Geographical Indications
Its Evolving Contours

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Geographical Indications
Its Evolving Contours

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July 2009
FOREWORD

MVIRDC World Trade Centre is pleased to place before the readers this useful publication on “Geographical Indications: Its Evolving Contours”, which is brought out by our Centre as a monograph in the WTO Study Series.

Geographical Indication (GI) is an indication of a product originating in a territory where the product’s quality, reputation and other characteristics are essentially attributable to its geographical origin. Thus, products which are registered under GIs in a territory are protected as Geographical Indications. A number of International Conventions such as The Paris Convention, The Madrid Agreement, The Lisbon Agreement and more recently the TRIPs Agreement of WTO have addressed this subject. GI is a sub-set of the TRIPs Agreement.

This study presents an overview of the interpretations and evolution of the concept of GIs in the context of the various International Conventions. Reputation of a product is a critical component of geographical Indications under the TRIPs Agreement. The study critically examines the system and practice of protection granted in respect of Geographical Indications in various countries, citing interesting GI cases. The GI approaches in the Indian system is analyzed with reference to the GI case studies in respect of several Indian products. India as a member of WTO has successfully registered as GIs a number of products in sectors such as tea, textiles, carpets, handicrafts, horticultural products, soap and essential oil, paintings, etc. Many more products are in the process of being registered. India has enacted the Geographical Indications of Goods (Registration and Protection) Act 1999. Geographical Indications Registry at Chennai has jurisdiction in India.

The study presents highlights of important GI disputes in the international arena for better appreciation of the specific interests of the concerned parties and the economic impact in the wake of such disputes. The study also discusses the present debate at the WTO in the context of extending higher levels of protection beyond wines and spirits.

I would like to express my sincere appreciation to Dr. Prabudhha Ganguli, an eminent expert on IPRs and author of this study, for his dedicated efforts in conducting this study and for his in depth research in shaping the study. I would also like to acknowledge the support and guidance of the research team of MVIRDC World Trade Centre in finalizing this study.

I am confident the study will serve as an excellent resource material on the subject of GIs and will be of benefit to Government agencies, policy makers and all interested stakeholders.

Y.R.Warerkar
Executive Director
MVIRDC World Trade Centre
Mumbai
Acknowledgements

Compiling this volume has resulted from intense synergistic interactions with several professionals and organizations. The author is immensely grateful to each and every one who has contributed to enrichment and value addition, which made the writing of this book an experience to remember.

The World Trade Centre, Mumbai, India: WTC partially funded the research that made it possible to explore the wide turf of Geographical Indications (GI). WTC’s funding is most gratefully acknowledged.

The study of GI and its present status required extensive library support and the author had the privilege of accessing the rich IPR resource in the Max Planck Institute for Intellectual Property Rights and Taxation in Munich. Professor Strauss of Max Planck Institute provided the library facilities of his institute for the research and discussions and the author thanks him for his hospitality and kindness. Alexander Von Humboldt Stiftung, Germany of which the author is an alumnus, supported the author’s visit to Munich for this research. The foundation has always been a strong supporter of its alumni and the author would like to express his personal gratitude to the foundation for their generosity and thoughtfulness.

I am especially thankful to Mr Pravin Anand contributing the case study on Pochampally Ikat and to Ms Lata Nair for her meticulous reading with constructive comments, which has helped the author during the iterative process of writing this volume.

I have immeasurably gained from interactions with the members of the Geographical Indications Registry in India. Their openness with information and expertise enabled me to appreciate the intricacies of administering the GI process in India. The author wishes to place on record the help received from Mr. L. Ravi, former Controller General of Patents, Designs, Trademarks and Geographical Indications, India and Mr R. Natrajan, Asst. Registrar of the GI Registry in Chennai, India during the research.

My team of researchers included my daughter Ms. Rinki Ganguli and my wife Dr. (Mrs) Suvra Ganguli who spent innumerable hours searching the Internet and sifting through voluminous information scattered in diverse media to distil from for them the essential essence of the subject matter. Without their painstaking work and enabling support it would not have been possible to produce this work. I find it difficult to quantify my gratefulness to them for their openheartedness.

This book in its e- form would not have been possible without the meticulous work by the IIPS team which includes Mrs. Anuradha Maheshwari, Ms Nazima Munshi, Ms. Swetal Patel, Ms. Aditi Kamath and Mr. Vinod Rawal, who not only spent hours editing the work but also formatted the work for uploading this work on the IIPS website.

Dr. Prabuddha Ganguli
Mumbai
18th July’ 2009
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Prabuddha Ganguli is the CEO of “VISION-IPR” offering services in management of Intellectual Property Rights, Information Security and Knowledge Management. He is also Honorary Scientific Consultant for Innovation and IPR matters to the Office of the Principal Scientific Adviser, Government of India and a member of the Advisory Board of the International Intellectual Property Institute, Washington. He is also member of the Advisory Board of the Institute of Intellectual Property Studies, Mumbai and a Senate Member of the National Institute of Fashion Technology, India. He is a member of the Advisory Board of the IPR Journal “World Patent Information”. After obtaining a Ph.D. in Chemistry from the Tata Institute of Fundamental Research, Mumbai, he did postdoctoral research in Germany as an Alexander von Humboldt Foundation Fellow, and worked in industry for over two decades, mainly in R&D, Manufacturing, Corporate Planning and knowledge management.

# TABLE OF CONTENTS

<table>
<thead>
<tr>
<th>Sr. No.</th>
<th>Chapter Heading</th>
<th>Page No.</th>
</tr>
</thead>
<tbody>
<tr>
<td>1.</td>
<td>Introduction</td>
<td>1-3</td>
</tr>
<tr>
<td>2.</td>
<td>The GI Dictionary</td>
<td>4-9</td>
</tr>
<tr>
<td></td>
<td>Certification Marks</td>
<td>4</td>
</tr>
<tr>
<td></td>
<td>Collective marks</td>
<td>5</td>
</tr>
<tr>
<td></td>
<td>Indications of Source</td>
<td>5</td>
</tr>
<tr>
<td></td>
<td>Appellations of Origin</td>
<td>6</td>
</tr>
<tr>
<td></td>
<td>Protected Designations of Origin</td>
<td>6</td>
</tr>
<tr>
<td></td>
<td>Protected Geographical Indications</td>
<td>7</td>
</tr>
<tr>
<td></td>
<td>Traditional Specialty Guaranteed</td>
<td>7</td>
</tr>
<tr>
<td></td>
<td>Geographical Indications</td>
<td>8</td>
</tr>
<tr>
<td>3.</td>
<td>Agreements</td>
<td>10-21</td>
</tr>
<tr>
<td></td>
<td>The Paris Convention</td>
<td>10</td>
</tr>
<tr>
<td></td>
<td>The Madrid Agreement</td>
<td>11</td>
</tr>
<tr>
<td></td>
<td>The Lisbon Agreement</td>
<td>12</td>
</tr>
<tr>
<td></td>
<td>Stresa Convention</td>
<td>15</td>
</tr>
<tr>
<td></td>
<td>TRIPS, Bilateral</td>
<td>16</td>
</tr>
<tr>
<td></td>
<td>Plurilateral Agreements and Free Trade Agreements</td>
<td>20</td>
</tr>
<tr>
<td>4.</td>
<td>Protection of Geographical Indications Systems in Various Countries</td>
<td>22-49</td>
</tr>
<tr>
<td></td>
<td>Thailand</td>
<td>23</td>
</tr>
<tr>
<td></td>
<td>Turkey</td>
<td>24</td>
</tr>
<tr>
<td></td>
<td>Singapore</td>
<td>24</td>
</tr>
<tr>
<td></td>
<td>Sri Lanka</td>
<td>25</td>
</tr>
<tr>
<td></td>
<td>Switzerland</td>
<td>26</td>
</tr>
<tr>
<td></td>
<td>China</td>
<td>27</td>
</tr>
<tr>
<td></td>
<td>Chile</td>
<td>28</td>
</tr>
<tr>
<td></td>
<td>Mexico</td>
<td>29</td>
</tr>
<tr>
<td></td>
<td>Argentina</td>
<td>30</td>
</tr>
<tr>
<td></td>
<td>Brazil</td>
<td>31</td>
</tr>
<tr>
<td></td>
<td>Vietnam</td>
<td>32</td>
</tr>
<tr>
<td></td>
<td>Malaysia</td>
<td>33</td>
</tr>
<tr>
<td></td>
<td>Peru</td>
<td>35</td>
</tr>
<tr>
<td></td>
<td>United States of America</td>
<td>36</td>
</tr>
<tr>
<td></td>
<td>Australia</td>
<td>39</td>
</tr>
<tr>
<td></td>
<td>European Union</td>
<td>43</td>
</tr>
<tr>
<td></td>
<td>Enforcing GIs in Europe</td>
<td>48</td>
</tr>
<tr>
<td>5.</td>
<td>GI in India</td>
<td>50-58</td>
</tr>
<tr>
<td>6.</td>
<td>Case Studies</td>
<td>59-74</td>
</tr>
<tr>
<td></td>
<td>Pochampally Ikat,</td>
<td>59</td>
</tr>
<tr>
<td></td>
<td>Cuban Cigars</td>
<td>60</td>
</tr>
<tr>
<td></td>
<td>Feta Cheese</td>
<td>61</td>
</tr>
<tr>
<td></td>
<td>Parma Ham</td>
<td>63</td>
</tr>
<tr>
<td></td>
<td>Spanish Champagne</td>
<td>66</td>
</tr>
<tr>
<td></td>
<td>Scotch Whisky</td>
<td>66</td>
</tr>
<tr>
<td></td>
<td>Darjeeling Tea</td>
<td>69</td>
</tr>
<tr>
<td></td>
<td>Melton Mowbray Pork Pie</td>
<td>73</td>
</tr>
<tr>
<td>7.</td>
<td>Knotty Unresolved Issues and the Current Debate</td>
<td>75-78</td>
</tr>
<tr>
<td>8.</td>
<td>Annexe I: GI Application No.44, Kondapalli Bommalu</td>
<td>79-82</td>
</tr>
<tr>
<td>9.</td>
<td>Bibliography</td>
<td>83-87</td>
</tr>
</tbody>
</table>
CHAPTER 1
INTRODUCTION

Winds of liberalisation blowing across the globe have catalysed fierce debates on seemingly obvious issues such as frameworks for enhanced transborder market access, reduced tariffs, creation of balanced protective shells for indigenous enterprises, maximising exploitation of global human, natural and infrastructural resources, conservation of biodiversity, with the hope that the world of the future will be more prosperous offering a quality of life better ever than before. The race to capture markets makes it imperative to continually innovate and creatively polarise the consumer favourably towards one’s products and services. Businesses therefore invest in efforts to etch in the minds of their consumers or customers identifiers of product or service recall by way of Brand / Goodwill building.

Consumer perception of products / services gets influenced by a combination of wide range factors such as quality, continued trust on the maker of the products or provider of the services, “value for money”, traditional processing in specific geographical regions even if it means purchasing them at a premium so long as their authenticity is ensured, etc.

Distinctive markers that facilitate differentiation of products / services, by way of distinctive names, signs, logos, slogans, shapes & ornamentation of products, etc that associate the products / processes / services with their origin in the market place gain significance in the framework for healthy competition.

It is in this context that the use of judicious combinations of Intellectual Property Rights (IPR) tools comprising Patents, Trademarks, Copyright and Design Registrations, Geographical Indications, help to effectively protect the interest of the producers and consumers alike. [Table 1]

One must appreciate that a trademark / service mark is generally used to create the association between a product / service and its source (or producer / service provider). In certain countries, geographical indications are protected through certification trademark or collective trademark regimes. In fact, there is a debate as to the adequacy of these regimes to protect GIs since the former can be avoided using the fair use exception provisions and the latter is not adequate in protecting the rights in a GI. Besides, both these systems are not uniform all over the world. These aspects will be discussed in a later chapter.

There is a plethora of examples wherein distinctiveness in terms of quality, characteristics and reputation of products are linked to specific geographical location or region and get to be known and / or identified by the name of the geographic location or region. Such geographic names / locations (Geographical indications (GI)) associated with the products / services create value and also attract premium from consumers. GIs are owned by an association of persons or producers, or an organization or authority representing the interest of the producers of the concerned goods / services in the specified region. The application for GI registration is to be made to the designated national authority under the law of geographical indication of that country.

There is little doubt that protection through GIs can support significant increases in value-addition through premium pricing. In this context, enterprises in some developing countries may be able to profit by using GIs in national and international markets.

It should be understood that even if a product is protected as a Geographical Indication, it does not prevent any one from producing it anywhere. The only restriction is that the product cannot be marketed using the name that has been registered as a GI. The name can be used only by authorized users of the GI for their product or service.

In Europe 84% of geographical indications are attributable to four product categories: wines (61.4%), spirits (9.5%), agricultural products (6.7%) and cheese (6.5%). There are around 4,200 registered GIs for wines and spirits and more than 640 GIs for other food products. France has a total of 593 GIs registered under the general EC rules, for wines and spirits and for foodstuffs, generating €19 billion for 138,000 agricultural enterprises. Likewise, Italy’s 420 GIs generate a value of €12 billion and give employment to more than 300,000 Italians. In Spain, 123 GI products generate some €3.5 billion.1

1 [Geographical Indications and the challenges for ACP countries; A discussion paper; O’Connor and Company; http://agritrade.cta.int/]

http://agritrade.cta.int/
### IPR COVERED IN THE TRIPS AGREEMENT

#### Table 1

<table>
<thead>
<tr>
<th>Type of Protection</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>Patents</td>
<td>Protect inventions that are novel, non-obvious and industrially useful.</td>
</tr>
<tr>
<td>Trademark and Service Mark</td>
<td>Protect distinctive marks such as words/signs including personal names, letters, numerals, figurative elements (logos), visually perceptible 2D or 3D shapes or their combinations, capable of distinguishing the goods or services in connection with which it is used in course of trade. In some countries, sounds and distinctive smells can also be registered as trademarks. They can be perpetually renewed from time to time.</td>
</tr>
<tr>
<td>Industrial Design Registration</td>
<td>Protect novel, non-functional features of shape, configuration, pattern, ornamentation or composition of lines or colors, applied to any article either in two or three dimensional or in both forms by any industrial process or means, whether manual, mechanical or chemical, separate or combined which, in the finished article appeal to and are judged solely by the eye.</td>
</tr>
<tr>
<td>Copyright</td>
<td>Protects original expressions of literary, musical, artistic and dramatic works as well as cinematograph films and sound recordings.</td>
</tr>
<tr>
<td>Layout Designs for Integrated Circuits</td>
<td>Scope of protection not only includes the protected chip but also the articles incorporating it.</td>
</tr>
<tr>
<td>Geographical Indications (GI)</td>
<td>“... 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.”</td>
</tr>
<tr>
<td>Trade Secrets and Undisclosed Information</td>
<td>Protection to persons/institutions on information lawfully under their control, to prevent the latter from being disclosed to, acquired by or used by others without their consent in a manner contrary to commercial practices, so long as the information is secret and has commercial value because it is a secret.</td>
</tr>
<tr>
<td>Anti Competitive Practices in Contractual Licenses</td>
<td>Protection against incorporation of restrictive clauses in licensing deals such as exclusive grant back conditions, conditions preventing challenges to validity and coercive package licensing, etc. that may have an adverse impact on trade and impede the transfer of technology.</td>
</tr>
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A Preliminary Database of Worldwide Geographic Indications (not including wines and most spirits) has been listed in [http://www.american.edu/ted/giant/global_analysis.doc](http://www.american.edu/ted/giant/global_analysis.doc). Of the 800 cases it is interesting to note that over 600 alone come from countries in the European Union.

Several studies relating to the economic fall out of GIs have been reported in the last decade.\(^2\) A few examples will illustrate the economic relevance of GIs:

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\(^2\) [Carsten Fink and Keith Maskus](http://siteresources.worldbank.org/INTRANETTRADE/..../16.TheDebate.pdf) One of the most recent references in this field is the final report titled “Assessing the Applicability of Geographical Indications as a Means to Improve Environmental Quality in Affected Ecosystems and the Competitiveness of Agricultural Products; by Mariano Riccheri, (Universidad de Alicante), Benjamin Görlich, (Ecologic), Stephanie Schlegel (Ecologic), Helen Keefe (Universidad de Alicante), Anna Leipprand (Ecologic), with the
♦ Certain regional designations for Bordeaux wines command a large price premium—as much as $15 per bottle in the case of the “Pomerol” designation (Landon and Smith 1998). 3
♦ Wines with a “Napa Valley” designation were priced 61 percent higher than wines with a “California” designation (Bombrun and Sumner 2003). 4
♦ Two Italian surveys carried out to determine purchasing habits regarding two types of products sold under a GI label (“Parmigiano-Reggiano” cheese and “Parma” ham) showed that about 70% of the consumers predominantly look for the GI label when purchasing these products and they do so two to three times as much as they look for a trademark.
♦ A 1999 EU consumer survey showed that 40% of consumers are willing to pay about 10% more for a product sold under a GI label than for a generic product. 5
♦ French GI cheeses are sold at a premium of 2 euro. Italian “Toscano” oil is sold at a premium of 20% since it has been registered as a GI in 1998. Many of these products, whose names are protected, are exported. 85% of French wine exports use GIs. 80% of EU exported spirits use GIs. Jamao coffee from the Dominican Republic has seen its price/lb rise from US$ 67 to US$ 107 since it has been registered as a GI. GIs are the lifeline for 138000 farms in France and 300000 Italian employees. 6
♦ “Jamaican Blue Mountain” coffee is known to sell at a premium of $14.50 per kg; French chicken “Poulet de Bresse” has a market price four times higher than regular French chicken.
♦ Compté cheese production has increased at a rate of 3% per year in the last 10 years, whereas the local production of Emmental cheese (not protected as a GI) has dropped. This steady increase in demand and production has created new employment and limited rural exodus from the region. Further the economic Benefits have spilled over to milk farms in the Compté region, resulting in the reduction in the volatility of milk prices, and a positive impact on tourism and the local food and hotel sectors.
♦ In the Spanish market, meat products bearing the “Galician Veal” label commanded a premium of $0.21 per kilogram (Loureiro and McCluskey 2000). 7
♦ A recent survey carried out in Spain by the producers of the nougats known as Turron de Jijona and Turron de Alicante shows that more than 50% of those interviewed were aware that the Turron de Jijona (which is a geographical indication) is more expensive than the generic Turron. Yet a striking 76% of the same consumer sample considered that Turron de Jijona represents a better price-quality relationship. More than 80% of EU spirits and 60% of French wines exported bear a GI. 8

Proponents of a stronger GI system include, Bulgaria, the European Union, Kenya, India, Sri Lanka, Switzerland, and Thailand, where as Argentina, Australia, Canada, Chile, Costa Rica, Guatemala, Japan, Namibia, Taiwan (China), and the United States have been comparatively less supportive of such a system.

This has been and continues to be a subject of intense unresolved debate at the WTO; and the future rounds of negotiations at the WTO are expected to address the knotty unresolved issues.
CHAPTER 2
THE GI DICTIONARY

International trade in the current era of globalization has undergone several changes and several attempts have been made to harmonize the different approaches and standards that governments of various countries around the world have been using to register GIs. Several concepts that can be traced in the evolution and conceptualization of "geographical indications" exist today. There happen to be three levels of definitions namely: Indications of Source, Appellations of Origin and geographical indications.

"Indication of source" and "appellation of origin" were incorporated earlier in the Paris Convention for the Protection of Industrial Property of 1883, the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods of 1891, and the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of 1958.

However, as trademark tools are used for the protection of geographical indications today, it would be appropriate to familiarize oneself with some of the frequently used terms in the file of marking of products and services. "Collective Marks" and “Certification Marks” have been of considerable importance in the marking of products, and in some countries they are considered to be an alternate system for GI.

“Certification marks”

“Certification marks" aim at guaranteeing certain characteristics or quality of products, and may be used by any person (even if not a part of a particular group or association) that complies with specified standards. The use of a certification mark is subject to the authorization of its owner, who does not trade with the mark himself, but ensures that the authorized users comply with the relevant standards. The verification by the owner of a certification mark, speaks of compliance with certain specified standards. A certification mark certifies that the goods conform to standards laid down and enforced by the proprietor of the mark. It is any word, name, symbol, or device used by a party or parties other than the owner of the mark to certify some aspect of the third parties' goods/services. There are three types of certification marks, which are used to indicate:
1) Regional or other origin;
2) Material, mode of manufacture, quality, accuracy or other characteristics of the goods/services; or
3) That the work or labor on the goods/services was performed by a member of a union or other organization.

The same mark can be used to certify more than one characteristic of the goods/services in more than one certification category: the mark ‘ROQUEFORT’ (U.S. Registration No. 571,798) is used to indicate that the cheese has been manufactured from sheep's milk and cured in the caves of the Community of Roquefort (France) in accordance with their long established methods and processes. In some countries, in the USA for example, if a certification mark consists solely or essentially of a geographical term, the authority that normally exercises control over its use, is a governmental body or a body operating under governmental authorization. Examples of registered certification marks in the USA include “Idaho”, “Real California Cheese”, “Napa Valley Reserve”, “Pride of New York”, “Ohio River Valley”, and DARJEELING which is a certification trademark in the US. Such registrations must be accompanied by the criteria that need to be met to use the certification, usually submitted as the regulations governing the certification mark.

Certification Marks are given by organizations that do not trade themselves, but certify that goods or services satisfy prescribed standards concerning origin, material, and mode of manufacture, quality, accuracy and other characteristics. For example, in India "Agmark" is a certification mark used for food items including spices, milk products, ISI is a mark given by the Bureau of Indian Standards, etc. It may be noted that India has recently established a "silk mark" to certify genuineness of silk textiles in India and Darjeeling,
a certification mark for a specific type of Tea produced in Darjeeling and can be marketed, provided the product satisfies the set quality standards. Similarly, WOOLMARK certifies that the goods on which it is used are made of 100% wool and LABEL ROUGE used for high quality agricultural products in France.

"Collective marks"

A collective trademark or collective service mark is a mark adopted by a ‘collective’ (i.e., an association, union, cooperative, fraternal organization, or other organized collective group) for use only by its members, who in turn use the mark to identify their goods or services and distinguish them from those of non-members. The ‘collective’ itself neither sells goods nor performs services under a collective trademark or collective service mark, but the collective may advertise or otherwise promote the goods or services sold or rendered by its members under the mark. Thus, the members may use the collective mark to distinguish the geographical origin or other common characteristics of certain products. These marks are principally designed to guarantee certain product characteristics (quality, nature or origin) for consumers. The submission of regulations for the use of the mark is normally required for the acquisition of a collective mark. A well-known example of a collective mark is INTERFLORA, which is used worldwide by a flower ordering service.

“Indications of Source”

“Indications of Source” is a very broad concept and are usually labels such as ‘Made in India’ or ‘Product of Maharashtra.’ It is generally understood that an indication of source is contingent only on the product’s geographical origin and not necessarily its inherent quality. The use of an indication of source is merely subject to the condition that a given product originates in the place designated by the indication of source. An indication of source can be defined:

"... as an indication referring to a country or to a place situated therein as being the country or place of origin of a product.”

The definition above does not specify any requirements concerning certain qualities, reputation, natural or human conditions or other characteristics of the product associated with its geographical origin. Three key elements constitute the notion:

(a) there is a clear link between the indication and geographical origin (e.g. ‘made in …’) rather than any other criterion of origin (e.g. ‘product of …’);
(b) unlike other IGOs, there is no requirement for distinguishing qualities or attributes of the good;
(c) the protected indication can be constituted by words or phrases that directly indicate geographical origin or phrases, symbols or iconic emblems associated with the area of geographical origin.

The term ‘indications of source’ is used in the Paris Convention and the Madrid Agreement. Article 1(2) of the Paris Convention enumerates among the objects of the protection of industrial property, indications of source and appellations of origin. More specific provisions concerning indications of source are contained in Article 10 of the same treaty. Article 10 of the Paris Convention, dealing with false indications of goods, states that its provisions concerning goods unlawfully bearing a trademark and their seizure:

"... shall apply in cases of direct or indirect use of a false indication of the source of the goods or the identity of the producer, manufacturer, or merchant."

Paragraph 2 of the same provision states that:

"(A)nny producer, manufacturer, or merchant, whether a natural person or a legal entity, engaged in the production or manufacture of or trade in such good and established either in the locality falsely indicated as

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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."

"Appellations of Origin"

Appellations of Origin, is a much narrower concept than 'indication of source'. As per the Paris Convention, 'appellation of origin' conveys not only the geographical source of the product, but makes a direct link between the product's quality and its geographical origin. The Lisbon Agreement elaborates further, stating that the geographical name designates a product, whose quality and characteristics are exclusively or essentially related to the geographical environment, including natural or human factors. Appellations of Origin must contain the name of a country, region or locality. Hence a narrower range of products is eligible for this classification. The term "appellation of origin" is defined in Article 2 of the Lisbon Agreement as:

"... the geographical name of a country, region, locality, which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors."

The denomination must therefore have an absolute correlation to a geographical name, which in turn, must serve to designate a particular product. This expression does not include the use of symbols or any other kinds of expression; rather it implies that the product name should be identical to the geographical name. For example, Bordeaux, Cuban, Porto, etc

The Lisbon Agreement sets forth two basic requirements for the protection of Appellations of Origin:

1) the Appellation must be protected in the home market
2) it must be registered with the World Intellectual Property Organization (WIPO)

The registration of the Appellation under WIPO prevents it becoming a generic name, as long as the product remains under protection in its home market. This protection covers usurpation or imitation, even if the true origin of the product is indicated or is accompanied by a term, such as 'kind,' 'type,' 'make,' 'imitation' or 'style.'

Appellation of origin is therefore a special kind of geographical indication, which signifies products with a specific quality that can be related exclusively or essentially due to the geographical environment such as climate, soil in which the products are produced, or produced using traditional methods of production or the like. Of the products covered, 84% are wines, spirits, cheese, tobacco and cigarettes, with 70% accounting for wines and spirits alone.

PDO, PGI and TSG are terminologies generally used in Europe to protect GIs ([Regulation (EEC) No 2081/92] and [Regulation (EEC) No 2082/92]).

Protected Designations of Origin (PDO)

A Protected Designation of Origin has been defined so as to imply a specific place by way of the name of the region being used to describe an agricultural product or foodstuff that:

a) it originates in that region,
b) it derives its quality or characteristics essentially or exclusively from this geographical environment with its inherent natural and human factors, and
c) the production, processing and preparation of which takes place in that defined geographical area.

An example of this is Parmigiano Reggiano which must be made from cow's milk from a particular region in Italy (Provinces of Parma, Reggio-Emilia and Modena, and a few neighboring areas), and be made there as
well, in order to carry the PDO label. Another example is Traditional Balsamic Vinegar of Modena (Aceto Balsamico Tradizionale di Modena), which must be made from grapes in Modena, fermented and matured a minimum of 12 years there (25 years to qualify as “extravecchio”), and bottled into 100-mL bottles in order to receive the label.

Protected Geographical Indication (PGI)

A Protected Geographical Indication (PGI) has been defined as to imply the specific place or a country by the name of the region, which is used to describe an agricultural product or a foodstuff that
a) it originates in that region, and
b) it possesses a specific quality, reputation or other characteristics which would be attributable to that geographical origin, and
c) the production and/or processing and/or preparation of which takes place in that defined geographical area.

Thus, designations of origin require a more intensive connection between quality and provenance, while geographical indications do not necessarily have to derive their qualities from the soil as such.

For example, Black Forest Ham (Schwarzwälder Schinken) is a product that can be found bearing the PGI label, only if it is produced in the Black Forest region of Germany using traditional recipes and finished by smoking over pine wood chips from the fir trees of that region. Similarly, the containers of Protected Geographical Indication Tuscan extra-virgin olive oil flaunt a clear mark, showing the name of the Safeguard Consortium, the capacity of the bottle, the name of the Inspection Board (which is in charge of certifying its Tuscan origins) and lastly the progressive ID number, which is the real key to its Origin.

Traditional Specialty Guaranteed (TSG)

TSG labels certify that the product has been made with a long-standing traditional method but is not linked to any specific geography. They should be produced either from traditional materials or produced using traditional techniques. Serrano Ham is a product that used to be made only in the mountains of Spain, but is now made throughout Spain (and possibly the rest of the world) in artificially controlled environments designed to replicate the conditions found in the mountains. The ham produced only within Spain and following traditional curing techniques is eligible for the TSG label. Similarly, Boerenkaas, the traditional Dutch Farmhouse Cheese has been granted a TSG label in the EU which now includes cheese made from raw cow, goat, sheep and buffalo milk using authentic traditional production techniques.

"Geographical Indications"

The concept of "geographical indication" is relatively new and was first introduced by WIPO during the discussions of a treaty for the international protection of names and symbols, which indicate a certain geographical origin of a given product. \(^{12}\) The term was intended to include both concepts, indication of source and appellation of origin and also symbols. \(^{13}\)

"... because geographical indications are not only constituted by names such as the name of a town, a region or a country ('direct geographical indications'), but may also consist of symbols."\(^{14}\)

The most recent definition of geographical indication can be found in Article 22.1 of the TRIPS Agreement, which refers to 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."

The definition of the TRIPS Agreement differs in a number of ways from the term "appellations of origin" contained in the Lisbon Agreement: \(^{15}\) The TRIPS Agreement allows GI’s on goods where a given quality, reputation or ‘other characteristic’ of the good is attributable to its geographical origin. The Agreement does not differentiate between agricultural and industrial goods, or between handicrafts and manufactured goods, but the definition does not apply to services.

As noted earlier in this chapter, “indication of source” in its broadest interpretation does not require the designated product quality, reputation or characteristic linked to its origin, but it in a way covers both Appellations of Origin and geographical indications. The term geographical indication identifies the product as originating in a particular place, where quality, reputation or other characteristics are attributable to their geographical origin. Since those qualities depend on the place of production, a specific "link" exists between the products and their original place of production. GI could be a symbol as an expression to identify the product as originating in a territory, region or locality, where a given quality, or reputation or other characteristic of the product is essentially attributable to its geographical origin. Examples of such symbols are the French flag or the Chilean flag associated with qualified wines produced in France or Chile respectively. Protection of Geographical indications is essential as consumers generally associate a geographical indication with its origin and quality and are prepared to pay a price for this genuineness. Any misrepresentation of the GI would be detrimental to the interest of the consumers and the producers alike.

Appellation of Origin on the other hand is specific and must necessarily correspond to the name of a country, region or locality. Though all Appellations of Origin can be considered as geographical indications but not every geographical indication is necessarily an Appellation of Origin.

All appellations of origin are also geographical indications, but not all geographical indications are -- at the same time -- appellations of origin. In summary GIs must meet three essential conditions namely

(a) the indication must necessarily identify a good and can be non-geographical names, iconic symbols, words or phrases,

(b) the good must necessarily possess ‘given quality’, or ‘reputation’ or ‘other characteristics’ that are ‘essentially attributed’ to the designated geographical area of origin; and

(c) the designated geographical area must be identified by the indication.

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\(^{12}\) This concept has also been adopted by the European Communities in the Council Regulation Nr. 2081/92, on the protection of geographical indications and designations of origin for agricultural products and foodstuffs.

