinds of products.

In order to facilitate the protection of geographical indications for wines, Art.23.4 provides that ‘negotiations shall be undertaken in the Council for TRIPS concerning the establishment of a multilateral system of notification and registration of geographical indications for wines eligible for protection in those Members participating in the system’. The effect of this provision will be to absorb the registration scheme established under the Lisbon Agreement and to remove the justification for the negotiations within WIPO for a new treaty on the protection of geographical indications which has been under preparation since 1974.

The Extension Debate

A submission by Turkey of 9 July 1999, prior to the Seattle Ministerial proposed the extension of the multilateral register to products other than wines and spirits. This proposal was endorsed by the African group of countries. In a document of 6 August 1999 Kenya, on behalf of the African Group, noted that at the
Singapore Ministerial that the Article 23.4 negotiations concerning a multilateral register for wines had been extended to include spirits. Consequently, it submitted (at para. 27) that

Considering that Ministers made no distinction between the two above-mentioned products, the African Group is of the view that the negotiations envisaged under Article 23.4 should be extended to other categories, and requests, in this regard, that the scope of the system of notification and registration be expanded to other products recognizable by their geographical origins (handicrafts, agro-food products).

At the TRIPS Council meetings in 2000 some misgivings were expressed by some delegations about the extension of Article 23.1 protection and the multilateral register beyond wines and spirits. In the meeting of the TRIPS Council held on 26-29 June 2000 the representative of Kenya said that “It was difficult to explain to people in the developing world that their representatives were involved in negotiations in the WTO concerning additional protection for wines and spirits without any benefit being offered to developing countries.”

The Chair of the TRIPS Council sought to separate the discussion of Article 23.2 from 24.2 to avoid confusion. A response to this suggestion was a proposal in October 2001 from Bulgaria, the Czech Republic, Egypt, Iceland, India, Kenya, Liechtenstein, Pakistan, Slovenia, Sri Lanka, Switzerland and Turkey that the extension of geographical indications to products other than wines and spirits be included as an extension of the built-in agenda.

The above developments are important for an understanding of the way in which the question of GIs was included within the Doha Ministerial Declaration adopted on 14 November 2001. Clause 18 of the Declaration provided:

With a view to completing the work started in the Council for Trade-Related Aspects of Intellectual Property Rights (Council for TRIPS) on the implementation of Article 23.4, we agree to negotiate the establishment of a multilateral system of notification and registration of geographical indications for wines and spirits by the Fifth Session of the Ministerial Conference. We note that issues related to the extension of the protection of geographical indications provided for in Article 23 to products other than wines and spirits will be addressed in the Council for TRIPS pursuant to paragraph 12 of this declaration.

The Hong Kong Ministerial Declaration of November 2005 affirmed the ‘central importance of the development dimension in every aspect of the Doha Work Programme’. Ambitious claims associating the protection of GIs with economic development are now made by those developing countries which support the international protection of GIs. It is put forward as a means of sustaining rural communities by helping to guarantee food security for those without cash
incomes, helping to natural environmental disasters and biodiversity (See UNDP, 2004). Underpinning the debate about the extension of the additional protection enjoyed by wines and spirits to other products is how the distinction between Articles 22 and 23 came about. In a communication dated 15 September 2000, from Bulgaria, the Czech Republic, Iceland, India, Liechtenstein, Slovenia, Sri Lanka, Switzerland and Turkey, it is suggested that

6. This differential treatment of geographical indications can only be explained in the light of the negotiations of the Uruguay Round. The relevant TRIPS provisions are the result of trade-offs which were specific to the circumstances prevailing at the time of the Uruguay Round negotiations, in particular during the Brussels Ministerial Conference (1990). This was, to some extent, due to the link at that time between the negotiations on geographical indications and the negotiations on agriculture.

7. There is no systematic or logical explanation for the distinction made in Section 3 of Part II of the TRIPS Agreement. This distinction ignores that geographical indications for categories of goods other than wines and spirits are equally important for trade. The economic and political significance of geographical indications is growing as increasing quality awareness and higher quality requirements promote the demand for products of a specific geographical origin. The added value to exported goods increases the chances for such legitimate goods to reach the market which is part of the global vision for a multilateral trading system. That is why, since the end of the Uruguay Round, the awareness of the need for an extension of additional protection to products other than wines and spirits has continuously increased and spread among Members.

8. Since not all issues relevant to the protection of geographical indications were settled in the Uruguay Round, the built-in agenda of the TRIPS Agreement provides for the basis for further negotiations on increasing the protection of geographical indications. In other words, the distinction between Articles 22 and 23 is said to be almost accidental as the same policy reasons which require the extended protection for wines and spirits apply to other products.

A comprehensive discussion of the practical implications of the differences between the two Articles is contained in the submission by the Swiss delegation to the TRIPS In the meetings of the TRIPS Council held on 21 and 22 September 2000 in which the representative of Switzerland introduced the joint communication mentioned above. He explained that “[s]ome Members might ask why it was so important to have this additional protection also for other products than wines and spirits and whether the current protection for these products was not sufficient”. After describing the terms of both Articles he provided an example illustrating why the additional protection under Article 23
“was also needed for geographical indication other than those for wines and spirits”:

Rice that was sold under the Indian geographical indication "Basmati", but which was clearly marked as originating from another region or country, would not mislead the public as to the place of origin of that product; nevertheless, such use would free-ride on the worldwide famous and therefore commercially valuable geographical indication "Basmati". The same applied with regard to the famous Swiss cheese "Vacherin Mont d'Or", for example. There was no systematic or logical explanation for the distinction made in Section 3 of Part II of the TRIPS Agreement and this distinction ignored that geographical indications for categories of goods other than wines and spirits were equally important for trade.

