
Geographical Indications

An Introduction



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Foreword

This publication provides an introduction to geographical indications (GIs), explaining their basic features, use and protection as an intellectual property right. Written for non-experts, it is a starting point for readers seeking to learn more about the topic.

While the publication focuses primarily on the protection of GIs as an intellectual property right, it also addresses the economic and social dimensions of GIs and responds to the questions most frequently raised by policymakers, producers and other stakeholders who wish to begin the process of developing a GI scheme for a product.

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Introduction

Since the adoption of the Agreement on Trade-Related Aspects of Intellectual Property Rights (the TRIPS Agreement) in 1994, which contains a section on geographical indications (GIs), this form of intellectual property (IP) has attracted increasing attention from policymakers and trade negotiators, as well as producers (mostly of agricultural products), lawyers and economists across the world. It is undoubtedly because of the TRIPS Agreement section on GIs that the issue now appeals to more and more nations beyond the rather restricted list of countries that have traditionally pursued active GI policies.

GIs have traditionally been considered to be IP. Article 1(2) of the Paris Convention for the Protection of Industrial Property of 1883 (Paris Convention) refers to “indications of source” and “appellations of origin” as objects of industrial property. Paragraph (3) of the same article specifies that the term “industrial property” is not limited to “industry and commerce” proper, but applies also to agricultural and extractive industries and to all manufactured or natural products, such as “wines, grain, tobacco leaf, fruit, cattle, minerals, mineral waters, beer, flowers and flour”.

The inclusion of indications of source and appellations of origin and the specific reference to a series of agricultural products in early versions of the Paris Convention are clear evidence that the 19th century diplomats who negotiated the international convention, primarily to protect inventions shown at international exhibitions, had not overlooked this, arguably, most ancient form of intellectual asset. Famous ancient brands are sometimes associated with products that have a specific geographical origin and go back as early as the 5th century BC, such as wine from the Greek island of Chios, referred to as an expensive luxury good in classical Greece.

The period following the conclusion of the Paris Convention saw numerous efforts aimed at increasing the level of multilateral protection afforded to indications of source and appellations of origin, which led, among others things, to the adoption of 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 (Lisbon Agreement), and to the inclusion, in the TRIPS Agreement, of a special section on GIs.

There is an abundant literature addressing the legal effects, rights and obligations flowing from the various multilateral agreements on GIs, as well as an ever-growing number of bilateral agreements containing chapters on GIs. This publication offers an introduction to GIs for readers new to the subject. It provides an overview of key definitions, basic policy considerations concerning the protection of GIs and an introduction to salient IP law-related issues.

Success stories from the world of GIs demonstrate that GIs, if well managed, are intangible assets with interesting potential for product differentiation, the creation of added value, as well as spin-off effects in areas related to the primary product for which the GI is known.

Against the background of a lengthy, passionate debate on the preferred form of legal protection for GIs, it is important not to lose sight of the value of GIs as intangible assets. Geographical indications are *distinctive signs* used to differentiate competing goods. They are collectively owned with a strong inherent *origin*-base, namely the geographical origin to which they refer. The reference to geographical origin – most regularly for agricultural products – combined with the use of traditional extraction and processing methods, presents an interesting marketing potential in terms of product branding. However, the use of geographical origin brands also presents a number of challenges. Owing to their collective nature, those who produce and market GIs must engage in collective action with regard to production methods, quality standards and control, as well as product distribution and marketing.

Key concepts

What is a geographical indication?

The basic concept underlying GIs is simple, and familiar to any shopper who chooses Roquefort over “blue” cheese or Darjeeling over “black” tea¹. “Cognac”, “Scotch”, “Porto”, “Havana”, “Tequila” and “Darjeeling” are some well-known examples of names associated throughout the world with products of a certain nature and quality, known for their geographical origin and for having characteristics linked to that origin.

A geographical indication is a sign used on products that have a specific geographical origin and possess qualities or a reputation that are due to that origin.



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Article 22.1 of the TRIPS Agreement defines geographical indications as

...indications which identify a good as originating in the territory of a Member [of the World Trade Organization], 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.

1. WIPO Intellectual Property Handbook, WIPO Publication No. 489 (E), 2004.

Most commonly, a GI consists of the name of the place of origin of the good, such as “Jamaica Blue Mountain” or “Darjeeling”. But non-geographical names, such as “Vinho Verde”, “Cava” or “Argan Oil”, or symbols commonly associated with a place, can also constitute a GI. In essence, whether a sign functions as a GI is a matter of national law and consumer perception.

Moreover, in order to work as a GI, a sign must identify a product as originating in a given place. In addition, the qualities or reputation of the product should be *essentially due* to the place of origin. Since the qualities depend on the geographical place of production, there is a *link* between the product and its original place of production.

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ROQUEFORT

A product, a region

Roquefort identifies a characteristic blue cheese made in a region in southwest France, around the municipality of Roquefort-sur-Soulzon.

The cheese is smooth and compact, with even blue veins, a very distinctive aroma, slight scent of mould and a fine, robust taste. It is made from raw, whole sheep’s milk from the Lacaune breed. Before it is pressed, the raw cheese is cultured with spores of *penicillium roqueforti*. It is then aged for at least 14 days in natural caves in the foothills of the calcareous cliffs in the region. Aging continues outside the natural caves for at least 90 days from the date of its manufacture.

A link between the product and the region

The characteristics of the milk obtained from indigenous breeds of sheep fed according to tradition, the characteristics of the caves in which the cheese is aged and the traditional know-how used in each step of the cheese-making process give Roquefort its unique features and taste.

Source: www.inao.gouv.fr
Confédération générale des producteurs de lait de brebis et des industriels de Roquefort, www.roquefort.fr



Photo: CIGC

Can geographical indications only be used for agricultural products?

Agricultural products typically have qualities that derive from their place of production and are influenced by specific local, geographical factors such as climate and soil. It is therefore not surprising that a majority of GIs throughout the world are applied to agricultural products, foodstuffs, wine and spirit drinks.

However, the use of GIs is not limited to agricultural products. A GI may also highlight specific qualities of a product that are due to human factors found in the product's place of origin, such as specific manufacturing skills and traditions. That is the case, for instance, for handicrafts, which are generally handmade using local natural resources and usually embedded in the traditions of local communities.



