SOME LEGAL ASPECTS OF GEOGRAPHICAL INDICATIONS (GIs) IN INTELLECTUAL PROPERTY LAW AND DEVELOPING COUNTRIES

Dissertation submitted to the Jawaharlal Nehru University
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the award of the Degree of

MASTER OF PHILOSOPHY

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CERTIFICATE

This is to certify that the dissertation entitled **"SOME LEGAL ASPECTS OF GEOGRAPHICAL INDICATIONS (GIs) UNDER INTELLECTUAL PROPERTY LAW AND DEVELOPING COUNTRIES"**, submitted by me in partial fulfillment of the requirements for the award of the degree of **MASTER OF PHILOSOPHY** is my own work and has not been previously submitted for the award of any other degree of this or any other university.

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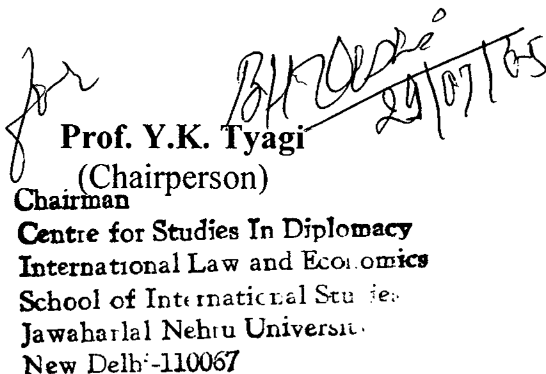

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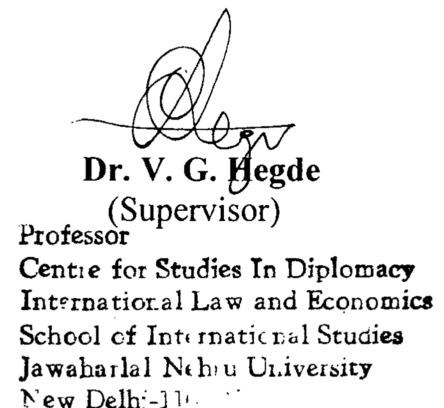

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List of Abbreviations

AIPPI	-	International Association for the Protection of Intellectual Property
APEDA	-	Agricultural and Processed Food Products Export Development Authority
APTDC	-	Andhra Pradesh Tourism Development Corporation
CEFTA	-	Central European Free Trade Area
CSIR	-	Council for Scientific and Industrial Research
CTM	-	Certification Trademark
DDA	-	Doha Development Assistance
DSU	-	Dispute settlement Understanding
EC	-	European Communities
EU	-	European Union
GATT	-	General Agreement on Tariffs and Trade
GIs	-	Geographical Indications
ICC	-	International Chamber of Commerce
INTA	-	International Trademark Association
IP	-	Intellectual Property
IPRs	-	Intellectual Property Rights
MFN	-	Most Favoured Nation
MTN	-	Multilateral Trade Negotiations
NABARD	-	National Bank for Agricultural and Rural Development
RSFTE	-	The Research Foundation for Science, Technology and Ecology
SI	-	Starch Index
TK	-	Traditional Knowledge
TNC	-	Trade Negotiations Committee
TRIPs	-	Trade Related Aspects of Intellectual Property Rights
UNDP	-	United Nations Development Programme
US	-	United States
USPTO	-	United States Trademark and Patent Office
WIPO	-	World Intellectual Property Organisation
WTO	-	World Trade Organisation

Dedicated to
Monish & Deepu

Chapter I

Introduction

Geographical Indications (GIs) are one of the forms of intellectual property rights (IPRs) incorporated in the Agreement on the Trade-Related Aspects of Intellectual Property Rights (TRIPs), 1994.[1] GIs are implicitly different in its characteristics when compared to other branches of IPRs. The general norm of IP law is a unique one in the sense, that it should benefit only those who create new knowledge, but GIs are not a 'new' contribution to society, nevertheless they are significant.

GIs are local, communal interests; they are usually group or state-owned property. GIs are a means of identifying the source and denoting the quality and reputation of regionally distinct agricultural goods for purposes of product recognition in the international market. For many years now, products originating from one particular region or another have gained reputations for their unique quality and characteristics. These special attributes are due to the natural factors (e.g., raw materials, soil, regional climate, temperature, moisture), and/or human factors, like the method of preparation or production; particularly traditional, collectively observed indigenous farming and processed techniques. Some of the examples are 'Darjeeling' (India) Tea, 'Swiss'(Switzerland) Chocolates, 'Roquefort' (France) Cheese, 'Florida' (US) Oranges, 'Cuba' Cigars, 'Champagne' (France) Wine.

Ideally, the reputation that are achieved over a number of years, have gained momentum in the modern era, translated into GIs, which has become an important tool for global trade. The economic and political significance of GIs has increased considerably because of the increasing quality awareness and higher quality requirements. It has promoted the demand for products of a specific geographical origin, resulting in an increased interest on the part of the countries of its origin in protecting their GIs. Therefore, it is necessary that any deception as to the origin of a good or unfair competition be thwarted.

1.1: *Origin of GIs*

It is highly difficult to trace the exact origin of GIs as such. But from the available resources it can be concluded that GIs had originated and was protected

[1] The TRIPS Agreement, Article 1(2) states that the term 'intellectual property' refers to Copyright and related rights, trademarks, geographical indications, industrial designs, patents, lay out-designs of integrated circuits, protection of undisclosed information.

in the Continental Europe. The best examples are 'Bordeaux'[2] and 'Champagne'.[3] Hence, the origin of the Geographical Indications (GIs) could be traced back to the Industrial Revolution in Britain, which commenced in the eighteenth century.[4] During that time, the industrial production was on a small scale; moreover, the corporate form of industrial organisation also did not exist. For this reason, the law of protectable goodwill was not necessary. Slowly, the manufactured products such as pottery and woven fabrics and agro productions were developed and earned revenue. In the competition to earn revenue from international trade, which was developing at that time, it became apparent that the products of particular regions were more saleable than comparable products from other regions, because of their superior quality. This superior quality resulted from the geographical advantages, such as climate, geology and temperature conditions.

To take advantage of the commercial attractiveness of these local reputations which reflected the skills of the local artisans, associations etc., and merchants branded their goods with marks which designated the place of origin of these products. The legislations to protect the commercial reputation of traders in discrete geographical localities evolved principally in Europe.

The industrial revolution saw the emergence of the modern trademark system. But it did not result in the disappearance of geographic marks. Particularly, in Europe the substantial food processed markets and alcoholic beverages markets were dependant upon the continued recognition of geographical marks and it has been protected through international conventions such as, Paris Convention 1883, Madrid Agreement 1891, Lisbon Agreement 1958 and now the TRIPs Agreement 1994.

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[2] William Van Caenegem, "Registered Geographical Indications: Between Intellectual Property and Rural Policy-Part II", *Journal of World Intellectual Property*, vol. 6, 2003, pp. 861-874 at 861. (In the middle ages in the South-West of France, and also in other French producing regions, the sale and consumption of wines from other regions were prohibited. Only wines originating in the region were allowed entry into its towns. Right up until the times of the French Revolution of 1789, the Bordeaux region also benefitted from two additional privileges, a) *privilege de la descente* and b) *privilege de la barrique*. At that time, the transport of wine in that region of France was by river. The *privilege de la descente* meant that wines from outlying regions, not being part of Bordeaux area, were not to be brought down by river to Bordeaux for sale before 11 November of each year, and some even later. The *privilege de la barrique* meant that the wines of Bordeaux were the only ones entitled to a barrel of a special form and dimension).

[3] Ibid, p. 864.

[4] Michael Blakeney, "Proposal for the International Regulation of Geographical Indications", *Journal of World Intellectual Property*, vol. 4, (2001), pp. 629-652 at 629.

1.2: *The Importance of Geographical Indications*

GIs are designed primarily to serve for the benefit of consumers in order to prevent deception with regard to the geographical origin of a product and they also serve a dual purpose,[5] inclusive of the former,

a) Protection of customers and consumers against wrong or misleading indications on the one side, and

b) Protecting the well-earned good-will of those being entitled to use the GI on the other.

The economic and cultural perspectives of GIs are also significant. Economically, they serve to protect intangible assets continued by market differentiation, reputation and quality standards. They also permit to attach the production of a specific product to the territory of its origin. GIs are not designed to be sold as commodity goods or to have a hegemonic preponderance in the market; they are usually shown in the market as a luxury good. In addition, it gives the consumer confidence in the product's origin, which is synonymous with quality and its special characteristics. Culturally speaking, GIs are intrinsically linked with the traditional ways of production. GIs first saw the light of day in Continental Europe, especially in France, Italy and Spain where they have been used for centuries. The environment and human factor has added a special value to the final product identified with a GI. GIs also give localities an opportunity to identify products that are collectively produced.[6]

1.3: *Benefits of GIs*

GIs have a high potential on increasing the reputation of a product, and it benefits by increasing the economic value of producers because higher quality leads to higher benefits, better identification in the market tends to increase consumer attraction and there is no high cost for producers. GIs have multisectoral

[5] Christopher Heath, The Importance of Geographical Indications, Paper presented at the EU-ASEAN workshop on Geographical Indiations: A Way into the Market, Hanoi, 7-8 October 2003.

[6] David Vivas-Eugui, "Negotiations on Geographical Indications in the TRIPS Council and their effect on the WTO Agricultural Negotiations-Implications for Developing Countries and the Case of Venezuela", *Journal of World Intellectual Property*, vol. 4, (2001), p.703-728 at p. 705.

benefits such as, the development of rural areas and a stronger implication with a specific territory by way of protecting the land and promoting stronger in environmental issues. It also protects the land, promotes stronger links between people and the region.

1.4: *Overview of GIs and TRIPs Agreement*

The International protection of GIs developed through a number of stages and at different levels. Before the TRIPs Agreement, it had its base in the Paris Convention for the Protection of Industrial Property 1883, Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods 1891, International Convention on the Use of Appellations of Origin and Denominations of Cheeses 1951 ("Stresa Convention"), Lisbon Agreement for the Protection of Appellations of Origin and their Regulation 1958. These Agreements were not effective in protecting the GIs world wide because of their lesser membership which was contained only to Europe.[7]

With its growing importance GIs had its rebirth under the TRIPs Agreement in 1994, at the end of the Uruguay Round negotiations under the auspices of General Agreement on Tariffs and Trade ('GATT'), after a longer debate and hard bargaining between the developed nations including United States, Japan, the European Union (E.U.) and Switzerland in the issue of extending the full-bodied protections for wine producers. The TRIPs agreement provides for additional protection of wines and spirits which has been contested by the developing countries.

Under the TRIPS Agreement, GIs are subject to the same general principles applicable to all other categories of Intellectual Property Rights (IPRs) included in the Agreement, mainly the Minimum Standards, the National Treatment and the Most Favoured Nation (MFN) clause. The early proposals were presented by the European Communities with regard to Geographical indications. The terminology problem for GIs still persists as recognized by WIPO within the Standing Committee on Trademarks, Industrial Designs and Geographical Indications (SCT).

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[7] Kevin M. Murphy, "Conflict, Confusion, and Bias under TRIPs Article 22-24", *American University International Law Review*, vol. 19, no. 5, (2004), pp. 1181-1230 at p. 1202.

Article 22 of the TRIPs Agreement provides protection to GIs in general to all products in the country of its origin and without an obligation for other countries to extend reciprocal protection. But Article 23 of the Agreement provides additional or stronger protection to GIs only in the cases of Wines and Spirits which means they should be protected even if there is no risk of misleading or unfair competition. Developing countries consider this Article as discriminatory in nature and argue for the extension of Additional Protection for the products other than wines and spirits. After the 'Basmati' case India has intensified the argument for extension of protection.

The TRIPS Agreement contains a clear and triple distinction in the level of protection for GIs relating to (i) all products [Article 22], (ii) for wines and spirits [Article 23.1, 23.2], and (iii) only for wines [Article 23.3, 23.4]. The Agreement at the time of its adoption represented the particular interest of the wine producer's viz., European and United States, in order to grant special protection to this kind of product, compared to the standard protection granted to other products. After the developing countries emergence in the international trade process, the entire area got its momentum. The TRIPS Agreement has certain grey areas which need to be closely perused. The most important of this is the interface between Geographical Indications and Trademarks, Generic Indications, Homonymous Indications and relationship between GIs and Traditional Knowledge.

The existence of a co-relation between Geographical Indications and Trademarks is evident from Articles 22.3, 23.2, 24.5 of the TRIPS Agreement. As a general rule, trademarks must not be descriptive or deceptive.[8] Consequently, trademarks that consist of or contain a GI cannot be protected if use of such trademarks would be misleading as to the true origin of the products on which the trademark is used. Laws on trademarks specifically exclude the registration of geographical terms that can be understood to constitute a reference to the origin of the relevant goods. This exclusion from registration usually depends on an assessment whether a geographical term used as a trademark would be perceived

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[8] Denis Croze, The International Legal Framework Concerning the Protection of Geographical Indications: WIPO Treaties and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), presented in EU-ASEAN Workshop on Geographical Indications: A Way into the Market, 7-8 October 2003, Hanoi at p. 12.

by the public to indicate a connection between the origin of the goods and the trademark.

Generally, Trademarks are distinctive so as to fulfill the role of distinguishing goods/services of one manufacturer from those of another. This leads to the general proposition that geographical indications are excluded from the domain of trademarks. Yet there are many conceivable and real instances where a trademark consists of or contains geographical indications. For example, the use of 'Antartica' as a trademark for bananas is considered permissible as there is no deceptive element in terms of implying geographic origin. But in other instance, the trademark "Budweiser"which was registered in the United States has been disputed by the Czech Republic. Though this trademark has been in existence since 1876, the Czech Republic claimed that the nature was derived from the town of Ceske Budejouice in the Czech Republic and got the trademark Budweiser cancelled in Austria, Israel, Portugal and Switzerland. Thus, still the relationship between Trademarks and Geographical Indications (GIs) is complex and the balance attempted by negotiators is brought in has been tenuous and open to varied interpretations. WIPO's Standing Committee on the Law of Trademarks, Integrated Designs and Geographical Indications (GIs) has cited these issues on a number of occasions. In this study these issues will be examined carefully.

Article 23.4 of the Agreement deals with the issue of establishing a common Multilateral System of Notification and Registration for GIs. This 'in-built agenda' has setforth its target before the TRIPs council. After the Doha Round in 2001, the issue got impetus and it has been referred to the Trade Negotiation Committee (TNC) and has received divergent proposals from among the various WTO member states. Several models have been put forward by the member states in this regard, and this study will examine the various proposals made by the member states and their analysis.

As mentioned earlier the protection granted by Article 23 is opposed by the developing countries on discriminatory grounds and seek for extension of protection under Article 24.1.

The Member States which are opposing the extension of protection to products other than wines and spirits do so, on the basis, that such an extension of the scope of Article 23.1 to products other than wines and spirits, would entail

reopening of the TRIPS Agreement for negotiations. Further, there is no legal basis for negotiating such an extension since there is no such mandate in any of the provision in TRIPS Agreement. Moreover certain countries argue that an extension would affect the trade process and the consumers would also be affected adversely.

Article 24.1 calls for negotiations of enhanced protection for individual GIs for wines and spirits. The majority of developing countries who are arguing for enhanced protection for all products claim that this Article refers to products other than wines and spirits. There is no consensus yet on this issue among the Member States.

1.5: *GIs in Indian Context*

GIs in India have existed for long as it has had a strong Agricultural and Handicrafts background. In compliance to the TRIPS Agreement, India has enacted the Geographical Indications of Goods (Registration and Protection) Act, 1999 and Rules, 2002. The Act came into force from 15th September 2003. Prior to the coming into the existence of this Act, GIs were protected by the Common Law under the principles of Passing Off and Unfair Competition. The Court has played a significant role in interpreting the above said principles and applied it in judgments. In the case of infringements of GIs that mislead the consumers as to the place of origin or constituted unfair competition there are instances, of the Court granting relief including grant of injunction restraining the defendant from using such indications. (*Imperial Tobacco Co. v. Registrar, Trade Marks,* AIR 1977 Cal.413; *Scotch Whisky Association v. Pravara Sakhar Shakar Karkhana Ltd,* AIR 1992 Bom.294).

The GIs Act, 1999 has been divided into nine chapters. Chapter I define various terms used in the Act. Chapter II deals with appointment, powers and establishment of Registry. Chapter III deals with procedure and duration of registration. Chapter IV describes the effect of registration. Chapter V contains special provision relating to trademark and prior user. Chapter VI provides for rectification and correction of the Register. Chapter VII relates to appeals and Appellate Board whereas, Chapter VIII prescribes penalties and procedure. The Indian Act defines GIs in a broad manner. It separately defines the term 'indications'. Another important feature is that the under the Act broad meaning

has been given to the term 'goods'. The remedies which are available for protection of GIs may broadly be classified into two categories: (i) Criminal and (ii) Civil Remedies. The punishment prescribed under the section varies from the six months to three years imprisonment and a fine of not less than Rupees fifty thousand which may extend to Rupees two lakh. The Act has prescribes for enhanced penalty for second or subsequent conviction. The discretion is vested with the courts to impose a lesser punishment than the minimum punishment after recording in the judgment adequate and special reasons for awarding such lesser punishment. The suit for infringement can also be filed in the court not inferior to that of a District Court. The Central Government established the Geographical Indications Registry with all India Jurisdiction at Chennai.

In the International arena, India plays an important role in the issue of extension of additional protection for GIs to products other than wines and spirits. In this issue, India jointly submitted its paper along with some of the other developing countries in the WTO. India maintained the stand that the additional protection would deliver enhanced benefits via increased trade opportunities for members and producers and, more effective protection for consumers and ultimately would promote export of such products. (*IP/C/W/204/Rev.1,* dated 2 October 2000, *IP/C/W/247/Rev.1,* dated 17 May 2001, *IP/C/W/308/Rev.1,* dated 2 October 2001, *IPC/C/W/353,* dated 24 June 2002). For the extension of additional protection, India cites the glaring examples of Darjeeling Tea and Basmati Rice.

1.6: *Review of Literature*

Many studies have been conducted on the historical development of geographical indications. Michael Blakeney observed that Marks indicating the geographical origins of goods were the earliest type of trademark and the article describes the protection of geographical indications under national and international law, with particular attention to the scheme of protection for such marks envisaged for the WTO TRIPS Agreement. Further, he emphasizes the need for the developing countries involvement in the process of negotiations and their importance when it deals with the variety of aspects such as trademarks, genetic resource materials and traditional knowledge. He suggested the settling of the genetic resources dispute matters by a systematic way. (Blakeney, Michael,

"Proposals for the International Regulation of Geographical Indications, *Journal of World Intellectual Property*, vol.4, 2002, pp.629-652).

Asserting the necessity of extension of additional protection to products other than wines and spirits and the enforcement of the multilateral system of registration and protection of GIs, Suresh C. Srivastava signifies the importance of basic issues of protection of GIs relating the TRIPS Agreement. He also extensively analyzed the debates on Multilateral System of Registration of GIs, and approaches for resolution of conflict between GIs and trademarks. (Srivastava C. Suresh, "Geographical Indications under TRIPS Agreement and Legal Framework in India: Part I and Part II", *Journal of Intellectual Property Rights*, vol. 9, 2004, pp.9-23). On the other hand, Niranjan Rao based on his study arguing for the removal of the provision of additional protection from the TRIPS Agreement itself. He concludes his study with a case study of Darjeeling Tea, by arguing that Article 22 protection may be enough and developing countries should experiment with Article 22 protection for some years, and if the results are unsatisfactory, then the developing countries should ask for enhanced protection. (Niranjan Rao, Geographical Indications in Indian Context: A Case Study of Darjeeling Tea", *Working Paper No.*110, September 2003, ICRIER, New Delhi)

The Article titled 'Geographical indications for Foods' by Marsha A. Echols portray the debate of extending the international recognition and protection of geographical indications for foods primarily from an African perspective. It describes GIs are as similar to traditional knowledge as they focus on old creativity and community ownership rather than other Intellectual Property matters. He stressed the role of Geographical Indications (GIs) in bolstering the rural areas where majority of the people are living. He also examined the Doha Development Agenda and its applicability to rural areas. He concludes by saying that African countries should consider carefully the economic and social impact of geographical indications for foods since there are potential benefactors. He also suggested that the country should evaluate its existing and potential geographical indications; its capabilities to implement extended system and whether the concession is required in negotiations to extend TRIPS recognition and protection are justified by the immediate and long term benefits. (Echols A. Marsha, "Geographical indications for Foods, TRIPS and the Doha Development Agenda, *Journal of African Law*, vol. 47, 2003, pp.199-220).

1.7: *Scope and Objective of the Study*

This study would be an attempt to define the concept of GIs with the help of various International Conventions and Agreements. Considering its scope, this study looks only into the provisions of TRIPs Agreement and other relevant multilateral agreements are referred briefly wherever it finds necessary. It examines the provision relating to additional protection to wines and spirits and the possible implications to developing countries. It also studies the negotiations on the extension debate in the Uruguay Round between the developed countries and developing countries. The study would also incorporate the recent WTO Panel ruling on GIs for the easy understanding of the subject. It also makes a modest attempt to look into the debate of extension of higher level protection to products other than wines and spirits, multilateral system of notification and registration of GIs between developed and developing countries. This study also concentrates on the matters such as trademarks, traditional knowledge, and homonymous indications, under the TRIPS Agreement. This study would also briefly analyse the position of India with regard to GIs with the help of case studies and examines the Geographical Indications of Goods (Registration and Protection) Act, 1999 and possible criticisms if any.

Therefore, this study is intended:

1. To analyse the implications of GIs towards developing countries.
2. To examine the possible issues involved in getting the Additional protection to products other than Wines and Spirits.
3. To examine the Indian Law on the subject of GIs and its implementation.
4. To analyse the establishment of Multilateral Notification and Registration of Wines in the developing countries perspective.

1.8: *Methodology*

The study will be based on both primary and secondary sources. Primary sources include documentations relating to GATT Documents, WTO Reports, WTO Agreements, WIPO Treaties, WIPO Symposium and relevant Conventions. This study will analyse the submissions made by the Member States to the various committees and council. In addition, the study will make use of the reports of the

TRIPS Council, Trade Negotiations Committee and World Trade Organization on the related subject matter. Further, the study will cover secondary sources such as books, articles, reviews and the comments of eminent authors and interviews with those who have worked in this field of study.

1.9: *Chapterisation*

I. Introduction

This Chapter will describe the importance, nature of GIs and its evolution as an important marketing tool of economy. It would also briefly examine the International Agreements which relate to geographical indications prior to the TRIPS Agreement.

II. *Geographical Indications (GIs) and Trade Related Aspects of Intellectual Property Rights (TRIPs)*

This chapter will examine the Geographical Indications provisions under the TRIPs Agreement. It will also analyse the debate of extension of additional protection to products other than wines and spirits, multilateral system of notification and registration of wines and spirits, resolution of conflict between trademarks and geographical indications, homonymous geographical indications, Traditional Knowledge aspects etc., It tries to analyse the comparative position and practices which are adopted with regard to GIs by the Member States of WTO.

III. *Geographical Indications (GIs): Implications for Developing Countries*

This Chapter would analyse the extension debate of additional protection to products other than wines and spirits and possible implications for developing countries. The study also examines on the issues which rose by the developed countries. It tries to examine the possible outcome of benefits to the developing countries if the TRIPs agreement provides for extension of higher protection.

IV. *Geographical Indications (GIs) and India*

This Chapter will describe how GIs were protected in India before the TRIPS Agreement came into force and study the present law relating to protection

of GIs. It would also carefully study the submissions made by India on this subject, the debate on extension of protection relating to all products, and a critical analysis of the Geographical Indications (Registration and Protection) Act, 1999.

V. *Conclusion*

This Chapter would attempt to derive conclusions from the preceding chapters.

Chapter II

Geographical Indications (GIs) and Trade Related Aspects of Intellectual Property Rights (TRIPs)

2.1: *Introduction*

The emergence of Geographical Indications (GIs) in the TRIPs[1] Agreement is one of the important outcomes of the Uruguay Round Negotiations that was concluded on 15 April 1994. The TRIPs Agreement[2] is the first multilateral text dealing with GIs as such and it may rightly be considered as an important step in this difficult field.[3] At the time of the adoption of TRIPS Agreement, all categories of Intellectual Property Rights (IPRs) regulated therein, neither had the same degree of legal or doctrinal development nor the same degree

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[1] Marrakesh Agreement Establishing the World Trade Organization, Annexe 1C: Agreement on Trade-Related Aspects of Intellectual Property Rights, April 15, 1994, reprinted in THE RESULTS OF THE URUGUAY ROUND OF MULTILATERAL TRADE NEGOTIATIONS-THE LEGAL TEXTS 6-19, 365-403 (Geneva: GATT Secreteriat, 1994).