The different roles of Articles 23 and 24 were also addressed in a communication dated 23 March 2001, from Bulgaria, Cuba, the Czech Republic, Egypt, Iceland, India, Liechtenstein, Mauritius, Nigeria, Sri Lanka, Switzerland, Turkey and Venezuela. At the meeting of the Council for TRIPS of 2 to 5 April 2001, Jamaica, Kenya, Pakistan and Slovenia requested that their delegations also be reflected as co-sponsors. The representative of Kenya associated his delegation with the proposal introduced by Switzerland regarding the extension of the higher level of protection to geographical indications for products other than wines and spirits citing its association with a number of agreements in this field, such as the OAU Model Law which provided protection for a wide range of products, including food products and handicrafts. He argued that “different levels of protection amounted to an unfair trade practice, or discrimination, i.e. something that the WTO should not be seen to support.”

Introducing the communication, the representative of Switzerland said that he expected there to be more co-sponsors of the proposal contained in it and requested the Secretariat explained that the protection provided by Article 22 in respect of GIs for products other than wines and spirits was insufficient in practice, because the "misleading test" was a burdensome requirement tailored to suit laws for the protection against unfair competition or the protection of consumers, but not the protection of intellectual property. Unlike Article 23, Article 22 did not prevent the use of geographical indications in translation or accompanied by expressions such as "style", "type", "kind", "imitation" or the like and thus enabled free-riding on renowned GIs by products not possessing the qualities which original products displayed due to their origin.

Also Switzerland argued that the "misleading test" of Article 22 resulted in legal uncertainty as to the enforcement and protection of individual GIs at the international level, because it was up to the national courts and administrative authorities to decide whether or not the public was misled by the use of a particular GI and whether or not the public was being misled and how the legal and administrative authorities applied and interpreted the "misleading test" differed from one country to another. The result was inconsistency of decisions and legal uncertainty as regards the protection of GIs and their enforcement at the international level. The possible distortions that this could create at the
multilateral level could be remedied by granting protection as under Article 23 not only to GIs for wines and spirits, but also to those for other products. At the TRIPS Council meetings of 27 to 30 November and 6 December 2000 the representative of Mauritius said that extending the scope of Article 23 to products other than wines and spirits was a coherent step based on what was already in the Agreement. She pointed out that Article 22.1 made clear that the provisions of the TRIPS Agreement covered geographical indications for all goods, however, it was the insufficient level of protection provided by Article 22 which had led to the establishment of a higher level of protection for wines and spirits. Thus, given that Article 22 already provided for the protection of geographical indications in respect of all goods, her delegation believed that the intention, as directed by this principle, had been that goods other than wines and spirits should be covered and this was how it read the mandate in Article 24.1. She also stated that her delegation did not believe and that there was no justification for a selective protection of products, the more so as the trade value of a geographical indication was equally relevant for products other than wines and spirits. Consequently, it felt that the higher level of protection currently granted to wines and spirits should be extended to other products generally and that one level of protection for all products would certainly provide greater predictability for trade in these products. She would like to point out, though, that a country like hers was asked in the areas of agriculture and services to liberalize and its response was that it did not think that it could actually do so in such a simple manner, because it did not have the competitive capacity to survive in a liberalized world. Realizing that it had one or two geographical indications, which could provide it with a niche market for one or two small products, it was participating in the present debate in the hope that, maybe after all, it could get some opportunities out of it.

Costs of Extension

In opposition to the proposals for an extension of the protection of geographical indications for wines and spirits under TRIPS to all products, on 29 June 2001, a joint communication was sent to the TRIPS Council by Argentina, Australia, Canada, Chile, Guatemala, New Zealand, Paraguay and the United States (Joint Communication). The Communication argued that the advantages of Article 23 protection was overstated and, relevantly for the current project, that the proposals for the extension of the TRIPS wines and spirits provisions to all products had insufficiently addressed the costs and burdens of this extension. It stated that “[t]hese new costs and burdens include administration costs, trade implications for producers, increased potential for consumer confusion, potential producer conflicts within the WTO Members and a heightened risk of WTO disputes.” The catalogue of costs outlined in this Joint Communication is annotated below.

Administration costs
The Joint Communication pointed out that the extension of Article 23.1 would create additional obligations under the TRIPS Agreement, which would require the implementation of new laws and administrative mechanisms and would need to be implemented at the national level by all WTO Members, both developed and developing, that did not already provide "additional protection" for products other than wine and spirits. It stated that implementing and administering new laws "would involve considerable costs in terms of both money and other resources for most governments, and may impact proportionately more on developing countries." It should be pointed out that the Joint Communication did not specify what these additional costs might be.

Commenting on the Joint Communication at the meetings of the TRIPS Council on 18 to 22 June 2001, the representative of Mauritius observed that the implementation of the Uruguay Round agreements as a whole was costly, but that there was no reason why an extension of additional protection should be much more expensive than the existing additional protection for wines and spirits. She also suggested that the new obligations would extend to all Members, including those that chose not to protect any of their own domestic GIs and that this could involve a considerable burden, particularly in view of the fact that some Members, such as the EU countries, have many hundreds of domestic geographical indications and would presumably expect "additional protection" of these terms by all other Members. This is no different to the burdens imposed by other categories of registrable industrial property such as patents and trade marks, where in all developing countries and LDCs and most developed countries, foreign applicants outnumber domestic applications. The ideal solution to these problems is for registration fees to cover these costs.

At the TRIPS Council meeting of 19-20 September 2001 the representative of Kenya pointed out that the additional cost of extension should not be a major issue as developing countries were facing considerable costs in implementing the TRIPS Agreement. Small additional costs resulting from extension would be offset by the benefits that accrue from it. He said that “especially for Members from the developing world, geographical indications in the areas of agriculture, handicraft and foodstuffs were a mainstay in their economy and trade.”