Photo: istockphoto @ ToIga TEZCAN

SWISS WATCHES

The term SWISS or SWISS MADE for watches is commonly understood as referring to a high-quality watch manufactured in Switzerland. Swiss watches enjoy a great reputation. But what does “Swiss made” actually mean for a watch?

A Swiss Ordinance of December 23, 1971, governs the use of the appellation “Switzerland” or “Swiss” for watches. This law sets out the conditions under which these indications can be used on watches. As stated on the Federation of the Swiss Watch Industry’s website, the understanding is that “Swiss quality for watches depends on the amount of work actually carried out on a watch in Switzerland, even if some foreign components are used in it”.

The terms “Switzerland” or “Swiss” can be used on a watch if:

- its movement (the motor of the watch) is Swiss;
- its movement is cased up in Switzerland; and
- the manufacturer carries out the final inspection in Switzerland.

A movement is considered to be Swiss if:

- it has been cased up in Switzerland;
- it has been inspected by the manufacturer in Switzerland; and
- the components of Swiss manufacture account for at least 50 per cent of the total value, without taking into account the cost of assembly.



Photo: © Richemont

Source: Ordinance governing the use of the appellation “Switzerland” or “Swiss” for watches, of December 23, 1971. See also the website of the Federation of the Swiss Watch Industry at www.fhs.ch

CHULUCANAS (CERAMICS)

The region of Chulucanas – in the province of Morropón, Department of Piura (in Peru) – produces a unique type of ceramic officially labeled with the appellation of origin “Chulucanas”. Chulucanas pottery has been made for centuries and is unique due to the particular traits of the endemic natural resources used, such as local clay, and the ancient and ancestral techniques employed.

The main natural components of Chulucanas pottery are clay, sand, mango leaves and the climate. For the elaboration of Chulucanas ceramics, the clay is extracted from certain quarries containing mainly yellow clay (“arcilla amarilla”) and black clay (“arcilla negra”). These particular types of clay contain divided particles that characterize not only their plasticity, but also their organic content of iron oxide and organic waste. The type of clay is also responsible for giving brightness to the ceramics when it is burnished.

The craftsmen of Chulucanas use distinctive ancestral techniques from ancient cultures such as the Vicús and the Tallán. Before completion, each ceramic piece will undergo a dozen steps. The artisans mold the raw clay with their hands and feet, and then use wooden pallets and stones in order

to better shape it. The first colors, derived from natural sources such as leaves and soil pigment, are added. Then the pieces are placed in an oven and submerged for hours in the smoke of burning mango leaves, which give Chulucanas pottery its characteristic black color. To complete the piece, the ceramic is polished by hand with a black stone, to give it a brilliant shine.

In 2006, the “Asociación de Ceramistas Vicús, the “Asociación Civil de Ceramistas Tierra Encantada” and the “CITE Cerámica de Chulucanas” filed a request for the appellation of origin “Chulucanas”, which was registered in 2008.



Photo: Mario Rubio / CITE Cerámica

Source:
See also Resolution No. 011517–2006/OSD on the website of the National Institute for the Defense of Competition and the Protection of Intellectual Property (INDECOP), dated July 26, 2006: www.indecopi.gob.pe

What is the difference between a geographical indication and a trademark?

Geographical indications and trademarks are distinctive signs used to distinguish goods or services in the marketplace. Both convey information about the origin of a good or service, and enable consumers to associate a particular quality with a good or service.

Trademarks inform consumers about the source of a good or service. They identify a good or service as originating from a *particular company*. Trademarks help consumers associate a good or service with a specific quality or reputation, based on information about the company responsible for producing or offering it.

Geographical indications identify a good as originating from a *particular place*. Based on its place of origin, consumers may associate a good with a particular quality, characteristic or reputation.

A trademark often consists of a fanciful or arbitrary sign that may be used by its owner or another person authorized to do so. A trademark can be assigned or licensed to anyone, anywhere in the world, because it is linked to a specific company and not to a particular place.

In contrast, the sign used to denote a GI usually corresponds to the name of the place of origin of the good, or to the name by which the good is known in that place. A GI may be used by all persons who, in the area of origin, produce the good according to specified standards. However, because of its link with the place of origin, a GI cannot be assigned or licensed to someone outside that place or not belonging to the group of authorized producers.

What is the difference between a geographical indication and an appellation of origin?

Appellations of origin are a special kind of GI. The term is used in the Paris Convention and defined in the Lisbon Agreement.

Article 2 of the Lisbon Agreement defines *appellations of origin* as

“(1)... 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.

This definition suggests that *appellations of origin* consist of the name of the product’s place of origin. However, it is interesting to note that a number of traditional indications that are not place names, but refer to a product in connection with a place, are protected as *appellations of origin* under the Lisbon Agreement (for example, Reblochon (cheese) and Vinho Verde (green wine)).

It is sometimes argued that products with a certain reputation, but no other quality due to their place of origin are not considered *appellations of origin* under the Lisbon Agreement. However, this interpretation is not universally accepted.

Nevertheless, *appellations of origin* and GIs both require a qualitative link between the product to which they refer and its place of origin. Both inform consumers about a product’s geographical origin and a quality or characteristic of the product linked to its place of origin. The basic difference between the two terms is that the link with the place of origin must be stronger in the case of an appellation of

origin. The quality or characteristics of a product protected as an appellation of origin must result exclusively or essentially from its geographical origin. This generally means that the raw materials should be sourced in the place of origin and that the processing of the product should also happen there. In the case of GIs, a single criterion attributable to geographical origin is sufficient, be it a quality or other characteristic of the product, or only its reputation. Moreover, the production of the raw materials and the development or processing of a GI product do not necessarily take place entirely in the defined geographical area.

The term appellation of origin is often used in laws that establish a specific right and system of protection for GIs, in so-called *sui generis* systems of protection (see the chapter on how to obtain protection for GIs). *Geographical indication* is a more general concept that does not determine a specific mode of protection.

Developing a geographical indication - why?

