

TPP's *coup de grâce* for shield against becoming generic

Trademark system victorious as GI system

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How are geographical names used?

1. As a geographical designation of products



2. To refer to non-geographical qualities of products



3. To evoke a certain associations or sense of aesthetics



EU's list to re-propertization “generic” geographical names

Beaujolais; Bordeaux; Bourgogne; Chablis; Champagne; Chianti; Cognac; Grappa di Barolo, del Piemonte, di Lombardia, del Trentino, del Friuli, del Veneto, dell'Alto Adige; Graves; Liebfrau(en)milch; Malaga; Marsala; Madeira; Médoc; Moselle; Ouzo; Porto; Rhin; Rioja; Saint-Emilion; Sauternes; Jerez, Xerez

Asiago; Azafrán de la Mancha; Comté; Feta; Fontina; Gorgonzola; Grana Padano; Jijona y Turrón de Alicante; Manchego; Mortadella Bologna; Mozzarella di Bufala Campana; Parmigiano Reggiano; Pecorino Romano; Prosciutto di Parma; Prosciutto di San Daniele; Prosciutto Toscano; Queijo São Jorge; Reblochon; Roquefort

Terroir: “product’s qualities come with the territory”

- Soil
- Climate
- Grapes
- Savoir-faire

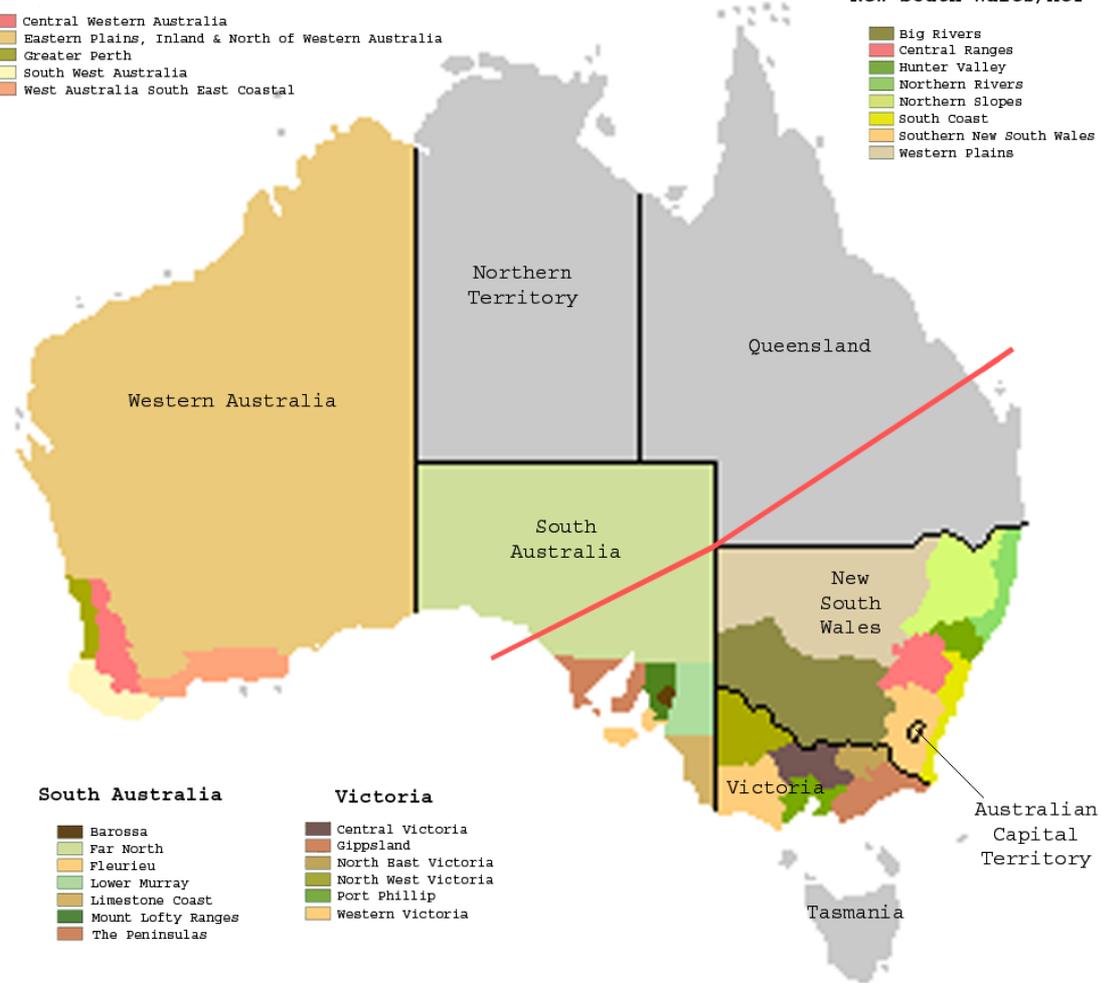


Western Australia

- Central Western Australia
- Eastern Plains, Inland & North of Western Australia
- Greater Perth
- South West Australia