**Trade implications for producers**

The Joint Communication suggested that the recognition of GIs might also require that producers incur costs "if they are forced to give up the use of commercially significant terms, as they would be forced to re-name, re-label and find new ways of marketing products that use such terms, both in domestic and overseas markets" (para 21) particularly, where they “have traditionally used a term and are suddenly forced to give it up” (para 23) This suggestion tends to ignore the effects of Article 24.6 of TRIPS which provides that

Nothing in this Section shall require a Member to apply its provisions in respect of a geographical indication of any other Member with respect to goods or services for which the relevant indication is identical with the term
customary in common language as the common name for such goods or services in the territory of that Member."

Finally, the Joint Communication suggests that industries such as the emerging dairy industry in some countries "may find potentially lucrative export markets closed to their products, as the government of the importing market or a third party may claim exclusive rights over the terms used to market those products" (paras.23 and 24). This obstacle is not attributable to Articles 23 or 24 of TRIPS, but the already existing GIs protection which exists in importing countries under their domestic laws and the general prohibition of Article 22 of TRIPS for countries to eliminate misleading GIs.

**Consumer costs**

Similarly, the Joint Communication identifies “the cost of the consumer confusion caused by the disappearance of terms customarily used to identify products” which “will increase search and transaction costs for consumers, at least in the short to medium term, and potentially prices as well.” (para.25) Again, this ignores the exception in Article 24.6 for terms which are customary in common language in the Member’s country and the general obligation to eliminate misleading GIs.

**Increased risk of producer conflict over individual GIs**

The Joint Communication also stated that the process of defining GIs “would likely lead to disputes between producers” particularly within a country “over demarcation of the region to be covered by a particular GI” and between “countries (particularly those with shared borders and therefore a shared history) which produce the same good and have traditionally used a certain GI” (paras 26 and 27). In addition to ignoring the effect of Article 24.6 of TRIPS, this observation overlooks the effect of Article 24.4 of TRIPS which provides:

> Nothing in this Section shall require a Member to prevent continued and similar use of a particular geographical indication of another Member identifying wines or spirits in connection with goods or services by any of its nationals or domiciliaries who have used that geographical indication in a continuous manner with regard to the same or related goods or services in the territory of that Member either (a) for at least 10 years preceding 15 April 1994 or (b) in good faith preceding that date.

In the event that Article 24 is extended to products in addition to wines and spirits, WTO Members would be permitted to continue to use those GIs which had already been in use for those products.

A joint communication from a group of countries, including Kenya and Nigeria suggested that the concerns of the USA and the other proponents of the Joint Communication of 29 June 2001 were unfounded. The representative of Switzerland, introducing the new paper at the TRIPS Council meetings of 19-20 September 2001 pointed out that the additional protection of Article 23.1 would not create the obligation for Members to create a new, costly and burdensome
regime as Members already had to provide protection for GIs under Articles 22 and 23. Secondly, it rejected the argument that that extension would lead to renaming of products and thereby confuse consumers, since GIs indicated the true origin of a product and prevented consumers from being misled. As for the argument that GIs would restrict trade, the Swiss delegate pointed out that "[e]very Member had a national heritage and traditional products which either by their origin or inherited know-how were of a unique blend and character, whether Members were already making use of this added value or were only beginning to do so on the world market. Extension held much to gain for all Members, developed, developing and least-developed." The representative of India identified as a fundamental problem for his country "was that products of world-class reputation, such as Basmati rice and Darjeeling tea, faced competition from products sold under the same name in combination with the word "style" and thus free rode on the indication of origin." He asked opponents of extension to explain how India could avoid losing trade through these practices, which Members were permitted to allow under the TRIPS Agreement for products other than wines and spirits. He pointed out that the basic problem was the imbalance in the Agreement and there had been no convincing argument as to why wines and spirits alone should benefit from additional protection.

**Increased risk of disputes between WTO Members**

Finally, the Joint Communication warns that any Member which did not provide the extended Article 23.1 protection for other Members' GIs could be involved in difficult and burdensome dispute settlement at the WTO. This argument is equally applicable to the current formulation of Article 23.1 in its application to wines, but to date there have been no such disputes.

**The Multilateral Register**

In June 2005 the EC submitted a proposal to amend the TRIPS Agreement to provide global protection for GIs in a multilateral system of registration. This proposal seeks to bring international protection for GIs into conformity with the European Union where a Community-wide system for their registration is considered an indispensable part of agricultural policy, serving both to preserve the incomes of small to medium-size producers and to guarantee the sustainability of the rural economy. The EC submission set out provisions for a centralized register that would be compulsory and have legal effect. The EC proposal of aimed at preserving each WTO Member's prerogative to determine whether a certain sign, indication or geographical name does indeed meet the TRIPS definition of a geographical indication. Opponents of the EC proposal, the US, Australia, Argentina, Australia, Canada, Chile, Ecuador, El Salvador and New Zealand opposed the extension of GIs protection, taking the position that the international protection of GIs is adequate as it stands and that such a drastic development would only serve to undermine
future gains in market access for non-European food and agricultural products. Concern has also been expressed about the additional costs and administrative burdens of implementing a distinct system of GI protection in addition to the TRIPS obligations. They advocated a system of voluntary notification and registration with no obligation to protect registered GIs. The opposition between the US and EU demonstrates that in relation to GIs at least there is not a simple North-South divide between the industrialised and the developing worlds. Newly industrializing and leading developing countries such as India, China and Kenya are well placed to take advantage of intellectual property protection afforded agricultural GIs. Other developing countries, however, may lack either the agricultural tradition related to place or the financial means to enforce the worldwide protection of their GIs. In June 2005 the EC submitted a proposal to amend the TRIPS Agreement to provide global protection for GIs in a multilateral system of registration. This proposal sought to bring international protection for GIs into conformity with the European Union where a Community-wide system for their registration is considered an indispensable part of agricultural policy, serving both to preserve the incomes of small to medium-size producers and to guarantee the sustainability of the rural economy. Given the fact that it possesses over 700 registered geographical indications, sophisticated institutional infrastructure and technical prowess, the European Union is exceptionally well placed to leverage the benefits of an expanded international system of GI protection. The EC submission set out provisions for a centralized register that would be compulsory and have binding legal effect. The EC proposal aimed at preserving each WTO Member’s prerogative to determine whether a certain sign, indication or geographical name met the TRIPS definition of a geographical indication. The US, Australia, Argentina, Australia, Canada, Chile, Ecuador, El Salvador and New Zealand opposed the extension of GIs protection, taking the position that the international protection of GIs is adequate as it stands and that such a drastic development would only serve to undermine future gains in market access for non-European food and agricultural products. Concern has also been expressed by these countries and others about the additional costs and administrative burdens of implementing a distinct system of GIs protection in addition to the TRIPS obligations. The opponents advocated a system of voluntary notification and registration with no obligation to protect registered GIs. A revised Communication from these countries, together with South Africa, proposed that the TRIPS Council should set up a voluntary system where notified geographical indications would be registered in a database. Those governments choosing to participate in the system would have to consult the database when taking decisions on protection in their own countries. Non-participating members would be “encouraged” but “not obliged” to consult the database. Hong Kong, China proposed a compromise under which a registered term would enjoy a more limited “presumption” than under the EU proposal, and only in those countries choosing to participate in the system.
In July 2008, a group of WTO members called for a “procedural decision” to negotiate three intellectual property issues in parallel: these two geographical indications issues and a proposal to require patent applicants to disclose the origin of genetic resources or traditional knowledge used in their inventions. \(^{40}\) In relation to the GIs Register the proposed text was that:

