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TRIPS AGREEMENT: TOWARDS A BETTER PROTECTION FOR GEOGRAPHICAL INDICATIONS?

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I. INTRODUCTION

Geographical Indications (GIs) are intellectual property rights.² Like trademarks or commercial names, GIs are distinctive signs which permit the identification of products on the market. They do not, however, protect products or production methods as such, but, rather, confer to all producers from a given geographical area the exclusive right to use a distinctive sign to identify their products if they possess a given quality, reputation, or other characteristic attributable to their geographical origins.³

Prior to the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS or the TRIPS Agreement), source indications with geographical significance comprised two categories: appellations of origin and indications of source. Appella-

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2. Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, LEGAL INSTRUMENTS – RESULTS OF THE URUGUAY ROUND, art. 1.2, 33 I.L.M. 81 (1994) [hereinafter TRIPS] (“For the purposes of this Agreement, the term ‘intellectual property’ refers to all categories of intellectual property that are the subject of Sections 1 through 7 of Part II.”). Section 3 of TRIPS refers to Geographical Indications. TRIPS came into force in 1995, and had effect in developed countries – including the United States – as of January 1, 1996. Developing countries, however, had until January 1, 2000 to comply with the TRIPS standards with respect to GIs and the least-developed countries have until January 1, 2006 to comply.

3. Historically, GIs have been given various definitions, but TRIPS defines them as, “indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.” *Id.* art. 22.1.

tions of origin signify not only the geographical region from which products originate but also specific features of the products which result from the natural and human factors in their particular locale.⁴ Indications of source merely state where the product was made.⁵ The TRIPS Agreement created a single category for such indications, GIs, which is broader than indications of source, but does not incorporate the natural and human factors of appellations of origin.⁶ For purposes of this discussion, the TRIPS definition of GIs is the most relevant. GIs are instruments designed to protect a product's reputation⁷ and differ from patents and copyrights in that they are not specifically designed to reward innovation.⁸ Rather, they reward producers situated in a certain region who follow production practices and customs associated with that region.⁹ GIs reward goodwill and reputation created or built up by a group of producers over

4. See Daniel Hangard, *Protection of Trademarks and Geographical Indications in France and in the European Union*, WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO) SYMPOSIUM ON THE INTERNATIONAL PROTECTION OF GEOGRAPHICAL INDICATIONS: MELBOURNE, APRIL 5–6, 1995, 65, 67 (1995) [hereinafter Symposium 1995]; Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, Oct. 31, 1958, 923 U.N.T.S. 205, reprinted in 3 STEPHEN P. LADAS, PATENTS, TRADEMARKS AND RELATED RIGHTS: NATIONAL AND INTERNATIONAL PROTECTION, 1954 (1975), available at <http://www.wipo.int/clea/docs/en/wo/wo012en.htm> (last visited Aug. 25, 2004) [hereinafter Lisbon Agreement].

5. See F. Addor & A. Grazioli, *Geographical Indications Beyond Wines and Spirits – A Roadmap for a Better Protection for Geographical Indications in the WTO TRIPS Agreement*, 5 J. OF WORLD INTEL. PROP. 865, 867 (2002) (defining an indication as, “any expression or sign used to indicate that a product or a service originates in a country, region, or a specific place without any element of quality or reputation”).

6. See TRIPS, *supra* note 2, art. 22.1 (“Geographical indicators are, for 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.”).

7. See *id.* art. 22.2.

8. A patent for an invention is the grant of a property right to the inventor, issued by the Patent Office. *Id.* art. 27. A copyright is the legal right granted to an artist, author, computer user, musician, playwright, publisher, or distributor to exclusive publication, production, sale, or distribution of a literary, musical, dramatic, or artistic work. *Id.* art. 9.

9. TRIPS, *supra* note 2, art. 22.1.

many years and, in this sense, operate to maintain traditional knowledge and practices.¹⁰

GIs benefit consumers by providing reliable information and assurances of authenticity¹¹ and, if used in a proper, well-protected way, can become effective marketing tools of great economic value.¹² Indeed, GIs convey the cultural identity of nations and regions and make it possible to add value to a country's natural riches and to its population's skills.¹³ In order for these benefits to become a reality, it is necessary to protect GIs at the international level.

Historically, GIs have received little international protection. Before 1994, the protection of GIs in international fora was limited to three international instruments under the auspices of the World Intellectual Property Organization (WIPO): the Paris Convention;¹⁴ the Madrid Agreement,¹⁵ and the Lisbon Agreement.¹⁶ The Paris Convention is a widely-recognized international agreement, while the other two suffer from limited membership.¹⁷ It was during the Uruguay Round¹⁸ that trade in in-

10. An example of traditional knowledge is the Turmeric (*Curcuma longa*), a plant in the ginger family yielding saffron-coloured rhizomes used as a spice for flavouring Indian cooking. It also has properties that make it an effective ingredient in medicines and cosmetics and as a color dye. As a medicine, it is traditionally used to heal wounds and rashes. See Shubha Ghosh, *Globalization, Patents, and Traditional Knowledge*, 17 COLUM. J. ASIAN L. 73, 93–94 (2003).

11. See Paul J. Heald, *Trademarks and Geographical Indications: Exploring the Contours of the TRIPS Agreement*, 29 VAND. J. TRANSNAT'L L. 635, 655 (1996).

12. See Michael Maher, *On Vino Veritas? Clarifying the Use of Geographic References on American Wine Labels*, 89 CAL. L. REV. 1881, 1885–86 (2001).

13. Lori E. Simon, *Appellations of Origin: The Continuing Controversy*, 5 NW. J. INT'L. L. & BUS. 132, 132 (1983).

14. Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, 21 U.S.T. 1583, 828 U.N.T.S. 305, available at <http://www.wipo.int/clea/docs/en/wo/wo020en.htm> (last visited Aug. 25, 2004) [hereinafter Paris Convention].

15. Madrid Agreement for the Repression of False and Deceptive Indications of Source, Apr. 14, 1891, 828 U.N.T.S. 168, available at <http://www.wipo.int/clea/docs/en/wo/wo032en.htm> (last visited Aug. 25, 2004) [hereinafter Madrid Agreement].

16. Lisbon Agreement, *supra* note 4.

17. As of September 24, 2004, only thirty-four States are members of the Madrid Agreement. A list of those Members is published on the WIPO website, at <http://www.wipo.int/treaties/en/documents/word/f-mdrd-o.doc> (last

tangibles was included, for the first time, in multilateral trade negotiations, resulting in, among others, the TRIPS Agreement, which technically is Annex C of the treaty that created the World Trade Organization (WTO). TRIPS covers a broad range of intellectual property rights¹⁹ and regulates the availability, scope, and use of these intangible assets.²⁰ The inclusion of GIs caused heated debates during the Uruguay Round and continues to generate discussion between the new and old world.²¹ Like many aspects of the Uruguay Round negotiations, the disagreement among Members impeded the creation of a complete system for the international protection of GIs.

Regrettably, compared to other intellectual property rights, protection of GIs at the international level remains inadequate. In addition to the legal uncertainty that TRIPS provisions continue to generate, many countries feel that the current level of protection provided for GIs fails to prevent free-riding on the reputation of genuine GIs.²² WTO Negotiators in the Uruguay

visited Oct. 19, 2004). As of October 4, 2004, only twenty-two States are members of the Lisbon Agreement. A list of the Members of the Lisbon Agreement is published on the WIPO website, at <http://www.wipo.int/treaties/en/documents/pdf/j-lisbon.pdf> (last visited Oct. 19, 2004).

18. The World Trade Organization is the outcome of a "negotiating" process – the Uruguay Round of Multilateral Trade Negotiations – launched by Ministers of GATT Members, who met at a Special Session of the GATT Contracting Parties at Punta del Este, Uruguay, in September 1986. The negotiations and process ended with the signing of the Final Act of the Marrakesh Agreement in April 1994 at Marrakesh, Morocco.

19. See TRIPS, *supra* note 2 (the intellectual property rights covered by the TRIPS Agreement are Copyright and Related Rights, Trademarks, Industrial Designs, Patents, Layout-Designs (Topographies) of Integrated Circuits, Protection of Undisclosed Information, and Control of Anti-Competitive Practices in Contractual Licenses).

20. See *id.* arts. 22, 63.

21. See Jorg Reinbothe & Anthony Howard, *The State of Play in the Negotiations on TRIPS (GATT/Uruguay Round)*, 13 EUR. INTELL. PROP. REV. 157, 161 (1991). On the one hand, some European countries, representing the old world, have a long tradition of protecting this type of intellectual property. On the other hand, the United States, Canada, Australia, and New Zealand, among others, representing the new world, have not historically had separate laws to protect GIs, apart from their respective systems of trademarks.

22. See WTO Council for TRIPS, *Communication from Bulgaria, Cuba, Cyprus, the Czech Republic, the European Communities and their Member States, Georgia, Hungary, Iceland, India, Kenya, Liechtenstein, Malta, Mauritius, Pakistan, Romania, the Slovak Republic, Slovenia, Sri Lanka, Switzer-*

Round were conscious of these deficiencies and, thus, mandated ongoing negotiations to continue the commitment toward improving intellectual property rights.²³ One of these areas is negotiations concerning the establishment of a multilateral system of GI notification and registration.²⁴ These negotiations began in 1995 and have yet to produce any real results. While some countries are in favor of granting further GI protection, others wish to maintain the status quo.

The purpose of this Article is, first, to describe how the WTO strives to secure effective protection for GIs, and, second, to explore the prospects for further development based upon these ongoing negotiations. In order to accomplish these objectives, the Article must first review the international protection of GIs prior to and under the TRIPS Agreement, followed by reviews and critiques of the various proposals for a multilateral system of registration set forth during negotiations. Next, the Article considers the appropriateness of expanding the system to establish additional protection for products other than wines and spirits. The Article then concludes by arguing in favor of further GI protection and for WTO Members to shoulder their responsibility by providing greater protection for GIs. Doing so ensures that TRIPS remains an effective multinational treaty and sets an example for compliance by other Members. This compliance would be particularly helpful for developing countries which are becoming aware that products identified with their country, or a given region within their country, can contribute mightily to their economic development.

II. INTERNATIONAL PROTECTION OF GEOGRAPHICAL INDICATIONS PRIOR TO THE TRIPS AGREEMENT

As stated in Section I, prior to the TRIPS Agreement, the Paris Convention,²⁵ Madrid Agreement,²⁶ and Lisbon Agree-

land, Thailand and Turkey, IP/C/W/353 (June 24, 2002) (Doc #02-3484), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple.

23. See TRIPS, *supra* note 2, arts. 23.4, 24.1, 24.2. See also Frederick M. Abbott, *TRIPS in Seattle: The Not-So-Surprising Failure and the Future of the TRIPS Agenda*, 18 BERKELEY J. INT'L L. 165, 166 (2000) (citing negotiation for GI protections as a "Built-In Agenda" item that remains before the TRIPS Council).

24. See TRIPS, *supra* note 2, art. 23.4.

25. Paris Convention, *supra* note 14.

ment²⁷ were the only noteworthy international treaties which provided GI protection. Unfortunately, the Paris Convention suffered from vagueness in terms of GIs, while the Madrid and Lisbon Agreements suffered from limited memberships.

A. *The Paris Convention*

Undoubtedly, the Paris Convention became the most important treaty adopted in the late nineteenth century because it influenced intellectual property laws adopted by many countries throughout the twentieth century.²⁸ This treaty was the first multilateral agreement to provide protection for GIs, although it was rather general and weak when compared to the protections afforded by the TRIPS Agreement.²⁹

The Paris Convention's large number of Member States agreed mainly to border measures for false indications without defining the conditions for protection.³⁰ Under the Paris Con-

26. Madrid Agreement, *supra* note 15.

27. Lisbon Agreement, *supra* note 4.

28. The Paris Convention was agreed to in 1883 and was complemented by the Madrid Protocol of 1891. It was further revised in Brussels (1900), Washington (1911), The Hague (1925), London (1934), Lisbon (1958), Stockholm (1967), and amended in 1979. The Paris Convention, as of August 25, 2004, had 168 signatory states. The complete list of signatory countries, as of July 15, 2004 is available at <http://www.wipo.int/treaties/en/documents/pdf/d-paris.pdf> (last visited Aug. 25, 2004). Up to the last decade, the history of the Paris Convention has been the history of international harmonization of industrial property laws and procedures. The 1883 Paris Convention laid the foundation for this movement. See Friedrich-Karl Beier, *One Hundred Years of International Cooperation – The Role of the Paris Convention in the Past, Present and Future*, 15 INT'L REV. OF INDUS. PROP. AND COPYRIGHT L. 1 (1984) (stating that “[t]he Paris Convention became the basic instrument for the protection of inventions, industrial designs trademarks and trade names, and for the protection against unfair competition on a worldwide level”). Typical for the time, the movement for extension and harmonization of the regimes for the protection of industrial property had its origins in industrialized Europe. The accession to the Convention by other countries shows how quickly the ideals of the Convention spread eastward.

29. See generally JOSÉ MANUEL CORTÉS MARTÍN, *LA PROTECCIÓN DE LAS INDICACIONES GEOGRÁFICAS EN EL COMERCIO INTERNACIONAL E INTRACOMUNITARIO*, 125–30 (2003).

30. See Albrecht Conrad, *The Protection of Geographical Indications in the TRIPS Agreement*, 86 TRADEMARK REP. 11, 28 (1996) (stating that the Paris Convention has more than a hundred members, but does not contain substantial provisions for the protection of GIs).

vention, Members must seize or prohibit imports with false indications of source, producer, manufacturer, or merchant.³¹ In its original form, Members acted only in cases of serious fraud.³² Article 10 of the Paris Convention mandates the seizure of goods in cases of “direct or indirect use of a false indication of the [source of the good or the] identity of the producer, manufacturer or merchant....”³³ In 1958, Article 10*bis*(3) was added to prohibit indications that were “liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity of the goods.”³⁴ Significantly, the word “characteristics” replaced the phrase “the origin.”³⁵ This provision serves as the basis for protection against misleading GIs. However, the Paris Convention fails to provide any remedies in case of infringement of this provision.

B. The Madrid Agreement

The Madrid Agreement provides specific rules for the repression of false and deceptive indications of source, thus exceeding the level of protection given to GIs by the Paris Convention.³⁶ Members having signed this agreement agree mainly to implement border measures and prevent the dilution of GIs into generic terms.³⁷

31. Paris Convention, *supra* note 14, arts. 9, 10.

32. See Louis C. Lenzen, *Bacchus in the Hinterlands: A Study of Denominations of Origin in French and American Wine Labeling Laws*, 58 TRADEMARK REP. 145, 184 (1968).

33. Paris Convention, *supra* note 14, art. 10.

34. *Id.* art. 10*bis*.

35. In the Lisbon Conference, the Austrian Delegation proposed to reform Art. 10*bis* of the Paris Convention, including the word “origin,” so that GIs were protected by this disposition. However, the firm opposition of the United States prevented this reform. See STEPHEN P. LADAS, 3 PATENTS, TRADEMARKS AND RELATED RIGHTS: NATIONAL AND INTERNATIONAL PROTECTION 1579 (1975).

36. Madrid Agreement, *supra* note 15, art. 1(1) (“All goods bearing a false or deceptive indication by which one of the countries to which this Agreement applies, or a place situated therein, is directly or indirectly indicated as being the country or place of origin shall be seized on importation into any of the said countries.”).

37. Over time, some product names on product labels have become generic and are used regardless of place of origin. See Council Regulation on the Protection of Geographical Indication and Designations of Origin for Agricultural Products and Foodstuffs (EEC) N. 2081/92 (July 14, 1992), art. 3, *reprinted in* 208 EUR. COMMUNITY OFFICIAL J. 1 (defining generic terms as “the name of an

The Madrid Agreement was amended in 1934 by adding Article 3*bis*, which prohibits the use of false representations on the product itself and in advertising or other forms of public announcements.³⁸ In addition to providing more specific protection, the Madrid Agreement included controversial areas of protection, most significantly Article 4, which prohibits Members from treating GIs of wines as generic terms.³⁹ However, few states signed the Madrid Agreement due largely to its expansive view of GI protection; several Paris Convention Members preferred to enter into bilateral agreements with the purpose of protecting GIs internationally.⁴⁰ Due to its weak support, the impact of the Madrid Agreement has been minimal.

agricultural product or a foodstuff which, although it relates to the place or the region where this product or foodstuff was originally produced or marketed, has become the common name of an agricultural product or a foodstuff"), available at <http://www.europa.eu.int>.

38. Madrid Agreement, *supra* note 15, art. 3*bis* ("The countries to which this Agreement applies also undertake to prohibit the use, in connection with the sale or display or offering for sale of any goods, of all indications in the nature of publicity capable of deceiving the public as to the source of the goods, and appearing on signs, advertisements, invoices, wine lists, business letters or papers, or any other commercial communication.").

39. *Id.* art. 4.

40. Bilateral and plurilateral (including regional) agreements may also serve the purpose of protecting GIs internationally. A number of countries have already entered into these types of agreements. These agreements can adopt the form of a specific treaty referring only to GIs by listing them, such as the agreement adopted by Germany and France in 1960 for the protection of indications of source, appellations of origin, and other geographical indications. This became the model for numerous bilateral agreements signed by European countries. See Roland Knaak, *The Protection of Geographical Indications According to the TRIPs Agreement*, 18 IIC STUDIES, STUDIES IN INDUSTRIAL PROPERTY AND COPYRIGHT LAW, FROM GATT TO TRIPS – THE AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS 117, 122–23 (Friedrich-Karl Beier & Gerhard Schricker eds., 1996) (discussing bilateral agreements on indications of source). Regional and bilateral agreements in force which provide protection to GIs have been submitted to the Council for TRIPS according to Article 4(d) of the TRIPS Agreement. See WTO Council for TRIPS, Note by the Secretariat, *Overview of Existing International Notification and Registration Systems for Geographical Indications Relating to Products other than Wines and Spirits*, IP/C/W/85/Add.1 (July 2, 1999) (Doc. # 99-2747), paras. 4–5, available at http://docsonline.wto.org/gen_search.asp?searchmode=simple.

C. The Lisbon Agreement

The Lisbon Agreement was enacted in 1958 as an attempt to achieve effective and enforceable protection for appellations of origin.⁴¹ It provided for strict protection through an international registration system⁴² and was modeled after the registration system for trademarks devised under the Madrid Agreement Concerning the International Registration of Marks.⁴³ Signatories of the Lisbon Agreement were emphasizing that the protection of appellations of origins should be as comprehensive as those for trademarks. The main feature of the Lisbon Agreement is that appellations of origin are to be recognized and protected as such, both in the country of origin and registered at an agency of the WIPO.⁴⁴ Article 1 states that once an appellation of origin is registered, it is to be protected in other Member countries.⁴⁵ According to Article 3, the Members must prohibit imitations under their respective domestic laws, including the use of terms as “like,” “type,” or “style,” which may be used along with the indication.⁴⁶ Article 6 provides that no appellation of origin can be considered generic in any other Member country, so long as it is protected in the country of origin.⁴⁷ However, such strict protection would require a change of national laws for many non-Member countries.⁴⁸ Because of its strict protection and lack of flexibility, the Lisbon Agreement has few signatories.⁴⁹

41. Lisbon Agreement, *supra* note 4.

42. *Id.* art. 5.