2 *See* generally on TRIPs, Symposium: Trade-Related Aspects of Intellectual Property, *Vanderbilt Journal of Transnational Law*, vol. 22, no.4 (1989); vol. 29, no.3 (1996); Shahid Alikhan and Raghunath Mashelkar, *Intellectual Property and Competitive Strategies in the 21st Century* (The Hague/London/New York: Kluwer Law International, 2004); Peter Drahos, *A Philosophy of Intellectual Property Rights* (Dartmouth: Aldershot and Brookfield, 1996); Christopher Arup, "TRIPs: Across the Global Field of Intellectual Property", *European Intellectual Property Review*, vol. 26, no.1 (2004), pp. 7-16; Margo A. Bagley, "Legal Movements in Intellectual Property: TRIPS, Unilateral Action, Bilateral Agreements, and HIV/AIDS", *Emory International Law Review*, vol.17, no.2 (2003), pp. 781-798; Dilip K. Das, "Intellectual Property Rights and the Doha Round", *The Journal of World Intellectual Property*, vol. 8, no.1 (2005), pp. 33-52; Sandipto Dasgupta and Yamini Srivastava,. "Public Health Safeguards in TRIPS a Domestic Legal Response", *Indian Journal of International Law*, vol. 43, no.4 (2003), pp. 661-704; Biswajit Dhar, and R.V. Anuradha, "Access, Benefit-Sharing and Intellectual Property Rights", *The Journal of World Intellectual Property*, vol. 7, no.5 (2004), pp. 597-639; Graeme B. Dinwoodie, and Rochelle C. Dreyfuss, "TRIPS and the Dynamics of Intellectual Property Lawmaking", *Case Western Reserve Journal of International Law*, vol. 36, no.1 (2004), pp. 95-122; Peter Drahos, "Securing the Future of Intellectual Property: Intellectual Property Owners and Their Nodally Coordinated Enforcement Pyramid", *Case Western Reserve Journal of International Law*, vol. 36, no.1 (2004), pp. 53-94; Mohammed El-Said, "The Road from TRIPS-minus, to TRIPS, to TRIPS-plus", *The Journal of World Intellectual Property*, vol.8, no.1 (2005), pp. 53-65; Assafa Endeshaw, "Asian Perspectives on Post-TRIPS Issues in Intellectual Property", *The Journal of World Intellectual Property*, vol. 7, no.6 (2004), pp. 211-235; Donald P. Harris, "TRIPS Rebound: A Historical Analysis of How the TRIPS Agreement can Ricochet Back Against the United States", *Northwestern Journal of International Law and Business*, vol. 25, no.1 (2004), pp. 99-164; Laurence R. Helfer, "Regime Shifting: The TRIPs Agreement and New Dynamics of International Intellectual Property Lawmaking", *The Yale Journal of International Law*, vol. 29, no.1 (2004), pp. 1-83; Pascal Lamy, "Trade-Related Aspects of Intellectual Property Rights: Ten Years Later", *Journal of World Trade*, vol. 38, no.6 (2004), pp. 923-954; Ruth L. Okediji, "Public Welfare and the Role of the WTO: Reconsidering the TRIPS Agreement", *Emory International Law Review*, vol. 17, no.2 (2003), pp. 819-918; Daya Shanker, "The Vienna Convention on the Law of Treaties, the Dispute Settlement System of the WTO and the Doha Declaration on the TRIPs Agreement", *Journal Of World Trade*, vol. 36, no.4 (2002), pp. 721-772; Danielle Tully, "Prospects for Progress: The TRIPS Agreement and Developing Countries After the Doha conference", *Boston College International and Comparative Law Review*, vol. 26, no.1 (2003), pp. 129-143.

[3] Daniel Gervais, *The TRIPs Agreement: Drafting History and Analysis* (London: Sweet and Maxwell, 1998), p. 62.

of acceptance among countries.[4] In the case of GIs, the appropriate legal treatment and level of protection continued to be fiercely debated between GATT members.[5] During the negotiations, GIs protection was a sensitive issue. Only at the final stages of the Uruguay Round, the agreement concerning GIs was reached, largely due to the parties ability to link GIs with the agricultural negotiations taking place at the time.

In this regard, this chapter is an attempt to look into the early negotiations on GIs under the TRIPs Agreement, the countries' positions, legal analysis of the TRIPs provisions on GIs, the interface between Trademarks and GIs, and the resolution of the conflict between the two areas. It would also study the various aspects of homonymous indications, debates on multilateral system of notification and registration, additional protection clause of the TRIPs Agreement.

2. 2: *Basic Negotiations on GIs: Various Proposals*

The negotiating plan[6] for the General Agreement on Tariffs and Trade (GATT) Uruguay Round, which included the TRIPs Agreement work programme, was agreed on 28 January 1987. Under the title 'Trade Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods', the negotiating plan set the scene for discussions on IPRs within one of the fourteen negotiating groups established under the 'Group of Negotiation on Goods'.[7] The first phase of negotiations encapsulates the entire issue of IP. The United States

[4] Sergio Escudero, "Internatonal Protection of Geographical Indications and Developing Countries", *WORKING PAPER NO. 10,* Trade-Related Agenda, Development and Equity (T.R.A.D.E.), South Centre, July 2001, at p. 22.

[5] Jorg Reinbothe and Anthony Howard, "The State of Play in the Negotiations on TRIPs (GATT/Uruguay Round), *European Intellectual Property Review,* vol. 13 (1991), pp. 157-164 at 158; M. Geuze, Protection of Geographical Indications under the TRIPs Agreement and Related Work of the WTO, in WIPO Symposium on the International Protection of Geographical Indications, Eger, Hungary, October 24 and 25, 1997; Jayashree Watal, *Intellectual Property Rights in the WTO and Developing Countries* (The Hague: Kluwer Law International, 2001) at p. 265.

[6] GATT Doc. No. GATT/1405 dated 5 February 1987.

[7] The Negotiating Group on Trade-Related Aspects of Intellectual Property, Including Trade in Counterfeit Goods', chaired by Ambassador Lars Anell of Sweden.

delegation in Geneva submitted its own proposal for the protection of IPRs on 19 October 1987.[8]

After that, the European Communities (EC),[9] Japan[10] and Switzerland[11] tabled their proposals in late 1987. Due to persistent pressure from wine and spirit producers in Europe, the EC has submitted another proposal, suggesting the inclusion of GIs and appellations of origin should also be included in the TRIPs Agreement.[12] The initial negotiations were stalled because of the stauch opposition of the developing countries over the competence of the GATT to negotiate substantive standards of IP protection.[13]

Again in July 1989, the TRIPs negotiating group met twice to discuss the applicability of basic GATT principles to IP and, the provision of adequate safeguards regarding the availability, scope and use of IPRs. By the end of 1989 there had been numerous proposals by countries participating in negotiations, but it did not make out any concrete results. In the early 1990's, five further proposals were put forward by the major players in the TRIPs negotiations,

[8] Suggestion by the United States for Achieving the Negotiating Objective, MTN.GNG/NG11/W/14 dated 20 October 1987, and Revision, MTN.GNG/NG11/W/14/Rev. 1 dated 17 October 1988. This proposal called for an end to the trade in infringing products through the implementation of customs controls and implementation of legislative norms for the protection oof intellectual property rights, with an assurance that such measures would not create barriers to legitimate trade.

[9] GATT Doc No. MTN.GNG/NG11/W/16 dated 20 November 1987. The EC proposal suggested that the TRIPs Agreement should adhere to the basic GATT principles of National Treatment, Non-Discrimination, Reciprocity and Transparency as well as covering new plant varieties.

[10] GATT Doc No. MTN.GNG/NG11/W/17 dated 23 November 1987. The Japanese proposal was similar to the submission of US, but in response to the concerns of its domestic computer chip industry, it additionally addressed the difficulties in protecting Semi-Conductor Lay Out Designs.

[11] The Switzerland proposal suggests a framework for a TRIPs Agreement and addressed the need for improvement of the enforcement of IP protection.

[12] Guidelines and Objectives Proposed by the European Community for the Negotiations on Trade Related Aspects of Substantive Standards of Intellectual Property Rights, MTN.GNG/NG11/W/26 dated 7 July 1988. This initial proposal of EC lacked the statement of concerning substantive standards. It did, however, suggest national enforcement provisions.

[13] The developing countries majorly led by India and Brazil questioned the relevance of IP for the GATT, and it strongly stressed the role of WIPO as the appropriate forum for IPRs in Michael Blakeney, "Intellectual Property in World Trade", *International Trade Law and Regulation,* vol. 1 (1995), pp. 76-81 at p. 79.

namely the European Communities,[14] Japan,[15] Switzerland,[16] the United States[17] and a Group of Developing Countries.[18]

The substantive issues of proposals submitted by the countries relates to GIs are discussed hereunder:

2.2.1: ***European communities Proposal***

The proposal submitted by the European Communities was the first initiation towards the inclusion of GIs. In this proposal, for the first time,[19] a simple definition of GIs including Appellations of Origin has been mentioned.

Section 3. f. defines GIs including appellations of origin as:

> *"Geographical indications are, for the purpose of this agreement, those which designate a product as originating from a country, region or locality where a given quality, reputation or other characteristic of the product is attributable to its geographical origin, including natural and human factors".*

2.2.1. i: ***Salient Features of the EC's Proposal***

a. The definition for GIs includes Appellations of Origin. The requirements are that the products should be originated from a country, region or locality. The products quality, reputation or characteristics should be attributable to its geographical origin which includes natural and human factors;
b. The protection should be accorded to Appellations of Origin wherever it is appropriate;

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[14] GATT Doc. No. MTN.GNG/NG11/W/68, dated 29 March 1990.

[15] GATT Doc. No. MTN.GNG/NG11/W/74, dated 15 May 1990.

[16] Standards and Principles Concerning the Availability, Scope and Use of Trade-Related Intellectual Property Rights, Communication from Switzerland, MTN.GNG/NG11/W/38, 11 July 1989; GATT Doc. No. MTN.GNG/NG11/W/73, dated 14 May 1990.

[17] Draft Agreement on the Trade-Related Aspects of Intellectual Property Rights, Communication from the United States, MTN.GNG/NG11/W/70, 11 May 1990.

[18] GATT Doc. No. MTN.GNG/NG11/W/71, dated 14 May 1990. The Group contains fourteen developing countries including Argentina, Brazil, Chile, China, Columbia, Cuba, Egypt, India, Nigeria, Pakistan, Peru, Tanzania, Uruguay and Zimbabwe.

[19] n. 9.

c. GIs shall be protected against any use which constitutes unfair competition, any use which may mislead the public as to the true origin of the product,
d. Appropriate measures should be taken at the national level to prevent the designation of generic character;
e. The registration of trademark contains geographical or other indication denominating or suggesting a country, region or locality with respect to the goods and those not having this origin shall be refused or invalidated. National laws shall provide the possibility for interested parties to oppose the use of such a trademark;
f. In order to facilitate the protection of GIs including appellations of origin, the establishment of an international register for protected indications should be provided for;
g. According to the TRIPs Agreement, the prevention of the use of GI identifying wines or spirits not originating in the place indicated by the GI, even where the true origin of goods is indicated or the indicated one is used in translation or accompanied by expressions such as 'kind', 'style', 'imitation' or the like. But according to the EC proposal, it was applicable to GIs relating to all products and not only to wines and spirits; and
h. The proposal, also included the 'additional protection' clause for wines and spirits and for the establishment of a multilateral system of notification and registration of GIs for wines eligible for protection in those countries participating in the system, and were finally incorporated in Article 23.4 of the TRIPs Agreement.[20]

2.2.2: ***United States Proposal***

In the first proposal of US there is no mention of GIs.[21] Even as of its fully articulated May 1990 proposal to the Trade Negotiations Committee (TNC),[22] the

[20] n. 14, Article 21(3) of the EC Proposal.

[21] n. 8.

[22] n. 17, Article 18 of the US proposal provides, "Contracting parties shall protect geographic indications that certify regional origin by providing for their registration as certification or collective marks", and According to Article 19, Contracting parties shall provide protection for

US appeared skeptical of extending the scope of protection afforded to GIs. Articles 18 and 19 of the proposal referred to GIs. The US proposed to protect GIs "that certify regional origin by providing for their registration as certification or collective marks". This was the system which has been currently practiced in the US. This provision drew on the law of trademarks, a notion that in the US, that had been the predominant approach towards protection of GIs.[23]

US had also sought protection, "for non-generic appellations of origin for wine by prohibiting their use when such use would mislead the public as to true geographic origin of the wine".

2.2.3: ***Swiss Proposal***

Swiss proposal has contained fairly elaborated provisions regarding GIs.[24] This proposal has included a more specific definition for GIs compared to other proposals.

Sec. 14- "*A geographical indication is any designation, expression or sign which aims at indicating that a product is originating from a country, a*

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non-generic appellations of origin for wine by prohibiting their use when such use would mislead the public as to the true geographic origin of the wine. To aid in providing this protection, contracting parties are encouraged to submit to other contracting parties evidence to show that each such appellation of origin is a country, state, province, territory, or similar political subdivision of a country equivalent to a state or county; or a viticultural area".

[23] Eleanor K. Meltzer, "TRIPs and Trademarks-or GATT Got Your Tongue?", *Trademark Reporter*, vol.83 (1994), p. 18.

[24] n. 16. "III. GEOGRAPHICAL INDICATIONS –
Definition of Geographical Indications
Use of Geographical Indications
15. Geographical indications shall be protected against use which is likely to mislead the public as to the true origin of the products. Shall notably be consideredto constitute such use:– any direct or indirect use in trade in respect of products not originating fromthe place indicated or evoked in the geographical indication in question;
– any evocation, even where the true origin of the product is indicated or the designation is used in translation or accompanied by expressions such as 'kind', 'type', 'style' or 'imitation';
– the use of any means in the designation or presentation of the product likely to suggest a link between the product and any geographical area other than the true place of origin.
Appropriate measures shall be taken so as to prevent a geographical indication from developing into a designation of a generic character as a result of the use in trade for products of a different origin.
The registration of a trademark which contains or consists of a geographical or other indication designating or suggesting a country, region or locality with respect to products not having this origin shall be refused or invalidated, if the use of such indication is likely to mislead the public as to the true geographical origin of the product.

region or a locality.The norms on geographical indications also relate to services".

GIs definition requires any designation, any expression or sign and it should aim at indicating a country's name, a specific region or a locality. This proposal also included "appellations of origin".[25] It has also expressly referred GIs relating to services.[26] This definition is more or less similar to the EC's proposal and it contains other criteria's which are not present in the EC's proposal.

2.2.4: ***Japanese Proposal***

The Japanese proposal contained only a short provision relating to GIs, without any express mention of appellations of origin.[27] Japanese proposal mainly relied on the Madrid Agreement 1967, and protection should be in consonance with the said Agreement. It proposed that:

> *"... protection for geographical indications by complying with the provisions under the Madrid Agreement for the Repression of False Deceptive Indications of Source of Goods of 1891, as last revised in 1967".*

[25] Ibid, Articles 220(2) and 220(3) of the Swiss Proposal.

[26] Ibid, Article 220(4) of the Swiss Proposal; *See* generally on the debate of 'services', note. 3 Gervais at p.67; Dwijen Rangnekar, "Geographical Indications: A Review of Proposals at the TRIPS Council-DRAFT", UNCTAD/ICTSD Capacity Building Project on Intellectual Property Rights and Sustainable Development, June 2002, at p.17. (The possibility of including services within the ambit of Part II Section 3 of TRIPs Agreement raises a series of questions. For example, does the term 'good' include or imply services? Can the references to 'services' in Articles 24.4 and 24.6 allow an interpretation that the definition in Article 22.1 encompasses services. Finally, the inclusion of services within the ambit of Article 22.1 raises a number of wider questions. No doubt, there are a range of services which on prima facie evidence fulfil the fundamental definitional requirement of a GI, such as health services, spas and traditional healing methods. Some countries already protect services as GIs, Viz., Liechtenstein, Peru and Switzerland (IP/C/W/253). However, to be included as a GI, a service will necessarily have to meet the conditions for protection, whi8ch require a clear link between place of origin and the service).

[27] n. 15, Article 2 of Part I of Section 1 of the Japanese Proposal.

2.2.5: ***Developing Countries Position***

Developing Countries has also submitted a proposal but it did not include GIs in that. Chapter III, Section 9 of the proposal addresses the protection of GIs. This has dealt elaborately in the next chapter of this study.

2.3: ***The Unified Proposal or 'Composite Text'***

Lars Anell, Ambassador to the GATT from Sweden and Chairman of TRIPS Negotiating Group made attempt to achieve progress by consolidating the various viewpoints of national delegations was made and on 26 January 1990 through a checklist of questions was produced to codify over 500 points of disagreement.[28] From the list of checklist issues, Ambassador Anell and the GATT Secreteriat consolidated the proposals of the EC, US and Developing countries had brokered a draft compromise text.[29] On 12 July 1990, a meeting of the TRIPs Negotiating Group received the compromise text that had been drafted by Ambassador Anell on his own initiative.[30] Section 3 of the Chairman's proposal referred to the protection of GIs.[31]

2.3.1: ***Salient Features of 'Unified Proposal'***

In order to facilitate the protection of GIs, the bracketed "Composite Text" indicated that "the Committee shall (examine the establishment of) (establish) a multilateral system for the notification and registration of GIs eligible for protection in the parties participating in the system".[32] This draft revealed the delegations' disagreement over several issues. The draft's definition of GI (Section 1-"Definition") varied considerably. Whereas one proposal was very

[28] M.P. Ryan, "*Knowledge Diplomacy: Global Competition and the Politics of Intellectual Property* (Washington, DC: The Brookings Institution, 1998) at p.110.

[29] Ibid, p. 111.

[30] GATT Doc. No. MTN.GG/NG11/W/76 dated 23 July 1990.

[31] This proposal included the obligations to protect geographical indications from: "any usurpation imitation or evocation, even where the true origin of the product is indicated or the appellation or designation is used in translation or accompanied by expressions such as 'kind', 'type', 'style, 'imitation', or the like. It also included an obligation to "co-operate with a view to establishing an international register for protected GIS, in order to facilitate the protection of GIs including appellations of origin".

[32] Article 27 of Document MTN.TNC/35/Rev.1.

general, not even referring to the link between the characteristics of the product and its geographical origin (paragraph 1.1), an alternative draft definition came close to what is today Article 22.1(paragraph 1.2). Both draft definitions used the term "product" instead of "good". This could be an indication of some delegations' intention to include services in the scope of protection.

On the other hand, the draft definition in paragraph 1.1 referred to "product [or service]". In that context, the term "product" was considered to be limited to "good", whereas the ordinary meaning of "product" would arguably also cover services. The final version under Article 22.1 refers to "goods", thus excluding services.

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As far as the scope of protection was concerned, the Anell Draft contained a bracketed proposal (under paragraph 2b.1), according to which protection was to be afforded against "any usurpation, imitation or evocation, even where the true origin of the product is indicated or the appellation or designation is used in translation or accompanied by expressions such as 'kind', 'type', 'style', 'imitation' or the like". The language used in this proposal is almost identical to the terms of the current Article 23.1. It provides for protection even when the public is not misled as to the origin of the products.

However, in one important aspect, this proposal went beyond the scope of the current Article 23.1: it applied to all products and was not limited to wines and spirits. The proposal was not retained in the subsequent Brussels Draft. The Anell Draft under paragraph 2c.1 expressly refers to the U.S. system of protecting GIs as certification or collective marks. This reference was not retained in the Brussels Draft or in TRIPs; instead, both oblige Members to provide the "legal means" for protection. As far as the establishment of a multilateral register for GIs is concerned, this proposal referred to establishment of a multilateral system of notification and registration of GIs for wines and later it became a part of the so-called 'Additional Protection' clause in the 'Dunkel Text'.

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2.4: ***Brussels Draft***

On 1 October 1990, a revised version of the Chairman's Draft was submitted to the TRIPs Negotiating Group, with further revisions incorporated into another version of the Draft issued on 22 November 1990, but the amendments to the Chairman's Draft had been minor. It was this version of the

draft TRIPs Agreement which was presented to the Brussels Ministerial Meeting at Heysel on 3 December 1990 and came to be known as the 'Brussels Draft'.[33]

The Brussels Ministerial meeting ended in a deadlock[34] without resolving many issues,[35] especially in the area of GIs and it reads that,

> *".... it has to be decided whether additional protection should be available for wine and spirits, and the scope of and conditions on exemptions to that protection".*[36]

To balance the differing positions of national delegations, an attempt was made by Director General Arthur Dunkel by tabling a new text of document corresponded to the "Draft Final Act Embodying the Results of the Uruguay Round of Multilateral Trade Negotiations" which was popularly known as "The Dunkel Draft".[37]

2.5: *The Dunkel Draft*

On 20 December 1991, the Director General attempted to achieve progress towards conclusion of the Uruguay Round by tabling a Final Draft.[38] As with negotiations for any multilateral treaty the Dunkel Draft of the TRIPs Agreement was a document that necessarily reflected the concerns of all main negotiating

[33] GATT Doc. No. MTN.TNC/W/35/Rev.1 dated 3 December 1990.

[34] T.P. Stewart, (ed.), *The GATT Uruguay Round: A Negotiating History (1986-1992)*, (Deventer, Netherlands: Kluwer Law and Taxation Publishers, 1993) at p. 2279.

[35] In November 1991, the Director General of GATT, Arthur Dunkel, issues a progress report identifying a range of intellectual property issues that still required resolution. The report noted that twenty issues remained unresolved in the draft TRIPs Agreement. For example in relation to term of patent protection, the availability of patents without discrimination with regard to place of invention, field of technology and whether the product was imported or locally produced, the status of protection for computer programs and rental rights, transitional periods that would be allowed to developed countries. See, *Progress of Work in Negotiating Group: Stock Taking,* GATT Doc. No. MTN.TNC/W89/Add.1 dated 7 November 1991.

[36] Ibid.

[37] Blakeney, n.11, p.80, he observed that the Dunkel Draft, presented as an all-or-nothing agreement designed to prevent parties from cherry picking parts of the Draft that they found acceptable, included a new version of the TRIPs Agreement, produced by the Director General in an attempt to broker a compromise between the differing positions of national delegations.

[38] Agreement on Trade-Related Aspects of Intellectual Property Rights, Inlcuding Trade in Counterfeit Goods (Annex III) in Dunkel Draft.

parties whose assent would be needed for the adoption of the Agreement. Most of the countries had come to consensus in their issues.[39] The EC had received its desired level of protection of GIs.[40] In the final stages of negotiations for the TRIPs Agreement, the focus shifted, with less emphasis on dealing with the concerns of developing countries and more time being spent dealing with the cracks that were beginnning to appear in the US-Europe-Japan alliance that had brought the idea of a TRIPs Agreement so close to fruition. But there were still outstanding differences between the United States and the European Communites on GIs.[41]

Section 3 of the new document (Dunkel Draft) referred to GIs, and it was the same text that had been approved in the later Marrakesh ministerial meeting. The structure of Section 3 of the Agreement encompasses five main categories of issues:

a) Defintion and scope of GIs;

b) Minimum Standards and common protection provided for GIs corresponding to all kinds of products;

c) Additional protection for GIs for wines and spirits;

d) Negotiation and review of section III on GIs; and

e) Exceptions to the protection of GIs.

Then Arthur Dunkel tabled the Draft Final Act Embodying the Results of the Multilateral Trade Negotiations, with minor amendments, and the same was made the final version of TRIPs[42] which was adopted at the conclusion of the

[39] Japan had retained the right of authors to allow rental of copyright works, developing countries had ensured that plants and animals could be excluded from patentability, developing countries were allowed singificant transitional periods of five years for pharmaceutical, agricultural and chemical products. In United States, pharmaceutical industry increasingly critical of the Dunkel Draft on grounds that developing countries were being allowed too long a transitional period to implement patents laws in accordance with the TRIPs Agreement. India remained sufficiently concerned about the likely implications of the TRIPs Agreement to abstain from giving a position on the Dunkel Draft.

[40] Duncan Matthews, *Globalising Inellectual Property Rights: The TRIPs Agreement,* (London and New York: Routledge, 2002) at p. 40.

[41] Ibid, The other area of differences includes US and Japan on rental rights for copyright works, Between EC and US on French video levies for the movie industry.

[42] Annex III, Draft Final Act Embodying the Results of the Uruguay Round of Multilateral Trade Negotiations, MTN.TNC/W/FA dated 20 December 1991.

Uruguay Round in Marrakesh on 12-15 April 1994.[43] All substantive provisions of the Paris[44] and Berne Conventions,[45] with the exception of moral rights were incorporated in the TRIPs Agreement. To this concern, the Agreement included the concerns of the national delegations of their particular issues viz, EC concern over GIs.[46]

Articles 22–24 of this draft were essentially the same as the final text of Articles 22–24 of TRIPS. The only substantive difference was the more limited scope of the continued and similar use exception under Article 24.4 of the Dunkel Draft: while the latter referred only to GIs identifying wines, TRIPS extended this exemption to spirits.

2.6: *GIs: Legal Framework under TRIPs Agreement*

The adoption of the Agreement on TRIPs in the GATT, 1994 has raised the level of protection of GIs, a recently recognized form of IPR,[47] to a multilateral level for all WTO members with the support of most of the developed economies, including the US, Japan, the E.U., and Switzerland.[48] The Agreement

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[43] Michael Blakeney, "The Impact of the TRIPs Agreement in the Asia Pacific Region", *European Intellectual Property Review,* vol. 6 (1996), pp.544-554 at p.545-6.

[44] Paris Convention for the Protection of Industrial Property, 20 March 1883, revised in 14 July 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305, available at www.wipo.int/clea/docs/en/wo/wo020en.htm.

[45] Berne Convention for the Protection of Literary and Artistic Works, 24 July 1971, 828 *U.N.T.S* 221 (originally signed at Berne on 9 September 1886).

[46] The concern of US is on rental rights for movies and compact discs. With the inclusion of limited exceptions and transitional periods to appease developing countries, the negotiators of the TRIPs Agreement then added the crucial enforcement and dispute settlement procedures that had been so absent from the earlier WIPO conventions.