1. Members agree to establish a register open to geographical indications for wines and spirits protected by any of the WTO Members as per TRIPS. Following receipt of a notification of a geographical indication, the WTO Secretariat shall register the notified geographical indication on the register. The elements of the notification will be agreed.

2. Each WTO Member shall provide that domestic authorities will consult the Register and take its information into account when making decisions regarding registration and protection of trademarks and geographical indications in accordance with its domestic procedures. In the framework of these procedures, and in the absence of proof to the contrary in the course of these, the Register shall be considered as a *prima facie* evidence that, in that Member, the registered geographical indication meets the definition of “geographical indication” laid down in TRIPS Article 22.1. In the framework of these procedures, domestic authorities shall consider assertions on the genericness exception laid down in TRIPS Article 24.6 only if these are substantiated.

3. Text based negotiations shall be intensified, in Special Sessions of the TRIPS Council and as an integral part of the Single Undertaking, to amend the TRIPS Agreement in order to establish the Register accordingly.

In relation to GI-Extension the proposed text was that:

7. Members agree to the extension of the protection of Article 23 of the TRIPS Agreement to geographical indications for all products, including the extension of the Register.

8. Text based negotiations shall be undertaken, in Special Sessions of the TRIPS Council and as an integral part of the Single Undertaking, to amend the TRIPS Agreement in order to extend the protection of Article 23 of the TRIPS Agreement to geographical indications for all products as well as to apply to these the exceptions provided in Article 24 of the TRIPS Agreement *mutatis mutandis*.

To date WTO Members remain divided over the proposal to negotiate the three subjects in parallel, with opponents arguing that the only mandate for the TRIPS Council is to negotiate the multilateral register. Under the Chairmanship of Ambassador Trevor C. Clarke (Barbados) during 2008-2009, the Special Session of the TRIPS Council considered the various proposals which had been made and the Chairman identified as “crucial” the two issues of participation and consequences/legal effects of registration.\(^{41}\) With respect to the issue of whether participation in the system should be voluntary or mandatory, some WTO Members interpreted the reference in the mandate concerning "a multilateral system" to mean that the system should apply to all Members. Other Members argued that the words "those Members participating in the system" mean that not all Members are expected to
participate. Ambassador Clarke encouraged Members “to continue searching for an acceptable solution that would determine a participation of Members in the Register that renders it a useful and meaningful tool in line with its purpose to facilitate protection.” With respect to the consequences/legal effects of registration, all Members seem to accept an obligation to consult the information on the Register and to take the information on the Register into account when making decisions regarding registration and protection of trademarks and geographical indications under their national procedures. However, views differ significantly as to how such information should be taken into account, what weight and significance should be given to it, and whether there should be a specific legal obligation to take the information into account.

In order to advance the negotiations, Ambassador Clarke suggested the following “Guiding Principles”:

(i) The purpose of the Register is to facilitate, not to increase, the protection of GIs for wines and spirits.
(ii) The Register should be useful and meaningful to both notifying Members and consulting Members.
(iii) The territorial nature of intellectual property rights should be preserved.
(iv) The Register should not impose undue financial and administrative burdens on Members.
(v) Special and differential treatment should be precise, effective and operational.

Ambassador Clarke’s successor as Chairman of the Special Session of the Council for TRIPS, Ambassador Darlington Mwape (Zambia) announced, upon assuming this office that the specific negotiating mandate of the Special Session was limited to the negotiations of a Multilateral Register of GIs for wines and spirits. He has strenuously resisted any calls for the extension of the Multilateral Register to products other than wines and spirits. In his report to the Trade Negotiations Committee (TNC) of 22 March 2011 he reiterated that “the specific negotiating mandate of the Special Session is limited to the negotiations of a Register of GIs for wines and spirits, and other TRIPS-related issues are being handled in another context and at a different level.” Ambassador Mwape is adhering to the strict letter of the Doha mandate. For the reasons mentioned above, there is no justification in principle for the differential treatment of wines and spirits in comparison with other products, both in relation to Article 23, as well as in relation to the multilateral register. If the extension of the register is to be addressed, it will have to be in the context of the general extension debate, as part of the periodic revisions of the TRIPS Agreement.