- West Australia South East Coastal

New South Wales/ACT

- Big Rivers
- Central Ranges
- Hunter Valley
- Northern Rivers
- Northern Slopes
- South Coast
- Southern New South Wales
- Western Plains



Definitions AO and GI

Art 2 Lisbon Agreement (AO)

(1) "AO" means the geographical denomination of a country, region, or locality, which serves to designate a product originating therein, the **quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors**

Art 2 Geneva Act Lisbon Agreement (AO + GI)

(1)(i) any denomination known as referring to such area, which serves to designate a good as originating in that geographical area, where the **quality or characteristics of the good are due exclusively or essentially to the geographical environment, including natural and human factors, and which has given the good its reputation**; as well as
(ii) any indication which identifies a good as originating in that geographical area, where a given **quality, reputation or other characteristic of the good is essentially attributable** to its geographical origin.

Art 22(1) TRIPS (GI)

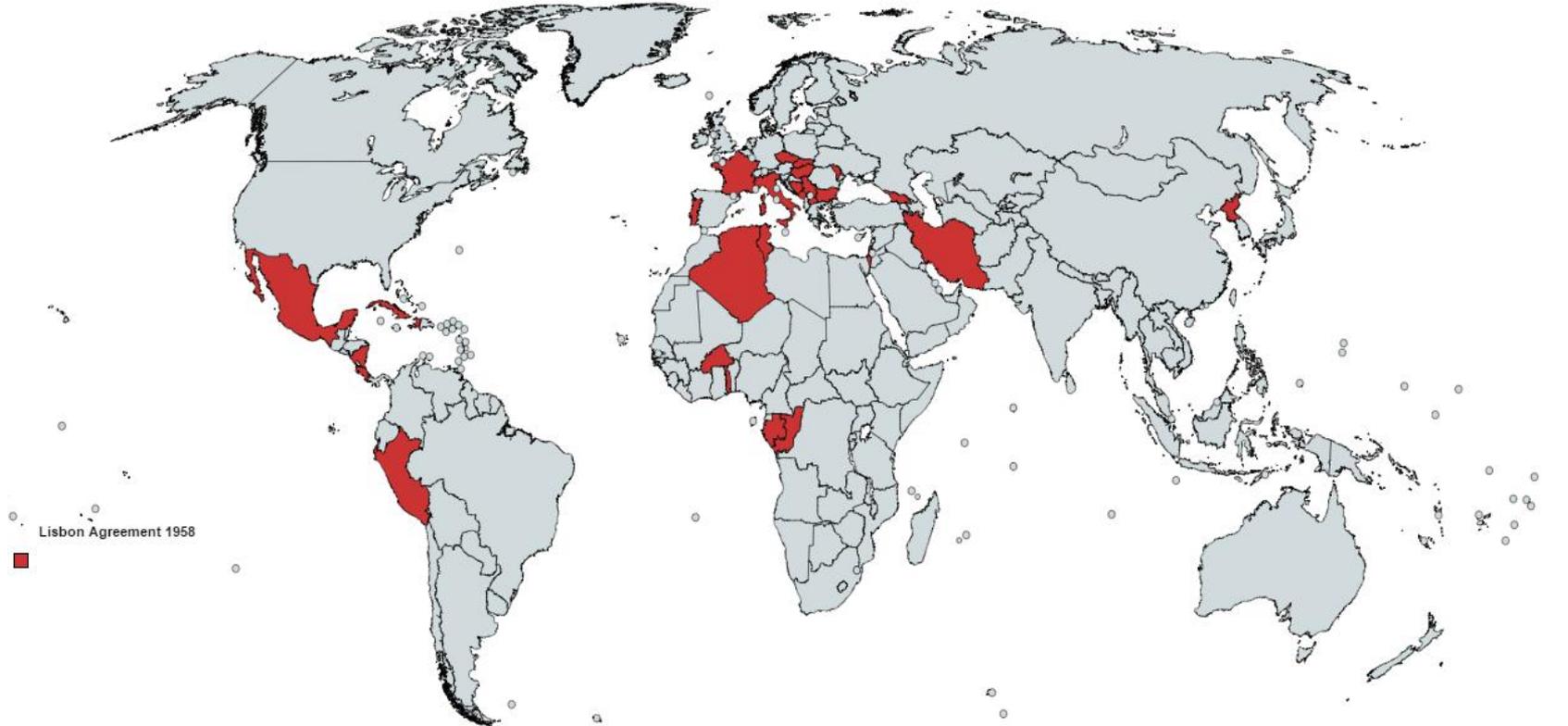
GI are, for the purposes of this Agreement, indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given **quality, reputation or other characteristic of the good is essentially attributable to its geographical origin**.