\(^{13}\) Ludwig Baumer, "Various Forms of Protection of Geographical Indications and Possible Consequences for an International Treaty", included in the Symposium of the International Protection for Geographical Indications, Funchal, Portugal, 1993, WIPO publication, p.32.


Comparison between appellations of origin and geographical indication

<table>
<thead>
<tr>
<th>Appellation of origin (AO), according to the definition of the Lisbon Agreement</th>
<th>Geographical indication (GI), according to the definition of the TRIPS Agreement</th>
</tr>
</thead>
<tbody>
<tr>
<td>AOs are necessarily geographical names of a country, region or locality, such as Tequila, Porto, Sherry that comes from the Jerez.</td>
<td>indication identifying a region or locality in the territory of a member country and certain quality, characteristic or reputation essentially attributable to such region or locality.</td>
</tr>
<tr>
<td>AO designates a product. The product's name is the same as the AO. For instance, &quot;Champagne&quot;, &quot;Bordeaux&quot;, Darjeeling, etc.</td>
<td>GI identifies a good. That means that a GI could be any expression -not necessarily the name of the place where the product originated - that could serve the purpose of identifying a given geographical place. For instance the French flag for identifying wines of certain quality or reputation or just the name of the place identifying the product such as &quot;jambon de Parma.&quot;</td>
</tr>
<tr>
<td>AOs insist that the quality and characteristic of the good should be exclusively and essentially attributable to its geographical location</td>
<td>GI considers the geographical environment where the product comes from, including natural (soil, climate, etc.) and human factors. GI also refers to the reputation of the product.</td>
</tr>
<tr>
<td>AO considers the geographical environment where the product comes from, including natural (soil, climate, etc.) and human factors.</td>
<td>GI can be depicted through symbols. For instance the Darjeeling logo or the Café de Colombia logo</td>
</tr>
<tr>
<td>AO covers only geographical names.</td>
<td></td>
</tr>
</tbody>
</table>

CHAPTER 3
AGREEMENTS

There are several agreements concerning the international protection of geographical indications. The following is a summary of the scope of protection that is provided for geographical indications under the following multilateral treaties: Paris Convention of 1883, the Madrid Agreement on Indications of Source (1891), the Stresa Convention of 1951, the Lisbon Agreement (1958), and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement of 1994).

THE PARIS CONVENTION

The Paris Convention was the first multilateral agreement signed in 1883 and was revised several times, in Brussels (1900), Washington (1911), The Hague (1925), London (1934), Lisbon (1958), and Stockholm (1967), and amended in 1979. As of October 2007, the convention has 171 signatory states. A provision prohibiting the use of a false indication of source appeared in the original text of the Paris Convention of 1883. Article 1(2) of the Paris Convention includes some indications of source and appellations of origin as subject matter of industrial property protection.

The definition of ‘Industrial property’ in Article 1(3) of the Paris Convention includes “all manufactured or natural products, for example, wine, grain, tobacco leaf, fruit, cattle, minerals, mineral waters, beer, flowers, and flour.”

Article 2(1): the convention applies to the widest range of industrial property, including “indications of source and appellations of origin and the repression of unfair competition.”

Article 9 provides the remedies available in the event of importation, etc., of goods unlawfully bearing a mark or trade name.

Article 10 is titled “False Indications: Seizure, on importation, etc., of goods bearing false indications as to their source or the identity of the producer.” This article does not explicitly refer to appellations of origin. However conceptually all appellations of origin may be interpreted to constitute an indication of source.

According to Article 10(2) of the Paris Convention, 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 affords 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.

It should be noted that Articles 9(5) and 9(6) of the Paris Convention lay down conditions for countries party to the Paris Convention but whose national laws do not permit seizure on importation or inside the country to replace those remedies by either a prohibition of importation or by any other nationally available remedy. Furthermore, Article 10ter(2) contains an undertaking of the States party to the Paris Convention to allow federations and associations representing producers and trade circles to bring actions in order to enforce the means of protection envisaged in Articles 9 and 10.

16 [http://www.iprhelpdesk.org]
17 [http://wipo.int/treaties/en/p/paris/trtdocs_wo020.html#P210_34746]
Article 11bis of the Paris Convention obliges members to provide protection against unfair competition and contains a non-exhaustive list of acts, which are to be prohibited. This provision gives the basis for the protection against misleading indications of source, including appellations of origin. The Paris Convention does not provide for any remedies in case of infringement of this provision. However, it may be noted that the protection was rather limited, since the prohibition was only applicable where the false indication of source was used in conjunction with a fictitious or non-existing trade name.

THE MADRID AGREEMENT

The original text of the Paris Convention of 1883 did not provide for the prevention of the use of false indications per se, but only where such use occurred in connection with the use of a false trade name. The next step in enhancing the protection of indications of source was the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods (“Madrid Agreement on Indications of Source”) 18. The Madrid Agreement was adopted in 1891 and revised in Washington (1911), The Hague (1925), London (1934), and Lisbon (1958), which was supplemented by the Additional Act of Stockholm (1967). As of October 2007, the Madrid Agreement for Indication of source has 35 contracting parties. The Madrid Agreement on Indications of Source not only prevents the use of “false” indications of source, but also prohibits the use of indications of source that are “deceptive,” i.e., literally true but nevertheless misleading. A few of the relevant articles of the Agreement are reproduced below:

Article 1

(1) All goods bearing a false or deceptive indication by which one of the countries to which this Agreement applies, or a place situated therein, is directly or indirectly indicated as being the country or place of origin, shall be seized on importation into any of the said countries.

(2) Seizure shall also be effected in the country where the false or deceptive indication of source has been applied, or into which the goods bearing the false or deceptive indication have been imported.

(3) If the laws of a country do not permit seizure upon importation, such seizure shall be replaced by prohibition of importation.

(4) If the laws of a country permit neither seizure upon importation nor prohibition of importation nor seizure within the country, then, until such time as the laws are modified accordingly, those measures shall be replaced by the actions and remedies available in such cases to nationals under the laws of such country.

(5) In the absence of any special sanctions ensuring the repression of false or deceptive indications of source, the sanctions provided by the corresponding provisions of the laws relating to marks or trade names shall be applicable.

Article 2

(1) Seizure shall take place at the instance of the customs authorities, who shall immediately inform the interested party, whether an individual person or a legal entity, in order that such party may, if he so desires, take appropriate steps in connection with the seizure effected as a conservatory measure. However, the public prosecutor or any other competent authority may demand seizure either at the request of the injured party or ex officio; the procedure shall then follow its normal course.

(2) The authorities shall not be bound to effect seizure in the case of transit

Article 3

These provisions shall not prevent the vendor from indicating his name or address upon goods coming from a country other than that in which the sale takes place; but in such case the address or the name must be accompanied by an exact indication in clear characters of the country or place of manufacture or production, or by some other indication sufficient to avoid any error as to the true source of the wares.

Article 3bis

The countries to which this Agreement applies also undertake to prohibit the use, in connection with the sale or display or offering for sale of any goods, of all indications in the nature of publicity capable of deceiving the public as to the source of the goods, and appearing on signs, advertisements, invoices, wine lists, business letters or papers, or any other commercial communication.

Article 4

The courts of each country shall decide what appellations, on account of their generic character, do not fall within the provisions of this Agreement, regional appellations concerning the source of products of the vine being, however, excluded from the reservation specified by this Article.

Articles 1 and 2 of the Agreement specify the cases and the manner in which seizure or similar measures may be requested and carried out. There however, exists no provision which allows private parties to directly request such measures. States parties to the Agreement may provide that such parties apply through a public prosecutor or any other competent authority.

Article 3bis obliges the States party to the Madrid Agreement to prohibit the use, in connection with the sale or display or offering for sale of any goods, of all indications capable of deceiving the public as to the source of the goods.

Article 4 of the Madrid Agreement on Indications of Source contains a special provision for “regional appellations concerning the source of products of the vine” which constitutes an exception to the rule that, in application of the Agreement, the courts are free to decide whether or not a given indication of source is a generic term.

Nonetheless, 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. Finally under an international registration system for trademarks, such as the Madrid Agreement Concerning the International Registration of Marks of 1981, (also known as the Madrid Agreement), and the Protocol relating to the Madrid Agreement Concerning the International Registration of Marks of 1989, it was possible to protect geographical indications as collective marks, certification marks or guarantee marks.

THE LISBON AGREEMENT AND THE PROTECTION OF APPELLATIONS OF ORIGIN

This Agreement was concluded in Lisbon on 31 October 1958. It was revised in Stockholm in 1967 and amended in 1979. Any member of the Paris Convention may accede to the treaty. This agreement offers the strongest protection for GIs. As of October 2007, 26 states are party to the Agreement. The Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration was a result of the Lisbon Diplomatic Conference of 1958, in which an attempt was made to improve the international protection for geographical indications beyond the framework of the Paris Convention and the Madrid Agreement on Indications of Source. The scope of protection for internationally registered appellations of origin is broader than the protection for indications of source under the Paris Convention and the Madrid Agreement on Indications of Source. The relevant articles of the Lisbon Agreement for the purposes of this chapter are

Article 1: Establishment of a Special Union; Protection of Appellations of Origin Registered at the International Bureau

(1) The countries to which this Agreement applies constitute a Special Union within the framework of the Union for the Protection of Industrial Property.
(2) They undertake to protect on their territories, in accordance with the terms of this Agreement, the appellations of origin of products of the other countries of the Special Union, recognized and protected as such in the country of origin and registered at the International Bureau of Intellectual Property (hereinafter designated as "the International Bureau" or "the Bureau") referred to in the Convention establishing the World Intellectual Property Organization (hereinafter designated as "the Organization").

**Article 2: Definition of Notions of Appellation of Origin and Country of Origin**

(1) In this Agreement, "appellation of origin" means the geographical name of a country, region, or locality, which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors.

(2) The country of origin is the country whose name or the country in which is situated the region or locality whose name constitutes the appellation of origin which has given the product its reputation.

**Article 3: Content of Protection**

Protection shall be ensured against any usurpation or imitation, even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as "kind," "type," "make," "imitation," or the like.

**Article 4: Protection by virtue of Other Texts**

The provisions of this Agreement shall in no way exclude the protection already granted to appellations of origin in each of the countries of the Special Union by virtue of other international instruments, such as the Paris Convention of March 20, 1883, for the Protection of Industrial Property and its subsequent revisions, and the Madrid Agreement of April 14, 1891, for the Repression of False or Deceptive Indications of Source on Goods and its subsequent revisions, or by virtue of national legislation or court decisions.

**Article 5: International Registrations; Refusal and Opposition to Refusal; Notifications; Use Tolerated for a Fixed Period**

(1) The registration of appellations of origin shall be effected at the International Bureau, at the request of the Offices of the countries of the Special Union, in the name of any natural persons or legal entities, public or private, having, according to their national legislation, a right to use such appellations.

(2) The International Bureau shall, without delay, notify the Offices of the various countries of the Special Union of such registrations, and shall publish them in a periodical.

(3) The Office of any country may declare that it cannot ensure the protection of an appellation of origin whose registration has been notified to it, but only in so far as its declaration is notified to the International Bureau, together with an indication of the grounds therefore, within a period of one year from the receipt of the notification of registration, and provided that such declaration is not detrimental, in the country concerned, to the other forms of protection of the appellation which the owner thereof may be entitled to claim under Article 4, above.

(4) Such declaration may not be opposed by the Offices of the countries of the Union after the expiration of the period of one year provided for in the foregoing paragraph.

(5) The International Bureau shall, as soon as possible, notify the Office of the country of origin of any declaration made under the terms of paragraph (3) by the Office of another country. The interested party, when informed by his national Office of the declaration made by another country, may resort, in that other country, to all the judicial and administrative remedies open to the nationals of that country.

(6) If an appellation which has been granted protection in a given country pursuant to notification of its international registration has already been used by third parties in that country from a date prior to such notification, the competent Office of the said country shall have the right to grant to such third parties a
period not exceeding two years to terminate such use, on condition that it advise the International Bureau accordingly during the three months following the expiration of the period of one year provided for in paragraph (3), above.

**Article 6: Generic Appellations**

An appellation which has been granted protection in one of the countries of the Special Union pursuant to the procedure under Article 5 cannot, in that country, be deemed to have become generic, as long as it is protected as an appellation of origin in the country of origin.

**Article 7: Period of Validity of Registration; Fee**

(1) Registration effected at the International Bureau in conformity with Article 5 shall ensure, without renewal, protection for the whole of the period referred to in the foregoing Article.

(2) A single fee shall be paid for the registration of each appellation of origin.

**Article 8: Legal Proceedings**

Legal action required for ensuring the protection of appellations of origin may be taken in each of the countries of the Special Union under the provisions of the national legislation:

1. at the instance of the competent Office or at the request of the public prosecutor;

2. by any interested party, whether a natural person or a legal entity, whether public or private.

The main principle of the Lisbon Agreement is that the States that are party to it undertake to protect appellations of origin that are protected “as such” in the country of origin and registered in the international register administered by WIPO (Article 1(2)); i.e., once a given appellation of origin is protected in its country of origin, that appellation of origin can be registered in an international register administered by WIPO.

The expression ‘as such’ may be interpreted either to mean protection as an ‘appellation of origin’ in the country of origin, or to the substance of the definition of appellation of origin in Article 2. If interpreted in the former sense, protection under unfair competition law or other laws would not apparently be considered sufficient. On the other hand, the latter interpretation renders possible the argument that it does not matter what form of protection is given but only whether the name is recognized and protected in its country of origin as a name of a geographical area serving to designate a product that originates therein and meets certain qualifications as defined in Article 2. In such an event, a collective or certification mark registration in the country of origin could arguably form the basis for a Lisbon registration, provided it relates to the same name. Rule 5(2) (vi) of the Regulations under the Agreement may appear to support this interpretation in the sense that it enumerates the type of evidence which may be submitted to show that a given appellation of origin is protected in its country of origin i.e., ‘the title and date of the legislative or administrative provisions, the judicial decisions or the date and number of the registration by virtue of which the appellation of origin is protected in the country of origin’.

The Lisbon Agreement protects *appellations of origin*, that is, indications in respect of products that possess special characteristics and features of quality attributable to their geographical origin. For the purposes of this Agreement, appellation of origin means "the geographical name of a country, region, or locality which serves to designate a product originated therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors" (Article 2(1)). The significant aspects of the definition as per this agreement are:

- the appellation must be the geographical name of a country, region or locality, thus excluding *indirect* geographical indications;
- the appellation of origin must serve to designate a product originating in the country, region or locality referred to;
• the "quality and characteristics" must be due exclusively or essentially to the geographical environment.

As per the Lisbon Agreement, the essential requirements for an appellation of origin to be protected are that (i) the appellation of origin should be protected in its country of origin, and (ii) the appellation of origin should be registered in the International Register of WIPO. Thus, under Article 3 of the Agreement, not only misleading use of a protected appellation of origin is prohibited, but "any usurpation or imitation [of the protected appellation of origin], even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as "kind," "type," "make," "imitation" or the like."

According to the Lisbon Agreement Regulations, applications for the international registration of an appellation of origin is to be addressed to the International Bureau in Geneva, by the competent office of the country of whose name, or the country in which is situated the region or locality whose name, constitutes the appellation of origin which has given the product its reputation. The competent office acts on behalf of any natural persons, or legal entities, public or private, having a right to use such appellation, according to their domestic law. The competent office applying for registration may state that it renounces protection in one or some of the countries specified by name, which are party to the Agreement. Any application shall be declined by the International Bureau if it is not in timely possession of all the information required or the competent office making the application has not paid the full amount of the registration fee. After its registration, the appellation of origin is published and notified to all other States party to the Lisbon Agreement. Since its entry into force on September 25, 1966, 835 appellations of origin have been registered under the Lisbon Agreement, of which 766 are still in force. Following the receipt of a notification of registration, a State that is party to the Lisbon Agreement may declare during a period of one year that it cannot protect the appellation of origin, which was the subject of the notification. With respect to those registrations made under the Lisbon Agreement, refusals of protection, concerning 51 international registrations, have been entered in the international register.

It is not sufficient for the country involved to protect its appellations under a general law. Each appellation has to benefit from distinct and express protection, stemming from a specific official or administrative act. The reason for such a requirement is that specific elements of the protection such as the geographical area, the lawful users of the appellation and the nature of the product linked to a given quality, must be determined. The duration of the protection of an international registration is for as long as it remains protected as an appellation of origin in the country of origin. There is no requirement for international renewal. The Agreement did not make exception for geographic indications which had already become generic in member states.

STRESA CONVENTION, 1951

In 1951 an international convention on the naming and composition requirements of particular varieties of cheese was signed in the Italian city of Stresa. It came into force in 1953. In brief, Europe's cheese industry met at Stresa and signed the Stresa (sometimes called Stressa) Convention, an important document which established precise regulations regarding the designation of cheeses and set out guidelines as to their characteristics. In fact, the Stresa Convention fixed the rules by means of which Austria, Belgium, Denmark, France, Italy, Norway, Holland, Sweden and Switzerland apply mutual protection to some of their cheeses. The Stresa Convention called "appellation d'origine" the cheeses produced or seasoned in the traditional area using authentic and unvarying local method, while the name "denominations" was referred to cheeses submitted to the national regulations, for example the standards for chemical composition were decided. 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.

Article 1 of the convention prohibits the use of any names which conflict with protection granted under the convention. For example, "Gorgonzola (Italy)" is listed as a designation of origin under the convention.
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" may benefit from protection based on designations of origin governed by national legislation, (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, Samsöe, 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 Deserbaïs 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.

TRADE RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS [TRIPS]

The TRIPS agreement, within the framework of the WTO comprehensively defines the term "Geographical Indication" and provides a meticulous means to link a protected geographical indication with a product of given quality, or reputation or other characteristics of the good, which are essentially attributable to its geographical origin. It incorporates all features of earlier agreements related to this subject. Articles 22, 23 and 24, of the TRIPS agreement essentially address matters related to definition and scope of a geographical indication, minimum standards and common protection provided for geographical indications corresponding to all kinds of products, additional protection for geographical indications for wines and spirits, exceptions to the protection of geographical indications, provision for negotiation, review of geographical indications and a framework for dispute settlement mechanism, between the member states of WTO.19

We now discuss the relevant articles of TRIPS related to GIs.20

Article 22 [Standard level of protection in order to avoid misleading the public and to prevent unfair competition]

1. Geographical indications are, for the purposes of this Agreement, 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.

2. In respect of geographical indications, 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).

19 [http://www.wto.org/english/tratop_e/trips_e/gi_background_e.htm]
20 [http://www.wto.org/english/docs_e/legal_e/27-trips_04b_e.htm#art221][http://www.ipr-helpdesk.org/documentos/docsPublicacion/pdf_xml/8_GeographicalIndications%5B0000003653_00%5D.pdf]
3. A Member shall, ex officio if its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if 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.

4. The protection under paragraphs 1, 2 and 3 shall be applicable against a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory.

Article 22.1 of the Agreement provides a definition of geographical indications by stating that they are:

"... 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."

It should be noted that by this definition, one only requires “an indication” that identifies goods as originating in the territory of a Member, a region or a locality of that territory. Thus, this definition not only embraces the requirements laid down by the Lisbon Agreement but sets higher standards to be met for a good to qualify as a GI, as only goods whose quality or reputation or 'other characteristics' are linked to its geographical origin, and to consumer’s purchasing decisions can qualify.

Articles 22.2 further requires WTO Members to provide the legal tools so that interested parties can prevent the use of any means in the designation or presentation of a good that indicates or suggests that the good 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. This article also addresses concerns of unfair competition. Further Article 22.3 requires Members to create provisions in their domestic laws to refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, but only if use of the same in the trademark for such good in that Member’s country is of such a nature as to mislead the public as to the true place of origin.

Additional Protection for Geographical Indications for Wines and Spirits

The TRIPS agreement has provisions that give geographical indications for wines and spirits stronger protection than that provided in Article 22 for all other products. It should be noted that though wines and spirits have certain common additional protection [Article 23.1, 23.2 and 24.1], the special protection enjoyed by wines by way of geographical indications is higher that those granted for spirits [Article 23.3 and 23.4].

Articles 23.1, 23.2 and 24.1 provide provisions for:

i) the legal means for interested parties to prevent the use of a geographical indication identifying wine and spirits not originating in the place indicated by the geographical indication, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as “kind”, "type", "style", "imitation" or the like.

ii) refusing or invalidating the registration of a trademark for wines or spirits, which contains or consists of a geographical indication identifying wines or spirits, respectively at the request of an interested party.

iii) in calling Members for negotiations aimed to increase protection for individual geographical indications for wines and spirits.

Usages such as “California Chablis,” “American Champagne,” and a sparkling wine “type Champagne” would thus fail this standard even if they are truthful statements.

This extra-additional protection for Wines by way of Article 23.3 and 23.4 are:

i) the need to accord protection for each geographical indication for wines in the case of homonymous indications.
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.

Homonymous indications are those which are spelled and pronounced alike but which are different in meaning and which are used to designate the geographical origin of products stemming from different countries. For example, "Rioja" is the name of a region in Spain and in Argentina and the expression applies for wines produced in both countries. With regard to the use of homonymous geographical indications when used in the same market, in respect to identical or similar products, as per Article 23.3 protection shall be accorded to each indication, subject to Article 22.4.

Article 23

1. Each Member shall provide the legal means for interested parties to prevent use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as “kind”, “type”, “style”, “imitation” or the like.

2. The registration of a trademark for wines which contains or consists of a geographical indication identifying wines or for spirits which contains or consists of a geographical indication identifying spirits shall be refused or invalidated, ex officio if a Member’s legislation so permits or at the request of an interested party, with respect to such wines or spirits not having this origin.

3. In the case of homonymous geographical indications for wines, protection shall be accorded to each indication, subject to the provisions of paragraph 4 of Article 22. Each Member shall determine the practical conditions under which the homonymous indications in question will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled.

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.

International Negotiations; Exceptions

This article essentially provides for a platform under the TRIPS Agreement for Members to engage in negotiations aimed at increasing the protection of individual geographical indications under Article 23. It also defines guidelines in paragraphs 4 through 8 under which members shall not be used by a Member to refuse to conduct negotiations or to conclude bilateral or multilateral agreements. Further a provision for the Council for TRIPS periodic review the application of the provisions of this Section has been made. It also provides for the Council to facilitate bilateral or plurilateral consultations within Members on matters affecting the compliance with the obligations under these provisions when attention to such issues are drawn to the attention of the Council [Article 24.1 and article 24.2]. Nothing prevents a Member to continue the use of a particular geographical indication of another Member identifying wines or spirits in connection with goods or services by any of its nationals who have used that geographical indication in a continuous manner with regard to the same 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 [Article 24.3 & Article 24.4]

A term is considered to have become generic if a term has become ‘customary’ for the product in the member’s territory. Generic terms are not eligible for protection as GI. There are several examples of generic terms such as Cheddar and Emmentaler cheeses and Dijon mustard etc indicating products over time and consumers have become accustomed to them as representing products of a certain type, quality, etc in many WTO member countries and these are now not eligible for protection as GI nor is there any obligation of the WTO member to extend protection to a GI [Article 24.6].

A good example of a “continuous use” is Budweiser beer. Beer has been brewed in Bohemia since the thirteenth century and has been named as “Budweiser”. Further since the 19th century an American beer is also being sold as Budweiser. One is now allowed parallel use of the term and the TRIPS Agreement does not offer any provisions to rely on in the case of any dispute between the parties.

According to Article 24.5 if a trademark has been acquired or registered in good faith before the date of application of the Agreement in that Member or before the geographical indication was protected in its country of origin, measures adopted to implement provisions covering Geographical Indications in the
TRIPS Agreement shall not prejudice eligibility for or the validity of the registration of a trademark or the right to use a trademark, on the basis that such trademark is identical with or similar to, a geographical indication. Further, trademarks acquired in good faith prior to the registration of a GI or before the TRIPS Agreement was signed shall remain protected. However, questions remain as to the meaning of “in good faith.”

Art.24.6 exempts the geographical indications of a Member ‘with respect to the products of the wine for which the relevant indication is identical with the customary name of a grape variety existing in the territory of that Member as of the date of entry into force of the WTO Agreement’. Thus, for wines named after grape varieties, use of the grape name is allowed if the grape existed in the member’s territory at the time of entry into force of the WTO Agreement.

It should also be noted that Article 24.6 opens with the statement "Nothing in this article shall require a Member to apply its provisions in respect to 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 of such goods or services in the territory of that Member."

Also, the right to use a personal name is not to be prejudiced under Article 24.8

**Article 24**

1. Members agree to enter into negotiations aimed at increasing the protection of individual geographical indications under Article 23. The provisions of paragraphs 4 through 8 below shall not be used by a Member to refuse to conduct negotiations or to conclude bilateral or multilateral agreements. In the context of such negotiations, Members shall be willing to consider the continued applicability of these provisions to individual geographical indications whose use was the subject of such negotiations.

2. The Council for TRIPS shall keep under review the application of the provisions of this Section; the first such review shall take place within two years of the entry into force of the WTO Agreement. Any matter affecting the compliance with the obligations under these provisions may be drawn to the attention of the Council, which, at the request of a Member, shall consult with any Member or Members in respect of such matter in respect of which it has not been possible to find a satisfactory solution through bilateral or plurilateral consultations between the Members concerned. The Council shall take such action as may be agreed to facilitate the operation and further the objectives of this Section.

3. In implementing this Section, a Member shall not diminish the protection of geographical indications that existed in that Member immediately prior to the date of entry into force of the WTO Agreement.

4. 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.

5. Where a trademark has been applied for or registered in good faith, or where rights to a trademark have been acquired through use in good faith either:
   (a) before the date of application of these provisions in that Member as defined in Part VI; or
   (b) before the geographical indication is protected in its country of origin:

   Measures adopted to implement this Section shall not prejudice eligibility for or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication.

6. 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. 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 products of the vine for which the relevant indication is identical with the customary name of a grape variety existing in the territory of that Member as of the date of entry into force of the WTO Agreement.

7. A Member may provide that any request made under this 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 the trademark in that Member provided that the trademark has been published by that date, if such date is earlier than the date on which the adverse use became generally known in that Member, provided that the geographical indication is not used or registered in bad faith.

8. The provisions of this Section shall in no way prejudice the right of any 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.
9. There shall be no obligation under this 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.

BILATERAL AGREEMENTS, PLURILATERAL AGREEMENTS, AND FREE TRADE AGREEMENTS (FTAs)

In recent years, bilateral agreements, plurilateral agreements and FTA have become common in which conditions for reciprocal arrangements for protection of Intellectual Property Rights become integral part of such agreements. A wide variety of options are considered such as

i) provide for the prohibition of use of the other party’s geographical indications for goods not having that origin.

ii) provide for the extraterritorial application of the other country’s national law concerning the protection of geographical indications.

This latter aspect may be important in cases where a given geographical indication does not only indicate the geographical origin of certain goods, but also certain qualities that are due to that origin, such as is the case with protected appellations of origin.

Examples of bilateral agreements are:

- Germany and France agreed for the protection of indications of source, appellations of origin and other geographical indications in 1960. Similarly, in 1994, Australia and the US to the reciprocal protection of wine names and related provisions. In 1992, a similar agreement was signed between the European Union and Hungary on trade in wines.

- Australia and the European Communities (EC) in 1994 negotiated a bilateral trade in wine agreement, where protection for geographical indication and traditional expressions were included. It also included the phasing out of European wine names used by Australian wine makers that have entered into generic common use. The Agreement also provided for mutual recognition of enological practices of each Party and improved European market access conditions for Australian products, by removing a number of technical barriers to trade between both Parties.

- EC and Mexico in 1997 agreed on mutual recognition and protection of designations for spirits (including wine spirit), which had the purpose of regulating the description, labeling, presentation and packaging of this kind of product. According to the Agreement, the 206 EC names protected in Mexico may not be used otherwise than under the conditions laid down in the laws and regulations of the EC and were reserved exclusively to spirits originating in the EC to which they applied. The two protected Mexican names in the EC may not be used otherwise than under the conditions laid down in the laws and regulations of Mexico and were reserved exclusively to spirits originating in that country to which they applied.

- EC and South Africa in 1999 signed an agreement in which it was agreed that, within 5 years South Africa would phase out the use of the terms "Porto" and "Sherry" for exports to most parts of the world, and within eight years, for exports to its neighboring states (mainly Mozambique and Angola). For purposes of the domestic market, the phase out period is twelve years and the use of new geographical indications should be negotiated after that period. South Africa agreed to use the terms "Tawny" and "Ruby" instead of "Sherry" and "Porto", respectively.

- The North American Free Trade Agreement (NAFTA), signed by the United States, Canada and Mexico, entered into force on January 1, 1994. NAFTA required the signatories to deny trademark protection to geographically misleading marks. In order to comply, Congress amended the Lanham Act to prohibit registration of geographically deceptively misdescriptive terms, but grandfathered in terms that became distinctive before December 8, 1993.
US-Colombia and the U.S.-Peru Trade Promotion Agreements (TPA) were signed in 2006 with provisions for higher protection of The Intellectual Property that include protection of Geographical Indications.21

USA has signed FTAs with several countries such as Colombia, Ecuador, Bolivia, Chile, in the Middle East/North Africa with Morocco, Bahrain, Oman, Jordan and other countries such as Singapore and Australia.

EC – US Wine Agreement signed on 10 March 2006, provides for:

• recognition of each other’s existing current winemaking practices;
• a consultative process for accepting new winemaking practices;
• the United States limiting the use of 16 semi-generic names such as Burgundy, Chablis, Champagne, Chianti, Claret, Haut Sauterne, Hock, Madeira, Malaga, Marsala, Moselle, Port, Retsina, Rhine, Sauterne, Sherry and Tokay in the US market which will grandfather existing uses of these semi-generic names on non-European wine but prohibit new brands from using these names on non-EU wine;
• the EU allowing under specified conditions for the use of certain regulated terms on US wine exported to the EU;
• recognizing certain names of origin in each other’s market;
• simplifying certification requirements for US wine exported to the EU;
• Lists of names of quality wines produced in specified regions from the EC and the US, which may be used as names of origin for wine only to designate wine of the origin indicated by such a name.

EC – Canada Agreement signed on 16 September 2003 along similar lines to the EC-Australia Agreement provided for:

• It was agreed that the EC will protect amongst other names “Canadian Rye Whisky” as a distinctive product of Canada
• End the “generic” classification in Canada of 21 European wine names in three phases: by 31 December 2013 for Chablis, Champagne, Port/Porto and Sherry; by 31 December 2008 for Bourgogne/Burgundy, Rhin/Rhine, Sauterne/Sauternes; and immediately on entry into force of the agreement for Bordeaux, Chianti, Claret, Madeira, Malaga, Marsala, Medoc/Médoc, and Mosel/Moselle. An end to the “generic” status of European spirits names Grappa, Ouzo, Jägertee/Jagertee/Jagatee, Kem/Kombrand and Pacharan would be phased out within 2 years from the entry into force of the Agreement.