Indeed, Ambassador Mwape has had a singular lack of success in securing agreement from negotiating parties even on a draft composite text on the Register. Ambassador Mwape reported that this text was “without prejudice to Members’ positions on the overall outcome of the negotiations” and that “Members are working on the understanding that nothing is agreed until everything is agreed, and that Members may revert to any issue of the text at any time.” Ambassador Mwape reported that despite the fact that this text reflects
the current state of negotiations, views differ on “whether and how the negotiating mandate should be accurately reflected in the Draft Composite Text” and that both sides appear to prefer that the text represents “the factual representation of the state-of-play in this negotiating group” at this time. 

Ambassador Mwape explained that “I have made strenuous attempts to resolve this and have offered to use my prerogative as Chair to improve textual compliance with the Special Session of the Council for TRIPS mandate. However, Members have been unable to engage constructively on this question and have instead insisted that the purely bottom-up and Member-driven nature of the text be scrupulously respected at this time.” In view of this situation, it may well be the case that the ACP Group of countries are better advised to address the possible extension of the multilateral register in the context of the general extension debate.

GI Disputes under the TRIPS Agreement

A number of WTO Members argued that the EU scheme for the protection of GIs was TRIPS-deficient in a number of areas. For example, the statement of the US to the WTO on the WTO trade policy review of the European Union expressed the concern that “foreign persons wishing to obtain protection for their GIs in the EU itself face a non-transparent process that appears to come into some conflict with the EU’s TRIPS obligations” and that “EU rulemaking processes are often perceived by third countries as exclusionary, allowing no meaningful opportunity for non-EU parties to influence the outcome of regulatory decisions”. On 1 June 1999, the US requested consultations with the European Communities (“EC”) pursuant to Article 4 of the Understanding on Rules and Procedures Governing the Settlement of Disputes (“DSU”) and Article 64 of the of the TRIPS Agreement regarding EC Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs. The United States and the EC held consultations on 9 July 1999, and thereafter, but these and following consultations failed to resolve the dispute.

In view of the global markets at stake in the agricultural and food processing sectors, the US and Australia became so concerned at the systematic discrimination its trade mark owners faced in enforcing their rights against European registered GIs that it invoked the WTO dispute settlement procedure. On the 18 August 2003, the US and Australia requested the establishment of a WTO dispute settlement panel to review the consistency of the EU Regulation 2081/92 with the rules of the TRIPS and GATT Agreements. The US and Australia argued that the EU scheme for the protection of geographical indications failed to comply with TRIPS in three chief respects: First, they claimed the EC Regulation was discriminatory and in violation of the national treatment obligations and the most-favoured-nation obligations in Articles 3 and 4 of the TRIPS Agreement and Articles I and III of the General Agreement on Tariffs and Trade 1994. The TRIPS Agreement requires that Members accord most-favoured-nation treatment to the GIs of fellow Member
States and national treatment to the geographical indications of their citizens. The US and Australia argued that Regulation 2081/92 does not provide the same treatment to other nationals and products originating outside the EC that it provides to the EC’s own nationals and products, does not accord immediately and unconditionally to the nationals and products of each WTO Member any advantage, favour, privilege or immunity granted to the nationals and products of other WTO Members, diminishes the legal protection for trademarks, does not provide legal means for interested parties to prevent the misleading use of a geographical indication, does not define a geographical indication in a manner that is consistent with the definition provided in the TRIPS Agreement, is not sufficiently transparent, and does not provide adequate enforcement procedures. As a result of the alleged violation, when US holders of geographic indications such as FLORIDA ORANGES and IDAHO POTATOES sought registration under the EC Regulation, they were subject to a requirement of reciprocity and equivalence. Although expressed to be ‘without prejudice to international agreements’ Article 12 states that the Regulation ‘may apply to an agricultural product or foodstuff from a third country provided that:

(a) the third country is able to give guarantees identical or equivalent to those referred to in Article 4,

(b) the third country concerned has inspection arrangements and a right to objection equivalent to those laid down in this Regulation,

(c) the third country concerned is prepared to provide protection equivalent to that available in the Community to corresponding agricultural products for foodstuffs coming from the Community.

Secondly, they claimed that the grant of exclusive rights in the use of the mark provided by virtue of TRIPS Article 16.1 require Member States to make available to earlier trademark owners rights against GIs. The United States argued that the Regulation was inconsistent with the exclusivity of the trade mark owners’ rights under Article 16.1 of the TRIPS Agreement because it does not ensure that a trademark owner may prevent uses of GIs which would result in a likelihood of confusion with a valid prior trademark.

Thirdly, they argued that Regulation 2081/92 was inconsistent with the EC’s obligations under Article 24.5 of the TRIPS Agreement, since the Regulation failed to provide sufficient protection to pre-existing trademarks that were similar or identical to a geographical indication.

Food exporters in the United States were concerned that geographical indications should not be given precedence over trade mark rights. The issue was one of priority between a coexisting GI and a trademark and whether the principle of first-in-time, first-in-right should be enforced as it is in the trade mark law of the United States. In contrast, in the EU trade marks are required to coexist with geographical indications. Under European law a trademark owner’s rights cannot prevail over a third party using a duly registered GI in accordance with honest business practices. As a result private trade mark suits brought by US litigants against European owned GIs might well result in the US trade mark owner having to forfeit valuable rights to priority and exclusivity. Thus, trade mark wars over the competitive European market for beer, had seen US trademarks
“BUDWEISER” and “BUD,” subject to termination in various Member States of the European Communities because the European law holds “BUDWEISER” and “BUD” to be geographical indications for beer from the Czech Republic. The cancellation of the Budweiser and Bud trademarks for beer in Europe caused unease among U.S. trade mark owners. The obstacles to registering US certification marks as GIs in Europe gave rise to further uncertainty about the security of protection and conditions of competition.