Interest in GIs has thrived in recent years. The obligation, under the TRIPS Agreement, for Members of the World Trade Organization (WTO) to protect GIs has, to a large extent, triggered this attention. But beyond that, what creates the attraction? The short answer is that they are seen as useful tools in marketing strategies and public policies, for which there has been growing interest in the last two to three decades.

Geographical indications as differentiation tools in marketing strategies: from mere source indicators to brands

Consumers pay increasing attention to the geographical origin of products, and care about specific characteristics present in the products they buy. In some cases, the “place of origin” suggests to consumers that the product will have a particular quality or characteristic that they may value. Often, consumers are prepared to pay more for such products. This has favored the development of specific markets for products with certain characteristics linked to their place of origin.

Brand recognition is an essential aspect of marketing. Geographical indications convey information about the origin-bound characteristics of a product. They therefore function as product differentiators on the market by enabling consumers to distinguish between products with geographical origin-based characteristics and others without those characteristics. Geographical indications can thus be a key element in developing brands for quality-bound-to-origin products.



Photo: David Bonilla Abreo

CAFÉ DE COLOMBIA- OVERCOMING THE RESOURCE CURSE THROUGH GEOGRAPHICAL ORIGIN-BASED BRANDING

Studies indicate that commodity-dependent economies tend to face two closely-related problems: price fluctuations and a long-term decrease in international prices.

Colombian coffee is no exception. During the late 1950s, the price of Colombian coffee plummeted from US\$0.85 to 0.45 per pound. This sparked a new differentiation strategy by the Colombian Coffee Growers Federation (FNC) aimed at creating public awareness of the Colombian origin of the coffee. The FNC began by putting a human face on Colombian coffee, creating the character JUAN VALDEZ to represent the archetypal Colombian coffee grower. During the 1980s, the FNC registered the Juan Valdez logo, and began to license the mark to roasters for use on their own branded products that contained, exclusively, Colombian coffee. In addition, the Republic of Colombia registered the word “Colombian,” in relation to coffee, as a certification mark in the United States of America and Canada. This was followed by intensive advertising campaigns.

In 2005, “Café de Colombia” was recognized as an appellation of origin in Colombia. In 2007, it became the first non-European Protected Geographical Indication (PGI) registered in the European Union (EU). The FNC’s differentiation strategy based on geographical origin did not end with the JUAN VALDEZ figure and the “Café de Colombia” appellation of origin. As of 2011, two new appellations of origin for coffee from specific regions of Colombia were recognized, namely “Café de Nariño” and “Café del Cauca”.

The FNC’s differentiation strategy has paid off. After more than 50 years of marketing efforts, there is no doubt that “Café de Colombia” enjoys a worldwide reputation and has become one of Colombia’s most valuable brands.

Source:
Reina, Mauricio *et al.*, *Juan Valdez, The Strategy Behind the Brand*, Bogota, 2008.
“Making the Origin Count: Two Coffees,” *WIPO Magazine*, 2007.
See also the website of the *Federación Nacional de Cafeteros de Colombia* at www.cafedecolombia.com



Geographical indications as a factor of rural development

A number of studies indicate that, under appropriate conditions, GIs can contribute to development in rural areas. The entitlement to use a GI generally lies with regional producers, and the added value generated by the GI accrues therefore to all such producers.

Because GI products tend to generate a premium brand price, they contribute to local employment creation, which ultimately may help to prevent rural exodus. In addition, GI products often have important spin-off effects, for example in the areas of tourism and gastronomy.

Geographical indications may bring value to a region not only in terms of jobs and higher income, but also by promoting the region as a whole. In this regard, GIs may contribute to the creation of a “regional brand.”

A word of caution is, however, needed. The mere fact of developing a GI for a product does not guarantee automatic success or development for the region. For GIs to contribute to development, several conditions must be present in the region and in the way in which the specific GI scheme is designed.

COMTÉ CHEESE - THE GOLD OF THE JURA MOUNTAINS

In the Jura Mountains, a medium-sized mountain range north of the Alps in eastern France, winters are harsh and long. The mountains are not suitable for growing cereals, but their varied flora and large prairies are perfect for obtaining high-quality cow’s milk.



Photo: CIGC

For many centuries, farmers in the region have transformed milk into a hard-curd cheese, ripened in the form of big wheels, that has historically constituted their main nourishment in the winter. As many liters of milk (450 liters) are needed to produce a cheese wheel, farmers must pool their milk, which has resulted in a long tradition of cooperative work.

In 1958, Comté was recognized as an appellation of origin by a French court. The product specification sets out the conditions necessary

for producing Comté cheese. For example, the milk must come exclusively from the Montbéliarde and French Simmental breeds, the stocking rate is limited to one cow per hectare of grassland pasture and the milk must be collected within a radius of 25 km. These criteria serve to generate more jobs than would more intensive farming methods.

Moreover, the specifications limit the amount of concentrates given to cows, favoring feeding based on local fodder, and the amount of fertilization is limited as well in order to preserve the natural biodiversity of the soil and the natural flora. This, in turn, has a positive effect on biodiversity.

Comté is today a recognized cheese in the French market. The stringent, albeit balanced conditions set out in the product specification carefully protect the interests of all actors in the production chain. This has also been the starting point of a new tourist attraction revolving around the Comté appellation of origin, through the creation of “Comté routes”. Studies show that the socioeconomic impact of the appellation of origin on the region has been positive in terms of job creation and income levels, limitation of rural exodus and environmental impact.

Source: Bowen, Sarah, “Re-Locating Embeddedness, A Critical Analysis of the Comté Supply Chain”, North Carolina State University, 2007.
Colinet *et al.*, “Case Study: Comté Cheese in France, INRA, University of Toulouse, France, 2006. See also the website of the *Comité Interprofessionnel du Gruyère de Comté* at www.comte.com

Geographical indications as a means to preserve traditional knowledge (TK) and traditional cultural expressions (TCEs)

Products identified by a GI are often the result of traditional processes and knowledge carried forward by a community in a particular region from generation to generation.

Similarly, some products identified by a GI may embody characteristic elements of the traditional artistic heritage developed in a given region, known as “traditional cultural expressions”. This is particularly true for tangible products such as handicrafts, made using natural resources and having qualities derived from their geographical origin. In addition, certain TCEs – such as indigenous and traditional names, signs and symbols – may also be protected as GIs despite their having no direct geographical meaning.