The Bangui Agreement of 1977 created the African Intellectual Property Organization, which also includes regional protection for different categories of intellectual property rights including appellations of origin. Benin, Burkina Faso, Cameroon, the Central Africa, Chad, Congo, Côte d’Ivoire, Gabon, Guinea, Guinea Bissau, Equatorial Guinea, Mali, Mauritania, Niger, Senegal and Togo are Parties to the OAPI Agreement, which embodies the national laws of the Member States of the African Intellectual Property Organisation and, therefore, applies directly in each Member State. All the Member States of the OAPI are party to both the Paris Convention and TRIPs Agreement. Burkina Faso, Congo, Gabon and Togo are also Parties to the Lisbon Agreement.

In 1993, The Banjul Protocol on Marks which came into force on March 6, 1997, was adopted by the Administrative Council of The African Regional Intellectual Property Organization (ARIPO) consisting of the English speaking African countries, and established a common trademark filing system under which an applicant may file a single application either at one of the contracting states or directly with the ARIPO Office and designate states where protection of the mark is sought. The ARIPO states currently consist of 16 contracting States (Botswana, Gambia, Ghana, Kenya, Lesotho, Malawi, Mozambique, Namibia, Sierra Leone, Somalia, Sudan, Swaziland, Tanzania, Uganda, Zambia, and Zimbabwe). States currently party to the Banjul Protocol are Botswana, Lesotho, Malawi, Namibia, Swaziland, Tanzania, Uganda and Zimbabwe.

CHAPTER 4
PROTECTION OF GEOGRAPHICAL INDICATIONS
...........Systems in various countries

Countries have generally chosen between two systems of jurisprudence, namely, the common law system and the civil law.

Under the common law system, both statute law and case law are considered for enforcement of rights. Thus, reputation and goodwill per se earned during trade in a territory would be considered as reasonable grounds to claim protection and it may not be necessary to a statutory protection to establish the rights in the geographical indication in that territory. In countries following the common law system, it is not unusual for the courts to give judgments with remedies based on a passing off action against an aggrieved party. In such matters, the question before the court is whether the goods or services of a plaintiff are being "passed off" as the goods / services of the defendants.

The basic elements of a case of passing off are:

"a misrepresentation made by a trader in the course of trade to prospective customers of his or ultimate consumers of goods or services supplied by him which is calculated to injure the business or goodwill of another trader (a reasonable foreseeable consequence), which causes actual damage to a business or goodwill of the trader by whom the action is brought or will probably do so."\(^\text{22}\) Under such circumstances, a court decision in favor of the plaintiff entitles him to\(^\text{23}\)

- an injunction, thereby restraining the defendant from passing off his goods or services as and for that of the plaintiff,
- damages for any actual injury to reputation suffered by the plaintiff or
- rendition of accounts.

In contrast, under civil law jurisprudence, a statutory registration would be necessary for protection and only use may not give the plaintiff all the protection he desires. The civil law system of jurisprudence offers the plaintiff a remedy of an injunction based on a statutory or formal protection in the country of origin as well as in the country of disputed use. In some civil law countries there even exists a provision for damages for injury caused to goodwill and reputation in such an action. The original model of the French Appellations d'origine Controllee for wines was modified and adopted by other countries for the protection of geographical indications by way of a sui generis legislation for geographical indications in general or for the specific products. Countries that have enacted special legislations for protection of geographical indications are India, Malaysia, Turkey, Thailand, Singapore, etc. Examples of legislation specifically enacted for protection of a product as a geographical indication are the Scotch Whisky Act, 1988 for protection of Scotch whisky, the Harris Tweed Act, 1993 for the protection of tweed made in some parts of Scotland etc.

Most of the countries that have enacted sui generis legislations for protection of geographical indications have done so after the establishment of the WTO. The basis for such a pattern may be attributed to Article 22 of the TRIPS Agreement which stipulates that members should provide 'legal means' to prevent misuse of geographical indications. However, several product specific legislations mentioned before have been enacted well before the TRIPS Agreement and these administer the specific product concerned.

APPROACHES FOLLOWED IN VARIOUS COUNTRIES/ REGIONS

A two-part Guide titled "Geographical Indications and TRIPS: 10 Years Later....A Roadmap for EU GI holders to get protection in other WTO Members" published in June 2007 by O’Connor and Company, a report commissioned and financed by the Commission of the European Communities covers general information on GI followed by 160 country review tables setting out main requirements for getting GI protection in these countries.\(^\text{24}\)

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\(^{22}\) Lord Diplock’s enumeration in the _Advocaat_ case.


Date uploaded to library: Wednesday, 15 February 2006
The text of the GI protection systems in a few countries given below have been adapted from the text given in the above references and should serve as examples of diverse systems. However for a detailed appreciation, the reader is directed to the cited references.

**THAILAND**

A Sui Generis protection of geographical indications by way of ‘The Protection of Geographical Indications Act 2003’ was put into force from 28 April 2004. The legal system further provides protection under The Consumer Protection Law and The Penal Code. The authority responsible for GI in Thailand is the Department of Intellectual Property of Thailand (DIPT) The protection system concerns goods that are natural, agricultural, mining and industrial products and handicrafts, but not services.  

Under the Thai law, the following acts are deemed unlawful:

- the use of geographical indication in order to misrepresent or mislead other persons to believe that the goods which do not originate from the geographical origin indicated in the application are goods originating from such origin; i.e. the use of the Geographical Indications of specific goods on the goods not originating from the geographical place indicated is unlawful. An indication of the true place of origin of a good seems to be sufficient to avoid misinterpretation or deception.
- the use of geographical indications in any manner which will cause confusion or deception as to the geographical origin, quality, reputation or any other characteristics of the goods so as to cause damage to other traders.

The Act also provides for higher protection to geographical indications of specific goods (wines, spirits and rice). Further by way of a Ministerial Declaration the government may declare any particular type of goods to be specific goods; for example rice was declared as a particular type of good.

In addition to procedural details prescribed by the Ministerial Regulations, an application for GI registration must provide minimum information related to the name being claimed, geographical area in which the product is produced, information on the reputation or any other characteristics of the goods and product quality related information. When a particular type of good has been announced as a specific good, use of the geographical indication with any goods not originating from the geographical origin indicated in the application shall be deemed an unlawful act regardless of any indication, use of any wording or performance of any action, so as to declare the true place of origin of such goods by the user. The declaration of the true place of origin of goods includes any use of the term “type”, “category”, “form”, any wording or anything similar thereto to accompany the geographical indication used with the said goods. It shall not be deemed unlawful if the user has been using that geographical indication for ten consecutive years before April 15, 1994 or in good faith before the date mentioned.

The Act has provisions for

- criminal proceedings for a breach of the use of registered GI. Further the GI owner could claim damages through civil procedure under the general tort law.
- cancellation and opposition mechanism for trademarks registration, which adopt the concept of the continuation of trademarks incorporating geographical indications
- refusal and invalidation of trademark registrations.
- Opposition of registration of GI including appeal against the decision of the Registrar of GI.
- Revocation of registered GIs
- Amendments of registration of GI
- Registration of foreign GIs but they must clearly show evidence that the geographical indication is protected under the law of that country and has been continuously used until the date of application in Thailand. The application would be examined under the Thai law.

Regarding the Questionnaire on Geographical Indications, as it was agreed at the IPEG meeting this matrix this is accessible to all member economies to update the data. [Geographical Indications Questionnaire Feb 2006 - Lead by Mexico.doc](http://www.apecipeg.org/library/resources/default.asp) and The Working Party on Agricultural Policies and Markets of the Committee for Agriculture: Joint Working Party of the Committee for Agriculture and the Trade Committee: Appellations of origin and geographical indications in OECD member countries: economic and legal implications [http://www.oecd.org/dataoecd/59/51/23526073.doc](http://www.oecd.org/dataoecd/59/51/23526073.doc)

25 The GI Act is available on [http://www.ipthailand.org/Static/IPSystem/GI.doc](http://www.ipthailand.org/Static/IPSystem/GI.doc)
The registration may be obtained from 6-18 months from the date of filing the application provided there is no opposition. There is no fixed term for a GI so long as all the conditions continue to be satisfied. Generic names may not be registered but no specific criteria have been given in the ACT as to how to establish a generic nature of the name. Geographical names such as Pisco spirit of Peru, pamello of Nakhonchaisri, jasmine rice of Surin and sweet tamarind of Petchaboon have been registered in Thailand. It may also be noted that CHAMPAGNE as a geographical indication has been registered in June 2006.

TURKEY

The legal framework in Turkey protecting GIs covering goods that are natural, agricultural, mining and industrial products and handicrafts, but not services include The Decree-Law No. 555 on the Protection of Geographical Signs adopted and entered into force on 27 June 1995 and Implementing Regulations under the Decree-Law No. 555 pertaining to the Protection of Geographical Signs adopted and entered into force on 5 November 1995. The authority responsible for registration of GIs is The Turkish Patent Institute.

The Decree-Law provides for

- Registration of designations of origin and geographical indications by way of Names & signs that meet the definition as per the law may be registered;
- Formal and substantial examination of the GI application;
- Publication of the GI applications;
- opposition of a GI application within six months from the publication in the Official Gazette, two national newspapers and one local newspaper;
- Appeal against decision of the registrar of GI;
- Non use of registered designations of origin or geographical indications in the cases when the genuine origin is indicated or used in translation or in combination with expressions such as “sort of”, “kind of”, “imitation” and “the like”;
- Prohibition of the use of false or misleading information as to the origin, nature or essential qualities of the product on its packaging, or in advertising material or documents relating to the product;
- Initiation of legal proceedings by the holder of the rights in a geographical sign against infringement of his rights;
- Non-protection of generic names as defined in Article 5.b of the Law;
- Protection of Geographical indications and designations of origin, used in translation;
- Registration of foreign geographical indications in Turkey subject to reciprocity Provisions;

There is no fixed term for the GI. However the owner of the GI has to renew the GI every 10 years.

SINGAPORE

The legal framework for the protection of GI includes The Geographical Indications Act (Cap. 117B) covering natural or agricultural product or any product of handicraft or industry that came into force from January 15, 1999 and The Trade Marks Act (Cap. 332, 2005 Rev. Ed.) which is applicable to all goods and services. In contrast to the laws in several countries, the GI Law in Singapore does not provide for registration of geographical indications. In Singapore Geographical indications enjoy automatic protection where they satisfy the elements required by the GI Law.

The GI Law provides for

- an interested party to initiate private civil actions for certain uses of geographical indications, when the good did not originate in the place indicated (in a manner which misleads the public as to the geographical origin of the goods) or when the use may constitute an act of unfair competition;
- no protection to geographical indications in relation to goods or services which have become the common name in Singapore;
- additional protection for interested parties in the cases of geographical indications for wines and spirits when they do not originate from the place indicated, even if the true origin of the goods is indicated, or the geographical indication is used in translation or accompanied by expressions such as “kind”, “type”, “style”, “imitation” or the like;
- specific provisions in relation to homonymous geographical indications for wines, stating that any interested party may apply to the Court for a declaration of the practical conditions under which the geographical indications are to be differentiated from one another;
Exceptions under which an interested party may not bring an action for a geographical indication include:

- it has become the common name, in Singapore, of the goods or services which it identifies;
- it has been continuously used by a qualified person (meaning a Singapore citizen or individual resident in Singapore, a body corporate incorporated under any written law, or any other person who has a real and effective industrial or commercial establishment in Singapore) in relation to goods or services for 10 years before 15 April 1994, or in good faith before that date;
- it is identical or similar to a trademark which had been used in the course of trade in good faith, or
- it is registered in good faith, or
- an application for the registration of that trademark had been made in good faith either before the Geographical Indications Act came into force or
- an application for the registration of that trademark had been made in good faith either before that geographical indication is protected in its country of origin; and it is the name of a person or his predecessor in business (except where the name is used in a manner to mislead the public).

The Trademark system in Singapore provides for the registration of GIs as collective marks or certification marks. A trademark application can be opposed within a stipulated time period after publication of the application. As is the normal practice in any trademark system, an applicant for registration of a certification mark must file with the Registrar regulations governing the use of the mark. The regulations must indicate who is authorized to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark, the fees (if any) to be paid in connection with the operation of the mark and the procedures for resolving disputes. Similarly, an applicant for registration of a collective mark must file with the Registrar regulations governing the use of the mark. The regulations must specify the persons authorized to use the mark, the conditions of membership of the association and, where they exist, the conditions for use of the mark, including any sanctions against misuse. The regulations governing the use of both a registered certification mark and a registered collective mark must be open to public inspection. A trademark may be renewed every 10 years.

SRI LANKA

Sri Lanka like Singapore follows a dual system for the protection of GIs i.e. a sui generis protection of geographical indications (without registration) under The Intellectual Property Act No. 36 of 2003 which replaced the Code of Intellectual Property Act No. 52 of 1979 contains a section on Geographical Indications (Part IX, Section 161) covering all agricultural products, foodstuffs, wines and spirits and services, and by the system certification and collective marks within its trade mark regime also under the Intellectual Property Act No. 36 of 2003 which replaced the Code of Intellectual Property Act No. 52 of 1979 contains a section on marks (Part V) covering all goods and services. It is not necessary to get a GI registered under the GI law.

The GI law

- prevents the use of GIs when they are misleading as to its origin and when their use constitutes an act of unfair competition;
- Prevents the use of the expressions such as “kind”, “type”, “style” or “imitation of the like” with geographical indications identifying goods, including agricultural product, food, wines or spirits [Section 161 (1) (iii)];
- Provides for the protection of homonymous GIs for goods including an agricultural product, food, wine or spirit, subject to the provisions of Sub-Section 161(2);
- Provides for issuance of injunctions and fines by the court to stop abuse of a GI reputation including destruction of infringement goods;
- Provides section 191(b) of the IP Act 2003 which states “any person who makes a false declaration in respect of [a] geographical indication inclusive of Ceylon Tea and Ceylon Cinnamon” shall be guilty of an offence
- A means for implementing a special system of protection for GIs in the particular industry or sector through powers given to the relevant Minister or statutory Authority to adopt regulations.
The Customs Ordinance prohibits the import and export covers GIs which prohibits the export/import of GI infringing or GI counterfeit goods. Examples of protected GIs in Sri Lanka are Ceylon Tea and Ceylon Cinnamon.

“Ceylon Tea” grown in the 6 main agro-climatic regions- Nuwara Eliya, Dimbula, Kandy, Ruhuna, Uva and Uda Pussellawa identifies tea originating in Sri Lanka (Ceylon till 1972), which possesses a distinctive quality and reputation essentially attributable to its geographical origin.

The Sri Lanka Tea Board has also registered “Ceylon Tea – Symbol of Quality” accompanied by a logo of a lion, as a trademark under the Intellectual Property Act, No. 36 of 2003. The mark may only be affixed on retail containers (value-added teas) packed in Sri Lanka provided that the tea is 100 per cent Ceylon Tea above ISO 3720 standard.

The Tea Board has also registered the Ceylon Tea mark as a trademark in around 80 countries. In many markets, registration has only been permitted of the lion logo without the accompanying words “Ceylon Tea,” and in such countries the protection falls short of protecting the GI “Ceylon Tea.”

SWITZERLAND

The protection of GIs in Switzerland covering goods such as agricultural products and processed agricultural products, including spirits but excluding industrial products implemented under a set of laws such as:

- The Federal Law on Agriculture of 29 April 1998;
- The Federal Ordinance on the Protection of Trademarks, 23 December 1992, as amended in May 2006;
- The Federal Law on Agriculture of 29 April 1998;
- Ordinance on Viticulture and the Importation of Vine of 7 December 1998, entered into force on 1 January 1999 (limited to wines);
- Agreement between the European Community and the Swiss Confederation on Trade in Agricultural Products of 30 April 2002.

The Federal Office of Agriculture is the designated authority responsible for the registration of GIs.

The Ordinance on the Protection of Appellations of Origin and Geographical Indications provides for:

- Definition of designations of origin and GIs thereby requiring the names and signs to meet the requirements to be eligible for registration;
- Prohibition of unauthorized use of registered geographical indications including the cases when the true origin is indicated or the geographical indication is used in translation or in combination with expressions such as “sort of”, “kind of”, “imitation” and “the like”.
- Prohibition of the use of similar geographical indications on any goods which may confuse consumers in respect of origin and specific properties of goods;
- Definition of generic names and criteria on how to establish a generic nature of the name (Article 4)
- Non protection of generic names;
- Registration of European Commission GIs in Switzerland;
- Protection of Geographical indications and designations of origin, used in translation, (Article 17);
- Opposition of GI application within 3 months of its publication;
- Appeal by applicant against a decision to refuse registration;
- Protection of designations of origin and geographical indications for unlimited duration (or as long as conditions for use of the registered name are respected).

CHINA

China follows a dual system offering protection of GIs under

- Regulation on Protection of Products of Geographical Indications (related to agricultural and handicraft goods, but not services) which came into force on July 15th, 2005 which was issued by The State General Administration of Quality Supervision, Inspection and Quarantine (AQSIQ) on 7 June, 2005; and
- The Chinese Trademark Law of 23 August 1982 amended on 22 February 1993 and on 27 October 2001 covering all goods and services. The associated regulations are:
  - Regulation for the Implementation of the Trademark Law of the People’s Republic of China, promulgated by Decree No. 358 of the State Council of the People’s Republic of China on 3 August 2002, and effective as of 15 September 2002;

The Regulation on Protection of Products of Geographical Indications provides:

- Definition of geographical indication and therefore applications for products that need to be protected must satisfy these definitions and the application must be accompanied by the specification with standards of production and management norms;
- Formal Procedures for the application and registration of GIs. In addition to other details as required by the Regulation, that applicant has to indicate the geographical origin of a product or service and the qualities and characteristics of the said product or service, which are exclusively due to the place of origin, including natural and human factors;
- Formal and substantive examination of the GI application;
- Publication of the decision to grant a Protection Title to a GI or refusal of application;
- Opposition to the grant of registration of a GI within two months after the publication of acceptance by the AQSIQ;
- Cancellation of registered GI if not used within two years after its registration;
- Prohibition of Unauthorized use of registered geographical indications including cases where the true origin is indicated or a geographical indication is used in translation or in combination with expressions such as “sort of”, “kind of”, “imitation” and “the like”. If a GI is liable to cause confusion such an extent as to mislead the public, it will be treated as “similar”.
- Geographical indications for all goods are protected in translation.

There is no special provision that protects geographical indications against a geographical indication, which although literally true as to territory, region or locality, in which the goods originate, falsely represents to public that the goods originate in another territory. There is no special provision for wines and spirits.

As in other countries, a GI application in China must provide among other details such as the name and address of an applicant, the certifying materials of GI products, in particular, the name and classification of products, the boundary of geographical origin and geographical features; the quality elements of the product, including physical, chemical, microbiological and organoleptic characteristics, and their correlations with the natural and human factors of the region as specified by the geographical indication; the specification of production techniques (including processing techniques, food safety and hygienic requirements, technical requirements on processing equipment, etc); the popularity of products, production, sales and historical facts of the product in question and technical standards of the GI products under application.

The Trademark regime for the protection of GIs provides:

- Definitions for GIs and therefore names and signs that meet such definition may be registered as collective or certification marks provided they satisfy all the conditions for registration as certification or collective marks; Examples of certification marks in China are ku er le fragrant pear. Dangshang crunchy pear.
- Formal application procedures which require that applicant to provide documents showing the given quality, reputation or any other characteristic of the goods indicated by the geographic indication; the correlation between the given quality, reputation or any other characteristic of the goods, and the natural and human factors of the region indicated by the geographic indication; the boundary of the region indicated by the geographic indication;
All processes such as opposition, cancellation renewal etc that are standard processes in any trademark law.

Ten-year term that is perpetually renewable.

CHILE

The legal framework for the protection of GI is based on a set of laws:

- The Law No. 19.039 of Industrial Property, from 1991 was amended by Law 19.996, published on March 2005, introduced a new Title for geographical indications and appellation of origin covers all goods but not services;
- Law Nº 18.455 (1985) sets Rules on production, processing and commercialization of Ethyl Alcohols, Alcoholic Beverages and Vinegars includes Appellation of Origin in Title V;
- Supreme Decree No. 78 of 1986 of Ministry of Agriculture which establishes a Regulation for Law No. 18.455, includes a Title V on Appellation of Origin;
- Supreme Decree Nº 464 of 1994 establishes Wine-growing Zones and Regulates its Use with regard to planting, seed-planting, production, and manufacturing. The viticulture zoning of Chile consisting of 5 regions and numerous sub regions, valleys and areas for wines.
- Supreme Decree Nº 521 of 1999 Regulates Appellation of Origin “Pisco”;
- Bilateral Agreement between Chile and the EC on wines and spirits, in force since 1 February 2003.

The key objectives are to (i) ensure that consumers are not mislead as to a product's true origin, quality or type, as well as, to (ii) provide an incentive for that industry.

The Ministry of Economic Affairs, Development and Reconstruction is the Authority administering GI in Chile.

Law 19.996, dealing with GIs provides:

- Definitions of appellations of origin
- Requirement of a favourable report from the Chilean Ministry of Agriculture for an application of a geographical indication from Chile or from a foreign country that involves agro-industrial or agricultural products;
- The same registration procedure for foreign appellations of origin and those with the national appellations of origin;
- Publication of an extract of the GI application in the Official Gazette.
- Opposition of a published application within 45 days of the publication;
- Civil actions to prevent the abuse of a registered GI;
- No protection to the translation of geographical names, except for wines and spirits;
- A higher level of protection is granted to wines and spirits (protection in translation, and when it is preceded by terms like “class”, “type”, “style”, “imitation” or another similar), even when the true origin of the product is indicated;
- A grandfather clause is evoked for the use of a GI name for wines and spirits in cases where the use has been for at least 10 years preceding 15 April 1994 in a continuous manner or in good faith preceding that date;
- Non registration of common or generic names whenever experts of that type of product as well as the public in general consider the name as common or generic, except if those names have been recognized as a geographical indications or an appellations of origin by an international treaties signed by Chile;
- No protection of a geographical indication which, although literally true as to territory, region or locality in which the goods originate, falsely represents to public that the goods originate in another territory;
- Indefinite term of registered geographical indication or an appellation of origin as long as it fulfills the requirements to be a geographical indication;
- Indefinite term of registered foreign GIs while they are continue to be protected in their country of origin and have not fallen into disuse in that country;
- Non granting of trademarks that correspond to a generic term, and those that where granted in the past can be annulled on the basis that such trade mark misleads or deceives consumers;

For registration of GIs in Chile, the applicant has to provide several details such as the Name, address and activity of the applicant for to the GI, the GI name, the geographic zone for the production,
extraction or elaboration of the product, a detailed description of the products that are going to bear the GI, a copy of specifications and controls, a technical study, prepared by an expert, on the characteristics or qualities of the product which are exclusively attributable to its environment and a certificate that indicates that the GI is registered in the foreign country.

Chile’s Industrial Property Law 19.039, in force since January 25, 1991 provides for refusal or its registration invalidated if there is any likelihood of the consumer being induced to make a mistake or mislead with respect to the origin of the product, quality or type of the products, services or establishments.

Geographical indications for Chilean wines and spirits are contained in Law Nº 18.455 and it’s Regulation (Supreme Decree Nº 464 and Supreme Decree Nº1521). The Supreme Decree No 464 regulates planting, seed-planting, production, manufacturing, establish the viticulture zoning of Chile consisting of 5 regions an numerous sub regions, valleys and areas for wines. The appellation of origin “Pisco” is regulated in the Supreme Decree. No 521.

Bilateral Agreement between Chile and the EC on wines and spirits offers a mutual recognition for EC and Chilean wines and spirits. An ex officio protection available for wines (Article 16 of Agreement on wines and spirits). The protection covers the name of the GI used in translation, and when it is preceded by terms like “class”, “type”, “style”, “imitation” or another similar, even when the true origin of the product is indicated. Chile agreed to halt using trademarks that contain European appellations of origin within a period of 5 years (for exports) and 12 years (in its internal market) starting from 2002. However, at the request of Chile, a new transition period has been granted by the EC on 14 February 2006, delaying the start of the phasing-out period for some Chilean trademarks not in 2002, but in 2005.

MEXICO

GIs are protected by a Sui generic system under

- The Industrial Property Law published by Decree in August 1994, as amended in 1997 and 1999 covering all goods, but not services;

Mexican Institute of Intellectual Property (IMPI) is the designated authority to grant GIs in Mexico.

Tequila; Mezcal; Talavera; Olinalá, CaféGIs in Mexico. Veracruz; Bacanora; Ambar de Chiapas, Mango Ataulfo; Café Chiapas, Charanda, Sotol are examples of GIs in Mexico.

The Law provides

- Definition of appellation of origin;
- Process for registration of Foreign appellations of origin by the national authorities of foreign countries or by persons with legal interest provided that it is established in a Treaty which Mexico is party; Authority to The Mexican Institute of Intellectual Property (IMPI) to grant a declaration of recognition to the foreign appellations of origin. With such recognition, future trademarks in Mexico cannot be registered with the name of the appellation of origin. The recognition may be obtained via the Lisbon Agreement of Appellations of Origin, as Mexico recognizes the appellations of origin of countries that are parties to this Agreement or via notification sent by the WIPO or through request of a country or person with legal interest in the recognition by the IMPI.
- No provisions for opposition of GI applications.
- Provision to appeal before the Mexican Federal Superior Court for a rejection of a GI application;
- Protection against unfair competition as well as against any use susceptible to cause error or confusion on the geographic origin of products. This protection covers the use of the GIs with expressions such as: “class”, “type”, “style”, “imitation” or other analogous ones;
- No provisions on homonymous geographical indications;
- Provisions for the invalidation of the registered GIs granted in violation of the provisions of the Industrial Property Law
- Prohibits the use of appellations of origin including that in which it is accompanied by the indications such as “kind”, “type”, “style”, “imitation” or other similar terms that create confusion in the mind of the consumer or imply unfair competition.
- Definition of infringement as performing, in the course of industrial activities or trade, acts that confuse, mislead or deceive the public by causing it wrongly to believe or assume, that the product
concerned comes from a territory, region or locality different from the true place of origin, in such a way as to mislead the public as to the geographical origin of the product.

- No specific provisions for wines and spirits.
- Infinite term for a registered GI as long as the conditions under which the GI was granted are met.

Enforcement of Appellations of Origin in Mexico is possible under the Appellations of Origin are protected by, Appellations of Origin of the Industrial Property Law—Title V, Collective marks protected by Title IV, Chapter II of Collective Marks of the Industrial Property Law, Provisions on infringements to Appellations of Origin under Article 213, subparagraph IX d and subparagraph XXII and Provisions on infringements to collective marks under Article 213, subparagraph IV, V, VIII, IX, X, XVIII, XIX, XX, XXI, and subparagraph XXVI.

According to article 90 of the Industrial Property Law, the following cannot be registered as trademarks:

- Proper or common geographical names and maps, and also generic nouns and adjectives when they indicate the origin of the products or services and can cause confusion or error regarding such origin. (Article 90, subparagraph X).
- The names of towns or places known for the manufacture of certain products, to protect those products, except the names of places in private ownership when they are special and not liable to be confused, and when the consent of the owner has been obtained. (Article 90, subparagraph XI). Thus appellations of origin cannot be registered as trademarks even when they do not indicate the originating territory of the goods, or even if they mislead or not the public as to the true place of origin.
- Appellations of origin are protected by Mexico's legislation (Title V Appellations of Origin of the Industrial Property Law).
- Collective marks are protected by the Mexico’s legislation (Title IV, Chapter II Collective Marks of the Industrial Property Law).
- Provisions on infringements to Appellations of Origin (Article 213, subparagraph IX d) and subparagraph XXII.
- Provisions on infringements to collective marks (Article 213, subparagraph IV, V, VIII, IX, X, XVIII, XIX, XX, XXI, and subparagraph XXVI).

ARGENTINA

In Argentina, the legal platforms providing a set of laws under which Geographical Indications may be protected so as to prevent consumer deception or misleading, are:

- **Law No. 25380 for indications of source and denominations of origin for agricultural and food products** came into force on 9 January 2001, as modified by the **Law No. 25966 of 17 November 2004** covers agricultural and food products.

  The Law:
  - defines both indications of source and denominations of origin;
  - provides procedures for registration and all associated actions such as opposition, cancellation, etc.;
  - allows for registration of foreign GIs, when Argentina has secured reciprocity agreements which would establish the conditions of registration;
  - prohibits the registration of generic names;
  - specifically provides in Article 236 (Food Code), that GI names considered as generic names (list includes names such as Champagne, Emmental, Gruyere, Habana, Jerez, Madera, Malaga, Oporto, Roquefort, Marsala) in Argentina can be used freely by anyone;
  - provides protection for an **indefinite period of time** (as long as the conditions for GI protection are maintained).


  The laws require any information presented to be clear, precise, true and verifiable in order to prevent consumer deception or misleading, in particular with regard to the origin, nature, quality and methods of production of the product. Further the laws:
provide for foreign GIs demonstrating that they are registered in their country of origin can be included in the Register;  
o Give guidelines with regard to the registration of national wine and spirits GIs;  
o Do not provide guidelines for the registration of foreign GIs;  
o Prohibit the use of registered designations of origin or geographical indications in the cases when the genuine origin is indicated or used in translation or in combination with expressions such as “sort of”, “kind of”, “imitation” and “the like”;  
o Prohibit the use of false or misleading information as to the origin, nature or essential qualities of the product is also prohibited;  
o Prohibit the registration of generic names  
Resolution N° C.20 of 14 June 2004 relating to wine labeling;  
Law N° 22.802 of 5 May 1983 on Fair Trading;  
The Trademark Law No. 22.362 and Decrees (558/81 and 1141/03) does not provide for the registration of collective marks. It also expressly excludes geographical indications from registration as trademarks (Article 3 c of the Trademark Law No. 22.362).  
MERCOSUR/GMC/RES. No. 26/03 – Technical Rule for the Labeling of Packaged Foods which applies to the labeling of any food that is commercialized in the market of Member States of the MERCOSUR, regardless of its origin protects consumer interests in all the Member States as it:  
o Prohibits the use of geographical appellations of a country, a region or a population, recognized as places in which are manufactured foods with specific characteristics, in the labeling or the advertisement of foods, manufactured in other places, when this can mislead the consumer.  
o Prohibits the use of the expression “type/tipo”, to names associated with wines and spirits.

The administrative authority for registration of wines is the Instituto Nacional de Vitivinicultura or National Institute of Wine and Vine and for other products it is The Ministry of Agriculture – SAGPyA

BRAZIL

GIs are protected in Brazil under  
Industrial Property Law No. 9279, from May 1996, entered into force in May 1997 covering all goods and services and the Acts No. 134 of 1997 and No. 75 of 2000 related to the process of registration;  

The Ministry of Development, Industry and Foreign Trade, National Institute of Industrial Property INPI is the designated authority responsible for the registration of geographical indications.

The Industrial Property Law provides

- Definitions for denominations of origin;  
- Formal examination of GI application;  
- Publication of approved INPI GI application;  
- Provision for opposition of the approved GI application within 60 days of the publication;  
- Extension of the protection granted to the GIs to the graphical or figurative representation of a geographical indication, as well as to the geographic representation of the country, city, region or location in which the name is a geographical indication;  
- Use of GI in a product container, case, tape, label, invoice, circular letter or poster, or in any other means of disclosure or advertising, indicative terms such as “type”, species”, “kind”, “system”, “similar”, “substitute”, “identical” or the like, failing to clearly state the true origin of the product;  
- No registration of generic names as GI though no criteria as to the generic nature of a geographical name or “everyday use” are given;  
- No registration as GI when the geographical name has entered into everyday use designating a given product or service;
o No protection extended to the translation of geographical names
o The term for a registered GI is indefinite provided the conditions that generated it continue to exist.

