



# Farm Foundation Round Table

## International Standards for Intellectual Property:

*Fostering the power of geographical indications and  
trademarks to advance & defend international  
competitiveness of agricultural products*

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# Historical perspective

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## **Goals of the *WTO Agreement on Trade-Related Aspects of Intellectual Property Rights* (“TRIPS Agreement”)**

- Update existing international standards and rules
- Establish dispute settlement mechanism to resolve conflicts between States for IP-related issues
- Provide detailed enforcement provisions
- National treatment and MFN – cornerstones of GATT system extended to IP
- Later, protections further expanded and clarified through TRIPS-plus provisions in Free Trade Agreements, such as Trans-Pacific Partnership (multilateral), and U.S.-Korea Free Trade Agreement (bilateral)

# General provisions of TRIPS

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- What is “intellectual property”?
  - Copyright and related rights
  - **Trademarks**
  - **Geographical Indications**
  - Industrial Designs
  - Patents
  - Layout Designs of Integrated Circuits
  - Protection against Unfair Competition
  - Protection of Undisclosed Information
    - Trade Secret
    - Pharmaceutical and agricultural test or other data



**TRADEMARKS AND GEOGRAPHICAL  
INDICATIONS (GIs)**



# Trademarks

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- **Article 15.1 – Protectable Subject Matter**
  - Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark.
  - Personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks.

The Coca-Cola logo, featuring the brand name in its signature red script.The Kellogg's logo, featuring the brand name in its signature red script.

(Selected Products from Forbes' "The World's Most Valuable Brands 2015 Rankings")

# Trademarks

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- **Article 16 – Rights Conferred**

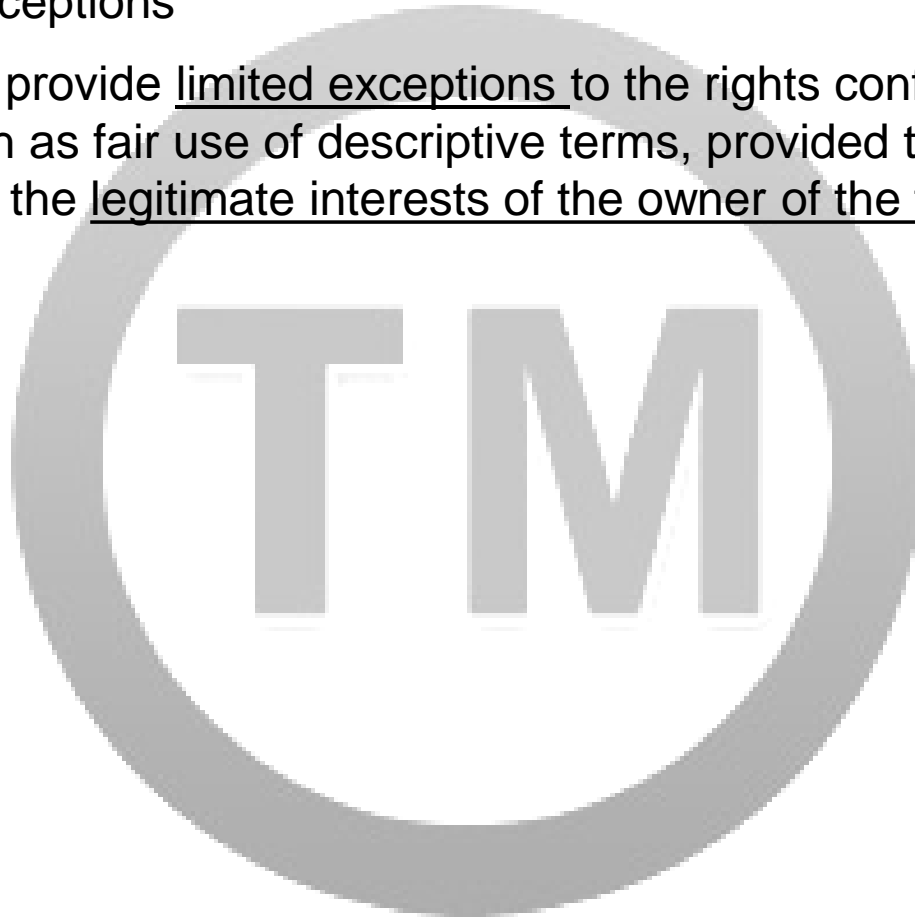
- 16.1 – The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade ***identical or similar signs*** for ***goods or services which are identical or similar*** to those in respect of which the trademark is registered ***where such use would result in a likelihood of confusion.***
  - Where there is an identical sign for identical goods or services, a likelihood of confusion is presumed.

# Trademarks

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- **Article 17** – Exceptions

“Members may provide limited exceptions to the rights conferred by a trademark, such as fair use of descriptive terms, provided that such exceptions take account of the legitimate interests of the owner of the trademark and of third parties.”



# Trademarks

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- **Article 20** - The use of a trademark in the course of trade shall not be unjustifiably encumbered by **special requirements**,
  - Special requirements include:
    - use with another trademark
    - use in a special form or
    - use in a manner detrimental to its capability to distinguish the goods or services of one undertaking from those of other undertakings.
- Currently at issue in Plain Packaging WTO Disputes



# Geographical Indications

- **Article 22** - GIs 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.**
- “Indication” need not be the actual name of the place.