43. Madrid Agreement Concerning the International Registration of Marks, Apr. 14, 1891, 828 U.N.T.S. 389. This Agreement was revised in Brussels (Dec. 14, 1900), Washington, D.C. (June 2, 1911), The Hague (Nov. 6, 1925), London (June 2, 1934), Nice (June 15, 1957), Stockholm (July 14, 1967), and amended one final time (Sept. 28, 1979).

44. Lisbon Agreement, *supra* note 4, art. 5.

45. *Id.* art. 1.

46. *Id.* art. 3.

47. *Id.* art. 6.

48. Conrad, *supra* note 30, at 26 (citing this as one of various reasons more countries did not sign onto the Agreement).

49. *Id.* at 23 (noting that despite a high standard of protection for GIs, the Lisbon Agreement was one of the models used for drafting the TRIPS provisions).

III. PROTECTION OF GEOGRAPHICAL INDICATIONS UNDER THE TRIPS AGREEMENT

A. *GIs Continue to Be a Source of Controversy in TRIPS Negotiations*

The treaties signed under the WIPO incur similar difficulties: either the scope of protection remains undefined and effective protection depends upon the good will of each Member country, or the agreement requires a standard of uniformity that is simply non-existent. The three previously-mentioned agreements exemplify how difficult it has been to strike a balance on the appropriate level of GI protection which would find support by a broad consensus of the international community. Nevertheless, these agreements set the stage for the more successful TRIPS Agreement. The Uruguay Rounds of the General Agreement on Tariffs and Trade (GATT)⁵⁰ provided the opportunity to include GIs in an international agreement that would guarantee protection. TRIPS is a monumental step forward in the area of GIs in that, with more than 147 signatories, it is the first widely-accepted international treaty in which all signatories are bound to protect GIs through substantive provisions and to enforce its application according to minimum standards.⁵¹ It also provides for a strong dispute settlement mechanism under the WTO.⁵² Additionally, TRIPS provides for periodic review⁵³ and renegotiations aimed at increasing GI protection.⁵⁴

50. GATT was first signed in 1947. Wesley A. Cann, Jr., *Creating Standards and Accountability for the Use of the WTO Security Exception: Reducing the Role of Power-Based Relations and Establishing a New Balance Between Sovereignty and Multilateralism*, 26 YALE J. INT'L L. 413, 414 (2001). The agreement was designed to provide an international forum that encouraged free trade between member states by regulating and reducing tariffs on traded goods and by providing a common mechanism for resolving trade disputes. *Id.* at 418.

51. See TRIPS, *supra* note 2, art. 1 ("Members shall give effect to the provisions of this Agreement. Members may, but shall not be obligated to, implement in their domestic law more extensive protections than is required by this Agreement, provided that such protection does not contravene the provisions of this Agreement.").

52. *Id.* art. 64.

53. *Id.* art. 71.

54. *Id.* art. 23.

One of the features of the TRIPS Agreement at the time of its adoption was that not all categories of intellectual property rights regulated therein had the same degree of legal or doctrinal development nor the same degree of acceptance among countries.⁵⁵ In the case of GIs, the appropriate legal treatment and level of protection continued to be fiercely debated between WTO Members.⁵⁶ The debate over GI protection did not follow the usual North-South divide;⁵⁷ instead, the dispute creates a dichotomy of states, with “emigrant” nations on one side and “immigrant” nations on the other.⁵⁸ The “emigrant nations” –

55. As previously discussed, prior to the TRIPS Agreement some international treaties, such as the Paris Convention, the Madrid Agreement, and the Lisbon Agreement, contained provisions on the protection of indications of source and appellations of origin. Even though they contained strong provisions for the protection of appellations of origin, their practical results were meager. This is because the Paris Convention included only a general provision on this matter, and because the Madrid and Lisbon Agreements had limited membership. See discussion, *supra* Parts II.A–C.

56. See Reinbothe & Howard, *supra* note 21, at 158; see also Leigh Ann Lindquist, *Champagne or Champagne? An Examination of U.S. Failure to Comply with the Geographical Provisions of the TRIPs Agreement*, 27 GA. J. INT'L & COMP. L., 309, 311–12 (1999) (“The inclusion of these [protections of geographical indications of source] caused heated debates during the Uruguay GATT Rounds and continues to generate discussion. The article that causes most debate is Article 23 which deals with the protection of [GIs] for wines and spirits.”).

57. Traditionally, developed and developing countries have tended to be in opposite groups in the GATT-WTO system. With some limited exceptions, this trend of opposition in North-South politics continues today. Developing countries have organized themselves into alliances such as the African Group and the Least-Developed Countries Group. But, in other issues, the developing countries do not share common interests and may find themselves on opposite sides of a negotiation. A number of different coalitions among different groups of developing countries have emerged for this reason. The differences can be found in subjects of immense importance to developing countries, such as agriculture. See WTO, *Understanding the WTO: Developing Countries. Some Issues Raised*, at http://www.wto.org/english/thewto_e/whatis_e/tif_e/dev4_e.htm (last visited Oct. 18, 2004).

58. “Emigrant” countries include those in Europe, Africa and parts of Asia, whereas “immigrant” countries include the United States, Australia, and Latin American countries. Especially for European countries, GIs have a long and proud tradition. Since antiquity, their existence has served to distinguish products and to indicate source, serving a similar function to that of present-day trademarks. See Dr. A. Grigoriev, Opening Remarks, *Symposium on the International Protection of Geographical Indications*, Nov. 9–10, 1989, cited in M.G. Coerper, *The Protection of Geographical Indications in the United States*

the European Union, Switzerland and former Eastern bloc countries and a selection of developing nations – support extensive GI protection, while countries like Australia, New Zealand and the United States ally with Latin American nations and other “immigrant” nations to oppose GI protection.⁵⁹

During negotiations, GI protection was a very sensitive issue. Only at the very end of the Uruguay Round was an agreement concerning GIs reached, and this was largely due to the parties’ ability to link GIs with the agricultural negotiations taking place at the time. Although the issue of intellectual property was included in the Uruguay Round at the very beginning,⁶⁰ early proposals were initially tabled by negotiators. In effect, the first texts presented during the Uruguay Round negotiations came to light almost a year after the Montreal Midterm Review of the negotiation process in 1988.⁶¹

B. Protection Granted to Geographical Indications under Section 3 of the TRIPS Agreement

According to the TRIPS Agreement, GIs are subject to the same general principles applicable to all categories of intellec-

of America, with Particular Reference to Certification Marks, 29 INDUS. PROP. 232, n.1 (1990).

59. See Addor & Grazioli, *supra* note 5, at 883 (affirming that the suitable protection of GIs has never been a conflict of interests between developed and developing countries, but between the countries of the old world and the new world); see also Reinbothe & Howard, *supra* note 21, at 158.

60. The United States and Japan submitted proposals to the Uruguay Round’s Preparatory Committee covering all intellectual property rights and their enforcement. This led to long negotiations in an attempt to reconcile differing proposals, but they ultimately failed to reach consensus. Ultimately, co-chairs Switzerland and Colombia tried to reconcile all the proposals sent to the Preparatory Committee. The Swiss-Columbian majority text served as the basis for the Ministerial Conference and in its list of “subjects for negotiations,” Ministers included the item “trade-related aspects of intellectual property rights, including trade in counterfeit goods.” DANIEL GERVAIS, *THE TRIPS AGREEMENT: DRAFTING HISTORY AND ANALYSIS* 10–11 (2d ed. 2003).

61. The proposals were presented by the European Communities, the United States, Switzerland, Japan, and a group of developing countries consisting of Argentina, Brazil, Chile, China, Colombia, Cuba, Egypt, India, Nigeria, Peru, Tanzania, and Uruguay. See, e.g., WTO Negotiating Group on TRIPS, *Draft Agreement on Trade-Related Aspects of Intellectual Property Rights*, presented by the European Communities, MTN.GNG/NG11/W/68 (Mar. 29, 1990) (Doc #90-0178), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple.

tual property rights included in the Agreement, primarily the “minimum standards,”⁶² the “national treatment,”⁶³ and the “most-favored-nation clause.”⁶⁴ Apart from these, Section 3 of the TRIPS Agreement regulates the availability, scope, and use of these intangible assets.⁶⁵

The structure of Section 3 is quite simple and clear. First, Article 22 provides general protection for all GIs.⁶⁶ In this respect, WTO Members should provide legal tools so that interested parties can prevent the designation or presentation of a good that indicates that the good originates in a geographical area other than the true place of origin. They can also prevent

62. TRIPS, *supra* note 2, art. 1 (“Members shall give effect to the provisions of this Agreement. Members may, but shall not be obligated to implement in their domestic law more extensive protection than is required by this Agreement.”).

63. *See id.* art. 3 (“Each Member shall accord to the nationals of other Members treatment no less favorable than that it accords to its own nationals with regard to the protection”). *See generally* Gail E. Evans, *The Principle of National Treatment and the International Protection of Industrial Property*, 18 EUR. INTEL. PROP. REV. 149, 160 (1996).

64. *See* TRIPS, *supra* note 2, art. 4 (“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* Wolfgang Fikentscher, *TRIPS and the Most Favored Nation Clause*, in CURRENT ISSUES IN INTELLECTUAL PROPERTY 137–45 (J. Straus ed., 1995).

65. Both the Paris Convention and the Lisbon Agreement had a clear influence on the provisions of the TRIPS Agreement in general, but particularly in the case of GIs. Substantive provisions contained in Articles 1 to 12 and 19 of the Paris Convention (1967) were “incorporated” in the TRIPS Agreement with respect to the minimum standards concerning: the availability, scope, and use of intellectual property; the enforcement of the intellectual property rights; and, the acquisition and maintenance of intellectual property rights and related *inter partes* procedures. This has had at least three important consequences: (i) Members of the WTO are to comply with the substantive provisions of the Paris Convention, mainly Articles 1 through 12 and Article 19, even if they were not signatories of that Convention; (ii) all WTO Members are bound by the same Act of the Paris Convention (Stockholm Act of 1967); and (iii) the provisions of the Paris Convention incorporated in the TRIPS Agreement became subject to the WTO dispute settlement mechanism.

66. TRIPS, *supra* note 2, art. 22. Among the protections, Article 22.2 requires Members to provide the legal means for interested parties to prevent 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. *Id.*

any use which constitutes an act of unfair competition within the meaning of Article 10*bis* of the Paris Convention.⁶⁷

Another important element of Article 22 is that inconsistent use of a GI which does not mislead the public as to its true origin should not be considered an infringement of TRIPS.⁶⁸ Additionally, Article 22 mandates that Members should refuse or invalidate the registration of a trademark which contains or consists of a GI, but only if such use of the trademark would be misleading.⁶⁹ Moreover, there is no obligation to protect GIs which are unprotected in their country of origin or have fallen into disuse in that country.⁷⁰ Thus, protection abroad is dependent on continuing domestic protection.

In addition to the general protection contained in Article 22, Article 23 accords additional protection for wines and spirits.⁷¹ This additional protection encompasses three main elements. First, it provides the legal means for interested parties to prevent the use of GIs which erroneously identify wine and spirits not originating in the place indicated by the GI.⁷² Second, it mandates the refusal or invalidation of the registration of a trademark for wines or spirits which contains or consists of a GI at the request of an interested party.⁷³ Third, it calls on Mem-

67. See *id.* Article 10*bis* of the Paris Convention was amended to prohibit indications that were "liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity of the goods." Paris Convention, *supra* note 14, art. 10*bis*.

68. Misleading the public consists of any "act or practice, in the course of industrial or commercial activities, that misleads, or is likely to mislead, the public with respect to an enterprise or its activities, in particular, the products or services offered by such enterprise, shall constitute an act of unfair competition." See WIPO, *Model Provisions on Protection Against Unfair Competition*, art. 4, Geneva, 1996. Also, according to Article 22(b), whether the use of a GI constitutes an act of unfair competition is governed exclusively by Article 10*bis* of the Paris Convention.

69. TRIPS, *supra* note 2, art. 22.

70. *Id.* art. 24.9.

71. *Id.* art. 23.

72. This is so 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.

73. TRIPS, *supra* note 2, art. 23.2 ("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

bers to negotiate for increased protections.⁷⁴ These provisions give GIs for wines and spirits stronger protection than those provided in Article 22 for other products.

Lastly, Section 3 of TRIPS establishes a series of exemptions to GI protection in an endeavor to accommodate past registration and use.⁷⁵ The first of these exemptions provides that nothing in Section 3 prevents a Member from continuing to use another Member's GI if it has used it continuously in the past with regard to the same goods or services.⁷⁶ Article 24.5 provides the second exemption allowing for continued use of previously acquired trademarks.⁷⁷ The third exception refers to generic terms and allows a country not to protect a GI if the relevant indication is identical to common names of such goods or services.⁷⁸

C. Negotiation and Review of TRIPS Section on Geographical Indications

Proposals by the European Community (EC), the United States, and Switzerland were indispensable to framing eventual obligations concerning GIs. For example, key elements like Article 23's "additional protection" for wines and spirits and for a multilateral register for indications of wines and spirits were

so permits or at the request of an interested party, with respect to such wines or spirits not having this origin.").

74. *Id.* art. 24.1 ("Members agree to enter into negotiations aimed at increasing the protection of individual [GIs] under Article 23."). It must be noted that this third protection actually lies in Article 24 and not in Article 23, which deals exclusively with wines and spirits. Some countries are of the opinion that this obligation applies to all geographical indications, and not only to those concerning wine and spirits. This topic is explored in further detail, *infra*, Part V.B.

75. *See id.* art. 24.

76. *Id.* art. 24.4 (either, (a) for at least 10 years preceding April 15, 1994 or, (b) in good faith preceding that date).

77. *Id.* art. 24.5. Article 24.5 provides that when a trademark has been acquired or registered in good faith before the date of application of the Agreement to that Member or before the GI was protected in its country of origin, measures adopted to implement Section 3 shall not prejudice eligibility for or the validity of the registration of a trademark or the right to use a trademark on the basis that such trademark is identical with, or similar to, a geographical indication.

78. *Id.* art. 24.6. Also, the right to use a personal name is not to be prejudiced under Section 3 of the Agreement. *Id.*

present in the EC Proposal. The eventual framework reflects “a very sensitive compromise in an area that was one of the most difficult to negotiate.”⁷⁹ WTO negotiators did not resolve all the issues that were on the table, but instead agreed to include within the TRIPS Agreement a “Built-In Agenda” for future negotiations that was designed to facilitate continued negotiations toward international protection of this legal category.

IV. NEGOTIATIONS FOR A MULTILATERAL SYSTEM OF REGISTRATION

A. *Terms of Reference in Article 23.4: Facilitate; Voluntariness; Registration and its Legal Effects; Wines and Spirits*

Under the TRIPS system, WTO Members must open negotiations in the TRIPS Council to establish a multilateral notification and registration system for GIs.⁸⁰ The precise terms of this obligation are in Article 23.4, which states that “[i]n 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 geographical system of notification and registration of geographical indications for wines eligible for protection in those Members participating in the system.”⁸¹

79. Matthijs C. Geuze, *Protection of Geographical Indications Under the TRIPS Agreement and Related Work of the World Trade Organization*, in SYMPOSIUM ON THE PROTECTION OF GEOGRAPHICAL INDICATIONS IN THE WORLDWIDE CONTEXT, OCT. 24–25, 1997, 41 (1999) [hereinafter Symposium 1997].

80. See TRIPS, *supra* note 2, art. 68.

81. This article was introduced in TRIPS at the request of the European Community, although this Proposal contemplated coverage applicable to all GIs and not only to those of the wine sector. WTO Negotiating Group on TRIPS, *Draft Agreement on Trade-Related Aspects of Intellectual Property Rights*, presented by the European Community, MTN.GNG/NG11/W/68, art. 21(3) (Mar. 29, 1990) (Doc #90-0178), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple (“In order to facilitate the protection of geographical indications including appellations of origin, the establishment of an international register for protected indications should be provided for. In appropriate cases the use of documents certifying the right to use the relevant geographical indication should be provided for.”). The Proposal was included in the text that the President of the Negotiations Group presented in July 1990. See WTO Negotiating Group on TRIPS, *Status of Work in the Negotiating Group, Chairman’s Report to the GNG*, MTN.GNG/NG11/W/76 (July 23,

1. Facilitate

As the plain language of the provision suggests, the objective of the creation of a register is to facilitate GI protections, thus providing the necessary means to identify and make public, in a transparent way, those GIs that Members should already protect. Identification is required because, when compared with other intellectual property rights, such as patents and trademarks, GIs are often difficult to recognize.⁸² TRIPS unquestionably constitutes a dramatic step forward in protecting wine and spirit GIs and, as such, the term “to facilitate” used in this provision must be understood to identify GIs that Members are already bound to protect, not via future multilateral registration but, rather, by present provisions of Part II, Section 3.

Article 23.4, along with the general definition of GIs in Article 22.1, implies that the register is only for GIs which fulfill criteria established in the TRIPS Agreement. Specifically, the provision suggests that only those that identify a good as originating in the territory of a Member will be able to accede to the multilateral register.

1990) (Doc #90-0444). During the autumn of that year, some countries were in favor of the creation of this register in the Uruguay Round and they even presented, in an informal way, some proposals which contemplated, in a detailed and systematic way, the creation of this register. These Proposals were debated by the Negotiations Group. However, other countries were committed solely to examining this question in the future. This disagreement was reflected in the project presented by the President of the Negotiations Group to the Ministerial Meeting of Brussels in December, 1990. See WTO Trade Negotiations Committee, *Draft Final Act Embodying the Results of the Uruguay Round of Multilateral Trade Negotiations – Part 1 – Revision*, MTN.TNC/W/35-1/Rev.1 (Dec. 3, 1990) (“In order to facilitate the protection of geographical indications, the Committee shall [examine the establishment of] a multilateral system of notification and registration of geographical indication eligible for protection in the PARTIES participating in the system.”). Finally, the Negotiations Group decided to establish a commitment of future works exclusively applicable to GIs of the wine sector, as reflected in the final text of Article 23.4. TRIPS, *supra* note 2, at art. 23.4.

