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## Trademarks and Geographical Indications: Conflict or Coexistence?

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Graduate Program in Law  
A thesis submitted in partial fulfillment of the requirements for the degree in Master of Laws  
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TRADEMARKS AND GEOGRAPHICAL INDICATIONS:

CONFLICT OR COEXISTENCE?

(Spine title: Trademarks and Geographical Indications)

(Thesis format: Monograph)

by

Melissa Ann Loucks

Graduate Program in Law

A thesis submitted in partial fulfillment  
of the requirements for the degree of Master of Laws

School of Graduate and Postdoctoral Studies

The University of Western Ontario

London, Ontario, Canada

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Trademarks and Geographical Indications: Conflict or Coexistence?

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## Abstract and Keywords

Both trademarks and geographical indications are legal devices which regulate communication to markets about a product. Trademarks indicate the commercial origin of a good or service while geographical indications signal the geographic origin. Both tools also legally grant exclusive rights to certain uses of a word or symbol. Tension arises when the tools overlap on the same subject matter. The thesis asks: is coexistence between the devices in the *TRIPS Agreement* possible? Are the concepts of trademarks and geographical indications related? If so, how? If not, how? Does the marketing literature of business recognize both registered trademarks and geographical indications as aspects of the same branding exercise?

The thesis finds that as trademarks and geographical indications are unique devices that are not interchangeable and it is possible for legislation to simultaneously protect both, trademarks and geographical indications are therefore not in conflict and can instead be viewed as harmonious tools.

Keywords: intellectual property, trademarks, geographical indications, brand, World Trade Organization, conflict, coexistence

## **Dedication**

This thesis is dedicated to Laurie and Tommy Mawlam, who taught me that facing daunting challenges is as much about attitude as it is about perseverance.

## **Acknowledgements**

I would like to thank Professor Margaret Ann Wilkinson for her guidance, inspiration and enthusiasm. Professor Wilkinson's infectious passion for learning encouraged me to pursue graduate studies. I would also like to thank my second reader, Professor Khimji and my examination committee as well as my fellow LL.M. colleagues for their support. I also owe a tremendous amount of gratitude to my friends and family who have been an unwavering source of strength during the writing of this thesis.

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## Chapter 1

“The *TRIPS Agreement*<sup>1</sup> is the first multilateral text dealing with geographical indications as such, and may be rightly considered an important first step in this difficult field.”<sup>2</sup> In addition to introducing geographical indications into an international agreement, the *TRIPS Agreement* provides for co-existence of geographical indications and trademarks. ‘Trademarks’ and ‘geographical indications’ are legal devices which regulate communication to markets about a product. Trademarks indicate the commercial origin of a good or service while geographical indications signal the geographic origin of a good.<sup>3</sup> Both tools also legally grant exclusive rights to certain uses of a word or symbol.<sup>4</sup> Tension arises when the tools overlap on the same subject matter.<sup>5</sup> While both devices act as a means of source identification to consumers, are they equivalent devices in law? What is industry’s perspective? If trademarks and geographical indications are equivalent, why is protection of geographical indications a source of contention as the World Trade Organization seeks to expand the categories of goods subject to geographical indication protection? Does the answer to rights

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<sup>1</sup> *WTO Agreement on Trade-Related Aspects of Intellectual Property Rights*, 15 April 1994, 331197, online: WTO <[www.wto.org/english/tratop\\_e\\_trips\\_e/t\\_agmo\\_e.htm](http://www.wto.org/english/tratop_e_trips_e/t_agmo_e.htm)> [*TRIPS Agreement*]. Note that this citation is not part of the original quote.

<sup>2</sup> Daniel Gervais & Elizabeth Judge, *Intellectual Property: The Law in Canada*, (Toronto: Thomson Canada Limited, 2005) at 550.

<sup>3</sup> Dev Gangjee, “Quibbling Siblings: Conflicts Between Trademarks and Geographical Indications” 82 (2007) *Chi.-Kent L. Rev.* at 1255.

<sup>4</sup> *Ibid* at 1258.

<sup>5</sup> Dev Gangjee, “Say Cheese! A Sharper Image of Generic Use Through the Lens of Feta” 5 (2007) *Eur. I. P. Rev.* at 172.

implementation lie in an either/or approach with a checkerboard of jurisdictions recognizing one system or the other or is a mediated outcome of co-existing protection in negotiated goods categories the solution? Is it possible that the devices can co-exist because they are different and operate in separate spheres? As the thesis will discuss, the co-existence of trademarks and geographical indications in the *TRIPS Agreement* is a source of contention between Members of the World Trade Organization. The thesis asks if the treatment of these “quibbling siblings”<sup>6</sup> in the *TRIPS Agreement* is a mistake due to an assumption that they are equivalent devices or is it possible for trademarks and geographical indications to co-exist?

### ***The Classic Case of Budweiser***

Tensions between the intellectual property tools of geographical indications and trademarks have existed for the past hundred years between the American and Czech brewers of Budweiser beer. The American brewer, Anheuser-Busch, and the Czech brewer, Budejovický Budvar<sup>7</sup> [Budvar], each produce their own version of ‘Budweiser’ beer. Since the late 1800s, the companies have fought over the right to use the ‘Budweiser’ name. The ‘Budweiser’ litigation highlights tension between trademarks and geographical indications as well as the broader issues at play. These tensions and

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<sup>6</sup> See *supra* note 3 generally.

<sup>7</sup> Bürgerliches Brauhaus, Český Akciový Pivovar was the predecessor company of Budejovický Budvar. Jitka Smith, “Budweiser or Budweiser?” 32 (1999) J. Marshall L. Rev. 1251 at footnote 10.

issues have led to a dispute between World Trade Organization Members and have stagnated negotiations at the World Trade Organization Doha talks.<sup>8</sup>

In 1876 Anheuser-Busch<sup>9</sup> began to manufacture beer for an immigrant from Bohemia, Carl Conrad under the name 'CCC Budweiser Beer'. In 1883 Anheuser Busch acquired the right to use 'Budweiser' from Conrad and in 1891 the parties signed an assignment agreement transferring the right to the name and the trademarks from Conrad to Anheuser-Busch.<sup>10</sup>

From his travels to Europe, Conrad was aware that 'Budweiser' beer "was considered by Europeans to be one of the finest beers made there [in Europe]."<sup>11</sup> It was Conrad's and Anheuser's intention that the American Budweiser be "similar in quality, color, flavor and taste to the 'Budweiser' beer then being made in Bohemia."<sup>12</sup> Anheuser-Busch's Budweiser beer in the 21<sup>st</sup> Century has come to hold 45% of the American beer market and the brand is the largest selling beer internationally.<sup>13</sup>

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<sup>8</sup> Frances Zacher, "Pass the Parmesan: Geographical Indications in the United States and the European Union- Can There be Compromise?" 19 (2005) *Emory Int'l L. Rev.* T 429.

<sup>9</sup> At the time, Anheuser-Busch Inc. was E. Anheuser Company's Brewing Association. See *Anheuser-Busch Inc. v. Du Bois Brewing Co.*, 73 F. Supp. 338, 348 (W.D. Pa. 1947) [*Du Bois Brewing Co.*]

<sup>10</sup> *Ibid* at paras 4-8.

<sup>11</sup> *Ibid* at para 6.

<sup>12</sup> *Ibid* at para 7.

<sup>13</sup> Philippe Zylberg, "Geographical Indications v. Trademarks: The Lisbon Agreement: A Violation of TRIPS?" (2002) 11 *U. Balt. Intell. Prop. L. J.* at 40.

In 1895, the Budvar brewery was founded in the town of Ceske Budejovice, in South Bohemia<sup>14</sup>. The town boasts a seven hundred year history of brewing beer which is entwined with the town's culture including the "local tradition, architecture and the arts."<sup>15</sup> The facades of historic buildings in the town depict breweries and brewing elements such as beer barrels, hopps, and beer cups.<sup>16</sup> Local restaurants that sell beer on tap also display folk art portraying the region's beer brewing tradition.<sup>17</sup> Budvar started using the names 'Budvar' and 'Budweiser' for the company's beer in 1895. Other breweries also existed in the town at the time. Over time, Budvar acquired these other breweries and eventually became the sole producer. The word 'Budweiser' is an:<sup>18</sup>

adjective originating from the German language name of the Czech town Ceske-Budejovice – Budweis – where the beer was born in the middle ages, thus describing the origin of the brew. In German, it is common to ad[d] the suffix "er" to a town in order to indicate that something or someone originates from that specific town.

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<sup>14</sup> Bohemia is a historic name for the area now known as the Czech Republic. See *supra* note 7 at footnote 24.

<sup>15</sup> *Supra* note 7 at 1255.

<sup>16</sup> Robert M. Kunststadt & Gregor Buhler, "Bud" Battle Illustrates Peril of Geographic Marks, (1998) 20 Nat'l L.J., C4.

<sup>17</sup> *Ibid* at C4.

<sup>18</sup> *Supra* note 13 at para 40. The City of Budweis was changed to Budejovice with the founding of the Czechoslovak Republic after World War I. See *supra* note 9 *Du Bois Brewing Co.* at para 8.

Between 1898 and 1911, American importers of the Czech beer labeled the product 'Budweiser'.<sup>19</sup> Anheuser-Busch argued that the use of the word 'Budweiser' infringed its American trademark. On August 19, 1911 Anheuser-Busch entered into an agreement with Budvar allowing Anheuser-Busch to use the term 'Budweiser' outside of Europe "so long as it did not use the word 'Original' in connection therewith."<sup>20</sup> In return, Budvar agreed not to object to Anheuser-Busch's 1876 trademark application in the United States. Budvar reserved the "right to use the word 'Budweiser' on its product in the United States and elsewhere throughout the world."<sup>21</sup>

In another agreement between Anheuser-Busch and Budvar executed on September 4, 1911, the Czech company conceded Anheuser-Busch's trademark rights in the United States "in the word 'Budweiser' and agreed to use the word 'Budweiser' only to describe the geographical origin of this beer."<sup>22</sup> Anheuser-Busch paid Budvar 82,500 Austrian kronen in exchange for the Czech company to withdraw its objections at the American Patent Office to Anheuser-Busch's use of 'Budweiser':<sup>23</sup>

as a trade-name or trade-mark on its beer, except in Europe, it being made clear that this license was not intended to permit the sale of the American-made beer as 'Budweiser' in any European country, and that the right already possessed and enjoyed by Burgerliches Brauhaus [Budejovicky Budvar] to sell its 'Budweiser' beer in the United States should continue.

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<sup>19</sup> *Supra* note 9 at paras 10-12.

<sup>20</sup> *Ibid* at para 46.

<sup>21</sup> *Ibid* at para 46.

<sup>22</sup> *Ibid* at para 12.

<sup>23</sup> *Ibid* at para 45.

On September 27, 1938 Anheuser-Busch adopted a resolution directing its officers to “take such legal and other action as might be necessary to eliminate the further use of the word ‘Budweiser’ [...] by the two brewers at Budweis.”<sup>24</sup> The Anheuser-Busch representatives negotiated agreements with the Czech brewer in the first quarter of 1939. Budvar agreed to “discontinue their use of the name ‘Budweiser’ on their beer sold in the United States and its territories, in exchange for which [Anheuser-Busch] paid them a total of \$127,000.”<sup>25</sup>

After the Second World War, Anheuser-Busch experienced increased competition and the American beer market became saturated, leading the company to seek new opportunities abroad.<sup>26</sup> In an attempt to either shut down Budvar or take over the company, Anheuser-Busch employed various tactics: aggressive marketing strategies, legal initiatives, attempts to buy stock in Budvar, and stopping procurement of hops from the Czech Republic. Anheuser-Busch’s tactics were unsuccessful.<sup>27</sup>

As set out above, Anheuser-Busch had agreed not to enter the European market in the August 19, 1911 agreement. Yet none of the agreements signed by the parties referencing the geographic use of ‘Budweiser’ addressed the jurisdiction of the United

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<sup>24</sup> *Ibid* at para 49.

<sup>25</sup> *Ibid* at para 49.

<sup>26</sup> *Supra* note 7 at 1251.

<sup>27</sup> Anheuser-Busch’s offer to buy Budvar included incentives such as investing in the town of Budweis’ downtown and schools combined with a marketing campaign of the American Budweiser in Czech media. The offer sparked public protests calling for the rejection of Anheuser-Busch’s offer. See *supra* note 16 at C4.

Kingdom.<sup>28</sup> Anheuser-Busch therefore sought to export its beer to the United Kingdom in the early 1970's as it was not part of the European Community at the time.<sup>29</sup> The decision to export led to a protracted dispute between Anheuser-Busch and Budvar which has sprouted in various forms including litigation in European jurisdictions within the United Kingdom (now a part of the European Union) as well as a parallel dispute at the World Trade Organization.<sup>30</sup>

The litigation in the United Kingdom is of interest for the purpose of this thesis because British legislation prior to 1994 allowed for competitors' trademarks to co-exist.<sup>31</sup> This co-existence of marks is relevant because, as will be discussed,<sup>32</sup> the World Trade Organization Panel eventually declared in 2005 that geographical indications and

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<sup>28</sup> *Anheuser-Busch Inc. v Budejovicky Budvar Narodni-Podnik* [2000] EWCA Civ 30 [*Anheuser 2000*] at para 3. The lack of inclusion of the United Kingdom in the previous agreements between Anheuser-Busch and Budvar may have been due to the fact that neither company was selling beer in that jurisdiction when the agreements were made. Another reason may be that the agreements referenced 'Europe' which may not have included the United Kingdom at the time. The United Kingdom joined the European Economic Communities on January 1, 1973. In examining the Budweiser disputes in the United Kingdom it is also relevant to note that prior to the implementation of the *TRIPS Agreement*, the United Kingdom lacked a system protecting geographical indications. In this sense, the United Kingdom is unlike continental European countries such as France, Portugal, Greece and Italy which had measures in place prior to the TRIPS Agreement to protect geographical indications. See *supra* note 13 at 50.

<sup>29</sup> See *supra* note 7 at 1251. The United Kingdom joined the European Economic Communities on January 1, 1973.

<sup>30</sup> *Finance Minister Says Current Government Not Likely to Privatize Budvar Brewery*, Czech Republic & Slovakian Bus. Rep., Sept. 12, 2003 WL61408099. See also Richard Terpstra, "Which Bud's for You? An Examination of the Trademark Dispute Between Anheuser-Busch and Budějovický Budvar in the English Courts" (2004) 18 Temp. Int'l & Comp. L. J. at 479: as of September 2003, Anheuser-Busch and Budvar were involved in forty lawsuits and forty administrative cases against each other worldwide.

<sup>31</sup> See Budweiser UK Litigation *infra* notes 265-320.

<sup>32</sup> *Infra* notes 240-261 and corresponding text.



trademarks may exist concurrently.<sup>33</sup> As the thesis examines in Chapter 3, in the most recent British Budweiser dispute culminating in September of 2011, the European Court of Justice held that the principle of honest co-existence continues despite recent legislative changes in the United Kingdom which had attempted to remove the principle.

As mentioned above, while the Budweiser litigation continued between the companies themselves, another dispute began between their respective states at the international level. On June 1<sup>st</sup>, 1999, the United States requested consultations with the European Community regarding *EC Regulation 2081/92*.<sup>34</sup> The Australian government later lodged a complaint and eventually, once the World Trade Organization Panel was established to address the complaint, the two cases were combined into one dispute before the World Trade Organization Dispute Settlement Board: *European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs*.<sup>35</sup> The essence of the American and Australian complaint was “that the E.U. regulation discriminates against foreign geographical

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<sup>33</sup> *Infra* note 175.

<sup>34</sup> Dispute Settlement: DISPUTE DS290: European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs, online: the World Trade Organization <online: [http://www.WorldTradeOrganization.org/english/tratop\\_e/dispu\\_e/cases\\_e/ds290\\_e.htm](http://www.WorldTradeOrganization.org/english/tratop_e/dispu_e/cases_e/ds290_e.htm)> [*Regulation*]. For the full text of the *Regulation* see Appendix A. For further discussion on the *Regulation* see Chapter 3 footnotes 168 – 264 and corresponding text.

<sup>35</sup> World Trade Organization Documents WT/DS174R (15 March 2005) [*EC-US Report*]; WT/DS290R (15 March 2005) [*EC-Australia Report*]. These Reports were adopted by the Dispute Settlement Body on 20 April 2005; see World Trade Organization Documents WT/DS174/23 and WT/DS290/21 (25 April 2005) [*World Trade Organization Dispute*]. The World Trade Organization issued its report on the matter in 2005: World Trade Organization, ‘European Communities-Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs: Complaint by the United States: Panel Report’, WT/DS174/R, 15 March 2005 [*World Trade Organization Report*].

indications and does not provide sufficient protection to pre-existing trademarks that are similar or identical to those protected in the E.U.”<sup>36</sup> As its title describes, the *Regulation* applied only to agricultural goods. Beer was one of the goods specifically contemplated by the *Regulation*.<sup>37</sup>

As the *Regulation* protected translations of geographical indications,<sup>38</sup> the European Community argued that the American company Anheuser-Busch would be unable to use the name ‘Budweiser’ within the European Community.<sup>39</sup> Budvar had registered ‘Budejovicky’ as a geographical indication in the European Community. ‘Budejovicky’, as described above, translates to ‘Budweiser’ and is the name of a Czech town. The United States took the position that ‘Budweiser’ was registered as a trademark prior to the registration of ‘Budejovicky’ as a geographical indication and therefore the trademark rights should take precedence over a geographical indication subsequently registered.<sup>40</sup> The European Community successfully argued in the *World Trade Organization Dispute* that geographical indications and trademarks may coexist.

The combination of the World Trade Organization *Report* and the fact that, as of 2009, the ‘Budweiser’ battle comprised approximately 100 court cases over the name in

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<sup>36</sup> *Supra* note 13 at 38.

<sup>37</sup> *Supra* note 34 Annex I

<sup>38</sup> *Supra* note 34 at Article 13.1(b).

<sup>39</sup> *Supra* note 35 [*World Trade Organization Report*] at 6.30.

<sup>40</sup> *Supra* note 35 [*World Trade Organization Report*] at 6.31.

forty jurisdictions<sup>41</sup> has contributed to the continuing tension in this area of the law. The extensive litigation has resulted in a patchwork of markets divided between the two companies: Anheuser-Busch sells 'Budweiser' in sixteen countries and 'Bud' another fifteen; Anheuser-Busch dominates the North American, South American and Asian markets. Budvar registered 'Budweiser' and 'Bud' as a trademark and appellation of origin or geographical indication in "28 European countries and 37 non-European countries."<sup>42</sup>

As mentioned, the litigation in the United Kingdom resulted in a decision by the European Court of Justice allowing for co-existence of use by both companies. Despite the litigation, the United Kingdom is Anheuser-Busch's "second most important global market for beer".<sup>43</sup> The World Trade Organization Panel issued its report on March 15, 2005 while the Doha talks began in November of 2001. One might expect that the mutual claim of victory by the United States and the European Union would set the stage for collaboration during the Doha round of talks; however, this has not been the case. When the World Trade Organization Members first negotiated the *TRIPS Agreement*, as mentioned earlier, discussions came to a deadlock over geographical indications.<sup>44</sup> The parties overcame the issue by agreeing to future negotiations.<sup>45</sup> In

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<sup>41</sup> Thitapha Wattanapruttipaisan, "Trademarks and Geographical Indications: Policy Issues and Options in Trade Negotiations and Implementation" 26:1 (2009) *Asian Development Review* at 198.

<sup>42</sup> *Ibid.*

<sup>43</sup> *Ibid.*

<sup>44</sup> Justin Waggoner, "Acquiring a European Taste for Geographical Indications" (2008) 33 *Brooklyn J. Int'l L.* at 578 at 578.

this way, the United States “did not have to concede too much ground to the EC [European Community] and the EC was assured of built-in negotiations during which it could work towards expanding GI [geographical indication] protection.”<sup>46</sup> The World Trade Organization Members agreed to discuss two topics with respect to geographical indications at the Doha talks:<sup>47</sup>

(i) creating a multilateral system for notification and registration for wines and spirits under Article 23.4 TRIPS; and (ii) the extension of Article 23 TRIPS ‘additional protection’ of GIs (i.e., protection granted even where there is no risk of misleading consumers or unfair competition) to products other than wines and spirits.

Considering the difficulty the parties had in reaching agreement during the Uruguay round of World Trade Organization talks, it is not surprising that the Doha Development Agenda is contentious and negotiations on geographical indications have stagnated for eleven years. The ‘Old World’<sup>48</sup> is in favour of both topics outlined above while the ‘New World’ opposes both ideas. As noted, when the Doha talks began in 2001, the World Trade Organization Dispute Settlement Board Panel had yet to issue its

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<sup>45</sup> *Ibid* at 578.

<sup>46</sup> *Ibid* at 578.

<sup>47</sup> Tomer Brode, “Taking Trade and Culture Seriously: Geographical Indications and Cultural Protection in WTO Law” (2005) 26 U. Pa. J. Int’l Econ. L. at 627.

<sup>48</sup> The ‘Old World’ consists of longstanding cultures such as European, Middle Eastern and Asian countries. For the purpose of this paper and the *World Trade Organization Dispute* examined, the paper focuses on European countries. The ‘New World’ comprises countries that are younger and colonized by the Europeans such as North America, South America, Australia and New Zealand. These countries are also home to older aboriginal cultures; however, this paper focuses on the emigrant European populations as the new world countries have not focused on the contributions of their aboriginal cultures in this debate but may do so in the future.

report with respect to the European *Regulation*. The parties were two years into the Doha round before the *World Trade Organization Dispute* ended. This meant that any potential advantage to either side by claiming victory was irrelevant by the time the report was issued as, by that time, the parties' positions were already entrenched at the Doha talks and, indeed, talks were stalled.

On March 3<sup>rd</sup> 2011, the World Trade Organization reported that negotiators in the Doha round had moved the talks forward with the production of a draft text.<sup>49</sup> The negotiators accomplished this feat by including all rival positions in parentheses. Although the document contains a large number of divergent positions, it is a major step forward as discussion can now focus on refining a single document as opposed to rival proposals.<sup>50</sup> The draft text is undoubtedly a success for negotiators but as a delegate from India commented, "one can easily see the 'work' but I'm a bit doubtful about the 'progress'."<sup>51</sup> This step towards resolution is thus tempered by the prospect of the ensuing further stages of negotiations.<sup>52</sup>

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<sup>49</sup> Intellectual Property: Geographical Indications Negotiations – Formal Meeting, (3 March 2011) online: The World Trade Organization <[http://www.World Trade Organization.org/english/news\\_e/news11\\_e/trip\\_ss\\_03mar11\\_e.htm](http://www.WorldTradeOrganization.org/english/news_e/news11_e/trip_ss_03mar11_e.htm)>.