The USA and Australia claimed that the EU Regulations imposed two requirements which contravened the national treatment principle contained in Article 2(2) of the Paris Convention as incorporated by Article 2.1 of the TRIPS Agreement: (i) the requirement that enterprises seeking to register GIs possessed a commercial establishment in the EU; and (ii) the requirement that GIs located in the territory of a WTO Member outside the EU could only be registered if that Member had adopted a system for GI protection that was equivalent to that in the European Communities and provided reciprocal protection to products from the European Communities.

The Panel Report in the dispute was adopted at a meeting of the Dispute Settlement Body on 20 April 2005. Concerning the discriminatory conditions regarding the registration of foreign GIs and requirement for reciprocity of protection, the Panel decided in favour of the US and Australia. Pursuant to Article 19.1 of the DSU, the Panel recommended that:

(a) The European Communities bring the Regulation into conformity with the TRIPS Agreement and GATT 1994.

(b) The European Communities could implement the above recommendation with respect to the equivalence and reciprocity conditions, by amending the Regulation so as for those conditions not to apply to the procedures for registration of GIs located in other WTO Members.

In an affirmation of the GI as intellectual property, the Panel endorsed the European principle of their coexistence with all but the most famous of prior trade marks. The Panel found that Art.14(2) of the Regulation was a "limited exception" permitted by Art. 17 of TRIPS because it only allows use by those producers who are established in the geographical area of products that comply with the specification.

On the critical issue of whether the nationals of other WTO Members were accorded less favourable treatment than the European Communities' own nationals, the Panel ruled that the conditions in the Regulations modified the effective equality of opportunities to obtain protection with respect to intellectual property in two ways. First, GI protection was not available in respect of geographical areas located in third countries which the Commission had not recognized. It was confirmed that the European Commission had not recognized any third countries. Second, GI protection under the Regulation could become available if the third country in which the GI is located entered into an international agreement with the EU. For the Panel, both of those requirements represented a significant "extra hurdle" in obtaining GI protection which did not apply to geographical areas located in the European Communities. The significance of the hurdle was taken to be reflected in the fact that currently no
third country had entered into such an agreement or satisfied those conditions. Accordingly, the Panel found that the equivalence and reciprocity conditions modified the effective equality of opportunities with respect to the availability of protection to persons wishing to obtain GI protection under the EU legislation, to the detriment of those wishing to obtain protection in respect of geographical areas located in third countries, including WTO Members. This was held to be less favourable treatment.

The Panel noted that whilst the Regulation did not prevent a foreign national from producing goods within the territory of the European Communities, the different procedures which applied to foreign nationals compared with those of the EU, were perceived as disadvantageous to the nationals of other Members (see Evans and Blakeney, 2006).

**Special and Differential Treatment under TRIPS**

The Agreement which established the WTO and a number of the annexed agreements, including TRIPS contain a number of provisions regarding the special and differential treatment (S&DT) of developing countries and LDCs. The objective of S&DT is to minimise the asymmetrical level of WTO member countries’ available resources (Alavi, 2009). This principle was recognised in paragraph 44 of the Doha Declaration, which stated:

> We reaffirm that provisions for special and differential treatment are an integral part of the WTO Agreements. We note the concerns expressed regarding their operation in addressing specific constraints faced by developing countries, particularly least developed countries. In that connection, we also note that some members have proposed a Framework Agreement on Special and Differential Treatment (WT/GC/W/442). We therefore agree that all special and differential treatment provisions shall be reviewed with a view to strengthening them and making them more precise, effective and operational. In this connection, we endorse the work programme on special and differential treatment set out in the Decision on Implementation-Related Issues and Concerns.

The main general S&DT provisions of TRIPS concern: (i) the phased implementation of its obligations by developing countries and LDCs provided for in Articles 65.2 and 65.4; (ii) technical and financial assistance to facilitate implementation of the Agreement provided for in Article 67; and (iii) the encouragement of technology transfer to LDCs provided for in Article 66.2. Under Art.65(2) developing countries were required to implement the provisions of TRIPS, including those relating to GIs, by the end of 1999, which was five years from the commencement of the Agreement. LDCs were given an extra five years for implementation by Art. 65.4. A decision of 29 November 2005 by the TRIPS Council extended the transition period for the implementation of the TRIPS Agreement by LDCs, from 1 January 2006 to 1 July 2013. That decision called for LDCs to provide the WTO TRIPS Council, preferably before 1 January 2008, as much information as possible on their individual priority needs for technical and financial assistance for implementing the TRIPS Agreement.
Following comprehensive needs assessment and stakeholder consultation exercise in Sierra Leone undertaken by ICTSD and Saana Consulting in 2007, with funding from the UK Department for International Development (DFID) on 3 October 2007 Sierra Leone made a formal submission of its needs for technical and financial assistance to the TRIPS Council. With encouragement from TRIPS Council Members and WTO Secretariat, and drawing on the experience of Uganda, in September 2008 Sierra Leone took the initiative to follow up the needs assessment by identifying the priority needs and translating these into a modest, initial two-year technical assistance project to enable the country to start taking forward the implementation of the TRIPS Agreement. A draft project document was prepared by the Government of Sierra Leone for a national technical assistance project on intellectual property rights and the TRIPS Agreement. By a communication from Sierra Leone dated 22 October 2008 the Government of Sierra Leone requested “immediate consultations with developed country WTO Members, on the operationalising of Article 67 of the TRIPS Agreement, as well as WIPO, WCO and UNCTAD and the Enhanced Integrated Framework Secretariat, with a view to securing technical and financial assistance for implementation of the proposed IP4SL project.” To date there has been no provision of technical assistance in response to this request.

Of greatest relevance to the introduction of GIs into LDCs is the encouragement of technology transfer by Ar. 66.2. It provides that:

Developed country Members shall provide incentives to enterprises and institutions in their territories for the purpose of promoting and encouraging technology transfer to least-developed country Members in order to enable them to create a sound and viable technological base.