82. See Conrad, *supra* note 30, at 12. One of the many problems related to recognition involves defining boundaries. As Conrad suggests, “one of the notorious problems involved in the protection of geographical names arises from the fact that in most cases they do not identify a single business source and therefore it is often difficult to establish the boundaries of the region that can legitimately claim use of the name.” *Id.* The other problem with GI identification involves genericness. See *id.*

2. Voluntariness

An ideal system would require all WTO Members to participate. However, a literal reading of Article 23.4 only establishes a voluntary participatory system.⁸³ This raises the issue of whether a system based on voluntary participation could bind WTO Members once a GI has been registered. The logical answer seems to be that a voluntary system could only bind participating Members. However, for reasons of transparency and efficiency it is preferable that all WTO Members be subjected to such registering, since a system whereby GIs are recognized and protected in some Member territories but not others surely creates legal and economic uncertainty, thus undermining the objective of the protection. Indeed, Article 23.4 calls for the establishment of a multilateral system of notification and registration of GIs, and a multilateral system can only be understood as requiring all parties to the WTO Agreement to be bound to protect registered GIs. Unlike plurilateral trade agreements, which bind only signatories, a multilateral system must be understood to include all WTO Members.⁸⁴ Therefore, in the lexicon of the WTO, “plurilateral” must be understood as referring to a system in which participation is entirely voluntary, whereas “multilateral” is understood to bind all Members.⁸⁵

83. See TRIPS, *supra* note 2, art. 23.4. Indeed, this position is supported by its wording: “...eligible for protection in those Members participating in the system.” *Id.*

84. The Agreement establishing the WTO expressly affirms that although the four Plurilateral Trade Agreements (Agreement on Trade in Civil Aircraft; Agreement on Government Procurement; International Dairy Agreement and the International Bovine Meat Agreement) are part of the WTO Agreement, they create neither obligations nor rights for Members that have not accepted them. Final Act Embodying the Results of the Uruguay Round of Multilateral Trade Negotiations, Apr. 15, 1994, LEGAL INSTRUMENTS – RESULTS OF THE URUGUAY ROUND vol. 1 (1994), art II.3, 33 I.L.M. 1125, 1144 [hereinafter WTO Agreement].

85. WTO Council for TRIPS, Special Session, *Minutes of Meeting*, TN/IP/M/4 (Feb. 6, 2003) (Doc #03-0786), para. 21, available at http://docs.online.wto.org/gen_search.asp?searchmode=simple. The representative of the European Communities stated that “a multilateral system was a system that somehow should concern all Members.” *Id.* Where systems and treaties in other areas of the WTO did not concern all WTO Members, they were termed “plurilateral,” such as the Agreement on Government Procurement. *Id.* In his delegation's view, “that was not just a purely theoretical interpretation.” In the same sense, the representative of Switzerland stated,

Certainly, the phrase “Members participating in the system” at the end of Article 23.4 seems to refer to voluntary participation. But, in my opinion, this reference can be interpreted as meaning no more than those Members who chose to participate by registering their GIs in the system. Under this interpretation, a participating Member would still be obligated to afford protection to GIs registered by other Members, even though it chooses not to register its own GIs. Nonetheless, the protection of registered GIs must be obligatory for all by virtue not only of the mandate of Article 23.4, but also via the other provisions of Part II, Section 3, particularly Article 24.1.⁸⁶ This provisional

The meaning of the term “multilateral” could only be determined by comparing it with the term “plurilateral.” In the WTO context, while “plurilateral” was understood to refer to a system in which participation was fully voluntary, for instance, the Agreement on Government Procurement, “multilateral systems” were instruments which bound all WTO Members.

Id. para. 28.

86. From a general perspective, it must be recalled that the WTO Agreement has eliminated the imbalances caused by the collateral agreements, also referred to as “Codes,” concluded after the Tokyo Round (1973–1979), which, in most cases, differentiated the norms and procedures for decision-making and dispute resolution and whose acceptance among the Contracting Parties was limited. However, some free-rider countries, countries which have assumed only the minimum level of obligations have tried to benefit from the Most Favored Nation (MFN) clause of Article I of GATT. These countries demanded the advantages resulting from these Codes, which they themselves have ignored. To avoid these imbalances, Article II.3 of the WTO Agreement states specifically that the MFN Clause is not applied to the four Plurilateral Agreements. See LUIS NORBERTO GONZÁLEZ ALONSO, *POLÍTICA COMERCIAL Y RELACIONES EXTERIORES DE LA UNIÓN EUROPEA*, 159 (1998). It must be observed, however, that nothing equal has been established in the section of the TRIPS Agreement relative to GI protection. Therefore, if we admitted that the multilateral register of GIs only must bind participant countries, nothing in it would prevent the other WTO Members from demanding the application of the MFN Clause established specifically in TRIPS, Article 4. Fikentscher, *supra* note 64, at 141. In the case of particular collateral agreements concluded within the framework of Section 3, Part II of TRIPS, the MFN Clause cannot apply because Article 24 urges the conclusion of bilateral or plurilateral agreements, thus revoking, in these specific cases, the benefits of this fundamental principle of the WTO system. However, from my point of view, this interpretation need not be accepted. Consider that a preliminary version of the TRIPS Agreement specifically established the following exemption to the MFN Clause for bilateral or multilateral agreements about GI protection:

intersection results in a system of obligatory GI protection for all because it prohibits any country from refusing to negotiate to improve the protection of individual GIs.⁸⁷ Thus, the notification of a GI to the register is equivalent to a request to open negotiations.

3. Registration and Its Legal Effects

There remains the question of how "registration" in Article 23.4 should be understood.⁸⁸ One view is that registration refers to a specific way of implementing TRIPS requirements that differs from the common law approach based on case law.⁸⁹ Registration in the field of intellectual property is normally understood as involving the grant of a title of protection with a genuine legal effect.⁹⁰ Under a system where registration has

PARTIES agree that the preceding paragraphs shall not prevent the conclusion pursuant to Article 19 of the Paris Convention (1967) of bilateral or multilateral agreements concerning the rights under those paragraphs, with a view to increasing the protection for specific geographical or other indications, and further agree that any advantage, favor, privilege or immunity deriving from such agreements are exempted from the obligations under point 7 of Part II of this agreement.

WTO Negotiating Group on TRIPS, *Status of Work in the Negotiating Group, Chairman's Report to the GNG*, MTN.GNG/NG11/W/76 (July 23, 1990) (Doc #90-0444), para. 4.2. However, this provision was not ultimately retained in the final wording of the Agreement, which leads to the conclusion that this principle would be applied totally to bilateral agreements relative to GIs protection.

87. TRIPS, *supra* note 2, art. 24.1 ("Members agree to enter into negotiations aimed at increasing the protection of individual [GIs] under Article 23....").

88. See generally WTO, WTO News: 1998 News Items, TRIPS Council, *Discussion Develops on Geographical Indication*, Dec. 2, 1998, at http://www.wto.org/english/news_e/news98_e/pu_e.htm (discussing proposal for registration system).

89. See generally WTO Council for TRIPS, Communication from the European Communities and their Member States, *Proposal for a Multilateral Register of Geographical Indications for Wines and Spirits Based on Article 23.4 of the TRIPS Agreement*, IP/C/W/107 (July 28, 1998) (Doc #98-2930), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple.

90. The creation of legal effects upon registration is perhaps best highlighted by the Madrid Agreement. Under the system created by the Madrid Agreement, the effect of an international application is to require each of the designated contracting parties to protect the subject matter in accordance

no legal effect, the act of registration would not add value to that of notification and therefore would not comport with Article 23.4.⁹¹ To give it such enhanced value, registration should follow a phase of examination which would give it greater legitimacy.⁹²

As with other titles of intellectual property, registration must confer a presumption of legality. The legal implications of this interpretation based upon Article 23.4 would be a presumption of eligibility for protection in the markets of all WTO Members for all GIs inscribed into the multilateral register. Equally important, the registration system must provide a forum for dispute resolution where Members can challenge the presumption of validity and its legal effects for those GIs which are alleged to lack the requirements mandated under TRIPS. In effect, Article 23.4 implies that the future system of notification and registration need not affect the TRIPS Agreement's rights and obligations. Instead, the register functions to assist in facilitating the protections arising from the TRIPS Agreement by means of developing more transparent and efficient procedures. In this sense, the register does not increase obligations nor diminish acquired rights.

The alternative view focuses on the text of Article 1, which states, "Members shall be free to determine the appropriate method of implementing the provisions of this Agreement within their own legal system and practice."⁹³ Thus, the regis-

with national or regional law, unless it has lodged a refusal to protect within a certain period. The system provides for the grant of an international title of protection, which provides protection in each contracting party as if a national title had been granted in that jurisdiction. However, the office of each designated contracting party can refuse to grant the protection. In the case of refusal, the holder of the international registration or deposit has the same remedies as if the trademark or industrial design had been deposited by him directly with the refusing office. See Madrid Agreement Concerning the International Registration of Marks, *supra* note 43.

91. WTO Council for TRIPS, Special Session, *Minutes of Meeting*, (Aug. 26, 2002) (Doc. #02-4570), para. 108 (arguing, from the Hungarian representative's comments, that registration must carry with it legal effect), *available at* http://docsonline.wto.org/gen_search.asp?searchmode=simple [hereinafter *Minutes of June 28, 2002 Meeting*].

92. *Id.* para. 110 (quoting the Switzerland representative, as arguing that the "provisions of an examination and a challenge procedure gave legitimacy to the listing in the multilateral register.").

93. TRIPS, *supra* note 2, art 1.

tration system need not supplant national systems of GI protection. In this sense, it continues to be the prerogative of Members to choose the legal means that best responds to their interests.

4. Wines and Spirits

Article 23.4 next addresses GIs for wine exclusively. However, the Ministerial Conference of Singapore of 1996 also included in the scope of its application the provision of spirits, as evidenced by the Ministerial Declaration of the Report of Council TRIPS of 1996, in which Section 34 affirmed the following:

In regard to GIs ... the Council will initiate ... preliminary work on issues relevant to the negotiations specified in Article 23.4 of the TRIPS Agreement ... Issues relevant to the notification and registration system for spirits will be part of this preliminary work. All of the above work would be conducted without prejudice to the rights and obligations of Members under the TRIPS Agreement....⁹⁴

Ministers did not distinguish between wines and spirits despite their competence to do so. Against this background, spirits were included in the Council's work; any other course of action would have been contradictory to the Ministerial Conference decision. Nevertheless, some Members continued to fight against this extension, alleging that the Singapore Ministerial Declaration only included "spirits" in the scope of preliminary work to be carried out under Article 23.4.⁹⁵ For these Members, the pronouncement in Paragraph 18 of the Doha Ministerial Declaration to the TRIPS Council to "complet[e] the work started ... on the implementation of Article 23.4..."⁹⁶ confirms the intention of the Minister that, with the exception of GIs for spirits, the multilateral system be established in accordance

94. WTO Council for TRIPS, *Report (1996) of the Council for TRIPS*, IP/C/8 (Nov. 6, 1996) (Doc. # 96-4704), para. 34, available at http://docsonline.wto.org/gen_search.asp?searchmode=simple [hereinafter *Report (1996) of the Council for TRIPS*].

95. *Id.*

96. WTO Ministerial Conference, Fourth Session, *Ministerial Declaration*, WT/MIN(01)/DEC/1 (Nov. 20, 2001) (Doc. #01-5859), available at http://docs.wto.org/gen_search.asp?searchmode=simple [hereinafter *Doha Ministerial Declaration*].

with the mandate provided in Article 23.4.⁹⁷ Those Members believe that spirits should be included in the “preliminary work” of the Council, but that they did not fall within the scope of “negotiations” which were envisaged only for wines.⁹⁸ As a result, those Members believe that references to spirits should be understood as relating to such work without the inference of negotiations.⁹⁹

The Doha Ministerial Conference attempted to clarify doubts about the coverage of the multilateral register. In the Declaration passed at the Conference, the Ministers affirmed the convenience of negotiating the establishment of a multilateral system of notification and registration of GIs for wines and spirits.¹⁰⁰ Nevertheless, WTO Members have different interpreta-

97. *Minutes of June 28, 2002 Meeting, supra* note 91, para. 18; WTO Council for TRIPS, Communication from New Zealand, *New Zealand's System of Protection for Geographical Indications and the Multilateral Notification and Registration System for Geographical Indications Under Article 23.4 of the TRIPS Agreement*, IP/C/W/189 (June 22, 2000) (Doc #00-2534), n.1, available at http://docsonline.wto.org/gen_search.asp?searchmode=simple.

98. To reflect the current limitation of the mandate established in Article 23.4 of TRIPS to wines, these WTO Members affirm that the term “and spirits” should appear in brackets in all the Proposals. See *Minutes of June 28, 2002 Meeting, supra* note 91, para. 18. However, the Chairperson, during the debates, said that Members have a very clear mandate to negotiate the establishment of a multilateral system of notification and registration of GIs for wines and spirits by the Fifth Session of the Ministerial Conference. He added that a Special Session is required to fulfill the mandate in its entirety and not to go beyond the mandate. *Id.* at paras. 20, 137; WTO Council for TRIPS, Special Session, *Minutes of Meeting*, TN/IP/M/5, para. 31 (Apr. 28, 2003) (Doc. #03-2231), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple [hereinafter *Minutes of Feb. 21, 2003 Meeting*].

99. See WTO Council for TRIPS, *Minutes of Meeting*, Doc. IP/C/M/20 (Oct. 15, 1998) (Doc. #98-3989), para. 48, available at http://docsonline.wto.org/gen_search.asp?searchmode=simple (comments from the New Zealand representative) [hereinafter *Minutes of September 17, 1998 Meeting*]; WTO Council for TRIPS, *Minutes of Meeting*, IP/C/M/22 (Apr. 9, 1999) (Doc. #99-1407), paras. 83, 85, 86 (comments from the New Zealand representative, Chile representative, and Korea representative, respectively that coverage should not extend to spirits), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple; WTO Council for TRIPS, *Minutes of Meeting*, IP/C/M/21 (Jan 22, 1999) (Doc. #99-0240), para. 82, available at http://docsonline.wto.org/gen_search.asp?searchmode=simple (comments from the Argentine representative stating that spirits fell outside the scope of negotiations).

100. See *Doha Ministerial Declaration, supra* note 96. The Doha Ministerial Declaration notes that the TRIPS Council will handle this under the Declara-

tions of this mandate. Some Members argue that the Ministerial Declarations, like those approved in Singapore or Doha, are mere political declarations that cannot extend, generalize, or modify what has been settled by an international treaty.¹⁰¹ Others affirm that Ministerial Conferences can modify the literal sense of some provisions of such treaties¹⁰² because of the

tion's paragraph 12 (which deals with implementation issues). Paragraph 12 offers two tracks:

- (a) where we provide a specific negotiating mandate in this Declaration, the relevant implementation issues shall be addressed under that mandate; (b) the other outstanding implementation issues shall be addressed as a matter of priority by the relevant WTO bodies, which shall report to the Trade Negotiations Committee, established under paragraph 46 below, by the end of 2002 for appropriate action.

Id. at para. 12.

101. In the final phase of negotiations of the Doha Ministerial Declaration, enough divergences arose among WTO Members as to whether this Declaration could or could not establish new mandates of negotiation not strictly established under the WTO Agreements. The Communication presented by Argentina rejected any legal relevance to the Doha Declaration with respect to the extension of additional GI protection to products other than wines and spirits, when no specific disposition existed in the WTO Agreements. WTO Ministerial Conference, Fourth Session, *Communication from Argentina Regarding Paragraphs 18 and 12 of the Draft Ministerial Declaration*, WT/MIN(01)/W/8 (Nov. 12, 2001) (Doc #01-5726), available at http://docs.wto.org/gen_search.asp?searchmode=simple. Alternatively, the Communication presented two days later by Bulgaria, the European Community and their Member States, Slovenia, Hungary, Kenya, Liechtenstein, Mauritius, Nigeria, Pakistan, the Czech Republic, the Slovakian Republic, Sri Lanka, Switzerland, Thailand and Turkey emphasized these Members' belief that paragraphs 18 and 12 of the Doha Ministerial Declaration clearly established a mandate to initiate negotiations on the extension of additional protection. WTO Ministerial Conference, Fourth Session, *Communication from Bulgaria, the Czech Republic, the European Communities and its Member States, Hungary, Liechtenstein, Kenya, Mauritius, Pakistan, the Slovak Republic, Slovenia, Sri Lanka, Switzerland, Thailand, and Turkey Regarding Paragraphs 18 and 12 of the Draft Ministerial Declaration*, WT/MIN(01)/W/11 (Nov. 14, 2001) (Doc. #01-5796), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple; see also WTO Ministerial Conference, Fourth Session, *Communication from Bulgaria, Kenya, India, and Sri Lanka Regarding Paragraphs 18 and 12 of the Draft Ministerial Declaration*, WT/MIN(01)/W/9 (Nov. 13, 2001) (Doc. #01-5779), available at http://docs.wto.org/gen_search.asp?searchmode=simple.

102. It is doubtful that the Doha Ministerial Declaration could be defined as an interpretation of the Ministerial Conference following the recommendations established in Article IX.2 of the WTO Agreement, since the parties did not show any evidence of consideration of this provision when drafting the

authority of interpretation attributed to the Ministerial Conference on Treaties signed in the Uruguay Round.¹⁰³

Thus far, the focus of the analysis has been on how the mandate established in Article 23.4 of TRIPS should be interpreted. The next section advances the debate by outlining a few main proposals presented by the TRIPS Council about the notification and registration system of GIs.

B. Differing Proposals on the Nature of the Registration System

The submissions that have been presented at the TRIPS Council for the establishment of a multilateral notification and registration system for GIs can be divided into two camps. The first is a minimalist approach defended by the United States, Australia, New Zealand, Japan, along with many Latin American countries. These nations advocate a voluntary system

Declaration. Perhaps the best explanation is that the Declaration was adopted following Article III.2 of the WTO Agreement. *See generally* J. Thuo Gathii, *The Legal Status of the Doha Declaration on TRIPS and Public Health under the Vienna Convention on the Law of Treaties*, 15 HARV. J.L. & TECH. 292 (2002); 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*, 36(4) J. WORLD TRADE 721, 722 (2002). Some analysts have suggested that the Doha Declaration must be seen as an understanding similar to the six understandings of the GATT passed during the Uruguay Round. *See* Steve Charnovitz, *The Legal Status of the Doha Declarations*, 207 J. OF INT'L ECON. L. 207, 211 (2002). It must be observed that in the case *United States - Import Prohibition on Certain Shrimp and Shrimp Products*, the Appellate Body noted the statements established in the Report of a WTO Council on Trade and Environment, which was part of a Report of the General Council for the Singapore Conference. WTO Report of the Appellate Body, *United States - Import Prohibitions of Certain Shrimp and Shrimp Products*, WT/DS58/AB/R (Oct. 12, 1998) (Doc. #98-3899), 38 I.L.M. 118, para. 168, available at http://docsonline.wto.org/gen_search.asp?searchmode=simple. Thus, if a Report of a WTO body can be useful to interpret the WTO law, it should be even more useful for a Decision of the Ministerial Conference.