<sup>50</sup> *Ibid.*

<sup>51</sup> *Ibid.*

<sup>52</sup> Regarding the World Trade Organization's report of the current state of the negotiations:

Turning to TRIPS-GIs for wines and spirits, there is in general no sign of appetite for activities, including work on low-conflict technical issues, as the issue of linkages is still cited as an obstacle for engagement on the side of the joint proposal group. The Chairman will start a process of consultations with individual delegations and in groups to determine how best to operationalize those elements of the MC8 outcome

In 1995 the World Trade Organization Agreement included the *TRIPS Agreement* as an appendix, which in turn encompasses both geographical indications and trademarks. The ongoing litigation over the term ‘Budweiser’ in relation to beer is evidence of a tension between trademarks and geographical indications. This leads to the overall research question of the thesis: is the combination of geographical indications and trademarks in the *TRIPS Agreement* an impossibility or is it possible for the two to co-exist?

### **Prior Research**

Prior legal research examining the tension between trademarks and geographical indications falls into six categories of articles: (1) concluding that the current World Trade Organization conflict resolution mechanisms are sufficient,<sup>53</sup> (2) advocating that the United States should agree to the European demands for expanded geographical indication protection,<sup>54</sup> (3) suggesting a need for improved conflict resolution methods

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that relate to the work of the Special Session. [Source: Chairman’s report:  
[http://www.wto.org/english/news\\_e/news12\\_e/gc\\_rpt\\_01may12\\_e.htm](http://www.wto.org/english/news_e/news12_e/gc_rpt_01may12_e.htm)]

<sup>53</sup> Michelle Agdomar, “Removing the Greek from Feta and Adding Korbel to Champagne: The Paradox of Geographical Indications in International Law” 18 (2008) *Fordham Intell. Prop. Media & Ent. L.J.* at 550.

<sup>54</sup> See: *ibid* at 600, *supra* note 44 at 595, Leigh Ann Lindquist, “Champagne or Champagne? An Examination of U.S. Failure to Comply with the Geographical Provisions of the TRIPS Agreement” (1999) 27 *GA. J. Int’l & Comp. L.* at 343 [*Champagne*]; Daniele Giovannucci, Elizabeth Barham & Richard Pirog, “Defining and Marketing “Local” Foods: Geographical Indications for US Products” (2010) 13:2 *The Journal of World Intellectual Property* at 112 [*“Local” Foods*]; Deborah Kemp & Lynn Forsythe, “Trademarks and Geographical Indications: A Case of California Champagne” 10 (2006) *Chap. L. Rev.* at 291 [*California Champagne*]; Stacy Goldberg, “Who Will Raise the White Flag? The Battle Between the United States and the European Union over the Protection of Geographical Indications” 22:1 (2001) *U. Pa. J. Int’l Econ. L.* at 151 [*White Flag*].

to resolve disputes and more negotiations,<sup>55</sup> (4) calling for a deeper understanding of the conflict or review of the relevant legislation,<sup>56</sup> (5) outlining suggestions to resolve the conflict,<sup>57</sup> or (6) concluding that due to the contentious nature of the conflict, it is unlikely that a solution exists.<sup>58</sup> One article stands out as it suggests that perhaps

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<sup>55</sup> Nina Resinek, “Geographical Indications and Trade Marks: Coexistence or “First in Time, First in Right” Principle” 29:11 (2007) E.I.P.R. and *supra* note 13 at 69.

<sup>56</sup> *Supra* note 5 at footnote 112 and corresponding text; G.E. Evans & Michael Blakeney, “The Protection of Geographical Indications After Doha: Quo Vadis?” 9:3 (2006) J. Int’l Econ. L. [*Blakeney*] at 614.

<sup>57</sup> Ivy Doster, “A Cheese by Any Other Name: A Palatable Compromise to the Conflict over Geographical Indications” (2006) 59:3 Vand. L. Rev. 901-902 [*Cheese*]. The author suggests two solutions: 1) use of the word ‘imitation’ on the label of goods that are not subject to geographical indication protection yet use a term that is recognized as geographical indications, and 2) the creation of a licensing system for the production of registered geographical indication goods outside of the region of origin with the producers in the region of origin controlling the foreign production of the good. See *infra* footnotes 60-61 and corresponding text for a discussion of why this second method exposes a misunderstanding of the concept of geographical indications.

Dwijen Rangnekar & Sanjay Kumar “Another Look at Basmati: Genericity and the Problems of a Transborder Geographical Indication” (2010) 13:2 The Journal of World Intellectual Property [*Basmati*] at 222-223. The authors suggest treating geographical indications like certification marks in order to recognize potential trans-border geographical indications such as ‘basmati’ which originates from a region along the borders of India and Pakistan.

*Supra* note 7 at 458-462. The author suggests that further geographical indication negotiations occur through bilateral negotiations instead of under the *TRIPS Agreement*. The author further suggests that the European Union pay the United States to recognize a broader category of geographical indications to assist producers with the costs of advertising and re-educating consumers regarding the new names for products not subject to geographical indication protection. The author, however, admits that this suggestion is unrealistic as the amount needed would be prohibitive and both sides are unlikely to “admit ideological defeat by accepting the money, even if it made economic sense.”

Tim Josling, “What’s in a Name? The economics, law and politics of Geographical Indications for food and beverages” IIS Discussion Paper No. 109 Freeman-Spogli Institute for International Studies, (January 2006) Stanford University [*What’s in a Name?*] at 26. Josling’s proposes that each country creates a system to regulate domestic and foreign uses of geographical origins originating from the country where importing countries request exporters to monitor and enforce the goods protected by geographical indications.

<sup>58</sup> Stéphan Murette, Roxanne Clemens, & Bruce Babcock, “The Recent International and Regulatory Decisions about Geographical Indications” MATRI Working Paper 07-MWP 10 (2007), Midwest Agribusiness Trade Research and International Center, Iowa State University [*Regulatory Decisions about Geographical Indications*] at 20; Michael Handler, “The WTO Geographical Indications Dispute” 69:1 (2006) MLR [*The WTO Geographical Indications Dispute*] at 80; *supra* note 41 at 197; Becki Graham,

coexistence is possible because it has been possible for competing trademarks to coexist in the United Kingdom in cases of ‘honest concurrent use’, a concept which the thesis explores in Chapter 3 through the examination of the British Budweiser litigation.<sup>59</sup>

It is interesting to note that the research comparing trademarks and geographical indications not only discusses the complexity of the devices but also reflects the confusion. This is apparent in Doster’s article, *Cheese by Any Other Name: A Palatable Compromise to the Conflict over Geographical Indications*. Doster suggests the debate concerning extended geographical indication protection could be resolved by the producers of a good under geographical indication protection “certifying and overseeing the production of the copy [good] in other countries. If the country of origin agrees to certify the production [of a good], a fee could be charged.”<sup>60</sup> As the chapter discusses below, a geographical indication not only indicates a good’s geographic origin, the *TRIPS Agreement* definition highlights that “a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.”<sup>61</sup> The idea that a good designated as a geographical indication could be produced outside of the geographic region is therefore a misunderstanding of the *TRIPS Agreement*. This is

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“TRIPS: Ten Years Later: Compromise or Conflict over Geographical Indications” 4 (2005) Syracuse Sci & Tech. L. Rep. [*TRIPS: Ten Years Later*] at 33-34.

<sup>59</sup> *Supra* note 3 at 1289.

<sup>60</sup> *Supra* note 57 at 901.

<sup>61</sup> *Supra* note 1 **Error! Bookmark not defined.** Article 22.1 definition of geographical indication:

[...] 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.**



because, according to the definition, there are regional factors which one cannot authentically replicate elsewhere; production of 'champagne' outside of the Champagne region is not champagne but rather an imitation, whether or not there is a licensing agreement.

### ***Thesis Organization and Research Questions***

The thesis' perspective is international in that it stems from issues under the World Trade Organization *TRIPS Agreement*. Mention of Member State domestic legislation flows from the issues highlighted with the *TRIPS Agreement*. As the author of the thesis is studying in Canada, the paper will attempt to add a Canadian perspective where possible.

This first chapter poses the research questions, defines key terms and sets the legislative framework. This Chapter also examines the first research question regarding the relationship between trademarks and geographical indications. Chapter Two explores the concept of branding, the legal concepts of trademarks and geographical indications as forms of, or tools for, branding and analyzes the connection between products and producers from an industry perspective. Chapter 3 examines two different legal disputes which have ultimately held that trademarks and geographical indications may coexist: the World Trade Organization dispute and the Budweiser litigation in the United Kingdom. Chapter 4 presents conclusions and argues that coexistence between trademarks and geographical indications is possible precisely because they are very different concepts.

In order to determine the answer to the overall research question, regarding whether co-existence between geographical indications and trademarks in the *TRIPS Agreement* is possible, this thesis examines first two other research questions:

1. Are the concepts of registered trademarks and geographical indications related? If so, how? If not, how?
2. Does the marketing literature of business recognize both registered trademarks and geographical indications as aspects of the same branding exercise?

If both trademarks and geographical indications are intellectual property devices, they should be comparable along similar lines. As discussed, both devices act as a method to inform consumers by indicating a good's source. If trademarks and geographical indications inform consumers, businesses should consider them marketing tools which leads to the second research question. The second research question should help to reconcile the two concepts. This is because if the answer to the second research question is no, then trademarks and geographical indications may be different but may still be related as posited in the first question. If the concepts are related, then perhaps drawing on conflict resolution theory might be advanced to help parties at odds to achieve resolution. If the parties are different and not related, conflict resolution methods may not apply.

In approaching the research questions, the thesis was guided by the following research propositions:

1. Though each is unique, geographical indications and trademarks are related concepts.
2. The marketing literature does not reference geographical indications.
3. There is a fundamental inconsistency between trademarks and geographical indications. As trademarks and geographical indications are inconsistent devices but appear as interchangeable in the *TRIPS Agreement*, it must be possible for the two different approaches to co-exist. If co-existence is possible, and trademarks and geographical indications are fundamentally inconsistent, then co-existence must have been achieved through conflict resolution.

### ***Methodology***

The thesis investigates the first research question posited, whether trademarks and geographical indications are related though distinct in law, through analysis of primary legal sources. The thesis examines the second research question by gathering empirical evidence in the form of conducting four searches of business journal databases. The searches were conducted using the business journal databases Business Source Complete<sup>62</sup> and ProQuest – ABI/INFORM Global.<sup>63</sup> These databases were chosen

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<sup>62</sup> The JISC Academic Database Assessment Tool describes the Business Source Complete database as

[T]he world's definitive scholarly business database, providing the leading collection of bibliographic and full text content. Business Source® Complete contains far more active, peer-reviewed, business related journals than any other database currently available. [...]In addition to the searchable cited references provided for more than 1,300 journals, Business Source Complete contains detailed author profiles for the 40,000 most-cited authors in the database. Journal ranking studies reveal that Business Source Complete is the overwhelmingly superior database for full text journals in all disciplines of business, including marketing, [...].

for their comprehensive coverage of peer reviewed business journals.<sup>64</sup> Two searches were conducted in each database: one for reference to trademarks and the second for reference to geographical indications. The search terms used for reference to trademarks were 'TRADEMARK' AND 'BRAND'. The search terms used for reference to geographical indications were 'GEOGRAPHICAL INDICATION' AND 'BRAND'. Appendices B, C, D and E summarize the findings. All searches were limited to peer reviewed journals. The initial search results included any journal in the database. As this chapter focuses on identifying marketing literature references to trademarks and or geographical indications, the results listed in the Appendices were further restricted to marketing, brand management or consumer research journals. Examples of journal articles which were discarded from the original search results include articles from law reviews and economic journals. Each article was reviewed to confirm that the text accurately reflected the category of 'TRADEMARK' and 'BRAND' or 'GEOGRAPHICAL INDICATION' and 'BRAND'. The following table outlines the searches and corresponding results.

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Online: [http://www.jisc-adat.com/adat/adat\\_db\\_details.pl?ns\\_ADAT:DB=Business%20Source%20Complete](http://www.jisc-adat.com/adat/adat_db_details.pl?ns_ADAT:DB=Business%20Source%20Complete)

<sup>63</sup> ProQuest – ABI/INFORM Global's database includes 3,000 business journals. Online: <http://www.lib.uwo.ca/programs/marketing/>

<sup>64</sup> Business Source Complete and ProQuest ABI/INFORM Global only include peer reviewed journals -- in comparison with Google Scholar which includes every kind of publication, not just peer reviewed. It is possible to obtain more results via Google Scholar but as I am unfamiliar with the business literature and lack the ability to discriminate between scholarly and non-scholarly business articles, I relied upon Business Source Complete and ProQuest ABI/INFORM Global to ensure the quality of the data as the searches revealed only peer reviewed articles.

**Table 1: Summary of Marketing Literature Search Results**

	Database: Business Source Complete	Database: ProQuest – ABI/INFORM GLOBAL	Duplication of Findings	Total Findings without Duplications
Search terms: 'trademark' and 'brand'	10	85	1	94 [10+85-1 = 94]
Search terms: 'geographical indication' and 'brand'	6	2	0	8 [6+2-0=8]

**Research Caveats**

While the search results included English translations of articles originally published in another language, the extent of coverage of the non-English publications is unclear. Non-English publications may therefore be under represented resulting in a weakness in the data.

Two business databases were used to perform the searches: Business Source Complete and ProQuest – ABI/INFORM GLOBAL (ProQuest). The databases were chosen for their comprehensive collection of peer reviewed business journals. Business Source Complete's main office is in the United States with additional offices in Australia, the United Kingdom, Japan, South Africa, India, the Czech Republic and Germany. ProQuest is based in the United States as well with international operations on every continent. Both databases are American companies which is a weakness of the data as the data

may be biased to American journals. The international offices of each company may offset an American bias.

The examination of the author's country of residence is also incomplete as the chapter draws conclusions from the countries in which the authors are indicated to be working. The country in which a professor lives is not necessarily the author's country of origin nor does it reflect influence from other cultures such as having lived abroad or membership in a cultural community substantially different from the dominant culture(s) of the country of residence.

### ***Defining Concepts:***

A marketing academic has described a 'brand' as "***A product plus added values...*** A brand is a bundle of functional, economic and psychological benefits for the end user, more simply known as quality, price and image [emphasis added]."<sup>65</sup> The quote demonstrates the difference between the terms 'product' and 'brand'. A product is the good identified by the brand; the product forms part of the description of a brand but the concepts are not synonymous as 'brand' is a broader term. The meaning of 'brand' remains elusive and contentious. Marketing Professor de Chernatony has identified the following nine themes to define 'brand': (i) a legal instrument, (ii) a logo, (iii) a company, (iv) an identity system, (v) an image in consumers' minds, (vi) a personality, (vii) a relationship, (viii) adding value, and (ix) an evolving entity.

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<sup>65</sup> "Building Brand Relationships", Financial Times, December 4, 1995. See also Leslie de Chernatony and Francesca Dall'Olmo Riley, "The Chasm between Managers' and Consumers' Views of brands: the experts' perspectives" (1997) 5 Journal of Strategic Marketing at 89 [*Chasm*].

### ***Conflict between Trademarks and Geographical Indications***

Disputes arise when one group asserts geographical indication rights and another asserts trademark rights over the same term or sign within the same jurisdiction.<sup>66</sup> The parties are then in conflict as they try to exercise exclusive rights over the same subject matter. An example of this scenario is the ‘Budweiser’ case outlined in the introduction. The situation is more difficult if the term is an indirect geographical indication<sup>67</sup>. Legal protection for a geographical indication rests on the indication’s ability to point to the product’s specific geographic origin.<sup>68</sup> As the *TRIPS Agreement* protects indirect geographical indications, proving a link between a good and a geographic location can prove difficult in these circumstances. An example of this is the case of *Federal Republic of Germany and Kingdom of Denmark v. Commission of the European Communities [Feta 2005]*.<sup>69</sup> The dispute highlights disagreement within

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<sup>66</sup> *Supra* note 3 at footnote 25 and corresponding text.

<sup>67</sup> Indirect indications are “non-geographical names or symbols, if perceived by the public as identifying a certain geographical origin.” WIPO, *Trademarks and Geographical Indications*, WIPO – WASME/IPR/GE/03/2(Sep 29, 2003) at 21. An example is ‘feta’ as there is no geographic region in Greece with that name yet Greece claimed the term is linked to a region and subject to geographical indication protection as discussed below.

<sup>68</sup> *Anheuser-Busch Inc. v. Budejovicky Budvar Narodni Podnik* [2001] ETMR 7 [*Anhesuer 2001*] at 82 (Swiss Federal Court of Justice; 15 February, 1999) “The function both of trade mark protection and of protection for appellations of origin is to ensure the distinguishing function of the designation and to prevent mistaken attributions – whether regarding the manufacturer or the place of origin. But unlike trade marks, appellations of origin attribute the goods for which they are used not to a certain undertaking but to a country, region or a place.”

<sup>69</sup> Judgment of 25.10.2005 - Joined Cases C-465/02 and C-466/02 Judgment of the Court (Grand Chamber) [2005] ETMR 16 [*Feta 2005*]. The European Court of Justice upheld the Commission’s finding that ‘feta’ fulfilled the “conditions required for registration as a traditional non-geographical name” [See para 43 and para 68 of *Feta 2005*] pursuant to Article 2.3 of the *Regulation. Feta 2005* examined Council Regulation (EC) No 2081/92 of 14 July 1992 on the Protection of Geographical Indications and Designations of Origin for Agricultural Products and Foodstuffs [1992] OJ L208 1.

Europe, the main proponent of geographical indications in *TRIPS Agreement* negotiations, over what qualifies as a geographical indication.<sup>70</sup> Another issue examined by the European Court of Justice relevant to this discussion was “whether ‘feta’ had become a generic name.”<sup>71</sup> *Regulation* Article 3.1 lists three criteria by which to determine genericity: “the situation in the member state of origin and areas of consumption, the situation in other member states, and the relevant national or Community laws.”<sup>72</sup> The factors are interesting because the European Court of Justice’s analysis of factors one and two included evidence of public perception regarding whether ‘feta’ is a generic term.<sup>73</sup> Use by the European Court of Justice of public perception “sets out an empirical reference for understanding of a geographical term –

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<sup>70</sup> *Supra* note 5 at 176. Interestingly, the *Feta 2005* pertains to the amended European Community regulation that was at issue in the *World Trade Organization Dispute* discussed in Chapter 3.

<sup>71</sup> *Supra* note 69 at para 70 of *Feta 2005* pursuant to Article 3.1 of the *Regulation*. See also the Danish Government’s similar claim at para 72.

<sup>72</sup> *Supra* note 57 [*Basmati*] at 211, paraphrasing para 75 of *Feta 2005* which states:

It must be recalled that the third subparagraph of Article 3.1 of the basic regulation provides: 'To establish whether or not a name has become generic, account shall be taken of all factors, in particular:

- the existing situation in the Member State in which the name originates and in areas of consumption,
- the existing situation in other Member States,
- the relevant national or Community laws

<sup>73</sup> *Supra* note 69 at para 86 which states:

The information provided to the Court indicates that **the majority of consumers in Greece consider that the name 'feta' carries a geographical and not a generic connotation. In Denmark, by contrast, the majority of consumers believe that the name is generic.** The Court does not have any conclusive evidence regarding the other Member States [emphasis added].



the relevant public.”<sup>74</sup> Public perception of geographical indications and trademarks is relevant to the discussion in Chapter 4 of the thesis which deconstructs the conflict between the proponents of the two intellectual property law devices.

### ***Comparing and Contrasting Trademarks and Geographical Indications***

In comparing intellectual property devices it is helpful to consider the following areas: (1) the nature of the owner, (2) the term of protection, (3) the nature of the object, and (4) the nature of the right.<sup>75</sup>

The nature of the owner differs as between trademarks and geographical indications. Persons, whether individuals or corporations, own the trademarks for the goods or services they sell; they may choose to license the right to use the mark to other persons.<sup>76</sup> Geographical indications, on the other hand, are owned by a collective body that licenses the right to use the indication to producers of goods in a defined geographic region; the users of the indication are not the owners. Use of a geographical indication is “open to all who satisfy the conditions for production [in the region] and

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<sup>74</sup> *Supra* note 57 [*Basmati*] at 212. The consideration of public perception of a geographical indication also occurred in *Wineworths Group Ltd v Comité Interprofessionnel du Vin de Champagne* [1992] 2 NZLR 327 (CA) at 340 where instead of focusing on the general public, the Court of Appeal emphasized “the significance of the name ‘Champagne’ in the market place, how it is used and how it is understood in the course of trade.”

<sup>75</sup> Daniel Gervais, “Traditional Knowledge & Intellectual Property: A TRIPS-Compatible Approach” (2005) *Michigan State Law Review* at 149.

<sup>76</sup> *Supra* note 1 Article 21 ‘Licensing and Assignment’ which states:

Members may determine conditions on the licensing and assignment of trademarks, it being understood that the compulsory licensing of trademarks shall not be permitted and that the owner of a registered trademark shall have the right to assign the trademark with or without the transfer of the business to which the trademark belongs.

therefore do not easily fit within the category of private property.”<sup>77</sup> Some European countries view the collective ownership of geographical indications as a right “which cannot be licensed or transferred out of the region.”<sup>78</sup> In this way, geographical indications reflect an emphasis on preservation of “heritage, rural landscapes and perhaps even a sense of regional or national identity.”<sup>79</sup>

The term of protection also differs between trademarks and geographical indications. The *TRIPS Agreement* limits trademark protection to “no less than seven years” although indefinite renewal is possible if one meets conditions such as use.<sup>80</sup> Geographical indications are unlimited in their duration although also subject to a use requirement. While holders of trademarks and geographical indications may both effectively have indefinite protection, the policy behind the approach differs. This is

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<sup>77</sup> *Supra* note 3 at footnote 19 and corresponding text:

This has been echoed in several GI decisions; for e.g. by the Swiss Federal Court of Justice, in the context of the narrower category of Appellations of Origin. See *Anheuser-Busch Inc. v. Budejovicky Budvar Nardoni Podnik* [2001] 7 ETMR 74, 82 (‘The function both of trade mark protection and of protection for appellations of origin is to ensure the distinguishing function of the designation and to prevent mistaken attributions – whether regarding the manufacturer or the place of origin. But unlike trade marks, appellations of origin attribute the goods for which they are used not to a certain undertaking but to a country, a region or a place.’)

<sup>78</sup> *Supra* note 3 at footnote 76. See also Jose Manuel Cortes Martin ‘The World Trade Organization TRIPS Agreement – The Battle between the Old and the New World over the Protection of Geographical Indications’ (2004) 7 *J World Int Prop* 287, 309. (‘GIs [geographical indications] and trademarks are inherently different intellectual property rights. The requirements applied to certification marks are much simpler than those applied to GIs which are much more precise when demanding that the particular characteristics of a product or its reputation are tied to a determined geographic area.’) See also Florent Gevers ‘Geographical Names and Signs Used as Trade Marks’ [1990] *EIPR* 285, 286; LA Lindquist ‘Champagne or Champagne? An Examination of U.S. Failure to Comply with the Geographical Provisions of the Trips Agreement’ (1999) 27 *Georgia J of International and Comparative L* 309, 311.

<sup>79</sup> *Supra* note 3 at footnote 76.

<sup>80</sup> *Supra* note 1 at Article 18.

because a trademark is subject to an ongoing use requirement in association with the registered goods compared to geographical indications which rely on demonstrating a link to the past and do not require renewal once the link has been successfully established.