Geographical indications are compatible with the nature of TK and TCEs in that they provide protection that is potentially unlimited in time, as long as the qualitative link between the products and the place is maintained and the indication has not fallen into genericity. They work as a collective right, there is no provision for a right to license or assign and the product-quality-place link underlying the

protection of a GI prohibits the transfer of the indication to producers outside the demarcated region.

While GIs do not directly protect the subject matter generally associated with TK or TCEs, which remains in the public domain under conventional IP systems and is open to misappropriation by third parties, they can indirectly contribute to their protection in several ways.

First, GI protection recognizes the cultural significance of TK and TCEs and can help preserve them for future generations. For example, in designing a GI scheme for a product, the production standards, also known as the “code of practice” or “regulations of use”, may include a description of a traditional process or TK.

In addition, through the added value of a GI scheme, producers are less tempted to replace traditional processes by possibly less costly ones. In India, for example, cheap powerloom-produced sarees are sold as highly-reputed “Banarsi” handloom sarees within and outside the Varanasi region (where authentic Banarsi sarees are produced). Powerloom imitations cost only one-tenth of the price of real handloom Banarsi sarees, thereby creating tough competition for local craftsmen and potentially causing the production of handloom sarees to become

unsustainable, and the skills and knowledge involved in the technique to be lost.

Geographical indications can provide protection for TK and TCEs against misleading and deceptive trading practices. They can also benefit indigenous communities by facilitating the commercial exploitation of TK and TCEs, and encouraging TK-based economic development. Geographical indications provide indigenous communities with a means to differentiate their products and benefit from their commercialization, thereby improving their economic position.



Photo: Aubard consulting



Photo: TAMMACHAT Natural Textiles

THAI SILK

“Thai silk”, produced on the Korat Plateau in Thailand’s northeast region, is synonymous with refinement, elegance and hundreds of years of tradition.

Thai silk is produced from the salivary glands of silkworms raised on mulberry leaves. The silkworm cocoons are placed in a vat of boiling water that separates the silk thread of the cocoon from the caterpillar inside. Unlike other silks that are smooth, satiny or crinkly, Thai silk is defined in particular by its coarse texture with unequal, irregular and slightly knotty threads, although it is generally soft and varies in color from light gold to light green. Since Thai silk yarn is yellow, it must be bleached before dyeing. Last but not least, the traditional handweaving process is important to Thai silk’s reputation.

There is not one but several types of Thai silk. Each one is linked to a specific region of Thailand and reflects particular knowledge related to the raising of silkworms and the way in which the material is woven and dyed. Each region’s silk is woven with typical designs, patterns and colors specific to that region. Examples of varieties of Thai silks protected as GIs include Lamphun Brocade, Chonnabot Midmee and Praewa Kalasin Thai silks.

Lamphun Brocade Thai silk is produced in the northern region of Lamphun. It is woven in bas-relief patterns created by using the heddle to lift and depress selected warp threads. Twisted silk threads are used as warp and weft, and supplementary silk threads are inserted to create the design. To complete a pattern, the process must be repeated, raising each heddle from first to last. Then the steps must be repeated in reverse order, from the last heddle to the first. The uniqueness of this process and the intricate detail of the patterns are the result of a long tradition of skills and techniques inherited and used for over 100 years. Lamphun Brocade Thai silk has always been used by the Thai royal family and the royal court in most of their important ceremonies. In Thailand, it is known as the “Queen of silk”.

Chonnabot Mudmee Thai silk is made in the northeast of Thailand. Its reputation results from the process of tie-dyeing the threads before weaving the fabric, and from its intricate patterns. It uses zoomorphic and geometric patterns made by using color in the weft in a traditional way.

Source: The registration of a Geographical Indication for Lamphun Brocade Thai Silk, Application No. 50100032, Registration No. Sor Chor 501000200”
See also the following website with information on the Queen Sirikit Institute of Sericulture: www.moac.go.th

Developing a geographical indication – what is involved?²

Recognition of a GI, whether through registration, a court or administrative decision or other means, is not enough, *per se*, to realize the potential benefits outlined in the preceding chapter. Protecting a GI is of course important, as will be explained in this chapter, but is not the only condition for its success.

In order for a GI to effectively create brand equity for a product, or to have a positive effect on rural development or the preservation of TK, TCEs or biodiversity, it is necessary to develop a comprehensive GI scheme. This is the set of rules and mechanisms underlying the functioning of a GI. Developing a GI scheme involves a number of important steps, such as:

- identifying the product's characteristics and assessing whether it has potential in internal or external markets;
- strengthening the cohesion of the group of producers and other operators involved, who will be the pillars of the GI scheme;
- setting up standards, sometimes called a *code of practice* or *regulations of use*. The code of practice or regulations of use usually, among other things, circumscribes the product's geographical region of production, and describes the production and processing methods. It may also describe the factors, natural and/or human, that are present in the region and contribute to the characteristics of the product;
- devising a mechanism to effectively attribute the right to use the indication to any producer and other operator concerned who produces the product within the established boundaries and according to agreed standards;

² A number of publications address this topic extensively. See, for example, the publications by the ITC, FAO and UNIDO referenced in the bibliography.

- establishing traceability, verification and control schemes in order to ensure continued quality and compliance with the code of practice or regulations of use;
- devising marketing strategies;
- obtaining legal protection for the GI and designing an enforcement strategy.

What are the costs?

It is evident that there are costs associated with developing a GI scheme. It would be difficult, and beyond the purpose of this publication, to quantify the costs involved in each of the steps mentioned above.

Moreover, those steps are not single, isolated acts. Protecting a GI does not only involve obtaining a right through registration or other appropriate means, but also enforcing that right. Verification and control must take place regularly throughout the lifetime of a GI, not just once. Promoting the GI is a continuing process. In short, a GI scheme must be managed throughout its existence.

How long does it take?

It may take several years to establish a complete GI scheme, as this involves several actors and requires taking into account different interests and policy considerations.

The actual time taken to develop a complete GI scheme may depend on some of the following factors, among others:

- the level of cohesion and organization of the group of producers and other operators concerned;
- the number and degree of conflicting interests and the way in which such interests are managed;
- the number and level of obstacles to legal protection of the GI – domestically or in foreign markets; and
- the existence of institutional support.