A GI applicant is expected to provide detailed information that includes full geographical name and legal name of the applicant, a description of the characteristics of the product or service; rules of use of a geographical name, and an official document that defines the geographical zone.

"Vale dos Vinhedos", a Brazilian Wine has been registered as a GI in Brazil.

- **MERCOSUR/GMC/RES. No. 26/03 – Technical Rule for the Labeling of Packaged Foods** which applies to the labeling of any food that is commercialized in the market of Member States of the MERCOSUR, regardless of its origin protects consumer interests in all the Member States as it:
  - Prohibits the use of geographical appellations of a country, a region or a population, recognized as places in which are manufactured foods with specific characteristics, in the labeling or the advertisement of foods, manufactured in other places, when this can mislead the consumer.
  - Prohibits the use of the expression “type/tipo”, to names associated with wines and spirits.

**VIETNAM**

The Intellectual Property Law of Vietnam adopted on 19 November 2005 and entered into force on 1 July 2006 covers goods that are natural, agricultural, mining and industrial products and handicrafts, but not services.

The **National Office of Intellectual Property (NOIP)** is the designated authority responsible for registration of GIs.

The Law provides:

- Definition of geographical indications so that names and signs that meet such definition may be registered;
- Formal and substantial examination of the GI applications;
- Publication of the decision to grant a Protection Title to a GI or refusal of application;
- Opposition of a GI application after publication including request of a re-examination in case of refusal of registration;
- Prohibition of the unauthorized use of registered geographical indications;
- Prohibition of the unauthorized use of geographical indications even in cases when the true origin is indicated or the geographical indication is used in translation or in combination with expressions such as “sort of”, “kind of”, “imitation” and “the like”;
- Non registration of Generic names of goods in Vietnam though the law does not provide the criteria of how to establish a generic nature of a name;
- Non-registration of Geographical indications that are not or no longer protected or have not been used in the origin country of such geographical indication.
- No reciprocity provisions though right to apply for registration is granted to foreigners;
- Registration of Geographical indications for all goods are protected in translation;
- No provision on homonymous geographical indications;
- No additional protection for wines and spirit;
- Geographical Indication Registration Certificate has indefinite term of validity beginning on the granting date and renewable every 10 years. However the term is liable to termination if the unique geographical factors or quality or reputation of the products bearing such geographical indication have been changed or the reputation is diluted;
- Rights to the legitimate user of the appellation of origin to request the compensation for the damages through the civil procedures or to request the handling of the infringement through administrative procedures.

Geographical indication applicants are expected to provide among other information, name or sign which is the geographical indication, product bearing the geographical indication, descriptions of the unique characteristics and quality, the reputation of the product bearing the geographical indication and unique natural factors attributing to the unique characteristics, quality, and reputation of the product, map of the geographical area corresponding to the geographical indication, documents proving the geographical indication is under protection in the country of origin if it has foreign origin, descriptions of the unique
characteristics shall include at least the following contents, descriptions of the relevant products, including raw materials (if any), and physical, chemical and biological and sensation elements of the product, methods to determine the geographical area corresponding to the geographical indication, evidence proving that the product originates from such geographical area, within the meaning of the law, descriptions of the local and stable production methods of the product, information on the relationship between the unique characteristics, quality or reputation of the product with the natural conditions within the meanings of the law, information on the self-inspection mechanism of the unique characteristics and quality of the products. The signs liable to mislead, confuse or deceive consumers as to the origin, functional parameters, purpose, quality or value of the goods or services shall not be protected by the State as trademark.

MALAYSIA

The protection of GIs covering all natural and agricultural products as well as any product of handicraft or industry


The Intellectual Property Corporation of Malaysia is the designated authority for the administration of GI. The law is intended to protect goods that have a specific geographical origin and possess qualities or a reputation that are due to that place of origin, to ensure equitable treatment of the producers concerned from an unfair competition and to ensure that the public are not misled as to the geographical origin of the goods and to prohibit the registration of geographical indication as a trade mark if it mislead the public as to the true place of origin of the goods.

The Law provides:

- Definition of Geographical Indications;
- Protection of GIs regardless whether or not the geographical indication is registered under the Act; and as against another geographical indication which, although literally true as to the country, territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another country, territory, region or locality;
- No protection of names that are generic though the law does not indicate how generic term shall be determined;
- Protection to homonymous geographical indication; in cases of homonymous geographical indications for wines, protection shall be accorded to each indication. In cases of bona fide concurrent use of homonymous geographical indications, the practical conditions under which the homonymous geographical indications in question will be differentiated from each other; are determined by taking into account the need to ensure equitable treatment of the producer concerned and that the public is not misled.
- Protection to a geographical indication as against another geographical indication which, although literary true as to the country, territory, region or locality in which the goods originate, falsely represents to the public that the goods, originate in another country, territory, region or locality;
- Exception for prior use i.e., where a trade mark has been applied for or registered in good faith, or where rights to a trade mark have been acquired through use in good faith either before the commencement of this Act or before the geographical indication is protected in its country of origin, this Act shall not prejudice the registrability or the validity of the registration of the trade mark, or the right to use the trade mark, on the basis that such a trade mark is identical with or similar to a geographical indication;
- Any interested person to institute proceedings in the Court to prevent the use of geographical indications
  - in the course of trade of any means in the designation or presentation of any goods that indicates or suggests, in a manner which misleads the public as to the geographical origin of the goods, that the goods in question originate in a geographical area other than the
true place of origin, or any use in the course of trade which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention;
- any use in the course of trade of a geographical indication which, although literally true as to the country, territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another country, territory, region or locality;
- any use in the course of trade of a geographical indication identifying **wines or spirits** for wines or spirits not originating in the place indicated by the geographical indication in question or a geographical indication identifying **spirits** for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the wines or spirits is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style" or "imitation".

- Special protection for GIs for wines is given under Section 7 of the Act with respect to homonymous geographical indications for wines. In this case, protection shall be accorded to each indication.

- Opposition procedure, where any interested person may, within two months from the date of advertisement of an application for registration, give notice to the Registrar and the applicant of his intention to oppose the application on the grounds that the geographical indication sought to be registered by the applicant does not fall either within the meaning of the definition of "geographical indication" under this Act, or is contrary to public order or morality, or is not or has ceased to be protected in its country of origin; or has fallen into disuse in its country of origin;

- Appeal to the court against the decision of the registrar if the opposition is rejected;

- Right to use a registered GI in the course of trade only to registered producers carrying on their activity in the geographical area specified in the Register;

- Term of a registered geographical indication of 10 years of protection from the date of filling an application and is renewable every 10 years;

The application for a GI registration should include the name, address, nationality of the natural person or legal entity and the capacity of the person who request a registration, a description of the GI, the geographical area, the products covered by the GI, a description of the quality, reputation and of any other characteristics of the GI product.

A few GI related features that form a part of the Trademark Law are:

- No action under section 5 (institution of proceeding for injunction and damages) shall be brought against a person for the use of a trade mark which contains or consists of any geographical indication, after the expiry of five years from the date of such use by that person or his predecessor in title has become generally known in Malaysia; or from the date of registration of the trade mark by that person under the Trade Marks Act 1976 whichever is earlier. However this exclusion shall not apply where the trade mark was used or registered in bad faith.

- Section 14A of Trade Marks Act 1976 provides that: “A trade mark shall not be refused registration by virtue of paragraphs (f) and (g) [concerning geographical indication] of section 14 if the application for its registration had been made in good faith, or if it had been used continuously in good faith in the course of trade by the applicant for its registration or his predecessor in title, either:-

  - before the commencement of the Geographical Indications Act 2000; or
  - before the geographical indication in question is protected in its country of origin."

  However, a trade mark shall not be refused registration by virtue of paragraphs (f) and (g) of section 14 if the geographical indication in question has ceased to be protected; or has fallen into disuse in its country of origin.

Paragraphs (f) refers to a mark or part of a mark which contains or consists of a geographical indication and paragraph (g) refers to a mark for wines which contains or consists of a geographical indication identifying wines, or is a mark for spirits which contains or consist of a geographical indication identifying spirits, not originating in the place indicated by the geographical indication in question.
Section 14 of Trade Marks Act 1976 provides that; “a mark or part of a mark shall not be registered as a trade mark if it contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the mark for such goods in Malaysia is of such a nature as to mislead the public as to the true place of origin of the goods.

Section 14 (1) (g) of Trade Marks Act 1976 provides that: A mark or part of mark shall not be registered as a trade mark if it is a mark for wines which contains or consists of a geographical indication identifying wines, or is a mark for spirits which contains or consists of a geographical indication identifying spirits, not originating in the place indicated by the geographical indication in question.

PERU

GIs for goods that are natural, agricultural, handicraft or industrial goods, but not services in Peru is protected under

- Peruvian Industrial Property Law, Legislative Decree No. 823, April 1996 (Title XV)
- Decree Law 26122, Law for the repression of unfair competition;
- Legislative Decree 716, Consumer Protection Law
- Directorial Resolution N° 72087-DIPI of 1990, which declares PISCO as a Peruvian appellation of origin.

National Institute for the Defense of Competition and Intellectual Property Protection (INDECOPI) under The Ministry of Industry, Tourism, Integration and International Trade Negotiations (INDECOPI) is the designated authority to administer GI in Peru.

The spirit of these laws are to indicate the geographical origin of a product and the qualities and characteristics of the said product, which are exclusively due to the place of origin, including natural and human factors (appellations of origin) and to ensure that objective the Peruvian legal system prevents the following acts:

i) Unauthorized use of the appellation of origin;
ii) Use to distinguish goods not included in the declaration of protection in so far as similar goods are involved or where the use takes undue advantage of the reputation of the appellation of origin;
iii) Any other practice liable to mislead consumers as to the true origin of the product.

MAÍZ BLANCO GIGANTE CUSCO and PISCO are two products that are registered as GI in Peru.

The Law provides:

- Definition of appellations of origin;
- Declaration of recognition to the foreign appellations of origin; Application for the declaration can be made either Via the Lisbon Agreement for European GIs originating from one of the European countries which are members of the Lisbon Agreement (France, Italy, Portugal, Czech Republic, Hungary and Slovakia) or directly towards the National Institute for the Defense of Competition and Intellectual Property Protection (INDECOPI);
- Same process of registering foreign geographical indications as is followed for registration of national appellations of origin;
- An application that has been examined and found suitable for grant to be published in the official gazette;
- No opposition procedure although opposition procedure is available under Decision 486 for 30 days;
- Protection against unauthorized use of the appellation of origin, the use to distinguished products not included in the recognition of protection, when the products are similar or when this products use the reputation of the appellation of origin, any other practice that can mislead the consumer about the true origin of the products, becoming generic;
- No provision on homonymous geographical indications
The right to the GI owner exclusive use of the denominations of origin. The right to use a GI is limited to 10 years. Renewal must be requested 6 months before the expiration date, otherwise the registration will be cancelled;

- Prohibiting the use of the GI name including when used with expressions such as type, like, etc.
- Protection of foreign GI protection subject to reciprocity;
- Non registration of Common or generic terms as an appellation of origin;
- Indefinite term of a registered GI so long as it continues to satisfy all the conditions under which it was registered;
- Legitimate user to initiate proceedings against infringement if the rights to the appellation of origin are infringed through administrative procedures. The competent national office may, ex officio, initiate the administrative procedures against the infringement of those rights.
- Any act of the use of the geographical indication that is likely to mislead the consumers with respect to the place of origin, it will be considered an infringement forbidden by law;
- Refusal or invalidation of a trademark that contains or consists of any geographical indication if is likely to mislead the public.

Appellations of origin for wines and spirits receive an additional protection. According to the Peruvian legal system, these appellations are protected not only against misleading acts, but also against the use of the appellations for wines or spirits not originating in the place indicated by the appellation of origin. The system provides the refusal and invalidation of trademark registrations when they contain a protected appellation of origin of wines and spirits. Also, when they reproduce, imitate, or contain a protected appellation of origin that is liable to create confusion or a mistaken association, or that involve taking unfair advantage of the well-known character of that appellation among the public.

According to Decision 486, the Member Countries of the Andean Community may not prevent continued and similar use of a particular appellation of origin of another country identifying wines and spirits in connection with goods or services by any of their nationals who have used that geographical indication in a continuous manner with regard to the same or related goods or services within the territory of the respective Member Country for at least 10 years preceding April 15, 1994 or, in good faith, preceding that date.

An applicant of GI is expected to provide a set of information that includes Name, domicile, residence and nationality of the applicant or applicants and proof of their legitimate interest, the appellation of origin in respect of the declaration filed, the demarcated geographical area where the production, extraction, or processing of the product to be identified by the appellation of origin takes place, a detailed description of the products that are designated by the appellation of origin, as well as of their characteristics.

USA

In the U.S.A., ‘geographical indications’ are protected under the US Trademark Act as ‘trademarks’, ‘collective marks’ or ‘certification marks’. The term "trademark" includes any word, name, symbol, or device, or any combination thereof...to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

Certain aspects related to wines and spirits are administered under the Administrative Labeling Regulations by US Alcohol and Tobacco Tax and Trade Bureau (TTB) (formerly ATF).

These provide the legal framework for interested parties

- to prevent the use of a GI that indicates or suggests that a good originates in a geographical area other that the true place of origin in a manner that misleads the public as to the geographical origin of the good
- to prohibit the registration of marks which consist of or comprise a geographical indication which, when used on or in connection with wines or spirits, identified a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the TRIPS Agreement enters into force with respect to the United States.

A few of the relevant sections of the Trademark Act of 1946, as Amended, Public Law 79-489, Chapter 540, Approved 5 July 1946; 60 STAT. 427 are as follows:

- Section 2(a), 15 U.S.C. 1052(a) - prohibits registration of marks that consist of or comprise, among other things, "a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines and spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 2(9) of the Uruguay Round Agreements Act) enters into force with respect to the United States.

- Section 2(e)(2), 15 U.S.C. 1052(e)(2) - prohibits registration of marks which, when used on or in connection with the goods of an applicant, are "primarily geographically descriptive" of them. Section 2(e)(2) specifically excludes "indications of regional origin", which are registerable under Section 4, 15 U.S.C. 1054 as collective and certification marks. In addition, where an applicant can demonstrate that a geographic term has become associated with its goods (or services) and thus has acquired distinctiveness with respect to those goods or services, registration is permitted under Section 2(f), 15 U.S.C. 1052(f).

- Section 2(e)(3), 15 U.S.C. 1052(e)(3) - prohibits registration marks which, when used on or in connection with the goods of the applicant, are "primarily geographically deceptively misleading of them".

- Section 4, 15 U.S.C. 1054 - Collective and certification marks, including indications of regional origin, are eligible for registration.


The Federal Alcohol Administration Act of August 29, 1935, 49 STAT. 977, 27 U.S.C. 201 et. Seq. in Section 105(e), 27 U.S.C. 205(e) prohibits the sale of alcohol beverage products that are not labelled in conformity with regulations intended to prohibit consumer deception and to provide the consumer with adequate information about the entity of the product. Promulgating regulations for the establishment of American viticulture areas are set forth in 27 C.F.R. Part 9.

It may be noted that with regard to federal registration of trademarks, the standards of protection required for wines and spirits under Article 32.2, are not explicitly extended by statute to other products. However, a refusal under Section 2(e)(3), 15 U.S.C. 1052(e)(3), of the Trademark Act [refusal on the basis that a proposed mark is geographically deceptively misleading is an absolute basis for refusal to register a mark for any goods and/or services.

The term of a trademark is 10 years, renewable indefinitely.

From the aforesaid discussion it is clear that:

- geographic terms or signs are not eligible for registration as trademarks if they are geographically descriptive or geographically misleading of the origin of the goods/services. If a term is misleading for the goods/services referred to, the consumers would be confused, misled and/or deceived by the use of the term on goods/services that do not come from the place as identified. However, the USPTO makes certain exceptions to the rule. In the case that any geographic term or sign has been used in a manner as to identify the source of the goods/services and in doing so, along the course of time, the consumers using such goods or utilizing such services begin to recognize that particular sign or mark as an identification for a particular company or manufacturer or group of producers. In such an instance, the geographic sign not only describes where the goods/services come from, but, it also describes the "source" of the goods/services. At that point, the sign has "secondary meaning" or "acquired distinctiveness." Thus, The 'primary meaning' to consumers is the geographic place, whereas the 'secondary meaning' to consumers is the producing or manufacturing source. If the descriptive term has a "secondary meaning" to consumers, the term has a source-identifying capacity and is protectable as a trademark

- The geographic names or signs--which otherwise would be considered primarily geographically descriptive and therefore ineligible for registration as trademarks or collective marks without a
showing of acquired distinctiveness in the United States--can be registered as certification marks. As it is a part of the trademark system, it allows for registration of geographical indications that are not merely place names, but signs such as words, slogans, designs, 3-Dimensional marks, colors or even sounds and scents.

- GIs can be registered as Collective Marks such as (1) collective trademarks or collective service marks and (2) collective membership marks.

Names like IDAHO POTATOES, Real California Cheese and Design, certification mark for cheese or Florida sunshine tree: certification mark for oranges, or VIDALIA ONIONS, or NAPA VALLEY Reserve and Design as certification mark for still wines and sparkling wines, Pride of New York and Design, certification mark for agricultural products which are produced or processed in New York, Ohio River Valley, a recognized viticulture area or WASHINGTON STATE APPLES are used in the United States and are protected as certification marks under U.S. trademark laws against unfair competition and trademark infringement, whether or not they are registered with the USPTO.

The following are examples of geographical indications of foreign countries that have been protected in the USA:

- **BRUNELLO DI MONTALCINO** (U.S. Reg. No. 1,860,163) - Italy
- **COGNAC** (Common-law, unregistered geographical indication certification) - France
- **LIEBFRAUMILCH** (U.S. Reg. No. 1,008,251) - Germany
- **MOSEL** (U.S. Reg. No. 1,008,252) - Germany
- **VINO NOBILE DI MONTEPULCIANO** (U.S. Reg. No. 2,251,165) - Italy
- **DARJEELING** (U.S. Reg. No. 2,685,923) - India
- **JAMAICA BLUE MOUNTAIN COFFEE** (U.S. Reg. No. 1,414,598) - Jamaica

As per the USPTO, the registration of the geographical indication on the Principal Register of the USPTO provides several advantages, e.g.,

- constructive notice to the public of the registrant's claim of ownership of the mark;
- a legal presumption of the registrant's ownership of the mark and the registrant's exclusive right to use the mark nationwide on or in connection with the goods/services listed in the registration;
- the ability to bring an action concerning the mark in federal court;
- the use of the U.S registration as a basis to obtain registration in foreign countries; and
- the ability to file the U.S. registration with the U.S. Customs Service to prevent importation of infringing foreign goods.

**Rules for opposition and cancellation**

If a party would be aggrieved by the registration of a trademark, service mark, certification mark or collective mark or would be damaged by the continued existence of a U.S. registration, that party may institute a proceeding at the TTAB, an administrative body at the USPTO. The TTAB has jurisdiction over opposition and cancellation proceedings as well as over appeals from an examining attorney's final refusal to register a mark in an application.

An opposition is a proceeding in which the plaintiff seeks to prevent the issuance of a registration of a mark on the Principal Register. "Any person who believes that he would be damaged by the registration" of a mark may file an opposition thereto, but the opposition may be filed only in response to the publication of the mark during the application in the Official Gazette of the USPTO. A cancellation proceeding is a proceeding in which the plaintiff seeks to cancel an existing registration of a mark. The proceeding may only be filed after the issuance of the registration. A petition for cancellation may be filed by "any person who believes that he is or will be damaged by the registration" of the mark.

The losing party at the TTAB level may appeal the TTAB's decision to the Court of Appeals for the Federal Circuit, a court with jurisdiction, *inter alia*, over intellectual property matters. From that court, the losing party may appeal to the U.S. Supreme Court.
With respect to protection of geographical indication certification marks, affected parties can oppose registration or seek to cancel registrations, all within the existing trademark regime in the United States. So, if a party believes that the certifier is not following its own standards or is discriminating by denying use of the mark to a qualified party, that party can file an opposition or cancellation proceeding against the certification mark or an action in federal court.

**AUSTRALIA**

In Australia, the framework for the protection and enforcement of geographical indications against unfair competition with specific stipulations prohibiting and conduct, which would mislead or deceive or likely to mislead or deceive the public regarding the place of origin of goods or the nature, characteristics or suitability of any goods and services include:

- Australian Wine and Brandy Corporation (AWBC) Act 1980, and Regulations AWBC Administrative Guidelines covering: Process for Registration and Setting of Conditions for Geographical Indications of Foreign Countries; Process for Registration for Geographical Indications of Agreement Countries; Process for Cancellation of Geographical Indications for Foreign and Agreement Countries
- Trade Marks Act 1995 and Regulations
- Trade Practices Act 1974
- State provisions such as the Liquor and Accommodation Act 1990 (Tasmania), and Fair Trading Acts of States and Territories
- Truth in labeling legislation such as the Commerce (Trade Descriptions) Act 1905, and Regulations
- Common law tort of passing off
- Australia New Zealand Food Standards Code
- The various state and territory Food Acts supply protection for all foods.

Geographical indications may be registered under Australian trade mark legislation as certification trade marks that indicate origin with the term signifying a link between the origin of goods and their essential quality, reputation etc to ensure

- the exclusive use of the term for those entitled to it.
- that consumers are not mislead as to the true origin of goods and services.

The protection is for 10 years which is renewable indefinitely upon payment of renewal fees.

Australia introduced Part VIB of the Australian Wine and Brandy Corporation Act 1980 (Cth) (AWBC Act) on 16 December 1993. Under that Act, the Geographical Indications Committee (GIC) was established, as was the Register of Protected Names. The Act made it an offence to knowingly sell wine with a false or misleading package and deemed the package to be false or misleading in certain circumstances, by reference to words or expressions included in the Register of Protected Names.

Regulations were made under the AWBC Act in December 1993 (AWBC Regulations) that, among other things, set out the so called “blending rules” and a schedule of European GIs and TEs that were to be phased out on certain dates. Then, on 4 October 1994, further regulations were introduced setting out the criteria that the GIC is to have regard to in determining a GI in relation to any particular region.

**Definition of GI under the Australian legislation**

The term ‘geographic indications’ in defined under the Trade Marks Act 1995, the Australian Wine and Brandy Corporation Act 1980 and the Australian Food Standards Code Spirit Standard (P3).

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As per Section 6 Trade Marks Act 1995:

"geographical indication', in relation to goods originating in a particular country or in a region or locality of that country, means a sign recognised in that country as a sign indicating that the goods:

"(a) originated in that country, region or locality; and

"(b) have a quality, reputation or other characteristic attributable to their geographical origin."

Section 4 of the Australian Wine and Brandy Corporation Act 1980 states that:

"geographical indication', in relation to wine, means:

"(a) a word or expression used in the description and presentation of the wine to indicate the country, region or locality in which the wine originated; or

"(b) a word or expression used in the description and presentation of the wine to suggest that a particular quality, reputation or characteristic of the wine is attributable to the wine having originated in the country, region or locality indicated by the word or expression."

The Australian Food Standards Code Spirit Standard (P3) within Clause 12(g)(i) states that,

"For the purpose of this sub clause a 'geographical indication' is any indication, whether express or implied, which identifies a spirit as originating in a particular country, locality or region, where a given quality, reputation or other characteristic of the spirit is essentially attributable to its origin in that particular country, locality or region."

Criteria for determination of GI

There are specific criteria laid down for conferring and mark as a 'geographic indication'.

The Australian Wine and Brandy Corporation Regulations (AWBC) as per Regulation 25 contain criteria for determining geographical indications for wines.

This regulation list out the following criteria:

(a) Whether the area falls within the definition of a sub-region, a region, a zone or any other area;

(b) The history of the founding and development of the area, ascertained from local government records, newspaper archives, books, maps and other relevant material;

(c) The existence in relation to the area of natural features, including rivers, contour lines and other topographical features;

(d) The existence in relation to the area of constructed features, including roads, railways, towns and buildings;

(e) The boundary of the area suggested in the application to the Committee under section 40R;

(f) Ordinance survey map grid references in relation to the area;

(g) Local government boundary maps in relation to the area;

(h) The existence in relation to the area of a word or expression to indicate that area, including:
- Any history relating to the word or expression; and
- Whether, and to what extent, the word or expression is known to wine retailers beyond the boundaries of the area; and
- Whether, and to what extent, the word or expression has been traditionally used in the area or elsewhere; and
- The appropriateness of the word or expression;

(i) The degree of discreteness and homogeneity of the proposed geographical indication in respect of the following attributes:
- The geographical formation of the area;
- The degree to which the climate of the area is uniform, having regard to the temperature, atmospheric pressure, humidity, rainfall, number of hours of sunshine and any other weather conditions experienced in the area throughout the year;
- Whether the date on which harvesting a particular variety of wine grapes is expected to begin in the area is the same as the date on which harvesting grapes of the same variety is expected to begin in neighboring areas;
- Whether part or all of the area is within a natural drainage basin;
- The availability of water from an irrigation scheme;
- The elevation of the area;
- Any plans for the development of the area proposed by Commonwealth, State or municipal authorities;
- Any relevant traditional divisions within the area;
- The history of grape and wine production in the area.

Further Regulation 24 of the AWBC Regulations contains definitions of "region", "sub region", "wine grape vineyard" and "zone".

In accordance with the provisions and regulations of the AWBC Act, "Adelaide Hills", "Langhorne Creek", "McLaren Vale", "Great Southern", "Orange" and "Hilltops" are some examples of geographic indications registered for wines.

They have been entered into Part (a) of the Register of Protected Names (RPN) which is maintained as per the provision of Section 40ZC of the AWBC Act.

Eligibility for application

Section 40R of the AWBC Act permits any of the following to apply for the determination of a geographical indication in relation to a region or locality in Australia:

(a) A declared winemakers organization;
(b) A declared wine grape growers organization;
(c) An organization representing winemakers in a State or Territory;
(d) An organization representing growers of wine grapes in a State or Territory;
(e) A winemaker;
A grower of wine grapes.

This application is to be in writing and to the Geographic Indication Committee.

The application is to be as per the provisions of Regulation 25(h) of the AWBC Regulations, which requires the proof of an existence of the relation of the name sought with the corresponding geographical area, including any history of the word or expression, the appropriateness and traditional use of the word within the local area or otherwise.

The Australian Wine and Brandy Corporation Act 1980 includes provisions (section 40D(5)) that provide that a description and presentation is not false merely because it includes an homonymous GI. Homonymous GIs are dealt with on a case by case basis. For example certain overlapping GIs have been registered (for example, Australia has determined that “Pyrenees” as an Australian GI (for Southern Victoria) and has also agreed to protect the French GI "Pyrenees.

Procedure for registration of recognition of a geographical indication

The following steps are followed upon the receipt of an application as per Regulation 25 of the AWBC Regulations:

- The Geographic Indication Committee (GIC) formulates an interim determination' after consultation with the declared winemaker organization and grape grower organizations or any such other organizations as the Committee would think.
- The 'interim determination' is then published in the Commonwealth Gazette Government Notices and the local newspaper.
- All interested parties within one month of the 'interim determination' being published have to make submissions to the GIC in respect of the determination.
- As per Section 40V of the AWBC Act, the notice of "interim determination" does not impose limitations on who is able to make submissions on the determination.
- Following the assessment and evaluation of the submissions made, the GIC verifies with reference to the submissions made, if any of the provisions of the application concerning the 'interim' should be modified.
- Consequently, the GIC would publish in the Commonwealth Gazette Government Notices and local newspaper a "final determination".
- Once the 'final determination' has been published, any further submissions of any opposition are to be made under the (Commonwealth) Administrative Appeals Tribunal Act 1975 to the Administrative Appeals Tribunal (AAT) within a period of 28 days of the publication of the "final determination".
- Application to the AAT for a review of the "final determination" must be made by or on behalf of any person whose interests are affected by the determination, as provided in the AWBC Act.
- The Tribunal will analyze the ‘final determination’ with reference to the submissions made to them and will announce their final decision regarding the matter, following which the "final determination" is entered in to the RPN.
- This "final determination" becomes effective on the day on which particulars of the determination are included in the RPN.
- Once the ‘final determination’ becomes effective, any further submissions of opposition received by the GIC will usually be referred to the original applicant.

Within the realm of the Trade Marks Act, 1995, any person has the power to oppose the registration of a trademark on the grounds that the mark contains or consists of a geographical indication where the goods in respect of which the mark is to be used do not originate in the region of the geographical indication. However, the geographical indication, which has been opposed, should be in the present use for the designated goods in the country where the designated goods originate. All the oppositions have to file with evidence in support of the submissions made. However, none of the Australian legislation or regulations regarding geographical indications allows geographical indications to be licensed.

Enforcement

With reference to the wine industry, the AWBC, monitors geographical indications compliance through its audit and export approval programs. Part VIA of the AWBC Act relates to record keeping and inspection powers, while Part VIB (Division 2) relates to the presentation of wine for sale, export and import.
However, there are different supervision methods that pertain to the monitoring of spirits at the border, and those which are on the domestic market.

At the **border**, the inspectors of the Australian Quarantine Inspection Service (AQIS) under the Imported Foods Control Act 1992 are responsible for ensuring that spirits being imported into Australia comply with the provisions on geographical indications in the Australian Food Standards Code Spirit Standard. In case of any inconsistency with any of the provisions concerning geographic indications relating to any of the imported products, the producer of the product would either have to make sure that the product is in compliance with the GI provisions or the products will have to be re-exported or destroyed.

At the **domestic level**, with respect to spirit standards, the enforcement and maintenance of food standards and GI compliance is the responsibility of state health authorities of the state governments. There are several state and territory Food Acts which have been enacted. These bodies have the authority to institute legal proceedings in the event of an alleged contravention of food standard provisions.

The Australian Competition and Consumer Commission (ACCC) is responsible for identifying breaches and potential breaches of the Trade Practices Act with references to other goods. They deal with the information and complaints they receive through consumers, intelligence agencies, media reports in newspapers, trade journals, newsletters, radio, television etc.

**Objections to the grant of a geographical indication**

The fundamental reason for an objection to grant of a trademark containing a geographical indication is that the geographical indication is an appropriate description for goods produced in a particular region, and therefore, such indications would have to be used by others from that region to describe their respective goods. Hence having a geographical indication as part of the trademark will not be instrumental in making a distinction between the goods of producers of the same product from the same region.

Opposition to registration of trademark may be initiated on the grounds that the trademark contains or consists of a sign that is a geographical indication and the goods in respect of which the mark is to be used do not originate in the region of the geographical indication.

In the case that a trademark has already been registered, the Trade Marks Act provides for an aggrieved party to apply to have the registration cancelled, removed or amended on some pertinent grounds including those mentioned earlier such as having a geographic indication as a part of the trade mark or that the mark is deceptive in nature and hence misleading or likely to mislead the public.