103. WTO Agreement, *supra* note 84, art. IX.2. In several cases, GATT Panels have emphasized the authority of the Ministerial Conference and the General Council. *See, e.g.*, WTO Report of the Appellate Body in the case *Japan - Taxes on Alcoholic Beverages*, WT/DS8/AB/R, WT/DS10/AB/R, WT/DS11/AB/R, sec. E (Oct. 4, 1996) (Doc. #96-3951), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple; Report of the Panel in the case *European Economic Community Restriction on Imports of Apples from Chile*, GATT B.I.S.D. (36th Supp.) 93, para. 12.1 (July 1990) (denominating the Ministerial Conference's interpretation as "authentic interpretation of a treaty").

characterized by its transparency. It would create no legal rights, and consequently, the inscription of a GI would not require protection by other Members. The second proposal advocating a minimalist approach is presented by Hong Kong, China, in which the inscription of a GI into the register would lack a process of substantive examination or opposition at the multilateral level. The inscription would be put into effect only after a cursory, formal examination of the GI subject to notification and questions relating to the conformity of a GI with Article 22.1. The applicability of the exceptions would remain in the local jurisdiction in accordance with domestic law. The obligation to give legal effect to registration under the system would only be binding on participating Members.

The second group advocates a maximalist approach. Members of the European Union, Switzerland, former Eastern bloc countries, and a selection of developing countries champion this view. The maximalist approach supports a compulsory system in which a GI would benefit from unconditional protection in the markets of all Members upon its inscription in the register.

1. The Minimalist Approach

i) The United States-led Proposal

The primary proposal advocating a minimalist approach was presented by the United States, Canada, Chile and Japan (U.S.-led Proposal).¹⁰⁴ The system of notification and registration of

104. The first proposal presented by the United States and Japan was the Communication dated March 11, 1999. WTO Council for TRIPS, *Proposal for a Multilateral System for Notification and Registration of Geographic Indications for Wines and Spirits Based on Article 23.4 of the TRIPS Agreement*, IP/C/W/133 (Mar. 11, 1999) (Doc. #99-0978), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple [hereinafter U.S.-led Proposal]. This proposal was later sponsored by Canada and Chile. WTO Council for TRIPS, *Proposal for a Multilateral System for Notification and Registration of Geographic Indications for Wines and Spirits Based on Article 23.4 of the TRIPS Agreement*, IP/C/W/133/Rev.1 (July 26, 1999) (Doc. #99-3125), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple. Argentina, Australia, Canada, Chile, and New Zealand also supported the U.S. initiative. WTO Council for TRIPS, Special Session, *Multilateral System of Notification of Geographical Indications for Wines (and Spirits)*, WTO Doc. TN/IP/W/6 (Oct. 29, 2002) (Doc. #02-5938), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple. Also providing

GIs urged in this approach is characterized solely by its informative nature. The system proposed would not create legal rights, and consequently, the inscription of a GI would not require protection by other Members.¹⁰⁵ Under this proposal, registration follows receipt by the administering body of notifications from participating Members. It includes notification in a searchable database of all GIs for wines and spirits and affirms the principle that GIs are territorial rights and, therefore, the conditions for granting and exercising them must be established in national legislations of WTO Members.¹⁰⁶ For that reason, the minimalist approach conceives of a voluntary system of notification and registration.¹⁰⁷ This means that any GI for wines or spirits established in accordance with national legislation is entitled to protection under Part II, Section 3, of the TRIPS, regardless of whether it is registered in the WTO database.¹⁰⁸

Members wishing to participate in this system submit to the Secretariat a list of domestic GIs eligible for protection under their national legislation, indicating the date, if any, on which protection will expire.¹⁰⁹ Subsequent notifications include additional domestic GIs eligible for protection under a Member's national legislation and any previously-notified GIs no longer eligible for such protection.¹¹⁰ Following receipt of notifications,

support to the minimalist approach is Colombia, Costa Rica, Ecuador, El Salvador, the Philippines, Guatemala, Honduras, Namibia, the Dominican Republic and Chinese Taipei. WTO Council for TRIPS, Special Session, *Multilateral System of Notification of Geographical Indications for Wines (and Spirits)*, WTO Doc. TN/IP/W/5 (Oct. 23, 2002) (Doc. #02-5799), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple. The October 29, 2002 Communication represents the most recent contribution from these countries to the debate on the establishment of a multilateral system of notification and registry of GIs.

105. U.S.-led Proposal, *supra* note 104, art. 3.

106. *Id.*

107. *Id.* para. 4.

108. *Id.* para. 3.

109. *Id.* The lists shall provide, with respect to each indication, the WTO Member that notified the indication, the expiration date of protection, if any, and any other multilateral agreement for GIs under which the indication is protected. The database, in turn, would include: the GI for the wine or spirit that has been notified, the WTO Member which has made the notification, the date on which the indication is protected by the notifying Member, the expiration date, if any, and any agreement under which the indication is protected.

110. *Id.* para. 2.

the Secretariat will compile a database of all notified GIs for wines and spirits and distribute copies to all Members.¹¹¹ After the initial notification, the Secretariat will revise the database of notified GIs, adding or deleting indications in accordance with Members' notifications. Moreover, the proposal states that, in accordance with Article 23.3, identical or similar GIs may be submitted by more than one WTO Member, provided that the GI is recognized by each notifying WTO Member in accordance with its national regime for protecting GIs.

With regard to the effects under national legislation, participants would be legally bound to consult the database, along with other sources of information, when making decisions regarding the recognition and protection of GIs for wines and spirits.¹¹² Registration in the multilateral system would not give rise to any presumption regarding eligibility for protection given the territorial nature of GIs and the application of Article 24 exceptions, which would remain in force under national law. Non-participants would be encouraged to refer to the database, along with other sources of information, in making such decisions under their national legislation.¹¹³ Thus, Members' participation would be limited to receiving these lists, among other sources of information, when they must make decisions on the protection in their territories of GIs of other Members.¹¹⁴

111. *Id.* ("The Secretariat shall have no discretion to decline acceptance of a GI notified by a WTO Member.").

112. *See id.*

113. *Id.* The proposal asserts that

[i]nformation obtained from WTO Multilateral Systems for Wines and Spirits would be taken into account in making those decisions in accordance with that national legislation. . . . WTO Members not participating in the system will be encouraged to refer to the WTO Multilateral System for Wines and Spirits, along with other sources of information, in making decisions under their national legislation. . . . in order to ensure that such decisions are based on the most complete information available.

Id.

114. This assertion appears to conform with U.S. law, in which the right of an interested party to challenge the use of a particular GI in the United States does not extend to the right to challenge the compliance by the United States with its obligations under the TRIPS Agreement. *See* 19 U.S.C. § 3512(c).

With regard to appeals or objections, the proposal sets out that decisions concerning protection for GIs, regardless of whether the WTO is notified, should occur at the national level at the request of interested parties.¹¹⁵ Should any appeal or objection result in a final decision that a domestic GI is ineligible for protection, that Member should notify the Secretariat during the subsequent notification period.¹¹⁶

ii) Hong Kong Proposal

The second proposal advocating the minimalist approach was presented by Hong Kong.¹¹⁷ Although this proposal attempts to reconcile the minimalist approach of the U.S.-led Proposal with the maximalist approach of the European Community, it is not truly a middle-ground proposal. Instead, it is much closer to the other minimalist proposals.

The Hong Kong Proposal proffers a multilateral system that would involve only a cursory formal examination of the GI subject to notification.¹¹⁸ This would contain basic information

115. U.S.-led Proposal, *supra* note 104, para. 2.

116. Apart from the proposal relative to the multilateral register, the United States presented another proposal arguing that one acceptable means of protecting GIs would be protection through the trademark system. See WTO Council for TRIPS, *Suggested Method for Domestic Recognition of Geographical Indications for WTO Members to Produce a List of Nationally-Protected Geographical Indications*, IP/C/W/134 (Mar. 11, 1999) (Doc #99-0979), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple. According to this proposal, using the trademark system to protect GIs would have the main advantage that no additional commitment of resources would be required to protect GIs. In other words, a government's use of its existing trademark regime to protect GIs would involve only government resources already committed to the trademark system for applications, registrations, oppositions, cancellations, adjudication, and enforcement. However, in my opinion, while the trademark regime may be advantageous to the United States, it is not an ideal model for multilateral GI protection.

117. Although it does not have any substantive commercial interest in GIs, Hong Kong presented a proposal about the negotiating mandate under Article 23.4. See WTO Council for TRIPS, Special Session, *Multilateral System of Notification and Registration of Geographical Indications Under Article 23.4 of the TRIPS Agreement*, TN/IP/W/8 (Apr. 23, 2003) (Doc #03-2166), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple. [hereinafter Hong Kong Proposal].

118. *Id.* sec. III.4.i ("The multilateral system involves only a formality examination of the geographical indication subject to notification. Provided that basic information identifying the geographical indication, its ownership, and

identifying the GI and its ownership and the basis on which it would be entered in the register.¹¹⁹ In terms of formal legal effects, registration on the multilateral register would constitute prima facie evidence of: (a) ownership; (b) that the indication was within the definition under Article 22.1; and (c) that it was protected in the country of origin.¹²⁰ These three issues would be deemed valid unless evidence to the contrary was produced by an opposing party.¹²¹ If such a party adduced evidence to the contrary, then national tribunals would weigh all the evidence and decide whether the issues and questions were proved to the standard required by the proceedings.¹²² According to the Hong Kong Proposal, this rebuttable presumption would help the presumed owner of the GI discharge the legal burden of proof on the three issues in the course of domestic proceedings.¹²³ Consequently, according to the Hong Kong Proposal, this would facilitate GI protection through Members' domestic legal systems.¹²⁴ The proposed framework would not change substantive legal rights of either party to a proceeding. For instance, questions relating to the conformity of a GI with Article 22.1 would remain in the local jurisdiction in accordance with domestic law. Questions relating to the applicability of the exceptions under Article 22.4 would continue to be decided by Members' domestic authorities. Inscription in the multilateral register would not have any legal effect or create any presumption in relation to these issues, except as it related to Article 24.9.¹²⁵

the basis on which it is claimed to be protected in the country of origin is submitted to the responsible authority, the indication will be entered on the register.”).

119. *Id.* annex A, para. B.1 (“The examination process does not involve substantive examination.”).

120. *Id.* annex A, para. D.2.

121. *Id.*

122. *Id.*

123. *Id.* sec.III.4.v.

124. *Id.*

125. *Id.* sec.III.4.iv.

Registration should be accepted by participating Members' domestic courts, tribunals or administrative bodies as *prima facie* evidence of: (a) ownership; (b) that the indication is within the definition of 'geographical indications' under Article 22.1 of the TRIPS Agreement; and (c) that it is protected in the country of origin. The intention is that the issues will be deemed to have been proved unless evidence to

The system would also not deal with competing claims for GIs, which would continue under national law. However, the Hong Kong Proposal suffers greatly because the lack of a substantive examination or opposition at the multilateral level limits the legal effects of registration to the rights holder.

With regard to participation, the Proposal establishes a voluntary system under which Members would be free to participate and make notifications of GIs protected in their territories.¹²⁶ The obligation to give legal effect to registration under the system would only be binding on participating Members.¹²⁷

iii) Shortcomings of the Minimalist Approach

The U.S.-led Proposal offers as its main objective a minimalist, limited information system in which national GIs would be notified and incorporated automatically.¹²⁸ However, the legal effects that, in principle, the inscription of a GI in the database would have are not specified, explicitly or implicitly.¹²⁹ This

the contrary is produced by the other party to the proceedings before domestic courts, tribunals or administrative bodies when dealing with matters related to geographical indications. In effect, a rebuttable presumption is created in favor of owners of geographical indications in relation to the three relevant issues.

Id.

126. *Id.* annex A, para. E. (“Participation in the system is voluntary which means that: 1. Members should be free to participate and notify GIs protected in their territories; 2. The obligation to give legal effect to registrations under the system will only be binding upon Members choosing to participate in the system.”).

127. *Id.*

128. Milo G. Coerper, *Certification Marks as a Means of Protecting Geographical Indications*, 1997-1998 A.B.A. SEC. INTELL. PROP. L., ANN. REP., COMMITTEE 202, <http://www.abanet.org/intelprop/97-98rep/202.html> (supporting this proposal, Coerper states that the system should not be obligatory for all WTO Members, but it could be a system of merely informative nature). See also Lynne Beresford, *The Protection of Geographical Indications in the United States*, in SYMPOSIUM ON THE INTERNATIONAL PROTECTION OF GEOGRAPHICAL INDICATIONS 48 (1999) (indicating that any registration system that finally is created would have to avoid the creation of additional obligations for WTO Members) [hereinafter Symposium 1999].

129. In the Meeting of the TRIPS Council on April 21–22, 1999, the U.S. Representative stated, “[t]he fact that a particular geographical indication was registered would not automatically obligate a Member to protect that geographical indication if it were not entitled to such protection under that Member’s TRIPS-consistent national law.” WTO Council for TRIPS, *Minutes*

proposal does not provide for a system with a truly multilateral character. It attempts to be no more than an information system where national GIs may be notified and automatically listed on a database to be established in the future by the WTO.¹³⁰ Therefore, it is difficult to understand the added value of the system envisioned in the U.S.-led Proposal. Although the burden on the WTO would be limited under this proposal, the costs entailed would not be compensated by any benefits other than those already existing at the national level and under notifications made on the basis of Article 63.2.¹³¹

A multilateral register clearly implies multilateral protection, and this must be the key element in establishing such a register.¹³² However, the U.S.-led Proposal is limited to creating a

of Meeting, IP/C/M/23 (June 2, 1999) (Doc. #99-2220), para. 51, available at http://docsonline.wto.org/gen_search.asp?searchmode=simple. From this affirmation, it can be deduced that the database would add nothing new and, consequently, would clearly not be useful "to facilitate the protection of geographical indications" as Article 23.4 prescribes. *Id.*

130. See WTO Council for TRIPS, *Communication from the European Communities and their Member States*, WTO IP/C/W/260 (May 30, 2001) (Doc. #01-2709), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple. The Communication lists criticisms of the minimalist approach. For example, it states, "[i]n a number of respects, [the U.S.-led Proposal] does not seem to constitute more than a mere database. It is not clear to us how the facilitation of the protection of [GIs], as requested in Article 23.4 of the TRIPS Agreement, would be ensured by a system limited to a mere database." *Id.*

131. Article 63.2 states:

Members shall notify the laws and regulations referred to in paragraph 1 to the Council for TRIPS in order to assist that Council in its review of the operation of this Agreement. The Council shall attempt to minimize the burden on Members in carrying out this obligation and may decide to waive the obligation to notify such laws and regulations directly to the Council if consultations with WIPO on the establishment of a common register containing these laws and regulations are successful. The Council shall also consider in this connection any action required regarding notifications pursuant to the obligations under this Agreement stemming from the provisions of Article 6ter of the Paris Convention (1967).

Id.

132. See WTO Council for TRIPS, *Communication from the European Communities and their Member States*, WTO IP/C/W/260 (May 30, 2001) (Doc. #01-2709), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple. The EC attacks the minimalist approach for failure to understand the scope of the terms "notification" and "registration." As used in the U.S.-led Proposal, "notification implies only transparency of information in a vol-

record rather than a true registration, as it only refers to legal effects under national legislation.¹³³ The system does not provide for a mechanism to filter out names that should not be protected and, therefore, risks creating more confusion than clarity.¹³⁴ The proposal is silent on the need for elements of proof, for the assessment of eligibility, or for an opposition procedure — elements which are indispensable to a future multilateral register.¹³⁵ It is impossible under this approach to ensure that terms that do not meet the provisions of Articles 22.1 or 24.9, or which fall under one of the exceptions provided for in Article 24, are denied eligibility.

The U.S.-led Proposal also does not establish procedures to resolve possible litigation, an indispensable procedure for any future multilateral register.¹³⁶ At the same time, the proposal leaves open the possibility for Members to end or interrupt their participation without legal ramifications. The great uncer-

untary and administratively simple system, while the term registration implies no legal effects. Consequently, it would appear that the provisions on notification and registration are identical in the joint Proposal.” *Id.*

133. U.S.-led Proposal, *supra* note 104, art. 3. (“Any [GI] for wines or spirits established *in accordance with national legislation* is entitled to protection under Section 3 of Part II of the TRIPS Agreement, whether or not it is registered in the WTO database.” (emphasis added)).

134. *Minutes of June 28, 2002 Meeting*, *supra* note 91, para. 75.

135. The U.S.-led Proposal makes reference neither to national legislation providing for protection, nor to the date on which each GI first received protection.

136. Argentina, Australia, Canada, Chile, New Zealand and the United States clarify that if an opposition system is to be established, the right to invoke the exceptions provided for in Article 24 would be undermined because they would have to be used through the system and would be subject to the successful result of the opposition procedure. WTO Council for TRIPS, Special Session, *Multilateral System of Notification of Geographical Indications for Wines (and Spirits)*, WTO Doc. TN/IP/W/6 (Oct. 29, 2002) (Doc. #02-5938), para. 22, available at http://docsonline.wto.org/gen_search.asp?searchmode=simple. Nevertheless, from my point of view, the establishment of this opposition system would have the ability to systemize the application of these exceptions and in no case would they be undermined, as its application could continue to be demanded by WTO Members. However, Article 24.1 demands the continuous obligation for all WTO Members to accept negotiations on the continuity of the application of these exceptions. TRIPS, *supra* note 2, art. 24.1 (“Members shall be willing to consider the continued applicability of these provisions to individual GIs whose use was the subject of such negotiations.”).

tainty regarding the legal effects of the system may thus increase litigation and, consequently, administrative costs.¹³⁷

As to the voluntary system upon which the U.S.-led Proposal insisted, it is unclear whether non-participating Members would be bound to give protection according to Article 23.¹³⁸ If non-participating Members were not bound, the protections announced in Article 23.4 would be undermined. The literal meaning of the U.S.-led Proposal is based on a political commitment without legal force:¹³⁹ authorities would be bound to refer to the register, yet the register gives rise to no national legal commitment.¹⁴⁰ The U.S.-led Proposal also does not provide for any monitoring mechanism which requires national authorities to “refer” to the lists of GIs on the database. As a result, these national authorities will not know whether to rely on the information included in the system when making a determination on the protection of a GI.¹⁴¹

For these reasons, it is difficult to understand how the mandate to facilitate the protection of GIs established in Article 23.4 would be fulfilled through this system. This proposal would establish a mere juxtaposition of existing national protection systems in a database without legal effects. As such, its value would be minimal. Assuredly, Article 23.4 calls for more ambitious action than this proposal offers. The proposal concentrates on the first part of the job, namely the establishment of a notification system, while the register would simply compile

137. *Minutes of June 28, 2002 Meeting, supra* note 91, para. 69.