Protecting geographical indications – a step in developing a geographical indication

Why protect a geographical indication?

Geographical indications are more than just a name or a symbol. They reflect a reputation strongly linked to geographical areas of varying sizes, thus giving them an emotional component. A GI's reputation is a collective, intangible asset. If not protected, it could be used without restriction and its value diminished and eventually lost.

Use of GIs by unauthorized parties is detrimental to legitimate producers and to consumers. Such use deceives consumers and leads them to believe they are buying a genuine product with specific qualities and characteristics, whereas they get an imitation. Producers suffer damage because valuable business is taken away from them, and the established reputation of their products is affected. Producers may even be prevented from using the indication themselves, for instance if it

is registered as an individual trademark by a company.

Protecting a GI enables those who have the right to use the indication to take measures against others who use it without permission and benefit from its reputation free of charge (“**free-riders**”). Protecting a GI is also a way to forestall **registration of the indication as a trademark by a third party** and to limit the risk of the indication becoming a **generic term**.

Deterring free-riding

A GI's reputation is the result of efforts undertaken by producers in a given region. Producers who do not work according to the specifications for that GI, which are sometimes restrictive, or who are not located in the defined production region may be tempted to use the GI to free-ride on its reputation. Often, such use is made in connection with lower-quality products.

It is important for several reasons that those who have the right to use a GI prevent its unauthorized use, not only to avoid losing business, but also, in the longer term, to ensure the GI is used only in relation to products that possess the qualities or characteristics to which it owes its reputation. Use of a GI for lower or different-quality products most likely results in tarnishing its reputation.

Forestalling registration of the geographical indication as a trademark by a third party

An unprotected GI may be registered as a trademark by an individual producer or company, for goods identical or similar to those identified by the GI. This is likely to occur at the international level for indications protected in one jurisdiction but not in others. For jurisdictions in which the GI is not protected, the indication may be considered a distinctive sign available for registration as a trademark. The first to file for registration would obtain the trademark, which might give them the right to exclude use of the indication by anyone else, including the producers who had historically used it in their country of origin.

Limiting the risk of the geographical indication becoming a generic term

Where a GI is no longer associated with a product characteristically linked to a geographical origin but used instead as the common name to designate the product, it is said to have become a generic term. In such a case, the indication can be used by anyone to designate a type of product rather than a product with a distinct geographical origin and specific geographical qualities or characteristics. It can no longer serve as a distinctive sign or be used in a product differentiation strategy. Protecting a GI and enforcing the right obtained over it contribute to reducing the risk of that indication becoming a generic term.

An example of a GI that has become a generic term is *Camembert* for cheese. This name can now be used on any camembert-type cheese made anywhere in the world.

In contrast, *Camembert de Normandie* is a French appellation of origin for a cheese produced only in Normandy

What does a protected geographical indication enable you to do? What does it not enable you to do?

Protection for a GI is usually obtained by acquiring a right over the sign that constitutes the indication. That right can be a *specific* right designed for GIs (a *sui generis* right), which may be called, for instance, a protected GI, a denomination of origin or an appellation of origin. The right acquired can also be a collective or a certification mark.

A GI right enables those who have the right to use the indication to prevent its use by a third party whose product does not conform to the applicable standards. For example, in the jurisdictions in which the Darjeeling GI is protected, producers of Darjeeling tea can exclude use of the term “Darjeeling” for tea not grown in the tea gardens of Darjeeling or not produced according to the standards set out in the code of practice for the Darjeeling GI. However, a protected GI does not enable the holder to prevent someone from making a product using the same techniques as those set out in the GI standards.

Photo: istockphoto @ Michal Bryc



Photo: istockphoto @ Cristian Lazzari

THE INTERNATIONAL LEGAL FRAMEWORK

The Paris Convention for the Protection of Industrial Property (1883)

The Paris Convention was the first international multilateral treaty to include provisions relating to indications of geographical origin. Article 1(2) of the Convention recognizes “indications of source” and “appellations of origin” as subject matter for industrial property. The Paris Convention does not directly define either of these terms, although it contains language that allows one to infer the following definition of an indication of source: “an indication referring to a country, or to a place situated therein as being the country or place of origin of a product³”.

An *indication of source* provides information about the geographical origin of a product, but does not imply any special quality or characteristic of the product for which it is used. Examples of indications of source are the mention, on a product, of the name of a country, or indications such as “made in...”, “product of...”. An indication of source can also be composed of symbols or iconic emblems associated with the area of geographical origin.

The Paris Convention stipulates that, in cases of use of false indications of source on goods,

the goods in question are to be seized upon importation or, ultimately, to be subject to the actions and remedies available in the country of importation. It further sets forth the obligation of Member States to ensure appropriate legal remedies for repressing the use of false indications of source.

The Paris Convention also requires its members to ensure effective protection against unfair competition. For example, the use of an indication of source on a good such that it could mislead the public as to the true geographical origin of the good could be considered an act of unfair competition.

The Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods (1891)

The Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods extends the protection afforded to false indications of source under the Paris Convention to deceptive indications of source as well. Deceptive indications are those which, although literally true, may be misleading. This would be the case where, for example, there are homonymous place names in two different countries, but only one place is known for the production of a particular good. If the name were used on goods from the similarly named place, the indication of

source would be considered deceptive as the public would likely be led to believe that the good came from a different place.

The TRIPS Agreement (1994)

The TRIPS Agreement, one of the WTO Agreements, is applicable to all WTO Members. It includes a section on the protection of GIs (Part II, Section 3).

Section 3 of the TRIPS Agreement sets forth a definition of a GI and contains a general obligation for WTO Members to provide protection against misleading use of a GI and against use that constitutes an act of unfair competition. It also requires Members to refuse or invalidate registration of a trademark that contains or consists of a GI with respect to goods not originating in the territory indicated, if use of the indication on the trademark for such goods might mislead the public as to the true place of origin.

In addition to that general obligation, Section 3 of the TRIPS Agreement requires WTO Members to provide protection against any use of GIs for wines and spirits and against registration as trademarks of those indications, even if such use or registration does not mislead the public as to the true origin of the goods.

