



International - Talks continue, but longstanding differences present obstacle to GI consensus

By Jane Denny

November 14 2011

Next month WIPO member states and interested parties will discuss a new draft instrument for the protection of geographical indications (GIs) and appellations of origin. The proposals follow Antonio Campinos' recent statement that OHIM would welcome the opportunity to oversee a non-agricultural register of GIs. However, the Europe v United States divide on GIs seems as wide as ever.

While there are many countries with national systems based only on a definition for 'geographical indications' along the lines of **Article 22.1** of the **Trade-Related Aspects of Intellectual Property Rights** agreement, others have national systems based on two definitions, one for 'geographical indications' and a second one for 'appellations of origin' along the lines of Article 2 of the **Lisbon Agreement**.

The international challenge is to create a registration system which unites these two approaches. Considering the upcoming discussions, Matthijs Geuze, head of the International Appellations of Origin Registry, explains: "In 2008, member states of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration created a Working Group for the purpose of exploring how this international registration system could be made more attractive for users and prospective new member states, while preserving its principles and objectives. This group is now engaged in a review of the Lisbon system, which has started to move in the direction of a revision of the Lisbon Agreement."

For trademark counsel, one challenge has been navigating international GI registrations, and the creation of a multilateral register for wines and spirits is currently being discussed under the Doha Agenda. At the MARQUES conference in September, Campinos outlined OHIM's support for the system of rights, suggesting that one role OHIM could take on is "the creation of a registration system for non-agricultural GIs, which the commission is currently examining... Non-agricultural GIs cover things that are a very vital part of national and regional identities. They create and sustain jobs and contribute to economic development. This is an area which is complementary to OHIM's existing expertise".

The OHIM president's stance on the issue has gained backing from **MARQUES** representative **Tove Graulund**, who says: "We would certainly not be against OHIM taking responsibility for running a GI register. It is really very untransparent at present, and when you do a search it is a challenge – some people know where to look and others don't. If OHIM could step in and create an accessible way to pre-search GIs, this would be perfect."

While the creation of a searchable register would be a useful tool, the wider issue of GIs continues to be divisive. A **recent European Commission** study looked at the feasibility of extending higher levels of protection to GIs for non-agricultural goods. The report referred to the "merits in looking at the creation of a specific and effective legal framework for their protection at the EU level. Such an approach could be based on the existing *sui generis* GI system available to wines, spirits and agricultural products which is perceived by producers as both an interesting protection and promotion tool. Finally, this could arguably give more credibility and leverage to the EU's approach on GIs in the international – bilateral and multilateral – negotiations. This could especially facilitate the enhancement of all European GIs at the international level."

During the most recent World Trade Organisation discussions in Doha, which were aimed at reaching a multi-lateral consensus on the GI issue, it became clear this enhancement would not be an easy task beyond the European Union.

In the 'anti GI' camp, the general feeling is that GIs have the potential to erode rights already registered by trademark owners, diluting registered trademarks and threatening the loss of rights by creating generic terms.

Bruce MacPherson, director of external relations at **INTA**, explains that the two camps are essentially the European Union and the United States, with the thinking of the pro-GI camp within Europe standing in almost direct opposition to current US thinking on the issue. He characterises the European perspective on GIs as ultimately self-serving: "The Europeans form agreements with developing countries by asking them to respect its 2,000 or so GIs in exchange for the EU respecting that developing country's four GIs."

INTA endorses the 'first in time, first in right' system and, says MacPherson, there should be no expectation of co-existence between a newly granted GI and a previously filed trademark "unless the trademark owner is willing".

Graulund agrees that the rights of trademark owners need to be balanced: "Our longer-term goal would be to have fairer examinations of GIs, as currently a brand owner cannot object to the

registration of a GI. It is a member state issue and a member state must object – there is no private interest voice or opposition process. I think that ‘first in time, first in right’ needs to be respected, but such a development is quite far off.”

The disparity between treatment of GIs highlights the difficulty for trademark owners in ensuring they don’t fall foul and, while political consensus on the international regime may be some way off, the creation of registers such as that proposed by OHIM can only be a positive tool for brand owners.

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