

INSTITUTIONAL ASPECTS RELATING TO THE ADMINISTRATION OF GEOGRAPHICAL INDICATIONS

How the Registry handles the processing of examination and registration of Geographical Indications. Challenges - Difficulties

INTRODUCTION

Registration of Geographical Indications and Appellations of Origin in Costa Rica began 15 years ago with the promulgation of the Trademarks and Other Distinctive Signs Law No 7978, driven by the importance that involves the recognition of the prestige that embraces certain goods specifically attributed to a provenance or geographical origin. Compared with countries of great importance in terms of intellectual property we are still in our early days but with the intention to continue growing and improving our processes.

INTERNATIONAL AND NATIONAL REGULATIONS

Costa Rica adheres to the following international standards:

1. Trade-Related Aspects of Intellectual Property Rights (TRIPS).
2. Lisbon Agreement for the Protection of Appellations of Origin and their International Registration.
3. International Treaties.

And national standards:

1. Trademarks and Other Distinctive Signs and its regulations.
2. Regulation of Geographical Indications and Appellations of Origin.
3. Procedures for Enforcement of Intellectual Property Rights Law.

APPLICATIONS

Costa Rica receives applications for registration of Geographical Indications and Appellations of Origin through two ways, by national via and by the Lisbon Agreement. By national via the register receives both national applications and international applications that are processed from our country.

The examination of international applications gets the same treatment as national applications, except for two additional requests: the test of recognition and the registration of the sign in the country of origin.

Applications that are coming from the Lisbon Agreement should not be analyzed on the minimum requirements established by law such as name or payment. The examiner searches the database to determine if there is no previous record in order to issue a publication, otherwise he will notify a negative resolution to the applicant, who will have the right to exercise in our country the same administrative and legal tools as a national applicant.

TRADEMARK LAW

Geographical Indications and Appellations of Origin are regulated by Articles 74 to 81 as follows:

1. Art. 74: Applicants.
2. Art. 75: Prohibitions.
3. Art. 76: Application.
4. Art. 77: Registration procedure.
5. Art. 78: Grant of registration.
6. Art. 79: Duration and registry modification.
7. Art. 80: Use rights of the Appellations of Origin or Geographical Indication.
8. Art. 81: Cancellation of registration.

APPLICANTS

Unlike countries such as Mexico and Peru in which the ownership of Geographical Indications and Appellations of Origin lies in the state, in Costa Rica the ownership can be held by:

1. One or more producers, manufacturers or craftsmen.
2. Associations and Cooperatives.
3. Competent Public Authority.

REQUIREMENTS

The application shall include the following requirements:

1. Name, address, applicant's nationality, production or manufacturing establishments.
2. The appellation of origin or geographical indication whose registration is sought.
3. The geographical boundaries of production to which the appellation of origin concerned.
4. The goods for which the appellation of origin is used.
5. Technically based specifications. It is a summary of the essential qualities or characteristics of the products.
6. Use and administration regulations.
7. Fee (\$50).

PROHIBITIONS

Geographical Indications and Appellations of Origin may not be registered if:

1. They didn't fit with law's definitions.

2. They are against to morality or public order or to induce the public to error about the geographical origin, nature, mode of manufacture, characteristics or qualities ...
3. They are the common or generic name of the goods.
4. They are liable to cause confusion with trademarks, geographical indications or appellations of origin, used previously applied for or registered.

PROCEDURE

The procedure for registration resembles the process of registration of trademarks as follows:

1. Presentation of the application.
2. Examination of requirements and prohibitions.
3. Publication.
4. Period for receiving objections.
5. Analysis of technical specifications.
6. Granting or refusal's resolution.
7. Revocation (3 days).
8. Appeal before the Administrative Court (5 days).
9. Judicial via.

COSTA RICAN EXPERIENCE

BACKGROUND

Costa Rica started its work with Geographical Indications and Appellations of Origin as of February 2000 with the publication of the Trademarks and Other

Distinctive Signs Law No. 7978. About fifty applications were received from national coffee companies such as La Meseta, Tarrazú and ICAFE.

The Register proceeded with the examination of applications but analyzing only formal aspects (minimum requirements established by law). The applications were suspended because of the gaps that the Law itself did not contemplate and were considered vital to the examination.