Finally, the TRIPS Agreement contains exceptions to the obligation to provide protection for GIs. A first exception applies to GIs for wines and spirits only, for those WTO Members in which the indications have been used in a continuing and similar manner for a number of years. A second exception applies where a trademark has been acquired in good faith in the territory of a WTO Member before the date of application of the TRIPS Agreement in that WTO Member, or before the GI is protected in the country of origin. A third exception applies where the indication is considered by a WTO Member to be the customary term in common language (the common name) for the identified goods or services.

- 3 Ludwig Bæumer, "Protection of geographical indications under WIPO treaties and questions concerning the relationship between those treaties and the TRIPS Agreement", in "Symposium on the Protection of Geographical Indications in the Worldwide Context", Eger, Hungary, October 24/25 1997, p.12, WIPO publication No. 760(E), Geneva, 1999.

How to obtain protection for a geographical indication?

Geographical indications are protected in different countries and regional systems through a wide variety of approaches – often by a combination of two or more approaches. Those approaches have been developed in accordance with different legal traditions and within a framework of certain historical and economic conditions.

There are three main modalities of protection for GIs: (a) so-called *sui generis* systems; (b) collective and certification marks; and (c) modalities focusing on business practices including administrative product approval schemes. These approaches involve differences with respect to important questions, such as the conditions for protection or the scope of protection. On the other hand, two of the modes of protection, namely *sui generis* systems and collective or certification mark systems, share some common features, such as the fact that they set up rights for collective use by those who comply with defined standards.

(a) *Sui generis* systems of protection

In certain jurisdictions, GIs may be protected through a system that applies specifically and exclusively to them – a *sui generis* system of protection. Such systems establish a specific right, a *sui generis* right, over GIs, separate from a trademark right or any other IP right. A *sui generis* protection system exists in the EU with regard to GIs for wines and spirits, agricultural products and foodstuffs. Many other jurisdictions throughout the world, such as India, Switzerland, the Andean Community countries and the African Intellectual Property Organization (OAPI), among others, also have *sui generis* systems of protection.

The terminology used to refer to *sui generis* rights over GIs is not uniform. Terms such as *appellations of origin*, *controlled appellations of origin*, *protected designations of origin*, *protected geographical indications* or simply *geographical indications*, are used in different legislation.

Generally, an application for registration of a *sui generis* right should contain a delimitation of the geographical area within which the product identified by the GI is produced; a description of the product's characteristics, quality or reputation; and the standards of production with which users of the right should conform. In certain jurisdictions, the link between

the product's characteristics and the geographical area must be substantiated. All those elements are contained in a document, which is sometimes called “the product specification”.

In addition, *sui generis* systems of protection usually require that verification and control schemes be put into place to ensure that users of the GI comply with the agreed standards of production.

A *sui generis* right protects at the very least against any use of the GI that would mislead consumers as to the true geographical origin of the product, or that constitutes an act of unfair competition. Geographical indications identifying wines and spirits are further protected against any use by an ineligible or unauthorized person, even where such use does not result in consumers being misled or in an act of unfair competition. In some jurisdictions with a *sui generis* system, such “additional protection” is afforded to GIs that identify other types of products as well. Furthermore, some *sui generis* systems protect GIs against use in a translation, or against imitation or evocation.

EXAMPLES OF GIs PROTECTED BY A *SUI GENERIS* RIGHT IN THEIR COUNTRY OF ORIGIN:

ARGAN OIL for an oil from the kernels of the argan tree, grown in Morocco



Photo: istockphoto @ Mosaikphotography

GRUYÈRE for a cheese from a specific region in Switzerland



photo: Interprofession du Gruyère

PROTECTION OF THE GEOGRAPHICAL INDICATION CRICOVA BY A SPECIAL LAW

By adopting Law No. 322-XV of 18.07.2003 on the Declaration of the Complex “Combinatul de Vinuri “Cricova” S.A.”, an Object of the National-Cultural Heritage of the Republic of Moldova, the Parliament created a special regime for the use of the GI “Cricova” for wine.

This law recognizes “Cricova” as part of the country’s cultural heritage and as a landscape complex of national importance.

“Cricova” is famous for its unique underground labyrinths. The greatest part of “Cricova’s” wine production facilities is placed underground, at a depth of 60-80 meters, creating a huge underground wine city with avenues, streets and broadways.

These labyrinths offer a truly unique, favorable microclimate that gives typicity to the wines. All year round, the naturally constant temperature there remains at +12° to +14°C, and the humidity at about 97 to 98%, the most propitious conditions for developing and aging exquisite, fine wines. This humid, cool environment contributes to the formation of the authentic character of “Cricova” wine products.

© Cricova



(b) Collective marks and certification marks⁴

Some countries protect GIs under trademark law, more specifically through collective marks or certification marks. This is the case, for example, in Australia, Canada, China and the United States of America.

What is meant by a collective mark or certification mark (or, in some countries, guarantee mark) differs from country to country. However, a common feature of these types of marks is that they may be used by more than one person, as long as the users comply with the regulations of use or standards established by the holder. Those regulations or standards may require that the mark be used only in connection with goods that have a particular geographical origin or specific characteristics.

In some jurisdictions, the main difference between collective marks and certification marks is that the former may only be used by members of an association, while certification marks may be used by anyone who complies with the standards defined by the holder of the mark. The holder, which may be a private or a public entity, acts as a certifier verifying that the mark is used according to established standards. Generally, the holder of a

certification mark does not itself have the right to use the mark.

Protection for GIs registered as collective or certification marks is provided for under general trademark law. In other words, protection is afforded against use in the course of trade by third parties without the owner's consent, of identical or similar signs for identical or similar goods, where such use would result in a likelihood of confusion⁵.

4. For further information on collective and certification marks, see document WIPO/STrad/INF/6. www.wipo.int/export/sites/www/sct/en/meetings/pdf/wipo_strad_inf_6.pdf

5. Article 16 of the TRIPS Agreement. See WTO document IP/C/W/253/Rev.1.

EXAMPLES OF GIs PROTECTED
BY COLLECTIVE OR
CERTIFICATION MARKS IN
THEIR COUNTRY OF ORIGIN:

IDAHO POTATO for potatoes grown in the
State of Idaho, in the United States of America



PUER for a dark tea from the Yunnan prov-
ince, in China



**(c) Laws focusing on
business practices⁶**

Geographical indications may be pro-
tected through certain laws that focus on
business practices, such as laws relating
to the repression of unfair competition,
consumer protection laws or laws on the
labeling of products.