[47] Doris Estelle Long, "Book Review: Recent Books on International Law", *American Journal of International Law,* vol. 96 (2002), pp.757-759 at 757. Here the author says, traditionally, IP at the international level has five acknowledged forms-patents, copyrights, trademarks, trade secrets, and industrial designs-that have served as the focus for both domestic and international protection regimes. These forms also generally subsume, at least in part, many of the newer types of IP protection, including geographic indications and (potentially) traditional knowledge and cultural expressions (at least in certain forms).

[48] Leigh Ann Lindquist, "Champagne or Champagne? An Examination of U.S. Failure to Comply with the Geographical Provisions of the TRIPs Agreement", *Georgia Journal of International and Comparative Law,* vol. 27 (1999), pp.309 at 334-335, (indicating those countries that supported the worldwide extension of a protective IPRs regime during the Uruguay Round of WTO talks).

ended by proposing that TRIPs should encompass the protection of GIs[49] by several Members. Since the Uruguay Round, the "New World" Wine producers[50] have opposed the "Old World" Wine producers[51] efforts to extend TRIPs to encompass robust protections for GIs. While there are multinational IP treaties such as Paris Convention,[52] Madrid Agreement,[53] and Lisbon Agreement,[54] but none has attempted to achieve the abovementioned goal. The Preamble of TRIPs clearly recognizes IPs as private rights and territorial in nature.

GIs are subject to the same general principles applicable to all categories of IPRs included in the Agreement, primarily the basic provisions and fundamental principles such as 'minimum standards',[55] the 'national treatment',[56]

[49] Christine Haight Farley, "Conflicts Between U.S. Law and International Treaties Concerning Geographical Indications", *Whittier Law Review,* vol. 22 (2000), p. 73.

[50] Jane Bullbrook, "Geographical Indications within GATT", *The Journal of World Intellectual Property,* vol. 17 (2004), pp. 501-522 at p. 508. According to this author, New World producers are U.S., Argentina, Australia, Canada, Chile, New Zealand, South Africa and Uruguay.

[51] Ibid, (Old Wine Producers are France, Germany, Italy, Spain, Portugal and Austria are the foremost among the old wine producers).

[52] n. 40.

[53] The Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods, 14 April 1891, 828 U.N.T.S. 389, available at http://clea.wipo.int.clea/lpext.dl1?=templates&fn=main-hit-h.htm&2.0.

[54] Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration, 31 October 1958, available at www.wipo.int/treaties/documents/english/word/j-lisbon.doc.

[55] Article 1 of the TRIPs Agreement provides, "Members shall give effect to the provisions of this Agreement. Membes may, but shall not be obligated to implement in their domestic law more extensive protectio than is required by this Agreement". See generally, J.H.Reichman, "Universal Minimum Standards of Intellectual Property Protection under the TRIPs Agreement", *The International Lawyer*, vol. 29 (1995), pp. 345-388.

[56] According to Article 3, "Each Member shall accord to the nationals of other Members treatment no less favourable than that it accords to its own nationals with regard to the protection...". See generally Gail E. Evans, "The Principles of National Treatment and the International Protection of Industrial Property", *European Intellectual Property Review,* vol.3 (1996), pp. 149-160. In the United States-Section 211 Omnibus Appropriations Act of 1998, Report of the Panel, 6 August 2001, WTO, WT/DS/176/AB/R, Para. 4; Report of the Appellate Body, 2 January 2002; WTO, WT/DS176/AB/R, para.233, the Appellate Body in its decision involving a dispute under TRIPs, an Act of Congress-the Omnibus Appropriations Act of 1998-was held to violate both the national treatment and MFN obligations of TRIPs. The Act, it was found, diminished the rights in the US of owners of trademarks that previously belonged to Cuban nationals that were expropriated during the Cuban revolution. U.S.-Omnibus Act targeted the trademark "Havana Club" used in the sale of rum. This resulted in prohibiting a Cuban-French joint Venture from securing the rights to the mark. After enactment, the EU filed the consultation, alleging breach of national treatment and MFN clauses in TRIPs. In interpreting the national treatment obligations, the decision of the Appellate Body in this case held in favour of the EU. It was found that if non-nationals face even

and the 'most favoured nation clause'.[57] Section 3 of Part II of the Agreement which deals with GIs in particular consists of three articles. Article 22 provides general protection for all GIs. Article 23 sets forth "Additional Protection for GIs for Wines and Spirits", and Article 24 concerns exceptions to the requirements of the above two articles and sets forth commitments to a process of international negotiation regarding protection of GIs. These Articles set forth the Minimum Standards and common protection for GIs for all products.

2.6.1: ***Definition of GIs:***

The definition of GIs is provided under Article 22.1 of the 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".

This definition indicates four possible broad elements to the definition and it has discussed below,

2.6.1. i: ***Element of 'good'***

The definition of GIs is limited to a "good", indicating that the negotiators rejected the proposal that 'services' also be attributed to territories. This does not preclude the possibility that Members may under national law allow claims for unfair competition based on misleading attribution of the source of services, but such protection is not required by this section of TRIPS. While the reference to a "good" is limiting in the sense of excluding services, it is broad in the sense of applying to all goods for which an appropriate geographical link is made. All

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a small possibility of a multiphase procedure and nationals ace a single phase procedure, this treatment places non-nationals in an inherently less-favourable situation, thus constitution of the national treatment provison of TRIPs.

[57] *See*, Article 4 of the TRIPs Agreement, "With regard to the protection of intellectual property, any advantage, favour, privilege or immunity granted by a Member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other members...". See generally on MFN Clause, Espiell, "The Most-Favoured Nation Clause: Its Present Significance in GATT, *Journal of World Trade Law,* vol. 5 (1971), p. 29; Rubin, "Most-Favoured-Nation Treatment and the Multilateral Trade Negotiations: A Quiet Revolution", *International Trade Law Journal,* vol. 6 (1981), p. 221.

agricultural products, for example, and not only wines and spirits as more specifically addressed in Article 23, are potentially the subject of GIs. According to Conrad, this restrictive element is appears to be contrary to the general concept of TRIPs.[58]

2.6.1. ii: ***Element of 'originating'***

The GIs identifies a good "originating" in the territory of a Member. This means that the good must be mined, grown or manufactured in that territory. As a consequence, there is no possibility of assigning the right to affix a GI to a party outside that territory. It is pertinent to note that there should be some flexibility in the term "originating". Some portion of the work involved in creating a good might take place outside the territory without undermining its "originating" character. The permissible extent of such outside work is a question common to the area of rules of origin elsewhere in GATT-WTO law. As the law applicable to GIs is unsettled, there may also be disputes regarding the extent of the flexibility as to the permissibility outside the work.

2.6.1. iii: ***Element of 'quality', 'reputation', and 'other characteristic'***

The definition in Article 22.1 refers to "a given quality, reputation or other characteristic of the good ... essentially attributable to its geographical origin". The notion of "quality" would encompass physical characteristics of the good, that is, attributes of the good that can be objectively measured. By separate reference to "reputation", however, the definition makes clear that identification of a particular objective attribute of a good is not a prerequisite to conferring protection. It is enough that the public associates a good with a territory because the public believes the good to have desirable characteristics, *i.e.*, that the good enjoys a "reputation" linked to the identifier of the place.

Article 22.1 refers to "other characteristic" of the good. If quality is commonly understood as implying a positive attribute, and reputation is commonly understood to imply a favourable impression, the term "other characteristic" may imply that a good may have an attribute such as colour, texture or fragrance that might be considered more neutral or even unfavourable in

[58] Albrecht Conrad, "The Protection of Geographical Indications in the TRIPS Agreement", *Trademark Reporter*, vol. 86 (1996), pp. 11-46 at p. 33.

the perception of consumers, yet still entitle the producing territory to protect its name in respect of that good. The quality, etc., must be "essentially attributable" to the geographic territory. This term or phrase is intended to establish the "link" between the product and the relevant territory. In large measure, the question whether product characteristics or reputation are attributable to a territory is at the root of debate concerning the potential scope of coverage for GIs.

A literal reading of "territory" would suggest that the link must be physical, that is, that the product must embody certain characteristics because of the soil conditions, weather or other physical elements in a place. This might be demonstrable, for example, in respect to wines the grapes for which are harvested in certain locations. However, because the notion of "essentially attributable" to geographic territory is extended by other terms in the Article 22.1 definition to refer to reputation, this implies that the link to territory may be based on human labour in the place. It might even extend to goodwill created by advertisement in respect to the place, although such an interpretation might at some point strain the definition of "attributable" which appears to require that the characteristic or reputation be inherent in the place, and not be solely the figment of a product marketer's imagination. This is not to suggest that national authorities in each WTO Member must adopt a broad reading of "reputation" or "essentially attributable", but rather to suggest that the language has some inherent flexibility.

2.6.1. iv: ***Element of 'indication'***

According to the TRIPs agreement a GIs to be protected as such, needs just to be 'an indication' but not necessarily the name of a geographical place on earth. Article 22.1 does not specify possible indications, thus allowing for words/phrases, iconic symbols and emblems, scripts and pictorial images etc. For example, iconic symbols like the Pyramids for Egyptain goods, or the Tajmahal for Indian goods, or the Statue of Liberty for American goods are permissible. It is essential that the 'indication' must evoke the terrritory from which the goods 'originate'. In this respect, there is no requirement for the indication to be a direct geographical name, permitting indications that are not geographical terms. Secondly, the good must necessarily possess 'given quality', a 'reputation' or 'other characteristics'. The separate reference to 'reputation' allows for the possibility of reputable goods that may not have a particular quality characteristic

or other characteristic attributable to their geographic origin. Conceivably, this allows public perceptions and expectations related to the good and its geographic origin to bear on the conditions for grant of protection. Thirdly, it is necessary that indication of quality-GI be linked together. This is clear from the dual requirements that 'indications' identify a good as originating in the territory' and that quality is 'essentially attributable to its geographic origin'.[59] Moreover, Article 22.1 applies to all kinds of goods and is not delimited to particular kind of goods.

According to Gervais,[60] given its ground breaking nature, this section of the Agreement begins with a definition of what consititutes a GI.

This should be welcomed because definitions are crucial to distinguish GIs from the notion of 'indications of source'[61] and 'appellations of origin'.[62]

2.6.2: ***Difference between 'Appellations of Origin' and 'Indications of Source'***

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[59] Dwijen Rangnekar, "Demanding Stronger Protection for GIs: The Relationship between Local Knowledge, Information and Reputation", UNU/INTECH, Discussion Paper Series-11, April 2004, pp. 1-42 at p. 10.

[60] Gervais, n. 3, p. 76.

[61] n. 53, Article 1(1) of the Madrid Agreement defines indications of source as, "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".

[62] n. 54, Article 2(1) of the Lisbon Agreement defines Appellations of Origin as "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; *See* generally on Appellations of Origin in WIPO Worldwide Symposium on Geographical Indications, Protection of Geographical Indications: Appellations of Origin, WIPO/GEO/SFO/03/7, 3 July 2003, available at: http://wipo.org/meetings/2003/geo-ind/en/index.html; L. Bendekgey and C.H. Mead, "International Protection of Appellations of Origin and Other Geographic Indications", *Trademark Reporter,* vol. 82 (1992), pp. 765-774; Lori E. simon, "Appellations of Origin: The Continuing Controversy, *North Western Journal of International Law and Business,* vol. 5 (1983), p. 132; Bryan Harris, "Appellations of Origin and Other Geographical Indications used in Trade", *European Intellectual Property Review,* (1979), p.205; Elizabeth Barham, "Translating Terroir: The Global Challenge of French AOC Labelling", *Journal of Rural Studies,* vol. 19 (2003), pp. 127-138, available at www.elsevier.com/locate/jrurstud; J. Chen, "A Sober Second Look at Appellations of Origin: How the U.S. will Crash France's Wine and Cheese Party", *Minnesota Journal of Global Trade,* vol. 5 (1996), p. 29; Vincent E. O'Brien, "Appellations of Origin and Brands of Geographical Significance: A Conflict with Potentially Serious Commerical Implications", *International Wine Association Bulletin,* vol. 23 (2000), p. 34; OECD, Appellations of Origin and Geographical Indications in OECD Member Countries: Economic and Legal Implications, Working Party on Agricultural Policies and Markets of the Committee for Agriculture Jouint Working Party of the Committee on Agriculture and the Trade Commission, COM/AGR/APM/TD/WP (2000) 15/FINAL.

Considering the close relationship between an 'indication of source', an 'appellation of origin' and GI, the most generic, simple and broadest concept corresponds to 'indication of source' which refers to the designations of any country or place situated therein, from where the product originated. This concept does not require that the product have a certain quality not a reputation or characteristic linked to its geographical origin. 'indication of source' includes both GI and appellations of origin.

'Appellation of Origin' is the most specific concept. In this case the expression identifying the appellation of origin should necessarily correspond to the name of a country, region or locality. This name permits the designation of a product whose quality and characteristics are given exclusively or essentially by its geographical origin, including natural and human factors. This means that the product and the geographical name should be the same, such as Bordeaux, Porto or Jerez. The quality or characteristics of the product should be exclusively due to its geographical environment, including natural and human factors. Hence all 'appellation of origin' are also GIs, but not vice versa.

2.6.3: *GIs Protection: Territorial Approach*

Article 22(2) obliges WTO Members to provide 'legal means' for interested parties to prevent (a) the use of any means (not limited to a name) in the designation or presentation of a good that could mislead the public into believing that the good in question originated in a geographical area other than the true place of origin, or (b) any use which constitutes an act of unfair competition within the meaning of Article 10*bis* of the Paris Convention. The first situation is found in Article 22(2) (a) which requires members to provide legal protection against the use of GIs mislead the public as to the geographical origin of the goods. Take for example, the use of symbols such as the Eiffel Tower or the Statue of Liberty to infer an association with France or the United States, or the use of a language or script to evoke an erroneous connotation of origin would fall

within this prohibition.[63] But, the Agreement does not specify the legal means to protect GIs. It is left to Members to decide what those means should be.[64]

2.6.4: *Links to Unfair Competition*

The second situation is found in Article 22(2) (b) which requires members to provide legal protection against the use of GIs where such use constitutes an act of Unfair Competition within the meaning of Article 10*bis*[65] of the Paris Convention. So, according to this article, the scope of protection is composed of two components:

a) protection against the use of indications that mislead the public or is deceptive;

b) Protection against the use of indications in a manner that amounts to unfair competition;

The essence of this Article reveals that unless a GI is protected in the country of its origin there is no obligation under this Agreement for other countries to extend reciprocal protection. Moreover, this Article is designed to protect the rights of traders to use GIs; it would appear that the producers, manufacturers and importers of goods bearing the GIs which identify the geographic origin of the goods are interested parties.[66]

2.7: *Trademarks, GIs and TRIPs: Interrelationships*

The use of Trademarks possibly dates back to the last millennium when craftsmen in India, China and ancient Rome used special marks to distinguish

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[63] Michael Blakeney, "Proposals for the International Regulation of Geographical Indications", *The Journal of World Intellectual Property*, vol.4 (2001), pp.629-652 at 641.

[64] See the Annex A to the WTO Note from the Secreteriat, JOB (00)/5619, pp. 71-78.

[65] n. 40, Paris Convention, Article 10*bis* (2) defining unfair competition as anything contrary to 'honest practices'.

[66] Peydro-Aznar J., 'The TRIPS Agreement: A Basis for Discussion', paper presented at the WIPO/EC/ASEAN National Seminar on the Agreement on Trade-Related Aspects of Intellectual Property and its Implications for Business Enterprises organised jointly by the Division of Business Administration, Faculty of Economics and Administration, University of Malaya and the World Intellectual Property Organization, Kuala Lumpur, 27-28 July 1995.

their products[67]. Trademarks have been protected throughout the world on fairly similar standards for more than a century. Trademarks are well established and recognized as key assets of brand owners in an industrialised society. When it comes to the protection of trademarks under the TRIPs Agreement, it is much less revolutionary than with regard to the protection of GIs.[68] The scope of trademark has explained is Section 16 of the TRIPs Agreement.[69] The interrelationship between the protection of trademarks and GIs[70] is accomodated by Article 22.3 of the TRIPs Agreement which permits a Member, *ex officio* if its legislation so permits or at the request of an interested party, 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, if the 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".*

and Article 23.2 reiterates the same principle in the case of wines and spirits. [71]

[67] M.B. Rao, Manjula Guru, *Understanding TRIPs: Managing Knowledge in Developing Countries* (New Delhi: Response Books, A Division of Sage Publications India Pvt. Ltd., 2003), p. 105.

[68] Neverethless, the TRIPs Agreement significantly expanded international trademark protection by covering service marks and well known marks and providing for requirements for member countries to provide both border enforcement and criminal sanctions against trademark counterfeiting, see, Jim Keon in Carlos M. Correa and Abdulqawi A. Yusuf, *Intellectual Property and International Trade, The TRIPs Agreement* (The Hague: Kluwer Law International, 1998) at p. 178.

[69] Article 16 (1) reads as follows: "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 confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use".

[70] See generally, on the history and relationship of trademarks and GIs, S.A. Diamond, "The Historical Development of Trademarks", *Trademark Reporter,* vol. 73 (1983), p. 22; J. McCarthy and V.C. Devitt, "Protection of Geographical Denominations: Domestic and International", *Trademark Reporter,* vol. 69 (1979), p.199, Coerper, "The Protection of Geographical Indications in the United States of America, with Particular Reference to Certification Marks, *Industrial Property,* July/August (1990), p. 232; F.I. Schechter, *The Historical Foundations of the Law Relating to Trade-Marks,* (Cambridge: Harvard University Press, 1925); Daniel R. Bereskin, "A Comparison of the Trademark Provisions of NAFTA and TRIPs", *Trademark Reporter,* vol. 83 (1993), p. 11-13.

[71] Article 23 (2) of the Agreement reads as follows: 'the registration of a trademark for wines 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'.

2.7.1: ***GIs and Trademarks: Areas of Convergence***

Trademarks are signs or a combination of signs, such as words, numerals, figurative elements, etc., capable of distinguishing goods or services of one undertaking from those of the others[72]. There is a single person whether legal or natural entitled to use the trademark. All producers belonging to the region or locality where the GI comes from are entitled to use it. This leads to the general proposition that GIs are excluded from the domain of trademarks.[73] Yet, there are many conceivable and real instances where a trademark consists of or contains a GI. For example, the use of 'Antartica' as a trademark for bananas is considered permissible as there is no deceptive element in terms of implying geographical origin.[74] Moreover, trademarks can consist of GIs in other circumstances, such as when the trademark is considered distinctive and the use of a GI is accepted as entirely fanciful. Examples include 'Mont blanc' for high quality writing equipment and 'Thames' for stationery.[75]

Individual production of goods are more linked to the notion of trademark; while collective production of products coming from the same geographical zone, and having the same quality, reputation or characteristic attributable to its geographical origin, are more linked to the notion of GIs. Trademarks are probably easier to protect internationally than GIs, but it requires an active role of the owner. Normally a trademark is protected because of its registration with the competent domestic authority. As a general rule, trademarks that consist of or

[72] Article 15(1) of the TRIPs Agreement.

[73] Michael Blakeney, "Geographical Indications and TRIPS" Occasional Paper no.8. Quaker United Nations Office, Geneva, 2001 at p. 12 available at http://www.geneva.quno.info/pdf/op8blakeney.pdf

[74] WIPO-International Bureau, Geographical Indications: Historical Background, nature of rights, existing systems for protection and obtaining effective protection in other countries. Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, 6th Session, March 12-16. SCT/6/3, Para. 103.

[75] Harte-Bavendamm, Geographical Indications and Trademarks: Harmony or Conflict? In WIPO Symposium on the International Protection of Geographical Indications, 2000; W. Taylor, "The Overlap Between Trademarks and Geographical Indications", *International Wine Law Association Bulletin,* vol. 5 (1999), p.5, available at http://www/aidv.org/bulletin/bull31_04-2003.htm; Daniel Hangard, Protection of Trademarks and Geographical Indications in France and in the European Union, in WIPO Symposium on the International Protection of Geographical Indications, Melbourne, 5-6 April, 1995.

contain a GI cannot be protected if the use of such trademark would mislead the public as to the true origin of the product. Normally, national laws exclude geographical terms from registration as a trademark, because it must not be descriptive or deceptive.

2.7.2: *Trademark and GIs: Areas of Conflict*

The TRIPs Agreement is the first multilateral Agreement on IPRs' dealing with GIs and Trademarks at the same time. The overlap between the two domains of IPRs is real and imminent. The disciplines in the TRIPs Agreement provide, at best a 'delicately balanced solution', or at worst an unclear and yet to be negotiated relationship.[76] The genesis of the conflict between GIs and trademark lies in Article 24(5)[77] and Article 16 of the TRIPs Agreement. An analysis of the provisions reveals that in order to seek protection of trademark, the following conditions must be satisfied: a) the trademark must be identical or similar to the GIs; b) trademark has been used in 'good faith'; and c) it has been used either: (i) before the date of application of the relevant TRIPs provision in that member; or (ii) before the GIs is protected in its country of origin. The close perusal of both provisions reveals that while Article 24(5) seeks to protect the then existing trademarks and thereby makes an exception Article 16 is absolute.

The possibilities of conflict area in between the two areas are would be: a) whether GIs protected in a country oı origin would debar registration of identical trademark in any other member country, b) the exception clause under Article 24 (5) raises some basic issues like,

1) what is meant by 'good faith'?;

2) who will determine 'good faith'?;

3) Is registration of GIs necessary for getting the protection?;

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[76] WIPO-International Bureau, Possible Solutions for Conflicts between Trademarks and Geographical Indications and for Conflicts between Homonymous Geographical Indications. Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, 5th Session, September 11-15. SCT/5/3.

[77] Article 24(5) provides that implementation of the protection of GIs pursuant to the TRIPs agreement shall not prejudice the eligibility or the validity of the registration or the right to use a trademark which is identical with or similar to a geographical indication of the trademark which has been used in good faith either: (i) before the date of the application of the relevant TRIPS provisions in that member; or (ii) before the GIs is protected in its country of origin.

4) Can unregistered trademarks claim protection?;

5) what amount of proof would be sufficient to get exemptions under Article 24(3); and

6) can the member country enter into an agreement in respect to protection of trademark where it comes in conflict with GIs.[78]

2.7.3: *Proposals on Harmonizing the Conflict Areas*

Wide divergence of opinion and legislation exist on this issue and the approaches are also different.

The EC pursued the concept of GI protection assuming a certain element of superiority of GIs over Trademarks. Historically, it may be noted that in the early 20th century there existed disputes over the Champagne appellations of origin as well as the concept of the public or common goods versus private property.[79] According to the EC, trademark should be abolished which contains wording that is identical to a geographical name used to describe a table wine.[80] The EC regulation 1493/1999 on the common organisation of the market in wine provides for example for the discontinuation designation is later on protected as a GI for wine.[81] The latest EC regulation 2081/92 is based on the concept of coexistence between a Trademark and a later GI (but not vice versa).[82]

The United States believes that "first-in-time, first-in-right" principle should be applied to conflicts between trademarks and GIs.[83]

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[78] Rangnekar points out there are unanswered questions on the relationship between Trademarks and GIs, they are 1. In what circumstances will a GI take precedence over a trademark, and vice versa? And 2. Can there be instances where trademarks and GIs overlap and coexist?.in Dwijen Rangnekar, Geographical Indications: A Review of the Proposals of the TRIPs Council-Draft, at p. 22.

[79] Burkhart Goebel, Geographical Indications and Trademarks: The Road from Doha, in WIPO Symposium on the International Protection of Geographical Indications, San Francisco, California, 9-11 July 2003, WIPO/GEO/SFO/03/11 at p.8.

[80] Wine Resolution-Recital 12-Council Regulation (EC) No. 2393/89 of July 24, 1989: General Rules for the Description and Presentation of Wines and Grapes Musts.

[81] Article 47 (1) and (2) (e) Para. H of EC Regulation 1493/1999.

[82] Article 14(2) and 13(4) (5) of EC Regulation 2081/92.

[83] The U.S. led proposal suggests that the protection system of GIs through the trademarks system is perfectly compatible with TRIPs, thus fulfilling all the prescriptions of Part II, Section 3 of the TRIPs Agreement, See WTO Council for TRIPs, Suggested method for Domestic Recognition of GIs for WTO members to produce a List of Nationally-protected Geographical Indications for

The International Association for the Protection of Intellectual Property[84] (AIPPI) suggests that when conflict arises between a trademark and GIs, a) the trademark office should *ex officio* refuse the registration of the mark; b) third parties may, i) oppose the application to register as a mark, and ii) bring proceedings for cancellation of the registration of the mark and for prohibition of use thereof, c) any national or regional legislation relating to GIs should include provisions for the resolution of conflicts between GIs and trademarks in accordance with the following principles:

i) such legislations should take into account existing bilateral and multilateral agreements,

ii) Interested parties must have the opportunity to intervene directly in any proceedings, which may affect their intellectual property rights,

iii) If a question arises as to the validity of a mark, such question should be decided only by the competent courts or authorities according to the national or regional laws relating to marks.

The WIPO Standing Committee[85] while dealing with the conflict between trademark and GIs observed that, "a GI is best protected under trademark and unfair competition law. Trademarks having acquired good faith to be protected against conflicting GIs".