Some overlap exists in the nature of the object protected in trademarks and in geographical indications. While both devices protect goods, one may also register trademarks in association with services and not geographical indications. Trademarks are also generally unrestricted with respect to the type of good or service with which they are registered<sup>81</sup> so long as they are “capable of distinguishing the goods or services of one undertaking from those of other undertakings”.<sup>82</sup> Both trademarks and geographical indications perform an informative function for consumers to differentiate goods.<sup>83</sup> Their function as source identifiers may elicit consumer expectations of

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<sup>81</sup> *Supra* note 1 Article 15.4 which states: The nature of the goods or services to which a trademark is to be applied shall in no case form an obstacle to registration of the trademark.

<sup>82</sup> *Supra* note 1 Article 15.1 definition of ‘trademark’.

<sup>83</sup> *Supra* note 1 Article 15.1. The function of trademarks as source identifiers is visible in Article 15.1 which states:

Any sign, or any combination of signs, **capable of distinguishing** the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark [emphasis added].

The function of geographical indications as source identifiers is visible in Article 22.1 which states:

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

quality.<sup>84</sup> The difference between the devices is that the commercial origin of trademark-protected goods can vary over time while the origin of the geographical indication's good is inextricably linked to one location associated with the product's reputation.<sup>85</sup> This restriction for geographical indications is significant as one must demonstrate a connection between the good and the region of production. The distinctiveness of a geographical indication is "the ability to differentiate between similar products on the marketplace and *not* in the classical trademark sense."<sup>86</sup>

Another difference between trademarks and geographical indications with respect to the nature of the object is that one geographical indication may protect only one good while one trademark may protect multiple goods in multiple product categories. For example, the geographical indication of 'Champagne' can only refer to the fizzy beverage made from grapes and fermented twice. The trademark 'JACKSON TRIGGS' may be registered for use in association with sparkling wine, clothing and or restaurant services.

With respect to the nature of the right, both devices grant *exclusive* rights to certain uses of a word or symbol. The purpose of exclusive rights is dual in nature: exclusivity protects consumers from deception as to a product's origin and it shields

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<sup>84</sup> As suggested by the United States in the *EC-US Report* at *supra* note 35 at 132. (All Written and Oral Submissions are contained in the Annexes to the DS174 Panel Report).

<sup>85</sup> *Supra* note 3 at circa footnote 5 and corresponding text.

<sup>86</sup> *Ibid.* See footnote 5 where Gangjee adopted "Barton Beebe's differentiation between source distinctiveness (specifically indicating commercial origin) and differential distinctiveness (the uniqueness of a sign when compared to other signs). Trademark law has traditionally been committed to the former, whereas GIs [geographical indications] are incapable of the former but valued for the later." See Barton Beebe 'Search and Persuasion in Trademark Law' (2005) 103 Michigan Law Review at 2028-2031.

producers from unfair competition.<sup>87</sup> Exclusive trademark rights decrease consumer search costs while increasing incentives for producers to maintain product quality as producers are assured “that they, and not their rivals, reap the reputational rewards of that investment.”<sup>88</sup> The same rationale applies to geographical indications<sup>89</sup> with the exception that the ‘exclusivity’ belongs to the collective of users as opposed to one corporation.<sup>90</sup> A difference between trademarks and geographical indication is the origin of the right. Trademarks are the product of human creation and one may create a mark overnight which may last as long as the public recognizes a link between the mark

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<sup>87</sup> *Supra* note 3 at footnote 22 and corresponding text that states:

This is the standard account in Anglo-American trademark jurisprudence. See generally WR Cornish & D Llewelyn *Intellectual Property* 5<sup>th</sup> edn (Sweet & Maxwell London 2003) 586-587; JT McCarty *McCarthy on Trademarks and Unfair Competition* 4<sup>th</sup> ed (West Group St Paul 2006) Ch 3 (Detailed account of how producers and consumers benefit from the identification function of a trademark). The European Court of Justice has echoed this sentiment for GIs: see *Commission v Germany* (C-12/74) [1975] ECR 181 at [7] (‘[T]hese appellations...must satisfy the objectives of such protection, in particular the need to ensure not only that the interests of the producers concerned are safeguarded against unfair competition, but also that consumers are protected against information which may mislead them.’)

<sup>88</sup> *Supra* note 3 at footnote 24 and corresponding text.

<sup>89</sup> See the OECD Study *Appellations of Origin and Geographical Indications in OECD Member Countries: Economic and Legal Implications* (Dec 2000) COM/AGR/APM/TD/WP(2000) 15/FINAL 7-8, 31-34; D Rangnekar *The Socio-Economics of Geographical Indications: A Review of the Empirical Evidence from Europe* (UNCTA/ICTSD Issue Paper No. 4, May 2004) 13-16; W van Caenegem ‘Registered Geographical Indications: Between Rural Policy and Intellectual Property – Part I (2003) 6 J World Intell Prop 699, 709-710. However historical debates and negotiations surrounding GI protection contain a persistent strand of misappropriation prohibition logic. This does not sit comfortably with the purely communicative model espoused by law and economics analysis, at least as an accurate descriptive proposition.

<sup>90</sup> *Supra* note 3 at footnote 24 and corresponding text.

and the given products or services with which it is used while geographical indications represent a link to a country's tradition, culture and history<sup>91</sup>.

Trademarks and geographical indications are related concepts because both devices identify a product's source and act as information for consumers. The nature of the right is another similar concept shared by trademarks and geographical indications. This is because both devices grant exclusive rights to certain uses of a word.

### ***The Legal Framework***

The following section examines trademarks and geographical indications according to the relevant international instrument, the *TRIPS Agreement*. The purpose is to provide a legal context for analyzing the two devices in Chapter 3's discussion of the *World Trade Organization Dispute*. The section first examines trademarks and then geographical indications.

Article 15.1 of the *TRIPS Agreement* describes protectable trademark subject matter.<sup>92</sup> Trademarks are not merely a company name or logo but rather the combination of text, font, colour, and figurative elements. The unique combination of these elements creates a distinctive sign linking a product to its producer.<sup>93</sup>

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<sup>91</sup> *Supra* note 47 at 631.

<sup>92</sup> *Supra* note 1 at Article 15.2-5 are interpretation aids regarding publishing obligations and optional 'use' requirements. Note: if use is required, the *TRIPS Agreement* Article 19 applies. Article 19 states that "[...] the registration may be cancelled only after an uninterrupted period of at least three years of non-use, unless valid reasons based on the existence of obstacles to such use are shown by the trademark owner. [...]"

<sup>93</sup> *Supra* note 1 at Article 15.1:

The *TRIPS Agreement* Article 16.1 outlines the rights member states must confer upon trademark holders: exclusive use in the case of trade in goods or services of a registered trademark.<sup>94</sup> For Member States to be in compliance with *TRIPS*, mark holders must satisfy a two-part test: trademark holders must demonstrate firstly that a third party acting without consent is using the mark and secondly that the use results in confusion. The laws of Member States must reflect the *TRIPS Agreement* requirement that confusion arises when a competitor uses an identical or similar mark on counterfeit goods. If the mark holder meets both elements of the test, domestic law in Member States must provide that the mark holder be able to prevent competitors from using the

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**1. Any sign, or any combination of signs, capable of distinguishing the goods or services** of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible [emphasis added].

<sup>94</sup> *Supra* note 1 at Article 16.1:

**1. The owner of a registered trademark shall have the exclusive right to prevent all third parties** not having the owner's consent **from using** in the course of trade **identical or similar signs for goods or services** which are identical or similar to those in respect of which the trademark is registered **where such use would result in a likelihood of confusion**. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use [emphasis added].

same or a similar mark. The term of protection in Member States must last at least seven years with the opportunity to renew a mark indefinitely.<sup>95</sup>

Article 22.1 of the *TRIPS Agreement* defines geographical indications 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** [emphasis added].

According to the definition, a good's quality, reputation or other characteristic satisfies the criteria for a geographical indication as long as it is attributable to the good's geographical origin.<sup>96</sup> The article broadly defines the term, creating the opportunity for widely differing thresholds to define geographical indications. Note that the definition relates only to goods and excludes services.<sup>97</sup> The definition also fails to address the question of specifications or standards to determine the quality, reputation, or other characteristic, which will make goods protectable.<sup>98</sup>

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<sup>95</sup> *Supra* note 1 at Article 18.

<sup>96</sup> Matthijs Geuze, "The Provisions on Geographical Indications in the TRIPS Agreement" (2009) 10:1 The Estey Centre Journal of International Law and Trade Policy 50 at 53.

<sup>97</sup> Irina Kireeva, Wang Xiaobing & Zhang Yumin, "Comprehensive Feasibility Study for Possible Negotiations on a Geographical Indications Agreement between China and the EU", EU-China Project on the Protection of Intellectual Property Rights, 27 April 2009 at 11. Note that Liechtenstein, Peru and Switzerland recognize services as forms of geographical indications. Among services recognized as geographical indications are health services and traditional healing methods.

<sup>98</sup> *Supra* note 41 at 173.



The definition refers to ‘indications’ which are not necessarily geographical locations.<sup>99</sup> The scope of geographical indications therefore includes direct and indirect geographical indications.<sup>100</sup> Direct indications require the product name to be a geographic name. Indirect indications are “non-geographical names or symbols, if perceived by the public as identifying a certain geographical origin.”<sup>101</sup> Recognition of indirect geographic indicators means that the *TRIPS Agreement* protects “other signs of geographical significance whether composed of words, phrases, symbols or emblematic images.”<sup>102</sup> An example of such a geographical indication is ‘feta’ which is neither a place nor region in Greece yet relates to the Greek culture.<sup>103</sup>

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<sup>99</sup> The concept of ‘geographical indications’ combines terms from two prior international agreements: the 1891 *Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods*, Apr. 14, 1891, as last revised at Lisbon on Oct. 31, 1958, 828 U.N.T.S. 163 [*Madrid Agreement*] and the 1958 *Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration*, Oct. 31, 1958, as last revised Jan. 1, 1994, 923 U.N.T.S. 205 [*Lisbon Agreement*]. The *Madrid Agreement* recognized ‘indications of source’ that indicate the place or country of origin such as ‘Made in America’ or ‘Product of Mexico’. Indications of source differ from geographical indications in that they do not link a product’s quality to geography. The *Lisbon Agreement* defined ‘appellation of origin’ in Article 2.1 as a geographical name that “designates a product whose quality and characteristics are exclusively or essentially related to the geographical environment, including natural or human factors”. This definition links a product’s quality with its geographical location and is therefore a higher threshold than indications of source.

<sup>100</sup> WIPO, *Trademarks and Geographical Indications*, WIPO – WASME/IPR/GE/03/2(Sep 29,2003) at 21.

<sup>101</sup> *Ibid.*

<sup>102</sup> WIPO’s Standing Committee on the Law of Trademarks, Industrial Designs & Geographical Indications, *The Definition of Geographical Indications*, SCT/9/4, (October 1,2002) at 3.

<sup>103</sup> *Ibid.* See supra notes 69-74.

In order for an indication of a good to qualify for geographical indication status under the *TRIPS Agreement*, it must meet the following three conditions:<sup>104</sup>

1. The good must have a consistent, unique quality;
2. The product must originate from a defined area; and
3. The goods must have qualities, reputation or other characteristics which are clearly linked to the geographical origin of goods.

***(i) Characteristic 1: Consistent, Unique Quality***

This characteristic justifies protecting an indication of a good. Consistent quality is necessary for creating a reputation and often, monopoly, being able to justify a higher price. For example, the average French cheese with a geographical indication sells for an additional 3.00€ per kilogram than a French cheese without a designation.<sup>105</sup> Other examples include Toscano olive oil, with its 10% price increase since obtaining geographical indication protection as well as Jamao coffee from the Dominican Republic where the price rose from US \$67/lb to US \$107/lb.<sup>106</sup> In addition to this anecdotal evidence of the value of geographical indications, a European Commission survey found that “almost half of EU consumers (43%) were prepared to pay up to 10% more for

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<sup>104</sup> Jingjing Zhou, *A Review of GI Protection From a Chinese Perspective* (LL.M. Thesis, University of Western Ontario 2007) [unpublished] at 14-15.

<sup>105</sup> Paul Vandoren, *The EU Geographical Indications Labeling System*, Tokyo-Osaka, (March 10-12, 2004) online: European Union Delegation of the European Commission to Japan <[http://jpn.cec.eu.int/home/showpage\\_en\\_event.eventobj53.1.php](http://jpn.cec.eu.int/home/showpage_en_event.eventobj53.1.php)>.

<sup>106</sup> *Ibid.*

products bearing a label of origin.”<sup>107</sup> In this way, geographical indications can assist in promoting a region’s goods thereby “serv[ing] important business interests.”<sup>108</sup>

***(ii) Characteristic 2: Product Origin***

The information provided by registering a geographical indication points to the product’s origin, protecting “consumers from the use of deceptive or misleading labels and provid[ing] consumers with choices among products and with information on which to base their choices.”<sup>109</sup>

***(iii) Characteristic 3: Qualities, Reputation, or Other Characteristics Linked to the Geographical Origin of Goods***

Goods protected by registered geographical indications derive reputation from natural factors such as climate and human factors such as production methods connected to a geographical region.<sup>110</sup> The production of Roquefort cheese illustrates how climate affects the quality of a good as producers age the cheese in the caves of the Roquefort district in France.<sup>111</sup> Roquefort reflects the caves’ unique atmosphere and therefore production of the cheese is inextricably linked to the geographic location.

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<sup>107</sup> *Ibid.*

<sup>108</sup> Steven A. Bowers, “Location, Location, Location: The Case against Extending Geographical Indication Protection under the TRIPS Agreement” (2003) 31 AIPLA Q. J. 129 at 131.

<sup>109</sup> Jose Manuel Cortes Martin, “TRIPS Agreement: Towards a Better Protection for Geographical Indications?” (2004-2005) 30 Brook. J. Int’l L. 117 at 118.

<sup>110</sup> *Ibid.*

<sup>111</sup> Lawrence W. Pollack, “Roquefort – An Example of Multiple Protection for A Designation of Regional Origin under the Lanham Act” (1962) 52 Trademark Rep. 755.

The *TRIPS Agreement* currently contains two levels of protection of geographical indications for goods. The first level provides protection for all goods except wines and spirits, the second provides a higher level of protection for wines and spirits. The purpose of Article 24.1 is to increase geographical indication protection while Article 24.2 creates a role for the World Trade Organization Council of *TRIPS* in negotiations.

Article 22 requires Members to provide a legal structure for holders of geographical indications. The Article focuses on protecting the public from misleading geographical indications and or trademarks.<sup>112</sup> Article 24.3 cements protection for geographical indications at the pre-existing level before the *TRIPS Agreement* came into force. The remainder of Article 24 emphasizes good faith,<sup>113</sup> exempts common language as infringement of a geographical indication,<sup>114</sup> and allows the use of a person's name or business partner predecessor to be a geographical indication so long as the public is not misled.<sup>115</sup> Article 24.9 is a list of situations when Members are exempt from protecting geographical indications. Article 22.2 subparagraphs (a) and (b) prohibit false or misleading designations regarding the product origin.<sup>116</sup> A

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<sup>112</sup> *Supra* note 104 at 70.

<sup>113</sup> *Supra* note 1 at Articles 24.4, 24.5, and 24.7.

<sup>114</sup> *Supra* note 1 at Article 24.6.

<sup>115</sup> *Supra* note 1 at Article 24.8.

<sup>116</sup> *Supra* note 1 at Article 22.2 states:

2. In respect of geographical indications, **Members shall provide the legal means for interested parties to prevent:**

(a) **the use of any means** in the designation or presentation of a good **that indicates or suggests that the good** in question **originates in**

geographical indication offends the provision if it misleads the public with respect to the good's geographic origin.<sup>117</sup> To engage the Article, countries must provide that holders of geographical indications need to demonstrate that the competitor's mark or geographical indication misleads the public or that the situation constitutes an act of unfair competition.

Article 22.4 extends geographical indication protection to regions "which, although literally true about the territory, [...] falsely represents to the public that the goods originate in another territory." This subparagraph addresses situations where, for example, cities in different countries share the same name a manufacturer of goods originating in a city not famous for the product must not be allowed to use the city name such that consumers think the goods are from the city of the same name that **is** famous for such goods.

Article 22.3 consists of rules to protect geographical indications through the trademark system. The Article restricts trademark applications or invalidates a registered trademark "if the TM [trademark] under consideration contains or consists of a false or misleading GI [geographical indication]."<sup>118</sup> In this way, the *TRIPS Agreement*

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**a geographical area other than the true place of origin in a manner which misleads the public** as to the geographical origin of the good;

(b) **any use which constitutes an act of unfair competition** within the meaning of Article 10*bis* of the Paris Convention (1967) [emphasis added].

<sup>117</sup> *Ibid.* This is in contrast to the protection afforded to wines and spirits.

<sup>118</sup> *Supra* note 97 at 12.

is broader than previous international agreements as it expands geographical indication protection into the sphere of trademarks.<sup>119</sup>

On the other hand, Article 24, mentioned above, reflects the tension in negotiations of the *TRIPS Agreement* as the Article carves out exceptions to Articles 22 and 23.<sup>120</sup> The conflict is between two groups: the 'Old World' and the 'New World'.<sup>121</sup> The 'Old World' consists of longstanding cultures such as European, Middle Eastern and Asian countries. For the purpose of this thesis and the *World Trade Organization Dispute* examined, the thesis focuses on the 'Old World' as represented by European countries. The 'New World' comprises countries that are younger and have been relatively recently colonized by the Europeans, such as North America, South America, Australia and New Zealand. These countries are also home to older aboriginal cultures; however, the law on which this thesis focuses has been shaped by immigrant European populations.

The 'Old World' wants to create a multilateral registry for wines and spirits and increase protection for geographical indications generally while the 'New World' does not.<sup>122</sup> During the original World Trade Organization *TRIPS Agreement* negotiations in

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<sup>119</sup> L. Bauemer, "Protection of Geographical Indications under WIPO Treaties and Questions Concerning the Relationship Between Those Treaties and the TRIPS Agreement" in *Symposium on the International Protection of Geographical Indications in the Worldwide Context* (1997) at 21.

<sup>120</sup> Daniel Gervais, *The TRIPS Agreement: Drafting History and Analysis*, (London: Sweet & Maxwell, 1998) at 197.

<sup>121</sup> *Supra* note 48.

<sup>122</sup> *Supra* note 47 and corresponding text.

the Uruguay round of talks,<sup>123</sup> the parties were at loggerheads to such a point that “the only possible outcome not blocking the negotiation was thus to agree to further talks”<sup>124</sup> and thus are part of the current ‘compromised’ text of Article 24 of the *TRIPS Agreement*.

### **Additional Protection for Wines and Spirits**

Article 23 creates a different protection for geographical indications in connection with wines and spirits.<sup>125</sup> While the general protection in Article 22 prohibits geographical indications that mislead the public, Article 23 is broader in that it prevents misuse even where the public is not misled. There is, therefore, “no need to show that the public might be misled or that the use constitutes an act of unfair competition, and this is the main reason why Article 23 is considered additional

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<sup>123</sup> The Uruguay round of World Trade Organization negotiations led to the creation of the *TRIPS Agreement*.

<sup>124</sup> *Supra* note 120 at 203.

<sup>125</sup> *Supra* note 1 Article 23.1 states:

Each Member shall provide the legal means for interested parties to prevent use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as “kind”, “type”, “style”, “imitation” or the like.

protection.”<sup>126</sup> Article 23 thus requires Members to meet a higher threshold of protection for wines and spirits.<sup>127</sup>

Article 23.2 addresses trademarks in wines and spirits.<sup>128</sup> The section differs from Article 22.3 for other goods as Article 23.2 “applies specifically to indications identifying wines and spirits” and is different from Article 22.3 because “deception (misleading the public about the true place of origin) does not have to be shown.”<sup>129</sup> Article 23.3 considers wines and spirits indications with identical names and requires that “protection shall be accorded to each indication, subject to the provisions of paragraph 4 of Article 22.”<sup>130</sup> In Article 23.4 Member States agreed to negotiations regarding the creation of a “multilateral system of notification and registration of geographical indications for wines eligible for protection in those members participating

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<sup>126</sup> *Supra* note 104 at 71.

<sup>127</sup> *Ibid.*

<sup>128</sup> *Supra* note 1 Article 23.2 states:

The registration of a trademark for wines which contains or consists of a geographical indication identifying wines or for spirits which contains or consists of a geographical indication identifying spirits shall be refused or invalidated, *ex officio* if a Member's legislation so permits or at the request of an interested party, with respect to such wines or spirits not having this origin.

<sup>129</sup> *Supra* note 120 at 197.

<sup>130</sup> *Supra* note 1 at Article 23.3 states:

In the case of homonymous geographical indications for wines, protection shall be accorded to each indication, subject to the provisions of paragraph 4 of Article 22. Each Member shall determine the practical conditions under which the homonymous indications in question will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled.



in the system.”<sup>131</sup> As the thesis discusses in Chapter Three, this Article continues to be a point of contention at the World Trade Organization Doha round talks.

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<sup>131</sup> *Supra* note 1 at Article 23.4.

## Chapter 2

[T]he world of brands and marketing depends overwhelmingly on the laws that establish trademark registration, because every modern brand is based on ease of enforcement of the legally granted monopoly of a registered trademark. It is this monopoly that justifies investment in advertising and other marketing techniques to build brand equity into what for many firms today is their most valuable asset.<sup>132</sup>

Kingston's comment illustrates a traditional perspective on the link between brands and trademarks: trademarks are the primary legal vehicle for brands. Does this relationship continue to hold true? Are the terms brand and trademark synonymous? Are trademarks the *only* legal vehicle for brand protection? This chapter asks the question: does marketing literature recognize either or both of registered trademarks and geographical indications as tools for branding? The chapter's research proposition is that the marketing literature will reference registered trademarks but not geographical indications. The chapter begins by comparing marketing and legal definitions of 'brand' with the *TRIPS* definitions of 'trademark' and 'geographical indication' to determine if any overlap between the concepts exists. The chapter will then present findings from a literature review of marketing journals to identify if any articles associate 'brand' and 'trademark' or 'brand' and 'geographical indication'. The results will provide evidence of industry's recognition, or lack of recognition, of trademarks and geographical indications as forms of branding.

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<sup>132</sup> William Kingston, "Trademark Registration Is Not a Right" (2006) 26 No.1 Journal of Macromarketing at 19.

### **“Brand” in Law**

This section examines the evolution of the definition of ‘brand’ from a legal and marketing perspective. The definitions are then compared to the *TRIPS* definitions of ‘trademark’ and ‘geographical indication’. This analysis provides a foundation for the terms used in the marketing literature data below; it also offers a method by which to compare the terms to determine if any overlap exists between them.<sup>133</sup>

Although disagreement exists with respect to the definition of ‘brand’, marketers tend to agree that the concept derived from trademarks.<sup>134</sup> The traditional function of trademarks is to identify the source of a product with protection for the product name, logo, and packaging aspects that may include the shape of the product.<sup>135</sup> In the mid 1990’s marketing literature began to expand the definition of ‘brand’, as reflected in Ambler’s definition that a brand is **“A product plus added values... A brand is a bundle of functional, economic and psychological benefits for the end user,** more simply known as quality, price and image [emphasis added].”<sup>136</sup> The association of intangible characteristics with brands has been attributed to growth in advertising and an increase

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<sup>133</sup> Whether the concepts overlap is relevant to the discussion in Chapter 4 of the thesis.