138. U.S.-led Proposal, *supra* note 104, art 4 (“The proposed system is entirely voluntary and would not impose undue burdens.”).

139. In the U.S.-led Proposal, the proponents of this system expressly establish that

WTO Members not participating in the system will be encouraged to refer to the WTO Multilateral System for Wines and Spirits, along with other sources of information, in making decisions under their national legislation involving recognition or protection of GIs for wines and spirits in order to ensure that such decisions are based on the most complete information available....

Id. art. 3. This Communication also clarifies that this system will not generate specific obligations for the Members that decide not to participate.

140. *Minutes of June 28, 2002 Meeting, supra* note 91, paras. 69, 75.

141. *Minutes of Feb. 21, 2003 Meeting, supra* note 98, para. 66.

participating Members' information.¹⁴² This does not satisfy the requirement of producing legal effects that registration inherently entails in the context of intellectual property rights.¹⁴³ A database which national authorities might or might not be required to refer to does not constitute a registration system in the intellectual property context. The costs of establishing and operating such a system should not be measured in absolute terms but, rather, in relation to the benefit offered by the system. If transparency alone is the only advantage offered by the proposed U.S.-led system, it might not be sufficient to justify its costs. To "facilitate" the legal protection of GIs under Article 23.4, a multilateral system should help administering bodies implement, and producers and consumers avail themselves of, legal protection.¹⁴⁴

The U.S.-led proposal wrongly emphasizes the convenience of using national systems of trademark protection for GIs.¹⁴⁵ Traditionally, confusion has existed between certification marks and GIs, fundamentally because of their similarities.¹⁴⁶ But, GIs and trademarks are inherently different intellectual prop-

142. The EC Communication takes the view that the U.S.-led Proposal conflates "notification" and "registration" into one concept because registration carries with it no legal effects. See WTO Council for TRIPS, *Communication from the European Communities and their Member States*, WTO IP/C/W/260 (May 30, 2001) (Doc. #01-2709), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple ("It would appear that the provisions on notification and registration are identical in the [U.S.-led Proposal].").

143. This can be deduced from other sections of TRIPS which employ the word "registration," most notably in Part II, Section 2, on trademarks. TRIPS, *supra* note 2, arts. 15, 18–19.

144. See *Minutes of June 28, 2002 Meeting*, *supra* note 91, paras. 68, 81.

145. U.S.-led Proposal, *supra* note 104 ("The proposed system does this by providing an uncomplicated and efficient system for notification and registration of the geographical indications for wines and spirits that we recognized in the national systems of individual WTO Members.").

146. Burkhardt Goebel, *Geographical Indications and Trademarks – The Road from Doha*, 93 TRADEMARK REP. 964, 982 ("Although GIs are recognized as a type of intellectual property pursuant to Art. 1 (2) of the TRIPS Agreement, it is sometimes argued that GIs cannot be considered as another form of intellectual property right since protection to the individual using a GI is effectuated only as a reflex of protecting a certain regional collective goodwill."). In my opinion, however, this interpretation is incompatible with the TRIPS Agreement, which clearly defines GIs as intellectual property rights and as private rights.

erty rights.¹⁴⁷ Requirements applied to certification marks are much simpler than those applied to GIs. Also, the procedures to protect certification trademarks are different from those used for the protection of GIs. In addition, a trademark has a limited duration. Although its registry is renewable, GIs have no expiration date so long as they are protected in their country of origin.¹⁴⁸ Finally, a trademark system does not protect GIs against

147. A conflict not definitively resolved is the relationship between Article 16 of TRIPS (which grants the holder of a registered trademark the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade signs for goods or services which are identical or similar to those with registered trademarks where such use would result in a likelihood of confusion) and the provisions of Part II, Section 3 of TRIPS about the conflict between GIs and trademarks (Articles 22.3, 23.2 and 24.5 of TRIPS, which establish that geographical trademarks that mislead the public can only coexist with GIs when they exist prior to the adoption of TRIPS, granting, consequently, a certain priority to the GIs in conflict). Some authors deduce from Article 16 that this conflict must be resolved according to the principle "First in Time, First in Right" to make compatible public and private interests promoted by both parties. For these authors, GIs must be seen as a "sign" in the Article 16 sense, which would let the holder of a previously registered trademark prevent the use of a concrete GI if there exists a likelihood of confusion. See Norma Dawson, *Locating Geographical Indications – Perspectives From English Law*, 90 TRADEMARK REP. 590, 599 (2000); Harte Baven-damm, *Geographical Indications and Trademarks: Harmony or Conflict?*, in Symposium 1999, *supra* note 128, at 61; Clark W. Lackert, *Geographical Indication: What Does the TRIPS Agreement Require?*, 109 TRADEMARK WORLD 22, 39 (1998); Florent Gevers, *Topical Issues of the Protection of Geographical Indications*, in SYMPOSIUM ON THE PROTECTION OF GEOGRAPHICAL INDICATIONS IN THE WORLDWIDE CONTEXT 154–55 (1997); Vincent E. O'Brien, *Appellations of Origin and Brands of Geographical Significance: A Conflict with Potentially Serious Commercial Implications*, 23 INT'L WINE L. ASSOC. BULL. 34 (2000), available at http://www.aidv.org/bulletin/bull23_09-2000.htm; D. J. Ryan, *The Protection of Geographical Indications*, in ESTUDIOS SOBRE PROPIEDAD INDUSTRIAL HOMENAJE A M. CURREL 425 (2000); W. Taylor, *The Overlap Between Trademarks and Geographical Indications*, 5 INT'L WINE L. ASSOC. BULL. 18 (1999), available at http://www.aidv.org/bulletin/bull31_04-2003.htm. In regard to the relationship between GIs and trademarks, the International Trademark Association (INTA) adopted a resolution in 1997 supporting the "First in Time, First in Right" principle. INTA, Request for Action by the INTA Board of Directors, *Protection of Geographical Indications and Trademarks*, Sept. 24, 1997, at http://www.inta.org/policy/res_geoindtms.html (last visited Oct. 18, 2004). However, from my point of view, Articles 2–24 of TRIPS are *lex specialis* which takes precedence over the general rule for the protection of trademarks set out in Article 16.

148. See TRIPS, *supra* note 2, art. 24.9 ("There shall be no obligation under this Agreement to protect geographical indications which are not or cease to

abusive use in translated form, in connection with modifiers such as “like,” “kind,” “style,” “type,” or “imitation,” or in conjunction with the true origin of the producer. Thus, although the system of certification marks may have certain advantages, in no case could it replace a specific system of protection of GIs, whose creation Article 23.4 demands.¹⁴⁹

The incompatibility of the U.S.-led proposed system with the obligations arising from TRIPS can hardly be overstated. If the trademark system was capable of providing absolute protection to GIs, the question relative to such protection would have been resolved in the trademarks section of TRIPS.¹⁵⁰ In TRIPS, the

be protected in their country of origin, or which have fallen into disuse in that country.”).

149. Possibly, as Michael Maher has stated, GIs and trademarks might communicate different information to the consumer. Maher, *supra* note 12, at 1925 n.47.

A consumer presumably understands that a product may be produced by any business in the region identified by the geographical indication. The geographic term may describe not only the product’s geographic origin, but also might connote specific qualities, features, or characteristics associated with similar products from that location, regardless of the individual identity of their producer.

Id.

150. 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 TRIPS, in addition to the principle of national treatment established in Art. 3. See WTO Council for TRIPS, *Suggested Method for Domestic Recognition of Geographical Indications for WTO Members to Produce a List of Nationally-Protected Geographical Indications*, IP/C/W/134 (Mar. 11, 1999) (Doc #99-0979), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple. This compatibility was reiterated by the United States in the Meeting of the TRIPS Council held on April 21–22, 1999. See WTO Council for TRIPS, *Minutes of Meeting*, IP/C/M/23 (June 2, 1999) (Doc. #99-2220), para. 51, available at http://docsonline.wto.org/gen_search.asp?searchmode=simple. In this meeting, the U.S. Representative affirmed that the protection of GIs by means of certification marks is a system which is compatible with the TRIPS Agreement and constitutes a way to fulfill the Section III obligations. At the same time, however, the U.S. Representative admitted that it was not the only system compatible with the Agreement. See also, Eleanor Meltzer, *Geographical Indications: Point of View of Governments*, Address Before the Worldwide Symposium on Geographical Indications (July 9–11, 2003) (outlining the U.S. position that the trademark regime can protect GIs and the shortcomings of the EC approach), available at <http://www.wipo.int/meetings/2003/geo-ind/en/program/index.htm>.

specific nature of GI protection is embodied in the reference made in Article 22.1 to the quality and particular characteristics of a product coming from a specific area. A link with production in a specific area is, however, alien to the trademark system. The bond with production in a certain zone is not linked to the trademarks system established in Part II, Section 2 of the Agreement. For these reasons, giving priority to the trademark system would simply deny the specificity and the interests of having an ad hoc regime, such as that embodied in Part II, Section 3. Also, it is necessary to keep in mind that trademark protection systems and examination requests relative to those trademarks differ among states. The U.S.-led Proposal would have the effect of transferring the faculty that corresponds with the origin country to decide on the existence of the GIs to the country where the registry request has appeared.

Likewise, it is highly questionable whether the elements of the Hong Kong Proposal could achieve the purpose of the mandated multilateral system enunciated in Article 23.4. Similar to the U.S.-led Proposal, this proposal envisions a voluntary element because Members would be free to notify and register their GIs, but enforcement would vary substantially.¹⁵¹ Seemingly the multilateral system would have legal effects for some Members, but it would really serve as a plurilateral instrument. With regard to the formal examination proposed by the Hong Kong plan, such a simple examination would not facilitate protection¹⁵² because of the significant risk that such a system would contain unreliable information.

The Hong Kong Proposal also established a renewable ten-year term of protection.¹⁵³ This was inspired by the system of protection of trademarks. Nothing in the future system should prejudice how Members implement their obligations under TRIPS, a point of the utmost importance to all delegations. The Hong Kong Proposal fails to understand that, unlike the case of trademarks, TRIPS does not require GI renewal. Rather, GI protection under TRIPS appears to be available for as long it

151. Hong Kong Proposal, *supra* note 117, annex A, para. E.

152. *Id.* annex A, para. B (“The examination process does not involve substantive examination.”).

153. *Id.* annex A, para. C.

was given in the country of origin.¹⁵⁴ Undoubtedly, a renewal system would prove more difficult and costly.

2. The Maximalist Approach

i) The EC Proposal

The proposal advocating maximum protection and legal effect for the GI registration and notification system was presented by the EC and its Member States (EC Proposal).¹⁵⁵ This proposal provides for a full registration system and combines elements from the Lisbon Agreement¹⁵⁶ and EC Regulation 2081/92.¹⁵⁷ This proposal favors clarity and legal certainty on the protection of GIs by advocating for the creation of a system that has

154. There is no indication in Articles 22–24 that a GI is subject to a shorter period requiring renewal measures.

155. WTO Council for TRIPS, Communication from the European Communities and Their Member States, *Proposal for a Multilateral Register of Geographical Indications for Wines and Spirits Based on Article 23.4 of the TRIPS Agreement*, IP/C/W/107 (July 28, 1998) (Doc. #98-2930), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple. The original proposal was revised two years later. WTO Council for TRIPS, Communication from the European Communities and Their Member States, *Implementation of Article 23.4 of the TRIPS Agreement Relating to the Establishment of a Multilateral System of Notification and Registration of Geographical Indications*, IP/C/W/107/Rev.1 (June 22, 2000) (Doc. # 00-2521), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple [hereinafter EC Proposal].

156. The Lisbon Agreement, *supra* note 4. See David R. Downes, *How Intellectual Property Could Be a Tool to Protect Traditional Knowledge*, 25 COLUM. J. ENVTL. L. 253, 273 (2000) (proposing the use of the Lisbon Agreement for the Protection of Appellations of Origin as a model for local, regional, and international registration systems).

157. Under the Regulation (EEC) N. 2081/92 the protected designation of origin (PDO) allows agricultural producers in Member States an exclusive right to the name of a particular foodstuff that is determined to be unique because the production, processing, or preparation takes place in a specific area using local expertise and resources. The protected geographical indication (PGI) also gives an exclusive right to a name for foodstuffs, but unlike the PDO, it does not require unique characteristics associated with a specific geographical environment. EEC N. 2081/92, *supra* note 37. Instead, the PGI grants protection for products due to their reputation. See also S. D. Goldberg, *Who will Raise the White Flag? The Battle Between the United States and the European Union over the Protection of Geographical Indications*, 22 U.P.A. J. INT'L ECON. L. 107, 141–44 (2001); CORTÉS MARTÍN, *supra* note 29, at 325–451.

several stages.¹⁵⁸ In the first stage, Members notify their domestic GIs together with regional, bilateral, or multilateral agreements protecting such GIs and proof of compliance with the definition of GIs to the Secretariat.¹⁵⁹ In the second stage, the Secretariat notifies all Members of the submission.¹⁶⁰ The Members then have an eighteen-month period in which to examine the submission.¹⁶¹ During that period, each Member may challenge the registration of the GI on any of the following four

158. The European Commission asserts that GI protection provides competitive benefits. European Commission, Agricultural Directorate General VI, *Agricultural Report 1998: Quality - Winning Markets and Reputation*, at http://europa.eu.int/comm/agriculture/publi/review98/p09_en.htm (last visited Oct. 18, 2004). The Commission participates in publicity campaigns, declaring the high quality of the products with a given designation, to raise awareness of the GIs both within the EC as well as in other markets. Not all commentators, however, share such a sanguine view of geographic indications. See, e.g., Charles Lister, *Protectionism and Integration: Designations of Origin for Foodstuffs in the European Community*, 47 *FOOD & DRUG L.J.* 639, 639-40 (1992). One perspective sees Regulation 2081/92 as a protectionist policy, disguised under the banner of food quality. Such a policy actually contravenes the EC's overriding purpose of market integration. *Id.* For a similar criticism leveled against trademarks, see M.A. Cunningham, *A Complementary Existence: An Economic Assessment of the Trademark and Competition Law Interface in the European Community*, 10 *TUL. EUR. & CIV. L.F.* 141, 150 (1995) ("Perception advertising distorts competition by deflecting sales from lower-priced substitutes of equal or greater quality by differentiating products in the eyes of a target audience solely on the basis of a perception.").

159. EC Proposal, *supra* note 155.

Notification to the Secretariat shall be accompanied by ... *prima facie* evidence of the geographical indication's conformity with the provisions of the Agreement.... Each participating Member may provide any other information it considers useful for the Agreement's implementation and for national application of the Prohibition on the use of geographical indications for non-originating products.

Id. (emphasis added). As to the question of what kind of proof would be appropriate, Members should not limit themselves as to what should be recognized as acceptable proof, in order to take into account the different legal systems in WTO Members. It could be the relevant legislation, but it could also be national certificates of registration, information on the original characteristics of the product, statistics of production, national regulations on the quality applicable to the product and the existence of producers' associations. Certainly, elements of proof should fully support an application for registration, and when objections to a registration are being raised, they should fully support the objections.

160. *Id.* para. C.

161. *Id.*

grounds for opposition: non-compliance with the general definition of a GI;¹⁶² absence of protection in the country of origin,¹⁶³ genericness,¹⁶⁴ and that the use of the GI would be misleading.¹⁶⁵ During the eighteen months following the publication by the Secretariat, the Members would be able to examine the GI's legitimacy by requesting explanations from the Member who presented the registration request. During this period, if a Member properly challenged the protection of a proposed GI, bilateral negotiations would be undertaken with the aim of reaching an agreement.¹⁶⁶

As far as who must demonstrate the grounds for opposition, the EC Proposal establishes that, in accordance with the TRIPS provisions and the normal legal practice in the WTO, the Member invoking the benefit must demonstrate that it has fulfilled the necessary conditions.¹⁶⁷ According to this principle, Members must invoke the exception and prove its applicability if the Member trying to register the GI does not agree.¹⁶⁸

Once the period of eighteen months from publication ends, the GI would be inscribed in the register.¹⁶⁹ If, during that time, there has been no opposition, the EC Proposal establishes that

162. See TRIPS, *supra* note 2, art. 22.1.

163. See *id.* art. 25.9.

164. See *id.* art. 24.6.

165. See *id.* art. 22.4.

166. EC Proposal, *supra* note 155, sec. C.2.

167. According to the TRIPS Agreement and the normal legal practice in the WTO, if a party wishes to invoke a benefit, it must demonstrate that it has fulfilled the necessary conditions. This principle is solidly stated in WTO and GATT case law. See, e.g., WTO Report of the Appellate Body, *United States - Measure Affecting Imports of Woven Wool Shirts and Blouses from India*, WT/DS33/AB/R (Apr. 25, 1997) (Doc. #97-1773), 7-9, available at http://docsonline.wto.org/gen_search.asp?searchmode=simple; WTO Report of the Panel, *Canada - Term of Patent Protection*, WT/DS170/R (May 5, 2000) (Doc. #00-1695), para. 6.10, available at http://docsonline.wto.org/gen_search.asp?searchmode=simple; WTO Report of the Panel, *United States - Section 211 Omnibus Appropriations Act of 1998*, WT/DS176/R (Aug. 6, 2001) (Doc #01-3806), sec. 3, available at http://docsonline.wto.org/gen_search.asp?searchmode=simple.

168. EC Proposal, *supra* note 155. The proposal speaks of "justified opposition," although nothing is said of who judges whether opposition is justified. *Id.* para. C.2. From my point of view, TRIPS Council can play a decisive role in the development of this function, in association with the tasks entrusted to it in Articles 24.2 and 68.

169. *Id.*

no Member will be able to reject the protection alleging that it does not fulfill the conditions demanded in the general definition.¹⁷⁰ Members also may not allege that the GI, although literally true as to the territory in which the goods originated, falsely represents that the goods originated in another territory.¹⁷¹ Moreover, Members may not allege that the GI deals with a generic term.¹⁷² It is possible, however, to deduce *sensu contrario* that the other exceptions to the protection will continue to be demanded by any Member.¹⁷³

From its inscription in the register, the GI would benefit from unconditional protection in the markets of all Members, as it would then be considered *prima facie* compatible with the definition in Article 22.1 and consequently deserving of protection.¹⁷⁴ Nevertheless, such presumption could be refuted if use of a GI was the object of a controversy before a national tribunal.¹⁷⁵ The register would protect GIs of other Members, since national jurisdictions and trademarks offices would have concise and clear information at their disposition. The list of GIs that had been registered would be published so that all the operators might know the inscription in the register. Consequently, the GIs would benefit from the presumption of protection. In addition, the EC Proposal mandates that Members will have to establish legal means so that the interested parties use the registration as a presumption of GI protection.