2.6: *Article 23- Additional Protection of GIs for Wines and Spirits*

Article 23 of the Agreement provides for higher protection for Wines and Spirits. In addition to that, the general protection for wines and spirits a stronger protection regime has been conferred under Article 23(1) of the Agreement.

WTO Members to produce a List of Nationally-protected Geographical Indications; IP/C/W/134 dated 11 March 1999; see also, Eleanor Meltzer, "Geographical Indications: Point of View of Governments, Address Before the Worldwide Symposium on Geographical Indications, San Francisco, California, July 9-11, 2003, (outlining the U.S. position that the trademark regime can protect GIs and the shortcomings of the EC approach). For critical analysis of this 'First in Time, First in Right', principle, *See*, Stephen Stern, Geographical Indications and Trademarks: Conflicts and Possible Resolutions, in WIPO Symposium on Geographical Indications, San Francisco, California, 9-11 July, 2003, WIPO/GEO/SFO/03/13.

[84] In regard to the relationship between GIs and Trademarks, the INTA adopted a resolution in 1997 supporting the 'First in Time, First in Right'. INTA, *Request for Action by the INTA Board of Directors, Protection of Geographical Indications and Trademarks*, 24 September 1997 (available at http://www.inta.org/policy/res_geoindtms.html).

[85] Draft Report of the International Bureau of WIPO, Geneva, 13-17 July 1998 at p.2.

Article 23(1) states that each member shall 'prevent use of a GI identifying wines (or spirits that do not originate) in the place indicated by the GI in question....". Members are to abide by this standard 'even where the true origin of the goods is indicated or the GI is used in translation or accompanied by expressions such as 'kind', 'style', 'imitation', or the like'. This standard is strict because it protects GIs even when there is no danger of the public being misled. For example, 'California Chablis' or 'California-style Chablis' are truthful statements, meaning that this Chablis, which Americans considers to be a generic type[86] of wine, originated in California. However, the issue is whether the use of the term 'chablis' is misleading with regard to origin. The US would not think that the statement is misleading, because 'Chablis' has become a generic term and including 'California' in the name clears up any misconception of origin. The EU would disagree, because it considers Chablis to be a GI since the product was derived from Chablis, France, a geographic region with certain special qualities and reputation.

This additional protection clause has two components: first, protection of each GI for wines in the case of homonymous indications,[87] i.e., indications that are either spelt or pronounced alike and used to designate the geographical origin of goods stemming from different countries. A well known case is that of 'Rioja', which is the name of a region in Spain and in Argentina and used as an indication for wine produced in both countries.[88] Honest use of the indication by producers in each of the different countries is envisioned. Article 23.3 has accorded the protection for each GI for Wines and also for homonymous indications. But there is no specific definition for homonymous indications in the TRIPs Agreement. The real problem of homonymous indications is when it comes in to the market

[86] *See* generally on generic terms, Brendan Brown, "Generic Term or Appellation of Origin?- Champagne in New Zealand", *European Intellectual Property Review,* vol. 14, pp. 176-180; Brody M. Peter, "Semi-Generic", Geographical Wine Designations: Did Congress Trip over TRIPS?" *Trademark Reporter*, vol. 89 (1999), pp. 979-985.

[87] Article 23 (3) of the TRIPs Agreement provides as follows: obliges each Member to 'determine the practical conditions under which the homonymous indications in question will be differentiated from each other', while ensuring equitable treatment of producers and that consumers are not mislead.

[88] WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, Possibile Solutions for Conflicts between Trademarks and Geographical Indications and for Conflicts between Homonymous Geographical Indications, WIPO Doc. SCT/5/3, 8 June 2000.

for use and in respect to similar or identical products. As a general rule, there is no specific provision under the TRIPS Agreement. Moreover, the obligation to protect homonymous GIs has been only provided for wines and not for other products.[89] Secondly, the establishment of a multilateral system of notification and registration of GIs for wines, in which the Member States would be eligible for the protection under those who joined in the multilateral system.

2.8.1: *Additional Protection for Products other than Wines and Spirits: Some Fundamental Issues*

One of the important areas of debate over GIs is the expansion of Article 23 and extending protection for products other than wines and spirits. Presently, TRIPs provides two levels of protection for the same IPR. Article 22's base level of protection is limited to cases where the public is misled as to the true geographic origin of a product or where GI use constitutes an act of unfair competition. Article 23 enhances the level of protection for wines and spirits beyond what is provided in Article 22. The 'misleading test' as applied to Article 22 is a burden some requirement tailored to suit laws for protection against unfair competition or protection of consumers. It does not mean that existing protection alone would apply to the extent needed to prevent "misleading public" because it results in wide legal uncertainty. Differential treatment of GIs under Article 23 can be explained as a product of negotiations of the Uruguay Round. The relevant provisions are the result of trade-offs specific to circumstances prevailing at the time of the negotiations, particularly during the Brussels Ministerial Conference in 1990. This was, to some extent, due to the link at that time between negotiations on GIs and Agriculture.[90]

The economic and political significance of GIs grows as increasing quality awareness and requirements increase demand for exported goods along with a demand for products of a specific geographical origin. The added value of exported goods increases chances for legitimate goods to reach the market, which

[89] Article 23 (4) of the TRIPs Agreement provides, "inorder to facilitate the protection of GIs 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.

[90] WTO, Understanding the WTO: Developing Countries. Some Issues Raised, (availale at http://www.wto.org/english/thewto_e/whatis_e/tif_e/dev4_e.htm).

is part of the global vision for a multilateral trading system. Hence, since the end of the Uruguay Round, the awareness of the need for additional protection for products other than wines and spirits has continuously increased and spread among WTO Members. Extension of Article 23 level protection would provide an adequate level of protection of GIs for all products, facilitating product identification by the consumer and, therefore, enhancing consumer choice.[91]

While consider to extend the GI protection, it is imperative to emphasize the proposal presented by the sponsors of additional protection for products other than wines and spirits. There are two main proposals setting out the negotiations that at best can be described as the positions from the 'new world' and 'old world' economies. The importance of GIs is most strongly held in Europe, where so many traditions involving the production of food stuffs, spirits and wine, began centuries ago. Those traditions migrated from the old world to the new, so that today, many produt names no longer serve as GIs.

Especially after 19 June 2002, the communication from a group of developing countries confirmed the call for extension of additional protection in the TRIPs council.[92] However, many developed countries have strongly opposed extension, partly because they believe there is no evidence to support the argued inadequacy of the protection currently available for products other than wines and spirits.[93] This debate has now been put before the TRIPs council and after the Doha round,[94] it has gained momentum. Adding to this argument, the International Chamber of Commerce (ICC) warns against a rush into an extension of Article 23 and opines that the implications of an extension of Article 23 type

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[91] Michael Maher, "On Vino Veritas? Clarifying the Use of Geographic References on American Wine Labels", *California Law Review*, vol. 89 (2001), p. 1881 quoted in Jose Manuel Cortes Martin, "TRIPS Agreement: Towards a Better Protection for Geographical Indications?", *Brooklyn Journal of International Law*, vol. 30 (2004), pp. 117-184 at p. 167.

[92] WTO, IP/C/W/353 of 24 June 2002.

[93] WTO, IP/C/W/386 of 8 November 2002.

[94] Para 18 of Doha Declaration reads that, "with a view to completing the works started in the Council for Trade Related Aspects of Intellectual Property Rights (Council for TRIPs) under the implementation of Article 23.4 agreed to negotiate the establishment of a multilateral system of notification and registration of GIs for wines and spirits by the 5th Session of the Ministerial Conference. We note that issues related to the extension of the protection of GIs provided for in Article 23 to products other than wines and spirtis will be addressed in the Council for TRIPs pursuant to para 12 of this Declaration", in WTO, WT/MIN (01)/DEC/1 dated 20 November 2001.

protection to products other than wines and spirits still will have to be studied carefully.[95]

2.9: *Multilateral System of the Notification and Registration of GIs*

The establishment of a system of notification and registration of GIs is the most pressing issue, since the WTO Member States undertook in Doha to reach an agreement on this issue by September 2003. This agenda item already forms part of the 'built-in agenda' of Article 23 (4) of TRIPs.[96] It is already clear at this point of time that the Member States are not likely to set-up a different notification and registration system of GIs for products other than wines and spirits in the future. It is fair to expect that the system will be expanded to products other than wines and spirits either through the expansion of Article 23 protection to such products or by opening the system for such products without enhancing the scope of protection at the same time. This has been communicated by the EC and a couple of other WTO Member states in Para. 32 of their communication of 19 June 2002:

> *"The multilateral system of notification and registration of GIs will contribute to the implementation of a more effective protection generally for GIs. A coherent approach to the protection of the GIs would suggest that the system be open to all GIs alike".*[97]

The system is therefore likely to have an impact far beyond the wine and spirits industries. At an early point, the negotiations focussed on two fundamentally different proposals of the system, one favoured by the United States, Cananda, Chile and Japan[98] and the other one favoured by the EC, their Member States and a number of other WTO Member States.[99] Hong Kong has

[95] International Chamber of Commerce, ICC Doc. No. 450.967 of 25 June 2003.

[96] n. 85.

[97] Communication from EC and other WTO Member States, IP/C/W/353. dated 24 June 2002.

[98] Communication from 11 March 1999, WTO, IP/C/W 133 and 26 July 1999 IP/C/W/353.

[99] WTO, IP/C/W 107/Rev.1 dated 22 June 2000.

submitted a separate proposal, [100] the INTA has outlined the concept of a system[101] and the Chairman of the Negotiating Committee has also outlined his opinion on the likely key elements of a system.[102]

2.9.1: *United States Proposal (Voluntary Registration System)*

The Joint proposal from the U.S., Canada and other countries[103] for a voluntary system of recognition, suggests that a "list" of GIs be outlined and protected for those WTO countries that choose to list their GIs on the Register. Thus, there would be no legal obligation beyond what already exist in TRIPS; it would be a voluntary system providing recognition of GIs.

The proposal also suggests that the WTO Members electing to participate in the process would submit to the Secreteriat a list of the GIs recognized under the Member's domestic legislation. The WTO Members participating would then commit to consult the Register, among other resources, when making decisions regarding the recognition and protection of the GIs in the application of their national laws and regulations. The commitment to "consult" is a key where the Register would not be binding upon the Members. Non-WTO Members would also be encouraged to cosult the Register when making their decisions on the recognition and protection sought by the GI owner. This proposal is made in light of the Pre-Doha Round where the above TRIPs provisions set out the obligation on Members to recognize GIs as a form of IP and to provide the legal means to prevent the improper or misleading use of a GI. It does not stipulate how the Member is to meet this obligation and allows the Member to apply its national legislation for the improper or misleading use, and to prevent deception.

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[100] WTO, TN/IP/W/8 dated 23 April 2003.

[101] International Trademark Association, Establishment of a Multilateral System of Notification and the Registration of GIs for Wines and Spirits purusant to TRIPs Article 23(4), available at www.wto.org/english/forums_e/ngo_e/pospap_e.htm.

[102] Note by the Chairman, JOB(03)/75 dated 16 April2003.

[103] WTO, TN/IP/W/S, Proposal for a Multilateral System for Notfication and Registration of GIs for Wines and Spirits based on Article 23.4 of the TRIPs Agreement, and TN/IP/W/6, Multilateral System of Notification and Registration of GIs for Wines (and Spirits). The Joint Proposal is supported by Argentina, Australia, Canada, Chile, Colombia, Costa Rica, Dominican Republc, Ecuador, El Salvador, Guatemala, Honduras, Japan, Namibia, New Zealand, Philippines, Chinese Taipei and the United States.

2.9.2: *European Communities Approach*

The EC proposal[104] seeks for much stronger protection to be given to GIs. It creates a new legal obligation binding upon WTO Members and non-Members,[105] and calls for a formal registration of GIs on a multilateral level. This is needed, according to the EC, to facilitate GI protection. The Register, however, should not require Members to enact domestic legislation. The multilateral Register, it is alleged, is the right insturment to provide transparency and legal certainty facilitating international trade.

First, Members would notify GIs that identify goods as originating in their respective territories. Upon receipt of the notice, publication of the GI is made, following which an eighteen-month period for opposition commences, where any WTO Member could challenge the registration of the GI in a duly justified manner.[106] The Members involved in the GI registration and its opposition would resolve the dispute themselves; the dispute would also be noted to the Register. Suppose, any Member does not challenge the registration, the Member is obliged to provide protection to the GI. Once on the Register, there is a presumption of eligibility for protection. Thus, any Member not challenging the registration cannot refuse to protect the GI on the basis that: a). the GI does not meet the defintion set out in TRIPs Article 22.1; b). it is false as set out in TRIPs Article 22.4; or c). that it falls within the exceptions set out in TRIPs Article 24.6.

The recent Canadian Federal Court decision of *Consorzio del Prosciutto di Parma v. Maple Leaf Meats Inc. (Parma ham)*[107] will be readily used in the European Press and by the EU as a case justifying the adoption of a Multilateral Register for GIs. The Canadian owner was first in time, first in right, thus blocking Italian Producers from selling their goods in association with the GI and denying Canadians their Italian ham. Maple Lead Meats filed an application under the Canadian Trademarks Act, claiming use of the mark "Parma" in association with various meat products. The application went uncontested, and the registration was issued in 1971. Much later, the *Consorzio del Prosciutto de*

[104] n. 95.

[105] Ibid., para. II.3.

[106] Ibid., para. II.7.

[107] 2 Federal Court, (2001), p. 536; the appeal to the Federal Court of Appeal was rejected.

parma, the association of *prosciutto* producers located in Parma, Italy and founded in 1963, attempted to expunge the registration on the basis that the mark was deceptively misdescriptive and lacked distinctiveness.[108] The evidence established that Maple Leaf's national reputation was more significant than the growing international reputation of Parma ham from Italy. In light of these findings, the registration of the mark was maintained. Thus, the *Consorzio del Prosciutto di parma,* the owner of the GI in most other countries, cannot import its ham into Canada under the Parma name. The Canadian trademark registration may be seen as a barrier to trade, contrary to the intent of TRIPs. The experience learned by the Europeans is that abandonment of rights is fatal, and explains the European Agenda in advocating a Multilateral Register System.[109]

2.7.3: *Other Proposals*

Departing from the new versus old world interests, two compromise positions have been submitted by Hungary and Hong-Kong. In the submission of Hungary,[110] it generally supports the EC mode and it provides for a binding and arbitration system to settle differences, if the bilateral negotiations fail to result in a resolution. It should be noted that the EC Proposal was made without prejudice to the application of the WTO Dispute settlement Understanding (DSU). The other compromise positions have been taken by Hong Kong, China, suggests a purely voluntary notification and registration system. Specifially, any notified GI would be included in the WTO's GIs register following a brief examination merely on the formalities. The registration would result in *Prima facie* evidence of the ownership of the GI, that the GI fulfils the definition in TRIPs Article 22.1,

[108] The Trademarks Act provides that a mark is not registrable if it is deceptively misdescriptive. The Court has to decide "whether the general public in Canada would be mislead into the belief that the product with which the trademark is associated had its origin in the place of the geographic name in the trade mark. The applicatn argued that words such as Parma are geographical names, and as such, common property. The evidence, however, did not demonstrate that at the materialdate, the general public would have been mislead.

[109] Jane Bullbrook, "Geographical Indications within GATT", *The Journal of World Intellectual Property,* vol. 17 (2004), pp. 501-522 at p. 507; The United States comment on this *Parma* issue has been elaborated by PeterGumbelin, FoodFight: The E.U. says regional delicacies need international protection. But will other countries swallow the idea?, *The Economist,* 31 August 2003, available at http://www.time.com/time/europe/magazine/article/0,13005,901030908-480249-1,00.html.

[110] WTO, IP/C/W/255.

and that it is protected in its country of origin. This presumption is rebuttable, with the final say to remain with each Member. The proposal does not go as far as extending the presumptions regarding the exceptions in TRIPs Article 24, (with the exception of Article 24.9, i.e., the country of origin). Finally, Hong Kong does not see a need for the multilateral challenge procedure.

After the Cancun Ministerial Meeting,[111] it was perceived that the qualities that best describe the negotiations are a lack of dynamism and an unwillingness of some Members to advance questions established in the Built-in-Agenda.[112]

As a whole, the idea of Multilateral System has been welcomed from several quarters irrespective of its various facets. It contributes towards the facilitation of protection of GIs. At the same time it may positively affect the work of trademark offices and brand owners alike by providing searchable data of protected GIs. The trademark owner who wishes to use a certain designation in the future should be able to search possible conflicts with prior GIs. Such an exercise may be made easier through the multilateral system.[113]

The current states of these negotiations are unknown. What has resulted, however, are firm positions from the two main parties. Those tensions are also displayed in the current consultations, and are discussed in the following section.

2.10: ***GIs before WTO Dispute Settlement Body***

There are currently two consultations filed with the WTO on the specific issue of GIs. Further, two significant non-governmental groups have criticized the EU's preferential of GIs and, specifically, the violation of the national treatment and MFN principles. A review of these disputes reveals the difficulties in providing rights in GIs while trying to remain true to TRIPs.

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[111] The cancun Ministerial Meeting Conference ended on 14 September 2003, with no results, after the Chairperson Luis Ernesto Derbez concluded that, despite considerable movement in conlsulatations, Members remained entrenched, particularly on the "singapore"issues. See, Ministerial Conference, Fifth Session, Ministerial Statement, WT/MIN(03)/20 dated 23 September 2003. About the failure of the recent trade talks in Cancun, See Jeffrey Schott, Unlocking the Benefits of World Trade, *The Economist*, 1 November 2003, at 65. Notwithstanding this setback, the Ministers reaffirmed all Doha Declarations and Decisions and recommitted themselves to working to implement them fully and faithfully.

[112] Jose Manual, n.87, p. 172.

[113] Goebel, n.79, p. 985.

2.10.1: ***US Complaint against EU***

Prior to the establishment of the EU, single market were under the Maastricht Treaty, the individual country laws relating to IP protection were viewed as a barrier to trade. To accomplish the goal of a single market, the EU adopted Directives on the harmonization of Member States IP laws. The TRIPs Agreement pre-empted much of this effort, as it required all WTO Members to provide minimum protection of IPRs. Examining the EU Regulation at the centre of the two consultations, it appears that EU may not be meeting its obligations under TRIPs and the goal of reducing barriers of trade.[114] Hence, the US initially filed a consultation in June 1999,[115] and requested additional consultations[116] with the EC regarding the protection by its Regulation of GIs relating to agricultural products and food stuffs. The specific allegation against the EC is that:

> *"Regulation protects trademaks and GIs for agricultural products and foodstuffs in the European Communities, but does not offer adequate protection to US GIs and trademarks."*

The main argument involves a breach of Article 3 of TRIPs, namely lack of national treatment.

2.10.2: ***Australian Complaint***

In addition, Australia has filed its second consultation in 2003[117] pertaining to the same GI regulation. The allegation was that in the protection of

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[114] Annex 1 A to the WTO Agreement, signed on 15 April 1994, Multilateral Agreements on Trade in Goods, Agreement on Technical Barriers to Trade, , the Agreement provides details on how international trade will function. Although GATT speaks in terms that are very general, the specifics such as the nature of packaging and labelling are key elements in providing Members with an understanding of how goods can be packaged and labelled for multiple jurisdictions and that the domestic laws will not serve as an impediment to trade. Indeed, this principle is recognized by the Preamble to the TBT Agreement providing that "Standards do not create necessary obstacles to international trade"; WTO, WT/DS231/AB/R, The Appellate Body Report in the *Sardines* Dispute is a good illustration of the application of the TBT Agreement and insight as to how the WTO may rule in the alleged breach of that Agreement in the GI Regulation consultations.

[115] WTO, WT/DS/174/1.

[116] WTO, WT/DS/174/1/Add.1, April 2003.

[117] WTO, WT/DS/290/6 dated 1 May 2003.

GIs and designations of origin for agricultrual foodstuffs, the EC has violated the principles of national and MFN treatment obligations of GATT[118] and specifically:

> "The EC measure seems not to accord immediately and unconditionally to the nationals and/or products of each WTO member any advantage, favour, privilege of immunity granted to the nationals and/or like products of any other WTO Member.
>
> The EC measure seems not to accord to the nationals and/or products of each WTO member treatment no less favourable than that it accords to its own nationals and/or like products of national origin.
>
> The EC measure may diminish the legal protection of trademarks.
>
> The EC measure may not be consistent with the EC's obligation to provide the legal means for interested parties to prevent misleading use of a gi or any use that constitutes an act of unfair competition within the meaning of Article 10*bis* of the Paris Convention.
>
> The EC may not have met its transparency obligations in respect of the measure.
>
> The EC measure may be more trade-restrictive than necessary to fulfil a legitimate objective, taking account of the risks non-fulfilment would create".

[118] Ibid., Australia alleges violation of TRIPs Articles 1,2,3,4,16,20,22,24,24,41,42 and 63, and pursuant to Articles 1 and III of GATT 1994, Article 2 of the TBT Agreement. The EC may also be in breach of its obligation under Article 65 of the TRIPS Agreement to apply the provisions of the TRIPs Agreement before the expiry of a general period of its obligations under Article XVI:4 of the WTO Agreement to ensure the confirmity of its laws, regulations and administrative procedures with its obligations under the annexed agreements.

2.10.3: ***WTO Panel's Decision on GIs between U.S. and EU***

According to the Panel's ruling, released to the public on 15th March 2005, the regulation erred by requiring other WTO Members to offer levels of protection for their trademarks in Europe. While the WTO Panel found several aspects of the regulation to be WTO-inconsistent, it did not condemn the regulation as a whole but simply recommend that it be amended to correct the violations. Both sides to the dispute welcome the ruling.[119] The Panel found that the provisions of the regulation relating to the availability of GI protection and those relating to the procedures for obtaining GI protection discriminate against products originating outside the EU. As such, they violate the national treatment obligation of both TRIPs Agreement and the GATT 1994. Continuing to focus on the actual operation of the regulatin, the Panel concluded that the regulation's provision allowing the co-existence of GIs and previously registered trademarks for the same region did not violate the TRIPs Agreement. The Panel agreed with Australia and the US that TRIPs requires that trademark owners be given the right to prevent use of subsequent GIs where confusion is likely to result. The Panel noted however that TRIPs also provides that such right may be limited if the legitimate interests of the trademark owner and third parties are protected. Turning to the facts before it, the Panel pointed out that the relevant right of trademark owners and third parties was to prevent consumer confusion and there was no evidence that the co-existence of trademarks and subsequent GIs resulted in the likelihood of confusion. More than 600 GIs had been registered over an eight year period, but the complainants in this case had been able to identify only four instances in which the GI registration would result in a likelihood of confusion with a prior trademark.[120]

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[119] WTO Panel Issues Mixed Ruling in GIs case, *Bridges Weekly Digest,* vol. 9, no. 9, 16 March 2005, available at http://www.ictsd.org/weekly/o5-03-16/WTOinbrief.htm; ICTSD Reporting-Australia Applauds WTO Ruling on Regional Food Names, Associated Press/Sydney, 16 March 2005; "U.S., EU, Australia All Claim Victory in WTO-GIs Dispute", *WTO Reporter,* 16 March 2005.

[120] Eliza Patterson, "WTO Panel Rules on Geographical Indications", ASIL Insights, 19 April 2005.