Art 18(1)(1)(4) TPP (GI)

GI means an indication that identifies a good as originating in the territory of a Party, 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**;

Lisbon Agreement 1958 28 members

Algeria, Bosnia and Herzegovina, Bulgaria, Burkina Faso, Congo, Costa Rica, Cuba, Czech Republic, DPR of Korea, France, Gabon, Georgia, Haiti, Hungary, Iran, Israel, Italy, Mexico, Montenegro, Nicaragua, Peru, Portugal, Moldova, Serbia, Slovakia, Macedonia, Togo, Tunisia



Shield Against Becoming Generic

Art 6 Lisbon Agreement

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.



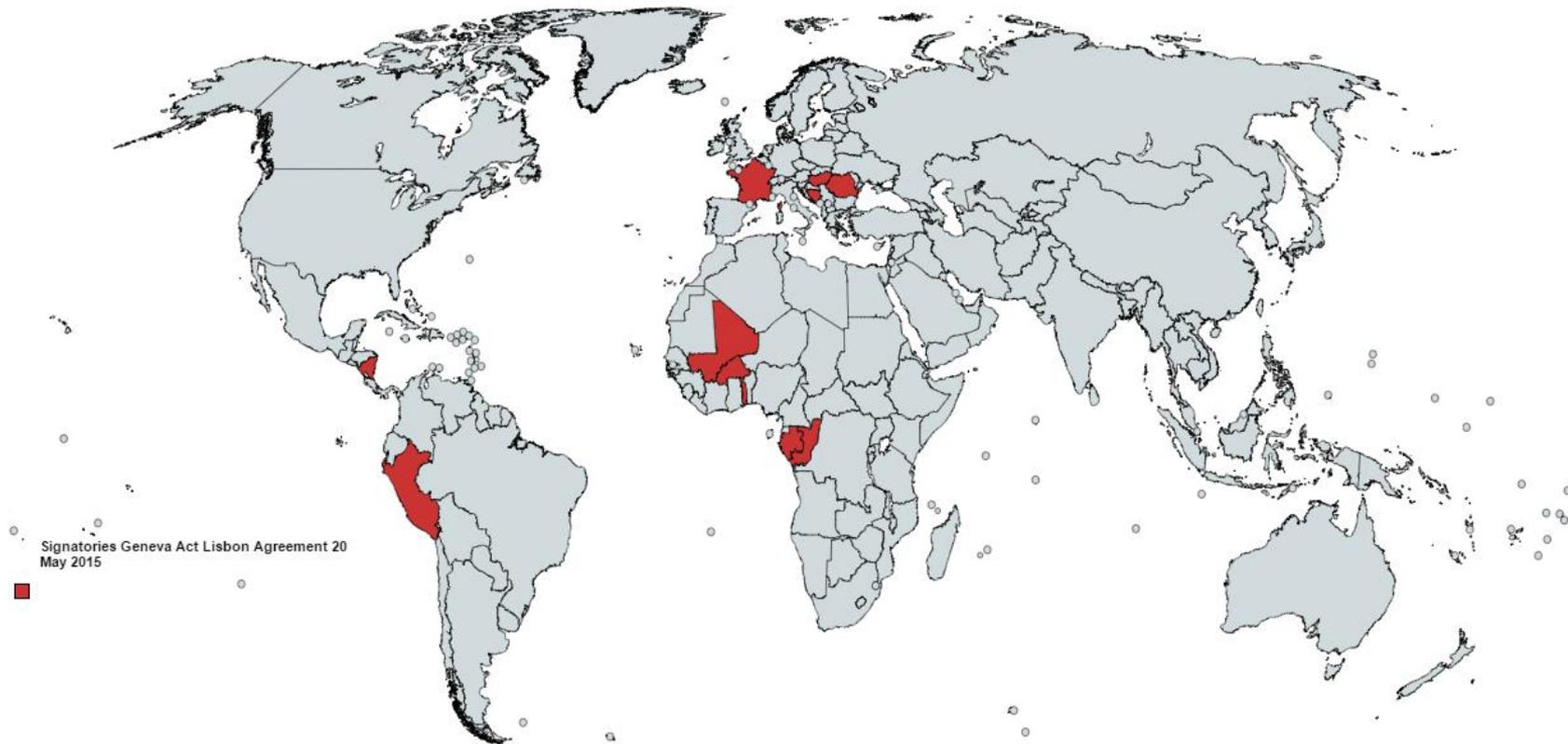
Content of Protection

Art 3 Lisbon Agreement

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.**

Geneva Act Lisbon Agreement 2015 11 signatories

Bosnia Herzegovina, Burkina Faso, Congo, France, Gabon, Hungary, Mali, Nicaragua, Peru, Romania, Togo (Italy, Portugal and Iran announced will be signatories). Germany, Switzerland, Russia, Morocco, Niger, China and Côte d'Ivoire welcomed the adoption of the Geneva Act.



Content of Protection

Art 11 Geneva Act Lisbon Agreement

(1) Each party shall prevent:

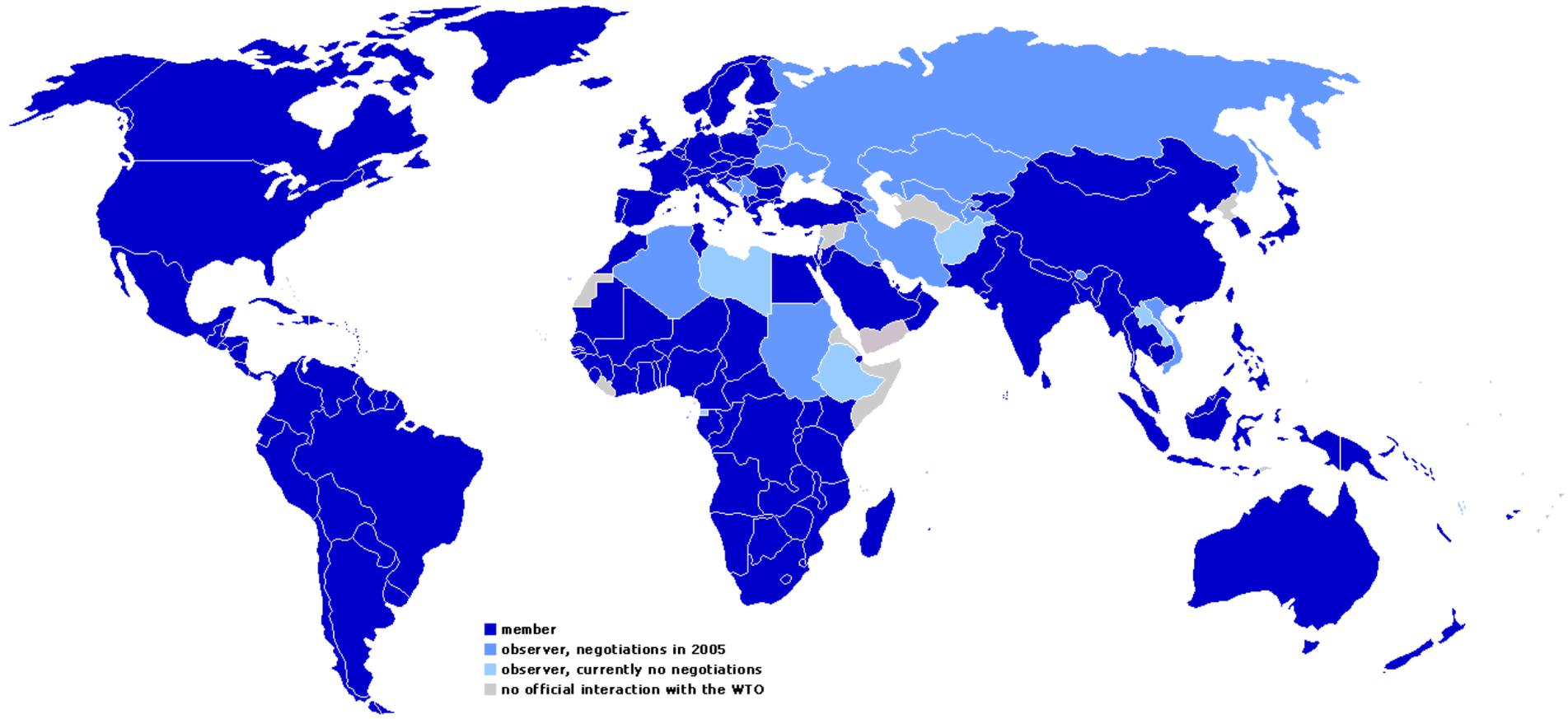
(a) use of the AO or GI

- (i) in respect of **goods of the same kind, not originating in the geographical area of origin;**
- (ii) in respect of **goods/services not of the same kind**, if such use would **indicate/suggest a connection**, and would be **likely to damage their interests**, or, because of the reputation of the AO or GI in the Contracting Party concerned, such use would be likely to **impair or dilute in an unfair manner, or take unfair advantage of, that reputation;**

(b) any other practice liable to **mislead** consumers as to the true origin, provenance or nature of the goods.

(2) Para (1)(a) shall also apply to use of the AO or GI amounting to its imitation, even if the true origin of the goods is indicated, or if the AO or the GI is used in **translated form or is accompanied by terms such as "style", "kind", "type", "make", "imitation", "method", "as produced in", "like", "similar" or the like.**

TRIPS 164 members



Content of Protection Non-Wine/Spirits

Art 22(2) TRIPS

Members shall prevent:

- (a) the use of any means in the designation/presentation of a good that indicates/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 10*bis* of the Paris Convention (1967).

Art 22(4) TRIPS

The protection shall be applicable against a GI 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.