# Geographical Indications

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- **Art. 22.2** - 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 its geographical origin

# Geographical Indications

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- **Art 22.3** – A Member shall refuse or invalidate the registration of a trademark which contains or consists of a GI with respect to goods not originating in the territory indicated, if use of the GI 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.

## Importance of GIs

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- In the words of the EU, the biggest user and proponent of GI Protection:

“Geographical indications strengthen competitiveness. In Europe this is a strategic tool in the development of our agriculture. This can also be true at international level, where they can contribute to economic development, particularly for raw materials exchanged at world level. The case of coffee is significant. International trade in coffee is almost liberalised, but an excess of production has led to a world wide collapse of prices. Only high quality coffees of a given geographical origin obtain higher prices. This experience shows that geographical indications, or similar steps, encourage quality rather than quantity.”

(European Commission Press Release, Brussels, August 2003, IP/03/1178)

# Potential “Claw Back” of GIs?

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- Generic terms vs. GIs
- Important market access issues!



# EU Wish List for Claw Back

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- **Wines & spirits**

- Bordeaux; Bourgogne; Chablis; Champagne; Chianti; Cognac; Marsala

- **Other products**

- Asiago
- Feta
- Fontina
- Gorgonzola
- Manchego
- Mortadella Bologna
- Parmigiano Reggiano (including Parmesan)
- Prosciutto di Parma
- Roquefort





# Trademarks vs. GIs

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# GIs: Wines and Spirits

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- **Article 23.1** – Each Member shall provide the legal means for interested parties to prevent use of a GI identifying **wines and spirits** for wines and spirits not originating in the place indicated by the GI in question
  - Even where the true origin of the goods is indicated or the GI is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like.
  - No “misleading” requirement.
- **Art 23.2** – TM registration for wines or spirits which contain a GI shall be refused or invalidated with respect to wines or spirits not having this origin. (No misleading requirement)

# GIs: Wines and Spirits

- **Art 23.4** – the “built-in agenda”

- In order to facilitate the protection of geographical indications for wines [and spirits], 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 [and spirits] eligible for protection in those Members participating in the system.



- Highly controversial; EU is biggest proponent, due to history and important agricultural interests.

# Geographical Indications

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- Expanding at bilateral level (outside WTO context), such as in EU-Canada FTA (CETA)
- According to the European Commission's summary:

**“Geographical Indications** – CETA recognises the special status and offers protection on the Canadian market to a list of numerous European agricultural products from a specific geographical origin, so-called Geographical Indications (GIs). Examples are Grana Padano, Roquefort, Elia Kalamatas Olives or Aceto balsamico di Modena. The Agreement also provides for the possibility to add other products' names to the list in the future. In addition, thanks to the agreement, some prominent EU GIs such as Prosciutto di Parma and Prosciutto di San Daniele will finally be authorised to use their name when sold in Canada, which was not the case for more than 20 years.”

# Recent GI- and Trademark-Related Developments

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- Trans-Pacific Partnership Negotiation Concluded October 5, 2015 (US, Australia, Brunei Darussalam, Canada, Chile, Japan, Malaysia, Mexico, New Zealand, Peru, Singapore, and Viet Nam)
- Creates a balance between GIs and generic terms, and between GIs and trademarks, that would likely be difficult in any agreement including the EU.
- For example, TPP Article 18.32 provides that GI protection may generally be opposed or cancelled on the following grounds:
  - (a) the geographical indication is likely to cause confusion with a trademark that is the subject of a pre-existing good faith pending application or registration in the territory of the Party;
  - (b) the geographical indication is likely to cause confusion with a pre-existing trademark, the rights to which have been acquired in accordance with the Party's law; and
  - (c) the geographical indication is a term customary in common language as the common name for the relevant good in the territory of the Party.

# Recent Developments

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- Complaints against Australia's Plain Packaging Requirement for Tobacco Products by (a) Honduras, (b) Dominican Republic, (c) Cuba, and (d) Indonesia, currently pending.
- For example, Cuba's Panel Request of 14 April 2014, lists the following alleged violations of the TRIPS Agreement, *inter alia*:



# Recent Developments

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- Article 16.1 of the TRIPS Agreement, because Australia prevents owners of registered trademarks from enjoying the rights conferred by a trademark.
- Article 16.3 of the TRIPS Agreement because Australia prevents owners of registered trademarks that are "well known" or might become "well-known" from enjoying the rights conferred by such a trademark.
- Article 20 of the TRIPS Agreement, because Australia unjustifiably encumbers the use of trademarks for tobacco products in the course of trade through special requirements. In particular, Australia mandates: (i) that trademarks relating to tobacco products be used in a special form, and (ii) that trademarks relating to tobacco products be used in a manner which is detrimental to their capability to distinguish tobacco products of one undertaking from tobacco products of other undertakings. In any event, the Plain Packaging Measures are ineffective (in that they do not achieve Australia's public health objective) and/or disproportionate (in that alternative and less restrictive measures would make an equivalent contribution to that objective).
- Article 22.2(b) of the TRIPS Agreement, because Australia does not provide effective protection against acts of unfair competition with respect to Cuban geographical indications.
- Article 24.3 of the TRIPS Agreement, because Australia is diminishing the level of protection afforded to Cuban geographical indications as compared with the level of protection that existed in Australia prior to 1 January 1995 including by restricting the use of Cuban geographical indications, such as the geographical indication "Habanos", on the retail packaging of large handmade cigar products.



## Plain Packaged Cigarette Package - Australia



Plain Packaging - Possible extension beyond tobacco?



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