Chapter III

Geographical Indications (GIs): Implications for Developing Countries

3.1: *Introduction*

For developing countries,[1] the conclusion of an agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) was one of the most controversial outcomes of the Uruguay Round. The concerns voiced about TRIPs have focused not only on the inequitable distribution of benefits to developed and

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[1] *See* generally on TRIPs and Developing Countries, Ruth L. Gana, "Prospects for Developing Countries under the TRIPs Agreement", *Vanderbilt Journal of Transnational Law,* vol. 29 (1996), pp. 735-775; Jayashree Watal, "The TRIPs Agreement and Developing Countries: Strong, Weak or Balanced Protection?", *The Journal of World Intellectual Property,* vol.1 (1998), 281-307; Carlos M. Correa, "Review of the TRIPs Agreement: Fostering the Transfer of Technology to Developing Countries", *The Journal of World Intellectual Property,* vol.2 (1999), pp. 939-960; Frederick M. Abbott, "The Enduring Enigma of TRIPs: A Challenge for the World Economic System", *Journal of International Economic Law,* vol. 1 (1998), pp. 497-521; Paul Vandoren, "The Implementation of the TRIPs Agreement", *The Journal of World Intellectual Property,* vol.2 (1999), pp. 25-34; Carlos M. Correa, *Intellectual Property Rights, the WTO and Developing Countries: The TRIPs Agreement and Policy Options,* (Penang: Third world Network, 1999); Third World Network, *Option for Implementing the TRIPs Agreement in Developing Countires,* (Penang, Malaysia: Third World Network., 1998); J. H. Reichman, "From Free-Riders to Fair Followers: Global Competition under the TRIPs Agreement", *New York Journal of International Law and politics,* vol. 29, nos 1-2 (1996/97), pp.11-93); UNCTAD, *TRIPs and Developing Countries,* UNCTAD/ITE/1 (New York: UN Publications, 1997); Draft Report of an Expert Group on Developing Countries, Third World Network, Penang , Malaysia, October 1997; R. Acharya, "Intellectual Property Rights and Information Technology: The Impact of the Uruguay Round on Developing Countries", *Information and Communication Technology Law,* vol. 5, no.2 (1996), pp. 146-166, Michael Blakeney, "The Impact of TRIPs Agreement in the Asia Pacific Region", *European Intellectual Property Review,* vol. 10 (1996), pp. 544-554; A. Cosbey, "The Sustainable Development Effects of WTO TRIPs Agreement: A Focus on Developing Countries",(available in http://iisd.ca/trade/trips.htm); M.L. Damschroder, "Intellectual Property Rights", *Vanderbilt Journal of Transnational Law,* vol. 21 (1998), pp. 367-400; A.M. Pacon, "What will TRIPs do for Developing Countries", in Beier, F.K. and G. Schreiker, (edns.), 'From GATT to TRIPs: The Agreement on Trade-Related Aspects of Intellectual Property Rights', *International Review of Industrial Property and copyright Law,* (special Edition), (1996). pp.329-357; R. Rapp and R. Rozek, "Benefits and Costs of Intellectual Property Protection in Developing Countries", *Journal of World Trade,* vol. 24, (1990), pp.75-102; C.A. Primo Baga and C. Fink, "Reforming Intellecual Property Rights Regimes: Challenges for Developing Countries", *Journal of International Economic Law,* vol. 1, (1998), pp. 537-554; Arvind Subramanian and Jayashree Watal, "Can TRIPs serve as an Enforcement Device for Developing Countries in the WTO?" *Journal of International Economic Law,* vol. 3 (2000), pp. 403-416; R. S. Tancer and S.B. Tancer, "Intellectual Property Laws in the Millennium Round", The *Journal of World Intellectual Property,* vol. 2 (1999), pp. 889-910; Jayashree Watal, "TRIPs and the 1999 WTO Millennium Round", *The Journal of World Intellectual Property,* vol. 3 (1999), pp.1-29; Susan K. Sell, "Intellectual Property Protection and Antitrust in the Developing World: Crisis, Coercion, and Choice", *International Organisation,* vol. 19, pp. 945-956; Ruth L. Gana, "Has Creativity Died in the Third World? Some Implications of the Internationalisation of Intellectual Property", *Denver Journal of International Law and Policy,* vol. 24 (1995), pp. 109-144; Jayashree Watal, "Intellectual Property Rights and Agriculture: Interests of Developing Countries", Paper presented at The Conference on Agriculture and the New Trade Agenda in the WTO 2000 Negotiations, 1-2 October 1999, Geneva, Switzerland; Juma, C. (1999) "Intellectual Property Rights and Globalization: Implications for Developing Countries". Science, Technology and Development *Discussion Paper No.* 4. Cambridge, Center for International Development and Belfer Center for Science and International Affairs, Harvard University, available at [http://www2.cid.harvard.edu/cidbiotech/dp/discuss4.pdf].

developing countries, but even more fundamentally on whether the agreement will actually result in net losses for many if not most developing countries.[2]

In the course of negotiation, the one IPR issue on which most developing countries coalesce is that of GIs. The issue of extension on the stronger protection to products other than wines and spirits has been the contentious issue between developed and developing countries. Though the developing countries are in the either side of the negotiation table, majority of WTO Members including the Central European Free Trade Area (CEFTA) countries, and several developing countries, including the African group, wish to extend the protection provided by GIs to products other than Wine and Spirits. It is unclear whether an extension of GIs to other products would be of net benefit to developing countries as a group.[3] It could also result in increases in such designations for products originating in developing countries for which other developing countries are consumers.

In this background, this chapter analyses the position of developing countries in the issue of extension of additional protection to products other than Wines and Spirits and their implications. It also tries to look into the possible outcome of benefits for developing countries. The study also examines the relationship between GIs and traditional knowledge and tries to study the aspects of extending the additional protection under the TRIPs Agreement to other food, agricultural products, handicrafts, etc.

3.2: *Developing Countries and TRIPs Agreement*

The origin of the TRIPs Agreement as a manifestation of international IPRs can be traced back to the late 1970's, when the growth of trade in counterfeit goods led to the mobilisation of corporate actors on a global scale with the formation of the Anti-counterfeiting Coalition, an alliance of 100 national Governments to strengthen protection against counterfeit trademarked goods.[4] At the GATT Ministerial meeting in 1982, the developed countries tries to resolve

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[2] South Centre, *The TRIPs Agreement: A Guide for the South (*Geneva: South Centre, 1997), p.7.

[3] Esperanza Duran and Constantine Michalopoulous, "Intellectual Property Rights and Developing Countries in the WTO Millennium Round", *The Journal of World Intellectual Property,* vol. 2 (1999), pp. 853-874 at p. 860.

[4] Michael Blakeney, "Intellectual Property in a World Trade", *International Trade Law and Regulation,* vol.1 (1995), pp. 76-81 at p.77.

the issue of Tokyo Round negotiations that had failed between 1973 and 1979,[5] but the developing countries led by India[6] and Brazil questioned the need for an agreement on IPRs within the GATT at all and argued that the World Intellectual Property Organisation (WIPO) was the appropriate forum for addressing counterfeiting issues.[7]

The developed countries chose the GATT as the forum for negotiations of TRIPs for the reason that they could use GATT as the negotiation forum to access developing countries products their markets 'in return to the protection of IPRs,[8] the developed countries may be able to use the GATT dispute settlement procedures when a dispute on IPRs arose,[9] and the negotiation of TRIPs under GATT is more effective in terms of the number of participants compared to other international institution, in particular the WIPO.[10]

In the face of developing countries opposition, the most important stimulus for progress in negotiations doesn't came through multilateral discussions in the Uruguay Round, but through the threat of bilateral trade sanctions being brought by the United States under Special 301 of the Omnibus Trade and Tariff Act of 1988 by amending Section 301 of the Trade Act of 1984. These were incredible threats to the developing countries to improve IP protection available in national law through bilateral negotiations. This led the developing countries in an inevitable position, to agree for further negotiations of IPRs. The Ministerial Declaration of 20 September 1986, which launched the Uruguay Round of trade

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[5] The Tokyo Round of multilateral trade negotiations was launched in September 1973, on the basis of an agenda approved by trade ministers at a ministerial meeting held in Tokyo.

[6] Fredrick M. Abbott, "Protecting First World Assets in Third World: Intellectual Property Negotiations in the GATT Multilateral Framework", *Vanderbilt Journal of Transnational Law*, vol. 22 (1989), pp. 689-745 at 713.

[7] A.J. Bradley, "Intellectual Property Rights, Investment and Trade in Services in the Uruguay Round: Laying the Foundation", *Stanford Journal of International Law*, vol. 23 (1987), pp. 57-98 at p. 67.

[8] Carlos M. Correa and Abdulqawi A. Yusuf (eds.), *Intellectual Property and International Trade: The TRIPS Agreement* (The Hague: Kluwer Law International, 1998), p. 8.

[9] John Croome, *Reshaping the World Trading System: A History of the Uruguay Round* (Geneva: WTO, 1995), p. 134.

[10] Huala Adolf, "Trade Related Aspects of Intellectual Property Rights and Developing Countries", *The Developing Economies*, vol. 39, no.1 (2004), pp. 49-84 at p. 50.

negotiations, outlined a whole range of issues for negotiation, including TRIPs,[11] which is the starting point for the Uruguay Round of Negotiations.

In sum, the TRIPs Agreement was largely the result of pressure from US business,[12] instead the contribution of developing countries over the formulation of TRIPs are considerably good irrespective of their typical problems.[13]

3.3: *Developing Countries Position on GIs*

At the outset, in the TRIPs negotiations, the US proposals contained no mention of GIs;[14] the initial substantive submission by the European Community of July 1988 included a detailed provision on the protection of GIs.[15] Switzerland has submitted a fairly comprehensive proposal on the subject matter of GIs. On the developing countries side, India submitted a proposal[16] but it did not directly discuss the GIs.[17] After that, a group of ten developing countries submitted its

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[11] Ministerial Declaration on the Uruguay Round, GATT Doc. No. MIN.DEC dated 20 September 1986. The objective of the TRIPs negotiating group were set out as follows: 'In order to reduce the distortion and impediments to international trade, and taking into account the need to promote effective and adequate protection of intellectual property rights, and to ensure that measures and procedures to enforce intellectual property rights do not themselves become barriers to legitimate trade, the negotiations shall aim to clarify GATT provisions and elaborate as appropriate new rules and disciplines'

[12] Susan K. Sell, *Power and Ideas: The North-south Politics of Intellectual Property and Antitrust,* (New York: State University of New York of Press, 1998), p. 135.

[13] Jayashree Watal, "TRIPs and the 1999 WTO Millennium Round", *Journal of World Intellectual Property,* vol. 3 (1999), pp. 1-29 at p.29, she opines that, 'as the impact of the TRIPs Agreement has become more widely understood the response from developing countries has become more pronounced. In formulation their response to the TRIPs Agreement, developing countries have, however, to some extent been hindered by an absence of reliable economic impact assessment'.

[14] Suggestion by U.S. for Achieving the Negotiations Objective, MTN.GNG/NG11/W/14 dated October 1987 and the Revision, MTN.GNG/NG11/W/14 Rev.1 dated 17 October 1987.

[15] Guidelines and Objective Proposed by the European Community for the Negotiations on Trade Related Aspects of Substantive Standards of Intellectual Property Rights, MTN.GNG/NG11/W/26.

[16] Standards and Principles Concerning the Availability, Scope and Use of TRIPs, Communication from Switzerland, MTN.GNG/NG11/W/38, dated 11 July 1989.

[17] The perspective of the developing countries in the intellectual property dialogue is set forth in considerable detail in a position paper submitted by India to the TRIPs working group in July 1989. Paper presented by India in Uruguay Round Multilateral Talks: Standards and Principles Concerning the Availability, Scope and Use of Trade Related Aspects of Intellectual Property Rights, Communication from India, MTN.GNG/NG11/W/37 dated 10 July 1989.

India argued that Patent protection is the mechanism for advancing certain industrial policies and that countries at different stages of economic development must have the flexibility in their patent systems to take into account disparities in economic development. (Para.4). India says, Every country should be free to determine both the general categories as well as the specific

proposal[18] in which it largely relied on the Unfair Competition principles for the protection of GIs. Chapter–III of the proposal dealt about the GIs. Section 9 protects GIs including Appellations of Origin,

> *"Parties undertake to provide protection for GIs including Appellations of Origin against any use of which is likely to confuse or mislead the public as to the true origin of the product".*

[Foot Note.2]: GIs are any designation, expression or sign which aims at indicating that a product originates from a country, region or locality.

The steady struggle by developing countries made Lars Annell, the then Chairman of the TRIPs[19] negotiating groups to present a Draft compromise text categorising the views of developed countries in 'Version A' and 'Version B' for the developing countries. Though, the Draft Text was considered to be a masterstroke cutting through the differences between the opposite poles,[20] there remained significant disagreements over well established areas of difference between developed and developing countries in the areas including GIs.[21] In the Brussels Draft,[22] when it collapsed in acrimony over unresolved issues in

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products sectors that it wishes to exclude from patentability under its national law taking into consideration its own socio-economic, developmental, technological and public interest needs.

With respect to trademarks, India argues that foreign trademarks may adversely affect the allocation of resources in developing countries and should be subject to regulation in accordance with national development objectives. (Paras 31-35). India argued that whether a trademark is 'well-known' should be determined on a country-by-country basis.
In conclusion, "It would.... not be appropriate to establish within the framwork of the GATT any new rules and disciplines pertaining to standards and principles concerning the availability, scope and use of intellectual property rights". (Para. 47).

[18] Proposal from the Developing Countries by Argentina, Brazil, Chile, China, Columbia, Cuba, Egypt, India, Nigeria, Peru, Tanzania and Uruguay, MTN.GNG/NG11/W71 dated 14 May 1990.

[19] Lars Anell Draft, MTN.GNG/NG11/W/76 dated 23 July 1990.

[20] Duncan Matthews, *Globalising Intellectual Property Rights: The TRIPs Agreement*, (London and New York: Routledge, 2002), p. 36.

[21] G.E., Evans, "Intellectual Property as a Trade Issue: The Making of the Agreement on Trade-Related Aspects of Intellectual Property Rights", *World Competition*, vol. 18, no. 2 (1994), pp. 137-180 at p. 172 as cited in Matthews, Ibid, at p. 37.

[22] GATT Doc. No. MTN.TNC/W/35/Rev.1 dated 3 December 1990.

Agriculture negotiations, the '10 plus 10 Group'[23] was set up to bring together negotiators from the developed and developing countries that were most active and most skilled in intellectual property protection.

From the beginning itself, the EC was in the foremost position to have concern over the protection of GIs. So, in the whole negotiating process, EC sought for the protection of GIs vehemently and hence, Arthur Dunkel in his so-called 'Dunkel Draft' had accorded the necessary protection to GIs.[24]

In the final stages of negotiations for the TRIPs Agreement, the focus shifted, and less emphasis on dealing with the concerns of developing countries and more time spent dealing with cracks that were beginning to appear in the US-Europe-Japan alliance that had brought the idea of a TRIPs Agreement so close to fruition. But still, there were still outstanding differences between the US and EU on GIs for wines and spirits.[25]

In sum, the negotiations involved on the GIs section of the TRIPs Agreement were among the most difficult ones. Indeed, this stemmed from clear divisions between the main proponents of the TRIPs Agreement-the US and EU. Such divisions also existed among other developed countries and among developing countries. The final text of the Agreement reflects these divisions and, in mandating further work, recognizes that the agreement could not be reached in a number of important areas. Whatever may be the explanation, the outcome was that the current text of TRIPs Agreement provides basic standards of protection and a higher standard specifically for wines and spirits. The inclusion of higher standards does not refer to the unique characteristics of wines and spirits but was rather a compromise reached in negotiations.[26]

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[23] In reality the size and membership of the '10 plus10' Group varied depending on the issue to be discussed at any particular meeting, with the group as small as '5+5' and large as twenty-five on different occasions. Countries that regularly participated include the United States, Canada, the European Communities, Japan, Argentina, Brazil, the Nordic Countries, Hong Kong, India, Malaysia, Switzerland and Thailand.

[24] Annex III, Draft Final Act Embodying the Results of the Uruguay Round of Multilateral Trade Negotiations, MTN.TNC/W/FA dated 20 December 1991.

[25] T.P. Stewart (ed.), *The GATT Uruguay Round: A Negotiating History (1986-1992),* (Deventer, Netherlands: Kluwer Law and Taxation Publishers, 1993), p. 2287.

[26] Report of the UK Commission on Intellectual Property Rights, Integrating Intellectual Property Rights and Development Policy, London, September 2002 at p. 21.

3.4: ***Scheme of Protection within TRIPs: Negotiating Issues***

The protection of GIs under TRIPs Agreement are two fold, 1) Article 22 of the TRIPs Agreement provides for the protection of GIs generally, and 2)Article 23 provides Additional protction for GIs for wines and spirits. This imbalance of protection is the focal point around which the GIs revolve in the TRIPs council. A large group of WTO Members, especially developing countries have proposed before the Council to extend the additional protection to other products. The reason behind the issue of extension is very simple in the case of developing countries, except few developing countries, no developing country has major exporter of wines and spirit and they are in the state of marketing their agricultural, handicraft and artisan production. In addition, GIs have features that respond to the needs of indigenous and local communities and farmers.[27] Moreover, developing countries think in terms of economic and other benefits in the case of extension to other products.[28]

Differential treatment of GIs under Article 23 can be explained as a product of specific balance negotiated during the Uruguay Round. This balance appears to be a last minute trade off negotiated during the Brussels Ministerial Meeting and it has been articulated as,

"this compromise (i.e. Article 23), sought by several wine-producing countries, particularly the EC, represented a significant concession by a number of Members, among them other wine-producing Membes, that did not see the need to create an imbalance in GI protection by conferring increased protection on wine and spirit to GIs"[29]

[27] F. Addor and A. Grazzioli, "GIs Beyond Wines and Spirits-A Roadmap for a Better Protection of GIs in the WTO TRIPs Agreement", *Journal of World Intellectual Property,* vol. 5, (2002), p. 865 at 893-95.

[28] Ibid, p. 896, F. Addor and grazzioli affirmed that 'the improved protection of GIs for all products on a level similar to the one granted at present for wines and spirits, would promise trade and investments advantages, in particular for all these developing and developed countries which depend on exports of primary commodities'.

[29] Proposal submitted by Argentina, Australia, Canada, Chile, Guatemala, New Zealand, Paraguay, United States of America, IP/C/W/289, para. 9.

It was observed that this may have happened due to the link at that time between negotiations on GIs and Agriculture.[30]

The issue of the extension debate started somewhere in 1997 beginning with informal papers before the Council.[31] These expressions were reiterated at the WTO Seattle Ministerial Conference and it was formally iniated with the tabling of a proposal for GI extension in the Council.[32] In its communication it has stated that there is no systematic or logical explanation for the distinction made in Section 3 of Part II of the TRIPs Agreement. This distinction ignores that GIs for categories of goods other than wines and spirits are equally important for trade.

Rangnekar identifies three broad themes in the debate.[33] i) To begin with there is the legal question of whether the 'balance' achieved at the Uruguay Round is immutable or re-negotiable? In this debate, this question takes the form of examining the juridical basis of the demand for GI-extension in terms of the built-in agenda[34] for further negotiations within Section 3. Equally, questions also have been raised on the legal justification for a hierarchy in the level of protection on the basis of product categories. ii) the second theme concerns the potential impact of GI extension on trade and production patterns, consumers, producers and existing obligations under the TRIPs Agreement. For instance, concern has been expressed about the re-balancing of rights and obligations and the consequent shift in burden between Members. In addition, the theme is also concerned about the administrative burden of GI extension, and finally iii) conerns

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[30] WTO, Understanding the WTO: Developing Countries, Some Issue Raised, at http://www.wto.org/english/thewto_e/whatis_e/tif_e/dev4_e.htm.

[31] Job No. 4152 dated 31 July 1997 by Switzerland, Job No. 4486 dated 4 August 1997 by Czech Republic, Job No. 5023 dated 16 September 1997 by India.

[32] Communication by Bulgaria, the Czech Republic, Iceland, india, Liechtenstein, Slovenia, Sri Lanka, Switzerland and Turkey. Later Egypt, Kenya and Pakistan became co-sponsors to this communication, IP/C/W/204 dated 15 September 2000.

[33] Dwijen Rangnekar, GIs: A Review of Proposals at the TRIPs Council-Extending Article 23 to Products Other Wines and Spirits, Issue Paper No. 4, ICTSD and UNCTAD, Geneva, Prepared for the UNCTAD-ICTSD Capacity Building Project on IPRs and Sustainable Development, available at http://www/iprsonline.org/unctadictsd/docs/CS_Rangnekar2.pdf.

[34] In 1996, the TRIPs Council identified in the TRIPs Agreement three built-in-Agenda items concerning GIs: Article 23.4, Article 24.1 and Article 24, Report of the Council for TRIPs, IP/C/8, 1996, paras 26 to 28.

the insufficiency or adequacy of protection available under Article 22 (in contrast to Article 23), which clearly is the 'key' point of the debate for *demandeurs* (IP/C/W/308, Para. 18).

3.4.1: ***Scope of Protection: Article 22***

Members advocating GIs extension presented a different presentation of the 'effectiveness' of protection under Article 22. Those are a) Article 22 enables free-riding on GIs, b) Article 22 leads to legal uncertainty, and c) Article 22 puts the burden of proof on the producer entitled to use a GI. They also concerned the difference in treatment according to products concerned is an anamoly in the IP system of the TRIPs Agreement, no substantive justification for a discriminatory treatment between GIs for wines or spirits and those for other products.[35] As a whole the Members argued that the Article 22 protection was a non-effective one.

3.4.2: ***Extending the Scope of Protection: Article 23***

Since the end of Uruguay Round, the awareness of the need for additional protection for products other than Wines and Spirits has continously increased and spread among WTO Members. Extension of Article 23 level protection would provide an adequate level of protection of GIs for all products, facilitating product identification by the consumer, and therefore, enhancing consumer choice. Extension would open new market opportunities by preventing trade distortions. The benefits resulting from extension would fosster the development of local rural communities and encourage a high quality agricultural and industrial policy.

When considering extending GI protection, it is imperative to emphasize that the proposal presented by the sponsors of additional protection for products other than Wines and Spirits does not seek to require re-appropriation of terms and indications considered generic. The goal of the extension proposal is also to prevent GIs, which are not generic, from becoming generic.

3.4.3: ***Reasons for Limiting the Scope of Protection***

[35] IP/C/W/247 dated 23 March 2001; IP/C/W/308 dated 14 September 2001, both are proposed by Bangladesh, Bulgaria, Cuba, The Czech Republic, Georgia, Hungary, Iceland, India, Jamaica, Kenya, The Kyrgz Republic, Leichtenstein, Moldova, Nigeria, Pakistan, Slovenia, Sri Lanka, Switzerland and Turkey.

With regard to Article 23 the Members opposing GI-extension cautioned the enthusiasm of *demandeurs* by noting that Article 23 protection is not absolute as often characterised by the *demandeurs*.[36]

To extend the scope of protection of Article 23 has been opposed by a group of countries including Argentina, Australia, Canada, Chile, Guatemala, New Zealand, Paraguay and the United States.[37] These countries argue that an extension of the scope of Article 23.1 to products other than wines and spirits would entail a re-opening of the TRIPs Agreement, which may form the legal basis for negotiating such an extension. Further, they asserted that the countries pleading for higher protection must address the potential consequences, namely,

1) Potential Costs to Members resulting from extending the protection of gis for wines and spirits to other products;
2) Potential effects on consumers; and
3) Potential effects on trade.

These three consequences has been heavily contested by the pro-extension countries, [38] and discussed in the following section:

3.4.3. i: ***Potential Costs of Extending Protection***

The argument is put forward by the opposing countries are that the financial and administrative burden would outweigh the benefit of more effective protection of GIs for other products on an equal footing with those for wines and spirits. But, the stand taken by the developing countries are reasonable and pointed out that, to rely on the consumer in order to determine whether or not the use of a GI is misleading or constitutes an act of unfair competition and making protection dependent on this is not adequate and effective protection of an IPR. To take public opinion as the decisive criterion in granting protectiion results in

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[36] IP/C/W/289, para.5; IP/C/W/386, para 10-12.

[37] IP/C/W/211 dated 15 June 2001, Communication from Permanent Mission of Australia, available at http://www.dfat.gov.au/ip/aus_joint_paper.pdf.

[38] IP/C/W/308 dated 14 September 2001; IP/C/W/308/Rev.1 dated 2 October 2001, Communication from Bangladesh, Bulgaria, Cuba, The Czech Republic, Georgia, Hungary, Iceland, India, Jamaica, Kenya, The Kyrgz Republic, Leichtenstein, Moldova, Nigeria, Pakistan, Slovenia, Sri Lanka, Switzerland and Turkey.

unpredictable and uncertian protection, dependent on time and place. Such protection can lead to arbitrary decisions. This uncertainty and lack of transparency can be removed by extending the protection offered by Article 23 for GIs for wines and spirits to GIs for other products. Regarding the cost issue, it is important to emphasise that GIs for wines and spirits for today, the authorities examine the product originate place and it would clearly facilitate the procedures of enforcing the protection on gis and result in a reduction of the workload of judicial and administrative authorities as well as cost advantages for the enforcement of GIs against misuse in general.[39]

3.4.3. ii. *Potential Implications of Extension for Consumers*

The second argument is that consumers will be confused regarding the products they buy because the use of terms that are misleading to consumers are already dealt with under an Article 22 standard. Article 22 already allows interested parties to protect GIs for all goods in instances where their use could confuse consumers. However, Article 23 standard to be applied for all goods, the increase in costs to industry to rename, reliable and repackage would be passed on to consumers resulting in higher priced goods. Also, consumers will no longer be able to recognize the products that they are used to purchasing.[40]

The argument is flawed for the reason that the GIs are to help consumers identify the true origin of a product they want to purchase and to prevent situations where consumers are misled as to the true geographical origin or the characteristics of the product. Consumers are entitled to a real choice based on correct, distinctive indications. The use of indications such as "Carolina rice, made in India" should be just as illegitimate as "Napa Valley wine, produced in bulgaria".[41] With the extension of Article 23.1, consumer confusion can be prevented.

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[39] Ibid, paras 10-11.

[40] Ibid, para 26.

[41] n. 38, Para. 14.

3.4.3. iii. ***Potential Effects on Extension of Trade***

The document IP/C/W/289 points out that extension and the more effective protection of GIs resulting from it might have negative implications on trade. The argument set forth runs that certain industries, could find access to lucrative trade opportunities in new and emerging markets closed to their products, or would incur costs due to the need to re name or relabeled their products. The concern that GIs could be used as a protectionist instrument to restrict trade, whether in agriculturre or any other area, is unfounded. The provisions of WTO Agreement are there to prevent this happening. If the protection of GIs for wines and spirtis is extended to other products, goods will continue to circulate freely, ensuring to both producers and consumers that the GIs on a product does indeed correspond to the place of origin of the product.[42]

3.4.4: ***Doha Round and GIs***

As the negotiations around GIs were deeply contested, the only solution was to agree to further talks in the future; hence the built-in-agenda for further negotiations.[43] The first provision for further negotiations in Section 3 is set out in Article 23.4, under which Members have agreed to engage in negotiations to estbalish an international register for GIs for wines (later extended to spirits).[44] In line with this reading, we also note that Article 23.4 is not time bound, i.e., neither is there a deadline for commencement of negotiations nor an end date for the completion of the same. In the mean time, Doha Ministerial Conference was held at Qatar which had fixed the end-date for the completion of negotiations.[45]

Para 18 of the Declaration which states,

"With a view to completing the work started in the Council for Trade-Related Aspects of Intellectual Property Rights (Council for TRIPS) on the implementation of Article 23.4, we agree to negotiate the establishment of

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[42] IP/C/W/308/Rev.1, para. 24.