170. See TRIPS, *supra* note 2, art. 22.1.

171. See *id.* art. 22.4.

172. See *id.* art. 24.6.

173. Although in accordance with Article 24.1 of TRIPS, this WTO Member must agree to enter into negotiations aimed at increasing the protection of individual GIs. Furthermore, the provisions of paragraphs 4–8 of Article 24 may not be used by the WTO Member to refuse to conduct negotiations or to conclude bilateral or multilateral agreements. In the context of such negotiations, Members shall be willing to consider the continued applicability of these provisions to individual GIs whose use was the subject of such negotiations. See Knaak, *supra* note 40, at 135.

174. EC Proposal, *supra* note 155.

175. *Id.*

Concerning the problem of homonymous GIs,¹⁷⁶ the proposal establishes the principle of coexistence in order to avoid deceptive practices vis-à-vis the consumer.¹⁷⁷ Negotiations could take place at that point between Members to avoid such fraud. Further, once any opposition procedure has been concluded, the GI would be registered by the Secretariat and thereby benefit from unconditional TRIPS-level protection. Finally, the EC Proposal establishes that the registration system should take into account future developments, such as when a GI was no longer used or a new GI had come into being.¹⁷⁸

ii) Critical Appraisal: Why the EC Proposal Works Best

The EC Proposal is the only one that facilitates multilateral GI protection as Article 23.4 prescribes. The principal characteristic of the EC Proposal is its concept of a full registration system. Although voluntary, the system proposed by the EC would provide that once a GI was registered it would bind all WTO Members. Rights to oppose registration would counterbalance this legal obligation. It, therefore, does not create new obligations, as any Member would have the opportunity to oppose a registration under the EC Proposal.¹⁷⁹

But, is a system which creates legal effects at the international level really necessary to facilitate protection? There are several reasons why it is necessary, but the most important is that international legal effects would make GI protection easier to implement by providing that registered GIs benefit from a presumption of eligibility for protection.¹⁸⁰ The system would enable producers to reduce costs as they would have easier access to the legal means available to them to secure and enforce

176. See TRIPS, *supra* note 2, art. 23.3. Homonymous geographical indications entail the use of two or more identical geographical indications used to designate the geographical origin of products stemming from different countries. The most frequent cases of homonymous geographical indications concern the names of regions which are located in different countries. An example for such a region would be an area situated along a river running through several countries, such as the Rhine.

177. EC Proposal, *supra* note 155, para. D.

178. *Id.* para. E.

179. *Id.* para. C.2.

180. *Id.* art. 11.

the level of protection prescribed in Articles 22 and 23.¹⁸¹ Producers would not feel compelled to seek protection of their GIs by way of prevention in Member countries. Occasional free-riding of a notified GI would be discouraged because producers using GIs registered by other countries would have to bear the burden of proof and incur litigation costs.

In case of litigation, the register would be a tool for these producers to “facilitate” the protection of their GIs by shifting the burden of proof. This could be particularly valuable for producers in developing countries who might not otherwise have the means to assert their rights in all markets. The notification, examination, and opposition phases should therefore be considered an investment in the system’s viability; the costs involved would be offset by the benefit that would be derived from effective protection.¹⁸² Without a presumption of eligibility, in most cases it would be difficult, if not impossible, for the average right-holder of a GI to enforce his rights under Article 23, because he would have to build a case from scratch before local courts. In certain cases, litigants would be thousands of kilometers from home and under completely different legal systems. This inconvenience would threaten the Members’ clear intention to provide Article 23-level protection to GIs for wines and spirits. Under the EC Proposal, producers with a policy of international expansion would be able to save costs when defending their names around the world.

Public administrations would have timely information that allows them, for example, not to register trademarks containing such GIs, as prescribed by Article 23.2. As a result, a system with legal effects at the international level is necessary to facilitate protection because usurpation would diminish and, in turn, litigation and administration costs would decrease. Again, this

181. *Id.*

182. The representative of Switzerland stated in the TRIPS Council meeting held on November 28, 2002, that “[t]he notification, examination and opposition phases should therefore be considered as an investment for the usefulness and viability of the system; the costs involved would be off-set by the benefit derived from a real facilitated protection.” WTO Council for TRIPS, Special Session, *Minutes of Meeting*, TN/IP/M/4 (Feb. 6, 2003) (Doc #03-0786), para. 94, available at http://docsonline.wto.org/gen_search.asp?searchmode=simple.

means that the EC Proposal would make GI protection easier to implement. Under the proposal, registered GIs benefit from a presumption of eligibility for protection; moreover, piracy is discouraged. These two features benefit all parties: producers, consumers, and administrations.¹⁸³

Nevertheless, the EC Proposal is not free from criticism. Certain aspects create difficulties. In particular, the reach of the effects of decisions adopted within the opposition procedures are exclusively limited to the parties.¹⁸⁴ This limitation of effects could easily lead to a situation where a notified GI which does not satisfy Article 22.1, or which constitutes a generic term opposed successfully by Members, would have to be protected by non-participating Members opposing the procedure. This would lead to the incongruity of two different categories of GIs: those inscribed in the register to which all Members would have to give total protection, and those whose registration would have been rejected by some Members. Those who had not objected would be forced to grant total protection. It is clear that this would harm legitimate commercial interests in all markets, not only for Members who did not oppose within the term and, for that reason, are forced to protect the registered indication, but also Members who carried out the opposition successfully.¹⁸⁵

183. *But see*, Goebel, *supra* note 146, at 986 n.72 (arguing that most of the existing multilateral systems of notification and registration, such as under Art. 6ter of the Paris Convention, the Hague Agreement in the field of industrial designs and the Madrid Protocol in the field of trademarks, all rely ultimately on determinations under domestic law to determine eligibility and protection). See WTO Council for TRIPS, Special Session, Revised Note by the Secretariat, *Discussion of the Establishment of a Multilateral System of Notification and Registration of Geographical Indications for Wines and Spirits: Compilation of Issues and Points*, TN/IP/W/7Rev.1 (May 23, 2003) (Doc. #03-2761), para. 57, available at http://docsonline.wto.org/gen_search.asp?searchmode=simple.

184. The EC Proposal states explicitly that "Members who have not challenged, within 18 months, the registration of an individual geographical indication under provision C.2 shall not refuse its protection on the basis of Articles 22.1, 22.4 and 24.6 of the TRIPS Agreement." EC Proposal, *supra* note 155, para. D.

185. See Goldberg, *supra* note 157, at 117.

This result seems to violate TRIPS in two ways: (1) if a Member can only oppose an application based on reasons stemming from the TRIPS Agreement, then a successful opposition means the geographical indication is not protectable under TRIPS; and (2) if only the op-

Certainly, some exceptions provided in the TRIPS Agreement have a specific character depending on national markets. Thus, the question of whether a GI has become a generic term under 24.6 could surface in a national market, but not necessarily in others. But, other reasons for successful opposition have a more general reach and, subsequently, must prevent the protection in all markets to obtain the true objective of Article 23.4. Hence, when a proposed GI to the register does not fulfill the criteria of the general definition of Article 22.1, it must not be allowed to accede to the register at all in order to avoid undermining the credibility of the system.

In order to avoid these problems, the system must differentiate between absolute and relative reasons for opposition.¹⁸⁶ The absolute opposition would be based on paragraphs 1 or 4 of Article 22.¹⁸⁷ The relative reasons for opposition would consist of the exceptions to the protection established in paragraphs 4, 5 or 6 of Article 24.¹⁸⁸ GIs having been opposed with a favorable result on the basis of the relative reasons for opposition could be registered, and Members who did not participate in the opposition procedure will be unable to deny protection. The refusal of the protection will be justified solely by the Member who has

posing Member need not protect the geographical indication, then it seems that the MFN Clause under Article 4 would be violated. A way to solve this problem with the EC Proposal is: when a geographical indication is successfully opposed, it should not be registered at all.

Id.

186. The system proposed by Hungary provides for a “multilateral possibility to challenge the registration of a notified geographical indication and that the results of a successful challenge, where appropriate, should apply on an *erga omnes* basis.” WTO Council of TRIPS, Communication from Hungary, *Incorporation of Elements Raised by Hungary in IP/C/W/234 Into the Proposal by the European Communities and their Member States on the Establishment of a Multilateral System Notification and Registration of Geographical Indications*, IP/C/W/255 (May 3, 2001) (Doc #01-2271), para. 2, available at http://docsonline.wto.org/gen_search.asp?searchmode=simple.

187. The two grounds for absolute opposition involve failure to meet the definitional standards of Article 22, Paragraph 1. The other absolute bar is Paragraph 4 which states, “[t]he protections under paragraphs 1, 2 and 3 shall be applicable against a [GI] which, although literally true as to the territory, region, or locality in which the goods originate, falsely represent to the public that the goods originate in another territory.” TRIPS, *supra* note 2, art. 22.4.

188. Article 24, paragraphs 4, 5 and 6 involve previous use, use by a trademark, and genericness within a Member State, respectively. *Id.* art. 24.

opposed the register with a favorable result, and this information must be entered into the register.¹⁸⁹

189. Apart from these proposals presented by WTO Members, non-governmental organizations (NGOs) are also trying to participate in these negotiations, as is shown by the paper presented by the INTA about the multilateral system for the notification and registration of GIs, and by the International Chamber of Commerce, regarding the expansion of additional protection for products other than wines and spirits. The INTA submitted its Proposal for the system in April 2003. International Trademark Association, *Establishment of a Multilateral System of Notification and the Registration of the Geographical Indications for Wines and Spirits Pursuant to TRIPS Article 23(4)*, Feb. 28, 2003, available at http://www.inta.org/downloads/tap_GIpaper.pdf. INTA recognizes that GIs need to be enforceable, without creating undue barriers to trade. "INTA is convinced that it is possible to achieve a harmonious co-existence of protection systems for GIs and other intellectual property rights, including trademarks...." Conflicts between these rights should be resolved pursuant to the well-established intellectual property principles of territoriality, exclusivity, and priority. INTA believes that no means of intellectual property protection is superior or inferior to another. INTA is of the opinion that the facilitation of the protection of GIs through the system should be based on the experience gained under other multilateral instruments for the protection of intellectual property rights, in particular, the Patent Cooperation Treaty (PCT) and the Madrid System. From those two well-established systems INTA extracts a number of features and conditions for the multinational protection of intellectual property rights:

The international notification/registration should be based on the existence of a national application/registration; the notification should be facilitated through an international body; the examination of whether the intellectual property right at issue meets the protection requirements should be carried-out in the country where protection is sought; third parties shall be able to challenge the application and/or registration before the national offices and for national courts in the country where protection is sought.

Id. at 3. Dealing with the substantive examination of GIs and with possible third-party rights through the established and largely well-trained national courts and administrative bodies will provide a particular advantage for smaller and medium-sized companies. For those companies, the costs for persuading a government to take up their case to the WTO will be prohibitive.

Id. at 5. The owner of a medium-sized company

who owns a trademark registration conflicting with a GI in fifty countries would have to persuade the governments of fifty countries to raise an objection with the WTO in order to defend the exclusivity of his prior trademark. The costs involved in such exercise will considerably exceed the costs of filing opposition proceedings or a cancellation action before... the respective national courts.

Id. "Furthermore, in many cases the trademark owner will not succeed in persuading a government to raise an objection on its behalf, since such an

V. EXPANSION OF THE SYSTEM: ADDITIONAL PROTECTION FOR PRODUCTS OTHER THAN WINES AND SPIRITS

The second battleground over GIs is the expansion of Article 23 protection for products other than wines and spirits.¹⁹⁰ Indeed, a large group of WTO Members, especially developing countries,¹⁹¹ have proposed before the TRIPS Council the elimination of existing deficiencies in the sphere of GI protection with a view to applying the same level of protection of wines and spirits to all other products.¹⁹² As a result of the pressure

objection may conflict with the specific government interests in the protection of its own GIs. *Id.* at 6. For that reason, INTA recommends that the system should follow a Madrid-like or PCT-like approach and include the following key-elements: notification/registration through an international body to the participating states, *ex officio* examination of protectability in the country of protection, refusal/opposition on the basis of prior (trademark) rights, ability to challenge the registration in the national courts. *Id.*

A system built on these concepts will facilitate - according to INTA document - the protection of GIs, in the same way that the Madrid System facilitates the protection of trademarks and the PCT facilitates the protection of patents. At the same time, it will recognize that GIs are what they are deemed to be under TRIPS, an intellectual property right, the importance and the value of which equals, but not surpasses, trademarks and patents.

Id.

190. See Addor & Grazioli, *supra* note 5, at 896 (affirming that, "the improved protection of geographical indications 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").

191. The issue of extension is of particular interest to developing countries because of the importance of the remunerative marketing of their agricultural, handicraft and artisan production. In addition, GIs have features that respond to the needs of indigenous and local communities and farmers. See *id.* at 893-95.

192. The call for extension of additional protection for GIs to products other than wines and spirits was confirmed in the Communication from Bulgaria, Cyprus, Cuba, Czech Republic, the European Community and their Member States, Georgia, Hungary, Iceland, India, Kenya, Liechtenstein, Malta, Mauritius, Pakistan, Romania, Slovakia, Slovenia, Sri Lanka, Switzerland, Thailand and Turkey, see WTO Council for TRIPS, *Communication from Bulgaria, Cuba, Cyprus, the Czech Republic, the European Communities and Their Member States, Georgia, Hungary, Iceland, India, Kenya, Liechtenstein, Malta, Mauritius, Pakistan, Romania, the Slovak Republic, Slovenia, Sri Lanka, Switzerland, Thailand and Turkey*, IP/C/W/353 (June 24, 2002) (Doc. #02-3484), available at http://docsonline.wto.org/gen_search.asp?searchmode

exerted by developing countries, this issue ranks very high on the negotiating agenda of the WTO.¹⁹³

A. The TRIPS Agreement's Preferential Treatment of Wines and Spirits

Presently, TRIPS provides two levels of protection for the same intellectual property right. Article 22's base level of protection is limited to cases where the public is misled as to the true geographical origin of a product or where GI use constitutes an act of unfair competition. Article 23 enhances the level of protection for wine and spirit GIs beyond that provided for in Article 22. The "misleading test" as applied to Article 22 is a burdensome requirement tailored to suit laws for protection against unfair competition or protection of consumers, but not protection of intellectual property. In particular, the condition that existing protection only apply to the extent needed to prevent "misleading the public" results in wide legal uncertainty. Unlike Article 23, Article 22 does not prevent the use of GIs in translation¹⁹⁴ or if they are accompanied by expressions such as "style," "type," "kind," or "imitation," thus enabling free-riding on renowned GIs. Nor does it prevent free-riding on the efforts and hard work employed to make a GI renowned. All such free-

=simple [hereinafter Switzerland Proposal for Extension]; see also WTO Council for TRIPS, *Proposal from Bulgaria, Cuba, the Czech Republic, Egypt, Iceland, India, Jamaica, Kenya, Liechtenstein, Mauritius, Nigeria, Pakistan, Slovenia, Sri Lanka, Switzerland, Turkey and Venezuela*, IP/C/W/247/Rev.1 (May 17, 2001) (Doc. #01-2491), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple.

193. See WTO Trade Negotiations Committee, *Statement by the Chairman of the General Council*, Doc. TN/C/1 (Feb. 4, 2002) (Doc #02-0530), at sec. 3, Agenda Item 2, available at http://docsonline.wto.org/gen_search.asp?searchmode=simple. The Chairman of the General Council of the Trade Negotiations Committee proposed that the Negotiations Committee should address issues in paragraphs 18 and 19 of the Doha Ministerial Declaration relating to TRIPS in regular meetings of the TRIPS Council on a priority basis.

194. Goebel argues that one way of dealing with this issue is to try to define more adequately the scope of protection provided for under Article 23. Goebel, *supra* note 146, at 989 ("Instead of providing general protection for 'use in translation' the scope of protection should properly be defined as use in translation, if that translation is associated by the relevant consumer groups with the geographical origin of the product.").

riding should be prohibited to avoid the risk of GIs becoming generic terms.¹⁹⁵

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 1990.¹⁹⁶ This was, to some extent, due to the link at that time between negotiations on GIs and agriculture.¹⁹⁷ Today, there are no economic or systemic reasons for protecting some GIs and not others. As the sponsors of additional protection for products other than wines and spirits have stated, the risk of confusion between products which originate in a specific region and have special qualities, and products which use the same denomination, but do not have these qualities is damaging to any product.¹⁹⁸

B. Advocating for Expansion of GI Protection to Other Products

The economic and political significance of GIs grows as increasing quality awareness and requirements increase demand for products of a specific geographical origin.¹⁹⁹ The added value of exported goods increases chances for legitimate goods to reach the market, which is part of the global vision for a multilateral trading system.²⁰⁰ 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 in-

195. Switzerland Proposal for Extension, *supra* note 192, sec. III, para. B.

Illegitimate use of a geographical indication with a “*délocalisant*” (i.e., so-called semi-generics) indicating the true origin or use in translation or with expression such as “kind,” “type,” “style,” “imitation,” or the like, will be prevented for all geographical indications alike and will help therewith prevent more geographical indications from becoming generic, thereby gradually losing all economic value.

Id.

196. For the importance of the Brussels Ministerial Conference of 1990 on the negotiating process and the final text of the TRIPS Agreement, see GERVAIS, *THE TRIPS AGREEMENT: DRAFTING HISTORY AND ANALYSIS*, *supra* note 60, at 73–74.

197. See, *Understanding the WTO: Developing Countries*, *supra* note 57.

198. Switzerland Proposal for Extension, *supra* note 192.

199. *Id.* sec. II.

200. *Id.*

creased and spread among WTO Members.²⁰¹ Extension of Article 23-level protection would provide an adequate level of protection to GIs for all products, facilitating product identification by the consumer and, therefore, enhancing consumer choice.²⁰² Extension would open new market opportunities by preventing trade distortions.²⁰³ The benefits resulting from extension would foster the development of local rural communities and encourage a high-quality agricultural and industrial policy. As is the case for products protected via trademarks, those benefiting from adequate GI protection would be in a better position to benefit from enhanced access to third-world markets. As such, a strong GI regime would bring economic benefits to producers worldwide, and not only to producers in countries where the local protection of GIs is already stronger than in the WTO.

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.²⁰⁴ The exceptions provisions of Article 24.6 would continue to apply to such indications.²⁰⁵ The goal of the extension proposal is to prevent GIs, which are not generic, from becoming generic. The proposal presented by these WTO Members also concerns other disadvantages resulting from the insufficient protection provided by Article 22, such as the burden of proof required under that provision to defend a GI against misuse.²⁰⁶

The creation of comprehensive GI protection is not incompatible with the smooth future development of business activities in a country. The same problem has been satisfactorily addressed in the context of wines and spirits, as TRIPS already provides enough flexibility, such as exceptions and transitional periods ensuring that disruption of trade does not occur.²⁰⁷ Transitional periods and exceptions can accommodate the in-

201. *Id.*

202. Maher, *supra* note 12, at 1881 (noting that GIs are important tools for consumer protection and product differentiation in the wine industry).