<sup>134</sup> Belinda Isaac, *Brand Protection Matters*, (London: Sweet & Maxwell, 2000) at 8.

<sup>135</sup> *Ibid.*

<sup>136</sup> “Building Brand Relationships”, *Financial Times*, December 4, 1995. The meaning of ‘brand’ remains elusive and contentious. Marketing Professor de Chernatony has identified the following nine themes to define ‘brand’: (i) a legal instrument, (ii) a logo, (iii) a company, (iv) an identity system, (v) an image in consumers’ minds, (vi) a personality, (vii) a relationship, (viii) adding value, and (ix) an evolving entity. *Supra* note 65 [*Chasm*] at 89.

in affluence.<sup>137</sup> The definition's use of the term 'values' and reference to 'psychological benefits' illustrates a concept of 'brand' that has transformed from a process focus to an attempt to create an emotional connection with consumers. This is a broader view of the word 'brand' than Kingston's comment above which emphasizes the trademark registration process. It is the expanded concept of brand that is relevant to the thesis. This is because if the broader definition of brand includes geographical indications, the finding would support an interpretation of the language of the *TRIPS Agreement*, discussed in Chapter Four, that the concepts are interchangeable intellectual property law tools.<sup>138</sup> The following analysis also provides an industry perspective on trademarks and geographical indications which could support the view that, though distinct, the devices may coexist.<sup>139</sup>

Table 2 below tracks the legal definition of 'brand' over several decades.

**Table 2: Legal Dictionary Definitions of 'Brand'**

Date of Definition	Definition/Description of 'Brand'	Source
1979	A word, mark, symbol, design, term, or a combination of these, both visual and oral, used for the purpose of identification of some product or service.	Black's Law Dictionary Special Deluxe Fifth Edition
1990	A word, mark, symbol, design, term, or a combination of these, both visual and oral, used for the purpose of identification of some product or service.	Black's Law Dictionary with Pronunciations, 6 <sup>th</sup> Edition

<sup>137</sup> *Supra* note 134 at 8.

<sup>138</sup> See Chapter 4 for further analysis.

<sup>139</sup> As is articulated in the *EC-US Report supra* note 35 at para 7.661.

1999	No definition available. Definition of 'branding' available referring to cattle branding.	Black's Law Dictionary 7 <sup>th</sup> edition
2004	<ol style="list-style-type: none"> <li>1) A character or combination of characters impressed or intended to be impressed on the skin or hide of stock to show ownership of the stock.</li> <li>2) Any mark, stencil, stamp, label or writing placed on any milk product or package.</li> </ol>	The Dictionary of Canadian Law, 3 <sup>rd</sup> edition
2004	<p><b>Brand. Trademarks.</b> A name or symbol used by a seller or manufacturer to identify goods or services and to distinguish them from competitors' goods or services; the term used colloquially in business and industry to refer to a corporate or product name, a business image, or a mark, <b>regardless of whether it may legally qualify as a trademark</b> [emphasis added].</p> <ul style="list-style-type: none"> <li>• Branding is an ancient practice, evidenced by individual names and marks found on bricks, pots, etc. In the Middle Ages, guilds granted their members the right to use a guild-identifying symbol as a mark of quality and for legal protection.</li> </ul> <p><b>Private brand.</b> An identification mark placed on goods made by someone else under license or other arrangement and marketed as one's own. • The seller of private-brand goods sponsors those goods in the market, becomes responsible for their quality, and has rights to prevent others from using the same mark.</p> <p><b>Brand architecture. Trademarks.</b> The strategic analysis and development of optimal relationships among the multiple levels of a company and its brands, products, features, technology, or ingredient names.</p>	Black's Law Dictionary 8 <sup>th</sup> edition
2009	<b>Brand: Trademarks.</b> A name or symbol used by a seller or manufacturer to identify goods or services and to distinguish them from competitors' goods or services; the	Black's Law Dictionary 9 <sup>th</sup> edition

	<p>term used colloquially in business and industry to refer to a corporate or product name, a business image, or a mark, regardless of whether it may legally qualify as a trademark.</p> <ul style="list-style-type: none"> <li>• Branding is an ancient practice, evidenced by individual names and marks found on bricks, pots, etc. In the Middle Ages, guilds granted their members the right to use a guild-identifying symbol as a mark of quality and for legal protection.</li> </ul> <p><b>Private brand.</b> An identification mark placed on goods made by someone else under license or other arrangement and marketed as one's own. • The seller of private-brand goods sponsors those goods in the market, becomes responsible for their quality, and has rights to prevent others from using the same mark.</p> <p><b>Brand architecture.</b> <i>Trademarks.</i> The strategic analysis and development of optimal relationships among the multiple levels of a company and its brands, products, features, technology, or ingredient names.</p>	
2011	<p>1) An identification impressed or affixed on or within the body of livestock to indicate ownership. <i>Livestock Identification Act, R.S.B.C. 1996, c. 271, s.1.2</i></p> <p>(i) A character or combination of characters, and</p> <p>(ii) any other mark or thing prescribed as a brand in the regulations that is used for the purpose of denoting ownership of or a livestock security interest in the livestock bearing the brand, but does not include an honorary brand, an age brand or an individual animal brand. <i>Livestock Identification and Commerce Act, S.A. 2006, c.L-16.2, s. 1.3.</i></p> <p>All of the brand elements that as a whole are used by a manufacturer to identify to a consumer a tobacco product made by the manufacturer that is a cigarette. <i>Tobacco Act, S.C. 1997, c.13, Cigarette Ignition Propensity Regulations, SOR/2005-178, s.1</i></p>	The Dictionary of Canadian law, 4 <sup>th</sup> edition

The legal definitions of ‘brand’ predominately equate ‘brand’ and ‘trademark’ as source identifiers. This is evident both in the descriptive terms of ‘brand’ in the 1979 definition as a “word, mark, symbol, design, term, or a combination of these” as well as the explicit reference to ‘trademark’ in the 2004 and 2008 definitions. The Black’s Law Dictionary 2004 and 2009 definitions of ‘brand’ are more comprehensive, with references to ‘private brand’ and ‘brand architecture’. The definition also broadened with respect to the part that references ‘brand’ as “the term used colloquially in business and industry to refer to a corporate or product name, a business image, or a mark, *regardless of whether it may legally qualify as a trademark* [emphasis added].” The legal definitions of ‘brand’ otherwise remain strongly linked to trademarks. This is apparent when one compares the legal ‘brand’ definitions above to the *TRIPS* definition of ‘trademark’<sup>140</sup> below:

**Any sign, or any combination of signs, capable of distinguishing the goods or services** of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, **in particular words including personal names, letters, numerals, figurative elements and combinations of colours** as well as any combination of such signs, shall be eligible for registration as trademarks [...] [emphasis added].

The key components of the *TRIPS* definition of ‘trademark’ are the reference to types of signs distinguishing goods or services. These elements of the *TRIPS* definition are almost identical to the 1979 and 1990 definitions of ‘brand’ above and continue to form part of

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<sup>140</sup> *Supra* note 1 **Error! Bookmark not defined.** at Article 15.1.

the legal definition of ‘brand’. By contrast, the legal definition of ‘brand’ does not overlap with the *TRIPS* definition of ‘geographical indication’<sup>141</sup>:

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

The definitions do not overlap because the definition of ‘geographical indication’ is premised upon associating a good with a geographic region. This is not true of the legal definitions of ‘brand’. The definitions also differ in that ‘brand’ refers to goods or services<sup>142</sup> while geographical indications reference goods only.

### ***‘Brand’ as a Marketing Concept***

The following timeline demonstrates the evolution of marketing definitions of ‘brand’, from a focus on source identification to a focus on more abstract qualities.

**Table 3: Marketing Definitions of ‘Brand’**

<b>Date of Definition</b>	<b>Definition/Description</b>	<b>Source</b>
1960s	“A name, term, sign, symbol, or design, or a combination of these, intended to identify the goods or services of one seller or group of sellers and to differentiate them from those of competitors.”	American Marketing Association (Nilson, <i>Value Added Marketing</i> (McGraw Hill, Maidenhead, 1992) at 19.
1991	“A brand...signals to the consumer the source of the product, and protects the customer and the producer from competitors who would attempt to provide products that appear to be identical.”	David Aaker, <i>Managing Brand Equity</i> (Macmillan, New York, 1991) at 7.

<sup>141</sup> *Supra* note 1 at Article 22.1.

<sup>142</sup> See for example the Black’s Law Dictionary 2009 definition of ‘brand’ in Table 2 above.



1992	<p>“The physical purchasing action is caused by a decision to acquire a product; the brand is there to serve as a means of identifying the manufacturer. <b>The values of the brand will reflect on the product, but one must not forget that it is the product that is bought.</b>” [emphasis added]</p>	<p>Nilson (Nilson, <i>Value Added Marketing</i> (McGraw Hill, Maidenhead, 1992) at 114.</p>
1994	<p>“To think of <b>a brand as a set of ‘intangible values’</b>, by contrast, is to understand something which is absolutely crucial in the successful development of brands today. And that is that brands do not exist, in any meaningful sense, in the factory or even in the marketing department. <b>They exist in the consumer’s mind.</b>” [emphasis added]</p>	<p><i>Total Branding by Design</i> (Kogan Page, London, 1994) at 18.</p>
1995	<p>“a product plus added values...<b>A brand is a bundle of functional, economic and psychological benefits</b> for the end user, more simply known as quality, price and image.” [emphasis added]</p>	<p>Tim Ambler and Chris Styles, “Brand Equity: Towards Measures that Matter” Center for Marketing Working Paper 95-902 London Business School</p>
1997	<p>“a link between the firms’ marketing activities and <b>consumer perceptions of functional and emotional elements</b>” [emphasis added]</p>	<p>De Chernatony, <i>Creating Powerful Brands</i> (Butterworth Heinemann, Oxford, 2<sup>nd</sup> ed., 1998)</p>
2006	<p>“Defining a brand is not easy. <b>A lawyer would tend to think of goodwill, trade marks and so on. But a brand includes more elements; such as image and reputation;</b> the values that the brand owner tries to inculcate in the buying public. A brand is what customers choose to buy. <b>Many decisions about brands are made by customers emotionally</b> or intuitively rather than rationally. <b>Successful brands create a relationship of trust between the customer and the brand.</b>” [emphasis added]</p>	<p><i>O2 Holdings Ltd. v Hutchison 3G Ltd.</i> [2006] EWHC 534 (Ch) (Transcript) at para 4.</p>
2008	<p>“[...] <b>the buyer is not really buying a thing; he is buying a vague expectation;</b> and it is the brand that provides the expectation.” [emphasis added]</p>	<p><i>Infra</i> note 1337 at 192.</p>

The early marketing definitions of 'brand' are synonymous with the *TRIPS* definition of a trademark as both refer to symbols identifying goods or services. The 1992 definition of 'brand' is the start of an expanded concept as it mentions a brand's values. The 1994 definition broadened the scope with reference to 'intangible values' and the 1995 definition expanded the term once again with use of the term 'psychological benefits'. The breadth of the concept grew with the description of a brand as a 'relationship of trust' with a customer in the 2006 definition and a brand as a 'vague expectation' in 2008.<sup>143</sup>

Both the legal and the early marketing definitions of 'brand' focus on a product's physical characteristics and function as a source identifier. The recent marketing 'brand' definitions demonstrate a gap between the function of a trademark and the intangible characteristics marketing literature now attributes to the definition of 'brand'. The gap between the concepts of 'brand' and 'trademark' is not as apparent in the legal definitions as the definitions overlap considerably. The law nevertheless differentiates the words with respect to legal protection as one may hold legal rights in a 'trademark' but not in a 'brand' as such. Isaac commented on the discrepancy between 'brand' and 'trademark' when she wrote that "[m]arketers constantly refer to their brands whereas lawyers tend to refer to trade marks – but what is the difference? Is a brand the same

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<sup>143</sup> The expansion of the term 'brand' is also visible in the three components of a brand: a brand's attributes, benefits and essence. These components are referred to in a hierarchy from tangible to intangible characteristics. A brand's attributes are comprised of tangible aspects such as the physical characteristics of the brand such as the colours and font used. A brand's benefits refer to an attempt to satisfy consumer wants and needs. A brand's essence, also referred to as a brand's personality. See *supra* note 134 at 10.

as a trade mark?”<sup>144</sup> British Justice Lewison also remarked on the gap between trademarks and brands in the 2006 United Kingdom case *O2 Holdings Ltd. v. Hutchison 3G Ltd.*<sup>145</sup> at para 7:

**English law does not... protect brands as such.** It will protect goodwill (via the law of passing off); trademarks (via the law of trade mark infringement); the use of particular words, sounds and images (via the law of copyright); shapes and configurations of articles (via the law of unregistered design right) and so on. **But to the extent that a brand is greater than the sum of the parts that English law will protect, it is defenceless against the chill wind of competition** [emphasis added].

As Justice Lewison notes, even the combination of the intellectual property law tools of copyright, trademark, passing off and design rights fail to fully protect the characteristics encompassed by brands.<sup>146</sup> Justice Lewison’s statement that a brand is greater than the sum of its parts is consistent with the evolution of the definition in Table 3 above. It is the abstract portion of a brand which eludes protection from traditional intellectual property law tools such as registered trademarks, passing off, and copyright.<sup>147</sup>

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<sup>144</sup> *Supra* note 134 at 1.

<sup>145</sup> [2006] EWHC 534 (Ch) (Transcript) [*O2 Holdings Ltd.*].

<sup>146</sup> Although *O2 Holdings Ltd.* and Justice Lewison’s comments address British law, the legal vehicles and concepts he discusses apply similarly in Canada with the exception of the British unregistered design right. The British ‘unregistered design right’ has been in force in Great Britain since August 1<sup>st</sup>, 1989 in the *Copyright, Designs and Patents Act, 1988*, c.48 [CDPA]. The unregistered design right is a “property right which subsists [...] in an original design” [CDPA § 213(1)]. Similar to copyright, the unregistered design right exists upon creation. [Estelle Derclaye, *The British Unregistered Design Right: Will it Survive Its new Community Counterpart to Influence Future European Case Law?* 10 Colum. J. Eur. L. 265 at 267] The right applies to the “design of any aspect of shape or configuration (whether internal or external) of the whole or part of an article” [CDPA § 213(2)]. The right is loosely similar to the Canadian right for industrial design with reference to protectable subject matter, however, the Canadian industrial design right requires registration. [*Industrial Design Act RSC 1985*, c I-9 at s.6(1)].

<sup>147</sup> While Justice Lewison’s comments highlight the combined deficiency of multiple traditional intellectual property tools, the scope of this thesis is limited to registered trademarks and geographical indications.

### ***Legal Concept of Trademark***

One could argue that while source identification for the purpose of quality control was initially the **only** function of trademarks,<sup>148</sup> the transport revolution changed the function of trademarks. This is because manufacturers began shipping goods across vast distances and the idea of brand equity<sup>149</sup> developed.<sup>150</sup> While traditional trademarks are bounded by jurisdiction,<sup>151</sup> famous marks<sup>152</sup> demonstrate a strain of trademark law which surpass jurisdictional limits.<sup>153</sup> The reach of a foreign registered trademark's reputation can also assist in registering a trademark in Canada if the applicant can demonstrate that spillover advertising of the mark in question has

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<sup>148</sup> *Kirkbi AG v. Ritvik Holdings Inc.*, 2005 SCC 65 at para 19.

<sup>149</sup> David Aaker, an authority on branding, defines 'brand equity' as "a set of brand assets and liabilities linked to a brand, its name and symbol, that add to or subtract from the value provided by a product or service to a firm and/or to that firm's customer." David Aaker, *Managing Brand Equity*, (New York: The Free Press, 1991) at 15.

<sup>150</sup> *Supra* note 148 at para 19.

<sup>151</sup> Alexander Le Péru, *Branding and territories: the conflict of applying domestic laws to universal trademarks* (LL.M. Thesis, McGill University 2004) [unpublished].

<sup>152</sup> 'Famous Marks' or 'Well-known Marks' can be described as:

Well-known trade and service marks enjoy in most countries protection against signs which are considered a reproduction, imitation or translation of that mark provided that they are likely to cause confusion in the relevant sector of the public. Well-known marks are usually protected, irrespective of whether they are registered or not, in respect of goods and services which are identical with, or similar to, those for which they have gained their reputation. In many countries, they are also, under certain conditions protected for dissimilar goods and services.

Source: World Intellectual Property Organization; Well-known marks; <online: [http://www.wipo.int/sme/en/ip\\_business/marks/well\\_known\\_marks.htm](http://www.wipo.int/sme/en/ip_business/marks/well_known_marks.htm)>

<sup>153</sup> *Supra* note 151 generally.

resulted in the mark acquiring ‘distinctiveness’.<sup>154</sup> Protectable subject matter under trademark law is also expanding as sounds are now protectable trademarks under Canadian law.<sup>155</sup> The comments above by Isaac and Justice Lewison are nevertheless consistent with the findings in Tables 2 and 3 above that the definition of ‘brand’ is now broader than the definition of ‘trademark’ despite the broadened trademark definition.

### ***Legal Concept of Geographical Indication***

While the protectable subject matter in trademark law has broadened and trademark protection is less tied to jurisdictional boundaries, the same cannot be said for geographical indications. Revisiting the *TRIPS* definition of ‘geographical indication’,<sup>156</sup> an intrinsic part of the definition is that a geographical indication binds a

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<sup>154</sup> *Supershuttle International Inc. v. Canada (Registrar of Trade-Marks)*, 2002 FCT 426 [*Supershuttle*]. The trademark in question was registered in the United States and the applicant filed an application in Canada under s.14 of the *Trade-marks Act*, RSC 1985, c T-13 [*Trade-marks Act*]. The relevant portion of section 14 states [emphasis added]:

**14. (1) Notwithstanding section 12, a trade-mark that the applicant or the applicant’s predecessor in title has caused to be duly registered in or for the country of origin of the applicant is registrable if, in Canada,**

**(b) it is not without distinctive character**, having regard to all the circumstances of the case including the length of time during which it has been used in any country;

In *Supershuttle*, evidence of spillover advertising from the United States into Canada was allowed under the test of distinctiveness in s.14(1)(b) of the *Trade-marks Act*.

<sup>155</sup> Practice Notice “Trade-mark consisting of a sound” published on March 28, 2012 online by the Canadian Intellectual Property Office at <http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr03439.html>

<sup>156</sup> *Supra* note 1 at Article 22.1

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

good to a *geographic region*. This element of the definition is important because without a tie to a geographic region, the concept of a geographical indication does not exist. The definition of ‘geographical indication’ also discusses ‘reputation’, which is similar to language used in the marketing definitions of ‘brand’ and can be considered an ‘intangible value’ as described in the 1994 definition in Table 2 above. The use of ‘reputation’ in the definition of ‘geographical indication’ refers to a characteristic of the good “essentially attributable to its geographical origin”.<sup>157</sup> The language of the marketing literature definitions of ‘brand’ speak to a reputation generally. The fact that concepts of both devices refer to reputation may form part of the confusion between trademarks and geographical indications. Chapter Four elaborates on this issue as a source of confusion between trademarks and geographical indications.<sup>158</sup>

### *The Connection Between Trademark, Geographical Indication and Brand from a Business Perspective*<sup>159</sup>

This section reports on the results of searches in peer reviewed business journals.<sup>160</sup> The searches queried whether academic marketing material referenced trademark or geographical indications in relation to branding.

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<sup>157</sup> *Ibid.*

<sup>158</sup> See Chapter 4 for further discussion.

<sup>159</sup> ‘Business Perspective’ refers to a search of marketing journals and marketing definitions of ‘brand’ over time.

<sup>160</sup> Refer to Table 1, p.19, *supra*, and also to notes 62 – 64 and corresponding text for a discussion of methodology

As Table 1 illustrated, ninety-four<sup>161</sup> marketing journal articles referenced 'TRADEMARK' and 'BRAND' when the results from both journal databases are combined. By contrast, a total of eight marketing journal articles in the databases referenced 'GEOGRAPHICAL INDICATION' and 'BRAND'.

The results in Table 1 confirm the research proposition that marketing literature references the term 'trademark' in association with 'brand'. The second part of the research proposition was also substantiated as the marketing literature generally does not recognize 'geographical indication' in association with 'brand'. Only a small number of articles, fewer than 1/10<sup>th</sup>, referred to 'geographical indication' and 'brand'.

This finding of a correlation between trademark and brand corresponds to the overlap between the traditional legal and marketing definitions of 'brand' and 'trademark' discussed above. The finding also corresponds with the lack of overlap between the definition of 'brand' and 'geographical indication'.

This data, in Table 1, and the analysis above demonstrates that, from a marketing perspective, 'trademark' is a concept which is a subset of the concept of 'brand'. From the same analysis, one may further conclude that 'geographical indication' is not a subset of 'brand': the definition of 'geographical indication' does not

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<sup>161</sup> See Appendices B, C and D for a detailed list of results. Note that there is one duplication that is in both the search for 'geographical indication' and 'trademark' that is not noted in Table 1. That result is: Schüßler Lennart, "Protecting 'Single-Origin Coffee' within the Global Coffee Market: The Role of Geographical Indications and Trademarks" (2009) 10:1 The Estey Centre Journal of International Law and Trade Policy, suppl. Special Section on Geographical Indicators 149

fall within the definition of 'brand' and the marketing literature does not associate the two terms. From the evidence presented in this chapter, a 'geographical indication' is not an equivalent concept to a 'trademark', nor is one a subset of the other.

As the marketing literature does not recognize geographical indications as a form of 'brand', perhaps they are better classified as a form of endorsement available for qualified producers. Endorsements "are a type of extrinsic cue often used by consumers to infer beliefs and product attributes."<sup>162</sup> Geographical indications align with the description of a form of endorsement because geographical indications, like endorsements, signal product attributes as they "identify a good [...] where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin."<sup>163</sup>

### ***The Attitudes of New and Old World Tension Authors Towards Geographical Indications***

Support for geographical indications is often characterized as a divide between the 'New World' and the 'Old World', as mentioned in Chapter one. Since Old World Countries are generally ardent supporters of geographical indications, it might be supposed that authors who discuss geographical indications in a business context would more often be from Old World countries.

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<sup>162</sup> Dwane Hal Dean, "Brand Endorsement, Popularity, and Event Sponsorship as Advertising Cues Affecting Consumer Pre-Purchase Attitudes" (1999) 28:3 *Journal of Advertising* at 3. "Endorsements may be most valuable for products with experience or credence attributes."

<sup>163</sup> *Supra* note 1 at Article 22.1.

