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Geographical Indications in the WTO News from the Doha Round of Negotiations



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Relevant TRIPS Provisions



- Definition (Article 22.1)
- Basic level of protection (Article 22.2-4)
- Additional protection for wines and spirits (Article 23)
- Agreement to enter into negotiations (Article 24.1)
- Not diminish protection GIs existing before TRIPS (Article 24.3)
- Exceptions (Article 24.4-9)
- Mandate to negotiate a GI Register (Article 23.4)
- National and MFN treatment (Articles 3-5)
- Procedures of acquisition & maintenance of rights if registration is foreseen (Article 62)
- Enforcement (Part III)
- Transition periods
- Dispute settlement

The TRIPS GI regime



- accommodates different manners of implementation (trademark system / *sui generis* system / unfair competition)
- does not require registration as a constitutive element
- accommodates both limited coexistence between earlier TMs and GIs, as well as strict first-in-time first-in-right approach
- covered by the WTO Dispute Settlement System

Dispute Settlement Case DS174/290

EC – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs



Complaints:

- by the US (WT/DS174/20) and Australia (WT/DS290/18)
- against the EU Regulation 2081/92 on GIs (foodstuffs)
- Panel Report adopted 20 April 2005 (WT/DS174/R and WT/DS290/R). No Appeal.
- Result:
 - EU's treatment of relationship between GIs and TMs is not in violation of TRIPS (limited co-existence of TMs and GIs),
 - but the system discriminates against non-EU GIs and thus violates the national treatment obligation under TRIPS
- EC amended its Regulation 2081/92. New Regulation 510/2006 entered into force in March 2006.

Negotiations on a GI Register

Negotiating Mandate: Article 23.4



*“In order **to facilitate** the protection of geographical indications 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.**”*

Highlighted: elements where delegations are having differences of views

GI Register Negotiations: Issues



Negotiating Positions:

- Main differences: **legal effect** and **participation**
 - Two basic approaches:
 - Commitment to consult a data base of registered GIs; legal effects under the domestic law; voluntary participation
 - A registration to have certain legal effects in all Members
 - Middle ground proposed Hong Kong, China: certain presumptions; voluntary participation
- Notification and registration
- Special and Differential Treatment, Costs, Fees.

GI Register Negotiations: The proposals on the table since 2008



- TN/IP/W/10/Rev.4 by the Joint Proposal Group (Argentina, Australia, Canada, Chile, Costa Rica, Dominican Republic, Ecuador, El Salvador, Guatemala, Honduras, Israel, Japan, Korea, Mexico, New Zealand, Nicaragua, Paraguay, **South Africa**, Chinese Taipei and the United States) (April 2011) (*Voluntary participation, commitment to consult the register, legal effects only under national law*)
- TN/IP/W/8 by Hong Kong, China (April 2003) (*Voluntary participation, certain rebuttable legal presumptions*)
- TN/C/W/52 (para. 1-3 and 9) by the “Modalities Group” (Albania, Brazil, China, Colombia, Croatia, Ecuador, the European Communities, Georgia, Iceland, India, Indonesia, the Kyrgyz Republic, Liechtenstein, Moldova, the Former Yugoslav Republic of Macedonia, Pakistan, Peru, Sri Lanka, Switzerland, Thailand, Turkey, **the ACP Group and the African Group**) (July 2008) (*Mandatory participation, register information is prima facie evidence for meeting the GI definition, assertions of genericism have to be substantiated*)

Recent progress – a single text



- Development of single negotiating text in consultations of a drafting group since January 2011
- *Easter Package* - Chair's report in TN/IP/21:
 - Summarizes work done
 - Publishes draft composite text (JOB/IP/3/Rev.1)

Draft Composite Text:

Differences on Legal Effect and Participation remain



[X.2 SCOPE AND COVERAGE

This system applies to wines falling under heading 22.04, and to spirits falling under heading 22.08, of the International Convention on the Harmonized Commodity, Description and Coding System ("Harmonized System"), done at Brussels on 14 June 1983.]^{CAN}

A. PARTICIPATION

A.1 [In accordance with paragraph 4 of Article 23 of the TRIPS Agreement,]^{JP,SG} participation in the System [[established in this Decision]^{JP,SG} is voluntary and no Member shall be required to participate.]^{JP,HKC,SG,IND,BRA}

[Participation in the system means:

- (a) Each WTO Member [shall be free to participate and]^{HKC} may notify geographical indications as provided in Section B.]^{CH,EU,HKC}
- (b) [Each WTO Member shall consult the Register as provided in Section E.]^{CH,EU} [The obligation to give legal effect to registrations under the system will only be binding upon Members choosing to participate in the system.]^{HKC,IND,BRA}

[A.2 In order to participate in the System, a Member shall make a written notification to the WTO through the WTO Secretariat of its intention to participate.]^{JP,CUB,HKC}

B. NOTIFICATION

Draft Composite Text:

Some issues contemplated by the drafting group



Notification:

- Content of Notification
 - Notify domestic means of protection?
- Translation / transliteration

Registration:

- Formality examination by WTO Secretariat
- Obligations to notify corrections?
- Withdrawals of registered GIs
- Require renewal of registrations after 10 years?
- Question of fees

Draft Composite Text:

Some issues contemplated by the drafting group



Special and Differential Treatment provisions:

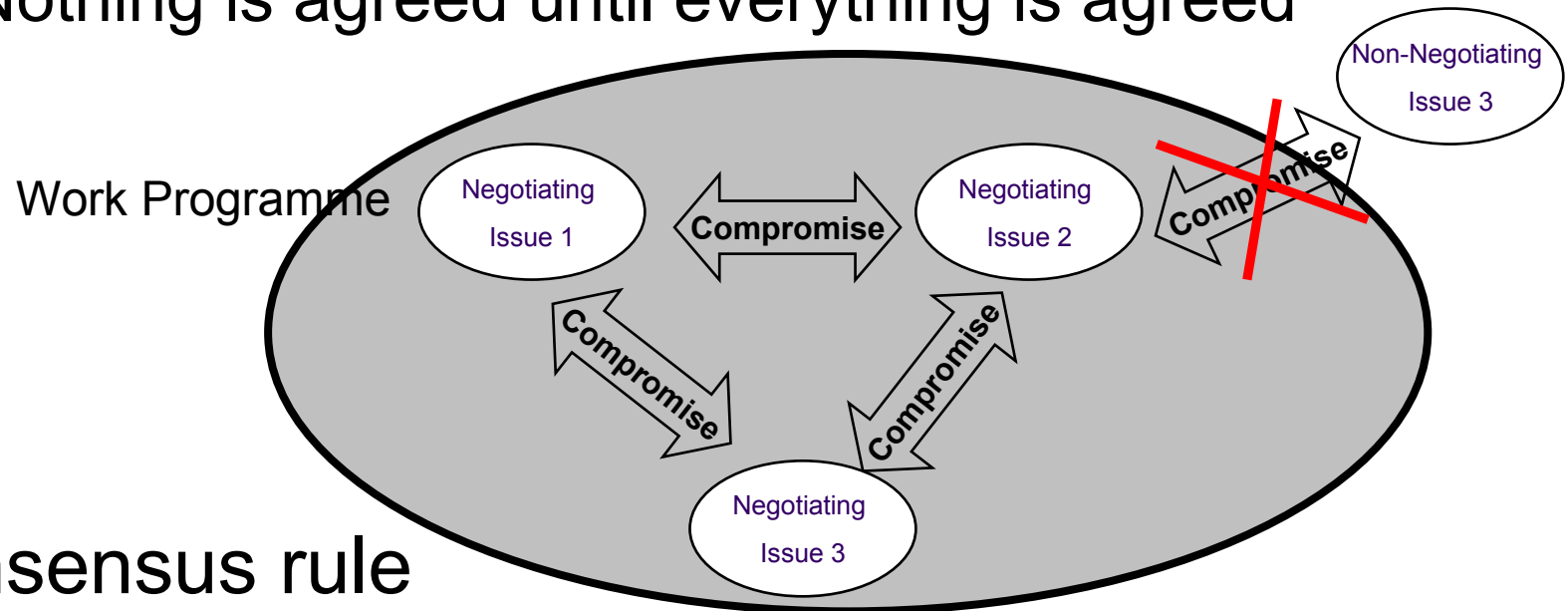
- Transitional periods for developing countries and LDCs
 - Exemption from registration fees
 - Technical/Financial assistance regarding
 - translations
 - participation in and implementation of the system (including notification of GIs)
- Engagement by developing countries from both camps

GI Extension

WTO Negotiation and decision-making



- Single undertaking
 - “Nothing is agreed until everything is agreed”



- Consensus rule
 - Each Member can block consensus

GI Extension: the proposal

= Extension of the higher protection of GIs for wines and spirits to GIs for other products

- What do proponents (GI Friends) want? (TN/C/W/52)
 - Article 23 to apply to all GIs
 - Article 24 exceptions to apply *mutatis mutandis*
 - Multilateral register (of GIs for wines and spirits) to apply to all GIs
 - Part of Single Undertaking
 - Linkage and Parallelism

GI Extension: the actors

TN/C/W/52 – Sponsors

Albania, Brazil, China, Colombia, Croatia, Ecuador, the European Communities, Georgia, Iceland, India, Indonesia, the Kyrgyz Republic, Liechtenstein, Moldova, the Former Yugoslav Republic of Macedonia, Pakistan, Peru, Sri Lanka, Switzerland, Thailand, Turkey, **the ACP Group and the African Group**

Non-Demandeurs:

New Zealand, Australia, United States, Canada, Chile, Argentina, Japan, Chinese Taipei (etc.)

GI Extension: some points made and issues raised



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- Discrimination between product categories legitimate?
 - Systemically
 - Economic impact
- Shift of burden legitimate?
 - Necessity to prevent “genericisation” of terms
 - Burden for legitimate users of
- Impact of GI Extension in third markets?
 - Existing economic interests
 - Impact of bilateral agreements feared by opponents

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Latest Developments

- First textual proposal by GI extension proponents TN/C/W/60 of 15 April 2011
- Proposal to amend TRIPS GI Section
 - Art. 23 protection to apply to all GIs
 - Art. 24 exceptions
- Put forward by Albania, China, Croatia, European Union, Georgia, Guinea, Jamaica, Kenya, Liechtenstein, Madagascar, Sri Lanka, Thailand, Turkey, and Switzerland
- DG Report on implementation issues (TN/C/W/61 of 21 April 2011)

State of Play

- Move from “positions” to “texts”
 - Work on single text since January 2011 has brought Members to focus and engage on the practical aspects of a GI Register
 - Issue of GI Extension has complicated progress in the GI Register negotiations
- Further progress tied to the fate of the wider Doha Round
 - What will be delivered in December 2011?
 - Negotiating mandate on GI Register pre-dates Doha Round

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Consult the website
www.wto.org