**EUROPE**

The document titled “Protection of geographical indications, designations of origin and certificates of specific character for agricultural products and foodstuffs: Working document of the commission services guide to community regulations March 2004” elaborates the requirements within the EU. However one has to read this in conjunction with the amendments in 1996, which are available on [http://ec.europa.eu/comm/agriculture/foodqual/protec/thirdcountries/index_en.htm](http://ec.europa.eu/comm/agriculture/foodqual/protec/thirdcountries/index_en.htm)

Prior to 1992, each member state of the EU adopted their own approach through various legislations for the protection and enforcement of Geographical Indications.

European rules on geographical indications as of now only relate to agricultural products. This is largely due to the fact that the rules for protecting geographical indications were based on the common agricultural policy rather than the rules on harmonizing internal trade. The first regulations were issued in the field of wines and spirits. These are:

Council Regulation 823/87 (for wines); 1 and
Council Regulation 1576/89 (for spirits).2


The most comprehensive rules on the protection of geographical indications outside the sphere of alcoholic drinks can be found in Council Regulation No. 2081/92 of 14 July 1992, as amended by Council Regulation No. 692/2003 of 8 April 2003.
The Council Regulation 2081/92 is a regional regulation binding all the members of the European Community on the protection of GIs and designations of origin for agricultural products and foodstuffs.

The Regulation applies to Geographical indications of agricultural products intended for human consumption with the exception of wines and spirits. Products that are covered by the Regulation are listed in Annexes I and II of the Regulation. The Annexes basically cover all kinds of foods, plus beverages such as beer, natural mineral waters (deleted from the Annex I by amendment in 2003), and beverages made from plant extracts, and certain agricultural products such as hay, essential oils, wool or cork. From 1993, more than 700 names were registered under Regulation 2081/92, including over 150 cheeses, 150 fresh or processed fruit or vegetables, 160 meat and meat-based products and 80 types of olive oil.

It may be noted at this point, that pursuant to the decision of the WTO Dispute Settlement Panel on the matter of whether the EU Regulation 2081/92 was consistent with regard to the rules of the TRIPS, the Regulation 2081 was repealed and amended. The amended Regulation 510/2006 adopted on 20 March came into force on 31 March 2006. It is designed to ensure that the Community regulation on registering GIs and designations of origin implements the recommendations of the WTO Dispute Settlement Body. Accordingly, the EC was required to amend the Regulation with respect to the equivalence and reciprocity conditions so as for those conditions apply to the procedures for registration of GIs located in other WTO Members.

The European Union system provides for multiple types of geographical indications, including the Protected Designation of Origin (PDO), the Protected Geographical Indication (PGI), and the Traditional Specialty Guaranteed (TSG).

**Protected Designations of Origin (PDO)**

A Protected Designation of Origin has been defined under Article 2(2)(a) of the Regulation as to imply a specific place by way of the name of the region being used to describe an agricultural product or foodstuff that:

a) it originates in that region,
b) it derives its quality or characteristics essentially or exclusively from this geographical environment with its inherent natural and human factors, and
c) the production, processing and preparation of which takes place in that defined geographical area.

However as per Article 2(3) even non-geographical and traditional names can be designated as PDO. The most common example is “Stilton” cheese, originating from England or “Feta” cheese produced in Greece. There is no place called “Stilton” or “Feta”.

Concerning the definitional breadth of the specified geographic area related to a PDO, Case T-109/97 in the European Court of Justice (ECJ) concerned the PDO ‘Altenburger Ziegenkäse’ (goat cheese made in the Altenburg region, which must contain a minimum percentage of goats’ milk), which was registered by Germany.

**Protected Geographical Indications**

A Protected Geographical Indication (PGI) has been defined under Article 2(2)(b) of the Regulation as to imply the specific place or a country by the name of the region, which is used to describe an agricultural product or a foodstuff that

a) it originates in that region, and
b) it possesses a specific quality, reputation or other characteristics which would be attributable to that geographical origin, and
c) the production and/or processing and/or preparation of which takes place in that defined geographical area.

Thus, designations of origin require a more intensive connection between quality and provenance, while geographical indications do not necessarily have to derive their qualities from the soil as such.

To register a geographical indication in the European system, producers must file an application with the European Union Member State from which the product originates. The Member State gives the application an initial review and then passes the application on to the European Commission and the other
Member States. The geographical indication is published in an official journal for a probationary period. Barring objections, the product is then registered as a geographical indication, but may be subject to revocation if the procedures were not properly followed.

According to the regulation, it is not possible to register the names of the following products:

- industrial products;
- spirits (which have specific rules under EC regulation 1576/89);
- wine-sector products, except wine vinegar (which have basic rules relating to the description, designation and presentation of wine products in EC regulation 1493/1999 and more specific provisions in several other Commission regulations); and
- mineral waters.

A name cannot be registered as a PDO or PGI if:

- it conflicts with a plant variety or an animal breed that, as a result, is likely to mislead the consumer with respect to the true origin of the product;
- it has become generic;
- its registration is liable to mislead the consumer as to the true identity of the product, in the light of a trademark's reputation and renown and the length of time it has been used.

Relationship to Trade Mark Law

Article 14.1 of the Regulation states that trademarks that have not been registered at the time that the geographical indication has been published for the same or similar products that may lead to confusion or misappropriation of the geographical indication shall be refused.

However, in the case that a specific trademark had been registered prior to the registration of the geographic indication, certain conditions would apply considering each case separately.

1. Where the trademark was registered in bad faith, it is prone to invalidation. At the same time, the exact characterization of bad faith has not yet been clarified. If bad faith would mean knowledge of a geographical location of that name, the provision would be rendered very broad. If bad faith would be knowledge of the existence of an actual geographical indication for conflicting products, the application would be narrower.

2. If the trademark was registered in good faith, Art. 14.2 seem to indicate coexistence between the trademark and the geographical indication, although the exact character of this co-existence is not clear.

3. Where the trademark has become well-known for products that could also originate from the geographical place, the trademark takes precedence, Art. 14.3. e.g. Tabasco sauce which originates from a Mexican province Tabasco.

Procedure for Registration

Registration is a two-step procedure. First, registration has to be effected on a national level and, subsequently, at the European level. Protection is conditional to the registration of an indication in the European Register. Registration procedures are as follows:

1. The application must contain a specification providing the following details:
   a. the name of the product, (generic names may not be registered)
   b. the product description,
   c. the definition of the geographical area,
   d. a description of the production method,
   e. a description of the link between product and geographical area,
   f. labeling details, and
   g. other requirements that might be stipulated in national law.

2. Either a certain “group” of producers of the product or even individuals may apply for the registration.
3. In the European system, an application must be filed with the member state from which the product seeking registration of the PGI/PDO originated.

4. The application is first examined by the member state to infer if the product meets the criteria laid out for the registration. After satisfactory examination of the application by the member state, it is then passed on to the European Commission and other member states.

5. Once the application is examined by the EC, the product is subsequently published in the *Official Journal of the European Union*. A three-month time period is provided for application of any opposition, if any to the registration of the product. Prior to the legislative changes in 2003, opposition to the application could only be by other member states by way of expressing concern to the member state of residence. However, in view of Art. 22 of the TRIPS Agreement, the right to object has now been broadened and allows natural or legal persons to file oppositions directly. Moreover, third countries or private parties from outside the area of the European Union may raise objections on the basis of reciprocity, i.e. that equivalent rights of opposition are granted to EU residents in that respective country.

6. Subsequently, once the objections are heard or if no objections are filed, the product is registered with the Commission as a GI.

7. After registration, a GI may still be subject to examination if an accusation is made that a producer or processor is failing to meet the required criteria.

8. If the Commission rules that there has been a failure to meet the required standards, the GI may be suspended or withdrawn.

However in view of the amended Regulation 510/2006 adopted on 20 March came into force on 31 March 2006 several changes have been made in the European System which include the following:

1. **Amended registration procedure for PDOs and PGIs from producers in third countries**
   a) The provisions concerning equivalence and reciprocity for products from third countries have been deleted in order to allow names corresponding to geographical areas in those countries to have access to the European system for the protection of GIs.
   b) Registration is open to associations of producers from third countries on proof that the name is protected in its country of origin and foreign applicants will no longer have to seek examination and transmission of applications from their national governments.
   c) From 3 April 2006, applications for registration of PDOs and PGIs from producers in third countries may be made directly with the European Commission on a single form, reducing the time needed for the application and approval process.

2. **Amended objection procedures applicable for groups and individuals in third countries**
   a) Prior to the amendments, oppositions were required to be verified and transmitted by third party governments. Now any natural or legal person having a legitimate interest in a Member State or a third country can to notify their objection to the proposed registration.
   b) From 3 April 2006, objections to applications by groups, organizations or individuals in third countries, can be made directly to the European Commission on a single form statement of objection.

3. **Amended inspection requirements in respect of third country registrations**
   a) Prior to the amendment, government participation in the inspection structures was required. Article 11.2, has been amended to allow verification of compliance of the specifications, before placing the product on the market, by one or more public authorities designated by the third country and/or one or more product certification bodies.

In 1959 an advertising company created the character Juan Valdez to promote Colombian coffee. In 1982, the mark was registered by the Federación Nacional de Cafeteros de Colombia for 100% Colombian coffee. Individual companies could use the logo by entering into a trademark licensing agreement and all uses of the mark had to be approved by the Federation subject to quality controls every 3 months. This mark could be used in addition to individual trademarks of the respective companies. In the 1990s, the federation launched a portfolio of associated trademarks and the logo has achieved a very high recognition in US and European market. In 2004 Café de Colombia was recognized as a geographical indication in Colombia. In June 2005, Café de Colombia was the first foreign Appellation of Origin application received by the European Commission after the amendment of the EU Regulation 2081/92.

Scope of Protection

Article 13 of the Regulation determines the scope of protection only of products (excluding services) registered under the said Regulation. The registered names shall be protected against commercial use of the name for identical or similar products, for other cases of false or misleading use, including translated versions of the name, and against use accompanied by expressions such as “style”, “type”, etc.

Enforcement

The European Union is largely dependant on each of its member states to monitor and enforce the protection of the GIs registered within their respective borders. However, though there is no fixed model of enforcement, there is a general framework that is followed by all the member states.

Art. 13 of the Regulation stipulate that member states should provide remedies in cases of infringement of an indication by third parties. However, the enforcement patterns differ in the European system, depending upon if the violation is at a regional or international level.

International level violations

These violations are usually identified at the national level by the authorized government agencies associated with distribution and labeling. Or else, it could be a producer of a protected GI or an association affiliated with that producer that discovers the violation, after which a charge will be brought before the authorities of the country in which the infraction has occurred. The authorities once notified should then proceed to stop the use of that GI by their own guidelines of enforcement. If there is a discrepancy and the violator continues to use the GI, the matter could move into the legal realm to be settled by the courts. Once a case is decided upon, it is up to each country to enforce the courts decision. If a country refuses to comply with the decision, the EC will analyze the violation and issue a letter of complaint if they believe the country is derelict in enforcing an established GI. If the host country of the violator still refuses to comply, then the EC may issue sanctions.

Regional level violations

If a violation occurs within a region, usually protection and enforcement occurs on this level. Most countries have consortiums set up that are responsible for monitoring GIs. The scope and depth of their power depends on each country. Some consortiums are government agencies, while others are private, or a mixture of the two. These groups are generally more hands on when it comes to monitoring and investigating GIs. In fact, many a times these consortiums have inspectors who go on site or in the fields to make sure producers are adhering to the standards of production set forth to label their product as a particular GI. If an infraction occurs, then two courses of action could be taken, depending on the country’s framework of enforcement. The violator could be subject to sanctions from within the body of that consortium but only if the violator is a member of that group. This scenario could be likened to a lawyer being reprimanded by a bar association. If a violator is not a member of the consortium, the case will be brought to the authorities within that country to settle the dispute. This similar action may occur if the consortium lacks the authority itself to issue reprimands to its own members.
Enforcing Geographical Indications in Europe

Cross-border issues in EU countries, stemming from the use of geographical names (a few examples)

<table>
<thead>
<tr>
<th>Complainant</th>
<th>Belgium v. Spain</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Issue</strong></td>
<td>Spanish rules governing the bottling of wines bearing the designation of origin “Rioja”. Belgium considered that those rules which, in particular, require the wine to be bottled in cellars in the region of production in order to qualify for “controlled designation of origin” (denominación de origen calificada) were detrimental to the free movement of goods. Belgium brought the Rome Treaty infringement proceedings before the Court of Justice. The obligation to bottle Rioja wine inside the geographical area identified by the product specification was considered by Belgium as a breach of Art. 34 of the Treaty of Rome which deals with the prohibition of quantity restrictions on exports.</td>
</tr>
<tr>
<td><strong>Decision</strong></td>
<td>The European Court of Justice rejected the claim from Belgium. On the basis of Art. 12 of EU Reg 823/87, ‘member states should be given a certain amount of freedom to specify the wine-making and preparation method for each wine within the framework of the oenological practices permitted in the Community’. The obligation to bottle the wine in the limited geographical area can be an indispensable element for the specificity of the wine produced in that area. Article 16 of the Rome Treaty stipulates that “provisions of Arts. 30 to 34 shall not preclude prohibitions or restrictions on imports, exports or goods in transit justified on grounds of (...) the protection of industrial and commercial property. Such prohibitions or restrictions shall not, however, constitute a means of arbitrary discrimination or a disguised restriction of trade between Member States”. By ensuring that wine growers in the Rioja region controlled bottling as well, the Spanish rules pursued the aim of better safeguarding the quality of the product and, consequently, the reputation of the designation. In the Court’s view, the Spanish rules were to be regarded as compatible with Community law despite their restrictive effects on trade, provided that they constituted a necessary and proportionate means of upholding the reputation enjoyed by the Rioja designation of origin.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Complainant</th>
<th>Consorzio di Parma v. Marks &amp; Spencer</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Issue</strong></td>
<td>To prevent the supermarket chain from selling Parma ham unless it had been sliced and packaged in Italy. It was argued that Parma ham could only be described as Parma ham if it complied with Italian law and that slicing and pre-packaging affected the quality of the ham (passing off action)</td>
</tr>
<tr>
<td><strong>Decision</strong></td>
<td>The UK Court of Appeal dismissed the appeal and the cross-appeal. It was held that there was no misrepresentation as to the nature of the product being sold.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Complainant</th>
<th>Consorzio di Parma v. ASDA Stores Ltd, a British supermarket chain</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>Issue</strong></td>
<td>To prevent the supermarket chain from selling Parma ham unless it had been sliced and packaged in Italy. It was argued that Parma ham could only be described as Parma ham if it complied with Italian law and that slicing and pre-packaging affected the quality of the ham (based on EU regulations).</td>
</tr>
<tr>
<td><strong>Decision</strong></td>
<td>The action failed. The British judge concluded that the EU regulations make Parma ham a protected designation of origin, but do not incorporate the Italian rules on slicing and packaging. Although the Italian rules prohibit the sale of Parma ham which has been pre-sliced and packaged in Britain as Parma ham, they do not have direct effect in Britain.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Complainant</th>
<th>Consorzio del Gorgonzola v. the Austrian company Agrasserata</th>
</tr>
</thead>
</table>

**Issue**  
The production by an Austrian company of *Oesterzola* cheese. Consorzio del Gorgonzola was against the use of the suffix *zola*, which could confuse consumers.

**Decision**  
The Loeben Court judges decided that the Austrian company had to stop selling this product. The Vienna Court of Appeal also found for Consorzio del Gorgonzola.

**Complainant**  
Consorzio del Gorgonzola v. an Austrian company

**Issue**  
The marketing in Austria since 1983 of a cheese produced in Germany called *Cambozola*. Consorzio del Gorgonzola asked the Austrian Court of Justice to ban the marketing of this product.

**Decision**  
The EU Court of Justice decided that *Cambozola* is evocative of the Gorgonzola protected designation of origin for two reasons. First, there is a phonetic similarity; secondly, both names refer to the same kind of product, a marbled cheese. Article 13 of EU Reg. 2081/92 states that registered names shall be protected against any misuse, imitation or evocation even if the true origin of the name is indicated (…). But Art. 14 of EU Reg. 2081/92 stipulates that the use of a trademark referring to a geographical name may continue notwithstanding the registration of a designation of origin or geographical indication if it was registered in *good faith* before the date on which application for registration of a designation of origin or geographical indication was lodged. The *Cambozola* mark had been registered as a trademark before the recognition of Gorgonzola as a designation of origin at European level; the role of verifying the presence of *good faith* on the basis of existing national and international legislation falls to the national courts. These courts must also verify whether the mark might mislead consumers regarding the nature, quality and origin of the product. The Austrian company proposed adding three words to the name *Cambozola*, i.e. *Cambozola, German soft cheese*. The Consortium refused this proposal.

**Complainant**  
Consorzio del Gorgonzola v. the German company Kaserei Champignon

**Issue**  
The use of the *Cambozola* mark by this company for a marbled cheese. Consorzio del Gorgonzola was against the use of this mark, since Gorgonzola marbled cheese was registered as a designation of origin at European level.

**Decision**  
The EU Court of Justice decided that *Cambozola* is evocative of the Gorgonzola protected designation of origin for two reasons. First, there is a phonetic similarity; secondly, both names refer to the same kind of product, a marbled cheese. Article 13 of EU Reg. 2081/92 states that registered names shall be protected against any misuse, imitation or evocation even if the true origin of the name is indicated (…). But Art. 14 of EU Reg. 2081/92 stipulates that the use of a trademark referring to a geographical name may continue notwithstanding the registration of a designation of origin or geographical indication if it was registered in *good faith* before the date in which application for registration of a designation of origin or geographical indication was lodged. The *Cambozola* mark had been registered as a trademark before the recognition of Gorgonzola as a designation of origin at European level; the role of verifying the presence of *good faith* on the basis of existing national and international legislation falls to the national courts. These courts must also verify whether the mark might mislead consumers regarding the nature, quality and origin of the product.

The German Court of Justice refused Consortio del Gorgonzola’s petition. Consorzio del Gorgonzola decided to appeal, but the appeal was refused. Eventually, the German Constitutional Court refused the last appeal and use of the name *Cambozola* in Germany was definitively authorised.
CHAPTER 5

GEOGRAPHICAL INDICATIONS SYSTEM IN INDIA

Geographical Indications protection is extremely important and necessary for an agro-based economy like India. Being a WTO member country and signatory to TRIPS, the Parliament of India passed the Geographical Indications of Goods (Registration and protection) Act 1999. The Act defines geographical indications, provides for the registration and better protection of GIs relating to goods, makes provisions for a GI registry, and elaborates on the concept of authorized user and registered proprietor and higher level of protection for notified goods. While the Act does not make provision for individual ownership, any association of persons or producers or any organization or authority representing the interest of the producers of the concerned goods can apply for registration in accordance with the provisions of Section 11 of the Act. It also provides for civil and criminal remedies for infringements. This Act came into force with effect from September 2003.

Definitions

“Geographical indication”, in relation to goods, means an indication which identifies such goods as agricultural goods, natural goods or manufactured goods as originating, or manufactured in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of such goods is essentially attributable to its geographical origin and in case where such goods are manufactured goods one of the activities of either the production or of processing or preparation of the goods concerned takes place in such territory, region or locality, as the case may be.

Explanation: - For the purposes of this clause, any name which is not the name of a country, region or locality of that country shall also be considered as the geographical indication if it relates to a specific geographical area and is used upon or in relation to particular goods originating from that country, region or locality, as the case may be;

“Goods” means any agricultural, natural or manufactured goods or any goods of handicraft or of industry and includes foodstuff.

“Indication” includes any name, geographical or figurative representation or any combination of them conveying or suggesting the geographical origin of goods to which it applies.

“Registered proprietor” in relation to a geographical indication, means any association of persons or of producers or any organization for the time being entered in the register as proprietor of the geographical indication.

“Producer”, in relation to goods, means any person who:-

(i) if such goods are agricultural goods, produces the goods and includes the person who processes or packages such goods;

(ii) if such goods are natural goods, exploits the goods;

(iii) if such goods are handicraft or industrial goods, makes or manufactures the goods,

and includes any person who trades or deals in such production, exploitation, making or manufacturing, as the case may be, of the goods.

GIs can be granted to an individual, a family, a partnership, a corporation, a voluntary association etc or any organization or authority established by or under any law for the time being in force representing the interest of the producers of the concerned goods.

Registry

GI Registry at Chennai has jurisdiction in India. The address is “Geographical Indications Registry, Intellectual Property Rights Building, G.S.T. Road, Guindy, Chennai 600 032. Phone: 044 – 22502091-93 & 98, Fax: 044–22502090. E-mail: gir-ipo@nic.in."
The Controller-General of Patents, Designs and Trade Marks appointed under sub-section (1) of Section 3 of the Trade Marks Act, 1999, shall be the Registrar of Geographical Indications. Registry maintains a Register of GI which is divided into two parts: Part A and Part B.

**Part A** contains details of distinguishing characteristics of the goods and of the registered proprietor which would be an association of persons or producers or a body representing interest of such producers like for instance the Tea Board, Coffee Board, Spices Board etc. To include all producers a collective reference may be made in the application.

**Part B** contains particulars of ‘authorized users’ of GI such as those producers (traders and dealers) who have not been included in the original application for registration. A producer of goods can apply for registration as an authorized user, with respect to a registered Geographical Indication. He should apply in writing in the prescribed form along with the prescribed fee.

**Procedure to apply for registration of GI**

The process comprises of filing an application with the registry, getting it examined, followed by office actions for its acceptance or refusal. The Registrar, who may consult an expert group to verify the technical details, examines the application. Thereafter the Examination report is issued to which the Applicant files a reply and on satisfaction the Registrar accepts the Application. The accepted application is then published in the GI journal. It is also possible to do online filing of GI application visit www.girindia.in or www.ipindia.nic.in

Any person can file a 'Notice of Opposition' within a maximum period of four months of publication in the Journal. The matter is then referred to the applicant of the GI followed by a set of proceedings that includes reply, evidence and hearing before the Registry. If the opposition is dismissed, the application will proceed to registration in Part A of the Register unless the Central Government otherwise directs. A certificate of registration is then issued. The process is depicted in the figure below:

### How to register?

**Registration fee – Rs. 5000/-**

- **Filing an application**
- **Examination**
- **Objections**
- **Opportunity for hearing**
- **Refused**
- **Acceptance**
- **Appeal to IPAB**
- **Rejected**
- **Publication in GI journal (4 months wp)**
- **No Opposition**
- **Issuance of registration certificate**

**Effect of Registration**

- It's prima facie proof of the ownership of the GI, and its validity thereof and is admissible in all courts in India without further proof or production of the original.

**Rights conferred by Registration**

1. To the producers entered in Part B (Authorized user) the exclusive right to the user of the registered GI
2. To both the producers and the registered proprietor the right to obtain relief in respect of infringement of the GI in the manner provided by the act.
The details that need to be included in the application for registration of GI are:

- How the indication serves to designate the goods as a Geographical Indication?
- The Class of goods
- The territory
- The particulars of appearance
- Particulars of producers
- An affidavit of how the applicant claim to represent the interest
- The standard bench mark or other characteristics of the geographical indication
- The particulars of special characteristic
- Textual description of the proposed boundary
- The growth attributes in relation to the G.I. pertinent to the application;
- Certified copies of the map of the territory
- Special human skill involved, if any
- Number of producers; and
- Particulars of inspection structures, if any, to regulate the use of geographical indication.

A homonymous geographical indication (i.e., where the name of two identical locations in different countries are both protected as geographical indications) may be registered under this Act, if the Registrar is satisfied, after considering the practical conditions under which the homonymous indication in question shall be differentiated from other homonymous indications and the need to ensure equitable treatment of the producers of the goods concerned, that the consumers of such goods shall not be confused or misled in consequence of such registration.

Prohibitions

The following shall not be registered as geographical indication:

a) the use of which would be likely to deceive or cause confusion; or
b) the use of which would be contrary to any law for the time being in force; or
c) which comprises or contains scandalous or obscene matter; or
d) which comprise or contains any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India; or
e) which would otherwise be disentitled to protection in a court; or
f) which are determined to be generic names or indications of goods and are, therefore, not or ceased to be protected in their country of origin, or which have fallen into disuse in that country; or
g) which although literally true as to the territory, region or locality in which the goods originate, but falsely represent to the persons that the goods originate in another territory, region or locality, as the case may be.

For the purposes of the prohibitions, “generic names or indications” in relation to goods, means the name of goods which, although relates to the place or the region where the goods was originally produced or manufactured, has lost its original meaning and has become the common name of such goods and serves as a designation for or indication of the kind, nature, type or other property or characteristic of the goods.

Further in the determination of whether the name has become generic, account shall be taken of all factors including the existing situation in the region or place in which the name originates and the area of consumption of the goods.

Term of GI

The Registration of a Geographical Indication is for a period of Ten Years. Renewal is possible for further periods of 10 years each. If a Registered geographical indication is not renewed, it is liable to be removed from the register.
**Application of GI to Goods**

Application of GI to Goods by a person takes place when he:

(a) applies it to the goods themselves; or  
(b) applies it to any package in or with which the goods are sold, or exposed for sale, or had in possession for sale or for any purpose of trade or manufacture; or  
(c) places, encloses or annexes any goods which are sold, or exposed for sale, or had in possession for sale or for any purpose of trade or manufacture, in or with any package or other thing to which a geographical indication has been applied; or  
(d) uses a geographical indication in any manner reasonably likely to lead to the belief that the goods in connection with which it is used are designated or described by that geographical indication; or  
(e) in relation to the goods uses a geographical indication in any sign, advertisement, invoice, catalogue, business letter, business paper, price list or other commercial documents and goods are delivered to a person in pursuance of a request or order made by reference to the geographical indication as so used.

Further a geographical indication shall be deemed to be applied to goods whether it is woven in, impressed on, or otherwise worked into, or annexed or affixed to, the goods or to any package or other thing.

**Falsification and False Application of GI**

Falsification includes

- making that geographical indication or deceptively similar geographical indication without the assent of the authorized user of the geographical indication;  
- altering, adding, effacing or otherwise falsifying any genuine geographical indication

A person shall be deemed to falsely apply to goods a geographical indication who, without the assent of the authorized user of the geographical indication,-

(a) applies such geographical indication or a deceptively similar geographical indication to goods or any package containing goods;  
(b) uses any package bearing a geographical indication which is identical with or deceptively similar to the geographical indication of such authorized user, for the purpose of packing, filling or wrapping therein any goods other than the genuine goods of the authorized user of the geographical indication.

**Infringement of GI**

The Act provides that once the GI is registered, an infringement action can be initiated both by the registered proprietor and by authorized users whose names have been entered on the Register. A registered GI is infringed by a person who not being an authorized user, uses such GI by any means in the designation or presentation that indicates or suggests that such goods originates in a geographical area other than the true place of origin of such goods in a misleading manner or uses a GI which constitutes an act of Unfair competition

(1) A registered geographical indication is infringed by a person who, not being an authorized user thereof,-

- uses such geographical indication by any means in the designations or presentation of goods that indicates or
- suggests that such goods originate in a geographical area other than the true place of origin of such goods in a manner which misleads the persons as to the geographical origin of such goods; or

- uses any geographical indication in such manner which constitutes an act of unfair competition including passing off in respect of registered geographical indication.  
  “Act of unfair competition” means any act of competition contrary to honest practices in industrial or commercial matters. Following acts shall be deemed to be acts of unfair competition, namely:-
(i) all acts of such a nature as to create confusion by any means whatsoever with the establishment, the goods or the industrial or commercial activities, of a competitor;
(ii) false allegations in the course of trade of such a nature as to discredit the establishment, the goods or the industrial or commercial activities, of a competitor;
(iii) geographical indications, the use of which in the course of trade is liable to mislead the persons as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods;
(c) uses another geographical indication to the goods which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the persons that the goods originate in the territory, region or locality in respect of which such registered geographical indication relates.

(2) The Central Government may, if it thinks necessary so to do for providing additional protection to certain goods or classes of goods under sub-section (3) below, by notification in Infringement Or registered geographical indications the Official Gazette, specify such goods or class or classes of goods, for the purposes of such protection.

(3) Any person who is not an authorized user of a geographical indication registered under this Act in respect of the goods or any class or classes of goods as indicated in sub-section (2) above, uses any other geographical indication to such goods or class or classes of goods not originating in the place indicated by such other geographical indication or uses such other geographical indication to such goods or class or classes of goods even indicating true origin of such goods or uses such other geographical indication to such goods or class or classes of goods in translation of the true place of origin or accompanied by expression such as “kind”, “style”, “imitation”, or the like expression, shall infringe such registered geographical indication.

(4) Further, where the goods in respect of which a geographical indication has been registered are lawfully acquired by a person other than the authorized user of such geographical indication, further dealings in those goods by such person including processing or packaging, shall not constitute an infringement of such geographical indication, except where the condition of goods is impaired after they have been put in the market.

Penalties / Remedies

The Act provides for both civil and criminal remedies for falsification / infringement.

The civil includes imposition of fines, forfeiture to government of all goods and things means of which the offence had been committed, damages, account of profit, together with or without any order for delivery of the infringing label and indications for destruction or erasure.

The criminal remedies include imposition of fine or imprisonment or both.

GI and TM

The Act prohibits registration of GI as a trade mark. The Registrar of Trade Marks shall suo motu or at the request of interested party refuse or invalidate the registration of a trade mark which consists of a GI with respect to goods not originating in the territory which such GI indicates, if use of such a GI as a trade mark would confuse or mislead the public as to the true origin of the goods. However, the Act protects use of trademarks that consists of a GI where it is registered in good faith under the Trade Marks Act or where the right to such trade mark was acquired prior to coming in to force of the Act.

The Act makes no difference between an Indian GI or a foreign GI.

As of December 11th 2008, 149 applications were received relating to agricultural, handicraft, industrial or manufactured goods and food products and of those 104 applications have been granted registration and the remaining are in various stages of the process.  

31 [Information acquired from the GI Registry in Chennai, India].
The table below lists the registration details of GI Applications that have been registered in India.