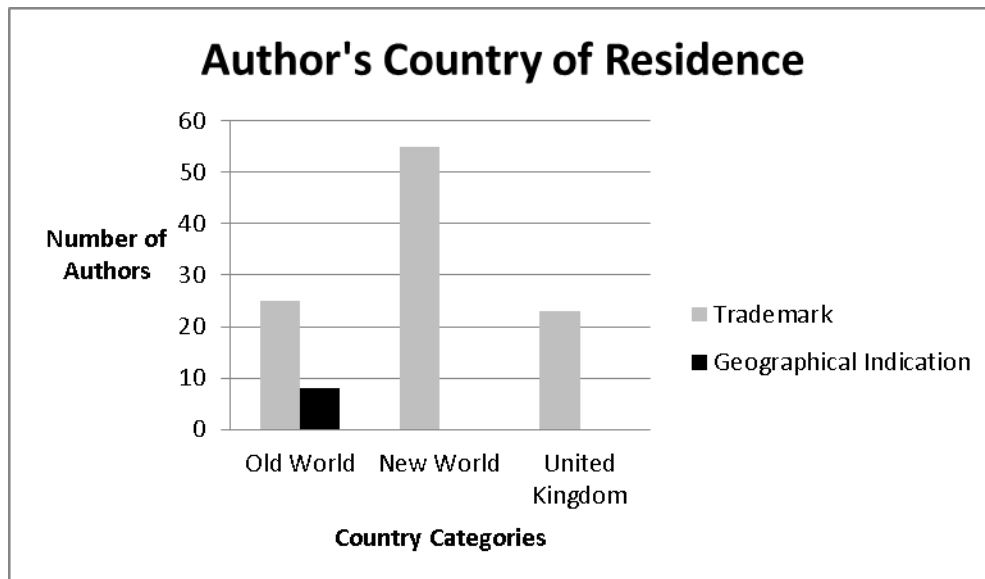


Table 4 below groups the author's country of residence according to the trademark and geographical indication articles listed in Table 1. The countries have been grouped into three categories: 'New World', 'Old World' and 'United Kingdom'. The 'New World' encompasses North and South America as well as Australia and New Zealand. The 'Old World' comprises the remainder of countries. The United Kingdom is represented separately because of the determination by the courts of that jurisdiction that competing trademarks and geographical indication marks may coexist if there is 'honest concurrent use'.<sup>164</sup> As Chapter 3 also discusses, the United Kingdom is a unique category as the country was considered independent from continental Europe for a significant period of time.<sup>165</sup> Each author of every article was included in the results so that if one article was written by three individuals, two from the United States and one from Germany, two points were given for the United States and one point was given for Germany.

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<sup>164</sup> See Chapter 3 for discussion on this topic.

<sup>165</sup> See also *supra* note 29 and corresponding text.

**Table 4: Author's Country of Residence**

The results in Table 4 demonstrate that the authors of branding articles that discuss geographical indications *all* live in the 'Old World'. Authors of branding articles that discuss trademark reside in each of the three categories ('Old World', 'New World' and the United Kingdom).

The finding that the authors of marketing articles that discuss geographical indications live in the 'Old World' is consistent with the fact that proponents of geographical indications are from the 'Old World'.

It is interesting to note that none of the United Kingdom authors wrote articles correlating geographical indications and brand. This is unexpected because the discussion in Chapter 3 of the Budweiser cases illustrates that the United Kingdom has

allowed for 'honest concurrent use' of competing marks throughout the last century.<sup>166</sup> One might have thought that some marketing literature would reflect this opportunity in British law.

### **Summary**

This chapter examined the legal and marketing definitions of 'brand', which were, in turn, compared with the *TRIPS* definitions of 'trademark' and 'geographical indication'. From the definition analysis, the chapter establishes that 'trademarks' are a subset of the concept of 'brand' and that 'geographical indications' are not a subset of 'brand' and, therefore, that geographical indications are not equivalent to 'trademarks'.

The chapter next presented data from searches of academic marketing journals looking for the terms 'trademark' and 'geographical indication' being used in connection with 'brand'. The search results demonstrate a strong correlation between use of the terms 'brand' and 'trademark'. Only a much weaker correlation was found between the terms 'geographical indication' and 'brand'. Both this data and the definition analysis establish that 'trademark' and 'brand' are definitely related concepts while 'geographical indication' and 'brand' are not. This Chapter establishes that 'geographical indications' and 'trademarks' are therefore not equivalent concepts.

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<sup>166</sup> *Infra* notes 272-273 and corresponding text.

## Chapter 3

As first described in Chapter 1, the European Community successfully argued in the *World Trade Organization Dispute* that geographical indications and trademarks may coexist under the *TRIPS Agreement*. The ruling is consistent with the recent European Court of Justice decision, *Budějovický Budvar, národní podnik, v Anheuser-Busch Inc.*,<sup>167</sup> also described in Chapter 1, involving the United Kingdom. This Chapter examines both these decisions in more detail.

### ***The World Trade Organization Dispute***

On July 14, 1992, the European Community adopted the *Regulation*.<sup>168</sup> The *Regulation* established a European Union wide system for notification and registration of European geographical indications for agricultural products and foodstuffs.<sup>169</sup> The European Community's stated purposes for the *Regulation* are reflected in the preamble which highlights the following goals:<sup>170</sup>

1. Promotion of certain agricultural products to benefit rural economies by improving farmers' income and retaining rural populations;
2. To service a growing demand for quality agricultural products with an identifiable geographical origin;
3. The desire to protect agricultural geographical indications to secure higher returns for the goods;
4. To develop a standardized European Union framework to protect geographical indications;

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<sup>167</sup> European Court Reports [2011] C-482/09 [*Anheuser 2011*].

<sup>168</sup> *Supra* note 34.

<sup>169</sup> *Supra* note 58 [*The WTO Geographical Indications Dispute*] at 70.

<sup>170</sup> *Supra* note 34 at Preamble. See Appendix A.

5. To lay a foundation to expand protected products with a geographical indication; and
6. To promote trade with non-European countries that guarantee equivalent protection for geographical indications;

On June 1, 1999 the United States requested consultations with the European Communities regarding the *Regulation's* alleged lack of protection for trademarks.<sup>171</sup> This was the first challenge to a domestic geographical indication protection system alleging non-compliance with international law.<sup>172</sup> The United States and the European Communities met on July 9, 1999 but were unable to resolve the dispute.<sup>173</sup>

Australia complained about the *Regulation* on April 17<sup>th</sup>, 2003 within the World Trade Organization framework.<sup>174</sup> On August 18, 2003 the United States requested that the World Trade Organization's Dispute Settlement Body establish a panel to address the concerns regarding the *Regulation*.<sup>175</sup> As both the United States and Australia had raised concerns about the *Regulation*, the World Trade Organization combined the proceedings.<sup>176</sup> Numerous other Member States, including Canada,<sup>177</sup> reserved the right to participate as third parties to the proceedings.<sup>178</sup>

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<sup>171</sup> *Supra* note 35 [*EC-US Report*] at para 1.1.

<sup>172</sup> *Supra* note 58 [*The WTO Geographical Indications Dispute*] at 72.

<sup>173</sup> *Supra* note 35 [*EC-US Report*] at para 1.1- 1.2; The parties met again on May 27, 2003 without any resolution

<sup>174</sup> *Supra* note 35 [*EC-Australia Report*].

<sup>175</sup> *Supra* note 35 [*EC-US Report*] para 1.3.

<sup>176</sup> On October 2, 2003 the Dispute Settlement Body established a single panel to address the complaints by the United States and Australia. *Supra* note 35 [*EC-US Report*] at 1.3 referring to the request made by

The arguments by the United States and Australia focused on two areas: national treatment of World Trade Organization Members and trademark owners' rights.<sup>179</sup> This thesis focuses on the second issue concerning trademark owners' rights as it highlights the tension between trademarks and geographical indications. The American and Australian arguments regarding trademark owners' rights in the *World Trade Organization Dispute* centered on an alleged inconsistency between Article 14.2 of the *Regulation* and Article 16.1 of the *TRIPS Agreement* [trademark holders' rights].<sup>180</sup> The main objection by the United States and Australia was that the *Regulation* allowed a registered trademark to co-exist<sup>181</sup> with a geographical indication registered after the trademark.<sup>182</sup>

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the United States in document WT/DS174/20 and the request made by Australia in document WT/DS290/18.

<sup>177</sup> The comments made by Canada as a third party focused on issues other than trademark owners' rights which this thesis examines.

<sup>178</sup> *Supra* note 35 [*EC-US Report*] at para 1.6. The request to be a third party to the dispute was made by the following Member States: Argentina, Australia (in respect of the United States' complaint), Brazil, Canada, China, Colombia, Guatemala, India, Mexico, New Zealand, the Separate Customs Territory of Taiwan, Penghu, Kinmen and Matsu ("Chinese Taipei"), Turkey and the United States (in respect of Australia's complaint).

<sup>179</sup> *Supra* note 35 *World Trade Organization Dispute* summary.

<sup>180</sup> *Supra* note 58 [*The WTO Geographical Indications Dispute*] at 74.

<sup>181</sup> The World Trade Organization Panel used the term 'coexistence' in the dispute to "refer to a legal regime under which a GI [geographical indication] and a trademark can both be used concurrently to some extent even though the use of one or both of them would otherwise infringe the rights conferred by the other." See *supra* note 35 [*EC-US Report*] at para 7.514. Note that the World Trade Organization Panel Report clarified that its "use of the term does not imply any view on whether such a regime is justified." *Supra* note 35 [*EC-US Report*] at para 7.514.

<sup>182</sup> *Ibid.*

It is helpful to analyze the *Regulation's* surrounding provisions, particularly Article 13 and Article 14.3, to understand the *World Trade Organization Dispute*. Article 13<sup>183</sup> of the *Regulation* clarifies the protection available for a geographical indication registered under the *Regulation*. Paragraph 1 of Article 13 protects a registered geographical indication from misleading uses. The positive right to use the geographical indication is implicitly granted by the *Regulation*.<sup>184</sup> The result is that the positive right by a holder of a registered geographical indication trumps the right of “trademark owners to prevent the use of a sign that infringes trademarks.”<sup>185</sup>

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<sup>183</sup> The relevant portion of the *Regulation's* Article 13 is paragraph 1 which states:

1. Registered names shall be protected against:

(a) any direct or indirect commercial use of a name registered in respect of products not covered by the registration in so far as those products are comparable to the products registered under that name or insofar as using the name exploits the reputation of the protected name;

(b) any misuse, imitation or evocation, even if the true origin of the product is indicated or if the protected name is translated or accompanied by an expression such as ‘style’, ‘type’, ‘method’, ‘as produced in’, ‘imitation’ or similar;

(c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product, on the inner or outer packaging, advertising material or documents relating to the product concerned, and the packing of the product in a container liable to convey a false impression as to its origin;

(d) any other practice liable to mislead the public as to the true origin of the product. Where a registered name contains within it the name of an agricultural product or foodstuff which is considered generic, the use of that generic name on the appropriate agricultural product or foodstuff shall not be considered to be contrary to (a) or (b) in the first subparagraph.

<sup>184</sup> This is implicit in several of the *Regulation's* provisions such as “Article 4(1) which refers to eligibility to use a protected designation of origin or a protected geographical indication; Article 8, which provides that the indications PDO and PGI and equivalent national indications may appear only on agricultural products and foodstuffs that comply with the Regulation; and Article 13(1)(a) which provides protection for registered names against direct or indirect commercial use on certain conditions.” *Supra* note 35 [*EC-US Report*] at para 7.517. The United States did not contest this interpretation.

<sup>185</sup> *Supra* note 35 [*EC-US Report*] at para 7.517

Article 14 addresses the relationship between geographical indications and trademarks as per the European Community's law.<sup>186</sup> Article 14.2, the text of which is reproduced in Table 5 below, applies to *trademarks* where registration has been applied for, obtained or where the trademark has been established by use in good faith and there are no grounds for the mark's invalidity or revocation. Article 14.2 applies to *protected geographical indications and designations of origin* which are not subject to refusal on any grounds such as those outlined in Article 14.3. The application of Article 14.2 is further restricted to scenarios where use of the trademark infringes registration of the geographical indication.<sup>187</sup> The text of *Regulation* Article 14.2<sup>188</sup> and the corresponding *TRIPS Agreement* Article 16.1 states:

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<sup>186</sup> Article 14.1 addresses trademark applications submitted after a geographical indication has been registered under the Regulation. This ensures the supremacy of a registered geographical indication over an unregistered trademark. *Supra* note 35 [*EC-US Report*] at para 7.519. The text of *Regulation* Article 14.1 states:

Where a designation of origin or geographical indication is registered under this Regulation, any application for registration of a trademark that is for a product of the same type and use of which will engender one of the situations indicated in Article 13 shall be refused if made after the date of submission to the Commission of the application for registration of the designation of origin or geographical indication. Trademarks registered in breach of the first subparagraph shall be invalidated.'

<sup>187</sup> *Supra* note 35 [*EC-US Report*] at para 7.522

<sup>188</sup> The European Communities amended the *Regulation* including Article 14.2 prior to the *World Trade Organization Dispute*. The language of Article 14.2 above is therefore the amended version which the Panel examined in the *World Trade Organization Dispute*.



**Table 5: Comparison of Regulation Article 14.2 and the TRIPS Agreement Article 16.1**Article 14.2 of the *Regulation*Article 16.1 *TRIPS Agreement*

[emphasis added]

[emphasis added]

With due regard to Community law, a trademark the use of which engenders one of the situations indicated in Article 13 and **which has been applied for, registered, or established by use**, if that possibility is provided for by the legislation concerned, **in good faith** within the territory of the Community, **before either the date of protection in the country of origin or the date of submission to the Commission of the application for registration of the designation of origin or geographical indication, may continue to be used notwithstanding the registration of a designation of origin or geographical indication, provided that no grounds for its invalidity or revocation exist** as specified by Council Directive 89/104/EEC of 21 December 1998 to approximate the laws of the Member States relating to trade marks and/or Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark. [footnotes omitted]

**The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using** in the course of trade identical or similar **signs** for goods or services **which are identical or similar to** those in respect of which **the trademark** is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use.

Article 14.2 allows for concurrent use of a trademark and a geographical indication where the trademark was registered *before* the geographical indication. Paragraph 2 of Article 14 is, therefore, an exception to Article 13 because it allows for continued use of a previously registered trademark where use of that mark conflicts with rights held by holders of registered geographical indications.<sup>189</sup> The Panel noted that the paragraph is also “an express recognition that, in principle, a *GI* [geographical

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<sup>189</sup> *Supra* note 35 [EC-US Report] at para 7.521.

indication] *and a trademark can coexist* under Community law. It is intended to implement Article 24.5 of the TRIPS Agreement.”<sup>190</sup>

Article 14.2 begins with the phrase “[w]ith due regard to Community law” which references the Community Trademark Regulation and the First Trademark Directive.<sup>191</sup> The Community Trademark Regulation and the First Trademark Directive each confer rights on holders of registered trademarks “to prevent ‘all third parties’ from certain uses of ‘any sign’, including uses where there exists a likelihood of confusion.”<sup>192</sup> These provisions are in accordance with Article 16.1 of the *TRIPS Agreement*.<sup>193</sup> Article 159 of the amended Community Trademark Regulation, however, stipulates that:<sup>194</sup>

**This Regulation shall not affect Council Regulation (EEC) No. 2081/92 on the protection of geographical indications** and designations of origin for agricultural products and foodstuffs of 14 July 1992, **and in particular Article 14** thereof [emphasis added].

The European Communities’ legislation supersedes member national legislation. The result is that registered trademark holders subject to *Regulation* Article 14.2 cannot prevent use by a third party in the European Communities if the third party holds a registered geographical indication.<sup>195</sup>

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<sup>190</sup> *Ibid.*

<sup>191</sup> *Supra* note 35 [*EC-US Report*] at para 7.524.

<sup>192</sup> *Ibid.*

<sup>193</sup> *Ibid.*

<sup>194</sup> *Supra* note 35 [*EC-US Report*] at 7.525.

<sup>195</sup> *Supra* note 35 [*EC-US Report*] at para 7.527

Article 14.3 of the *Regulation* consists of conditions for registration of geographical indications.<sup>196</sup> The paragraph prevents registration of a geographical indication that is likely to mislead consumers with respect to the true identity of the good. The effect of Article 14.3 is that it may be possible for a previously registered trademark to prevent the registration of a geographical indication in some circumstances.<sup>197</sup>

### ***Arguments by the Parties***

The United States argued that the “Regulation is inconsistent with Article 16.1 of the TRIPS Agreement because it does not ensure that a trademark owner may prevent uses of GIs [geographical indications] which would result in a likelihood of confusion with a prior trademark.”<sup>198</sup> The United States therefore challenged coexistence between trademarks and geographical indications under the *Regulation*. Australia made a similar argument.<sup>199</sup>

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<sup>196</sup> Article 14.3 of the *Regulation* states:

A designation of origin or geographical indication shall not be registered where, in the light of a trade mark's reputation and renown and the length of time it has been used, registration is liable to mislead the consumer as to the true identity of the product.

<sup>197</sup> *Supra* note 35 [*EC-US Report*] at para 7.530

<sup>198</sup> *Supra* note 35 [*EC-US Report*] at para 7.512. Its claim only concerns valid prior trademarks, not trademarks liable to invalidation because they lack distinctiveness or mislead consumers as to the origin of goods.

<sup>199</sup> *Supra* note 35 [*EC-Australia Report*] at para 7.516 which states:

Australia claims that the Regulation is inconsistent with Article 16.1 of the TRIPS Agreement because it denies the owner of a registered trademark the exclusive right to prevent uses of GIs which would result in a likelihood of confusion with a prior

The European Communities refuted the argument for the following reasons:<sup>200</sup>

- (1) Article 14.3 of the Regulation, in fact, prevents the registration of GIs [geographical indications], use of which would result in a likelihood of confusion with a prior trademark;
- (2) Article 24.5 of the TRIPS Agreement provides for the "coexistence" of GIs [geographical indications] and prior trademarks;
- (3) Article 24.3 of the TRIPS Agreement requires the European Communities to maintain "coexistence"; and
- (4) [I]n any event, Article 14.2 of the Regulation would be justified as a limited exception under Article 17 of the TRIPS Agreement.

The thesis examines the arguments by the United States and the European Communities as well as the Panel's findings. The arguments made by Australia reflect the arguments made by the United States.<sup>201</sup> For ease of reference and due to the similarity of the positions between the United States and Australia, the thesis discusses the *World Trade Organization Dispute* as between the United States and the European Communities.

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trademark. Its claim does not concern conflicts involving the future acquisition of trademark rights and GIs.

<sup>200</sup> *Supra* note 35 [EC-US Report] at para 7.513. The European Communities made the same argument at para 7.517 in *supra* note 35 [EC-Australia Report].

<sup>201</sup> For the discussion of Australia's and the European Communities arguments as well as the Panel's findings, see *supra* note 35 [EC-Australia Report] at paras 7.536 – 7.686. Australia made three additional arguments with respect to the *Regulation*, none of which were successful. The additional arguments included: (1) that *Regulation* Article 14.2 "is inconsistent with Article 16.1 of the TRIPS Agreement because it does not "provide for" or "implement" the presumption of a likelihood of confusion in the case of use of an identical sign for identical goods." [para 7.687]; (2) "the Regulation is inconsistent with Article 16.1 of the TRIPS Agreement because it does not ensure that objections to registration are admissible on the grounds that use of the GI would result in a likelihood of confusion." [para 7.694]; and (3) "the Regulation is inconsistent with Article 16.1 of the TRIPS Agreement because it does not ensure that an objection by the owner of a registered trademark will be considered by the "ultimate decision maker", being the regulatory committee of EC member States." [para 7.702]

***Issue #1: Regulation Article 14.3 Prevents Registration of a Geographical Indication Likely to be Confusing with a Prior Trademark***

The United States submitted that Article 14.3 of the *Regulation* “is the sole provision in the Regulation that addresses the confusing use of registered GIs [geographical indications] vis-à-vis trademarks and Article 14.3 does not satisfy the obligations under Article 16.1 of the TRIPS Agreement.”<sup>202</sup> TRIPS Article 16.1<sup>203</sup> provides a right to all registered trademark holders to **prevent use** by third parties of the same or similar mark on identical or similar goods. Article 14.3 of the *Regulation* is in conflict with the TRIPS provision because owners of registered trademarks “cannot necessarily tell, at the time of registration of the GI [geographical indication], whether its subsequent use will be confusing”<sup>204</sup> and therefore cannot prevent use of the mark by third parties. This is because the use of geographical indications is not always limited by product specifications making the protected use unclear.<sup>205</sup> The United States also alleged that *Regulation* Article 14.3 “does not provide a right to the ‘owner of a trademark’, as required by Article 16.1, but merely authorizes the EC [European Community] authorities to decline registration of a GI [geographical indication] in

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<sup>202</sup> *Supra* note 35 [EC-US Report] at para 7.534

<sup>203</sup> *Supra* note 1 at Article 16.1 states:

**The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner’s consent from using** in the course of trade **identical or similar signs for goods or services which are identical or similar** to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use [emphasis added].

<sup>204</sup> *Supra* note 35 [EC-US Report] at para 7.536.

<sup>205</sup> *Ibid.*

limited circumstances.”<sup>206</sup> The United States stressed the private nature of intellectual property rights and that it is beyond the power of government authorities to make decisions on behalf of trademark owners.<sup>207</sup>

The United States also noted that it is possible to register a geographical indication in a manner which precludes *Regulation* Article 14.3 objections. This occurred in the Budweiser case. The Czech corporation, Budvar, registered three geographical indications<sup>208</sup> “through an accession treaty [with the European Community], in a manner that precludes objections [from the American producer and trademark holder of ‘Budweiser’ Anheuser-Busch] based on Article 14.3 or any other provision.”<sup>209</sup>

The European Communities argued that *Regulation* Article 14.3 “is sufficient to prevent the registration of any confusing GIs [geographical indications].”<sup>210</sup> The European Communities refuted the alleged incompatibility between *Regulation* Article 14.3 and *TRIPS* Article 16.1 because “the risk of registration of a GI [geographical indication] confusingly similar to a prior trademark is very limited due to the criteria for

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<sup>206</sup> *Ibid.*

<sup>207</sup> *Ibid.*

<sup>208</sup> *Supra* note 35 [*EC-US Report*] at para 7.573 “Budejovické pivo”, “Ceskobudejovické pivo” and “Budejovický mešt’anský var”

<sup>209</sup> *Supra* note 35 [*EC-US Report*] at para 7.536.