[43] Daniel Gervais, *The TRIPS Agreement: Drafting History and Analysis* (London: Sweet & Maxwell, 1998) at p. 135.

[44] The Annual Report of the TRIPs Council 1996, IP/C/W/8, (Para. 34).

[45] Doha WTO Ministerial 2001: Ministerial Declaration, WT/MIN (01)/DEC/1 dated 20 November 2001.

a multilateral system of notification and registration of GIs for wines and spirits by the Fifth Session of the Ministerial Conference. We note that issues related to the extension of the protection for in Article 23 to products other than wines and spirits will be addressed in the council for TRIPs pursuant to para. 12 of the declaration".

Doha Round has been considered as an important watershed for the developing countries with regard to GIs extension. The deadline was fixed by the Declaration and the Trade Negotiations Committee of WTO as December 2002. Following to the deadline fixation, another proposal has been submitted by Switzerland on behalf of other developing countries.[46]

The communication discuss about the various aspects of the extension clause by highlighting how it could be enshrined in the Section 3 of the TRIPs Agreement, and formulates a proposal for appropriate action to be included in the report of the TRIPs Council to the Trade Negotiations Committee (TNC), by the end of 2002 purusant to Doha Declaration. In extending the Scope of Article 23.1 of the TRIPs Agreement, it has discussed about the 'rationale' of the extension.[47]

The date has been extended and the Director-General has engaged in consultations in an effort to come to a decision on extension debate.[48] In his submission, it has been suggested that how the extension of additional protection

[46] IP/C/W/353 dated 19 June 2002, Communication from Bulgaria, Cuba, Cyprus, The Czech Republic, The European Communities and their Member States, Georgia, Hungary, Iceland, India, Kenya, Leichtenstein, Malta, Mauritius, Pakistan, Romania, The Slovak Republic, Slovenia, Sri Lanka, Switzerland, Thailand and Turkey.

[47] Ibid, Para. 12, states that, the rationale of extension is that gis for all products deserve the same level of protection. i.e., the one which applies currently only to wines and spirits. In order to establish such uniform protection for all products and extend the additional protection of Article 23.1' of the TRIPs Agreement to other products. It is proposed to remove the reference in Article 23.1 of the TRIPs Agreement to wines and spirits, and to prevent use of a gi "identifying products of the same category" not originating in the place referred to by the GI. With 'extension' the existing imbalance of Section 3 will disappear, providing the same level of effective protection to GIs for all products.

[48] TN/C/W/14 dated 8 July 2003, Communication from Bulgaria, Cyprus, The Czech Republic, Estonia, European Commission, Hungary, India, Kenya, The Kyrgz Republic, Latvia, Leichtenstein, Malta, Macedonia, Poland, Romania, Slovak Republic, Slovenia, Sri Lanka, Switzerland, Thailand and Turkey.

of products other than wines and spirits should be implemented[49] and the modalities of that inclusion has been put forth by Switzerland in this proposal.[50]

The 'extension' debate attracts several like minded developing countries and the number has increased significantly at the end of 2004.[51]

3.4.5: *Post Doha Round Developments*

Recently, on December 2004, Switzerland on behalf of India and other developing countries, presented a new communitcation to the General Council of the WTO aimed at assisting the consultations of the Director General on the extension of the Additional Protection for GIs to all products. Requested by the decision of the General council of 1st August 2004,[52] these consultations must allow concluding the work on extension in order for Members to decide on appropriate action by July 2005. The new communication also sets out key points on the contents and benefits of 'GI extension'[53]. The Doha Development Assistance (DDA) July 2004 Package[54] provides for GIs as, 'the relaunch of consultations with Members by the Director General on the extension of the protection of GIs provided for in Article 23 of TRIPs Agreement to products other

[49] Ibid, para.II, "The implementation in the TRIPs Agreement will require only minor modifications of the text of the Article 23 and corresponding changes in Article 24 of the TRIPs Agreement. The limitation to wines and spirits will be deleted and replaced with a neutral reference to products, thereby extending the more effective protection of this Article to GIs for all products".

[50] Ibid, para.III, "In submission JOB(02)/194 of 26 November 2002 to the TRIPs Council, which was later circulated as TNC Document TN/C/W/7 on 29 November 2002, Members in favor of the extension to other products also proposed that the TNC adopts the following guidelines for the negotiations on 'extension':

a. the protection of Article 23 of the TRIPs Agreement shall apply to GIs for all products;
b. the exceptions contained in Article 24 of the TRIPs Agreement shall apply *mutatis mutandis*;
c. the multialteral register to be established shall be open for GIs for all products.

[51] TN/C/W/14/Add.2 dated 15 July 2003, Communication from Bulgaria, Cyprus, The Czech Republic, Estonia, European Commission, Hungary, India, Kenya, The Kyrgz Republic, Latvia, Leichtenstein, Malta, Macedonia, Poland, Romania, Slovak Republic, Slovenia, Sri Lanka, Switzerland, Thailand and Turkey, and newly *Morocco* has added to the list of sponsors.

[52] WTO Doc. WT/L/579 dated 1st August 2004.

[53] WTO Doc. WT/GC/W/540/Rev.1 and TN/C/W/21/Rev.1 dated 14 December 2004.

[54] WTO Doc. WT/L/579 dated 1st August 2004, 147 Members of WTO has approved on 1st August 2004 a package of framework modalities paving the way for progress of the Doha work programme.

than wines and spirits'. According to this mandate, the Director General is to report to the TNC and the General Council no later than July 2005. The General Council shall review progress and take any appropriate action no later than July 2005.[55] The confirmation of WTO Members commitment to progress in the negotiations on the 'extension debate' shows that there is a room of hope for the developing countries.

3.5: *GIs and Traditional Knowledge*

Globalisation has raised the stakes in the protection of intellectual property rights worldwide.[56] Products that depend on IP rights to gain economic value are integral to markets of international trade. In turn, IPRs are vital to international trade because such rights create expectations of economic gain from investments of intellectual property, time and finances. There is an entire field of tradition-based intellectual activity, referred to as traditional knowledge (TK), which often does not receive the benefit of IP protection. Thus the IPRs hurt the traditional economies of devleoping countries, but that GIs may be an IPR more advantageous to their developing economies.[57] TK is a valuable heritage for the communities and cultures that develop and maintain them, as well as for other societies and the world as a whole. In the context of biodiversity, it is valuable for achieving conservation and identifying sustainable uses of biodiversity and genetic resources in important sectors such agriculture and medicine. The use of

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[55] Ibid, para 1.d.

[56] Graham Dutfield, "TRIPS-Related Aspects of Traditional Knowledge", *Case Western Reserve Journal of International Law,* vol. 33 (2001), pp.233 at 235; Shubha Ghosh, "Globalization, Patents and Traditional Knowledge", *Columbia Journal of Asian Law,* vol. 17 (2003), p. 73 at 74; Surinder Kaur Verma, "Protecting Traditional Knowledge: Is a *Sui Generis* System an Answer?", *Journal of World Intellectual Property (*2004), pp.765-805; Michael Blakeney, "Communal Intellectual Property Rights of Indigenous Peoples in Cultural Expressions, *The Journal of World Intellecltual Property,* vol.1 (1998), pp. 985-1002; Carlos M. Correa, "Traditional Knowledge and Intellectual Property", QUNO, Geneva, 2001 available at http://hostings.diplomacy.edu/quaker/new/doc/tkcol3.pdf; Chakravarthi Raghavan, *ASEAn for Protecting Indigenous/Traditional Knowledge,* Third World Network, 5 May 2000, John Mugabe, *Intellectual Property Protection and Traditional Knowledge: An Exploration in International Policy Discourse,* African Centre for Technological Studies, Nairobi, 1998, available at http://www.acts.or.ke/papers.htm; Daniel Gervais, "TRIPS, Doha and Traditional Knowledge", *The Journal of World Intelleltual Property,* vol. 6, no. 3 (2003), pp. 403-419; Michael Blakeney, "The Protection of Traditional Knowledge under Intellectual Property Law", *European Intellectual Property Review,* vol. 6 (2000), pp.251-261.

[57] David R. Downes, "How Intellectual Property Could be a Tool to Protect Traditional Knowledge", *Columbia Journal of Environmental Law,* vol. 25 (2000), p. 253 at 268-73.

GIs for products of indigenous and local communities' traditional knowledge could be valuable tools for such communities seeking to gain economic benefits from their traditional knowledge or to prevent its objectionable commercial use by outsiders.[58] GIs respond to certain indigenous concerns more effectively than do other IPRs.[59] In particular, rights to control GIs can be maintained in perpetuity; they do not confer a monopoly right over the use of certain information, but simply limit the class of people who may use a specific symbol.

Todate, debate on IPRs and biodiversity are focussed on Patents and Plant Breeders Rights, but the potential value of GIs and trademarks warrants much greater attention.[60]

WIPO and United Nations Development Programme (UNDP), in consultation with the CBD[61] Secretariat and other relevant organizations, should support collaboration between indigenous groups whose products could benefit from the use of GIs or trademarks, indigenous groups that have already developed related mechanisms, and experts from well-established systems of GIs in industrialized countries. The first step should probably be a survey to identify indigenous communities[62] with products having market potential and an interest in using marks of origin to manage the market.

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[58] Daniel J. Gervais, "The Internationalization of Intellectual Property: New Challenges from the Very Old and the Very New", *Fordham Intellectual Property Media and Entertainment Law Journal,* vol. 12 (2002), p. 929 at 960.

[59] WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore, Second Session, Survey on Existing Forms of Intellectual Property Protection for Traditional Knowledge-Preliminary Analysis and Conclusions, WIPO/GRTKF/IC/2/9 dated 3 Decmeber 2001. In the WTO, the view has been expressed that under certain circumstances GIS could be a particularly important way of protecting TK. For example, the EC has stated that in the context of TK. GIs could play a complementary role in protecting traditional products under certain circumstances.

[60] David Downes, Using Intellectual Property as a tool to protect Traditional Knowledge: Recommendation for Next Stepts, CIEL Discussion Paper, Prepared for Convention on Bio Diversity Workshop on Traditional Knowledge, Madrid, November 1997 at p. 12.

[61] Convention on Biological Diversity, 5 June 1992, reprinted in 31 *International Legal Materials* 818.

[62] Weerawit Weeraworawit, "International Legal Protection for Genetic Resources, Traditional Knowledge and Folklore: Challenges for the Intellectual Property System", in Christopher Bellman, Graham Dutfield and Ricardo Melendez-Ortiz, (eds.), *Trading in Knowledge: Development Perspectives on TRIPs, Trade and Sustainability* (London: International Centre for Trade and Development, Earth Scan Publications Limited, 2003).

The TRIPs Agreement requires WTO Members to provide for protection of GIs and trademarks. The creation of systems of GIs or the support of community efforts to use trademarks could bring economic rewards to communities seeking to market products based upon sustainable traditional production practices. In addition, GIs and trademarks benefit consumers by providing them with reliable information and assurances of authenticity.[63] They also respond to certain indigenous concerns more effectively than do other IPRs. In particular, rights to control trademarks and geographic indications can be maintained in perpetuity, and they do not confer a monopoly right over the use of certain information, but simply limit the class of people who can use a certain symbol.

This discussion emphasizes geographic indications, because they have certain additional virtues. They are based upon collective traditions and a collective decision-making process; they protect and reward traditions while allowing evolution; they emphasize the relationships between human cultures and their local land and environment; and they are not freely transferable from one owner to another; and they can be maintained as long as the collective tradition is maintained.

GIs are different from patents and copyrights in that they are not specifically designed to reward innovation. Rather, they reward producers that are situated in a certain region and that follow production practices associated with that region and its culture, customs and communities.[64] They are designed to reward good will and reputation created or built up by a group of producers over many years and in some cases over centuries.[65] In this sense, they can operate to maintain traditions and conserve traditional knowledge and practices.

GIs lend themselves better to communal organization than do other IPRs. A producer qualifies to use a geographical indication according to its location and

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[63] Paul J. Heald, "Trademarks and GIs: Exploring the Contours of the TRIPS Agreement", *Vanderbilt Journal of Transnational Law*, vol. 29 (1996), p.635-660 at 655.

[64] Jose Manual Cortes Martin, "The WTO TRIPs Agreement: The Battle Between the Old and the New World over the Protection of GIs", *The Journal of World Intellectual Property,* vol. 7, no. 3 (2004), pp. 287-326 at 326.

[65] Bernard O'Connor, "Protecting Traditional Knowledge: An Overview of a Developing Area of Intellectual Property Law", *The Journal of World Intellectual Property*, vol. 6, no.5 (2003), pp. 677-698 at p. 689.

method of production. It is immaterial whether the producer is an individual, family, partnership, corporation, voluntary association or municipal corporation. Typically, the producers based in the relevant region work cooperatively to establish, maintain and enforce guidelines for production of the good subject to the geographical indication.

In general, it has been argued that developing countries may find it in their interest to use GIs as a tool[66] to help develop and maintain both domestic and export markets for distinctive goods originating in their territory. In fact, some developing countries are doing precisely this in current talks in the TRIPs Council (one example is Mexico, regarding tequila). Regarding conservation the original products of these areas could be classified as GIs if the producers decide to link their collective norms and connected traditional knowledge.[67]

The observations of WIPO's Intergovernmental Committee on Intellectual Property and Genetic Resources , Traditional Knowledge, and Folklore is that some forms of IPRs cover the content of knowledge, others a specific expression, and others a distinctive sign or symbol.[68] One important finding of the Committee's "Review of Existing Intellectual Property Protection of Traditional Knowledge" was that while many countries considered few IP instruments suitable for protecting traditional knowledge, some looked favorably upon GIs.[69]

Supporters of TK are also supporting the developing countries agenda on Article 23 level protection to other products. Infact, the reason is when the additional protection would be granted it will cover TK products also. They argue that TK emerges from the customs, practices, and needs of a particular people of

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[66] Jose Manual Cortes Martin, "TRIPs Agreement: Towards a Better Protection of GIs", *Brooklyn Journal of International Law,* vol. 30, no.4 (2004), pp. 117-184 at p. 178.

[67] David R. Downes and Sarah H. Laird, *Innovative Mechanisms for Sharing Benefits of BioDiversity and Related Knowledge; Case Studies on GIs and Trademarks,* (UNCTAD Biotrade Iniative, 1999), available at http://www.ciel.org/publications/pubbaw.html.

[68] WIPO, Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore, Fifth Session, *Overview of Activities and Outcomes of the Intergovernmental Committee,* WIPO/GRTKF/IC/5/2 dated 3 April 2003 available at http://www.wipo.int/documents/en/meetings/2003/igc/grtkf_ic_5_12.pdf.

[69] WIPO, Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore, Third Session, *Review of Existing Intellectual Property Protection of Traditional Knowledge,* WIPO/GRTKF/IC/3/7 dated 6 May 2003 available at http://www.wipo.int/documents/en/meetings/2003/igc/grtkfic3_7.pdf.

territory; TK products very often have a strong association with geographical regions.[70]

3.6: *GIs for Food and Handicrafts etc*

GIs are economically as well as culturally significant, as confirmed by the resumption of the US' request for consultations with the European Communities (EC) regarding the EC regulations of GIs, which was joined by an Australian request for consultations.[71] Given the potential value of GIs as well as between GIs and generic names for foods, this form of industrial property became a contentious topic within the Doha Development Agenda, where the topic has been carefully followed by several countries including Kenya, Mauritius, Nigeria and India. African teas, coffees, sea food and spices from India are among the foods of potential interest. Currently the use of a label to promote the geographical link between a food and a locale is common to commodities (e.g., rice and salt), semi-processed products (e.g., coffee and tea) and processed foods (e.g., beverages, fruit preserves and sauces).[72] In this regard, EC regional approach, which melds community and national approaches to protecting GIs for food, is the best known.[73] This regional approach has not prevented intra-community conflicts over geographical names for popular goods. The Bangui Agreement now have a specific approach to GIs.[74]

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[70] Sumathi Subbiah, "Reaping What they Sow: The Basmati Rice Controversy and Strategies for Protecting Traditional Knowledge", *Boston College International and Comparative Law,* vol. 27, (2004), pp. 529-559 at 548.

[71] European Communities-Protection of Trademarks and GIs for Agricultural Products and Foodstuffs: Request for Consultations by the United States, WT/DS 174 (7 June 1999). This request was amended by an Addendum of 10 April 2003. Australian Request, WT/DS290/1 dated 23 April 2003. Several WTO Members, including Argentina, India and Mexico, asked to join the consultations. On 15 March 2005 the Panel Report has come out on this issue in favour of United States and Australia.

[72] OECD (S. Lucatelli), Implications of Origin and GIs in OECD Member Countries: Economic and Legal Implications, COM/AGR/APM/TD/WP (2000) 15/Final (2001).

[73] This rule is contained in Council Regulation (EEC) No. 2081/92 of 14 July 1992 on the protection of GIs and designations of origin for agricultural products and food stuffs, O.J.L. 208, p.1 dated 24 July 1992.

[74] Signed in Bangui on 2nd March 1977. The Bangui Agreement was revised in 1999 and entered in to force from February 2002. The revisions were designed to bring the Bangui Agreement into conformity with the TRIPs Agreement. Its Article 12 and Annex VI addresses GIS. As of May 2003 only GIs registered is Korhogo Cotton.

Under TRIPS Agreement, the situation regarding GIs for food is unclear. While the EC, Switzerland and some other developing countries read Article 24.1[75] to be all inclusive regarding product coverage and, so logically with in the Doha work program, the others disagree. Supporting to the disagreement, Berkey signifies that the assignment of IPRs to food GIs means that TRIPs increasingly may become a factor in agricultural trade disputes.[76] Many developing coutries support an extended GI regime for food under TRIPS, in spite of their initial opposition to a new negotiations while their Uruguay Round commitments are still being evaluated and implemented. Kenya and Nigeria have been vocal in this subject. Mauritius has been among the countries that tabled important papers before the TRIPs Council. Egypt and Morocco also favor extended protection for foods. Among the other developing countries interested in an extension of some form are India (tea), Indonesia (tea), Jamaica (coffee) and Thailand (rice).

3.7: *GIs and Rural Development*

Rural development is an important consideration in trade policy and the development of international rules. While the WTO Agreement and the Agreement on Agriculture did not mention rural development specifically, the Doha Declaration does.[77] The World Summit for Food[78] also adds public concern about the plight of the people. Many rural communities around the world are suffering from population loss and economic value. The GIs can provide limited support to economic and social stability, to small businesses and to rural communties. In combination with tourism, which is the largest industry today, trading on the name and origin of a food can bolster the economy of a local community and improve the income of small producers. Adding value to foods to make them marketable in niche markets is another option for promoting rural development, since GIs can add value and can create consumer interest in perceived high quality 'local, 'ethnic' or 'exotic' foods from a particular region.

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[75] Article 24.1 states that "Members agree to enter into negotiations aimed at increasing the protection of individual GIs under Article 23".

[76] Berkey O. Judson, "Implications on the WTO Protection for Food and GIs", *American Society of International Law Insights*, April 2000, available at www. asil.org/insights/insigh43.htm.

[77] note 45, Para. 13 of the Doha Ministerial Declaration, 14 November 2001.

[78] FAO, Report of the World Food Summit: Five Years Later, 10-13 June 2002.

The success and renown of a GI can add some glamour to rural life and a local community. A GI can also add value even to products made in smaller quantities, which is within the scope of small and micro businesses in rural communities.[79]

[79] Marsha A. Echols, "GIs for Foods, TRIPS and the Doha Development Agenda", *Journal of African Law,* vol. 47, no.2 (2003), pp.199-220 at p. 204.

Chapter IV

Geographical Indications (GIs) and India

4.1: ***Introduction***

India is a land of immense Intellectual Property (IP) with a number of cultural traditions, traditional communities, and tangible cultural heritage. It has a host of cultural assets which encompass forts, palaces, museums, heritage destinations, arts, crafts, folk music and dance. The concept of GIs is not a new for Indian domain. Evidence of the existence of GIs in India can be traced back to medieval times, as ruins of early civilizations on the banks of river Indus have revealed artifacts such as Harappan pottery, Jewelry and Mohenjadaro toys.[1] India is rich in spices,[2] tea and rice items. Basmati rice, Pashmina wool, Alphonso Mangoes, Kolhapuri Slippers, Malabar Pepper, Turmeric and Neem used here are some of the examples. Globalization has raised the stakes in the protection of IPRs worldwide. Products that depend on IPRs to gain economic value are integral to markets of international trade.[3] In turn, IPRs are vital to international trade because such rights create expectations of economic gain from investments of intellectual energy, time and finances.

India after opening its economy to the path of globalization, and as a prospective exporter of agricultural products has consciously signed the TRIPs Agreement in 1994, an offshoot of WTO and thereby accepted the conditions to make structural adjustments accordingly. Even after entering into TRIPs agreement, India has not effectively protected its GIs at the national level. Only after the 'Basmati' and 'Darjeeling' issues, India enacted its legislation on GIs to meet out the international developments on this area.[4]

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[1] Chander M. Lall, "Geographical Indications and Developing Countries", *International Trademark Association Special Report on Geographical Indications,* 1 September 2003.

[2] European's have come to India in the 16th Century to monopolize the Spices trade, in R.P. Anand, "New Laws of the Sea: Emerging Norms and Institutions", Lectures Delivered at The Institute of International Public Law and International Relations, Thessaloniki, Greece, 24th Session, 23-27 September 1996 at p. 6.

[3] Graham Dutfield, "TRIPS-Related Aspects of Traditional Knowledge", *Case Western Reserve Journal of International Law,* vol. 33 (2001), p. 233 at 237.

[4] A. David Ambrose, "National and International Protection of Geographical Indications-An Overview", in D.S. Prakash Rao (ed.,), *Festrschrift: Constitutional Jurisprudence and Environmental Justice-Essays in Honour of Prof. A. Lakshminath* (Andhra University, Vishakapatnam, 2001) at p. 825.

In this background, this Chapter analyses the development of GIs protection in India before the entry into force of TRIPs Agreement. It also includes a case study of Basmati and Darjeeling Tea in relation to GIs in India. It would also try to analyse the legal position of Geographical Indications of Goods (Registration and Protection) Act, 1999. This study would also go into a detailed account of contribution made by India to the international development of GIs and their submissions before the TRIPs council.

4.2: ***Legal Framework Prior to TRIPs Agreement***

The Indian Law relating to Trademarks and other forms of Industrial Property is derived from Common-law. Therefore, to comprehensively understand the protection of GIs under Indian law, it is necessary to look into development of the law relating to GIs in the United Kingdom

4.2.1: ***Common Law Approach on GIs***

The legal protection of GIs has its conceptual roots in the law of trademarks in UK. One of the early cases in this regard is The APOLLINARIS trademark case[5] has created a legal policy on the issue of registration of trademark and provides the commercial and legal context for the development of GIs in UK.

The doctrine of Passing off has been explained in these internationally reputed products having a geographical connotation, such as Champagne, Scotch whisky and Sherry.[6]

The critical question here is how these decisions have influenced the Indian context. Given the fact that the Indian law of Passing-Off is almost completely derived from the common law, it seems logical to assume that the

[5] Apollinaris Co. Ltd V. Duckworth, 23 RPC (1906); Re Apollinaris Co.'s trademark, 2 (1891) Ch. 186; Re Apollinaris trademark, 2 (1907) Ch 178, 24 RPC 436 (High Court); *Re The Application of the Societe des Usines Chimiques Rhone-Poulenc* case; Re Clarke, Son & Morland Ltd.'s Trademark, 2 All E.R.(1938) 377; *Yorkshire Copper Works Ltd., v. Registrar of Trademarks,* 1 All E.R. (1954) 570.

[6] See, Paul Abel, "The 'Sherry' Case", *Trademark Reporter,* vol. 58 (1968), pp. 188-190; Vine Products Ltd., v. Mackenzie & co. Ltd; Bollinger v. Costa Brava Wine Co., Ltd.,. 3 All E.R. (1959) 800

cumulative effect of these decisions would be the same in India as well.[7] Before going into the approaches of Indian judiciary it is necessary here to look into the concept and scope of passing-off principle.[8]

4.2.1. i: *Principle of Passing-Off*

The House of Lords in *ErvenWrnink BV. v. Townend & Sons*[9] had an occasion to explain the essentials of the cause of action for passing-off. Lord Diplock relied up the Halsbury's Laws of England,[10] and ruled that the plaintiff must prove each of the following of five essentials in an action for Passing-Off, a) a misrepresentation, b) made by a trader in the course of trade, c) to prospective customers of his or ultimate consumers of goods or services supplied by him, d) which is calculated to injure the business or goodwill of another trader, in the sense that this is a reasonably foreseeable consequence, and e) which causes actual damage to a business or goodwill of the trader by wom the action is brought.

In *Reckitt and Colman Products Ltd v. Borden Inc.,*[11] (Jif Lemon Case), Lord Oliver reduced the aforesaid five essential elements formulated by Lord Diplock to three namely, a) the existence of plaintiff's goodwill, b) a misrepresentation as to the goods or services offered by the defendant, and c) damage (or likely damage) to plaintiffs goodwill as a result of the defendant's misrepresentation. This view was reiterated in the case of *Consorzio de Proscuitto di Parma v. Marks and Spencer.*[12]

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[7] Shyamkrishna Balganesh, "Systems of Protection of Geographical Indications of Origin: A Review of Indian Regulatory Framework", *Journal of World Intellectual Property,* vol. 6, no. 4 (2003), pp. 191-205 at p. 196.