**REGISTRATION DETAILS OF G.I APPLICATIONS IN INDIA  2003 – 2008**

Information Provided by the Geographical Indications Registry, Chennai, India

<table>
<thead>
<tr>
<th>S. No</th>
<th>Application No.</th>
<th>Geographical Indications</th>
<th>Product</th>
<th>State</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>1 &amp; 2</td>
<td>Darjeeling Tea (word &amp; logo)</td>
<td>Tea</td>
<td>West Bengal</td>
</tr>
<tr>
<td>2</td>
<td>3</td>
<td>Aranmula Kannadi</td>
<td>Handicrafts</td>
<td>Kerala</td>
</tr>
<tr>
<td>3</td>
<td>4</td>
<td>Pochampalli Ikat</td>
<td>Textiles</td>
<td>Andhra Pradesh</td>
</tr>
<tr>
<td>4</td>
<td>5</td>
<td>Salem Fabric</td>
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<tr>
<td>5</td>
<td>7</td>
<td>Chanderi Fabric</td>
<td>Textiles</td>
<td>Madhya Pradesh</td>
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<td>8</td>
<td>Solapur Chaddar</td>
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<td>7</td>
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<td>Solapur Terry Towel</td>
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<td>10</td>
<td>Kotpad Handloom fabric</td>
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<td>9</td>
<td>11</td>
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<td>10</td>
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<td>Kota Doria</td>
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<tr>
<td>11</td>
<td>13 &amp; 18</td>
<td>Mysore Agarbathi</td>
<td>Incense Sticks</td>
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<td>15</td>
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<td>Textiles</td>
<td>Tamil Nadu</td>
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<td>16</td>
<td>Bhavani Jamakkalam</td>
<td>Textiles, Carpets</td>
<td>Tamil Nadu</td>
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<td>Textiles</td>
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<td>Channapatna Toys &amp; Dolls</td>
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<td>Andhra Pradesh</td>
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<td>31</td>
<td>Kasuti Embroidery</td>
<td>Embroidery (Textiles)</td>
<td>Karnataka</td>
</tr>
<tr>
<td>26</td>
<td>32</td>
<td>Mysore Traditional Paintings</td>
<td>Paintings</td>
<td>Karnataka</td>
</tr>
<tr>
<td>27</td>
<td>33</td>
<td>Coorg Orange</td>
<td>Horticulture Product</td>
<td>Karnataka</td>
</tr>
<tr>
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<td>34</td>
<td>Mysore Betel leaf</td>
<td>Horticulture Product</td>
<td>Karnataka</td>
</tr>
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<td>35</td>
<td>Nanjanagud Banana</td>
<td>Horticulture Product</td>
<td>Karnataka</td>
</tr>
<tr>
<td>30</td>
<td>37</td>
<td>Madhubani Paintings</td>
<td>Paintings</td>
<td>Bihar</td>
</tr>
<tr>
<td>31</td>
<td>44</td>
<td>Kondapalli Bommallu</td>
<td>Handicrafts</td>
<td>Andhra Pradesh</td>
</tr>
<tr>
<td>32</td>
<td>47</td>
<td>Thanjavur Paintings</td>
<td>Paintings</td>
<td>Tamil Nadu</td>
</tr>
<tr>
<td>33</td>
<td>53</td>
<td>Silver Filigree of Karimnagar</td>
<td>Handicrafts</td>
<td>Andhra Pradesh</td>
</tr>
<tr>
<td>34</td>
<td>54</td>
<td>Alleppey Coir</td>
<td>Coir Products</td>
<td>Kerala</td>
</tr>
<tr>
<td>35</td>
<td>55</td>
<td>Muga Silk</td>
<td>Textiles</td>
<td>Assam</td>
</tr>
<tr>
<td>36</td>
<td>65</td>
<td>Temple Jewellery of Nagercoil</td>
<td>Handicrafts</td>
<td>Tamil Nadu</td>
</tr>
<tr>
<td>37</td>
<td>69</td>
<td>Mysore Jasmine</td>
<td>Horticulture</td>
<td>Karnataka</td>
</tr>
<tr>
<td>38</td>
<td>70</td>
<td>Udupi Jasmine</td>
<td>Horticulture</td>
<td>Karnataka</td>
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<td>71</td>
<td>Hadagali Jasmine</td>
<td>Horticulture</td>
<td>Karnataka</td>
</tr>
<tr>
<td>40</td>
<td>17</td>
<td>Navara Rice</td>
<td>Agricultural Products</td>
<td>Kerala</td>
</tr>
<tr>
<td>41</td>
<td>36</td>
<td>Palakkadan Matta Rice</td>
<td>Agricultural Products</td>
<td>Kerala</td>
</tr>
<tr>
<td>42</td>
<td>63</td>
<td>Thanjavur Art Plate</td>
<td>Handicrafts</td>
<td>Tamil Nadu</td>
</tr>
<tr>
<td>43</td>
<td>76</td>
<td>Ilkal Sarees</td>
<td>Textiles</td>
<td>Karnataka</td>
</tr>
<tr>
<td>44</td>
<td>73</td>
<td>Applique – Khatwa Patch Work of Bihar</td>
<td>Handicrafts</td>
<td>Bihar</td>
</tr>
<tr>
<td>45</td>
<td>74</td>
<td>Sujini Embroidery Work of Bihar</td>
<td>Handicrafts</td>
<td>Bihar</td>
</tr>
<tr>
<td>46</td>
<td>75</td>
<td>Sikki Grass Work of Bihar</td>
<td>Handicrafts</td>
<td>Bihar</td>
</tr>
<tr>
<td>47</td>
<td>49 &amp; 56</td>
<td>Malabar Pepper</td>
<td>Agricultural Products</td>
<td>Kerala</td>
</tr>
<tr>
<td>48</td>
<td>50</td>
<td>Allahabad Surkha</td>
<td>Guava</td>
<td>Uttar Pradesh</td>
</tr>
<tr>
<td>49</td>
<td>52</td>
<td>Nakshi Kantha</td>
<td>Textiles</td>
<td>New Delhi</td>
</tr>
<tr>
<td>50</td>
<td>60</td>
<td>Ganjifa cards of Mysore (Karnataka)</td>
<td>Handicrafts</td>
<td>Karnataka</td>
</tr>
<tr>
<td>51</td>
<td>61</td>
<td>Navalgund Durries</td>
<td>Textiles</td>
<td>Karnataka</td>
</tr>
<tr>
<td>52</td>
<td>62</td>
<td>Karnataka Bronze Ware</td>
<td>Handicrafts</td>
<td>Karnataka</td>
</tr>
<tr>
<td>53</td>
<td>77</td>
<td>Molakalmuru Sarees</td>
<td>Textiles</td>
<td>Karnataka</td>
</tr>
<tr>
<td>54</td>
<td>85</td>
<td>Monsooned Malabar Arabica Coffee</td>
<td>Coffee</td>
<td>Karnataka</td>
</tr>
<tr>
<td>55</td>
<td>114</td>
<td>Monsooned Malabar Robusta Coffee</td>
<td>Coffee</td>
<td>Karnataka</td>
</tr>
<tr>
<td>56</td>
<td>72</td>
<td>Spices – Alleppey Green Cardamom</td>
<td>Agricultural Products</td>
<td>Kerala</td>
</tr>
<tr>
<td>57</td>
<td>78</td>
<td>Coorg Green Cardamom</td>
<td>Agricultural Products</td>
<td>Karnataka</td>
</tr>
<tr>
<td>58</td>
<td>95</td>
<td>East India Leather</td>
<td>E. I. Leather</td>
<td>Tamil Nadu</td>
</tr>
<tr>
<td>59</td>
<td>94</td>
<td>Salem Silk</td>
<td>Textiles &amp; Textile Goods</td>
<td>Tamil Nadu</td>
</tr>
<tr>
<td>60</td>
<td>93</td>
<td>Kovai Cora Cotton</td>
<td>Textiles &amp; Textile Goods</td>
<td>Tamil Nadu</td>
</tr>
<tr>
<td>61</td>
<td>92</td>
<td>Arani Silk</td>
<td>Textiles &amp; Textile Goods</td>
<td>Tamil Nadu</td>
</tr>
<tr>
<td>62</td>
<td>83</td>
<td>Bastar Dhokra</td>
<td>Handicrafts</td>
<td>Chhattisgarh</td>
</tr>
<tr>
<td>63</td>
<td>84</td>
<td>Bastar Wooden Craft</td>
<td>Handicrafts</td>
<td>Chhattisgarh</td>
</tr>
<tr>
<td>64</td>
<td>91</td>
<td>Nirmal Toys and Craft</td>
<td>Handicrafts</td>
<td>Andhra Pradesh</td>
</tr>
<tr>
<td>65</td>
<td>59</td>
<td>Maddalam of Palakkad</td>
<td>Handicrafts</td>
<td>Kerala</td>
</tr>
<tr>
<td>66</td>
<td>58</td>
<td>Screw Pine Craft of Kerala</td>
<td>Handicrafts</td>
<td>Kerala</td>
</tr>
<tr>
<td>67</td>
<td>64</td>
<td>Swamimalai Bronze Icons</td>
<td>Handicrafts</td>
<td>Tamil Nadu</td>
</tr>
<tr>
<td>68</td>
<td>82</td>
<td>Bastar Iron Craft</td>
<td>Handicrafts</td>
<td>Chhattisgarh</td>
</tr>
<tr>
<td>69</td>
<td>87</td>
<td>Konark Stone carving</td>
<td>Handicrafts</td>
<td>Orissa</td>
</tr>
<tr>
<td>70</td>
<td>88</td>
<td>Orissa Pattachitra</td>
<td>Paintings</td>
<td>Orissa</td>
</tr>
<tr>
<td>71</td>
<td>90</td>
<td>Machilipatnam Kalamkari</td>
<td>Textile and Textile Goods</td>
<td>Andhra Pradesh</td>
</tr>
<tr>
<td>72</td>
<td>110</td>
<td>Eathamozhy Tall Coconut</td>
<td>Agricultural Products</td>
<td>Tamil Nadu</td>
</tr>
<tr>
<td>73</td>
<td>57</td>
<td>Brass Broidered Coconut Shell Crafts of Kerala</td>
<td>Handicrafts</td>
<td>Kerala</td>
</tr>
<tr>
<td>74</td>
<td>66</td>
<td>Blue Pottery of Jaipur</td>
<td>Handicrafts</td>
<td>Rajasthan</td>
</tr>
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<td>75</td>
<td>67</td>
<td>Molela Clay Work</td>
<td>Handicrafts</td>
<td>Rajasthan</td>
</tr>
<tr>
<td>76</td>
<td>68</td>
<td>Kathputlis of Rajasthan</td>
<td>Handicrafts</td>
<td>Rajasthan</td>
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<tr>
<td>77</td>
<td>97</td>
<td>Leather Toys of Indore</td>
<td>Handicrafts</td>
<td>Madhya Pradesh</td>
</tr>
<tr>
<td>78</td>
<td>98</td>
<td>Bagh Prints of Madhya Pradesh</td>
<td>Handicrafts</td>
<td>Madhya Pradesh</td>
</tr>
<tr>
<td>79</td>
<td>100</td>
<td>Sankhedha Furniture</td>
<td>Handicrafts</td>
<td>Gujarat</td>
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<tr>
<td>80</td>
<td>101</td>
<td>Agates of Cambay</td>
<td>Handicrafts</td>
<td>Gujarat</td>
</tr>
<tr>
<td>81</td>
<td>102</td>
<td>Bell Metal Ware of Data and Tikamgarh</td>
<td>Handicrafts</td>
<td>Madhya Pradesh</td>
</tr>
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<td>103</td>
<td>Kutch Embroidery</td>
<td>Handicrafts</td>
<td>Gujarat</td>
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<td>51</td>
<td>Kani Shawl</td>
<td>Textiles</td>
<td>Jammu &amp; Kashmir</td>
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<td>79</td>
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<td>Textile</td>
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<td>Milk Product</td>
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<td>81</td>
<td>Pokkali Rice</td>
<td>Agricultural Product</td>
<td>Kerala</td>
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<tr>
<td>87</td>
<td>86 &amp; 108</td>
<td>Pipli Applique Work</td>
<td>Handicrafts</td>
<td>Orissa</td>
</tr>
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<td>88</td>
<td>89</td>
<td>Budiiiti Bell &amp; Brass Craft</td>
<td>Bell &amp; Brass metal</td>
<td>Orissa</td>
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<td>96</td>
<td>Thanjavur Doll</td>
<td>Toys</td>
<td>Tamil Nadu</td>
</tr>
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<td>104</td>
<td>Santiniketan Leather Goods</td>
<td>Leather Goods</td>
<td>West Bengal</td>
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<td>105</td>
<td>Nirmal Furniture</td>
<td>Furniture</td>
<td>Andhra Pradesh</td>
</tr>
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<td>106</td>
<td>Nirmal Paintings</td>
<td>Paintings &amp; Art Works of Wood</td>
<td>Andhra Pradesh</td>
</tr>
<tr>
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<td>107</td>
<td>Andhra Pradesh Leather Puppetry</td>
<td>Leather Goods, Wall Hangings &amp; Toys, Playthings</td>
<td>Andhra Pradesh</td>
</tr>
<tr>
<td>94</td>
<td>111</td>
<td>Laxman Bhog Mango</td>
<td>Horticulture</td>
<td>West Bengal</td>
</tr>
<tr>
<td>95</td>
<td>112</td>
<td>Khirsapati (Himsagar) Mango</td>
<td>Horticulture</td>
<td>West Bengal</td>
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<td>113</td>
<td>Fazli Mango grown in the district of Malda</td>
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<td>West Bengal</td>
</tr>
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<td>Uttar Pradesh</td>
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<td>48</td>
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<td>109</td>
<td>Naga Mircha</td>
<td>Agricultural Product</td>
<td>Nagaland</td>
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<td>115</td>
<td>Assam (orthodox)</td>
<td>Agricultural Product</td>
<td>Assam</td>
</tr>
<tr>
<td>102</td>
<td>116</td>
<td>Nilgiri (Orthodox)</td>
<td>Agricultural Product</td>
<td>Tamil Nadu</td>
</tr>
<tr>
<td>103</td>
<td>124</td>
<td>Virupakshi Hill Banana</td>
<td>Agricultural Product</td>
<td>Tamil Nadu</td>
</tr>
<tr>
<td>104</td>
<td>126</td>
<td>Sirumalai Hill Banana</td>
<td>Agricultural Product</td>
<td>Tamil Nadu</td>
</tr>
</tbody>
</table>
CHAPTER 6

CASE STUDIES ON GIs

Case Study 1: Pochampally Ikat

{Write up of this Case Study is courtesy Anand & Anand Associates, New Delhi, India.}

POCHAMPALLY IKAT in normal parlance refers to a handloom fabric easily recognized by the weave and the peculiar diamond design and its variations, which is very specific to Pochampally. The weaving of this fabric is a traditional art practiced in and around the Pochampally village and parts of Warangal District in the State of Andhra Pradesh, India.

Pochampally is a small town in the Nalgonda district of Andhra Pradesh, a handloom cluster known for its very unique IKAT design for centuries. The art of IKAT involves dyeing the yarn and weaving it into traditional design on the handloom. There are about 5000 weavers in and around the Pochampally village who practice this art. This is how the weave got the name POCHAMPALLY IKAT.


The Pochampally Ikat case was the first lawsuit instituted under the Geographical Indications of Goods (Registration and Protection) Act 1999.

Facts:

The Plaintiffs are responsible for production and marketing of POCHAMPALLY IKAT. POCHAMPALLY IKAT is a fabric made of natural materials such as cotton or silk or a combination of both, having designs that are evocative of the diffused diamond or chowka design.

Registration of the GI POCHAMPALLY IKAT confers legal protection in case of unauthorized use or infringement. It also vests in the Registered Proprietor and the Authorized Users a legal right to initiate infringement action.

The special qualities or essential features, which characterize POCHAMPALLY IKAT are enumerated hereunder:

- It is made of natural fiber e.g. cotton or silk or a mixture of both;
- The threads/yarn is tied and dyed in different colors according to the predetermined pattern/design;
- Dyed thread/yarn is used for weaving;
- Into weft ikat or warp ikat or both, also known as double ikat;
- They have designs, which are evocative of the diffused diamond or chowka design.

In May 2005, the Plaintiffs came to know that the Defendant No. 1 was retailing saris under the false geographical indication of HYCO POCHAMPALLY.

Further investigation revealed that Defendant No. 2 was manufacturing and retailing the saris.

Grounds for filing suit

A Suit for permanent injunction restraining infringement of Geographical Indication, passing off, unfair competition, damages and delivery up, etc. was filed by the Plaintiffs against the Defendants.

The Defendants are manufacturing and selling their product with the label HYCO POCHAM PALLY, which is visually and phonetically similar to the Plaintiffs Geographical Indication and product
POCHAMPALLY IKAT. The adoption by the Defendants of word ‘Pochampally’ in HYCO POCHAMPALLY in respect of identical goods would lead to confusion and deception in the minds of the consumers leading to the passing off of the Defendants goods as those of the Plaintiffs and unfair competition. The use of ‘Pochampally’ in HYCO POCHAMPALLY is of the nature of passing off since the product is not made using the traditional methods significant of the geographical indication, but instead is a product made on power looms. Thus the adoption of the mark HYCO POCHAMPALLY by the Defendants is a blatantly dishonest and mala fide attempt to derive unfair advantage by creating the impression that the Defendants products have some connection, nexus, association, affiliation with or endorsement by the Plaintiffs.

The Defendants have also falsified the geographical indication POCHAMPALLY IKAT with the meaning of Section 38(1)(a) & (b) by making POCHAMPALLY IKAT or something deceptively similar without the consent of the Plaintiffs.

**Order**

Suit decreed in favor of the Plaintiffs and application under order 23 rule 3 read with Section 151 of the CPC filed on behalf of both the parties for compromise.

**Case Study 2: CUBAN CIGARS**

**Brief History**

Cuba has a long history of producing some of the world’s finest tobaccos and cigars.

In 1960, the United States introduced a trade embargo and economic sanctions on the island of Cuba thereby forbidding all trade between the two countries. Following this, several US based companies such as General Cigar, introduced products in their markets to term their cigars as ‘Cuban style’ cigars with ‘Cuban seed’ and with Cuban brand names to sell in the United States where Cuban companies, products and their brand names are not recognized.

Cuba cannot enforce the trademark of Cohiba cigars, one of its most prestigious brands, in the United States because of the decades-old trade embargo against President Fidel Castro’s government, a federal appeals court ruled. The Second Circuit Court in New York overturned a May 2004 district court decision that General Cigar, an American company, had violated trademark laws by selling cigars under the Cohiba name in the United States. Although Cuba never registered the Cohiba trademark in the United States, the lower court judge found that the name was famous enough to deserve protection. But the appeals court ruled that the embargo bars Cuba from acquiring any American trademarks [New York Times, February 25, 2005]

However, Cuban Cigars are globally recognized as a product of Cuba distributed by the State run Cuban distributing company, Habanos.

The ownership of the brand their use including the possible confusion in the consumer’s mind when terms such as “Cuban Style” or the word CUBA is associated with Cigars in the market place.

Tobacco was first grown in the American continents and the Mayan civilization in Central America smoked the leaves. With the fall of their civilization the habit of tobacco smoking spread to North and South America. The discovery of America by Christopher Columbus in 1642, opened the world to the habit of smoking rolled tobacco leaves, which then spread to various parts of Europe especially in Spain and Portugal. The word ‘tobacco’ is possibly derived from Tobago, in the Caribbean island. The word ‘cigar’ derived from ‘sikar’, the Mayan word for smoking.

As Castro gained power in Cuba in the late 1950’s, the wealthy ruling class fled Cuba to countries such as the US. These people who previously owned many business such as cigar and rum left their production facilities in Cuba and took with them the recipes, production process and know how of making these well known Cuban products.

Needless to mention that the soil composition in Cuba, its environment, traditional methods of cultivation & processing, that includes harvesting, curing, rolling and packaging gives the Cuban Tobacco certain distinctiveness because of which they are considered as preferred tobacco and cigars worldwide.
**The dispute**

The legal disputes over Cuban cigars involve two brands of Cigars namely Cohiba and Trinidad.

1978: ‘Cohiba’ was registered as a trademark for Cigars by an US Company, Culbro Corporation and then assigned the trademark to the American Company, General Cigar.

1996: TTT Trinidad, La Habana, Cuba by the USPTO.

1997: The Trinidad family petitioned the USPTO for cancellation. There is no resolution yet; in the meantime, the Trinidad family is selling cigars with the TTT Trinidad name.

1997: The Cuban government petitioned the USPTO in protest of naming rights and the almost identical trademark on the grounds that

- The name ‘Cohiba’ under which Cuba claims to have produced its top of the line cigars since 1960. Cuba claims that ‘Cohiba’ is a ‘famous name’ and under international law, "should not be appropriated by a producer in another country."
- The trademark or logo that wraps the cigar is very similar on both the American and the Cuban brand. The only distinguishing detail on the wrapper is the red color band for the American cigar and the yellow band for the Cuban
- The American brand is sold under the advertisement of being ‘Cuban style’ and made with ‘Cuban seed’ which may be considered to be creating confusion in the minds of an average consumer.

1998: The Omnibus Consolidated and Emergency Supplemental Appropriations Act (OCES) was brought into law in the USA. Section 211 of this Act prohibits Cuban companies from registering ‘confiscated’ trademarks in the US without permission of the original owner. US courts are also prohibited from recognizing any such trademark rights. The intention was to lay claim that the original owners of the trademarks were the families that fled Cuba before 1960.

The EU has formally backed Cuba on questioning the legality of the OCES Act and requested the WTO take up the matter to its Dispute Settlement Body. The Dispute Settlement Body of the WTO concluded that there is nullification or impairment of the benefits accruing to the European Communities under the TRIPS Agreement and requested the United States to bring its measures into conformity with its obligations under the TRIPS Agreement.

**Case Study 3: FETA CHEESE**

The case relates to the issue of repatriation of semi-generic names i.e. EC Regulation, Article 3(1), defines a ‘name that has become generic’ as the name of an agricultural product or a foodstuff which, although it relates to the place or the region where this product or foodstuff was originally produced or marketed, has become the common name of an agricultural product or a foodstuff.

Feta is included in a list of 41 names, which the European Commission submitted to the WTO agricultural round under the Doha negotiations, seeking their protection as GIs for the exclusive use of EU producers.

In 2002, the European Commission had registered the name 'feta' as a protected designation of origin (PDO) for a kind of white cheese soaked in brine traditionally produced in Greece and made from ewes’ milk or a mixture of ewes’ milk and goats’ milk. Thus, the name enjoys Community-wide protection as it was reserved exclusively for cheese originating in Greece.

In order to be registered as a PDO, a traditional name such as ‘feta’, which is not the name of a region, place or country, must refer to an agricultural product or a foodstuff from a defined geographical environment with specific natural and human factors which is capable of conferring on that product or foodstuff its specific characteristics. Furthermore, the name could not have become generic.

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The geographical area defined by the Greek legislation covers only the territory of mainland Greece and the department of Lesbos. Extensive grazing and transhumance, central to the method of keeping the ewes and goats used to provide the raw material for making Feta cheese, are the result of an ancestral tradition allowing adaptation to climate changes and their impact on the available vegetation.

This has led to the development of small native breeds of sheep and goats which are extremely tough and resilient, fitted for survival in an environment that offers little food in quantitative terms but, in terms of quality, is endowed with an extremely diversified flora, thus giving the finished product its own specific aroma and flavor. The interplay between the natural factors and the specific human factors, in particular the traditional production method, which requires straining without pressure, has thus given Feta cheese its remarkable international reputation.

This dispute started about 20 years ago with Denmark and Germany claiming that the name Feta had become generic. The ECJ rejected these arguments.

**Sequence of Events**


12 Jun 1996: The name ‘feta’ in the Annex thereto in Part A, under the heading ‘cheeses’ and the country ‘Greece’, was registered as a protected designation of origin (‘PDO’).

16 Mar 1999: Judgment from the European Court of Justice in Joined Cases C-289/96, C-293/96 and C-299/96 Denmark and Others v Commission [1999] ECR I-1541, the Court of Justice annulled Regulation No 1107/96 in so far as it registered the name ‘feta’ as a protected designation of origin. In paragraph 101 of that judgment, the Court held that, when registering the name ‘feta’, the Commission had not taken any account whatsoever of the fact that that name had been used for a considerable time in certain Member States other than the Hellenic Republic.

In paragraph 102 of the judgment, the Court found that the Commission, in considering the question of whether ‘feta’ was a generic name, had not taken due account of all the factors which the third indent of Article 3(1) of the basic regulation required it to take into consideration.


15 Oct 1999: The Commission sent to the Member States a questionnaire on the manufacture and consumption of cheeses known as ‘feta’ and on how well known that name was amongst consumers in each of the States.

24 Apr 2001: Based on the response received to that questionnaire the scientific committee concluded unanimously that the name ‘feta’ was not generic in nature.

14 Oct 2002: The Commission adopted the contested regulation. Under that regulation, the name ‘feta’ was once again registered as a protected designation of origin.

The Defendant was The Commission of the European Communities supported by Hellenic Republic.

25 Oct 2005: In the Judgment delivered by the Court of Justice the Court concluded that the term 'feta' had not become generic and that the present action must be dismissed.

The court further ordered that the Federal Republic of Germany to pay the costs in relation to Case C-465/02 and the Kingdom of Denmark to pay the costs in relation to Case C-466/02. It further ordered the Hellenic Republic, the French Republic and the United Kingdom of Great Britain and Northern Ireland to bear their own costs.

Some of the features on which the court decision was based were:

♦ Findings of the scientific committee was that more than 85% of Community consumption of feta, per capita and per year, takes place in Greece. As noted by the scientific committee, the production and consumption of feta is concentrated in Greece.
♦ The name ‘feta’ carries a geographical and not a generic connotation.
♦ feta is commonly marketed with labels referring to Greek cultural traditions and civilization. It further noted that labels used by non-Greek EU producers on their Feta cheese often referred to Greece, either in words or by the color scheme they used. It also noted that Danish law referred to Danish Feta, and not Feta, suggesting that it was the Danish version of an otherwise Greek cheese.
♦ It is legitimate to infer there from that consumers in those Member States perceive feta as a cheese associated with the Hellenic Republic, even if in reality it has been produced in another Member State.
♦ The name ‘feta’ was protected by a convention between the Republic of Austria and the Kingdom of Greece, concluded on 20 June 1972 pursuant to the agreement of 5 June 1970 between those two States relating to the protection of indications of provenance, designations of origin and names of agricultural, craft and industrial products (BGBl. Nos 378/1972 and 379/1972). Since then, the use of the name in Austria has been reserved exclusively for Greek products.

Case Study 4: PARMA HAM

Prosciutto di Parma, or Parma ham, has been made in the Parma area from pigs reared in northern and central Italy since Etruscan times. It is famous throughout the world. It is made according to traditional methods and standards. The name "Prosciutto di Parma", signifying ham from the Parma area, is a "protected designation of origin" (PDO) under European Community legislation [http://www.publications.parliament.uk/pa/ld/ldjudgmt.htm]

The outward guarantee of the authenticity of the product is the brand mark in the form of a five pointed coronet (the "corona ducale") symbolizing the ancient Grand Duchy of Parma. By Italian law this has to appear upon the product in whatever form it is sold to the customer. If he buys a complete ham, or slices cut from a ham in the shop, it must appear branded upon the ham itself. If he buys pre-packaged pieces or slices, it must appear stamped upon the package. The authority which under Italian law enforces compliance by producers with the required methods and standards of manufacture and also protects the name and mark against misuse by others is the "Consorzio del Prosciutto di Parma" or Parma Ham Association ("the
Asda, a Wal-Mart-owned British supermarket chain, was in the business of selling ham bearing the description "Parma ham", bought presliced from Hygrade. Hygrade buys the ham boned but not sliced from an Italian producer (of the Consorzio) and then slices and hermetically seals the hams in packets containing five slices each.

The packets all bear the wording "ASDA A taste of Italy PARMA HAM Genuine Italian Parma Ham" on the front, and on the back: "PARMA HAM All authentic Asda continental meats are made by traditional methods to guarantee their authentic flavor and quality" and "Produced in Italy, packed in the UK for Asda Stores Limited".

The long-running dispute began back in November 14, 1997 when the Italian Parma ham trade consortium, Consorzio del Prosciutto di Parma, filed a suit against Asda and Hygrade in the English courts seeking several injunctions against them, but primarily requiring them to cease their activities on the ground that they were contrary to the rules applicable to Parma ham.33

They said Asda was flouting an Italian law, which stated slicing, and the consortium in the Parma region must do packaging. Asda had argued that the Italian law could not be applied under UK law. The applications were dismissed twice before an Italian company, The Consorzio and Salumificio thereafter appealed to the House of Lords who decided to stay the proceedings and refer the matter to the ECJ for a preliminary ruling.

The European Court's advocate-general issued an 'opinion' which backed Asda's claim.

But, the Court noted as a preliminary point that the specification on the basis of which the PDC Parma ham was registered expressly mentions the requirement of slicing and packaging of the product within the region of production for ham marketed in slices.

The Court also observed that reference made in the judgment to the condition of the slicing and packaging of the ham which constitute important operations which may damage the quality and authenticity, and consequently the reputation, of the PDO if those requirements are not complied with.

The Court stated that the question posed by the House of Lords consisted essentially of four elements:

1. Whether Regulation No.2081/92 must be interpreted as precluding the use of a PDO from being conditional on operations such as the slicing and packaging of the product taking place in the region of production.
2. Whether imposing such a condition on the use of the PDO "Proscuitto di Parma" for ham marketed in slices constitutes a measure having equivalent effect to a quantitative restriction on exports, within the meaning of Article 29 EC.
3. Whether, if so, the condition in question may be regarded as justified and hence compatible with Article 29 EC.
4. Whether that condition may be relied on against economic operators when it has not been brought to their notice.

The Court ruled that the wording of Art 4 of Regulation No. 2081/92 does not exclude the application of special technical rules to operations leading to different presentations on the market of the same product. In each case the criterion of quality, mentioned in the preamble to the regulation, must be satisfied in order to guarantee of an identifiable geographical origin. Consumers have in recent years tended to attach greater importance to, and there is a growing demand for such guarantee.

33 [Consorzio Del Prosciutto Di Parma v. Asda Stores Limited and Others; http://www.parliament.the-stationery-office.co.uk/pa/ld200001/ldjudgmt/jd010208/parmah-1.htm]
Article 29 EC prohibits all measures which have as their specific object or effect the restriction of patterns of exports and thereby the establishment of a difference in treatment between the domestic trade of a member state and its export trade, in such a way as to provide a particular advantage for national production or for the domestic market of the state in question. The Court made reference to the specification of the PDO "Proscuitto di Parma", which expressly mentions the requirement of slicing and packaging the product in the region for production for ham marketed in slices, and the Italian law in terms of which this was done. Registering the PDO "Proscuitto di Parma" in accordance with Article 4 of Regulation 2081/92 thus had the effect of making slicing and packaging in the region of production a condition for the use of the PDO "Proscuitto di Parma" for ham marketed in slices.

The consequence of the condition was therefore that ham produced in the region and fulfilling the conditions required for use of the PDO "Proscuitto di Parma" could not be sliced outside of the region without losing that designation. The Court reasoned that the rules thus had the specific effect of restricting patterns of exports of ham eligible for the PDO "Proscuitto di Parma" and thereby established a difference in treatment between the domestic trade of a member state and its export trade. A quantitative restriction on exports within the meaning of Article 29 EC was therefore introduced.

The Court rationalized that the conditions relating to Parma ham were aimed at safeguarding the quality and authenticity of the product and therefore the PDO, and must be regarded as compatible with EC law, despite its restrictive effects; it is shown that it is necessary, proportionate and capable of upholding the reputation of the PDO "Proscuitto di Parma".

Parma ham is consumed most often in slices and the operations leading to that presentation are developed to obtain a specific flavor, color and texture that will be appreciated by consumers. The operations specified by Italian legislation referring to the PDO "Proscuitto di Parma" are detailed and strict and regulate three stages that lead to the placing on the market of pre-packaged slices. All three stages are rigorously monitored by representatives of the inspection structure who permanently monitor compliance of all requirements and certify the number of packages produced.