<sup>210</sup> *Supra* note 35 [*EC-US Report*] at para 7.540.

registrability of trademarks applied under EC [European Community] law.”<sup>211</sup> The European Communities noted that “the complainants have not identified an example of a GI *which gives rise to a likelihood of confusion with an earlier trademark* [emphasis added].”<sup>212</sup> Article 14.3 of the *Regulation* had been used once although the European Community Council found that the geographical indication at issue would not mislead the public if allowed to coexist with the two previously registered trademarks.<sup>213</sup> The European Communities, however, did not deny the possibility that the geographical indication in that instance *could* be used in a manner to mislead the public.<sup>214</sup>

With respect to the ‘Budweiser’ geographical indications, the European Communities commented that the indications “contain a unique endorsement that they apply ‘without prejudice to any beer trademark or other rights existing in the European Union on the date of accession.’”<sup>215</sup> The European Communities “did not deny that

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<sup>211</sup> *Supra* note 35 [EC-US Report] at para 7.540. The European Communities argued this is because “[g]eographical names are primarily non-distinctive and, as such, are not apt for registration as trademarks. [...] Under EC law, they [geographical names] may only be registered as a trademark where the geographical name is not currently associated, and it can reasonably be assumed that it will not be associated in the future, with the product concerned; or where the name has acquired distinctiveness through use.” *Supra* note 35 [EC-US Report] at para 7.541.

<sup>212</sup> *Supra* note 35 [EC-US Report] at para 7.540.

<sup>213</sup> *Supra* note 35 [EC-US Report] at para 7.571. This was the case of the geographical indication, ‘Bayerisches Bier’, registered in 2001 with the proviso that the continued use of the previously registered trademarks, ‘BAVARIA’ and ‘HØKER BAJER’, was permitted under Article 14.2. The European Council allowed the registration of the geographical indication because it determined that it would not mislead the public as per Article 14.3 of the *Regulation*.

<sup>214</sup> *Supra* note 35 [EC-US Report] at para 7.572. The European Communities submitted that while this is possible in theory, in practice “this may happen only when the registered name is used together with other signs or as part of a combination of signs.”

<sup>215</sup> *Supra* note 35 [EC-US Report] at para 7.540.

these GIs ["Budejovické pivo", "Ceskobudejovické pivo" and "Budejovický mešt'anský var"] could be used in a manner that would result in a likelihood of confusion with these prior trademarks ['BUDWEISER' and 'BUD'].<sup>216</sup>

The Panel found that the United States "made a prima facie case that Article 14.3 of the Regulation cannot prevent all situations from occurring in which Article 14.2 would, in fact, limit the rights of a trademark owner."<sup>217</sup> The Panel found that there was a lack of evidence to demonstrate that "it is possible to seek invalidation of a GI [geographical indication] registration under Article 14.3 in *all* cases in which use of a GI would otherwise be found to infringe a prior trademark."<sup>218</sup> The Panel observed that

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<sup>216</sup> *Supra* note 35 [EC-US Report] at para 7.573.

<sup>217</sup> *Supra* note 35 [EC-US Report] at para 7.562. This was based on three observations by the Panel:

- 1) Article 14.3 of the *Regulation* "requires GI registration to be refused where it would be 'liable to mislead the consumer as to the true identity of the product'. This is limited to liability to mislead as to a single issue, and not with respect to anything else." [para 7.559]
- 2) Article 14.3 of the *Regulation* "specifically prohibits GI registration 'in light of a trade mark's reputation and renown and the length of time it has been used'. [...] [These factors] indicate that the scope of Article 14.3 is limited to a subset of trademarks which, as a minimum, excludes trademarks with no reputation, renown or use." [para 7.560]
- 3) Article 14.3 of the *Regulation* "does not refer to use (of the GI) or to likelihood or to confusion, when other provisions of the Regulation do. [...] This indicates that the standard in Article 14.3 that registration would 'mislead the consumer as to the true identity of the product' is intended to apply in a narrower set of circumstances than the trademark owner's right to prevent use that would result in a likelihood of confusion." [para 7.561]

<sup>218</sup> *Supra* note 35 [EC-US Report] at para 7.567. The Panel noted "an inconsistency between the European Communities' position that Article 14.3 of the Regulation, in practice, prevents the registration of GIs, use of which would result in a likelihood of confusion with a prior trademark, and its decision to avoid contesting that there may be circumstances in which the four specific GIs referred to above could be used which would not result in a likelihood of confusion with these specific prior trademarks." *Supra* note 35 [EC-US Report] at para 7.574.



“what the United States regards as ‘trademark-like use’ is, in the European Communities, considered perfectly legitimate use as a GI [geographical indication].”<sup>219</sup>

***Issue #2: Coexistence of Geographical Indications and Prior Trademarks under TRIPS Article 24.5***

The issue in this section was whether *TRIPS* Article 24.5 constituted a justified limitation on the right of exclusive use afforded to trademark owners under *TRIPS* Article 16.1.<sup>220</sup> The United States argued that any compromises or exceptions to trademark rights are explicit in the *TRIPS Agreement*.<sup>221</sup> To support this line of reasoning, the United States pointed to *TRIPS* Article 23.3, *Additional Protection for Geographical Indications for Wines and Spirits*. *TRIPS* Article 23.3 carves out explicit additional protection for wines and spirits. The *TRIPS Agreement* lacks a similar exception for “simultaneous use of a geographical indication and a prior trademark where use of the geographical indication would be inconsistent with the rights under

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<sup>219</sup> *Supra* note 35 [*EC-US Report*] at para 7.567.

<sup>220</sup> *Ibid.* *TRIPS* Article 24.5 states [emphasis added]:

**Where a trademark has been applied for or registered in good faith**, or where rights to a trademark have been acquired through use in good faith either:

(a) before the date of application of these provisions in that Member as defined in Part VI; or

(b) before the geographical indication is protected in its country of origin;

**measures adopted to implement this Section shall not prejudice eligibility for or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication.**

<sup>221</sup> *Supra* note 35 [*EC-US Report*] at para 7.578. An example is *TRIPS* Article 23.3 which recognizes geographical indication protection for wines and spirits.

Article 16.1.”<sup>222</sup> The United States also argued that the term ‘validity of registration’ in Article 24.5 should be interpreted in connection with Article 16.1 as “all the rights which flow from registration, including the right to prevent uses that would result in a likelihood of confusion.”<sup>223</sup> The language of *TRIPS* Article 16.1 demonstrates that the right of a trademark owner to prevent use is a right which is exclusive, “valid against all third parties and cover identical or similar signs, including GIs [geographical indications].”<sup>224</sup> The United States emphasized that the power of trademark registration is linked with the exclusive right of use outlined in *TRIPS* Article 16.1.<sup>225</sup> The United States also noted that both the European Court of Justice and the United States Supreme Court have recognized exclusivity of use as “the core of a trademark right”.<sup>226</sup>

The European Communities’ position was that “the *TRIPS* Agreement recognizes trademarks and GIs [geographical indications] as intellectual property rights on the same level, and confers no superiority to trademarks over GIs.”<sup>227</sup> The European Communities also argued that “coexistence may not be a perfect solution to resolve

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<sup>222</sup> *Supra* note 35 [EC-US Report] at para 7.578.

<sup>223</sup> *Supra* note 35 [EC-US Report] at para 7.616.

<sup>224</sup> *Supra* note 35 [EC-US Report] at para 7.577.

<sup>225</sup> *Supra* note 35 [EC-US Report] at para 7.579.

<sup>226</sup> *Supra* note 35 [EC-US Report] at para 7.580.

<sup>227</sup> *Supra* note 35 [EC-US Report] at para 7.583.

conflicts between different types of intellectual property rights but there is no perfect solution.”<sup>228</sup>

In response to the United States’ argument that exclusivity rights are central to trademark law, the European Communities suggested that “exclusivity is as essential to a GI [geographical indication] or even more essential, because the choice of a GI is not arbitrary, unlike a trademark, and the establishment of a GI takes longer than a trademark.”<sup>229</sup> Regarding *TRIPS* Article 24.5, the European Communities focused on the article’s language at the end of the section that states “**measures adopted** to implement this Section **shall not prejudice** eligibility for or **the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with**, or similar to, **a geographical indication** [emphasis added].” The European Communities argued that the provision should be interpreted to allow World Trade Organization Members to prejudice trademark owner rights other than the validity of the registration.<sup>230</sup> This would include “in particular the right to prevent others from using the sign of which the trademark consists.”<sup>231</sup>

The Panel found that *TRIPS* Article 16.1 requires Members “to make available to trademark owners a right against certain uses, including uses as a GI [geographical

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<sup>228</sup> *Supra* note 35 [EC-US Report] at para 7.587.

<sup>229</sup> *Supra* note 35 [EC-US Report] at para 7.589.

<sup>230</sup> *Supra* note 35 [EC-US Report] at para 7.584. This was the relevant portion of the European Communities’ argument with respect to Article 24.5 but not the entire argument.

<sup>231</sup> *Supra* note 35 [EC-US Report] at para 7.584.

indication].”<sup>232</sup> The Panel held that the *Regulation* limited this right for trademark owners subject to Article 14.2.<sup>233</sup> The Panel also found that *TRIPS* Article 24.5 “is inapplicable and does not provide authority to limit that right [found in *TRIPS* Article 16.1 allowing trademark owners to prevent use of the mark by geographical indications].”<sup>234</sup>

***Issue #3: Article 24.3 of the TRIPS Agreement requires the European Communities to maintain “coexistence”***

The United States submitted that *TRIPS* Article 24.3<sup>235</sup> “is an exception with respect to the implementation of the GI [geographical indication] Section of the [TRIPS] Agreement and does not impose any exception to the obligation to provide trademark rights under Article 16.1.”<sup>236</sup> The European Communities responded that the language of *TRIPS* Article 24.3 requires coexistence between earlier registered trademarks and geographical indications.<sup>237</sup> Article 14.2 of the *Regulation* provided for coexistence “immediately prior to the entry into force of the World Trade Organization Agreement. If the European Communities allowed the owners of prior registered trademarks to

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<sup>232</sup> *Supra* note 35 [*EC-US Report*] at para 7.625.

<sup>233</sup> *Ibid.*

<sup>234</sup> *Ibid.*

<sup>235</sup> *Supra* note 1 Article 24.3 states [emphasis added]:

In implementing this Section, a **Member shall not diminish the protection of geographical indications that existed** in that Member immediately prior to the **date of entry into force of the WTO Agreement.**

<sup>236</sup> *Supra* note 35 [*EC-US Report*] at para 7.627.

<sup>237</sup> *Supra* note 35 [*EC-US Report*] at para 7.628.

prevent the use of later GIs [geographical indications], this would diminish the protection of GIs contrary to Article 24.3.”<sup>238</sup>

The Panel interpreted the phrase “the protection of geographical indications that existed in that Member immediately prior to the date of entry into force of the World Trade Organization Agreement” in *TRIPS* Article 24.3 as “the state of protection of GIs [geographical indications] immediately prior to 1 January 1995, in terms of the individual GIs which were protected at that point in time.”<sup>239</sup> Because all parties involved agree that before January 1, 1995 no geographical indications were registered under the *Regulation*, *TRIPS* Article 24.3 is inapplicable.

***Issue #4: Regulation Article 14.2 as a Limited Exception under TRIPS Article 17***

The European Communities argued that the Panel should analyze the *Regulation*’s “regime of coexistence ‘as such’ and not as applied.”<sup>240</sup> The European Communities’ position was that *Regulation* Article 14.2 is a ‘limited exception’ contemplated by *TRIPS* Article 17. This is because Article 14.2:<sup>241</sup>

**only allows use by those producers who are established in the geographical area on products that comply with the specification. The trademark owner retains the exclusive right to prevent use by any other persons. Coexistence falls within the example of ‘fair use of descriptive terms’ because GIs are descriptive terms, even where they consist of a non-geographical name, and their use to indicate the true origin of goods and the characteristic associated with that origin is ‘fair’ [emphasis added].**

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<sup>238</sup> *Ibid.*

<sup>239</sup> *Supra* note 35 [*EC-US Report*] at para 7.636.

<sup>240</sup> *Supra* note 35 [*EC-US Report*] at para 7.644.

<sup>241</sup> *Supra* note 35 [*EC-US Report*] at para 7.640.

*TRIPS Agreement* Article 17 considers the interests of trademark owners and those of third parties.<sup>242</sup> The European Communities argued that trademark owners' interests would be protected by *Regulation* Article 14.3. This is because *Regulation* Article 14.3 prohibits the registration of geographical indications where registration is "liable to mislead the consumer as to the true identity of the product."<sup>243</sup> The European Communities argued that "legitimate interests of the owner of trademark" contemplated by *TRIPS* Article 17 should be interpreted to mean "less than full enjoyment of all exclusive rights under Article 16.1 of the TRIPS Agreement."<sup>244</sup> The European Communities' perspective on the interests of third parties is that 'third parties' includes users of geographical indications and consumers.<sup>245</sup>

The United States refuted the European Communities' reasoning that *Regulation* Article 14.2 is a limited exception on trademark owners' rights under *TRIPS* Article 17 because "there is no limit on the number of potential users of a registered GI [geographical indication]."<sup>246</sup> According to the United States, the third party interests should include trademark licensees and consumers.<sup>247</sup> The United States suggested that

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<sup>242</sup> *Supra* note 1 Article 17:

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

<sup>243</sup> *Supra* note 34.

<sup>244</sup> *Supra* note 35 [*EC-US Report*] at para 7.641.

<sup>245</sup> *Ibid.*

<sup>246</sup> *Supra* note 35 [*EC-US Report*] at para 7.638.

<sup>247</sup> *Ibid.*

the phrase in *TRIPS* Article 17 ‘legitimate interests of the owner of the trademark’ include the trademark’s economic value.<sup>248</sup> The *Regulation* does not limit the use of a geographical indication that could “destroy the economic value of the trademark.”<sup>249</sup>

The Panel examined the phrase ‘limited exceptions’ in *TRIPS* Article 17 and noted that the only right at issue in the dispute is the trademark owners’ right to prevent certain uses under Article 16.1. The Panel found that the scope of *Regulation* Article 14.2 qualified as a ‘limited exception’ under *TRIPS* Article 17.<sup>250</sup> This is because the owner of the trademark may continue to use the mark and prevent confusing uses “except with respect to the use of a GI as entered in the GI register in accordance with its registration.”<sup>251</sup> With respect to the legitimate interests of the trademark owners under *TRIPS* Article 17, the Panel confirmed that from the more than 600 geographical indications registered under the *Regulation* over eight years, the complainants were able to identify only four instances that would result in a likelihood of confusion.<sup>252</sup> The Czech Budvar beer geographical indications comprise three of the four geographical indications at issue.<sup>253</sup> The Czech geographical indications registration restricts their use to apply ‘without prejudice to any beer trademark or other rights existing in the

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<sup>248</sup> *Supra* note 35 [*EC-US Report*] at para 7.639.

<sup>249</sup> *Ibid.*

<sup>250</sup> *Supra* note 35 [*EC-US Report*] at para 7.661.

<sup>251</sup> *Supra* note 35 [*EC-US Report*] at para 7.659.

<sup>252</sup> *Supra* note 35 [*EC-US Report*] at para 7.674.

<sup>253</sup> *Ibid.*

European Union on the date of accession.<sup>254</sup> The fourth instance is the mark ‘Bayerisches Bier’;<sup>255</sup> the complainants were unable to demonstrate an actual likelihood of confusion with a trademark in that case.<sup>256</sup>

Regarding the issue of third party interests outlined in *TRIPS* Article 17, the Panel agreed with the European Communities that ‘third party’ includes users of a geographical indication in accordance with its registration.<sup>257</sup> The Panel disagreed with the United States that ‘third party interests’ should include trademark licensees.<sup>258</sup> The Panel also interpreted the word ‘legitimate’ in connection with third parties in *TRIPS* Article 17. The Panel found that the third party interests are ‘legitimate’ under the *Regulation* because the *Regulation* has several conditions<sup>259</sup> with respect to the term ‘geographical indication’.<sup>260</sup> The Panel therefore found that the exception to trademark owners’ rights under the *Regulation* is inconsistent with *TRIPS* Article 16.1 but is justified under *TRIPS* Article 17.<sup>261</sup>

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<sup>254</sup> *Supra* note 35 [*EC-US Report*] at para 7.669.

<sup>255</sup> *Supra* note 213.

<sup>256</sup> *Supra* note 35 [*EC-US Report*] at para 7.674.

<sup>257</sup> *Supra* note 35 [*EC-US Report*] at para 7.681.

<sup>258</sup> *Supra* note 35 [*EC-US Report*] at para 7.680.

<sup>259</sup> The *Regulation* conditions the Panel referenced include the fact that the *Regulation* restricts the application of ‘geographical indication’ to a defined term in Article 2.2, there are additional conditions with respect to product quality, reputation and origin as well as labelling and misleading advertising directives.

<sup>260</sup> *Supra* note 35 [*EC-US Report*] at para 7.684.

<sup>261</sup> *Supra* note 35 [*EC-US Report*] at para 7.688.



### ***Interpretation of the World Trade Organization Dispute Outcome***

When the Panel released its report, the United States, Australia and the European Communities all claimed partial victory in the result and none of the parties appealed.<sup>262</sup> The United States and Australia ‘succeeded’ because the European Community’s implementation of the policy was held to have violated the *TRIPS Agreement*.<sup>263</sup> The Europeans ‘succeeded’ because the Panel endorsed the principle of ‘coexistence’ between trademarks and geographical indications in Article 14.2 of the *Regulation*.<sup>264</sup>

### ***Budweiser UK Litigation***

The Panel in the *World Trade Organization Dispute* above held that trademarks and geographical indications can coexist under the *TRIPS Agreement*. The *World Trade Organization Dispute* also illustrated conflict between these rights on a theoretical level.

As discussed in Chapter 1, the worldwide litigation between the American corporation, Anheuser-Busch, and the Czech company, Budejovicky Budvar [Budvar], over the term ‘BUDWEISER’ provides a concrete example of conflict on this issue. Anheuser-Busch and Budvar have been grappling for market share in multiple

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<sup>262</sup> Dispute Settlement: dispute DS174 European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs, World Trade Organization; online: <[http://www.wto.org/english/tratop\\_e/dispu\\_e/cases\\_e/ds174\\_e.htm](http://www.wto.org/english/tratop_e/dispu_e/cases_e/ds174_e.htm)>

<sup>263</sup> *Infra* note 264. In addition to the Panel finding that Article 14.2 of the *Regulation* violated *TRIPS* Article 16.1, the Panel decision forced the European Communities to significantly change the policy regarding the registration of foreign products and the Panel’s decision opened the European geographical indications regime to non-European countries.

<sup>264</sup> Johann Robert Basedow & Davide Bonvicini, “The EU-US trade dispute on Geographical Indications. Two scorpions in a bottle?” (Paper presented to the WTO Seminar, delivered at the Graduate Institute of International and Development Studies Programme, 8 May 2009) [unpublished] at 17 footnote 73.

jurisdictions where each party claims rights to the word identifying their product. The claims by Anheuser-Busch stem from trademark registration rights while Budvar's claims to 'Budweiser' are generally linked to geographical indication rights. In the United Kingdom, Budvar holds several non-trademark registrations with respect to 'Budweiser'.<sup>265</sup> However, Budvar also owns registered trademarks with disclaimers.<sup>266</sup> Until 1994,<sup>267</sup> the United Kingdom lacked "any tailor-made legislative framework for their [geographical indications] protection with no general law of unfair competition and possess[ed] few native geographical indications of major economic significance."<sup>268</sup> Not

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<sup>265</sup> *Supra* note 28 *Anheuser 2000* at 2. In 1967 Budvar registered 'BUDWEISER BIER' and 'BUDWEIS BEER' as appellations of origin with the United International Bureau for the Protection of Intellectual Property, the agency now known as the World Intellectual Property Organization [WIPO].

WIPO defines an 'appellation of origin' as:

A special kind of geographical indication. It generally consists of a geographical name or a traditional designation used on products which have a specific quality or characteristics that are essentially due to the geographical environment in which they are produced. The concept of a geographical indication encompasses appellations of origin.

<sup>266</sup> *Supra* note 28 *Anheuser 2000* at 2. In 1962 Budvar registered the trademark 'BUDWEISER BUDBRU' in the United Kingdom but disclaimed "any exclusivity in the use of the word 'BUDWEISER'. In 1971 Budvar registered 'BUDWEISER BUDVAR' as a trademark in the United Kingdom with the same disclaimer as the 1962 'BUDWEISER BUDBRU' mark. In 1976 Budvar filed for registration of 'BUD' in the United Kingdom. See *Bud Trade Mark*, [1988] R.P.C. 535.

<sup>267</sup> In 1994 the United Kingdom's *Trade Marks Act 1994* entered into force.

<sup>268</sup> Norma Dawson, "Locating Geographical Indications--Perspectives from English Law" (2000) 90 *Trademark Rep.* at 593. However at 598 Dawson also references the United Kingdom's *Trade Marks Act 1905* which she claims permitted

registration of geographical and other descriptive words upon proof of distinctiveness. In most cases this would be established by evidence of secondary meaning acquired through use but the registration of fanciful or arbitrary geographical names which would cause other traders no inconvenience also was permitted because there was no legitimate business reason for using such names in relation to their products.

only did the United Kingdom lack a formal protection mechanism for geographical indications prior to 1994, English law was described as a “hostile environment for the legal protection of geographical indications to flourish.”<sup>269</sup> Despite the scarce direct legal acknowledgement of geographical indications prior to the implementation of the *TRIPS Agreement*, the English High Court in a judgment arising before 1994 stated in 1997 that “the law has advanced in effect to give rise to a civilly enforceable right similar to an *appellation contrôlée* [appellation of origin<sup>270</sup>].”<sup>271</sup> The exception for ‘concurrent honest use’ by competing corporations for identical marks in section 12(2) of the British *Trade Marks Act 1938*<sup>272</sup> reflects the High Court’s unofficial acknowledgment of appellations of origin as well as the common law protection for passing off.<sup>273</sup>

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The United Kingdom was not the only country which is also now part of the European Union to lack protection for geographical indications prior to the *TRIPS Agreement*. The Scandinavian countries also did not protect geographical indications before implementing the *TRIPS Agreement*. Other European countries such as France, Portugal, Greece and Italy have well-developed geographical indication protection. See *supra* note 13 at footnote 243.

<sup>269</sup> *Supra* note 268 at 593 referencing English law prior to 1994.

<sup>270</sup> *Supra* note 77 for a discussion of appellations of origin.

<sup>271</sup> *Chocosuisse Union des Fabricants Suisses de Chocolat v. Cadbury Ltd.*, [19981] RPC 117, 127 (Laddie, J. (High Ct)).

<sup>272</sup> Repealed 31.10.1994.

<sup>273</sup> Prior to the implementation of the *TRIPS Agreement*, English law protected known geographical indications under passing off actions as a means by which one could “prevent deception as to origin and unfair competition, in recognition of their [the geographical indications’] ability to develop a reputation.” See *supra* note 268 at 610.