[8] Kerly, *Law of Trademarks and Trade Names,* 12th edition, para 1602, Kerley defines 'Passing-Off' as 'an actionable wrong for the defendant to represent, for trading purposes, that his goods are those or that his business is that of the plaintiffs..'.

[9] 1970 R.P.C. 31.

[10] vol. 48, 4th edition, p. 98 at para. 144.

[11] 1 All E.R. (1990) 873.

[12] 1991 R.P.C. 351.

4.2.2: *Role of Indian Judiciary on the Protection of GIs*

Prior to the inclusion of GIs under TRIPS Agreement, the infringement of GIs has been dealt through the principle of passing-off and unfair competition rules in Indian context. The court has entertained petitions in cases of infringement of GIs that misleads the consumer as to the place of origin or constitutes unfair competition. In such cases they have granted relief including grant of injunction restraining the defendant to use such indications.

The foremost in this regard was *Imperial Tobacco Co., v Registrar, Trademarks, Calcutta*[13] the Calcutta High Court explained the following concept of 'geographic term' as "Geographical terms and words used in geographical scene to denote place of origin, but used in an arbitrary or fanciful way to indicate origin or ownership regardless of location, may be sustained as a valid of trademark".

The Indian Courts has interpreted and applied the principle of passing-off in many cases. In *Dyer Meakin Breweries v. The Scotch Whisky Association,*[14] this was a case where the registration of the mark "Highland Chief" together with a pictorial representation of a Scotsman used in relation to whisky was opposed by the respondent on the ground that it was misleading and deceptive, the court found the mark to be misleading and ordered as cancellation. In doing so, it quoted with the approval the decision in the *Champagne* Case.[15] Thus it is logical to assume that the Indian law of passing-off would have covered an action for restraining the deceptive use of a geographical attribution.[16]

In the leading case by Bombay High Court in *Scotch Whisky Association v. Pravara Sakhar Shakar Karkhana Ltd.,*[17] the plaintiff, the Scotch Whisky Association, a company incorporated under the Companies Act of the UK instituted the Passing-Off action against the defendants; a manufacturer of various brands of Indian whisky known as 'Blended Scotch Whisky' or 'Blended with Scotch', under various brands, namely 'Drum beater' and 'God Tycoon'.

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[13] AIR 1977 Cal. 413.

[14] AIR 1980 Del. 125.

[15] n. 9.

[16] Balaganesh, n. 12, p. 197.

[17] AIR 1992 Bom. 294.

The Court held that i) the plaintiffs have sufficient interest and *locus standi* to prevent passing-off of Indian Whisky manufactured by defendant as 'Scotch Whisky' and to prevent damage to reputation and goodwill of Scotch Whisky, ii) the Plaintiffs have made out a strong *prima facie* case that the defendants are passing-off their goods as Blended Scotch Whisky or goods closely and substantially associated with Blended Scotch Whisky when in fat they are not. The Plaintiffs have, therefore, made out a case for grant of an interim injunction on merits of the case, (iii) the defendants are deliberately and intentionally passing-off their product as if 'Belnded Scotch' although as a matter of law, even unintentional misrepresentation is also actionable. It is unfortunate that the defendants have resorted to unfair device by using the words 'Blended with Scotch' and indulged in colourable imitation and unfair trading in an attempt to reap harvest by appropriation of plaintiff's goodwill in Scotch Whisky trade. The attempt of the defendants to justify the use of the words 'Blended with Scotch' has totally failed. The balance of convenience is in favour of the plaintiffs and not in favour of the defendants. (iv) the defendant is restrained from advertising or offering for sale or distributing in any country whisky which is not Scotch Whisky with the description 'Blended with Scotch Whisky' or 'Blended Scotch Whisky' or 'Blended with six year old Vatted Malt Scotch' or the word 'Scotch' or the impugned label or the impugned carton which bears the mark 'Gold Tycoon' containing the word 'Scotch' or the description 'Blended Scotch whisky' or 'Blended with six year'.

It is to be noted that from the aforesaid decisions, the Indian Judiciary is afforded adequate protection to GIs even the absence of any legislation in force.

In 1994 India has signed the TRIPs Agreement and thereby it came into force from 1st January 1995. The Agreement prescribes minimum standard of protection for GIs and additional protection for wines and spirits. It requires WTO Members to provide legal means to prevent the use of GIs that misleads the public to the geographical origin of the goods or constitutes an act of unfair competition. Article 22 to 24 of the Agreement provides protection for GIs. Each Member is free to provide legal protection according to their interest for GIs and there is no specific requirement under the Agreement.

4.3: *Indian Geographical Indications of Goods (Registration and Protection) Act, 1999*

In compliance to its obligation under the TRIPs agreement, India has enacted the Geographical Indications of Goods (Registration and Protection) Act, 1999[18] along with the Geographical Indications of Goods (Registration and Protection) Rules, 2002 after a long gap of four years from the TRIPs Agreement. The Act came into force from 15th September 2003.[19] The Act seeks to provide for registration and better protection of GIs relating to goods.

The main purpose of the Act is to protect the interests of the producers, manufacturers and the consumers from being deceived by the falsity of the geographical origin. The Act has been divided into nine chapters.

4.3.1: *Salient Features*

The Indian Act defines GIs in a broad manner. It separately defines the term 'indications'. Another important feature is that under the Act broad meaning has been given to the term 'goods'. The remedies which are available for protection of GIs may broadly be classified into two categories under the Act: (i) Criminal and (ii) Civil Remedies. The punishment prescribed under the section varies from the six months to three years imprisonment and a fine of not less than Rupees fifty thousand which may extend to Rupees two lakh. The Act has prescribes for enhanced penalty for second or subsequent conviction. The discretion is vested with the courts to impose a lesser punishment than the minimum punishment after recording in the judgment adequate and special reasons for awarding such lesser punishment. The suit for infringement can also be filed in the court not inferior to that of a District Court. The Central Government established the Geographical Indications Registry with all India Jurisdiction at Chennai.

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[18] The Geographical Indication of Goods (Registration and Protection) Bill, 1999 having been passed by both the Houses of Parliament received the assent of the President on 30th December, 1999 and came on the statute book as THE GEOGRAPHICAL INDICATIONS OF GOODS (REGISTRATON AND PROTECTION) ACT, 1999 (48 of 1999).

[19] 15th September 2003 *vide* S.O. 1051 (E) dated 15-09-2003, published in the Gazette of India, Extra., Pt. II, Sec. 3(ii), dated 15th September, 2003.

4.3.2: *Substantive Provisions*

4.3.2. i: *Definition of GI*

"Geographical Indication" in relation to goods,[20] means an indication which identifies such goods as agricultural goods, natural goods or manufactured goods as originating, or manufactured in the territory of 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.

4.3.2. ii: *Concept of Goods*

The Act[21] defines 'goods' to mean any: 1) Agricultural goods, 2) Natural goods, 3) Manufacturing goods and iv) Goods of Handicraft and foodstuff.
The definition of goods in the Act is restrictive and refers to 'agricultural, natural or manufactured goods or any goods of handicraft or of industry and includes foodstuff'. While the TRIPs Agreement refers to 'goods' whereas Indian Act has classified the goods. Moreover the Indian definition is not exhaustive but merely illustrative.

4.3.2. iii: *Meaning of Indication*

The word 'indication'[22] has also defined under the Act which includes: 1) any name, 2) geographical or figurative representation or 3) any combination of them conveying or suggesting the geographical origin of goods to which it applies. For example, the name of Darjeeling for tea indicates that the origin of tea is from Darjeeling, the name Scotch Whisky indicates the origin of that whisky is from Scotland.

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[20] Section 2 (e) of the Act.

[21] Section 2 (f) of the Act.

[22] Section 2 (g).

4.3.2. iv: *Prohibition of Registration of Certain GIs*

Section 9 of the Act prohibits the registration of GIs,

a. the use of which would be likely to deceive or cause consusion, 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 matters, or
d. which comprises 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 the 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.

4.3.2. v: *Registration of homonymous GIs*

A homonymous GIS 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 indication and the need to ensure equitable treatment of the producers of the goods concerned, tht the consumers of such goods shall not be confused or miled in condequence of such registration, subject to the provisions of section 7 of the Act.[23]

This provision has been delineated from Article 23.3 of the TRIPS Agreement and in India's condition so far it has not been experienced and moreover, in the Act the phrase used for the registration for homonymous GIs is 'may'.

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[23] Section 10.

4.3.2. vi: *Duration, Renewal, Removal and Restoration of Registration*

The registration of a GI shall be indication shall be for a period of ten years,[24] but may be renewed from time to time in accordance with the provisions of the this section. The registrar on application made by the registered proprietor or by the authorised user renews the registration of GI for a period of 10 years from the date of expiration of the original registration or the last renewal of registration as the case may be.[25]

No person shall be entitled to institute any proceeding to prevent or recover damages for the infringement of unregistered geographical indications.[26] Further nothing in this Act shall be deemed to affect the right of action against any person for passing-off goods as the goods of another person.

A registration of GIs, shall, if valid, give to the registered proprietor and all authorized user whose name has been entereed in the register, the right to obtain relief in respect of infringement of the geographical indications. However, authorised users shall have the exclusive right to the use of the GIs in relation to the goods in respect of which the geographical indications are registered. This right is subject to the conditions and limitations to which the registration is subject. Two or more authorized users of a registered GI shall have co-equal rights.[27]

A registered GI is infringed by a person[28] who, not being an authorized user thereof, (i) uses such GIs by any means in the designation or presentation of goods that indicates or suggests that such goods originate in some other geographical area other than the true place of origin of the goods in a namnenr which misleads the public, or (ii) uses any GIs in such manner which constitutes an act of unfair competition including passing-off in respect of registered GIs, or (iii) uses another GIs to the goods which, although literally true as to the territory,

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[24] Section 18 (1).

[25] Section 18 (2).

[26] Section 20.

[27] Section 21.

[28] Surekha Vasishta and Amar Raj Lall, "Geographical Indications of Goods (Registration and Protection) Act, 1999, in A.K. Koul and V.K. Ahuja (eds.), *The Law of Intellectual Property Rights: In Prospect and Retrospect* (New Delhi: Faculty of Law, University of Delhi, 2001) at p. 254.

region or locality in which the goods originate, falsely represent to the public that the goods originate in the region, territory or locality in respect of which such registered GIs relate.[29]

4.3.2. vii: *Special Provisions Relating to Trademarks and Prior Users*

The registration of a trademark may be refused or invalidated which a) contains or consists of a GIs with respect to the good or class or classes of goods not originating in the territory of a country, or a region or locality in that territory which such GIs indicates, if use of such GIs in the trademark for such goods, is of such a nature as to confuse or mislead the persons as to the true place of origin of such goods or class of classes of goods.[30]

This section protects a trade mark which contains or consists of a GI which has been applied for or registered in good faith under the trademarks law or where such trademarks have been used in good faith before the commence,emtn of the proposed legislation before the date of filing of an application ffor registration of a GI.[31]

The Calcutta High Court[32] had an occasion to look into the matter of GI and trrademark and the question before the court is whether a geographical name, without any relevance to the trade be registered as a trademark?. In this case, the Imperial Tobacco Company of India Ltd applied to the Registrar of Trademarks for registration. The trademark for registration is a label, used as wrapper of packets of cigarettes bearing the device of snow clad hills in outline with the word 'simla' written prominently in various panels of the lable with small inscription that the content is a product of the appellant company. The Registrar rejected the application for registration. Thereupon the company filed an appeal before the Calcutta High Court. The Court while disallowing the appeal laid down the principles that a) the mark 'Simla' is a geographical name and the snow-clad hills in outline in the mark indicates its use in ordinary or geographical signification, so

[29] Section 31.

[30] Section 25 (1).

[31] Under Section 9(1) (b) of the The Trademarks Act, 1999, a mark which indicates geographical origin is an absolute ground for refusal of registration.

[32] n. 19.

that the mark is neither a fancy or invented word nor one with a secondary meaning, and b) no trademark should be allowed to registered which may hamper or embarrass the traders or trade now or in future in respect of the place or country which is proposed to be registered.

In view of the imprint of snow clad hills in outline in the trademark 'Simla' the ordinary or geographical signification is obvious and patent even though it has no refernce to the quality or place of origin of the goods. Further, registration of such trademark may hamper or embarrass the trade or traders in or around the locality in future as held by judicial authorities cited earlier in similar cases. Also 'Simla' is too prominent a city, the capital of Himachal Pradesh, well known in the country and abroad and in its ordinary or geographical significance. It is inherently neither distinctive nor adapted to distinguishing the goods of the appellant as a particular trader from those of others, and is also hit by the provisions of Section 9 (I)(d) of the Trade and Merchandise Act, 1958.

Under Section 24, any right to a registered GI shall not be the subject matter of assignment, transmission, licensing, pledge, mortgage or any such other agreement.

4.3.2. viii: *Additional Protection for Certain Goods*

The Central Government may by notification in the Official Gazette provide for additional protection for certain goods or classes of goods, which are notified.[33] GIs once lawfully acquired further dealing in such goods shall not constitute an infringement unless the goods are impaired after they have been put in the market.

It is considered to be one of the most important section as far as India is concerned. Because, this section provides panacea for the extension debate of additional protection grant to products other than wines and spirits. This provision provides extra ordinary power to Central Government to provide additional protection for goods by way of notification.

The suit for infringement hs to be filed in court not inferior to that of a district court having jurisdiction. The court can stay the suit pending the final disposal of such proceedings before the appellate board and if no such

[33] Section 22 (2).

proceedings and the court is satisfied,[34] the court can adjourn the case for a period of three months from the date of the framing of the issue in order to enable the party concerned to apply to the Appellate Board for rectification of the Register.[35]

4.3.3: *Procedural Requirements*

The Act contains the procedural formalities like manner of application, contents of the application[36] and what kind of goods can be registered.[37]

4.3.3. i: *Procedure of Registration*

Any association of persons or producers or any organisation or authority established by or under any law for the time being in force representing the interest of the producers of the concerned goods, who are desirous of registering a GI in relation to such goods can apply for registration.[38] So, any person claiming to be the producer of the goods in respect of which a GI has been registered may apply for an authorised user of such GI.

The application must be made to The Registrar. Under the Act, the Controller-General of Patents, Designs and Trademarks appointed under sub-section (1) of section 3 of the Trademarks Act, 1999 shall necessary be the Registrar of Geographical Indications. He shall be assisted by such number of officer, which the Central Government may think fit.[39]

The Registrar or the Appellate Board may cancel or vary the registration of GIs or of an authorized user for the contravention or failure to observe the conditions entered on the Register. It enable any persons aggrieved by the absence or omission of any entry in the register without sufficient cause or any

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[34] Section 57.

[35] Section 66.

[36] Section 11 (2) (a)

[37] Section 8.

[38] Section 11 (1).

[39] Ibid.

entry wrongly remaining on the register by any error or defect, to apply to the Appellate Board or the Registrar to pass appropriate orders.[40]

4.3.3. ii: ***Appeals to the Appellate Board***

Any person aggrieved by an order or decision of the Registrar under this Act, or the rules made thereunder, may file an appeal to the Appellate Board. Such appeal must be filed within three months from the date on which the order or decision is communicated to the aggrieved parties.[41]

4.3.3. iii: ***Enforcement Provision***

The remedies available for protection of GIs may broadly be classified into two categories namely criminal and civil remedies.

Criminal Remedy: i) Falsifying and falsely applying geographical indications to goods,[42] ii) Selling goods to which false GIs is applied;[43] iii) Falsely representing a GI as registered,[44] iv) improperly describing a place of business as connected with the GIs registry,[45] v) Falsification of entries in the register. The punishment prescribed for the aforesaid offences varies from six months to three years imprisonment and a fine of not less than Rs 50,000 but not extend to Rs. 2 lakh.[46] However, the court for adequate and special reasons in writing may impose lesser punishment. The Act also prescribes for enhanced penalty for second or subsequent conviction. The term of imprisonment in such cases shall not be less than one year but it may exceed up to Rs. 2 lakh.[47] The discretion is vested with the courts to impose a lesser punishment than the minimum punishment after

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[40] Sections 27 and 28.

[41] Section 31.

[42] Sections 38 and 39.

[43] Section 40.

[44] Section 42.

[45] Section 43.

[46] Section 39.

[47] Section 41.

recording in the judgment adequate and special reasons for awarding such lesser punishment. No cognizance would be taken of any conviction made before the commencement of the Act. The offence under this Act is cognizable.

The Registry of GIs established in Chennai with all India Jurisdiction[48] which has started function according to the Act.[49] So far the Registry has granted 10 GIs which began from 15 september 2003.[50] The products that have been given GI certification include *Darjeeling Tea* from West Bengal, *Pochampally Ikat* from Andhra Pradesh, *Mysore Silk* from Karnataka, *Salem Fabric* from Tamil Nadu, *Goa Fenny* from Goa, *Banarasi Silk* from Uttar Pradesh, *Payyanur Modhiram (Ring)* from Kerala, *Aranmulai Kannadi (Mirror)* from Kerala and *Chanderi Saris*[51] from Madhya pradesh. Some of them are also pending before the Registry. For instance, Joss Stick.[52] When we closely observe every state has greatest wealth of GIs. For example in Rajasthan, Summer Fabric of Kota Doria to the heavy weight of the stone industry Kota Stone, Bikaneri Bhujia to the sweet, from the light but hand block Sanganeri and Bagru prints to the Barmer Kashidakari.

4.3.4: *Critical Analysis of the Act*

1. According to Indian GI's Act, only authorised users of the GI have a legitimate claim to the production of the product. Though a craftsman/weaver belongs to the particular area, if his/her name is not in the list of unauthorised user, he can be forced to stop the production.

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[48] According to Section 5 of this Act, GIs Registry has been established with All-India Jurisdiction with its head office at 434, Guna Complex, Teynampet, Annasalai, Chennai-600 018 {*vide* S.O. 1052 (E), dated 15th September 2003.

[49] J. Venkatesan, *Vice-Chairman Appointed to IPR Board,* The Hindu, 27 April 2003.

[50] Manisha Gupta, *Rajasthan's Wealth of Intellectual Capital,* The Hindu, 31 May 2005.

[51] The renowned *Chanderi Saris* manufactured in Chanderi Tahasil of Ashok Nagar District of Madhya Pradesh and it has registered on 28th January 2005. This is for the first time that a product of textile sector from Madhya Pradesh has been registered. The handloom weavers of Chanderi Tahasil have been traditionally engaged in manufacturing in other parts of the state as well as the country using inferior quality of thread and other material damaging the reputation of *Chanderi Saris.* China has badly affected the local weaving industry by manufacturing Banarasi and Kanjivaram Saris at lower cost. The registration of *Chanderi Saris* under the Act would provide them protection against such damage. This is the first achievement towards protection of weaving clusters in the state. (available at http:// www.mpinfo.org)

[52] The Hindu, New Delhi, 15 November 2005.

Thus, the Act is anomalous is so far it put the very people at the risk of suffering from it.

2. The Act is silent on the issue of migration. Suppose if a skilled worker, also an authorised user, leaves for a distant town? Can the person who come to some place in which he learns the skill, on that situation, Can he register himself as an authorised user.
3. The status of GI is valid only for ten years. After that it should be renewed. Take for example, suppose Kolhapur footwear, in this case, can it undergo any change even after ten years. This clause is verbatically copied from the trademark and copyright acts without applying the mind.
4. According to the Act, there are three essentials to be satisfied before the registration for GI, namely quality, reputation and characteristics. But the Act set standard only reputation and characteristics and there is no quality control before and after registration.

In sum, the GIs Act could be enormously beneficial for a country as rich as source of potential GIs as India. However, several problems exist in the framing of the law, rules and administration. For real benefits the problems should be identified and resolved through a proper framework of law.

4.4: *India's Contribution for the protection of GIs in International level*

India always in the forefront when it comes to address the issue of IPR related matters in the global level. During the Uruguay Round Negotiations, India played a significant lead role in organising developing countries front against the mighty States such United States, Europe Community and Japan. The first of such was when India raised the active voice against the GATT as the forum for negotiations for IPR related matters and suggested WIPO as the appropriate forum. Having its strong agricultural background, India has submitted various proposals on GIs[53] and vehemently argued for Additional Protection for products

[53] Communication From India, MTN.GNG/NG11/W/37 dated 10 July 1989; MTN.GNG/NG11/W/71 dated 14 May 1990; IP/C/W/204 dated 15 September 2000; IP/C/W/247 dated 23 March 2001; IP/C/W/308 dated 14 September 2001; IP/C/W/308/Rev.1 DATED 2 October 2001; IP/C/W/353 dated 19 June 2002; TN/C/W/14 dated 8 July 2003; TN/C/W/14/Add.2 dated 15 July 2003 and a detailed discussion of India's proposals contains in Chapter-3 in this work.

other than wines and spirits with EC. One of the most important concern for the Indian side is with regard to absence of higher level of protection as in Article 23[54] protection to the Indian and all other GIs and at the international level it requires larger resources for worldwide protection and enforcement. Absence of this protection leads to consumers are being misled and thereby causes heavy loss national income. To prove on this point, a case study of Darjeeling Tea and Basmati Rice has taken as a sample and it needs a detailed account of study.

4.5: *Case Studies*

Two cases have been taken and analyse the situation of that product and tries to examine the GIs belongs to India and its effects at multilateral level.

4.5.1: *Basmati Rice*

In late 1997, an American Company Rice Tec Inc, was acquired a patent for a novel method of breeding a long grain of aromatic rice, for a novel method of preparing and cooking the rice, and for the grains themeselves.[55] RiceTec Inc, had been trying to enter the international Basmati market with brands like 'Kasmati' and 'Texmati' described as Basmati-type rice[56] with minimal success. However, with the Basmati patent rights, RiceTec will now be able to not only call its aromatic rice Basmati within the US, but also label it Basmati for its exports. This has grave repercussions for India and Pakistan because not only will India lose out on the 45,000 tonnes US import market, which forms 10% of the total Basmati exports, but also its position in markets like the EU, the UK, Middle East and West Asia. In addition, the patent on Basmati is believed to be a violation of the fundamental fact that the Basmati grown only in Punjab, Haryana, and Uttar Pradesh is called Basmati. According to the Agricultural and Processed

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[54] Article 23 of the TRIPs Agreement provides Additional Protection to Wines and Spirits.

[55] Vandana Shiva, "Basmati Biopiracy: Ricetec Must Withdraw all Patent Claims for Basmati Seeds and Plants, available at http://www.vshiva.net/Articles/Basmati/biopiracy.htm.

[56] The name 'basmati' derives from the Hindi word for fragrant, an appropriate connection because the rice is known for its aromatic scent which has been described as nut-like, in Joayemi Adewumi, India-US Basmati Rice Dispute, Trade and Environmental Database Case Studies, available at http://www.american.edu/projects/mandala/TED/basmati.htm.

Food Products Export Development Authority (APEDA), India is the second largest producer of rice after China, and grows over a tenth of the world's wheat.

The Rice Tec Inc, was issued the Patent number 5663484 on Basmati rice lines and grains on 2nd September 1997.

"In abstract, the invention relates to novel rice lines and to plants and grains of these lines. The invention also relates to a novel measn for determining the cooking and starch properties of rice grains and its use in identifyuing desirable whose plants are semi-dwarf in stature, substantially photoperiod insensitive and high yielding, and produce rice grains having characteristics similar or superior to those of good quality Basmati rice. Another aspect of the invention relates to novel rice lines produced from novel rice lines. The invention provides a method for breeding these novel lines. A third aspect relates to the finding that the starch index (SI) of a rice grain can predict the grain's cooking and starch properties, to a method based thereon for identifying grains that can be cooked to the firmness of traditional Basmati rice preparations, and to the use of this method in selecting desirable segregants in rice breeding programs".[57]

At the time the Basmati rice patent was granted to Rice Tec, the Council for Scientific and Industrial Research (CSIR) was challenging the trumeric patent. The granting of the patent to Rice Tec immediately launched the turmeric patent. The granting of the patent to Rice Tec immediately launched a challenge to the Basmati rice patent. As attorneys for the Indian Government stated, "Rice-tec has got a patent for three things: 1) growing rice plants with certain characteristics identical to Basmati, 2) the grain produced by such plants and 3) the method of selecting rice based on a starch index (SI) test devised by Rice Tec, Inc.[58] They also point to the fact that seventy-five percent of U.S. rice imports are from Thailand and that the reminder are from India and Pakistan; both varieties are rice that cannot be grown in the US. The legal theory is that the patent is not novel and for an invention that is obvious, being based on rice that is already being imported to the US. Finally, India's attorneys also seek to challenge the use of the term 'basmati' in conjunction with the patent and in the marketing of the rice.

[57] For a detailed study on claims, see Shubha Ghosh, "The Traditional Terms of the Knowledge Debate", *North Western Journal of International Law and Business*, vol. 23 (2003), pp. 589-631 at p. 611.

[58] Basmati Rice: U.S. Firm Withdraws Patent Claim, Hindustan Times, 28 September 2000.

Such use of the term creates confusion as to geographic origin and usurps the goodwill and recognition established with basmati rice grown in and sold from India.