The Court found that the condition of slicing and packaging in the region of production may be regarded as justified as a measure protecting the PDO. Moreover, the resulting restriction may be regarded as necessary for attaining the objective pursued, in that there are no alternative less restrictive measures capable of attaining it. The PDO "Proscuitto di Parma" would not receive comparable protection outside of the region, even with labelling to the effect that the slicing had taken place outside of the region, and the Court expounded further that any deterioration in the quality of the ham sliced outside of the region, resulting from the slicing and packaging, might harm the reputation of all ham marked under the PDO "Proscuitto di Parma".  

Thus the Court concluded that the fact that the use of the PDO "Proscuitto di Parma" for ham marketed in sliced is conditional on the slicing and packaging operations being carried out in the region of production may be regarded as justified, and therefore compatible with Article 29 EC. The case impacts not only on Parma ham, but on all geographical indications applying to agricultural and food products.

Asda can no longer slice and package Parma ham in the UK, having moved production back to Italy. The supermarket said it wanted to have the freedom to choose where it sliced and packed the meat, in order to keep prices low.

However, Asda can still use the Parma name when the meat is sliced on a delicatessen counter in front of shoppers.

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34 [www.tralac.org]
35 [http://news.bbc.co.uk]
Case Study 5: SPANISH CHAMPAGNE

Spanish Champagne Case (J. Bollinger & Ors. v. The Costa Brava Wine Co. Ltd.)

In this case, the plaintiff’s claim was that Champagne produced in France was and had been for a long time known to the trade and the public in the UK as ‘Champagne’ and as such had acquired high reputation. The main defense of the defendant was that the prefix ‘Spanish’ was sufficient to avoid any confusion.

The Judge described this as a ‘fairly specious argument’ but he rejected it. He observed that, “The suggestion is, of course, that in the present case the Spanish wine is so like Champagne that it is not improper to call it ‘Champagne’ with the adjective ‘Spanish’. But for the purpose of the question which I have to decide – which is whether the name is calculated to deceive, and which is concerned with unfair trading – it seems to me that close resemblance makes the counterfeit not less but more calculated to deceive, and so the argument fails.”

The Judge drew a distinction between those who were knowledgeable and those who were ignorant in matters of wine. The former would know that Champagne came exclusively from France, and were not buying real Champagne but a Spanish sparkling wine. But according to the evidence given, many people in the UK who were drinking wine were not brought up to that habit and knew nothing of the various types of wine and their countries of origin. The Judge observed that “There is thus, in my view, a considerable body of evidence that persons whose life or education has not taught them much about the nature and production of wine, but who from time to time want to purchase Champagne, as the wine with great reputation, are likely to be misled by the description ‘Spanish Champagne’.

In conclusion, the Judge held that the acts of the defendants amounted to dishonest trading and noted three aspects of the conduct of the defendants in this behalf.

- The defendants sold the same wine in Spain but not under the name ‘Spanish Champagne’, but as ‘Perelada’ under its own legitimate reputation. It intrigued the Judge as to why the name ‘Champagne’ was selected only for the British market.
- Mr. Michael Grylls, presumably the moving spirit behind the defendant company who was loquacious enough about his discovery of the name ‘Perelada’, at the party held to celebrate the failure of the prosecution of the criminal case mentioned earlier, was conspicuously absent to give evidence at the hearing of this action.
- The brochure freely distributed by the defendant, entitled ‘Giving a Champagne Party’, was found by the judge to be plainly a blatant attempt to secure to the sale of the defendant company’s wine the advantage of the goodwill connected with the word ‘Champagne’ and the business of the plaintiffs and the other producers and shippers of Champagne.

Based on the above findings the action succeeded and the defendants were injunctioned from passing off.

Case Study 6: Scotch Whisky

The underlying issue in this case study concerns the labeling processes for internationally marketed products named for the region, area, or nation where they are produced. Systematic and planned efforts have been directed by Scotland to retain its sole ownership of the label ‘Scotch’ for its Scotch whisky. It has successfully enforced its ownership in the EU and in other parts of the world. It has prevented other countries and regions from reproducing Scotch-type whisky and marketing it for international trade purposes as “Scotch” or even “Scotch-type” whisky thereby protecting the integrity of their product, as an expression of Scottish culture, taste, and cleverness.

The product and its association with Scotland

Scotch whisky is generally identified as a major product from Scotland that is closely linked with its environment, people and culture.

The distillation and maturation processes for making of Scotch whisky involves the use of Scottish peat to smoke the barley, or the Scottish oak to make the maturation casks, or the Scottish air to seep through the casks and give the spirit its character.37

The traditional process of manufacturing Scotch whisky generally follows the following steps:

♦ soaking the barley, about 2-3 days
♦ spreading the barley the floor to germinate before it is dried and fired in a kiln with natural Scottish peat "cut from the moors of Scotland". The smoke from the fire flavors the barley, called ‘peat reek’, giving Scotch its distinctive flavor
♦ the malted barley is ground, mixed with hot water in a mash tun that turns the starch in the barley into sugary liquid, ‘wort’
♦ the wort is then fermented in a fermenting vat where yeast is added to ferment into crude alcohol, called 'wash'
♦ the mixture is distilled in 'swan-necked copper stills', the temperature is raised to carry on the fermentation slowly, before separating the alcohol and wash. The 'vapors' are funneled into condensers and re-converted to liquid before the process is repeated. The malt is distilled twice. There is a lot of art in the selection of the conditions and time for the second distillation (forming the middle cut)
♦ the cut as per the distillers choice is transferred to oak casks for maturing at least for a period of 3 years.38

Further, the casks in which the Scotch is matured is of significance in the process as they are responsible for the character and color of the product as it is believed that the Scottish air that diffuses through the porous wood of the casks is absorbed by the spirit to give its distinctive taste. It is a further cultural belief that a small portion of the spirit that evaporates from the casks and rises to the 'heavens' (called 'angels' share') is another significant process step for the whisky produced to get its distinguishing taste, flavor and quality. After maturation the whisky is ready to be drawn, bottled as is or blended with various other whiskies (including grain whiskies).

It is by now well established that the word Scotch invokes in a consumer a distinctive feeling, expectation and satisfaction that makes this product so popular. The premium it enjoys over other products itself is a measure of the consumer appeal and has become an item of significant commercialization and trade from Scotland.39,40

The name 'whisky' itself derives from the Gaelic (a local language spoken in Scottish Highlands) ‘uisage beatha’ or ‘usquebaugh’, which meant ‘water of life’ (Gaelic is). Historical references to this ‘water of life’ have dated as far back as 1494 when a man named Friar John Cor purchased “eight bolls of malt...wherewith to make aquavitae”.41 Scotch is such a celebrated drink that in the song Auld Lang Syne, the ‘cup of kindness’ refers to whisky. Although malt whisky is also made in Ireland, Japan, and New Zealand, one can easily see that the success and cultural pride of Scots with this treasured spirit can never be reproduced.

Protecting “Scotch” and enforcing its GI

The Scotch Whisky Association (SWA), the largest lobbying voice for Scotch producers and distillers, has been most aggressive to protect the interests of “Scotch Whisky” manufacturers in Scotland and to enforce their rights on Scotch as a “GI” in various parts of the world including “unfair tax discrimination. as it contributes significantly to British Trade.42

Judgement by a UK Court on “Manx whisky”

The Glen Kella production company in the Isle of Man, an island near Scotland was producing and selling its product, called Manx whisky. The Scottish distillers claimed that the Glen Kella's production
process was distorting the ‘whisky’ label. In and around the United Kingdom, the term ‘scotch’ or ‘whisky’ automatically creates association with the traditional spirit of Scotland. It was noted that the Glen Kella process involved a third distillation of Scotch Whisky to remove the tar and color from traditional Scotch to produce a colorless form the spirit.

The Scotch distillers and the Scotch Whisky Association stated that “whisky must retain the colour, aroma, and taste derived from its distillation and maturation” (Financial Times London Edition, 3 December 1996:10) and that somehow the third distillation process destroys the essence of the whisky.

After detailed deliberations, the British High Court on 24 March 1997 gave a judgment that the production process of Manx whisky fell outside EU regulations governing spirits that “qualify” whisky as such and “to allow Glen Kella to call itself whisky would risk an insidious process of erosion of the integrity of the reputation or aura of true whisky” (Mason, 1997:20). Thus, Glen Kella could no longer market its product as true whisky, and Scotland was able to uphold the integrity of the whisky, which dominates world markets.

The Jack Daniels whiskey in the USA

This case highlights another aspect of differences in Scottish traditions in Whisky making, naming and marketing to gain market share as compared to a process followed by Jack Daniels in the making of American Whiskey. In 1866, Jack Daniels began production of “whisky” in Lynchburg, Tennessee, USA where he identified ‘pure spring water’ in a cave in Lynchburg and began making his famous whiskey. The process comprises of first mixing corn, rye, and barley malt with the spring water into mash, then cooking and fermenting with yeast and placing the mixture in a 100-foot deep copper still. It is then filtered for about 12 days “drop by drop” into huge ‘mellowing’ tanks, followed by roasting with charcoal made from sugar maple trees burned in the open air. After distillation, the liquid is placed into white oak barrels where it expands/contracts with temperature changes and gains its color.43

This shows the distinct differences between the two processes (though both are traditional and being practiced for a very long time). However, in the interest of the consumer, the two spirits should be clearly differentiated in terms of their names and certainly the word Scotch should not be allowed to be used in naming the American Whiskey as the process and the characteristics are totally different in the two products.

Indian Courts on Scotch whisky

There have been at least six cases since 1986 when the courts have restrained local distilleries from selling whiskies with names like Royal Scot, Grand Scot and Henry Scot. A few years ago, a court in India ruled against a leading Indian whisky-maker for marketing a spirit that copied the design and livery of the Glenfiddich bottle.

The Scotch Whisky Association went to court in India to prevent Khoday Distilleries from selling its whisky under the Peter Scot brand. The mark Peter Scot was registered in India in the name of Khoday Distilleries Limited (registration 273203 in class 33) in 1971. The Scotch Whisky Association appealed to the Trade Marks Registrar in India to remove the mark Peter Scot from the Register. The Registrar allowed the application. Khoday Distilleries subsequently appealed to the High Court.

The Chennai High Court found that even the use of the word “Scot” by Khoday Distilleries in relation to whisky is unacceptable.


The Plaintiffs namely The Scotch Whisky Association & Others had filed this suit for a permanent injunction restraining the Defendant and those acting under the Defendant from dealing, in any manner, with whisky under the name “Red Scot” or any other name containing the word “Scot” or any word similar thereto so that the Defendant cannot “pass off” its whisky as Scotch whisky.

On 22nd April, 2004, summonses were issued in the suit and the Defendant was restrained from dealing in any whisky containing the word “Scot”. Despite service, no one appeared on behalf of the

43 http://www.jackdaniels.com
Defendant. Accordingly, by an order dated 10th December 2004, the Defendant was proceeded against ex parte.

The Scotch Whisky Association argued that the use of the word Scot in relation to whisky by the defendant passes off the reputation of Scotch whisky, which is geographically indicative. Extensive explanations were given on the distinctive

While upholding the permanent injunction the judge stated:

"Having heard learned counsel for the Plaintiffs and having perused the affidavit by way of evidence (the averments in which have not been denied), I am satisfied that the Defendant is liable to be restrained from passing off its "Red Scot" whisky as a produce of Scotland. This can only be done by injunctioning the Defendant from using the word “Scot” or any other word similar thereto in the whisky manufactured by it.

In view of the well settled law laid down by this Court, and reiterating the necessity of preventing a violation of the intellectual property rights of parties, I think it would be appropriate if the damages as prayed for by the Plaintiffs to the extent of Rs.5,00,000/- are granted.

Under the circumstances, the suit is decreed in the above terms. The Plaintiffs are entitled to the permanent injunction prayed for and also to damages to the extent of Rs.5,00,000/-. The Plaintiffs will also be entitled to costs of Rs.3,10,000/- which they say they have incurred in this litigation."

In coming to this conclusion, the Court relied on Scotch Whisky's geographical significance. This is the first such ruling based on GI in India.

Challenging the order of the HC, Khoday Distilleries moved the Supreme Court in India and pleaded that though Scotch Whisky Distillers Association (SWDA) had knowledge about registration of the 'Peter Scot' trademark as early as September 1974; it waited for more than 12 years to move the Registrar for deletion of the 'Peter Scot' trademark. Khoday Distilleries argued that whatever be the merits of the arguments on the part of the association, its plea for deletion of the trademark was hopelessly time-barred as the product had been in the market for more than a decade. The HC had held that the adoption of a name which indicates the geographical region even when the goods had no connection with that place, was itself dishonest. The Supreme Court Bench comprising Justices S B Sinha and Lokeshwar Singh Panta allowed the appeal of Khoday Distilleries and set aside the HC judgment giving legitimacy to the trademark 'Peter Scot'. The Supreme Court elaborately considered the tests applied by courts in England, Australia and USA regarding deceptive similarity of goods. The Court also referred to a passage in Kerly's classic book on trademark and ruled that “if the goods are expensive and not of a kind usually selected without deliberation and the customers are generally educated persons which are all matters to be considered”. It held that "where the class of buyers is educated and rich, the test to be applied is different where the product would be purchased by the villagers, the illiterate and the poor". On May 27th 2008, the Court concluded that it was concerned with the class of buyers who are supposed to know the value of money, the quality and content of Scotch whisky and the difference in the process of manufacture, the place of manufacture and their origin. Applying these tests the Court decided in favour of Khoday Distilleries

**Case Study 7: Dartjeeling Tea**

*Rajendra Kumar and Vasundhara Naik, K&S Partners, New Delhi, India; article in SME Newsletter, WIPO* [This write up has been reproduced without any changes.....permission was granted by the authors.]

The hills of Darjeeling are located in the northern part of West Bengal, is the home for one of the finest varieties of tea in the world. Tea cultivation in this region has been has been done over 150 years. Darjeeling tea has a very special connotation to tea consumers because of its distinctive flavor, taste and pleasure. These characteristics are attributed to the synergistic combination of the environment, climatic conditions, cultivation methods, harvesting and post harvest processing, etc.

Over the years over 17500 hectares in Darjeeling and around 100 tea gardens with a workforce of over 50 thousand is responsible for the production of 11.5 million kilograms of Darjeeling tea. Annually around ......... Million Dollars of Tea is exported from this region.

While the tea industry in India is almost completely in the private sector, it is statutorily controlled by the Government since 1933 under various enactments culminating in the Tea Act, 1953. The Tea Board in India is a Board set up under the same Act of Parliament. The Board is administratively under the control of
the Ministry of Commerce & Industry of the Government of India (the federal or central government). The Tea Board is vested with the authority to administer all stages of tea cultivation, processing and sale of the tea industry, including the Darjeeling segment through various orders. The Tea Board, however, has been working in close cooperation with the Darjeeling Planters' Association, which is the sole producers' forum for Darjeeling tea.

Given that Darjeeling has a high reputation; both the Tea Board and the Darjeeling Planters Association have been involved at various levels in protecting this common heritage. The protection is essentially geared to:

- prevent misuse of the word "Darjeeling" for other types of tea sold world-wide
- deliver the authentic product to the consumer
- enable the commercial benefit of the equity of the brand to reach the Indian industry and hence the plantation worker
- achieve international status similar to Champagne or Scotch Whisky both in terms of brand equity and governance/administration

1983 - Darjeeling logo Created

One of the first significant measures was taken by the Tea Board to protect Darjeeling as a geographical indication about 15 years ago by developing a "Darjeeling" logo.

Statutory Protection

Domestic

The Darjeeling logo created in 1983 has since been registered in various jurisdictions including UK, USA, Canada, Japan, and Egypt and some European countries as a Trade mark/ Certification Trade Mark/Collective Mark.

The Tea Board has obtained "home protection" by registering the Darjeeling logo and also the word "Darjeeling" as a Certification Mark under the Indian Trade and Merchandise Marks Act, 1958. Under the new Geographical Indication of Goods (Registration & Protection) Act, 1999, (which has become operational on September 15, 2003), the Tea Board has also filed applications for the Darjeeling logo as well as "Darjeeling" word to be registered as a geographical indication.

Since February 2000, the statutorily compulsory system of certifying the authenticity of the Darjeeling tea being exported was put in place under the provisions of the Tea Act, 1953. The system requires all dealers in Darjeeling tea to compulsorily enter into a license agreement with the Tea Board India and pay an annual license fee. The terms and conditions of the Agreement provide that the licensees would furnish information relating to production, manufacture and sale of Darjeeling tea through auction or otherwise. The Tea Board is thus able to compute and compile the total volume of Darjeeling tea produced and sold in any given same period. No blending whatsoever with teas of other origin is permitted.

Under this authentication process, 171 companies dealing with Darjeeling tea have registered with the Tea Board. Out of 171, 74 are producer companies and 97 are trader/exporter companies. Certificates of Origin are then issued for export consignments. Data is entered from the garden invoices (the first point of
movement outside the factory) into a database, and export of each consignment of Darjeeling tea is authenticated by issue of the Certificates of Origin by crosschecking the details. This ensures the supply-chain integrity of Darjeeling tea until consignments leave the shores of India. The Customs authorities in India have, by officially issued instructions, instructed all Customs checkpoints to check for and ensure that Certificates of Origin accompany Darjeeling Tea consignments.

The Tea Board has also sought the support of all overseas buyers, sellers and Tea Councils and Associations in so much as they should insist that Certificates of Origin accompany all export consignments of Darjeeling tea. Overseas importers are thus ensured of 100% authentic Darjeeling tea in all their consignments.

**International**

Overseas, the Darjeeling logo and word are registered or applied for registration under the relevant laws available in the country where registration is sought. The present position of international registration of Darjeeling and Darjeeling logo is summarized in the chart below.

<table>
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<th>No.</th>
<th>Country</th>
<th>Nature and subject matter of Registration</th>
<th>Registration No.</th>
<th>Validity</th>
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<td>1.</td>
<td>Canada</td>
<td>Certification Mark</td>
<td>0903697</td>
<td>Valid until voluntarily abandoned or expunged pursuant to a court order.</td>
</tr>
<tr>
<td>2.</td>
<td>Egypt</td>
<td>Trade Mark</td>
<td>103072</td>
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<td>3.</td>
<td>International Registration–Germany, Austria, Spain, France, Portugal, Italy, Switzerland and former Yugoslavia.</td>
<td>Collective Mark</td>
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<td>September, 2007.</td>
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<td>4.</td>
<td>Benelux registration – Belgium, Netherlands, Luxembourg</td>
<td>Collective Mark</td>
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<td>March 2007</td>
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<td>Certification Mark for DARJEELING logo</td>
<td>532240</td>
<td>October 9, 2007</td>
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<td>Certification Mark for DARJEELING (word)</td>
<td>831599</td>
<td>December 10, 2005</td>
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</table>
In addition to the above, the Tea Board is also in the process of putting in place additional applications for "Darjeeling" and/or Darjeeling logo as certification mark/collective mark in Australia, Canada, Germany and a number of other countries.

**1998 - Worldwide watch agency for monitoring conflicting attempted registrations appointed**

Pursuant to the appointment of the agency, several instances of attempted registrations have been found. Some of these have been challenged through oppositions and cancellations and some through negotiations. Of the fifteen instances, while five have been successfully concluded in countries such as Japan, Sri Lanka and Russia, seven are still pending decision.

One of the key issues faced by the Tea Board is one of mixing whereby a tea packer maintains a level of tasting consistency and price stability in his brand by mixing Darjeeling tea with teas procured from different sources. There is no process change involved but the packer justifies the considerable mark-up in the retail prices on the ground that he has made considerable investments in propagating his mixture under his brand.

The Tea Board and the Darjeeling producers insist and require that, while the use of the expression "Darjeeling blend" would be applicable to a blend of Darjeeling teas drawn from more than one Darjeeling estate, tea may only be called Darjeeling tea if it contains 100% Darjeeling tea. For example, if the name DARJEELING is used as part of the packer’s brand, then the tea to be sold thereunder would be required to be 100% Darjeeling tea conforming to the standards prescribed by the Tea Board.

However, if Darjeeling tea is one of the components of a tea mixture and such mixture is sold under the packer’s mark (which does not include the name DARJEELING as part thereof), then the Tea Board requires that the ratio, name and percentage of each of the components including Darjeeling tea, shall be clearly indicated on the packaging, and the font, design and size of the name DARJEELING and other constituents must be in accordance with and proportionate to the contents of the pack: the objective being to ensure that there is no misrepresentation amounting to passing off as to content and origin of the mixture and thus protect the intrinsic value and integrity of Darjeeling as a geographical indication. Further, the consumer must know what he/she is buying and how much Darjeeling tea is contained in the mixture. Unless there comes into play, a greater degree of transparency, consumers, as well as producers, will be deprived of their legitimate due.

**Difficulties & Inequities in Enforcement**

Worldwide, all GIs are primarily faced with two kinds of risk, one arising from their generic use to indicate a class of products without any regional nexus and the other from their dilutive use as trademarks on similar or dissimilar goods or services. Such enforcement is further compounded by the difficulties arising from the civil law and common law divide among various jurisdictions, the former insisting on formal registration in the country of disputed use and the other insisting on proof of local reputation and goodwill in the country of disputed use. The enforcement of Darjeeling as a geographical indication is no exception to this, and is currently faced with either the problems expressed above, or similar challenges in France and USA.

**Costs of protection and enforcement for the industry and the government**

In the last four years, the Tea Board has spent approximately USD 200,000 on legal and registration expenses, costs of hiring an international watch agency and fighting infringements in overseas jurisdictions. This does not account for administrative expenses including manpower working on the job in the Tea Board, cost of setting up monitoring mechanisms, software development costs etc. It is a great challenge for every geographical indication right-holder to incur such expenses for protection.
Considering that protection of Darjeeling as a geographical indication is the responsibility of the Tea Board as a statutory body of the Government of India with other public policy objectives and concerns for the welfare of the average plantation workers and other interests involved in the industry, the exorbitant and phenomenal resources spent by the Tea Board for worldwide protection and enforcement constitute a significant drain on the already strained budgets of developing countries such as India. This is even harsher because India has geographical indications primarily in the field of agriculture and handicrafts. Nevertheless, the Tea Board has recognized the importance of protection and, despite the costs, has striven to ensure that Darjeeling tea is protected for the benefit of the producers and consumers.

**Case Study 8: Melton Mowbray Pork Pie**

Northern Foods Plc v The Department for Environment, Food and Rural Affairs & Anor [2005] EWHC 2971 (Admin) (21 December 2005); Case No: CO/3184/2005

The Claimant, Northern Foods PLC, challenged the decision of the Defendant, the Department of the Environment, Food and Rural Affairs (“Defra”) to forward to the European Commission an application by the Melton Mowbray Pork Pie Association (“MMPPA”) for the registration of “Melton Mowbray Pork Pie” as a protected geographical indication (“PGI”) under EC Council Regulation 2081/92/EEC. The decision was notified to the Claimant on 28 February 2005 in a lengthy reasoned letter and Defra forwarded the application to the Commission on 9 May 2005.

Melton Mowbray in Leicestershire in the 18th century became a popular region for fox hunting. The hunting season coincided with the slaughter of pigs. Some of the pork went into pork pies and these were popular initially with hunt servants and later with those hunting. In the early 19th century, pork pies originating in Melton Mowbray started to be carried to London. Although the early part of the 20th century saw a decline, the trade revived and in 1998 the MMPPA was formed to bring together producers of what they would claim to be the authentic Melton Mowbray pork pie.

The true Melton Mowbray pies as they are known must be baked without the help of a hoop or tin. Distinctive "hot-water pastry" must be used to allow the pie to stand unsupported in the oven. Uncured pork gives the meat a grey look. Around half of the pie should be high quality pork. No artificial colors, flavors or preservatives should be used. Animal fat content in pastry should be high to make pies distinctively moist.

The "geographical area" defined in the MMPPA application of GI covered a large area, including not only Leicestershire, but Nottinghamshire and parts of Northamptonshire and Lincolnshire.

Northern Foods Plc objected to this broad geographical coverage on the basis that the ‘defined geographical area’ for the purposes of Article 2(2) (b) and 4(2) of the EC Regulation 2081/92 is a specific place or region and not a wide geographical area. Therefore, the ‘geographical area’ defined in Article 4(2) (c) as part of the specification must be ‘Melton Mowbray’ and not areas outside or around Melton Mowbray; thereby asserting that Melton Mowbray pork pies should come only from Melton Mowbray. Northern Foods also stated that a registration on that basis would prevent not only most of the members of the MMPPA from selling their pork pies as "Melton Mowbray"; it would prevent the Northern Foods itself from doing so, quite apart from the specification of the contents of the pies. Further Northern Foods preferred no registration at all, although they suggested that "Melton Mowbray pork pies" could receive a "Traditional Speciality Guaranteed" (“TSG”) designation under a different regulation (2082/92).

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44 [http://www.guardian.co.uk/food/Story/0,2763,1672385,00.html](http://www.guardian.co.uk/food/Story/0,2763,1672385,00.html), [http://www.bailii.org/ew/cases/EWHC/Admin/2005/2971.html](http://www.bailii.org/ew/cases/EWHC/Admin/2005/2971.html)
The commercial motivation behind the opposing the registration of Melton Mowbray pork pies as GI is that the designation of the large area would protect one local producer Samworth Brothers, with 55 per cent share of the £50m (£74m) market for the pies, with a production site within the proposed area outside of the town, including a factory in Leicester city. Northern Foods with 25 % market share, has been producing pork pies labelled as "Melton Mowbray" since the 1800s (produces its brand of the pies at plants in Wiltshire and Shropshire, outside the designated area), while GEO Adams and Kerry Foods each hold six per cent.

In defending their position, DEFRA and MMPPA argued that the ‘defined geographical area’ under Article 2(2) (b) of the Regulation can be a wider area and that there were several GI registrations in the EU where the specification extends beyond the specific region. For example in the registration of Pruneaux d’Agen the region not only includes Agen, but other areas as well. Similarly in the case of Agneau de Pauillac the registration covers large areas other than Pauillac.

Further they drew attention to Articles 2(2)(b) and Article 4(2)

Article 2(2)(b) reads as:

"geographical indication [PGI] means the name of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff;
–Originating in that region, specific place or country, and
–Which possesses a specific quality, reputation or other characteristics attributable to that geographical origin and the production and/or processing and/or preparation of which take place in the defined geographical area "

Article 4(2) reads as:

“The product specification shall include at least:

(a) name of the agricultural product or foodstuffs, including the designation of origin or the geographical indication;
(b) a description of the agricultural product or foodstuff including raw materials, if appropriate, and principal physical, chemical, microbiological and/or organoleptic characteristics of the product or the foodstuff;
(c) definition of the geographical area
(d) evidence that the agricultural product or the foodstuff originates in the geographical area, within the meaning of Article 2(2) (a) or (b), whichever is applicable;
(e) a description of the method of obtaining the agricultural product or foodstuff…;
(f) details bearing out the link with geographical environment or the geographical origin within the meaning of Article 2(2) (a) or (b), whichever is applicable;”

Another case of relevance is the dispute concerning the Commission of the European Communities v the Federal Republic of Germany concerned an application by the Federal Republic of Germany reserving the appellations ‘Sekt’ and ‘Weinbrand’ to the domestic product. The ECJ ruled that ‘an area of origin which is defined on the basis either of the extent of national territory or a linguistic criterion cannot constitute a geographical area capable of justifying an indication of origin’, particularly as the products in question could be produced from grapes of indeterminate origin. [Case 12–74, Judgment, 20 February 1975]

Mr. Justice Crane dismissed the blocking action at the high court by ruling that Northern Foods’ main objection - that the proposed "region” of 1,800 square miles goes far beyond Melton Mowbray - was misconceived, and that many other European products had even bigger protected areas of origin.

This decision has major implications in the field of GI as it illustrates that even fairly old and well-established products whose names have not yet become generic, can be protected by Geographical Indications if the applications are appropriately constructed based on facts of the products.

On 14 March 2006, the Court of Appeal accepted the submission of Northern Foods that the link between the PGI and the defined geographical area should be clarified by the ECJ, considering the ‘real possibilities’ that Member States might be applying different criteria. Accordingly, the reference asks the court of Luxembourg to identify the criteria that must be applied in delimiting that defined geographical area referred to in Articles 2(2)(b) and 4(2)(c) of the Regulation.
CHAPTER 7

KNOTTY UNRESOLVED ISSUES AND THE CURRENT DEBATE

The major issues that are live in the international GI debate cover three main aspects namely:

a) to extend the enhanced level of protection afforded to wines and spirits in Article 23 of the TRIPs Agreement to all products

b) to create a legally binding multilateral register for GIs

c) new generation of TRIPS-plus GI and trademark standards being developed through regional and bilateral free trade agreements.

Two issues are debated under the Doha mandate, both related in different ways to the higher (Article 23) level of protection: creating a multilateral register for wines and spirits; and extending the higher (Article 23) level of protection beyond wines and spirits. Both are as contentious as any other subject on the Doha agenda.

GI Extension

In June 2005, the EC submitted a proposal for 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). Turkey, African group of countries, including Kenya, Nigeria and South Africa, Cuba, Czech Republic, Dominican Republic, Honduras, India, Indonesia, Nicaragua, Pakistan, Sri Lanka, and Venezuela support the proposal of an extended GI both to serve as a means of product differentiation and also as a legal framework for protection of traditional knowledge.

These countries have proposed an extension of the enhanced level of protection afforded to wines and spirits in Article 23 of the TRIPs Agreement to all products, including agricultural products, processed foods, beverages and handicrafts as they consider the protection afforded to such products under the TRIPS Agreement is grossly inadequate.

In contrast, several submissions to the WTO such as "US Submissions on GIs at the WTO TRIPS Council: ‘Joint Proposal for a Multilateral System of Notification and Registration of Geographical Indications for Wines and Spirits’, Communication from Argentina, Australia, Canada, Chile, Ecuador, El Salvador, New Zealand and the United States, TN/IP/W/9, 13 April 2004; ‘Multilateral System of Notification and Registration of Geographical Indications for Wines (and Spirits)’, Communication from Argentina, Australia, Canada, Chile, New Zealand and the United States, TN/IP/W/6, 29 October 2002; 'Proposal for a Multilateral System for Notification and Registration of Geographical Indications for Wines and Spirits based on Article 23.4 of the TRIPS Agreement, 'Communication from Argentina, Australia, Canada, Chile, Colombia, Costa Rica, Dominican Republic, Ecuador, El Salvador, Guatemala, Honduras, Japan, Namibia, New Zealand, Philippines, Chinese Taipei, and the United States, TN/ IP/W/5, 23 October 2002, propose a divergent view on the same subject.

These countries come with the opposing view that the protection afforded to products other than wines is adequate but have consented to continue their participation in consultations related to the issues related to GI-extension. Their concern is that the costs of GI-extension far outweigh any perceived benefits.