These laws do not create an individual
industrial property right over the GI. How-
ever, they indirectly protect GIs insofar as
they prohibit certain acts that may involve
their unauthorized use.

6. See WTO document IP/C/W/253/Rev.1.

COMBINING DIFFERENT MEANS OF PROTECTION

The modes of protection for GIs do not necessarily apply on a mutually exclusive basis. In some jurisdictions, it is possible to combine different means of protection. Thus, a GI can be protected through a *sui generis* system, for example as an appellation of origin, and also as an individual or a collective mark. A mark may be used to protect the product label, which can include the GI and an additional figurative element affixed to the product to indicate to consumers that it complies with the product specifications for the appellation of origin.

Parmigiano Reggiano is recognized as an appellation of origin in Italy and registered as a Protected Designation of Origin (PDO) in the EU for a cheese produced, according to specification, in the provinces of Parma, Reggio Emilia, Mantua (to the right of the Po River), Modena and Bologna (to the left of the Reno River), in Italy.

At the same time, the name *Parmigiano Reggiano* is protected by a collective mark for the pin-dot writing printed on the rind of the cheese, where it is commercialized pre-packaged.

PARMIGIANO
REGGIANO

In addition, a label including the name *Parmigiano Reggiano* is used on the packaging. That label is also protected as a collective mark.



Source: Consorzio del Formaggio Parmigiano-Reggiano

RIOJA is recognized as a qualified appellation of origin in Spain and registered as a PDO in the EU for a wine produced in the Rioja region of Spain. The PDO protects the name *RIOJA* as such.

Furthermore, two logos including the name *RIOJA* are registered in order to reinforce protection of the name against misuse. These logos are protected by a collective mark and an individual mark, respectively.



Source:
ROMARIN www.wipo.int/romarin
Consorzio del Formaggio Parmigiano-Reggiano
Consejo Regulador de la Denominación
de Origen Calificada Rioja

How long does it take to protect a geographical indication through registration?

Obtaining protection for a GI through registration of a *sui generis* right or a collective or certification mark is just one step in the process of establishing a GI scheme. The registration procedure, from application to grant, may itself take several months or even years, depending on the system concerned and on any obstacles to registration that may be found along the way.

What are the potential obstacles to protecting a geographical indication?

There are several obstacles, from a legal point of view, that may arise when seeking protection for a GI, including the following:

Conflict with a prior mark

A GI may be refused protection in a particular territory if the authority in that territory considers that the GI is identical or similar to a trademark previously applied for, registered or acquired through use, in good faith, and that use of the GI would result in a likelihood of confusion with the trademark.

Generic character

A GI may be refused protection if the competent authority considers that the sign constitutes the common name for the kind of product or service to which it applies.

Homonymous geographical indications

Homonymous GIs are those that are spelled or pronounced alike, but which identify products originating in different places, usually in different countries. In principle, these indications should coexist, but such coexistence may be subject to certain conditions. For example, it may be required that they be used in association with additional information as to the origin of the product in order to prevent consumers from being misled.

A GI may be refused protection if, due to the existence of another homonymous indication, its use would be considered potentially misleading to consumers with regard to the product's true origin.

The indication is the name of a plant variety or animal breed

In certain jurisdictions, protection may be refused to a GI if it conflicts with the name of a plant variety or an animal breed and may, as a result, mislead the consumer as to the true origin of the product.

Protecting geographical indications abroad

Why protect your geographical indication abroad?

Intellectual property rights are governed by the “territoriality principle”. The effects of a right obtained in a particular jurisdiction are limited to the territory of that jurisdiction. Thus, where a right over a GI is obtained in one jurisdiction, it is protected there but not abroad. In other jurisdictions, the GI would face the risks usually associated with lack of protection. Protection in each of the markets in which the GI product is commercialized is therefore paramount. In order to protect a GI abroad, there may be a requirement to first protect the GI in the country of origin.

How are geographical indications protected abroad?

There are four main routes for protecting a GI abroad:

- by obtaining protection directly in the jurisdiction concerned;
- through the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration;
- through the Madrid System for the International Registration of Marks (in which the GI concerned is protected in the country of origin as a collective or certification mark); and
- by concluding bilateral agreements between States or commercial partners.

Bilateral agreements

Two States or two trading partners (usually customs territories) may agree to protect each other’s GIs under a bilateral agreement. Such agreements may be independent treaties or form part of a wider trade agreement. There are numerous examples of this type of agreement, particularly in the wine and spirits sector. Some date back to the mid-twentieth century, but they continue to be a common way to protect GIs, as evidenced by the number of agreements negotiated in recent years that are not limited to wine and spirits.

MODES OF PROTECTION AROUND THE WORLD FOR THE DARJEELING WORD AND LOGO⁷

DARJEELING



Country	Nature and subject matter of registration
INDIA	<ul style="list-style-type: none"> • Copyright registration A-67292/2004 for DARJEELING logo • Certification Mark 532240 for DARJEELING logo • Certification Mark 831599 for DARJEELING word • DARJEELING word as a geographical indication No. 1 • DARJEELING logo as a geographical indication No. 2
AUSTRALIA	<ul style="list-style-type: none"> • Certification Mark 998593 for DARJEELING logo • Certification Mark 998592 for DARJEELING word
EUROPEAN UNION	<ul style="list-style-type: none"> • Community Collective Mark 004325718 for DARJEELING word • Community Collective Mark 008674327 for DARJEELING logo • PGI for DARJEELING word under Regulation No. 510/06, Commission Implementing Regulation (EU) No. 1050/2011 of 20 October 2011
JAPAN	<ul style="list-style-type: none"> • Trademark 2153713 for DARJEELING logo • Regional Collective Mark for DARJEELING TEA word (Application No. 007-103568)
TAIWAN (Province of China)	<ul style="list-style-type: none"> • Certification Mark 01327971 for DARJEELING word • Certification Mark 01327972 for DARJEELING logo
UNITED STATES OF AMERICA	<ul style="list-style-type: none"> • Certification Mark 1632726 for DARJEELING logo • Certification Mark 2685923 for DARJEELING word
CANADA	<ul style="list-style-type: none"> • Official Mark 0903697 for DARJEELING logo
International Registration (Madrid system)	<ul style="list-style-type: none"> • Collective Mark 528696 for DARJEELING logo for Austria, France, Germany, Italy, Montenegro, Portugal, Serbia, Spain, Switzerland