The Regulation of Geographical Indications and Appellation of Origin was published in 2007. It came to fill the gaps that the law had, which includes:

1. Specification: This document will support technically that the good is different due to the geographic environment, including natural and human factors. The document must contain the product, its features, maps demarcating the geographical area, description of the process or production method, description of quality control, and analysis and technical studies that demonstrate the link between the good and the area.
2. Technical Study: The technical criterion which checks whether the provisions of specification is enough to proceed with the registration or not. It is clear that the Register does not have the necessary expertise to carry out such studies; therefore the regulation allows the support of professional, scientific, technological centers, or educational institutes.
3. Use Regulation: Rules that will determine the requirements that producers must meet in order to obtain the authorization of use, rights and obligations, control mechanisms, regulatory board's appointment to ensure compliance with the rules of use and penalties for noncompliance.

With the regulation it was possible to continue the examination of the applications that were filed in 2000. La Meseta Company did not continue with their applications due to bankruptcy; while Tarrazú and ICAFE continued their procedures and provided all the technical documents.

However Costa Rica faced other problems: who will perform the technical studies for the specifications? This issue was well resolved with the norm, but in practice it was not so easy to solve, because the applicant must pay the study and by that time there were no regulations regarding the right person to perform the technical studies or the process to execute them.

In regards to "Bananas of Costa Rica" [currently registered] an agreement with the National University was performed for studying the specifications. With "Café de Costa Rica" [also registered] a free agreement with the Ministry of Agriculture and Livestock was generated [The State collaborates with the State]; while for

Chorotega Ceramics [currently underway] an agreement with the Ministry of Culture specifically with the area of museums was performed.

Basically in the early days, the Industrial Property Registry walked very closely with the national applicant to develop a procedure, fulfill the gaps that the Law and its Regulation have in order to successfully achieve the registration of Geographical Indications and Appellation of Origin.

CHALLENGES AND DIFFICULTIES

Lack of legal framework

Lack of standards is one of the strongest challenges that generated a delay on the registration of the first Geographical Indications and Appellation of Origin. Even though Costa Rica has now a Law and a Regulation which typify GI's and AO'S, the truth is that there are still gaps to fill. Therefore steps have been taken in order to complete the legal framework and make the process more efficient.

Absence of entities that carry out technical studies

During the examination of each request, an agreement or arrangement has been executed with an institution capable to perform specific technical studies. A regulation based on a fair and equitable system, in order to determine which entities will be authorized to do the studies is ongoing. The main goal is to generate a database with the information concerning each institution; so that the request may be forward to them.

The goods do not yet enjoy the recognition or prestige required.

There is a project for Geographical Indication with blackberries in Costa Rica. Most of the blackberries consumption comes from imported blackberries and a small part of it comes from local production. Apparently the project has not been successful yet because the local production lacks the necessary recognition as to qualify for a Geographical Indication.

Limited financial resources

For producers, artisans and even cooperatives or associations, it is extremely onerous to process the specifications, to finance technical studies, or to maintain

the Control Board and control mechanisms. The people involved are local producers, small businesses with a strong limitation in generating financial resources to invest in the development of these requirements. They need to be aware that the price of the goods will increase with Geographical Indications. Customers are willing to pay higher prices in exchange of quality therefore producers will increase their income and will be able to support the expenses for the registration process.

Lack of motivation

This is a consequence of the limited financial resources. Producers lose their interest in management of Geographical Indications as a consequence of lack of incentives from the State and the expenses that involve the procedure itself.

Production's limited economic dimension

Producers, artisans and even cooperatives or associations, cannot meet product demand as to grow internationally.

Geographical Indications and Appellation of Origin's defense and promotion

There are not enough financial resources to maintain registration of the sign and to defend it against possible infringements and also to promote the mark internationally.

COFFEE OF COSTA RICA

BENEFITS:

Major product positioning in the international market. (Product Identification)
Benefit more than 50,000 coffee-growing families in the country.

BANANAS OF COSTA RICA

BENEFIT:

Major product positioning in the international market. (Product Identification)

International certificate was obtained (Lisbon) at very low cost.

August 1, 2011: International Registration No. 900 Banana of Costa Rica.

TURRIALBA CHEESE

BENEFITS:

Economic benefits of hallmark for manufacturers.

Create job opportunities.

Preserve traditional knowledge.

INTERNATIONAL APPLICATIONS PROCESSED AS NATIONAL

TEQUILA

Title: GOVERNMENT OF MEXICO (Regulatory Council TEQUILA a.C.).

Registration Date: November 13, 2009.

Registration number: 196 232.

WHERE ARE WE GOING

Promote the registration of Geographical Indications and Appellation of Origin.

To give lectures and training in regards GI's and AO'S legal framework to stakeholders.

Participate in exhibitions regarding Geographical Indications and Appellation of Origin.

Identify potential goods that accomplish the requirements to be Geographical Indications or Appellation of Origin.

Provide support and guidance to producers of those goods before, during and after the registration process.

Reinforce protection and to managing of Geographical Indications and Appellation of Origin.