Since many analysts have concluded that the attempt to cancel RiceTec's patent will likely unsuccessful Indian Government has filed a re-examination application[59] through an NGO, Agricultural and Processed Food Products Export Development Authority (APEDA). The reexamination led to a preliminary decision by the USPTO in March 2001 to reject of most Rice Tec's claims and gave the company until May 2001 to file a response. By April 2001, Rice Tec withdrew not only the three claims directly challenged by the Indian Government, but also withdrew an additional eleven claims and amended another one. Rice Tec even changed the name of its patent from 'Basmati Rice Lines and Grains' to the more neutral 'Rice Lines Bas 867, RT 1117, and RT 1121.[60]

The United States Patent and Trademarks Office (USPTO) came to its final decision in August 2001 to narrow Rice Tec's patent. The USPTO upheld the patent for three hybrid varieties that Rice Tec developed. However, the USPTO rejected the remaining broader claims. The current patent does not prevent Indian Basmati producers from exporting to the US or significantly disadvantage Indian Basmati Rice in the US market. The Indian Government and NGOs considered the result to be a victory, and the Indian Government decided not to challenge the three upheld claims. Even the Rice Tec company called it a fair outcome and a 'solomon-type' result. Neverethless, supporters of GIs and TK asserts that there is an economic threat because the term 'Basmati' does not have specific protection and is deemed generic under U.S. law.[61]

At the same time, The Research Foundation for Science, Technology and Ecology (RFSTE), an NGO from India and an another US based NGO filed a petition with the Federal Trade Commission (FTC) requesting the agency to regulate the use of the term 'Basmati' in domestic advertising, but they have not file a formal action asking officially for GIs protection. The FTC denied the

[59] U.S. Patent Reexamination Certificate No. 5663484 (issued on 29 January 2002).

[60] Shuchi Sinha, Basmati Patent: Whose Rice is it Anyway?, India Today, 3 September 2001 at p. 40.

[61] Jairam Ramesh, Basmati Gets Steaming Again, India Today, 3 September 2001, at p. 35.

petition summarily.[62] As a consequence, Rice Tec and any other company that produces aromatic, basmati-like rice anywhere in the world outside of South Asia, Basmati rice's place of origin, can sell the products using the name 'Basmati'.

According to Indian Farmers, NGOs and the Indian Government, there is no such thing as "American Basmati Rice". It is inaccurate and even oxymoronic, in the same way that the term "American Champagne". Still, the FTC is not fully to blame for its overly legalistic dismissal based on likelihood of consumer injury. The FTC's priority is not granting GIs protection to a product, which can be more appropriately decided by the USPTO's trademark office.

However, because 'Basmati' failed to be recognized as even a geographically specific term, the Indian Government and other observers viewed the result of the USPTO case as only a limited victory. The Indian Government, with the help of NGOs, had successfully defended against a potentially economically destructive patent by showing that Basmati rice was a product of prior art. However, US law still denied GIs protection and permitted the generic use of the name 'Basmati', which Indian observers view as inextricably linked to their cultural heritage.[63]

This case has made Indian Government to enact Geographical Indications (Protection and Registration) Act, 1999, and this case also makes an attempt to synthesize the Traditional Knowledge and GIs.

4.5.2: *Darjeeling Tea*

The district of Darjeeling is situated in the province (state) of West Bengal, India. Tea has been cultivated, grown and produced in tea gardens geographically located in these areas for the last 150 years. The gardens are all located at elevations up to over 2000 metres above mean sea level. Due to the unique and complex combination of agro-climatic conditions prevailing in the region and the production regulations imposed, such tea has a distinctive and naturally-occurring quality and flavour which has won the patronage and recognition of discerning consumers all over the world for well over a century.

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[62] The FTC stated that Basmati rice is "included as an example of 'aromatic rough rice', and is not limited to rice grown in any particular country, in http://www.ftc.gov/os/2001/05/riceletter.pdf.

[63] Sumathi Subbiah, "Reaping What They Sow: The Basmati Rice Controversy and Strategies for Protecting Traditional Knowledge", *Boston College International and Comparative Law Review*, vol. 27 (2004), pp. 529-559 at p. 555.

The quality, reputation and characteristics of the tea is essentially attributable to its geographical origin and cannot be replicated elsewhere resulting in Darjeeling Tea being considered a geographical indication. Broadly there are 2 factors that contribute to the exceptional taste of Darjeeling tea – the geographical location and the processing.

Geographic Location:

Altitude	700 to 2000 meters nestling in the shadow of the snow-clad Kanchenjunga peak
Latitude	26°31' and 27°13' North
Longitude	87°59' and 88°53' East
Rainfall	Minimum of 50" to 60" p.a.
Humidity	Very high
Soil	Rich and loamy soil. In the uplands it is usually red and gritty and is residual i.e. derived from the weathering of underlying rocks and rich in organic matter from the surrounding forest cover.
Gradient of slope	60° to 70°
Temperature	1.7 to 11.1°C a maximum of 20°C
Flavor	'Muscatel'
Spring Flush (May to June)	Leaf has purplish bloom. Liquor is mellow and amber in color with a fruity (grapey) flavor called Muscatel.

The protection of Darjeeling tea - the Indian experience

Objectives

- To prevent misuse of the word "Darjeeling" for tea sold world-wide
- To deliver the correct product to the consumer
- To 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.

Darjeeling tea is produced by 86 tea gardens/estates over an area of 19,000 hectares with an annual production of about 10,000 tons. About 70% of total production of Darjeeling tea is exported. The area under cultivation and the production have been stagnant for the past two decades. There are four seasons of cropping, viz., Easter, spring, summer and autumn. The easier and spring flushes have the unique Darjeeling flavour and command a high price. While the production during these flushes account for 20% of total output they account for 40% of revenue. The main markets for this high end Darjeeling Tea are Germany,

Japan, the US and UK.[64] The summer and autumn flushes are not so uniques and most of it is consumed within the country. At one time they used to be exported to the former Soviet Union. While Darjeeling tea produced in Darjeeling is 10,000 tons, it is estimated that 40,000 tons of tea is sold as Darjeeling Tea in the world market in any since 1976.[65] The consumers of these 40,000 tons of tea are being misled into believing that they are consuming Darjeeling Tea when in fact they are not. The recent World Report analyses the trends and impacts of Darjeeling tea and reveals that the demand for Darjeeling tea was estimated during the period 1972-2002. The results obtained suggest that the GI protection has increased the price of Darjeeling tea in total by less than 1 percent in real terms over the 1986-2002 period and criticizes the empirical literature on GIs is extremely limited.[66] To protect the Darjeeling Tea, the common geographical name protected under the Certification Trademark (CTM) system,[67] prior to the GIs Act of 1999.

A certification mark is understood as a mark adminsitered by a proprietor who certifies the goods as to their origin, material, mode of manufacture, or performance of services, quality, accuracy or other characteristics, and thereupon allows use of the mark.[68] The Tea Board of India is the authority set up under the Indian Tea Act of 1953 to promote tea production in India. The Tea Board is the certifying authority and is registered as the proprietor of the mark "Darjeeling Tea" in relation to tea grown in the Darjeeling District.

The CTM registration is existed when the system of CTM registration is not accepted in a jurisdiction where protection is sought, e.g. France for Darjeeling, Where GI registration is necessary to avail for the reciprocity mandate under EU 2081/92, it gives a clear status to a GI indicating a direct link with

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[64] Niranjan Rao, Geographical Indications in Indian Context: A Case Study of Darjeeling Tea" *Working Paper No. 110*, Indian Council for Research on International Economic Relations, New Delhi, available at http://www.icrier.res.in/pdf/wp110.pdf at p. 17.

[65] Pettigrew, "Tea Board of India's New Scheme to Protect Darjeeling Tea", *Tea International*, 2003.

[66] WTO Trade Report, 2004 (Geneva: WTO, 2004) at p. 86.

[67] Chapter VII Section 60 to 70 of the Trade and Merchandise Marks Act, 1958 deals with Certification Marks.

[68] Similar definition found in S. 2 (c) of the Indian Trademarks and Merchandise Marks Act, 1958 and Section 2(e) of the Indian Trademarks Act, 1999.

geographic origin, Lack of consensus between countries, non GI vis a vis pro GI – time lost.[69]

Necessary where no legal platform exists to register a GI or a CTM which is a TRIPS obligation e.g. Japan, With additional protection it would not be necessary to establish the credentials/ reputation of a GI before fighting infringement of similar "types", "styles", "look alikes". Additional protection would rectify imbalance caused by special protection of wines and spirits.

To prevent the counterfeiting, India Tea logo has been registered and protected under copyright in India. Tea Board has recently initiated action that will facilitate India Tea logo campaign in Russia, our largest importer. This is as per strategy laid out in the Mid Term (2002-06) Export Strategy Plan for Indian Tea developed by Tea Board. The framework under which the logo will be granted is undergoing change and a monitoring mechanism is being put in place to ensure that teas being exported under the logo to Russia meet a minimum benchmark quality. This minimum benchmarked quality has been ascertained as part of a separate exercise where the most popular brands in the Russian market were analysed and Indian tea alternatives developed. This exercise is going hand in hand with an advertising campaign that has been executed in Russia promoting Indian Teas, (the first phase of which commenced in October 2002) where Indian teas carrying the logo are being earmarked.

In the case of infringement[70] the Tea Board can initiate action for the violation. But there is no practical information as far as the infringement of its certification mark of Darjeeling tea or how many of them have been prosecuted. [71]

According to Rao, Article 23 protection to Darjeeling Tea is not a good idea and he suggests that Article 22 protection may be enough. Developing countries, which are arguing for extension of protection to other products, should experiment

[69] Naba Kumar Das, Protection of Darjeeling tea, Worlwide Symposium on Geographical Indications
organized by the World Intellectual Property Organization (WIPO) and the United States Patent and Trademark Office (USPTO) San Francisco, California, July 9 to 11, 2003, WIPO/GEO/SFO/03/8.

[70] Section 75 of the Indian Trademarks Act, 1999.

[71] Rao,n. 60, at p. 20.

with Article 22 protection for some years and if the results are unsatisfactory should then ask for enhanced protection.[72] Contrary to that many of the scholars including Naga Kumar Das, Chairman, Tea Board of India expresses concern over the Additional Protection for other products other than wines and spirits.

This part would take few samples of GIs which has registered with the Registry in India.

4.5.3: *Pochampally Ikat:*

Pochampally is a small town in Nalgonda District near to the capital city of Andhra Pradesh, Hyderabad, is probably one of the most flourishing centre of modern handloom industry and producing *Ikat* saris on a large scale for centuries. Pochampally, a handloom cluster is known for its very unique *Ikat* design for centuries. It has about 5000 weavers who weave the handloom with traditional design called *Ikat*. The weavers in Pochampalli are basically Hindus of the Padmasali or Devang communities who have been residents for long and have thus adopted the local dialect and social norms. These weavers produce *Ikat* textiles with geometrical designs, and have also recently started experimenting with all-Indian styles. It is believed that *Ikat* technique was brought to Pochampalli from Chirala, another town in Andhra Pradesh, a couple of generations ago, perhaps as early as 1915 when the workshops in Chirala are said to have been weaving ikat saris, turbans etc.

One of the reasons why Pochampalli saris find a better market in India and abroad is, the weavers use modern synthetic colors instead of the expensive vegetable dyes for dying, thereby not only bringing down the cost of production, but also getting a chance to be more creative by trying out complex designs. Since the 1960's Pochampalli *ikat*-weavers were influenced by the paolu designs of Gujarat. The reasons for this influence could be many. Migration of the weavers could be one of them. However, there are some experts who feel that more than migration it could be influence of the print media, which could be one of the major reasons. "Weavers have probably seen the Gujarati designs either in a magazine or might have actually seen one of the patola fabrics. It is also possible

[72] Ibid at p. 26.

that weavers came across the designs at a handloom exhibition and copied the design," say some experts.

With the objective of converting this uniqueness into commercial value, the Textiles Committee launched a cluster initiative under its Cluster Development Programme to facilitate the local associations "Pochampally Handloom Weavers' Co op. Society Ltd", an autonomous society registered under the society Act 1860 and "Pochampally Handloom Tie & Dye Silk Sarees ManufacturesAssociation" an association established under the law are the two bodies that are responsible for production and marketing of Pochampally Ikat. The Directorate (Handlooms & Textiles) Government of Andhra Pradesh, Weavers Service Centre (WSC), APTDC, NABARD have been involved in the process of GI registration. The services of APTDC used for filling before GI registry and NABARD has provided funds under its DRIP to cover the costs involved.

The famous Pochampally *ikat* tie-and-dye sari has won Intellectual Property Rights protection, more than a year after its first applied. It is the first traditional Indian craft to receive this status of geographical branding. The design won protection in the Geographical Indications category. This will protect the Pochampally handloom sari from unfair competition and counterfeit. An estimated one hundred thousand weavers in Andhra Pradesh may benefit from the granting of Intellectual Property Rights to the traditional tie-and-dye fabric, which has seen falling demand due to competition from cheaper fabrics copying from the design.

4.5.4. *Chanderi Fabric*

Chanderi, a small town located closes to river Betwa in Guna District of Madhya Pradesh, is famous for the unique silk fabric produced there. A staggering 60% of the population of 30,000 has been involved in manufacturing and trading of this fabric of centuries. Chanderi fabric is known for its sheer texture, light weight and transparency. Typically worked and fringed heavily with handmade gold dots or motifs of golden thread, the sarees have been patronised by royalty.

There are a little over 3600 adequately skilled weaver families working in Chanderi. Typically, family members are engaged in different functions like warping, coloring and weaving. The introduction of the power loom and

machines in other parts of the country has led to the production of similar looking but obviously spurious Chanderi.

Chanderi fabric has an enormous export potential. But the way the production and supply chain is managed is totally unprofessional and utterly unorganised. No labeling, product specification or customised packing methods are employed. Chanderi silk has applied for GIs protection, but due to procedural infirmities, the application has been rejected. Now Chanderi Development Foundation funded by United Nations Industrial Development Organisation to protect Chanderi silks and tries to get GIs protection.

Chapter V

Conclusion

Geographical Indications (GIs) are an important component of TRIPs, in comparison to other Intellectual Property Rights (IPRs), it is a recent origin. GIs denote the geographic origin of goods with specific qualities, reputations and other characteristics that are essentially attributable to the special natural conditions of those origins. It plays an increasingly important role in the course of trade in goods. Many GIs have acquired valuable reputation which if not adequately authorized, will lead to their false use, detrimental to consumers and legitimate producers. Illegitimate production of geographically indicated products causes damages to the consumers and producers as they are deceived by the same. Therefore, the protection of GIs is always of significance, and deserves to be protected.

The study of the negotiating history shows that, during the early stages of negotiations, the developing countries failed to recognize the importance of GI protection to defend their cultural, technical and traditional patrimony as well as the contribution of GIs for the development of economies. It is also vivid that the TRIPs Agreement, during the time of its adoption represented the particular interests of US and wine producing countries of Europe; that were successful in according special protection to wines and spirits mostly originating in their countries. Section 3 part 2 (article 22 to 24of the TRIPs Agreement) deals with the GI protection. The legal protection for GIs is needed basically for two reasons; (i) protection against deceptive/misleading use of an indication; (ii0 protection against the use of indication that are acts of Unfair Competition. The analysis of this section shows that the grand of the GI protection under TRIPs is conditional on three factors, *via,* (i) quality of the product, (ii) indication, and (iii) reputation or characteristics. But it is pertinent to note that the subject matter definition given in Article 22.1 does not distinguish between goods based on different sectors (agricultural industry) or production time (manufactured or handicraft) and therefore provides minimum scope of protection.

But the study of the subsequent section (Section 23) shows that the TRIPs Agreement provides for a stronger protection to wines and spirits, which highlights the political bargain struck between the US and EU during the last stages of the Uruguay Round negotiations, thus catering to their economic interests. They study further extrapolates the significance of the legal protection of

GIs to developing countries, most of which has strong traditional background and experience in the use of GIs. But the main difference with the developed countries is that, in developing countries the GIs are related to agricultural products, and the current level of protection accorded to the agricultural products established under TRIPs Article 22 is insufficient. Therefore, the contention of the developing countries for stronger additional protection to products other than wines and spirits is decidedly a justifiable claim for the economic development of these countries. It was asserted that the Doha Round of trade negotiations was successful one in this regard, since it approved the agenda of extension of the additional protection to the products other than wines and spirits.

It could be inferred from this study that the agenda of 'extension' is a contested subject matter. The contention of those countries who are supporting the 'extension' are that the GIs protection is an industrial property measure, which makes it possible to protect all products that are distinguished by the quality, reputation or other characteristics, which are essentially attributed to their geographical origin.

The countries opposing the extension of GI maintains that there is no mandate in any of the existing TRIPs Agreement, which may form the legal basis for negotiating such an 'extension,' they asserted that the 'extension' would involve certain costs and shifts in burdens among Members, which in turn will enhance the risk of WTO disputes.

It is submitted that the argument that the scope of Article 23.1 cannot be varied, modified or extended, is not justifiable because it is apparent that Article 23 accords a special status to wines and spirits thus proving to be discriminatory. This is against the principles of equality, detrimental to the interest of one of more parties of the agreement, therefore needs to be reviewed. Further, denial of the additional protection to other products on the ground that there is no mandate itself would not only run counter to just and equitable principle but would also be against the rule of law.

The study has also analysed India's stand on this issue which is supported by the European Communities, Switzerland and neighbouring countries such as Sri Lanka, Pakistan and other like minded countries (informally known as the Friends of GIs), have taken the stand before the TRIPS council that there are today no economic or systemic reasons for protecting GIs for certain products

differently from others. Therefore, it could be argued that, in this dynamic world of globalization and harmonization of IP rights and economies, uniform standards of protection of GIs are strongly called for to foster and nurture an equitable world trade order. The inexplicable discrimination against GIs for products other than wines and spirits, if not rectified, will lead developing countries to conclude that the TRIPs Agreement is just eyewash. On a larger frame, the TRIPS council should also examine the difficulties faced by member states in enforcing GI rights internationally because of the dual jurisprudential systems and the lack of a uniform mode of protection for GIs, in the case of Additional Protection granted to other products. Thus, it can be seen that discrimination between the developed and developing countries under the TRIPS introduces an element of inequity and imbalance in the world trade order, which is not acceptable. This discrimination calls for either country specific WTO dispute settlement action or the negotiating proposals like we are doing today for amendment of Art. 23 of TRIPS, would ensure an absolute level of protection and a uniform practicable legal regime for all GIs (not wines and spirits alone).

To achieve the aim of extension, Article 24.1 can be effectively used and this Article requires Members to enter into negotiations aimed at increased protection for individual GIs under Article 23. Articles 24.1 and 23.4 have been interpreted as the legal basis for raising the level of protection and extending the protection of wines and spirits. Article 23.4 of the TRIPs Agreement provides that, in order to facilitate the GI protection of wines, negotiations shall be undertaken to establish a multilateral system of notification and registration of GIs for wines eligible for protection in those Member countries participating in such a system.

As regards to multilateral registration, there are divergent proposals from the Member countries starting from full registration system to voluntary registration. There are some discussions about the possible legal effects of the Register. Developed countries argue that the effects would be *erga omnes* because the mandate is restricted to wines only. On the other hand, the majority of developing countries except Mexico (tequila) along with few others do not agree to join in such a system since wine production is mostly concentrated in certain European and Eastern European countries, the U.S., Chile and Australia.

Nevertheless, the extension of the multilateral system to other products is essential for many developing countries. Hence, the developing countries presented a document in which they confirmed the legal arguments in favour of an extension to other products and proposed a 'basket approach.' As has been rightly pointed out by several scholars in this field, the possible benefits from such a multilateral system are manifold. To consolidate the benefits they suggested that action should be needed at two levels, national and international level. At national level, it is necessary to:

a. Gather information and prepare national inventories of products which could be protected by GIs;
b. Initiate educational processes with private industry and traditional producers on the legal structure, benefits and registration procedures of GIs;
c. Initiate processes of *ex officio* registrations in areas where the producers are widely dispersed or not well organised;
d. Prepare, set up and implement technical norms that would guarantee the quality of specific products;
e. Analyse the international market possibilities of national products protected by GIs, and study tariff lines, sanitary and phytosanitary measures, technical standards, etc;
f. Use the information of technology in the promotion of products protected by GIs;
g. Co-ordinate the actions of agricultural and the IP authorities in order to promote the national registration of foodstuff GIs.

At the international level it is imperative to;

a. Keep a comprehensive approach to the results of GI negotiations in the WTO.
b. Prepare a list of GIs which are currently protected in the developing countries;
c. Describe national experiences with other products in the council for TRIPs,
d. Request technical co-operation from those developed countries interested in the establishment of a multilateral register system.

GIs and Traditional Knowledge are similar in various facets. Traditional Knowledge are used to enhance the commercial value of natural, traditional and craft products of all kinds if their particular characteristics may be attributed to their geographical origin. A number of products that come from various regions are the result of traditional processes and knowledge implemented by one or more communities in a given region. The special characteristics of those products are appreciated by the public, and may be symbolized by the indication of source used to identify the products. Better exploitation and promotion of GIs would make it possible to afford better protection for the economic interests of the communities with traditional knowledge. So it can be checked through proper legal mechanism.

The other important concern over GIs for developing countries is, how far it will protect the food items (agricultural) and handicrafts etc. Since majority of the developing countries are rich in agricultural products and cultural traditions, the increased protection of individual GIs under Article 23, could be negotiated within Article 24.1 of the Agreement.

Some scholars argue that (Echols A. Marsha, Judson O. Berkey) GIs are a means to promote the rural communities. Though there is no specific mention about the rural areas in any of the WTO multilateral agreements, GIs had a close relationship with the rural development. The study finds that GIs can create and support local jobs and encourage diversification and originality in production. GIs allow producers to dedicate themselves to the marketing of typical products that meet the demands of consumers, in terms of origin and quality. Moreover, GIs contribute to the preservation of environment, natural resources as well as protection of a culinary, artisan, cultural and often ancestral heritage.

This study also reveals some interesting details regarding the usage of GIs in India. Prior to the TRIPs Agreement, the GIs have been protected through the Common Law principles of Passing-off and Unfair Competition. The Indian Courts have interpreted the said principles in various decisions and thereby afforded adequate protection to GIs from infringement even without any legislation. Infact, the 'Basmati' Case awakened the Indian side to legislate a new law for GIs in tune with the TRIPs Agreement. The case studies of 'Basmati' and 'Darjeeling' had shown the adverse effect on the economy due to non-granting of additional protection to products other than wines and spirits under Article 23.

In compliance with the TRIPs obligations as mentioned in the above paragraph India has enacted The Geographical Indications of Goods (Registration and Protection) Act, 1999 and it came into force in 2003. India seeks to provide for the registration and better protection of GIs relating to goods in India. The Act is administered by the Controller General of Patents, Designs and Trademarks who is the Registrar of GIs. The tenure of protection is initially for ten years which could be renewed from time to time. The salient features of this legislation include definition of several important terms like 'geographical indication', 'goods', 'producers', 'authorised user' etc. The Act also has provisions for the maintenance of a Register of GIs in two parts-Part A and Part B-and use of computers etc, for maintenance of such Register. It also contains both Criminal and Civil enforcement provisions.

The definition of 'goods' in the Act is restrictive and refers to 'agricultural, natural or manufactured goods or any goods of handicraft or of industry and includes foodstuff. While the TRIPs Agreement refer to 'goods', Indian Act has classified the goods. In India GIs can be registered by any association of persons or producers or any organization or authority established by or under any law for the time being in force representing the interests of the producers of the concerned goods, who are desirous of registering a GI in relation to such goods can apply for registration. The period of registration under the Act is ten years. The registration of an authorized user shall be a period of ten years. The registration of GIs are prohibited if they are i) likely to deceive or cause confusion, ii) the use of which would be contrary to any law for the time being in force, iii) if it comprises any scandalous or obscene matter and iv) which comprises or to hurt the religious susceptibilities of any class or citizens of India or it would be disentitled to protection in a court of law. The penalty for applying false GIs has been made the same as under The Trademarks Act, 1999. The punishment would be imprisonment for not less than six months and extendable to three years.

On an analysis of the Act, it shows that it as a piece of legislation it depicts India's socio-economic necessities. Infact it has made optimal use of the flexibility inherent in the TRIPs and the Agreement is moulded under the guise of 'higher standards'. This is reflected in the definition of GIs, which allows a wide variety of goods to be brought under the regime, including handicrafts and

agricultural products. Similarly on the issue on additional protection, the Act, in complying with TRIPs regime, has at the same time left the window open for inclusion of products other than wines and spirits. The main criticism of the Act is that it gives importance to procedural matters rather to substantive issues. The term used in the Act which pertains to authorised user, regarding the issue of migration, the tenure period of ten years has also been subject to criticism. Apart from this, the Government has established a GIs Registry to receive and process applications. So far, ten GIs have been registered in the Registry. The list of details has been mentioned in the study. No dispute has arisen so far on the protection of GIs before the Registry.

Appendix

Provisions on GIs under TRIPs

Section 3: geographical indications

Article 22

Protection of geographical indications

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 106bis of the Paris Convention (1967).

3 A Member shall, ex officio if its legislation so permits or at the request of an interested party, refuse or invalidate the registration to 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 23

Additional protection for geographical indications/or wines and spirits

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 m 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.

Article 24

International negotiations: exceptions

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 witting t0 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 10 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 dale 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 lo 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.

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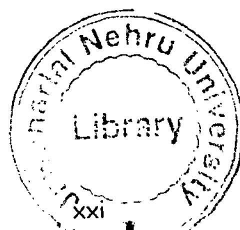
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