7. Source: Tea Board of India: www.teaboard.gov.in/

Direct protection

One option for protecting GIs is directly in the jurisdiction concerned. As explained previously, GIs are protected through a wide variety of approaches in different jurisdictions, and often by a combination of two or more methods. Protection under laws against unfair competition and protection as a *sui generis* right, collective mark or certification mark are generally the modes of protection made available in different jurisdictions. Right owners may use the means available in the jurisdiction of interest and, where more than one mode of protection is available, they will need to determine which option is most suitable to their needs.

For example, to protect a GI in Australia, China or the United States of America, an application for registration of a collective or a certification mark may be filed directly with the respective trademark office. Those seeking protection in the EU for GIs identifying agricultural products or foodstuffs can apply for registration of a Protected Geographical Indication (PGI) or a Protected Designation of Origin (PDO). It is also possible to file an application for registration of a collective Community trademark with the EU's Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM).

Lisbon Agreement

The Lisbon Agreement was established to facilitate the protection of appellations of origin at the international level. It offers a means of obtaining protection for an appellation of origin originating in one Member State in the territories of all other members through a single registration called “an international registration”.



Only an appellation of origin that is recognized and protected in its country of origin may be the subject of an application for international registration. The “country of origin” is defined as “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”.

Applications for international registration must be filed with WIPO by the competent authority of the country of origin. Individual applicants cannot present applications to WIPO, even were they to have the right to use the appellation of origin concerned.

WIPO notifies the other States party to the Lisbon Agreement of any applications it receives. Any Member State may declare, within a period of one year, that it cannot protect the appellation of origin notified to it. The Agreement does not set forth the grounds on which a notification of international registration may be refused, but leaves it to Member States to determine the grounds on which it cannot protect a given international registration in their territory.

If no declaration of refusal is communicated to WIPO by a Member State within the one-year time limit following receipt of a notification of registration, the protection of the appellation of origin takes effect in that country as of the date of international registration. However, a Member State may declare that protection is assured in that country as of a different date, which may not be later than the date of expiry of the one-year refusal period.

Appellations of origin registered under the Lisbon Agreement are protected against any usurpation or imitation of the appellation, 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.

Once an appellation of origin has been internationally registered, it is protected without any limitation in time, meaning with no need for renewal. An appellation that has been granted protection by a Member State cannot be deemed to have become generic in that State as long as it is protected as an appellation of origin in the country of origin.

Madrid system

Geographical indications can be protected in several countries as collective or certification marks through the Madrid Agreement Concerning the International Registration of Marks, concluded in 1891, and the Protocol relating to the Madrid Agreement, adopted in 1989. Both treaties constitute the Madrid system and are administered by WIPO.

The Madrid system may be used by anyone with a connection, through a real and effective commercial or industrial establishment, domicile or nationality, with a Contracting Party, meaning the countries or organization party to the Agreement and/or Protocol. It offers the possibility to protect a mark, including a collective mark or a certification or guarantee mark, in several countries, by filing one application (an international application) directly with the applicant's national or regional trademark office (the office of origin) and obtaining one registration (international registration).

A mark may be the subject of an international application only if it has already been registered by or applied for with the trademark office of the Contracting Party with which the applicant has the necessary "connection" to the system.

The applicant designates, in the international application, the Contracting Parties in whose territories protection is sought. WIPO communicates the mark to the offices of the designated Contracting Parties, which examine it in exactly the same way as if it had been filed as a national application. If examination results in grounds for refusal, or if a third party files an opposition, the office of the designated Contracting Party may, within a fixed time limit, declare that protection cannot be granted in its territory. If no refusal is issued by that office, or if a refusal is subsequently withdrawn, the international registration obtained for the mark under the Madrid system has the same effects, in the Contracting Party concerned, as a national registration.

An international registration is initially valid for 10 years and can be renewed indefinitely for 10-year terms.

International registrations for marks protected under the Madrid system can be searched through the ROMARIN database, available on WIPO's website at www.wipo.int/madrid/en/romarin/

The following GIs are protected as collective or certification marks under the Madrid system:

BAROLO

International Registration No. 1022062
in class 33, for wine



International Registration No. 958378 in
class 31, for persimmons



International Registration
No. 1034838 in class 31, for star apple fruits



International Registration No. 959458 in
class 30, for tea

NAPA VALLEY

International Registration No. 1085952
in class 33, for wine

LÜBECKER MARZIPAN

International Registration No. 493902 in
class 30, for marzipan

Source: ROMARIN database

Conclusion

Although they are one of the oldest forms of IP, GIs have only recently become the subject of generalized interest. In many countries, the need to comply with obligations under the TRIPS Agreement triggered this focus on GIs. Countries soon realized that there is potential value in this form of IP. The fact that GIs are embedded in a territory means they can be effective tools for promoting locally-based development. Their close linkage with tradition suggests that they can have a positive impact on the preservation of TCEs and TK. With the increasing recognition of GIs' multifunctional character, the challenge will be to design and implement a comprehensive GI scheme that could constitute the basis for sustainable development.

This booklet describes some of the policy considerations related to the development of GI schemes, as well as some of the factors and conditions involved in their success. It then concentrates on one of those conditions, namely the protection of GIs as an IP right. It is clear that legal protection of GIs should not be an isolated aim, and that it is not the unique prerequisite for a successful GI. However, it is also evident that failure to adequately protect

GIs as IP can throw overboard even the most balanced, development-oriented GI scheme.

The booklet outlines some of the current threats facing unprotected GIs, and summarizes the modes of protection available at the national and international levels.

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SCT/9/4: "The Definition of Geographical Indications"

SCT/9/5: "Geographical Indications and the Territoriality Principle"

SCT/10/4: "Geographical Indications"

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