

Where to go from there? From INTA's perspective

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I- A challenging context

Why GIs matter so much?

- GIs link products and their origin, and also a unique production method or distinguishing qualities.
- GIs offer opportunities: many countries have understood the importance of GIs to promote their domestic specialties and economy.
- GIs are important:
 - to producers/right owners** as legal IPR/marketing tool,
 - to the society** (as they contribute to local economy and rural development, prevent delocalization and promote a certain culture)
 - to consumers** as they link products and qualities/origin.

Broad Definition of GIs

- Art 22 of TRIPS Agreement provides a very **broad definition**:
“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”.
- The definition covers very diverse things such as:
 - Wine and spirits GIs (Rioja wine, Cava for Sparkling wine),
 - Agricultural products (Manchego cheese)
 - Even non-agricultural products in some countries (Belgium lace, Indian Kashmir Pashmina, French Laguiole knives)...

Different legal approaches

to GI protection have emerged (before and after TRIPS):

- sui generis system dedicated to GIs
- TMs, collective TMs, certification marks
- Enforcement of Unfair competition Law, Consumer Protection Law in some developing countries or some Common Law jurisdictions.

Different levels of protection & recognition

- Different **level of protection** granted to different products (agricultural products less protected than wine and spirits GIs which have absolute protection).
- Also **different recognition** according to the level of connection between the product and their origin.
E.g.: Protected Designation of Origin (PDO) in EU: the product must be produced AND processed within the defined geographic area, exhibiting qualities or characteristics essentially due to that area vs. Protected Geographical Indication (PGI) “The GI where the product must be produced OR processed in the geographical area, or both”.

Position of INTA

- INTA dedicated to the protection of TM and related rights.
- INTA in favor of GI protection. But not to the detriment of TMs. Naturally interested **in conflicts** between prior TMs and later GIs.
- GIs and TMs are not always in conflict. They can also be **complementary** and it is not unusual that a product bear both.
- Promoting the **First in time, first in right principle**.
- Also promoted a multilateral register for wine and spirits as proposed by TRIPS Agreement which would respect this principle.

INTA in Action

- INTA has a **full Committee** dedicated to GIs.
- Exchange with GI associations
- Organization of special **educational events** on GIs.
 - Session on Geo branding at the INTA 2017 AM
 - 2015 Conference in Rome on geographical indicators – including GIs.
- Creation of a “**Geographical Indications International guide**” for our membership listing all the various GI protections per country.
- Observer in the negotiations of the **Geneva Act** of the Lisbon Agreement.

II- What's next ?

At the international level

- Prolonged deadlock on TRIPS
- The Geneva Act of the Lisbon Agreement on Appellations of Origin and Gis:
does not provide an inclusive global system open to all protection systems.

Multiplication of regional and bilateral Agreements

with IPR provisions promoting a certain kind of protection vs. another.

- Minus: prevents a harmonized global approach
- Plus: some countries with multiple trading partners explored ways to adapt to/incorporate different kinds of protection

The Example of China

- After 2001 and 2013 Trademark law revision:
 - art.16 (special clause to protect GIs) +
 - art.10.1.7, 10.1.8 & 10.2 (interdiction of geographic name to register as trademark)
- New judicial interpretation on trademark registration (as of March 1, 2017) with article 17 on GI protection:
 - direct protection on the basis of GIs as such is possible, even for non-identical products
 - extended protection in the form of collective or certification mark on the basis of well-known mark, even for the products not similar, is also possible.

Exemple: Napa valley (an American GI registred in China as certification mark) succesfully opposed the application of registration of Screw Kappa Napa in Beijing IP court.

The example of China

- SPC has replied in 2009 that when a GI is registered as a collective or certification mark, the infringer could be charged with criminal responsibility.
- Customs will forbid the importation and exportation of goods infringing GIs registered as collective or certification marks.

A new balance between TM & GIs in China

- No abuse of GIs, no preemptive registration of GIs as ordinary trademark
- &
- Safeguard of prior TM's owner legitimate rights in the conflict with GIs



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