Europe which is fairly advanced in its GI system and infrastructure with over 700 registered GIs is pressing hard on the GI Extension issue at it would be able to fruitfully leverage the benefits of an expanded multilateral system of GI protection. Similarly developing countries such as China, India, and Kenya are supporting this proposal as they hope to exploit the protection afforded by this system to their agricultural GIs. They further claim that the extended protection would provide a good platform for the desired

sustainable development of rural communities, including increased food security for those without cash incomes, and the promotion of environmental biodiversity. 46

On the other hand, given the cost of establishing and maintaining the institutions necessary for intellectual property protection, serious doubts remain over the ability of those countries less advanced or less advantageously situated to benefit from additional GI protection. In as much as these differing needs and capacities have been recognized in ongoing negotiations in the WTO over the last decade, no ready solution to the further global harmonization of GIs has been found to date.

Controversy therefore surrounds the interpretation of Article 24, which somewhat ambiguously obliges Members to enter into negotiations ‘aimed at increasing the protection of individual geographical indications under Article 23’, while simultaneously ensuring that there is no reduction in ‘the protection of geographical indications that existed in that Member. 47

The multilateral register for GIs

In June 2005, the EC also submitted a proposal [IP/C/W/107/Rev.1 (on the GI register)] for the inclusion of an annex to the TRIPS Agreement establishing a multilateral system of notification and registration of geographical indications (GIs) by a three-step process namely:

1. WTO Members would notify their GIs and the WTO Secretariat would publish all notifications.
2. WTO Members would have 18 months to examine the notifications and would have the right to object to the registration of a notified GI. In such a case, the Members concerned would start bilateral negotiations aimed at resolving the disagreement.
3. The notified GI would be registered in the multilateral register with reference to any challenge.

Article 23.4 of the TRIPs Agreement mandates negotiations for the establishment of a multilateral register for wines to “facilitate the protection of geographical indications”.

The EC proposal is for a legally binding international register which would apply to all products in line with its proposal for GI-extension. If the EC proposal is accepted, it would imply that notification of a geographical indication by one country would in effect suggest the protection of the notified GI in all WTO Members. Thus under the circumstances, registered GI could no longer be claimed:

(a) not to be in conformity with the definition of GIs in the TRIPS Agreement
or

(b) to be false homonymous (literally true but misleading)
or

(c) to be a generic name.

For example if the EC notifies ‘feta’ as a GI, then other Members of the WTO would be required to prevent the term ‘feta’ from being used in their countries as it would be the sole right of the producers from Greece, unless the registration is successfully opposed on the grounds of one of the exceptions in TRIPs Article 24, such as the product being a generic term in that Member Country.

This is perceived by several of the countries such as Argentina, Australia, Canada, Chile, Costa Rica, Dominican Republic, Ecuador, El Salvador, Honduras, Japan, Mexico, New Zealand, Chinese Taipei and the US, opposing this proposal with their concerns that it would in effect unduly drag the governments into a multilateral dispute settlement process in an arena that has normally been private commercial rights [TN/IP/W/10]. These countries have made the alternative ‘Joint Proposal’ for the creation of a voluntary


register that WTO Members could consult when affording protection to wine and spirit GIs. This system would increase information flows and “facilitate the protection of geographical indications,” as required by the TRIPS Agreement, without being unnecessarily burdensome.

**Hong Kong, China** has proposed a compromise (document TN/IP/W/8). Here, 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.

At the heart of the debate are a number of key questions.

When a geographical indication is registered in the system, what legal effect, if any, would that need to have within member countries, if the register is to serve the purpose of “facilitating protection” (the phrase used in Article 23.4)? And to what extent, if at all, should the effect apply to countries choosing not to participate in the system. There is also the question of the administrative and financial costs for individual governments and whether they would outweigh the possible benefits.

Opinions are strongly held on both sides of the debate, with some highly detailed arguments presented by each side. As an idea of the issues under negotiation, the main headings of the latest WTO Secretariat compilation (TN/IP/W/12) are:

- Preamble
- Legal form
- Participation
- Notification (mandatory elements, optional elements, format and other aspects)
- Registration (“formality examination”, reservations, content of registrations, form of register)
- Consequences of registration (in participating members, in non-participating members, in least-developed country members)
- Duration and renewal of registrations
- Modifications and withdrawals of notifications and registrations
- Fees and costs

These issues also need to be resolved.

A third contentious issue specifically related to the EU relates to what is termed as “Clawback”.

Negotiations are underway on the issue of “Clawback” proposal of the EC which has produced a list of 41 products, such as ‘feta’ and ‘parmesan’ for the exclusive use of its own producers.

Whereas under GI-extension the exceptions in TRIPS Article 24 would continue to apply, it is perceived by several Member States that ‘clawback’ would remove them, and with them, the ability of WTO Members to use established trademarks and generic terms.

It is further perceived by the opposing parties that many of the products on the EC’s clawback list are widely considered generic in world markets, and are often produced in much larger quantities by WTO Members other than the EC itself. This would cause costly disruption to global trade by granting the European producers monopoly rights over the use of certain terms whilst putting non-EC producers and consumers at a disadvantage. Higher costs flowing from the need to re-label and re-market products would be passed on to consumers.

While opposing the EU proposal, the example of FETA Cheese is cited by Australia pointing that the Australian supermarkets currently stock Australian feta, Greek feta, Bulgarian feta and Danish feta. Under the EC’s clawback proposal, only the Greek feta could be labeled as feta and all the other types would have to be renamed. This would be costly to producers and manufacturers and confusing for consumers who have been used to having the choice to buy feta of all kinds for decades. Such an outcome would be essentially protectionist and monopolistic and contrary to the trade liberalizing goals of the Doha Round. These contentious issues also continue to figure as subject matter of debates in the WTO.

The following arguments against extension were made in a TRIPS Council paper (IP/C/W/298) by Argentina, Australia, Canada, Chile, Guatemala, New Zealand, Paraguay and the United States:
• the costs of implementing new laws and administrative mechanisms that would be necessary to fulfill new TRIPs obligations;

• the administrative and financial burden of providing ‘additional protection’ to a large number of other Members’ GIs;

• possible closing-off of future market access opportunities for emerging industries, and uncertainty concerning the continued use in existing markets;

• differential impact on Members (and industry), particularly Members that do not already have elaborate TRIPs-plus systems in place;

• consumer confusion caused by re-naming and re-labeling of products; and

• heightened risk of disputes over GIs between WTO Members and between producers in WTO Members
Annex I

G.I. - APPLICATION NUMBER – 44

Kondapalli Bommalu

Reproduced from Pages 32-40 from Geographical Indications Journal August 1st 2006

Application is made by (a) Lanco Institute of General Humanitarian Trust (LIGHT) and (b) Kondapalli Wooden Toys Manufacturers Mutually Aided Purchase And Sales Co-Operative Society Limited for the registration in Part A of the register of Kondapalli Bommalu under Application No.44 in respect of Stationery, artist materials, instructing and teaching material, printing block falling in Class. 16, collectibles, souvenirs, mementos, artifacts, awards, prices and gifts being goods (not included in other classes) of wood falling in Class.20, Wall hangings (non-textile) falling in Class.27 and Games, playthings, sporting articles not included in other classes, decoration for Christmas trees falling in Class.28 is hereby advertised as accepted under sub-section (1) of section 13 of Geographical Indications of Goods (Registration and Protection) Act, 1999.

Applicant: (1)  Lanco Institute of General Humanitarian Trust (LIGHT)
(2)  Kondapalli Wooden Toys Manufacturers Mutually Aided Purchase And Sales Co-Operative Society Limited

Address : (1)  Lanco Institute of General Humanitarian Trust (LIGHT),
Lanco House, 141, Avenue 8, Road No. 2, Banjara Hills, Hyderabad 500 034, Andhra Pradesh.
(2)  Kondapalli Wooden Toys Manufacturers Mutually Aided Purchase And Sales Co-Operative Society Limited,
Kondapalli, Ibrahimpatnam Mandal, Krishna District, Andhra Pradesh.

Geographical Indication: KONDAPALLI BOMMALU

Class: 16, 20, 27 & 28

Goods: Class 16    Stationery, artist materials, instructing and teaching material, printing blocks
       Class 20   Collectibles, souvenirs, mementos, artifacts, awards, prices and gifts being goods (not included in other classes) of wood
       Class 27   Wall hangings (non-textile)
       Class 28   Games, playthings, sporting articles not included in other classes, decoration for Christmas trees.

(a) Name of the Applicant: (1) Lanco Institute of General Humanitarian Trust (LIGHT)
(2) Kondapalli Wooden Toys Manufacturers Mutually Aided Purchase and Sales Co-Operative Society Limited

(b) Address: (1) Lanco Institute of General Humanitarian Trust (LIGHT), Lanco House, 141, Avenue 8, Road No. 2, Banjara Hills, Hyderabad 500034, Andhra Pradesh.
(2) Kondapalli Wooden Toys Manufacturers Mutually Aided Purchase And Sales Co-Operative Society Limited, Kondapalli, Ibrahimpatnam Mandal, Krishna District, Andhra Pradesh.

(c) List of association of persons/Producers/ organization/authority:
To be provided on request

(d) Type of goods: Handicrafts

(e) Specification:
The toys can be easily differentiated form other wooden toys by their **weight**, which is the most important and distinct characteristic feature. Also, the aesthetic carving of the shape of toys are carved in such a manner that the finished product, that is the toy, has a lifelike quality which is expressive of rural ambience and village life. There is no particular size for the toys and the same theme is made in different sizes to suit the taste and the surface area for beautification.
(f) Name of the geographical indication (and particulars) :
KONDAPALLI BOMMALU

(g) Description of the goods:
Kondapalli Bommalu is delightful expressions of art of rich traditional value made from the wood of 'Tella Poniki' also called 'White Sander' (botanically called Juotia Rotteri Fromis). The trees are found in the forests and hills adjoining Kondapalli. The toys and figures are of different sizes and shapes. The utter simplicity and expressive features of these toys and figures are disarming as they portray various themes of village life and also spiritual themes. The toys traditionally depict mythological characters, occupational figures like the village potter, fisherman, and toddy tapper, besides rural folk and their animals and birds.

The famous forms and figures of Kondapalli Bommalu are Elephant (Ambari), Dashaavataraalu. These exquisite pieces of art made by the artisans conveying the said themes fall in three distinct categories:

1. animals and birds,
2. male and female figures depicting rural life, &
3. mythological figures.

These toys and figures of wood are painted in bright and vibrant colours which are very pleasing and appealing to the eye. For painting the toys vegetable or enamel colours are used. These are prepared by the artisans themselves form locally available materials which are extracts of plants like Karakkai, Moduga etc.

Kondapally Bommalu is unique, being light in weight, not easily breakable and brightly colored are considered to be the best. The artisans are excellent wood carvers who have also carved vahanas or vehicles for the presiding deities in the temples. They make temple cars and chariots strictly in accordance with tradition. The artisans are not only experienced but are also well versed in the theoretical aspects of the craft. They have adopted the South Indian style of architecture of wood, which is evident in their work. The popular classical collection includes Dasavatara, the Sitopadesa, and toys depicting events associated with the life of Lord Krishna. The mythological toys pose a great challenge, as they require skill in portraying half-human and half-animal god figures.

The village set constitutes toys of various occupations of people in the village as mentioned earlier. The artists choose colors symbolizing the character of the image. They display a perfect blending of science, aesthetics and religion in their work. The skilled craftsmanship of the artisans and the use of the instruments 'bahudara' and 'palapu chekka' (described in the production process) is a very unique feature in the production of Kondapalli Bommalu.

(h) Geographical area of production and Map as shown in the page No.
The Kondapalli Bommalu are produced/ made at Kondapalli Village, located about 20 kilometers from Vijayawada, in Krishna District of the state of Andhra Pradesh in India. The area of production i.e. Kondapalli village lies in between longitudes 80 degree 31’ 28”E and 80 degree 32’ 32”East, and between latitudes 16 degree 37’ 30”N and 15 degree 36’ N, covering an area of 1.5 sq kilometers.

(i) Proof of origin [Historical records] :
There is a legend regarding the origin of Kondapalli. It says that the word Kondapalli has been derived from the name of a shepherd named ‘Kondadu’ who showed the site to a Kondaveedu Reddi King and hence it was called Kondapalli. A fort named ‘Kondapalli Fort’ was built in this place during the region of King Anavema Reddy in 1360 A.D. It was however during the rule of the Qutab Shahis that Kondapalli gained paramount importance and fame as a hill fortress. The Sultans re-christened it as Mustafanagar. Later, the British East India Company considered it as a strategic location and a military school existed here till 1859.

Though Kondapalli has lost its past medieval glory, it still retains its high and rich tradition in the sphere of fine arts with its world famous toy craft, namely Kondapally Bommalu.

The art of making Kondapalli Bommalu started about 400 year ago. Thereafter, the craft developed and attained perfection. The craftsmen take up wood sculpture and painting as their hereditary profession. The unique toys now marketed are the result of perfection, quality and reputation acquired over the past 400 years. In this regard The Imperial Gazetteer of India (1909) states as follows,
“At Kondapalli there is a special industry - involved in the manufacture of small figures and toys from a light wood which grows on the hills.” There is also reference to this group of people in the “Brahmmanda Purana”.

This community claims its origin to Muktharishi, who is said to have been endowed with skills in arts and crafts by Lord Shiva himself. These chitrakaras (craftsmen) claim that it was their ancestors who sculpted the numerous sculptures like the garuda, nandi, simha and the vahanas in the many temples in Andhra Pradesh. For some years in the past there was neglect of the interests and development of the Kondapalli artisans due to the advent of mechanized toys. But now in recent years the scenario has completely changed. The Government, Governments departments, certain institutions and organizations are giving a helping hand in developing this industry.

(j) Method of Production:
Kondapalli Bommalu are made by a sequential process starting from the selection of good quality wood of Tella Poniki Trees till the toy is painted and dried.

Selection of Wood, Cutting and Seasoning -
Healthy and mature trees of ‘Tella Poniki’ also called ‘White Sander’ (botanically called Jiuotia Rotleri Fromis) that have reached a height of minimum 10 –15 feet and 2-3 feet bark diameter are selected from the nearby forests of Kondapalli for making Kondapalli Bommalu. The selected tree is cut/ chopped into wood of manageable pieces. The freshly cut wood is usually heavy in weight. It is allowed to dry in the sun for about month. This is called seasoning. During this time the cut wood looses sufficient moisture and becomes light and soft, to the extent that you can cut through the wood with ease. This makes it suitable to carve interesting figures (i.e. for artistic wood carving). It is to be noted that proper seasoning is very important. For wood not seasoned properly or for long enough becomes worm infested and unusable for toy making. As such no external pest control measure is adopted.

Cutting Into Desired Sizes -
The dried wood is then cut into pieces according to the desired size of the toy to be made, by using an axe.

Carving -
Then, a “BAHUDARA” is used to carve the desired shape of the toy. Bahudara is an instrument used to carve the soft wood in order to get the desired shape. This Instrument is unique in the production of Kondapalli Bommalu.

Filing –
The carved soft wood is then filed using a shaper so as to give it a better shape.

Joining of parts/ pieces –
Then the artisan joins the shaped wood pieces (i.e. glue them together) by using a locally prepared adhesive called temma jiguru. Temma Jiguru is the gum used for gluing, prepared as per traditional methods. Now synthetic glues are also being used to reduce cost. Thus the outer look of the toy is prepared.

Final Stage: Concealment of signs and joints –
This skeleton of the toy has rough and square edges. These edges are rounded to give the toy a smooth body by applying ‘makku’. This gives final shape to the toy. This also conceals all signs and joints. ‘Makku’ is made by boiling a mixture of finely ground powder of tamarind seeds and saw dust in water until it becomes a smooth paste. It is applied using a tool called ‘palapu chekka’. This tool is a thin and smooth piece that fits comfortably in ones hands, made by filing a cow’s horn into a smooth oval shaped device. The use of this tool is also a unique feature in the production process.

Finishing Process:
a) Application of Lime –
When the makku dries completely, the toy with its smooth edges and all basic components resembles the final shape. But it as such is not yet finished. Its initial finish is brought about by skilfully applying a coat of lime mixed with ‘tumma jiguru’ through a brush. All the tasks until this point are usually done by men in the family. Then the women of the family take over to finish the toy.

b) Coloring -
The next step involved is the coloring of the toys. For a few toys, wood primer is first applied before coloring. In other cases vegetable colors and/ or enamel colors are used for painting. (In olden days,
artisans used vegetable colors which involved a lengthy process for its extraction. Later on chemical colors came into use, which were found to be dangerous if consumed accidentally and so its use was discontinued. So at present only enamel colors and vegetable colors are used for painting the toys. These vegetable colors are prepared by the artisans themselves from locally available material which is extracts of plants like Karakkai, Moduga etc. The painting is done by brushes made of goat hair. Now ordinary paint brushes available in the market are also used.

**Uniqueness:**
Kondapalli Bommalu are unique in quality, reputation and other characteristics. They are defined to the following effect; “Kondapalli Bommalu are exquisite pieces of art

A) originating from the geographic region of Kondapalli Village in the State of Andhra Pradesh, India, and

B) made from the cut and seasoned soft and light wood of Tella Poniki by hand carving using a special chisel Bahudara and painting with vegetable and/or enable colors in bright and vibrant colors appealing to the eye, so as to portray and depict themes relating to spirituality and village life falling under any one or more of the following three distinct categories namely;

1) animals and birds,
2) male and female figures depicting rural life, and
3) mythological figures.

**Inspection Body:**
The applicants have informed that they are towards the establishment of an Inspection Structure in consultation with Government Agencies.

**Other:**
They are used during the traditional “BOMMALA KOLUVU” OR KOLLU where dolls are displayed ceremoniously during the Dasara festival. The export market has good potential. The Andhra Pradesh Handicrafts Development Corporation (APHDC) plays a vital role in marketing and export. It is heartening to note that many of the children of the craftsmen intend to continue with their hereditary craft. Long term and short term action plans are being made by the authorities concerned for imparting training, packaging and marketing of the toys which are a pride of Andhra Pradesh and our country.
BIBLIOGRAPHY


Two outstanding – and longstanding - issues under the TRIPS Agreement have been subsumed within the Doha Work Programme (DWP). Both relate to geographical indications (GIs): first, the development of a multilateral register of GIs applying to wines and spirits and, second, the proposal to extend the higher levels of protection offered by the TRIPS Agreement to GIs on wines and spirits to other products. Support for and opposition to both these initiatives are highly polarized, with WTO members taking deeply entrenched positions. The supporters of GIs often state that results in these two areas are a necessary condition for a settlement in the agriculture negotiations. However, opponents and skeptics claim that GIs are a damaging form of protectionism. Little progress has been made on these dossiers for years, yet there is increasing insistence that some movement will be necessary in the coming months if the Ministerial Conference to be held in Hong Kong, China in December 2005 is to be a success. Are GIs a negotiating chip that will eventually be taken off the table for some other concession? At this point, that question has no answer.

2. Website of GIANT (Geographical Indications & International Trade)
   http://www.american.edu/ted/giant/Case%20study%20map/casestudies2.html

   A portal that lists a large number of GIs as Case Studies.

3. Consorzio per la tutela del formaggio Gorgonzola v Käserei Champignon Hofmeister GmbH & Co. KG and Eduard Bracharz GmbH.

4. Briefing Rooms: WTO: Beyond the Agreement on Agriculture Website of USDA
   http://www.ers.usda.gov/Briefing/wto/geoindications.htm

   Presents a discussion on issues related to naming rights and EU proposals for GIs. Issues vis-à-vis USA on protection of GI matters are also discussed. Certification marks of IDAHO Patato and Florida Oranges are also illustrated.

5. Enjoying a Good Port with a Clear Conscience: Geographic Indicators, Rent Seeking and Development

   The European Union is attempting to have the protection of geographic indicators strengthened in the WTO. There may be sufficient rents and other benefits available to justify this strategy in the negotiations. To achieve its rent-seeking goals, however, the European Union needs allies at the negotiations. It has been courting developing countries by touting the benefits of geographic indicators for their products. For most products originating in developing countries, the opportunities for rents will first have to be created, a resource-intensive and problematic activity. Further, even if rents can be created in the short run, the forces of competition are likely to erode them. Scarce resources might be better utilized on other development strategies that are more likely to yield sustainable development.

6. Geographical Indications
   http://www.geographicindications.com/index.htm

   A portal of varied information on GIs, including national laws, international regimes, academic research, GI in practice, Discussion groups, Contacts in various countries, etc.

7. A Preliminary Database of Worldwide Geographic Indications (not including wines and most spirits)
   http://www.american.edu/ted/giant/global_analysis.doc

   A preliminary list of potential GI products from around the world. The database focuses on products largely that are not spirits or wines, although some spirits are included. Of the 800 cases we include
over 600 alone come from countries in the European Union. This reflects the types of recognition accorded these products rather than the number of potential GIs in other countries. Also focuses on the rest of the world.

8. UNCTAD-ICTSD project on IPRs and Sustainable Development
http://www.iprsonline.org/unctadictsd/docs/order_form_web.pdf
Lists titles of several papers that discuss diverse aspects of GI Origin, Prominence, Profit, and Consumer Confusion: An Analysis of the

9. Global Debate on Geographical Indication Protection Systems Arinolayemi A. Adegbonmire and L. Taylor Arnold
http://www.law.wfu.edu/prebuilt/IPLJ_Spring2004_Arnold.pdf
This paper explores the nature of this international intellectual property debate. It outlines the international trade issues implicated and the treaty-mandated framework for their resolution. It discusses various methods for protecting implicated intellectual property, and highlight areas of overlap and conflict among the alternatives. Finally, the bilateral use of certification marks are proposed as a solution to address conflict among the various alternative intellectual property protection methods, and as a method of throwing light onto the deeper, more elusive, and controversial contemporary trade issues.

http://www.iprsonline.org/unctadictsd/docs/GI%20paper.pdf
Demanding Stronger Protection for GI. The Relation between local knowledge, Information and reputation. [2004]
Dwijen Rangnekar
http://ideas.repec.org/p/dgr/unuint/200411.html
Reviews present discussions on GI and especially on the debates based on the submissions made at the TRIPS Council. It addresses various aspects of the ongoing international debates of GI-extension, the ‘negotiating balance’ achieved at the Uruguay Round; insufficiencies of the scope of protection available under Article 22; and the potential impact on trade and consumers. One area of contention is the explicit hierarchy in the level of protection, whereby indications for wines and spirits are offered stronger protection through Article 23 that indications for other products through Article 22. Further issues related to costs associated with implementing GI-extension, costs arising from consumer confusion and costs on account of trade.production disruption have been considered as a growing concern and there is a divide between various members of the WTO. It also presents a detailed analysis of the terms ‘indication of geographical origin’ (IGO), geographical indication, indication of source or appellation of origin and their relationship with Trademarks.

11. The Socio-Economics of Geographical Indications, Dwijen Rangnekar ICTSD- Bridges, Year 8 No.8, Sept. 2004. p.20-21
http://www.iprsonline.org/unctadictsd/docs/CS_Rangnekar2.pdf
This paper is a continuation of the earlier papers of the author and collates and critically reviews evidence on GIs from several European case studies.

http://www.wipo.int/geo_indications/en/
This site covers diverse aspects of GI including various treaties, agreements, definitions, including links to articles titled “Making the Origin Count: Two Coffees …. And a Tea” - WIPO Magazine, issue no. 2007/5, “From Darjeeling to Doha” (including: “Tasting Success in China”) - WIPO Magazine, issue no. 2007/4 and the papers that were presented in the 2007 International Symposium on GIs (Beijing, June 26 to 28).

14. Common Labels and Market Mechanisms  Christine Boizot-Szantaï, Sébastien Lecocq, Stéphan Marette  
http://www.ivry.inra.fr/corela/docs/Eggs.pdf

In this article, the impact of common labels is investigated with both theoretical and empirical approaches. Recent statistics regarding the egg market in France suggest that retailer brands largely adopt common labels. A simple theoretical framework enables us to determine the conditions under which producers and/or retailers with different product qualities decide to post a common label on their products. In particular, a situation of multiple equilibria (one where the label is used by the high-quality seller only and one where it is used by the low-quality seller only) is exhibited when the cost of the label is relatively large. The demand is then estimated for different segments of the French egg market, including producer/retailer brands with/without common labels. The estimates are used to derive expenditure and price elasticities, and allow us to calculate welfare measures revealing a relatively large willingness-to-pay for labels.

15. IPR Helpdesk  
http://www.ipr-helpdesk.org/controlador/resources/showDocument?len=en&idFicha=0000003653&formato=xml_html&nomFichero=GeographicalIndications&idFichero=00&cod_padre=t_01.04.02.01

This site has detailed description of the GI system in Europe and also has links to the text of the Council Regulation (EC) No. 510/2006 of March 2006 on the protection of GIs and designations of origin [http://www.ipr-helpdesk.org/controlador/services/search?counter=0&len=en&resource=document&text=geographical%20indications]

16. Geographical Indications and Property Rights: Protecting Value-Added Agricultural Products Bruce A. Babcock and Roxanne Clemens  
MATRIC Briefing Paper 04-MBP 7 May 2004  
http://www.card.iastate.edu/publications/DBS/PDFFiles/04mbp7.pdf

This article describes and contrasts three systems of protecting property rights for agricultural products (certification mark, E.U.-wide GI, and WTO GI) and discusses some of the benefits and problems of each system and the effects of each system on helping to differentiate and protect high-value U.S. agricultural products.

17. The protection of geographical indications after doha: quo vadis?  
G. E. Evans* and Michael Blakeney  
http://ideas.repec.org/a/oup/jieclw/v9y2006i3p575-614.html

This paper examines the two major regulatory models advanced by the European Union and the United States of America for the protection of GIs. In the light of the Doha Development Agenda, the authors argue in favour of an incremental approach that would allow developing countries the flexibility to adjust additional protection in accordance with their level of economic development.

http://ethesis.helsinki.fi/julkaisut/oik/julki/pg/rovamo/

The thesis attempts to articulate the underlying reasons, justifications, principles and policies behind the protection of GIs in the EC and then elaborates the scope and shape of the GI system. The essential questions it attempts to answer are (1) What is the basis and criteria for granting GI rights? (2) What is the scope of protection afforded to GIs? and (3) Are these both justified in the light of the functions and policies underlying granting and protecting of GIs? It also discusses cases such as The Rioja case, Parma Ham case, and the Budějovické pivo or Budweiser Beer case. It documents a very rich bibliography.

19. Impacts of the IPR rules on Sustainable Development Contract No. SCS8- CT-2004-503613; Workpackage 3;
Assessing the Applicability of Geographical Indications as a Means to Improve Environmental Quality in Affected Ecosystems and the Competitiveness of Agricultural Products [Final Report], Mariano Riccheri, Benjamin Görlich, Stephanie Schlegel, Helen Keefe, Anna Leipprand, in collaboration with Graham Dutfield and Dwijen Rangnekar
http://www.underutilized-species.org/Documents/PUBLICATIONS/wp3_final_report.pdf

This is a recent exhaustive analysis of the review on and the existing and potential links that can be established between current Geographical Indications (GIs) and regional sustainable development especially in relation to the Competitiveness of Agricultural Products from EU regions, Candidate Countries and Developing Countries. It has followed a case study approach, centred on European case studies, as the European Union was considered to be proper laboratory to study socio-economic and environmental effects. GI measures, since it possesses a strong system, with a strong market importance and long standing tradition in the trade of "local" products as well having a well established, "special" or sui generis legal system of protection. In addition, despite a single legislation, there are different national uses regarding GIs, with countries like Spain, France or Italy which have adhered to "sui-generis" systems long before the a common European Regulation3 was established, and others such as the UK or the northern European countries which have protected indications through general laws of unfair competition, passing-off and/or trademark law.

20. Emerging Issues for Geographical Indication Branding Strategies
Sanjeev Agarwal and Michael J. Barone
MATRIC Research Paper 05-MRP 9, January 2005
http://www.card.iastate.edu/publications/DBS/PDFFiles/05mrp9.pdf

Branding strategies centering on the geographical origins of a product can provide a basis for differentiating commodity products. The use of such "geographical indications" (or GIs) can involve unique quality characteristics associated with a particular location or quality images that are based on the history, tradition, and folklore in a region. This paper describes the benefits and pitfalls (such as the threat of new entrants, oversupply, the broadening of boundaries to include more producers, and limiting generic use of such names) of using GI branding strategies. It also focuses on trademark issues germane to a company’s ability to (1) adopt GI-based trademarks as a means of gaining a competitive advantage and (2) protect the rights associated with such marks in order to sustain this source of competitive advantage.

21. GEOGRAPHIC ORIGINS DATABASES

WIPO - Lisbon Structured Search
http://www.wipo.int/ipdl/en/search/lisbon/search-struct.jsp
The Lisbon Express database contains information on all the appellations of origin entered, in accordance with the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, in the international register kept by the WIPO International Bureau.

EU - Database of Origin and Registration (DOOR)
The Database of Origin & Registration (DOOR) project supports the agricultural product quality policy by providing a modern IT system for the dissemination of public data with regard to registered PDOs (Protected Designations of Origin), PGIs (Protected Geographical Indications) and TSG (Traditional Specialities Guaranteed).

22. O’Connor and Company….website on GI
http://www.oconnor.be/content/practice_areas/geographical_indications.html
This site contains important information on GIs and also articles on various aspects of GI.

23. Information on GI in Canada
http://www.agr.gc.ca/itpd-dpci/english/topics/tripsqsas.htm
http://www.agr.gc.ca/itpd-dpci/english/topics/tripsqsas_protection.htm
In addition to answering questions on GI and Certification Mark systems in Canada, it lists examples of registered GIs in Canada.

24. The History and Future of Geographical Indications in Europe and the USA Raffi Melkonian [2005]
http://leda.law.harvard.edu/leda/data/689/Melkonian05.html
This student paper traces the history of geographical indication protection for food products through French, American, and European history, attempting to show that current disagreements on the substance of such protections stem from the details of regulation rather than some fundamental distinction in legal regime. The author recommends a negotiated solution to the current standoff between the world’s two most important trading power, which he believes to be possible without serious deviation from either European or American precedent.

25. The Recent International and Regulatory Decisions about Geographical Indications
Stéphan Marette, Roxanne Clemens, and Bruce A. Babcock
http://www.card.iastate.edu/publications/DBS/PDFFiles/07mwp10.pdf

As worldwide consumer demand for high-quality products and for information about these products increases, labels and geographical indications (GIs) can serve to signal quality traits to consumers. However, GI systems among countries are not homogeneous and can be used as trade barriers against competition. Philosophical differences between the European Union and the United States about how GIs should be registered and protected led to the formation of a WTO dispute settlement panel. This paper discusses the issues behind the dispute, the World Trade Organization (WTO) panel decision, and the EU response to the panel decision leading to the new Regulation 510/2006. Given the potential for GI labels to supply consumer information, context is provided for the discussion using recent literature on product labeling. Implications are drawn regarding the importance of the panel decision and the EU response relative to GI issues yet to be negotiated under the Doha Round.


The Newsletter highlights the pending issues to be negotiated related to GIs at the WTO.

27. Geographical Indications: Distinguishing the Uniqueness of BioTrade Products … Issue No.10, Feb 2007 from BioTrade Facilitation Programme
UNCTAD

This is a Technical Update on various issues related to GI especially in the developing and least developed countries.

http://www.aidv.org/Reims

This article illustrates issues related to GI and Trademarks with the help of several case studies.


This report presents 7 case-studies of Geographical Indications in various parts of the world. Each casestudy is presented according to a common template in order to highlight similarities and differences.