203. Switzerland Proposal for Extension, *supra* note 192.

204. *Id.* sec. III, para. F.

205. *Id.*

206. *Id.* sec. III, para. E.

207. *Id.* sec. II.4. *See, e.g.*, TRIPS, *supra* note 2, art. 24.4.

terests of producers and make re-labeling unnecessary. Therefore, extension, as such, will not affect the production and export of products.

In summary, the rationale of extension is that GIs for all products deserve the same level of protection as that which applies currently only to wines and spirits. In order to establish such uniform protection for all products and broaden Article 23.1 protections to other products, some WTO Members have proposed removing the reference in Article 23.1 to wines and spirits, and preventing the use of a GI "identifying products of the same category" not originating in the place referred to by it.²⁰⁸ This would eradicate the existing imbalance in Part II, Section 3, thus providing the same level of effective protection to GIs for all products.²⁰⁹

However, many countries, including Argentina, Australia, Canada, Chile, Japan, Mexico, New Zealand, and the United States, have strongly opposed extension, partly because they believe there is no evidence that protection currently available for products other than wines and spirits is inadequate.²¹⁰ They also object because they feel that extending protections would create unnecessary obligations, be significantly costly, and generate limited benefits, if any.²¹¹ Additionally, New Zealand, for example, believes that an extension to the scope of goods covered by Article 23 would be premature.²¹² The majority of these countries has been consistently obstinate about giving strong protection to GIs. While these countries wish to approach negotiations over protection for GIs and expansion of TRIPS slowly, Members that could benefit the most are ready to move full speed ahead.

208. Switzerland Proposal for Extension, *supra* note 192, art. III.B.12.

209. *Id.* sec. II.

210. See Woranuj Maneerungsee, *Protection for Silk and Rice Hits Snags*, BANGKOK POST, Nov. 21, 2002, at 3 (noting U.S. opposition to an extension of geographical identification protection).

211. See, e.g., Meltzer, *supra* note 150, para. 19.

212. WTO Council for TRIPS, Communication from New Zealand, *Geographical Indications and the Article 24.2 Review*, IP/C/W/205 (Sept. 18, 2000) (Doc #00-3673), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple.

VI. FUTURE PROSPECTS IN MULTILATERAL NEGOTIATIONS

The main proposals presented thus far aimed at ensuring effective protection for GIs can be categorized as incompatible, thus, the negotiations on these proposals in the TRIPS Council have been stalled. The views of the different Members are divided, not only by the legal effects of the registration system for GIs, but also by the question of the extension of GIs to products other than wines and spirits.²¹³

With respect to the notification and registration system for GIs, the maximalist approach — represented by the EC Proposal — seems best suited to achieve the objective of facilitating the protection of GIs as prescribed in Article 23.4. Nevertheless, some countries have shown their opposition to the proposal, alleging that this would demand the creation of an exceedingly complex and legally ambitious system.²¹⁴ By contrast, those in favor of the U.S.-led Proposal state that the European system would establish new legal obligations for WTO Members²¹⁵ since they could be bound to verify hundreds of different

213. As a general matter, it has been argued that developing countries may find it in their interest to use GIs as a tool to help create and maintain both domestic and export markets for distinctive goods originating in their territory. See Ralph S. Brown, *New Wine in Old Bottles: The Protection of France's Wine Classification System Beyond Its Borders*, 12 B.U. INT'L L.J. 471 (1994).

214. *Minutes of September 17, 1998 Meeting*, *supra* note 99, at para. 48 (comments from the New Zealand representative).

215. While the European Community is proposing the creation of a register for all foodstuffs, other nations are challenging the very blueprint for this register. At the conclusion of the 1999 Special 301 Review, the United States initiated a WTO dispute-settlement case against the EC based on TRIPS deficiencies in EEC Regulation 2081/92. See WTO, Request for Consultations by the United States, *European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs*, WT/DS174/1 (June 7, 1999) (Doc. #99-2282), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple. The United States argues that EEC Regulation 2081/92's reciprocity requirement violates the National Treatment Principle of Article 3 of the TRIPS Agreement and does not provide sufficient protection to pre-existing trademarks that are similar or identical to a GI and appears to be inconsistent with the European Communities' obligations under TRIPS. The United States argues that the WTO rules require the EC to afford the same GI protection to non-EC states that it offers its own nationals - regardless of whether the non-EC nation has similar GI standards. This could mean that this Regulation does not provide the same treatment to other nationals and products originating outside the EC that it provides to the EC's own nationals and products; does not accord immediately and unconditionally

GIs and face onerous opposition procedures, which will be especially burdensome for Members with limited resources.²¹⁶ More-

to the nationals and products of each WTO Member any advantage, favor, privilege or immunity granted to the nationals and products of other WTO Members; diminishes the legal protection for trademarks (including to prevent the use of an identical or similar sign that is likely to); does not provide legal means for interested parties to prevent the misleading use of a GI; does not define a GI in a manner that is consistent with the definition provided in the TRIPS; is not sufficiently transparent; and does not provide adequate enforcement procedures. Invoking the first step to resolving a trade dispute at the WTO, the United States requested private consultations with the EC before deciding whether to initiate formal dispute settlement proceedings. See WTO Request for Consultations by the United States, Addendum, *European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs*, WT/DS174/1/Add.1 (Apr. 10, 2003) (Doc. #03-1960), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple. However, these consultations failed to resolve the dispute. The U.S.-amended complaint alleged that the EC regulation also violated the MFN Clause of TRIPS. Fifteen WTO Members have joined the consultations: Australia, Mexico, New Zealand, Sri Lanka, India, Argentina, Hungary, Malta, Bulgaria, the Czech Republic, Cyprus, Slovenia, Turkey, Romania and the Slovak Republic. See, e.g., WTO, Communication from Australia, *European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs, Request to Join Consultations*, WT/DS174/4 (Apr. 23, 2003) (Doc. #03-2161), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple. Finally, the United States asked the Dispute Settlement Body to establish a panel. WTO, Request for the Establishment of a Panel by the United States, *European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs*, WT/DS174/20 (Aug. 19, 2003) (Doc. #03-4330), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple. Many other Members also requested to join these consultations. See, e.g. WTO, Request for the Establishment of a Panel by the Australia, *European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs*, WT/DS290/18 (Aug. 19, 2003) (Doc. #03-4315), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple). In addition to these concerns, the United States raises objections to wine import certification practices instituted by the EC, as well as labeling requirements specifically relating to an EC attempt to phase out the usage of semi-generic names (i.e., Burgundy, Champagne, Chablis) on non-EC wines and other “traditional expressions” (primarily geographical indications) used to describe wine. See generally USTR National Trade Estimate Report on Foreign Trade Barriers, available at http://www.ustr.gov/Document_Library/Reports_Publications/2004/2004_National_Trade_Estimate/2004_NTE_Report/Section_Index.html (last visited Oct. 20, 2004); ROBERT M. MACLEAN & BETTINA VOLPI, EU TRADE BARRIER REGULATION: TACKLING UNFAIR FOREIGN TRADE PRACTICES (2000).

216. *Minutes of September 17, 1998 Meeting*, supra note 99, para. 41.

over, the creation of a system with these characteristics would consume a great amount of resources.²¹⁷ These countries opposing the maximalist approach have also insisted that such an approach is incompatible with means used by many WTO Members to protect GIs, such as certification marks, unfair competition law, and common law.

Whether the system should be expanded to establish additional protection for products other than wines and spirits is also hotly contested. A large group of Members, predominantly from developing countries,²¹⁸ supports expansion because the legal system currently provided under TRIPS, including its exceptions, is insufficient for providing strong protection for GIs. These Members believe that additional protection granted for some GIs constitutes arbitrary discrimination against all other products. Conversely, there is another group of countries which believes that additional protection granted only for certain products in the TRIPS Agreement reflects the balance reached in multilateral trade negotiations, and should not, thus, be altered at this stage.²¹⁹

217. *Id.*; see also *id.* para. 45 (declarations of the Australian representative). Likewise, in the meeting held on March 21, 2000, the Australian representative affirmed that it had not been considered necessary under the TRIPS Agreement to override or preempt national decision-making processes on trademark or patent protection to create default global protection for individual intellectual property rights, even for well-known marks which were viewed by some as having global reach. GIs should not become default global rights without reference to the specific commercial conditions and legal situations in the jurisdiction of each Member concerned. WTO, Council for TRIPS, *Minutes of Meeting*, IP/C/M/26 (May 24, 2000) (Doc. #00-2113), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple.

218. The call for extension of additional protection for GIs to products other than wines and spirits is being demanded by the following developing countries: Bulgaria, Cyprus, Cuba, Czech Republic, Georgia, Hungary, Iceland, India, Kenya, Liechtenstein, Malta, Mauritius, Pakistan, Romania, Slovakia, Slovenia, Sri Lanka, Thailand, and Turkey.

219. Opponents, such as the United States, Canada, Argentina, El Salvador, and the Philippines, say that while an international register protecting all foodstuffs may sound appealing, it raises many potential problems. First, they argue that an international register is not necessary because Article 22 already provides sufficient protection for all foodstuffs and many countries have simply not resorted to using Article 22 TRIPS in protecting their products. Second, while the EC and other advocates claim that an international register would benefit all WTO Members (especially developing countries), opponents counter that developing countries have few domestic GIs and

To date,²²⁰ 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.²²¹ This

would, instead, find themselves having to provide extensive legal protection for a large number of foreign GIs. Furthermore, opponents argue that the EC Proposal will not offer protection to nearly as many products as it has stated because many of these product names have become generic terms (which do not receive GI protection under the TRIPS). Third, opponents claim that a global register would impose major costs on producers and consumers. An international register, they say, will force companies to analyze every export market to ensure that their product names are not illegally using a GI protected under that registry. A business using such a GI could be forced to re-name and re-package its goods, the costs of which might be passed along to consumers in the form of higher prices. Finally, they point out that the EC has had numerous problems with its own domestic GI regulation, and suggest that the WTO first create an international register for wines, evaluate its effectiveness, and then discuss the possibility of creating an international register for all other foodstuffs.

220. The Cancun Ministerial Conference ended on September 14, 2003 with no results, after the Chairperson Luis Ernesto Derbez concluded that, despite considerable movement in consultations, Members remained entrenched, particularly on the "Singapore" issues. See WTO Ministerial Conference, Fifth Session, *Ministerial Statement*, WT/MIN(03)/20 (Sept. 23, 2003) (Doc. #03-5034), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple. About the failure of the recent trade talks in Cancun, see Jeffrey Schott, *Unlocking the Benefits of World Trade*, THE ECONOMIST, Nov. 1, 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. See *id.*; J.M. Paugam, *Après Cancun: La double crise de l'OMC*, 477 REVUE DU MARCHÉ COMMUN ET DE L'UNION EUROPÉENNE 230-34 (2004).

221. The Council for TRIPS met on April 7, 2004, for its first special (negotiating) session since the Cancun Ministerial Conference, to continue negotiations on a multilateral register for GIs for wines and spirits. Discussions focused on the key outstanding issues in the negotiating mandate provided in the TRIPS Agreement, with fundamental divisions remaining among Members. Discussions at the meeting broadly fell under the two key outstanding issues related to "participation" and "legal effect." The meeting made virtually no headway, with one observer noting that in contrast to other negotiating areas, such as agriculture, the TRIPS discussions had not even entered the "listening" phase. *TRIPS Council Scrutinises GI Negotiating Mandate*, 8 BRIDGES WEEKLY TRADE NEWS DIGEST 6 (2004), available at <http://www.ictsd.com/weekly/04-04-22/BRIDGESWeekly8-14.pdf> (last visited Oct. 20, 2004). The supporters of the joint proposal believe that the European approach, which would allow Members to challenge proposed registrations and would require registered terms to be protected in all WTO Member countries, would amount to "TRIPS-plus" by increasing the obligations under the TRIPS. In response, the new grouping called the "Friends of Geographical

paralysis is made more evident when these negotiations are compared with those of the Uruguay Round, during which there was considerable pressure.²²² Currently, no pressure exists, nor are there the commitments to negotiate that existed during the Uruguay Round where certain chapters of the final agreement could be combined with others.²²³

Indications,” which included more than 50 Members, noted that such a database would be unreliable – and consequently not “facilitate” protection – if Members were unable to challenge a term internationally. They believe that allowing Members to opt out of the system would make it “plurilateral” rather than “multilateral,” as required by the mandate. Rather than increasing obligations, they stated that the system would simply facilitate Members’ compliance with existing obligations under the Agreement. Hungary also pointed out that, in any case, even the “joint proposal” could be regarded as “TRIPS-plus” as it would require a notification that does not currently exist. *See id.*

222. Coerper has stated that “There is no time schedule for such “negotiations,” nor does it appear that any establishment of such a system need be mandatory – it could be merely informative – as regards to the wine appellations notified and registered by the various members. *See* Milo G. Coerper, *Certification Marks as a Means of Protecting Wine Appellations in the United States*, IPL NEWSLETTER (A.B.A. Sec. Intell. Prop. L.), Spring 1998, at 24.

223. Sergio Escudero, *TRIPs: el alcance de la protección de las indicaciones geográficas*, in TEMAS DE DERECHO INDUSTRIAL Y DE LA COMPETENCIA: PROPIEDAD INTELECTUAL EN EL GATT 163 (Carlos Correa ed., 1997) (highlighting that for some countries, the United States, among others, it is inopportune to conduct the negotiation now. For this author, nothing guarantees the register will be created because there is not a specified period to achieve this goal.). *See also* Coerper, *Certification Marks as a Means of Protecting Wine Appellations in the United States*, *supra* note 222, at 25 (emphasizing the absence of any precise timetable to carry out the negotiations as the main problem the creation of the multilateral register). Nevertheless, it can be clearly deduced that Article 24.1 TRIPS is a commitment for Members to enter into negotiations to increase the protection of certain GIs. This *pactum de negociando* seems, in any case, to include the duty for any WTO Member to negotiate in good faith and avoid illegal delays. *See* North Sea Continental Shelf Cases (FRG v. Den.; FRG v. Neth.), 1969 I.C.J. 3, 46 (Feb. 20) (“The parties to a negotiation] are under an obligation so to conduct themselves that the negotiations are meaningful, which will not be the case when either of them insists upon its own position without contemplating any modification of it.”). Another scholar states:

The idea that states are under an obligation to negotiate, at least in those situations where the extent of their rights can only be defined by reference to the rights of other states, is both the pragmatic and logical consequence of the interdependence of states in the modern world and of the general recognition, by states, practitioners, and students, of international relations of that interdependence.

Nevertheless, the future is certainly not discouraging. In fact, the apparent paralysis that has surrounded the debate in the TRIPS Council could change in the short run. To begin, the Doha Ministerial Declaration placed the protection of GIs on the agenda²²⁴ of WTO trade negotiations,²²⁵ fixing a precise schedule of negotiation that impels creation of the registration system for GIs and expansion of protection for products other than wine and spirits.²²⁶ This mandate provides a definitive impetus to the negotiations that, up to the present day, have been suspended by Members reluctant to accord protection to this legal category. According to the Declaration, the negotiations must conclude no later than January 1, 2005,²²⁷ and will be supervised by a Trade Negotiations Committee which will act under the authority of the General Council.²²⁸ Furthermore, these statements have been reaffirmed by the General Council of the WTO in the Decision about the Doha Work Programme adopted on August 1, 2004.²²⁹

Martin A. Rogoff, *The Obligation to Negotiate in International Law: Rules and Realities*, 16 MICH. J. INT'L L. 141, 183 (1994).

224. See Abbott, *supra* note 23.

225. *Doha Ministerial Declaration*, *supra* note 96.

226. *Id.* para. 18.

With a view to completing the work started in the Council for Trade-Related Aspects of Intellectual Property Rights ... on the implementation of Article 23.4, we agree to negotiate the establishment of a multilateral system of notification and registration of geographical indications for wines and spirits by the Fifth 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 spirits will be addressed in the Council for TRIPS pursuant to paragraph 12 of this Declaration.

Id.

227. *Id.* para. 45.

228. *Id.* para. 46 ("Issues related to the extension of the protection of GIs provided for in Article 23 to products other than wines and spirits will be addressed in the Council for TRIPS, which shall report to the Trade Negotiations Committee, established under paragraph 46 of this Declaration, by the end of 2002 for appropriate action.")

229. See Doha Work Programme, *Decision Adopted by the General Council on 1 August 2004*, WT/L/579 (Aug. 2, 2004) (Doc #04-3297), at 2, available at http://docsonline.wto.org/gen_search.asp?searchmode=simple.

The (General) Council requests the Director-General to continue with his consultative process on all outstanding implementation issues under paragraph 12(b) of the Doha Ministerial Declaration, including

A. The Importance of GI Protection to Developing Countries May Serve as a Catalyst to Further Negotiation

It is apparent from recent debates that developing countries are becoming aware of the importance of GIs as instruments that contribute to the development of their economies.²³⁰ Although these countries might have shown greater interest in this subject during the Uruguay Round,²³¹ lamentably, they did not understand the importance of an effective system of GI protection to defending their cultural, technical and traditional

on issues related to the extension of the protection of geographical indications provided for in Article 23 of the TRIPS Agreement to products other than wines and spirits, if need be by appointing Chairpersons of concerned WTO bodies as his Friends and/or by holding dedicated consultations. The Director-General shall report to the TNC (Trade Negotiations Committee) and the General Council no later than May 2005. The Council shall review progress and take any appropriate action no later than July 2005.

Id.

230. Compare Heald, *supra* note 11, at 656 with E. Durán & C. Michalopoulos, *Intellectual Property Rights and Developing Countries in the WTO Millennium Round*, 2 J. OF WORLD INTELL. PROP. 860 (1999). Heald asserts that increasing protection of GIs will stimulate the exports from developing countries in agricultural and crafts products under the identification of an exclusive GI. In this respect, he mentions the success that is experienced in the U.S. market with Chilean wine. On the other hand, Durán and Michalopoulos assert that there is no evidence that all developing countries will benefit from an extended protection of GIs because this will depend on whether the country is a producer of the merchandise whose GI is protected.