Budvar's Budweiser bottle in the United Kingdom includes two registered geographical indication, registered recently under the *Regulation* discussed above.<sup>274</sup>

Budvar also had earlier registered three appellations of origin under the *Lisbon Agreement* in 1967.<sup>275</sup> The United Kingdom has not signed the *Lisbon Agreement* and therefore would not have recognized Budvar's appellation of origin registrations but the United Kingdom does recognize geographical indication registrations since 1990 as the United Kingdom is now a member of the European Union and is a member of the World Trade Organization and, because of the latter, the *TRIPS Agreement* applies.<sup>276</sup>

Although the litigation between Anheuser-Busch and Budvar in the United Kingdom has focused on trademark disputes, with the exception of the first action which was a case of passing off, analyzing the Budweiser disputes are nevertheless relevant for this thesis. The British courts have consistently upheld coexistence with

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<sup>274</sup> Budvar registered two geographical indications within the European Union. The first is 'Budějovické pivo' and the second is 'Budějovický měšt'anský var', both of which were registered on September 23, 2003. See European Commission: Agriculture and Rural Development DOOR online: [http://ec.europa.eu/agriculture/quality/door/list.html;jsessionid=pL0hLqLXhNmFQyFl1b24mY3t9dJQPflg3xbL2YphGT4k6zdWn34!-370879141?&recordStart=0&filter.dossierNumber=&filter.comboName=&filterMin.milestone\\_\\_mask=&filterMin.milestone=&filterMax.milestone\\_\\_mask=&filterMax.milestone=&filter.country=CZ&filter.category=PDOPGI\\_CLASS\\_21&filter.type=&filter.status=>](http://ec.europa.eu/agriculture/quality/door/list.html;jsessionid=pL0hLqLXhNmFQyFl1b24mY3t9dJQPflg3xbL2YphGT4k6zdWn34!-370879141?&recordStart=0&filter.dossierNumber=&filter.comboName=&filterMin.milestone__mask=&filterMin.milestone=&filterMax.milestone__mask=&filterMax.milestone=&filter.country=CZ&filter.category=PDOPGI_CLASS_21&filter.type=&filter.status=>).

<sup>275</sup> *Supra* note 99. The appellations of origin registered include: 1) 'ČESKOBUDĚJOVICKÉ PIVO / BUDWEISER BIER / BIÈRE DE ČESKÉ BUDĚJOVICE / BUDWEIS BEER' registered on November 22, 1967, 2) 'BUDĚJOVICKÉ PIVO - BUDVAR / BUDWEISER BIER - BUDVAR / BIÈRE DE BUDWEIS - BUDVAR / BUDWEIS BEER – BUDVAR' registered on November 22, 1967, and 3) 'BUDĚJOVICKÝ BUDVAR / BUDWEISER BUDVAR' registered on November 22, 1967. See the World Intellectual Property Organization *Lisbon: The International System of Appellations of Origin* online at: <<http://www.wipo.int/cgi-lis/guest/irange5?ENG+17-00+41346902+79+F-ENG+256>>.

<sup>276</sup> Geographical indications in the United Kingdom are enforced by the national Minister of Agriculture, Fisheries and Food, the Secretary of State for Health and the Secretary of State for Wales under the *Spirit Drinks Regulations 1990 No. 1179* which entered into force on June 29<sup>th</sup>, 1990.

respect to the right to use the term 'Budweiser' by competitors for the same product category. The United Kingdom serves as an example of coexistence on a broader scale by illustrating tension one would find between an overlapping trademark and geographical indication.

### ***The 1979 Passing Off Action***<sup>277</sup>

On August 1<sup>st</sup>, 1979 Anheuser-Busch commenced a passing off action against Budvar and Budvar counterclaimed.<sup>278</sup> Whitford J. dismissed both claims and held that both parties were allowed to "use the name Budweiser since in 1979 there was a dual reputation and neither had achieved the reputation improperly and neither was making a misrepresentation."<sup>279</sup> Whitford J. acknowledged that confusion may arise but justified it on the basis of the *Trade Marks Act 1938*<sup>280</sup> s.12(2)<sup>281</sup> which created an

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<sup>277</sup> *Anheuser-Busch Inc v Budejovicky Budvar NP (t/a Budweiser Budvar Brewery)* [1984] FSR 413 [*Anheuser 1984*].

<sup>278</sup> *Supra* note 28 at 2. The purpose of the passing off action was to prevent Budvar from selling beer under the name 'BUDWEISER' or 'BUD'.

<sup>279</sup> *Ibid.*

<sup>280</sup> C.22 (repealed 31.10.1994) [*1938 Act*].

<sup>281</sup> *Ibid* section 12:

12(1) Subject to the provisions of subsection (2) of this section, **no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor** and already on the register in respect of the same goods or description of goods, **or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion.**

**(2) In case[s] of honest concurrent use, or of other special circumstances** which in the opinion of the Court or of the Registrar make it proper so to do, **the Court or the Registrar may permit the registration of trade marks that are identical** or nearly resemble each other in respect of the same goods or description of goods by more than one proprietor subject to such conditions

opportunity for ‘concurrent honest use’ by competitors for identical marks. He stated that “[p]arliament had recognized that circumstances might arise in which two different persons ought to be entitled to use one and the same mark in respect of the same goods.”<sup>282</sup> The judge also held that ‘BUD’ was the “inevitable abbreviation of the name Budweiser.”<sup>283</sup> Anheuser-Busch appealed but the Court of Appeal dismissed the case.<sup>284</sup> The result was that both parties could claim entitlement to the use of ‘BUDWEISER’ in the United Kingdom.<sup>285</sup>

### ***The Contemporaneous Bud Trademark Action***<sup>286</sup>

In 1976, Budvar applied to register the mark ‘BUD’ for use in association with beer, ale, porter and malt beverages.<sup>287</sup> The mark was advertised in October of 1978 with a disclaimer that “the mark be used only in relation to beers brewed in Budweis, Czechoslovakia.”<sup>288</sup> Anheuser-Busch opposed the application.<sup>289</sup> The relevant ground for

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and limitations, if any, as the Court or the Registrar, as the case may be, may think it right to impose [emphasis added].

<sup>282</sup> *Supra* note 28 [Anheuser 2000] at 2.

<sup>283</sup> *Ibid.*

<sup>284</sup> *Supra* note 277 [Anheuser 1984] 457. Regarding evidence of confusion, the Court of Appeal held that the relevant time period to consider was when BB “first entered the English market in a not negligible way in 1973-4 by which time AB [Anheuser-Busch] had a reputation with a substantial number of people in this country [...]” The court also stated that as Anheuser-Busch did not sell to the general public and “no business in England by then.” *Supra* note 28 [Anheuser 2000] at 3.

<sup>285</sup> *Supra* note 28 [Anheuser 2000] at 3.

<sup>286</sup> Bud Trade Mark, Trade Marks Registry Chancery Division [1988] R.P.C. 535 [Bud Trade Mark 1988].

<sup>287</sup> *Supra* note 286 [Bud Trade Mark 1988] at 2; the associated goods refers to class 32. See *infra* note 295 and corresponding text for a discussion of Class 32 goods.

<sup>288</sup> *Ibid.*

opposition for the purpose of this case study is the first, in which Anheuser-Busch argued that acceptance of the mark's registration would cause confusion thereby offending s.11 of the 1938 Act. Section 11 states:

**It shall not be lawful to register as a trade mark** or part of a trade mark **any matter** the use of **which would**, by reason of its **being likely to deceive or cause confusion** or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design [emphasis added].

The Assistant Registrar, Mr. Myall, held that section 11 did not apply because the evidence demonstrated "confusion on the part of only a few people, and then mostly confusion between the opposed parties' BUDWEISER marks, not their BUD marks."<sup>290</sup>

Walton J agreed on appeal<sup>291</sup> when he stated:<sup>292</sup>

**[w]hat would be the equity in refusing a person registration of a contraction of his proper trade mark**, which cannot be complained of at all, which his customers are invariably, as the evidence runs, going to use. Of course precisely and exactly the same applies to AB [Anheuser-Busch] Budweiser and the use by their customers of BUD, but **I cannot think that if the substantive mark of 'Budweiser' in both cases can be fairly used, there can be any question of a court of equity at any time saying: 'But you cannot possibly use the way in which your customers are going to describe it.'** The one must, as a matter of equity and justice carry the other [emphasis added].

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<sup>289</sup> *Ibid.* There were three grounds of opposition but for the purposes of this analysis only the first ground is relevant.

<sup>290</sup> *Ibid* at 7.

<sup>291</sup> *Ibid.*

<sup>292</sup> *Ibid.*

Walton J. agreed with Mr. Myall’s decision that the mark was registerable because of the section 12(2) override as this was a case of “honest concurrent use” and qualified as “special circumstances”.<sup>293</sup>

***BUDWEISER Trademark Action in the late 1980’s***

Budvar and Anheuser-Busch commenced another round of litigation in the United Kingdom in the late 1980’s, this time with respect to registering the trademark ‘BUDWEISER’. Anheuser-Busch applied to register three ‘BUDWEISER’ marks and Budvar applied for one registration. Table 6 outlines the trademark applications:<sup>294</sup>

***Table 6: United Kingdom Trademark Applications for ‘BUDWEISER’***

<b>Date of Application</b>	<b>Trademark Applicant</b>	<b>Mark</b>	<b>Class of Associated Goods</b>
December 11, 1979	Anheuser-Busch	BUDWEISER	Beer, ale and porter
June 12, 1980	Anheuser-Busch	BUDWEISER PREMIUM BEER	Label mark for lager beer
October 22, 1981	Anheuser-Busch	BUDWEISER KING OF BEERS	Label mark for beer
June 28, 1989	Budvar	BUDWEISER	Class 32 for: beer, ale and porter; malt beverages; all included in Class 32 but not including any such goods for supply to, or sale in, the United States of America’s Embassy and PX [military] stores in the United Kingdom <sup>295</sup>

<sup>293</sup> *Supra* note 28 [*Anheuser 2000*] at 3.

<sup>294</sup> *Ibid* at 3 referencing *supra* note 286. Data table created by author of the thesis.

<sup>295</sup> *Supra* note 28 at 3.



Budvar opposed Anheuser-Busch's three applications and Anheuser-Busch opposed Budvar's application. Assistant Registrar, Mr. Harkness, heard the applications and gave his decision on July 30, 1997. The date of Mr. Harkness' decision was eighteen years after the date of the first application, of the four in the table above.<sup>296</sup> Mr. Harkness concluded both parties possessed rights in the mark and could claim ownership thereby allowing all registrations.<sup>297</sup>

Both parties appealed. Justice Rimer heard the appeals and dismissed both on the grounds that "BB's [Budvar's] right to use the name Budweiser concurrently with AB [Anheuser-Busch] had been established by the decision in the passing off action."<sup>298</sup> Furthermore Rimer J. found that "this was a case where there had for long been an honest concurrent use by both Anheuser-Busch and Budvar of the mark Budweiser and the unusual circumstances of the case, [...] were sufficiently special to justify overriding under s.12(2) any s.11 [confusion] objection."<sup>299</sup> Anheuser-Busch and Budvar each appealed Rimer J.'s decision to the Court of Appeal, Civil Division on February 7, 2000.<sup>300</sup>

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<sup>296</sup> *Supra* note 28 at 4. At this point the United Kingdom had enacted new trademark legislation; however the case was determined using the previous Act as it was in force when the oppositions were filed.

<sup>297</sup> *Ibid* at 5.

<sup>298</sup> *Ibid*.

<sup>299</sup> *Ibid*.

<sup>300</sup> *Ibid*. Budvar contended that the decision to allow the marks to co-exist is correct and therefore the Court of Appeal should dismiss both appeals. Alternatively Budvar argued that if Anheuser-Busch's appeal is allowed, the Court should refuse the application.

Three judges presided over the hearing and each wrote a concurring judgment dismissing both appeals.<sup>301</sup>

***Trademark Expungement Action after the New Trademarks Act, 1994***<sup>302</sup>

The 1994 review of the trademark regime in the United Kingdom introduced explicit protection for geographical indications for the first time. The next round of litigation between Anheuser-Busch and Budvar concerned an attempt by Anheuser-Busch to force the revocation of two of Budvar's marks. The first mark in question was 'BUDWEISER BUDBRÄU'<sup>303</sup> and the second mark at issue was use of the word 'BUD'<sup>304</sup>. Anheuser-Busch sought the expungement of the marks under subsection 46(1)<sup>305</sup> of the recently revamped British trademark legislation, the *Trades Mark Act 1994*<sup>306</sup>.

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<sup>301</sup> *Ibid* at 15-18. Justice Gibson reiterated the arguments regarding the ability of subsection 12(2) to override the section 11 prohibition of confusion due to "honest concurrent use" thus holding that each party was entitled to use of the mark. Justice Judge's analysis also focused on the override capabilities of subsection 12(2) and held that the "the exercise of the judge's discretion under s.12(2) cannot be impugned." Justice Ferris' reasoning with respect to the section 11 analysis differed from that of the other Justices however the end result was identical in that subsection 12(2) was able to override issues of confusion.

<sup>302</sup> Budějovický Budvar, Národní Podnik v. Anheuser-Busch, Inc., [2002] EWCA Civ 1534 [*Anheuser 2002*].

<sup>303</sup> *Ibid* at para 5.

<sup>304</sup> *Ibid* at para 18.

<sup>305</sup> Section 46 states:

"(1) The registration of a trade mark may be revoked on any of the following grounds -

(a) that within the period of 5 years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use; . . .

The issue regarding both marks pertained to the meaning in subsection 46(2) of “use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered.” The appeal regarding expungement of the second mark also examined the meaning of ‘genuine use’ in s.46(1)(a).<sup>307</sup> The Court of Appeal found in favour of Budvar and held that the use of the marks in a form different from the registered mark nevertheless constituted use.<sup>308</sup>

***The Reference Concerning the United Kingdom Trades Mark Act 1994 and the European Union Directive***

The updated *1994 Act* created another opportunity for litigation in the Anheuser-Busch and Budvar dispute. This was because the *1994 Act* was intended to implement the *European Trade Marks Directive 89/104/EEC*<sup>309</sup>. The challenge arose because section 5 of the *1994 Act* prohibited a trademark from registration in certain circumstances:

5(1) A trade mark shall not be registered if it is identical with an earlier trademark and the goods or services for which the trademark is applied

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(2) For the purposes of sub section (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, . . .”

<sup>306</sup> C.26 [1994 Act].

<sup>307</sup> *Supra* note 302 [Anheuser 2002] at para 3.

<sup>308</sup> *Ibid* at paras 13-14 regarding the first mark (‘BUDWEISER BUDBRÄU’) and para 33 regarding the second mark ‘BUD’.

Lord Walker and Justice Pill wrote concurring judgments agreeing with the reasoning of Sir Nourse.

<sup>309</sup> [Trade Marks Directive]. Note: the *Trade Marks Directive* was replaced by *Directive 2008/95/EC* but not in any material respect.

for are identical with the goods or services for which the earlier mark is protected [emphasis added].<sup>310</sup>

**(2) A trade mark shall not be registered if because—**

**(a) it is identical with an earlier trade mark and is to be registered for goods or services similar** to those for which the earlier trade mark is protected, or

**(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar** to those for which the earlier trade mark is protected,

**there exists a likelihood of confusion on the part of the public**, which includes the likelihood of association with the earlier trade mark.

Under the terms of s.5 of the *1994 Act* Anheuser-Busch argued that its mark, ‘BUDWEISER’ was an ‘earlier trade mark’ and therefore should necessitate expungement of the competing Budvar ‘BUDWEISER’ mark.<sup>311</sup>

It was clear from a reading of the legislation that Anheuser-Busch’s mark was earlier under s.6(1) as Anheuser-Busch submitted a registration application on December 11<sup>th</sup>, 1979 although the mark was not registered until May 19<sup>th</sup>, 2000.<sup>312</sup> Budvar’s

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<sup>310</sup> Note: s.6(1) of the *1994 Act* defines an ‘earlier trademark’ as: “a registered trademark [...] which has a date of application for registration earlier than that of the trademark in question, taking account (where appropriate) of the priorities claimed in respect of the trademarks.”

<sup>311</sup> *Anheuser-Busch Inc v Budejovicky Budvar Narodni Podnik* [2008] EWHC 263 (Ch) [*Anheuser 2008*] at para 17. As per subsection 6(1) which defines an ‘earlier trade mark’ as: a registered trademark [...] which has a date of application for registration earlier than that of the trademark in question, taking account (where appropriate) of the priorities claimed in respect of the trademarks.”

<sup>312</sup> *ibid.*

'BUDWEISER' mark was also registered on May 19<sup>th</sup>, 2000 but Budvar had applied for the registration much later, on June 28<sup>th</sup>, 1989.<sup>313</sup>

The matter was heard by the United Kingdom Court of Appeal<sup>314</sup> and involved interpretation of the *Trade Mark Directive*, because the issue was raised of "how far EU registered trade mark law permits honest concurrent use of trade marks."<sup>315</sup> The Court of Appeal referred three questions to the Court of Justice of the European Communities regarding the interpretation of the *Trade Marks Directive*.<sup>316</sup> For the purpose of this case study, the third reference question is relevant:<sup>317</sup>

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<sup>313</sup> *Ibid* at para 16. Budvar was prevented from issuing a cross-application seeking a declaration of invalidity of Anheuser-Busch's 'BUDWEISER' because Anheuser-Busch applied for the declaration four years and 364 days after the Registrar granted registration to each company. Section 47(2) provides for a trademark to be declared invalid if there is an earlier trademark. Section 48 creates a limitation period of five years regarding applications of invalidity. Anheuser-Busch's application was issued within the five year period but served on Budvar after the expiry of the limitation period.

<sup>314</sup> *Anheuser-Busch Inc v Budejovicky Budvar Narodni Podnik* [2009] EWCA Civ 1022 [*Anheuser 2009*].

<sup>315</sup> *Ibid* at 1022.

<sup>316</sup> *Ibid*.

<sup>317</sup> *Supra* note 167 [*Anheuser 2011*] at para 26. The other two questions were:

(1) What is meant by "acquiesced" in Article 9.1 of the *Trade Marks Directive* and in particular:

- (a) is "acquiesced" a Community law concept or is it open to the national court to apply national rules as to acquiescence (including delay or long-established honest concurrent use)?
- (b) if "acquiesced" is a Community law concept can the proprietor of a trade mark be held to have acquiesced in a long and well-established honest use of an identical mark by another when he has long known of that use but has been unable to prevent it?
- (c) in any case, is it necessary that the proprietor of a trade mark should have his trade mark registered before he can begin to "acquiesce" in the use by another of (i) an identical or (ii) a confusingly similar mark?

**Does Article 4(1)(a) of Directive 89/104 apply so as to enable the proprietor of an earlier mark to prevail even where there has been a long period of honest concurrent use of two identical trade marks** for identical goods so that the guarantee of origin of the earlier mark does not mean the mark signifies the goods of the proprietor of the earlier and none other but instead signifies his goods or the goods of the other user? [emphasis added].

Article 4(1)(a) of the *Trade Marks Directive*, states:

1. **A trade mark** shall not be registered or, if registered, **shall be liable to be declared invalid:**

(a) **if it is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for or is registered are identical** with the goods or services for which the earlier trade mark is protected [emphasis added]

The European Court held that the interpretation of Article 4(1)(a) is:<sup>318</sup>

**[t]he proprietor of an earlier trade mark cannot obtain the cancellation of an identical later trade mark designating identical goods where there has been a long period of honest concurrent use** of those two trade marks **where**, in circumstances such as those in the main proceedings, that **use neither has nor is liable to have an adverse effect on the essential function of the trade mark** which is to guarantee to consumers the origin of the goods or services [emphasis added].

The Court noted in para 75 that Budvar's use of the 'BUDWEISER' trade mark did not have an adverse effect on Anheuser's trademark. This was due to the 'exceptional' circumstances of the case.<sup>319</sup> The result was therefore that, despite the 1994 United

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(2) When does the period of "five successive years" commence and in particular, can it commence (and if so can it expire) before the proprietor of the earlier trade mark obtains actual registration of his mark; and if so what conditions are necessary to set time running?

<sup>318</sup> *Ibid* at para 85.

<sup>319</sup> *Ibid* at para 76. The Court described the exceptional circumstances as:

- 1) Each company had marketed their beer under 'BUDWEISER' for approximately thirty years prior to the registration of the mark. [para 77]

Kingdom *Trade Marks Act*, geographical indication and trademark marks may continue to coexist in the United Kingdom.

From a statutory interpretation perspective, the European Court's finding is unreasonable. This is because Article 4(1)(a) of the *Trade Marks Directive* calls for a trademark to be declared invalid if it is identical with an earlier trademark and the associated goods are the same. Anheuser-Busch applied for the trademark 'BUDWEISER' in 1979 while Budvar applied for the same trademark in 1989. Due to the pending litigation, both parties' marks were registered on the same day. The language in Article 4(1)(a) of the *Trade Marks Directive* refers only to 'an earlier trade mark' and not a 'registered trade mark'. Anheuser-Busch therefore had a strong case that its mark was 'earlier' than Budvar's mark because the application was submitted ten years prior. Noticeably the issue of which mark was 'earlier' was not a point of discussion in the European Court's decision. Article 4(1)(a) makes no mention of 'honest concurrent use' which is a phrase the Court liberally read into the interpretation of the Article. In reading into Article 4(1)(a) the Court tacitly continued legislation that was no longer in effect.

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- 2) The UK Court of Appeal in February 2000 [*supra* note 28] authorized each company to register the mark jointly and concurrently. [para 78]
  - 3) Both corporations used the 'BUDWEISER' mark in good faith. [para 79]
  - 4) Despite the identical names, United Kingdom consumers can distinguish the products due to the differences in the products' "tastes, prices and get-ups". [para 80]
  - 5) Despite the fact that both companies used the same trademark for beer the products were "clearly identifiable as being produced by different companies." [para 81]

The European Court also created a window of opportunity for future litigation in paragraph 83 of the decision which states that if “in the future, there is any dishonesty associated with the use of the Budweiser trade marks, such a situation could, where necessary, be examined in the light of the rules relating to unfair competition.” Considering the litigious history between the parties, this comment may foreshadow the next arena for the continuation of the dispute.

The Budweiser disputes are similar to the *World Trade Organization Dispute* examined in this chapter. The doctrine of ‘honest and concurrent use’ represented in the United Kingdom’s *1938 Act* recognizes that cases exist “where two parties with similar or even identical trade marks can and should be allowed to co-exist.”<sup>320</sup> This approach is similar to the *World Trade Organization Dispute* pertaining to the *TRIPS Agreement* which also endorsed co-existence. The following Chapter examines the reasons for conflict in an effort to answer if coexistence between trademarks and geographical indications under the *TRIPS Agreement* is possible.

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<sup>320</sup> *Anheuser-Busch, Inc. v Budweiser Nat’l Corp.*, [2003] 1 N.Z.L.R. 472 at para 11.



## Chapter 4

The previous chapters have established that, from a business perspective, trademarks and geographical indications are completely separate concepts, with only trademarks recognized as an aspect of branding, and that, from an international perspective, there is much conflict between companies, such as in the case of the 'Budweiser' litigation, and countries, the 'Old' and the 'New', over geographical indications and trademarks. Given these differences and conflicts, this chapter addresses the question: is it possible for geographical indications and registered trademarks to coexist in the *TRIPS Agreement*? If so, how? As trademarks and geographical indications are inconsistent devices but appear as interchangeable in the *TRIPS Agreement*, how could it be possible for the two devices to co-exist? It had been suggested in the research proposition that co-existence would only be possible if trademarks and geographical indications were not fundamentally different, through the use, consciously or unconsciously, of conflict resolution strategies. However this thesis establishes that the two concepts are fundamentally different. This finding is consistent with the findings by international tribunals and the United Kingdom court system. The Chapter concludes by finding the two devices can coexist and represent alternative business strategies. The Chapter approaches the question by first examining further the tension between geographical indications and trademarks.