The expertise of countries, particularly those in Europe, in establishing and managing GIs systems is an obvious source of expertise for those LDCs seeking to establish the marketing of origin goods. It has been suggested that this S&DT provision should also be extended to developing countries (Michalopoulos, 2002 at p.12).

It has been suggested that S&DT measures are a way of “rebalancing” the TRIPS Agreement to provide a better reflection of the interests of developing countries and LDCs in line with the objectives of the Agreement which are set out in Article 7 (see Stevens, 2003). Although GIs are not an area where there is neat demarcation of developed/developing country interests, it is suggested that “some developing countries would clearly benefit from higher standards of GIs protection applied to all products.” (Michalopoulos, 2002 at p.14). The development of the multilateral register and its extension to all products is an example of this approach. Also, the “effective implementation of rules for disclosure of geographic origin for genetic materials would appear to contribute to rebalancing of the TRIPS Agreement in favour of developing countries” (Michalopoulos, 2002 at p.17).

Other Possibilities for the International Protection of GIs

**WTO Agreement on Agriculture**
The question of the international protection of GIs has also been pursued, particularly by the EU, outside the TRIPS Council. In February 2003, the EC proposed to the WTO’s Committee on Agriculture, that it “claw back” certain GIs which were being “used by producers other than the right-holders in the country of origin”.\(^{58}\) The EC’s approach to geographical indications in the context of the agriculture negotiations is complementary to the TRIPs negotiations. The EC explained that its objective was to negotiate “specific commitments in order to guarantee fair market access opportunities for those wines, spirits and other agricultural and food-stuff products whose quality, reputation or other characteristics are essentially attributable to their geographical origin and traditional know-how.”\(^{59}\) As a follow-up to this proposal, in September 2003, a preliminary list of products (wines, spirits, cheeses and ham) were notified to the Committee which fell into this category.\(^{60}\) The claw back proposal was strongly opposed by the same countries which were opposed to GIs extension in the TRIPS Council. The EC sought to allay concerns by referring to the “grandfathering” clause of Article 24.4, which would allow the use of protected GIs by producers in third countries providing that they have done so for more than ten years prior to the signing of an amendment.\(^{61}\)

At the TRIPS Council meetings of 27 to 30 November and 6 December 2000 the representative of Mauritius pointed out, though, that a country like hers was asked in the areas of agriculture and services to liberalize and its response was that it did not think that it could actually do so in such a simple manner, because it did not have the competitive capacity to survive in a liberalized world.\(^{62}\) Realizing that it had one or two geographical indications, which could provide it with a niche market for one or two small products, she indicated that Mauritius was participating in the extension debate in the hope that, maybe after all, it could get some opportunities out of it.\(^{63}\)

Within the Committee on Agriculture the view has been strongly pressed that GIs protection was a matter for the TRIPS Council, as the agriculture negotiations focus on food products, whereas proposed negotiations under TRIPS would cover all products including handicrafts, etc.\(^{64}\) Certainly, the recent WTO documents concerning the negotiations on agriculture make no reference to GIs.

**Convention on Biological Diversity (CBD) and the Protection of Traditional Knowledge (TK)**

At the May 9-10, 2011 workshop on GIs under this project a number of delegations indicated that CBD issues were more important for them than GIs. The principal CBD issues which have been pursued in the FAO, WIPO and the WTO concern the access to genetic resources, the disclosure of the origin of those resources when forming the basis of patent applications and the sharing of benefits from their utilisation, particularly when those resources are identified with the assistance of TK.

By way of example, in 2002 the EU had submitted to the TRIPS Council that the disclosure of origin of genetic resources involved in patent applications should be a mandatory obligation.\(^{65}\) This was reiterated by the EU in May 2005 in its
submission to the IGC on the “Disclosure of Origin or Source of Genetic Resources and Associated Traditional Knowledge in Patent Applications”, the EU argued that “there are good reasons for an obligation to disclose that an invention is directly based on traditional knowledge associated with the use of genetic resources.” The African Group of countries endorsed this EU proposal in the Group’s response to the Australia/New Zealand May 2010 submission to the IGC. The African Group also proposed the principle that IPRs and obligations be clarified “with respect to the protection of traditional knowledge, genetic resources and traditional cultural expressions and certainty and clarity for prior informed consent and fair and equitable benefit sharing.”

On December 8, 2010, the Delegation of Angola submitted the proposals of the African Group. This suggested the commencement of negotiations on a mandatory disclosure requirement and an appropriate way to ensure prior informed consent and fair and equitable benefit sharing, in line with the Nagoya Protocol. The African proposal suggested that negotiations be based upon two current proposals on a mandatory disclosure requirement and the incorporation of the “internationally recognized certificate of compliance” as stipulated in the Nagoya Protocol, together with any other submission that may be tabled by member countries. In relation to the option for guidelines and recommendations on defensive protection, the African Group proposed consideration of the use of available databases on GR and/or associated TK.

On May 6, 2010, the Delegations of Australia, Canada, New Zealand, Norway and the United States of America submitted a working document on GR Geneva, for the seventeenth session of the IGC held December 6 to 10, 2010. The African Group proposed a number of amendments are to this submission. It suggested that “inventors/users using genetic resources and/or associated traditional knowledge comply with requirements for prior informed consent and fair and equitable benefit sharing”. That patents not be granted where these requirements are not met and that “the patent system must provide for a mandatory disclosure requirement ensuring that the IP Offices becomes a key checkpoint for disclosure and monitoring the utilization of genetic resources and/or associated TK (in line with Article 13 of the CBD Nagoya Protocol)”. In relation to TK, the African Group proposed the following principles:

- Recognise and maintain the role of the IP system in promoting innovation and in the protection of traditional knowledge, genetic resources and traditional cultural expressions and fair and equitable sharing of benefits arising from their use.
- Promote certainty and clarity of IP rights and obligations with respect to the protection of traditional knowledge, genetic resources and traditional cultural expressions and certainty and clarity for prior informed consent and fair and equitable benefit sharing.
- Promoting transparency and dissemination of information by disclosing country of origin and publishing and disclosing technical information.
related to new inventions, where appropriate and where publicly available, so as to enrich the total body of technical knowledge accessible to the public.