Content of Protection Wine/Spirits

Art 23(1) TRIPS

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.**

Art 23(3) TRIPS 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.**

Exclusive *Sui Generis* system undermined

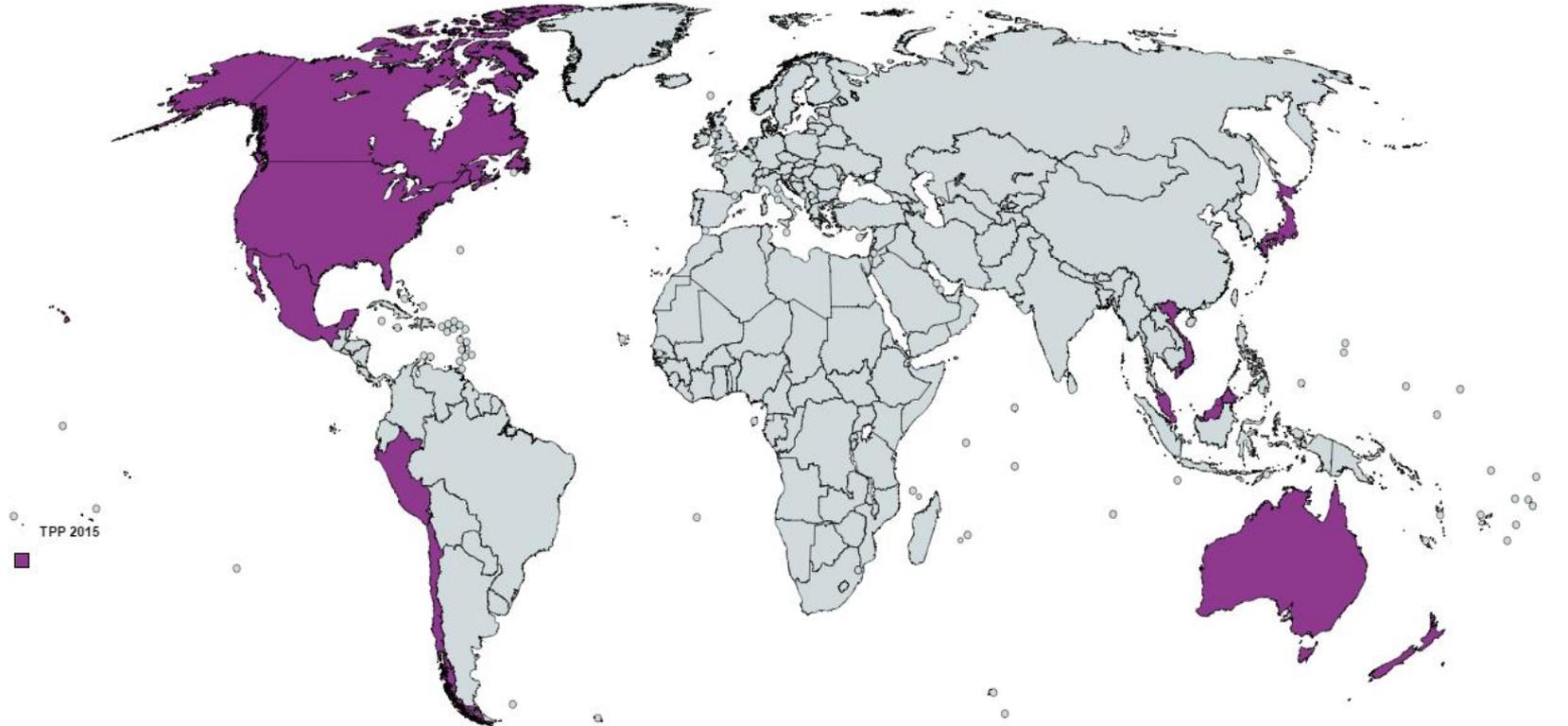
Art 24(6) TRIPS

Customary language of the common name of the goods/service

Grapes excluded

TPP 12 signatories

Australia, Brunei, Canada, Chile, Japan, Malaysia, Mexico, New Zealand, Peru, Singapore, United States, Vietnam



Exclusive *Sui Generis* system undermined

Art 18.30 TPP

Recognition of Geographical Indications The Parties recognise that GI may be protected through a **trademark or sui generis system** or other legal means.

Art 18.19 TPP

Collective and Certification Marks Each Party shall provide that trademarks include collective marks and certification marks. A Party is not obligated to treat certification marks as a separate category in its law, provided that those marks are protected.

Each Party shall also provide that signs that may serve as geographical indications are capable of protection under its trademark system



Confusion, genericism

Art 18.32(1) TPP

Grounds for Opposition and Cancellation

(A Party is not required to apply this Article to GI for wines and spirits or to applications or petitions for those GI)

- (a) confusion with a pre-existing TM pending application/registration
- (b) confusion with a pre-existing TM
- (c) **customary in common language as the common name**

Article 18.32(5) TPP

Translation, transliteration

Guidelines for Determining Whether a Term is Generic

Art 18.33 TPP

Factors include:

- (a) the term is used to refer to the type of good in question, as indicated by competent sources such as **dictionaries, newspapers and relevant websites**;
- (b) how the good referenced by the term is marketed and used **in trade** in the territory of that Party.

Multi-Component Terms

Art 18.34 TPP

An individual component of a multicomponent term that is protected as a geographical indication in the territory of a Party **shall not be protected** in that Party if that **individual component is a term customary in the common language** as the common name for the associated good.

Multi-Component Terms



↪ Bekijk de documentaires



Conclusions

- TM system victorious:

TRIPS= exclusive sui generis system or TM system;

TPP = **sui generis system and TM system or TM system.**

- TPP's ISDS could make it possible that foodstuff producers sue governments TPP members for not invalidating a generic TM;
- Certification TM system with its protection against genericism makes system more innovative.
- Despite GI protection via international agreements signed by TPP members, they shall not preclude the possibility that the protection of a GI ceases, unless the GIs refer to wines and spirits (Art 18.36(3) TPP).

Thank you

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