231. During the Uruguay Round, Switzerland showed great interest in protecting GIs for crafts products such as "Swiss Made" for clocks or the image of the Matterhorn for chocolates, see *Communication from Switzerland*, NG11/W/73, in Negotiating Group on TRIPS, *Meeting of Negotiating Group of May 14-16, 1990*, Note by the Secretariat, MTN.GNG/NG11/21 (June 22, 1990) (Doc. #90-0360), para. 41, available at http://docsonline.wto.org/gen_search.asp?searchmode=simple. Some developing countries also rejected limiting the additional protection to wines and spirits, wanted the protection system to cover products of interest to their economies such as coffee, tea or tobacco. See, e.g., WTO, Note by the Secretariat, *Meeting of the Negotiating Group*, MTN.GNG/NG11/28 (Nov. 29, 1990) (Doc. #90-0713), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple. Unfortunately, however, most of these countries did not understand the importance that the system could have in defending its cultural, technical and traditional patrimony, and let the opportunity go. Because of that, these countries will have to make concessions to take up such negotiations again at the present time.

patrimonies.²³² As a result, these countries now will likely be forced to make concessions in order to begin the negotiations again. Even so, pressure exerted by these countries to establish the registration system for GIs and for extension can certainly advance the negotiations.

B. Geographical Indications and Traditional Knowledge

Another factor which could influence the negotiations on the improvement of GI protection is the pressure exerted by some developing countries to establish a mechanism for protection of traditional knowledge within the framework of intellectual property.²³³ These Members place great value in the contribution to development objectives that protection of this knowledge can make.²³⁴ The use of GIs for products of indigenous and local

232. See generally Downes, *supra* note 156, at 268–73 (arguing that intellectual property rights hurt the traditional economies of developing countries, but that GIs may be an intellectual property right more advantageous to their developing economies).

233. In a Communication from Bolivia, Colombia, Ecuador, Nicaragua, and Peru, these countries define traditional knowledge as:

Innovations, creations and cultural expressions generated or preserved by its present possessors, who may be defined and identified as individuals or whole communities, natural or legal persons, who are holders of rights. The economic, commercial and cultural value of this traditional knowledge for its possessors warrants and justifies a legitimate interest that this knowledge be recognized as subject matter of intellectual property. This expectation on the part of those concerned that their traditional knowledge should be given legal recognition has found expression in an increasing number of national, regional and international forums, and is quite as legitimate as the expectations which in the past justified the recognition of the new subjects of intellectual property that were mentioned above by way of example.

WTO Council for TRIPS, *Review of the Provisions of Article 27.3(b), Proposal on Protection of the Intellectual Property Rights Relating to the Traditional Knowledge of Local and Indigenous Communities*, IP/C/W/165 (Nov. 3, 1999) (Doc. #99-4753), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple.

234. Apart from development objectives, WTO Members have alleged some other reasons to remedy these problems about the protection of traditional knowledge. These are, among others, a common economic interest, in the sense that traditional knowledge is a valuable global resource and, hence, international efforts to secure its protection should be actively supported. See, e.g., WTO Council for TRIPS, *Minutes of Meeting*, IP/C/M/32 (Aug. 23, 2001)

(Doc. #01-4090), paras. 134, 136, *available at* http://docsonline.wto.org/gen_search.asp?searchmode=simple (comments by Indonesian and Venezuelan representatives, respectively). More specifically, it has been argued that traditional knowledge has the potential of being translated into commercial benefits by providing leads for the development of useful products and processes, in particular in the pharmaceutical and agricultural sectors, saving time and cost for the biotechnology industry. WTO Council for TRIPS, *Minutes of Meeting*, IP/C/M/28 (Nov. 23, 2000) (Doc. #00-5002), para. 136, *available at* http://docsonline.wto.org/gen_search.asp?searchmode=simple (comments by the Brazilian representative) [hereinafter *Minutes of Sept. 21–22, 2000 Meeting*]; WTO Committee on Trade and Environment, Council of TRIPS, Submission by India, *Protection of Biodiversity and Traditional Knowledge – The Indian Experience*, IP/C/W/198 (July 14, 2000) (Doc #00-2889), *available at* http://www.docsonline.wto.org/gen_search.asp?searchmode=simple. For these reasons, it is in the common interest of mankind to provide conditions that would be favorable to the preservation of traditional knowledge and the continuing vitality of the peoples and communities which generate and develop it. See WTO Council for TRIPS, *Minutes of Meeting*, IP/C/M/30 (June.1, 2001) (Doc. #01-2746), paras. 153, 184, *available at* http://docsonline.wto.org/gen_search.asp?searchmode=simple (comments by Venezuelan and Ecuador representatives, respectively). Other reasons are based on equity: given the important economic value of traditional knowledge, the holders of traditional knowledge should share in the economic benefits derived from that knowledge. WTO Council for TRIPS, Communication from Bolivia, Columbia, Ecuador, Nicaragua, and Peru, *Review of the Provisions of Article 27.3(b), Proposal on Protection of the Intellectual Property Rights Relating to the Traditional Knowledge of Local and Indigenous Communities*, IP/C/W/165 (Nov. 3, 1999) (Doc #99-4753), *available at* http://docsonline.wto.org/gen_search.asp?searchmode=simple. Given that TRIPS requires countries with traditional and indigenous communities to provide intellectual property protection for a broad range of subject matters, including new ones such as plant varieties, biological materials, layout designs and computer software, it is only equitable that traditional knowledge should be given legal recognition. *Id.*; WTO Council for TRIPS, Communication from Cuba, Honduras, Paraguay and Venezuela, *Review of Implementation of the Agreement under Article 71.1, Proposal on Protection of the Intellectual Property Rights of the Traditional Knowledge of Local and Indigenous Communities*, IP/C/W/166 (Nov. 5, 1999) (Doc. #99-4791), *available at* http://docsonline.wto.org/gen_search.asp?searchmode=simple. These countries also have raised an argument for food security, pointing out that local farming communities have over the years developed knowledge systems for the conservation and sustainable use of biological diversity, including through the selection and breeding of plant varieties. The well-established practices of saving, sharing and replanting seeds sustain these communities and ensure their food security. See, e.g., *Minutes of Sept. 21–22, 2000 Meeting*, supra note 234, at para. 142 (comments by the Kenya representative); WTO Council for TRIPS, Communication from Mauritius on behalf of the African Group, *Review of the Provisions of Article 27.3(b)*, IP/C/W/206 (Sept. 20, 2000) (Doc #00-3760), *available at*

communities' traditional knowledge could be valuable tools²³⁵ for such communities seeking to gain economic benefits from their traditional knowledge or to prevent its objectionable commercial use by outsiders.²³⁶ GIs respond to certain indigenous concerns more effectively than do other intellectual property rights.²³⁷ In particular, rights to control GIs can be maintained in perpetuity; they do not confer a monopoly right over the use of certain

http://docsonline.wto.org/gen_search.asp?searchmode=simple. Finally, environmental protection is suggested as a reason to use GIs to protect traditional knowledge of indigenous peoples and local communities because traditional knowledge is central to their ability to operate in an environmentally sustainable way and to conserve genetic and other natural resources. Protection of traditional knowledge is therefore, according to these countries, closely linked to the protection of the environment. See WTO Council for TRIPS, *Minutes of Meeting*, IP/C/M/30 (June.1, 2001) (Doc. #01-2746), para. 184, available at http://docsonline.wto.org/gen_search.asp?searchmode=simple (comments Ecuador representatives).

235. See Daniel J. Gervais, *The Internationalization of Intellectual Property: New Challenges from the Very Old and the Very New*, 12 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 929, 960 (2002) (noting that the example of GIs show that, in certain cases, rights can be granted to "representatives" of a group or a community); 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 (Dec. 3, 2001) (stating that GIs could be used to afford adequate legal protection of traditional knowledge, including indigenous designs, and various expressions of folklore), available at http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=1994.

236. To date, the debate on intellectual property rights and biodiversity has focused on patents and on plant breeders' rights. Downes, *supra* note 156, at 269. However, the potential value of GIs warrants greater attention. See, e.g., GRAHAM DUTFIELD, CAN THE TRIPS AGREEMENT PROTECT BIOLOGICAL AND CULTURAL DIVERSITY? 20-23 (African Centre for Technology Studies, Biopolicy International Series No. 19, 1997).

237. *Survey of Existing Forms of Intellectual Property Protection for Traditional Knowledge*, *supra* note 235. In the WTO, the view has been expressed that under certain circumstances GIs could be a particularly important way of protecting traditional knowledge. For example, the European Community has stated that in the context of traditional knowledge, geographical indications could play a complementary role in protecting traditional products under certain circumstances. See WTO Council for TRIPS, *Minutes of Meeting*, IP/C/M/32 (Aug. 23, 2001) (Doc. #01-4090), para. 136 (comments by Venezuelan representatives), available at http://docsonline.wto.org/gen_search.asp?searchmode=simple.

information, but simply limit the class of people who may use a specific symbol.²³⁸

The concession of patents or other intellectual property rights to people other than populations where the traditional knowledge originated has preoccupied more and more countries.²³⁹ They are just beginning to demand the establishment of international measures of protection. Considering that most of these products are made following traditional methods which enjoy a quality, reputation, or other characteristic that can be attributed to their geographical origin, these products could benefit from GI protection; such protection could, at least, play a complementary role in their protection.²⁴⁰ It would be worthwhile to explore the role that GIs could play in promoting the goals of the Convention on Biological Diversity,²⁴¹ which recognizes the existence of defined geographical areas that require regulation

238. See Downes, *supra* note 156, at 271 (noting that GIs are designed to reward goodwill and reputation created or built up by a group of producers over many years and in some cases over centuries).

239. The Basmati case is a good example of granting a patent to people other than the populations that originated the knowledge. Basmati is a variety of rice from the Punjab provinces of India and Pakistan. The rice is a slender, aromatic long grain variety that originated in this region and is a major export crop for both countries. Annual basmati exports are worth about \$300 million, and represent the livelihood of thousands of farmers. The "Battle for Basmati" started in 1997 when the U.S. rice breeding firm RiceTec Inc. was awarded a patent (US5663484) relating to plants and seeds, seeking a monopoly on various rice lines, including some having characteristics similar to Basmati lines. Concerned about the potential effect on exports, India requested a re-examination of this patent in 2000. The patentee, in response to this request, withdrew a number of claims including those covering basmati type lines. Further claims were also withdrawn following concerns raised by the USPTO. The dispute has, however, moved on from the patent to the misuse of the name "Basmati." In some countries the term "Basmati" can be applied only to the long grain aromatic rice grown in India and Pakistan, while in others it is considered generic. For additional information on this case, see JAYASHREE WATAL, *INTELLECTUAL PROPERTY RIGHTS IN THE WTO AND DEVELOPING COUNTRIES* 272–73 (2001).

240. GIs are especially suitable for use by indigenous and local communities since they are based upon collective traditions and a collective decision-making process, protect and reward traditions while allowing evolution, emphasize the relationships between human cultures and their local land and environment, are not freely transferable from one owner to another, and can be maintained as long as the collective tradition is maintained.

241. Convention on Biological Diversity, June 5, 1992, 31 I.L.M. 818.

to aid in conservation. The original products of these areas²⁴² could be classified as GIs if the producers decide to link their collective norms and connected traditional knowledge to the conservation.²⁴³ The creation of GIs could bring economic rewards to communities seeking to market products based upon sustainable, traditional production practices.

Notable in this respect are observations of WIPO's intergovernmental committee on Intellectual Property and Genetic Resources, Traditional Knowledge, and Folklore that some forms of intellectual property rights cover the content of knowledge, others a specific expression, and others a distinctive sign or

242. One example of indigenous peoples' use of identification of origin as a tool to protect cultural forms and their use comes from the southwestern region of the United States. There, artisans of several Native American tribes earn as much as \$800 million annually from commercial sales of arts and crafts. For instance, the distinctive styles of Pueblo pottery, silver jewelry, and other items such as drums are well known. Styles and designs are considered a cultural heritage. In Zuni, a design may be the property of a certain family and no person outside that family has the right to use it. These indigenous communities were concerned that non-indigenous producers were using non-traditional methods to produce similar products that they passed off as indigenous traditional goods. In response, the state of New Mexico enacted the Indian Arts and Crafts Protection Law. The law places a duty on retailers of native arts and crafts to investigate whether goods are produced by indigenous persons by hand using natural materials. Only if a good passes this test can it be labeled "an authentic, Indian, hand-made piece." Controversy continues because the law does not address whether goods are produced by traditional methods. Although this example is unrelated to biodiversity, it offers significant lessons for indigenous control of traditional knowledge. See Sandra Lee Pinel & Michael J. Evans, *Tribal Sovereignty and the Control of Knowledge*, in INTELLECTUAL PROPERTY RIGHTS FOR INDIGENOUS PEOPLES, A SOURCEBOOK 41, 44-48 (Tom Greaves ed., 1994). Through similar mechanisms, there may be opportunities to gain benefits from products of biological resources produced through traditional methods or based on traditional knowledge. See generally DAVID R. DOWNES & SARAH A. LAIRD, INNOVATIVE MECHANISMS FOR SHARING BENEFITS OF BIODIVERSITY AND RELATED KNOWLEDGE: CASE STUDIES ON GEOGRAPHICAL INDICATIONS AND TRADEMARKS (UNCTAD Biotrade Initiative, The Center for International and Environmental Law ed., 1999), available at <http://www.ciel.org/Publications/pubbbaw.html> (last visited Aug. 16, 2004).

243. DOWNES & LAIRD, *supra* note 242, at 10 ("[M]ore than other major types of intellectual property, geographical indications have features that respond to norms for use and management of bioresources and traditional knowledge that are characteristic of the culture of many indigenous and local economies.").

symbol.²⁴⁴ Thus, the possibility of a product being protected by these complementary, though overlapping, instruments of intellectual property is very real. By way of example, consider handicrafts: their technical content may be protected as a technical idea, while GIs could protect their cultural value. One important finding of the Committee's "Review of Existing Intellectual Property Protection of Traditional Knowledge" was that while many countries considered few intellectual property instruments suitable for protecting traditional knowledge, some looked favorably upon GIs.²⁴⁵

VII. CONCLUSION

What is the best way to protect, at an international level, the names of well-known products, such as Rioja wine or Idaho Potatoes, which have reputations known by consumers around the world? Do current international rules provide sufficient safeguards, or should governments implement another system of more effective protection? These are the questions that need to be solved by WTO Members within the scope of the Built-In Agenda of the TRIPS Agreement.

The analysis of the TRIPS Agreement's provisions emphasizes that it offers legal instruments for the protection of future GIs while also protecting the illegal use of GIs already in use before the TRIPS Agreement went into effect.²⁴⁶ Although these

244. See 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/5/12 (Apr. 3, 2003), available at http://www.wipo.int/documents/en/meetings/2003/igc/pdf/grtkf_ic_5_12.pdf.

245. See 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 (May 6, 2002), available at http://www.wipo.int/documents/en/meetings/2002/igc/pdf/grtkfic3_7.pdf.

246. It could be said that the "sins of the past," the expression so often used to talk about the first legislative developments relative to GI protection, still have not been purified. This expression has often been used to describe the incapacity of the first international legislative developments to prevent GIs which had properly functioned to indicate that a product came from a certain place, but were later transformed in another country into a generic designation of a type of product. This expression is mentioned often by scholars. See, e.g., GERVAIS, *THE TRIPS AGREEMENT: DRAFTING HISTORY AND ANALYSIS*, *supra* note 60, at 203; Albrecht Krieger, *La revision de l'Arrangement de Lisbonne*

provisions undoubtedly represent a considerable improvement in international protection with respect to that which existed under WIPO, TRIPS did not create a complete system for the international protection of GIs. Quite the contrary, these provisions continue generating considerable legal uncertainty. This is also true with regard to the existing imbalance between protection levels, leading to an additional level of GI protection for wines and spirits, as compared to other products.

For these reasons, the work on TRIPS is far from finished and the debate between new and old world countries continues to be divisive in the furtherance of TRIPS' goal of protecting intellectual property and global economic interests. By virtue of the program incorporated into the text of the Agreement, the provisions relative to the protection of GIs do not constitute a body of static norms; thus, the Agreement must evolve towards a more effective model of protection.

However, until now, debates in the TRIPS Council have been deadlocked. Different Members are divided over the nature, reach, effects, and coverage of the registration system for GIs. With respect to the notification and registration system for GIs, the minimalist approach presents the great disadvantage of limiting itself to creating a simple database without consistent legal effects. This approach is not of a multilateral character and does not help facilitate WTO protection for GIs. The proposal is silent on the need for elements of proof or an opposition procedure — elements indispensable to a future multilateral register. Therefore, this system risks creating more confusion than clarity about which products should be given Article 23-level protection.

The maximalist approach, as represented in the EC Proposal, is better suited to achieve the objective of facilitating the protection of GIs as prescribed in Article 23.4. The system proposed would be truly multilateral, as mandated in Article 23.4, because it would have legal effects on all Members. It would thus facilitate protection already available under the TRIPS

concernant la protection des appellations d'origine, 9 LA PROPRIÉTÉ INDUSTRIELLE 399, 406 (1974) (Krieger cites to the term “péchés du passé” (“sins of the past”) but attributes the expression to Moser v. Filseck); Knaak, *supra* note 40, at 116; Dawson, *supra* note 147, at 590 (“this must be seen as a bargaining position, not a crime and still less a sin.”).

Agreement and would, therefore, favor legitimate users of GIs, consumers, and administrations alike. It would also guarantee legal certainty as one of the key elements of the multilateral system. From my point of view, it is clear that only a meaningful and truly multilateral system could fulfill the mandate that had been contained in the Built-In Agenda of TRIPS. Nevertheless, some countries have shown their opposition to the latter proposal by alleging that this would demand creation of an overly complex system.

Opinions are also divided with respect to the extension of GI protection provided under Article 23 to products other than wines and spirits. For some countries, the legal system provided under the TRIPS Agreement is insufficient. Moreover, additional protection granted for wines and spirits constitutes arbitrary discrimination against all other products. But, for another group of countries, the additional protection granted only for certain types of products reflects the balance reached in the multilateral trade negotiations.

Nevertheless, the apparent paralysis that has surrounded the debate in the TRIPS Council could change soon. GIs are on the agenda of WTO trade negotiations, which establishes a precise negotiating schedule for the creation of the registration system and the expansion of additional protection for products other than wine and spirits, assuming that the necessary consensus is reached. This has been recently reaffirmed by the General Council of the WTO.

In addition, when approaching the negotiations of the Built-In Agenda, the TRIPS Council must consider the repercussions from the perspective of commerce and development in developing countries. The subject of GIs is of particular interest to developing countries because of the importance to those countries of the remunerative marketing of their agricultural production. Additionally, the assistance of GI protection to traditional knowledge would be vital. Undoubtedly, expansion of the full scope of the TRIPS GI regime is an effective demonstration of the relevance of the Agreement to their economic circumstances. Resistance to this extension may communicate an unfortunate message to those countries about the political *real-*

politik of the international intellectual property rights regime.²⁴⁷ Therefore, WTO members should accept their responsibility to provide greater protection for GIs. By doing so, they will assist in ensuring that TRIPS remains an effective multinational treaty by setting an international example for compliance.

247. See Michel Blakeney, *Proposals for the International Regulations of Geographical Indications*, 4 J. OF WORLD INTELL. PROP. 629, 652 (2001).