At the Third Intersessional Working Group of the IGC, which met from February 28 to March 4, 2011, a Working Group was appointed to review and rationalize the various Objectives and Principles which had been received by the IGC with a view to clarifying the key and divergent policy positions and issues, which the IGC would need to make informed decisions. This report was transmitted to the IGC for its consideration at its 18th session (May 9 to 13, 2011).

In the absence of agreement of the IGC, or other fora on these CBD issues, the international protection of GIs might provide a useful second best solution. A number of the so-called “biopiracy” episodes have involved the appropriation of biological resources which are often sold under names which identify their geographical origin. The development of an international system for the protection of GIs might therefore also provide for the protection of biological resources.

Notes

1. Arrêt de la Cour du Parlement concernant la police des vins, 18 July 1764.
2. The Stresa Convention was ratified by Austria (12 June, 1953); Denmark (2 August 1953); France (20 May 1952); Netherlands (29 October 1955); Norway (31 August 1951); Sweden (27 January 1951) and Switzerland (5 June 1951).
9. WTO Doc. WT/MIN(01)/DEC/1, 20 November 2001
10. IP/C/W/204/Rev.1, 2 October 2000.
14. Ibid.
15. Ibid., para. 87.
16. Ibid., para.88.
17. Ibid., para 89.
18. IP/C/M/29, para. 103, 6 March 2001.
19. Ibid.
20. WTO Doc. IP/C/W/289.
22. Ibid., Attachment at paras. 14-16.
26. Ibid.
27. The other proponents were the delegations of Bulgaria, Cuba, the Czech Republic, Georgia, Hungary, Iceland, India, the Kyrgyz Republic, Liechtenstein, Moldova, Pakistan, Slovenia, Sri Lanka, Switzerland and Turkey (WTO Doc. IP/C/W/308, 2 October 2001).
29. Ibid.
30. Ibid., para. 76.
31. Ibid., para 28.
32. Paragraph 3.2(a).
34. The EC proposed amending Section 3 of the TRIPS Agreement with a view to extending the regime of protection today available for geographical indications on wines and spirits to geographical indications on all products ("extension") and; in addition a proposal for the inclusion of an annex to the TRIPS Agreement establishing a multilateral system of notification and registration of geographical indications (GIs). World Trade Organization, General Council, Trade Negotiations Committee, Council for Trade-Related Aspects of Intellectual Property Rights, Special Session on Geographical Indications, Communication from the European Communities 14 June 2005, WT/GC/W/547, TN/C/W/26, TN/IP/W/11.
35. 'Since 1993, more than 700 names, designating inter alia over 150 cheeses, 160 meat and meat-based products, 150 fresh or processed fruits or vegetables and 80 types of olive oil, have been registered in this context. The Commission has also received over 300 further applications for the registration of names and/or amendments to specifications from Member States and third countries'. Proposal for a Council Regulation on the Protection of Geographical Indications and designations of origin for agricultural products and foodstuffs, Commission of the European Communities, Brussels, 5.1.2006, para.3.
39. TN/IP/W/8, 23 April 2003
40. Communication from Albania, Brazil, China, Colombia, Ecuador, the European Communities, Iceland, India, Indonesia, the Kyrgyz Republic, Liechtenstein, the Former Yugoslav Republic of Macedonia, Pakistan, Peru, Sri Lanka, Switzerland, Thailand, Turkey, the ACP Group and the African Group, TN/IP/W/52, 19 July 2003
42. Ibid., para.11.
43. Ibid., at para.16.
45. Ibid., para. 5.
46. WTO Doc TN/IP/21 at para. 15.
47. Ibid., paras 15-17.
48. Ibid., para 16.
49. WTO Trade Policy Review of the European Union, Statement by the United States to the WTO, 24 July 2002,
50. See variously, United States' first written submission, paras. 137-140, 170; United States' first oral statement, paras. 42-43.
51. Gerolsteiner Brunnen GmbH & Co. v Putsch GmbH (Case C-100/02).
52. The battle over the right to the name ‘Budweiser’ has pitted the world’s largest brewer, Anheuser-Busch of the United States, against the ‘boutique’ Czech brewer Budejovicky Budvar. The latter, based in the Czech town of Ceske Budejovice (also known as Budweis), claims it has been brewing a beer under the name since the 13th century, although the American beer has gained broader international reputation in recent years. See WTO, 1999: Preparations for the 1999 ministerial conference – Agreement on TRIPS: Extension of the additional protection for geographical indications to other products. Communication from the Czech Republic. WT/GC/W/206.
53. WT/DS290/R.
54. Eg see European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products And Foodstuffs- complaint by the USA, WTO Doc WT/DS174/R, 15 March 2005, para 7.139.
55. Ibid., at para 7.141.
58. See WTO document IP/C/W/523.
59. WTO Doc., A Proposal For Modalities In The WTO Agriculture Negotiations, Specific Drafting Input by the EC’, JOB(03)/12, 5 February 2003.
60. Ibid., at 3.
63. IP/C/M/29, para. 103, 6 March 2001.
64. Ibid.
65. Communication by the EC and its Member States to the TRIPs Council on the review of Article 27.3 (b) of the TRIPs Agreement, and the relationship between the TRIPs Agreement and the Convention on Biological Diversity and the protection of traditional knowledge and folklore, WTO document IP/C/W/383.


68. Ibid., Annex., at p.6.

69. WIPO/GRTKF/IC/17/10.


71. WIPO/GRTKF/IC/16/7.


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