## ***Sources of Conflict and Confusion between Geographical Indications and Trademarks***

There are several explanations advanced for why trademarks and geographical indications are perceived to be in conflict. These include reasons why these two very different concepts have come into conflict and the rhetoric of the conflict. The reasons for conflict between the devices include 1) the language in the *TRIPS Agreement*, 2) the perspective of each functioning as a source identifier and 3) the concept of ‘reputation’. The rhetoric of the conflict encompasses 1) cultural protection, 2) economic perspectives, and 3) trade and agricultural policy positions. The following section will explore each of the concepts.

### ***Reasons for Conflict***

#### ***1) The Language of the TRIPS Agreement***

The *TRIPS Agreement* implies that trademarks and geographical indications are interchangeable; the World Trade Organization Panel came to this conclusion from the language of Article 24.5.<sup>321</sup> The purpose of Article 24.5 is to allow for registration of

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<sup>321</sup> *Supra* note 1 at Article 24.5 states:

**Where a trademark has been applied for** or registered in good faith, **or where rights to a trademark have been acquired through use** in good faith either:

(a) before the date of application of these provisions in that Member as defined in Part VI;

or

(b) **before the geographical indication is protected in its country of origin;**

**measures adopted to implement this Section shall not prejudice eligibility for or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication** [emphasis added].

trademarks that are identical or similar to geographical indications.<sup>322</sup> The fact that Article 24.5 allows for registration of similar marks does not necessarily mean that trademarks and geographical indications are interchangeable devices. The provision does however correspond with the World Trade Organization Panel's finding that the devices may coexist as similar marks may be registered under each system.

## **2) Perspective of Trademarks and Geographical Indications Functioning as Source Identifiers**

Another source of confusion regarding trademarks and geographical indications arises from their functions. As discussed in Chapter Two, originally the *only* function of trademarks was to identify product origin.<sup>323</sup> Over the centuries the function of trademarks has expanded in terms of protectable subject matter and the concept of 'source' has morphed into a broader concept than simply identification of product origin. The result is that, like the definition of 'brand', the concept of 'trademarks' is evolving. By contrast, the function of geographical indications remains limited to identifying a product's geographic origin. The essential geographic element of the definition of geographical indications prevents geographical indications from

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<sup>322</sup> *Supra* note 120 at 135: The purpose of *TRIPS* Article 24.5 is:

**to allow a trademark to be registered** (and registration applied for), **and used, even if it is identical with or similar to a geographical indication**, provided the trademark is at least applied for (including if it [is] registered, naturally) or rights acquired through use either before the WTO member concerned must apply Article 23 or before the indication is protected in its country of origin [emphasis added].

Note: the purpose of Article 24.7 is "to impose a time limit on measures taken pursuant to Articles 22 or 23 (notably Articles 22.3 and 24.5) against the use (or cancellation of the) registration of a trademark consisting or containing a geographical indication." [*Supra* note 120 at 137]

<sup>323</sup> See discussion in Chapter 2.

transforming into a more abstract notion in a manner similar to the recent trademark transformation.

### 3) *Reputation*

A shared aspect of trademarks and geographical indications that may contribute to confusion with respect to the devices is discussion of reputation. The *TRIPS Agreement* definition of a geographical indication includes ‘reputation’.<sup>324</sup> The use of ‘reputation’ in the definition of ‘geographical indication’ in the *TRIPS Agreement* refers to a characteristic of the good “essentially attributable to its geographical origin”.<sup>325</sup>

The international *Feta Dispute* involving geographical indications highlighted the relevance of public opinion with respect to registration of a geographical indication.<sup>326</sup> The scientific committee charged with gathering evidence for the Commission’s report on whether ‘feta’ was generic outlined the role of public perception of a good’s reputation as:<sup>327</sup>

**a designation of origin or geographical indication can be considered as having become the common name of a product only when there is in the relevant territory no significant part of the public concerned that still considers the indication as a geographical indication . . . it is**

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<sup>324</sup> *Supra* note 1 at Article 22.1:

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

<sup>325</sup> *Ibid.*

<sup>326</sup> *Supra* note 69 at paras 43 and 89.

<sup>327</sup> Recital 23 in Commission Regulation (EC) 1829/2002 of 14 October 2002 amending the annex to Regulation 1107/96 with regard to the name Feta [2002] OJ L277/10.

**with regard to the general public that the designation or indication in question must have lost its original geographical meaning.** In determining what the general public perception is, both “direct” measurements are relevant, such as opinion polls and other surveys, and “indirect” measurements, such as the level of production and consumption, the kind and nature of labeling employed, the kind and nature of advertising employed with regard to such products, use in dictionaries, etc [emphasis added].

In the above discussion of reputation, it is important to note that the public was canvassed to determine if a link existed *between the product and a geographic location*.

Reputation is also relevant with respect to the concept of the ‘distinctiveness’ of a trademark (which is a registrability requirement).<sup>328</sup> Two variations of distinctiveness exist in the trademark context: inherent and acquired.<sup>329</sup> A mark is inherently

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<sup>328</sup> *Supra* note 1 at Article 15.1 Protectable Subject Matter that states:

**Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark.** Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. **Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use.** Members may require, as a condition of registration, that signs be visually perceptible [emphasis added].

The *Trade-Marks Act, RSC 1985, T-13 [Canadian Trade-marks Act]* at s.2 defines ‘distinctive’ as:

[...] a trade-mark that actually distinguishes the wares or services in association with which it is used by its owner from the wares or services of others or is adapted so to distinguish them

<sup>329</sup> Roger T. Hughes & Toni Polson Ashton, *Hughes on Trade-Marks*, 2d ed. Looseleaf (Markham: LexisNexis Butterworths, 2005) at 649 footnote 19.

distinctive if it is a unique or an invented name or symbol.<sup>330</sup> If a mark is not inherently distinctive, it may “acquire distinctiveness through continual use in the marketplace.”<sup>331</sup> In order to establish acquired distinctiveness, one must establish that a mark “has become *known to consumers* as originating from one particular source [emphasis added].”<sup>332</sup> Canadian jurisprudence has described distinctiveness as “the very essence and cardinal requirement of a valid trade-mark.”<sup>333</sup> The rationale for the distinctiveness requirement relates to consumer protection.<sup>334</sup> Distinctiveness avoids product confusion in the public by indicating that products sold under the same trademark are from a ‘single source’.<sup>335</sup>

The trademark conversation about distinctiveness varies from the reputation discussion in the context of geographical indications above because the geographic source of a trademarked product may change even as the trademark retains its distinctiveness but this is impossible in the case of a geographical indication.

‘Single source’ with respect to trademarks may include multiple production locations worldwide. An example is that consumers of a beverage with an associated trademark expect that drinks sold under the same trademark contain identical product

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<sup>330</sup> *Ibid.*

<sup>331</sup> *Ibid.*

<sup>332</sup> *Ibid.*

<sup>333</sup> *Ibid.*

<sup>334</sup> *Supra* note 2 at 189.

<sup>335</sup> *Ibid* at 235.

in each bottle regardless of whether the drink was bottled in different factories located in different regions.<sup>336</sup>

Another variation between reputation with respect to trademarks and reputation with regard to geographical indications is that a trademark's reputation may broaden the traditional legal protection afforded to trademarks as:<sup>337</sup>

**The protection afforded to marks with a reputation extends beyond their meaning as a badge of origin. Such marks are protected even when they are used on goods or services which do not lie within the ambit of the goods or services claimed at registration:** that is, the goods and services which are supplied by the proprietor under the mark. To that extent, **it may be argued that what is being protected are wider 'brand values', rather than the trade mark's meaning as an indicator of origin** [emphasis added].

The British case of *Arsenal Football Club Plc v Matthew Reed*<sup>338</sup> is an example where some have argued that the European Court of Justice recognized "broad protection for trade marks in their role as 'brands', which is defined as 'a wider concept intended to attract consumer loyalty by virtue of values, including lifestyle messages, associated with that brand'."<sup>339</sup> While the European Court of Justice may have been more cautious

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<sup>336</sup> *Ibid* at 242.

<sup>337</sup> Lionel Bently, Jennifer Davis, & Jane Ginsburg, *Trade Marks and Brands: An Interdisciplinary Critique*, (Cambridge: Cambridge University Press, 2008) at 85.

<sup>338</sup> C-206/01 [2003] 1 CLMR 12 [*Arsenal*].

<sup>339</sup> *Supra* note 337 at 88, footnote 113 quoting Sumroy and Badger, 'Infringing "Use in the Course of Trade"' 164. See also H. Norman, 'Time to Blow the Whistle on Trade Mark use' (2004) 1 IPQ 1, who believes that the value of trade marks, not least as merchandising and licensing tools, suggests that they deserve to be protected beyond their role as a badge of origin. From this perspective, she views the Arsenal decision as a promising development. See also J. Tumbridge, 'Trade Marks: The Confusion of "Use"' (2004) 9 EIPR 431.

in its decision regarding protection of ‘brand values’ than some have interpreted,<sup>340</sup> it is certainly the case that using reputation as a means to *extend* legal protection of a good is impossible in the case of geographical indications: the geographical indication ‘champagne’ could not be extended to protect cheese produced in France’s Champagne region just because the reputation of ‘champagne’ was such an indication to the public of a unique source the public would similarly associate cheese with the same identifier.

Both trademarks and geographical indications refer to ‘reputation’. The use of ‘reputation’ in the definition of geographical indications is similar to the language used in the marketing definitions of ‘brand’ and can be considered an ‘intangible value’ as described in the 1994 definition in Table 3 in Chapter Two. However, an important caveat to this observation is that the use of ‘reputation’ in the definition of ‘geographical indication’ refers to a characteristic of the good “essentially attributable to its geographical origin”<sup>341</sup> whereas the language of the marketing literature definitions of ‘brand’ speaks to a reputation generally. The fact that both geographical indication and trademark literature discuss a good’s ‘reputation’ may have helped form

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<sup>340</sup> *Ibid* “By finding that, on the one hand, the essential meaning of a trade mark remains its meaning as an indicator of origin, but, on the other, that non-trade mark use can compromise this meaning, the ECJ [European Court of Justice] has taken a nuanced approach to the extent to which ‘brand values’ should be protected by trade mark registration. It may have recognized the importance of the transferability of trade marks (*qua* brands), but it has remained cautious as to the extent to which a trade mark’s ‘emotional’ values might also be protected.”

<sup>341</sup> *Supra* note 1 at Article 22.1:

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



the misconception that trademarks and geographical indications share an identical function.

### ***Rhetoric of the Conflict***

The rhetoric of the conflict clearly identifies those in conflict as nation states. If the conflict was between nation states, then a given nation state would be expected to take a consistent position on the conflict. France's position in the case of *Feta 2005*, discussed below, demonstrates that is not the case.

In the United Kingdom Budweiser litigation history, the parties to the action were the American and Czech *corporations*, Anheuser-Busch and Budvar respectively. At the World Trade Organization, only Member countries have standing to be parties to a dispute, thus in the *World Trade Organization Dispute* the parties were the United States, Australia and the European Communities.<sup>342</sup> World Trade Organization Member *countries* agreed to the terms of the *TRIPS Agreement* and continue to negotiate additional terms in the Doha talks considering the relevant parties to a conflict resolution theory. In the litigation explored in this thesis, another type of interest is involved: the commercial interests of private parties.

The conflict between nation states and conflict between private parties is highlighted by the difference between the *World Trade Organization Dispute* involving the European Union Regulation discussed above and the *Feta Dispute* within the

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<sup>342</sup> *Supra* note 35.

European Union.<sup>343</sup> In the *World Trade Organization Dispute*, the European Community defended its *Regulation*. In the *Feta Dispute*, the conflict was *between* European countries; Denmark and Germany challenged Greece's registration of 'feta' under the *Regulation*. France and the United Kingdom obtained standing as interveners in support of Denmark and Germany's challenge.<sup>344</sup>

France, as discussed earlier, is a strong supporter of geographical indications so for the French government to oppose the designation of 'feta' as a geographical indication is surprising.<sup>345</sup> France's varying position on registration of geographical indications underlines the difficulties of framing the tension as a country versus country one.

This analysis of the *Feta Dispute*, highlighting its unexpected parties, leads to the observation that tension between proponents of trademarks and geographical indications is best framed around the products involved. This framing is contrary to the 'Old World' versus 'New World' perspective:<sup>346</sup> the *Feta Dispute* illustrates that even 'Old World' countries may oppose protection of a geographical indication.

### **1) Cultural Protection**

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<sup>343</sup> See also *supra* note 69.

<sup>344</sup> *Ibid.*

<sup>345</sup> France's position was surprising from a theoretical standpoint which demonstrates the political nature of the *TRIPS Agreement* as discussed in Chapter 4.

<sup>346</sup> See Chapter 1.

Our values define us and as part of that identity, we associate with groups that share or represent our values.<sup>347</sup> Accordingly, conflicts that engage core values cause reactions that are more emotional and people are “less likely to conceive or consider tradeoffs”.<sup>348</sup> Ideologically based disputes are unique in that they “involve core values and ideological beliefs.”<sup>349</sup>

The conflict that this thesis examines may, at first, seem unlikely to represent a value-based conflict. However, it can be seen that the ‘Old World’ countries’ arguments reference culture, tradition, and history. The ‘New World’ countries’ arguments, in favour of a trademark regime, reflect a sense of unfairness justified by economics, trade and agricultural policy. In this way, the discussions mirror the values of the constituents.

Many of the geographical indications from Europe are applied to foodstuffs.<sup>350</sup> What we eat and drink reflects our society and is “as essential [an] element of our culture as any”<sup>351</sup> and food “has been likened to language, as an expression of national and local culture.”<sup>352</sup> In addition, all geographical indications are products where a

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<sup>347</sup> Marieke de Mooij, *Consumer Behavior and Culture: Consequences for Global Marketing and Advertising*, (California: Sage Publications, Inc. 2004) at 44.

<sup>348</sup> *Ibid.*

<sup>349</sup> Kimberly A. Wade-Benzoi *et al.*, “Barriers to Resolution in Ideologically Based Negotiations: The Role of Values and Institutions” (2002) 27:1 *The Academy of Management Review* 41 at 43.

<sup>350</sup> *Supra* note 41 at 187.

<sup>351</sup> *Supra* note 47 at 14.

<sup>352</sup> *Ibid* at 13.

“quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.”<sup>353</sup> As food forms part of culture generally and as all geographical indications are by definition connected to a location, it is reasonable to presume that food or drink with geographical indication protection is something with which inhabitants of a region strongly identify. Even where the geographical indication is not associated with food, it is associated with place and, as such, will be associated with strong feelings by locals. Food has been described as “an important expression of cultural practices, perceptions and identities, both individual and collective.”<sup>354</sup> Anthropologists have found that food marks membership or non-membership in social groupings.<sup>355</sup> Literature has furthermore likened food to language as a method by which to express culture.<sup>356</sup> The UNESCO Draft Convention Non-Exhaustive List of Cultural Goods and Services also includes ‘culinary traditions’ in the list of ‘cultural activities’.<sup>357</sup> Viewing the negotiations through this lens, it is understandable that proponents of geographical indications feel strongly about increasing protection. Emotions may rise if negotiators from the ‘New World’ fail to demonstrate an understanding of the cultural significance of geographical indications.

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<sup>353</sup> *Supra* note 1 at Article 22.1.

<sup>354</sup> *Supra* note 47 at 642. The European Regulation examined in this thesis is restricted to agricultural products and foodstuffs which is why food is discussed in this section.

<sup>355</sup> *Ibid.*

<sup>356</sup> *Ibid.*

<sup>357</sup> *Ibid* at 644.

Proponents of geographical indications argue that the traditional regional methods of production deserve protection and may disappear under open market conditions.<sup>358</sup> Protection of geographical indications is thus argued to be a means to protect “heritage, rural landscapes and perhaps even a sense of regional or national identity.”<sup>359</sup> One European winemaker articulated his perspective on the conflict when he said, “each bottle of American or Australian wine that lands in Europe is a bomb targeted at the heart of our rich European Culture.”<sup>360</sup>

Opponents of geographical indications counter this approach in several ways. Firstly, they suggest that geographical indications are generic terms representing product categories and thus not worthy of legal protection.<sup>361</sup> They argue further that the ‘New World’ producers of disputed goods also have an historic claim to the product names due to emigration from the ‘Old World’. This is because as people immigrated to the New World, they brought with them the production knowledge and terminology from where they came. The history of Anheuser-Busch choosing the name ‘Budweiser’

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<sup>358</sup> *Ibid* at 653. See for example, the speech of European Commission Member, Dr. Franz Fischler ‘Quality food, CAP reform and PDO/PGI’ (Speech/04/183) Siena 17 April 2004. “Products with a history, which have withstood the passing of time, which form part of Europe’s heritage, and with their own specific characteristics linked to the environment and know-how are very valuable assets. Such products are, if you like, part of our identity, our culture and our traditions, and consumers are used to recognising specific foods, or drinks, by the name of the area in which they are produced.” See also the opinion of Advocate General Ruiz-Jarabo Colomer considering FETA in *Canadene Cheese Trading v Hellenic Republic* [1997] ECR I-4681 at 10 “Cheese forms part of western food and culture. [...] Consequently there is no doubt as to the importance of cheese in Mediterranean civilization.”

<sup>359</sup> *Supra* note 3 at 1268.

<sup>360</sup> Winemaker from Languedoc, 1999. Quoted in William Echikson, “Noble Rot: A Bordeaux Wine Revolution” 15 (2003).

<sup>361</sup> *Supra* note 8 at 436.

for its beer because of a Czech-American employee's nostalgia for his homeland is such an example. In this way, the 'New World' possesses its own historical and cultural link to the products and terms at issue and should be allowed to use them.<sup>362</sup>

## ***2) Economic Perspectives***

It has been argued that geographical indications restrict competition.<sup>363</sup> Unlike many market protectionist measures however, geographical indications do not have the "blatantly market-restrictive effects of tariff or tax trade protectionism."<sup>364</sup> The primary function of geographical indications is as a tool to link a good to its geographic source. In this light, one could argue that geographical indications "promote free trade by facilitating full information, towards perfect market conditions."<sup>365</sup>

The 'Old World' notes that products which benefit from geographical indications sell for a premium price: "French dairy farmers get 10% more for milk sold to make Comte cheese."<sup>366</sup> The 'Old World' therefore argues that producers of unrecognized geographical indication goods are losing billions of euros per year.<sup>367</sup> Proponents of geographical indications further argue that non-Europeans, or the 'New World' are

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<sup>362</sup> *Ibid.*

<sup>363</sup> *Supra* note 56 [*Blakeney*] at 580.

<sup>364</sup> *Supra* note 47 at 647.

<sup>365</sup> *Ibid.*

<sup>366</sup> James Cox, What's in a Name? USA Today, Sept. 9, 2003 at 1B.

<sup>367</sup> *Supra* note 8 at 434.

“free-riding on the reputation of European-quality products.”<sup>368</sup> The ‘Old World’ perspective is that ‘feta’ cheese and ‘prosciutto’, for example, are intellectual property and foreign use of the terms constitutes an infringement on intellectual property and that foreign goods using these indications are counterfeit products.<sup>369</sup>

‘New World’ opponents argue that such protected products attract premium prices regardless of merit.<sup>370</sup> Protection is the result of proving a historical link between the product and the geographic region, not necessarily superior quality. This is particularly frustrating to ‘New World’ countries when producers lacking geographical indication protection must design expensive marketing campaigns<sup>371</sup> to create brand and product recognition while competitors with geographical indication protection can charge a premium price without incurring additional costs and without having to make a guarantee of enhanced quality. The ‘New World’ countries therefore view negotiations for increased geographical indication protection as helping European businesses at the expense of ‘New World’ corporations who would have to spend money promoting new product terminology.<sup>372</sup>

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<sup>368</sup> *Supra* note 44 at 570.

<sup>369</sup> *Ibid.*

<sup>370</sup> *Supra* note 47 at 649.

<sup>371</sup> For example Kraft has spent ‘tens of millions of dollars’ advertising the term ‘pamesello’ as the company can no longer sell ‘parmesan’ cheese. See *supra* note 44 at 569.

<sup>372</sup> *Supra* note 8 at 434. Consider the case of Kraft which can no longer use the term ‘Parmesan Cheese’ in Europe. In 1945 in the U.S. Kraft began producing parmesan cheese, its version of Parmigiano-Reggiano. The Italian version of Parmigiano-Reggiano is produced in an 800 year old labour intensive process culminating in aging the cheese for twelve months and selling the cheese in fresh wedges. Parmesan

### 3) Trade & Agricultural Policy Positions

Because of the industrialization of agriculture in the twentieth century,<sup>373</sup> farmers are now capable of producing large food surpluses.<sup>374</sup> The economies of scale which have developed mean that it is often uneconomical for small-scale farmers to continue.<sup>375</sup> Agricultural biotechnology in the twenty-first century has furthered the focus on mass production in agriculture. Small-scale farming communities and associations in Europe have therefore turned to geographical indications as a legal response to the problem.<sup>376</sup> Geographical indications change production focus from quantity-based to quality-based goods, resulting in consumers paying more for goods produced by traditional methods.<sup>377</sup>

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cheese is aged for ten months, mass-produced and sold in a dry powder. Italian producers argued Kraft was free riding on the traditional name and that Kraft infringed the Parmigian-Reggiano geographical indication. Kraft now sells its cheese under the name 'Pamessello Cheese'. See also *supra* note 44 at 569. To promote the new name, Kraft spent tens of millions of dollars.

<sup>373</sup> For example the movement to increase yields by using new crop cultivars irrigation fertilizers pesticides and mechanization. See *supra* note 56 [*Blakeney*] at 576 footnote 2.

<sup>374</sup> *Ibid* at 576.

<sup>375</sup> For example, between 1998 and 2001 the price of coffee dropped 58%. This demonstrates the decreased return for commodity farmers. See *ibid*.

<sup>376</sup> *Ibid*.

<sup>377</sup> *Ibid* at 583. Geographical indications serve this end better than trademarks because unlike trademarks, geographical indications "cannot be sold or delocalized and are accessible to any producer within the specified region of origin". See also Recital 3 to Regulation 5190/2006 which states: 'A constantly increasing number of consumers attach greater importance to the quality of foodstuffs in their diet rather than to quantity. This quest for specific products generates a demand for agricultural products or foodstuffs with an identifiable geographical origin.' This also connects to an effort to increase the profile of geographical indicator protected products on the basis of quality. See also *supra* note 34 Article 2 of the *Regulation* 2081/92.



The European Union views expanding the protection of geographical indications as “an indispensable part of agricultural policy, serving both to preserve the incomes of small to medium-size producers and to guarantee the sustainability of the rural economy.”<sup>378</sup> Enhanced protection of geographical indications would accomplish this goal as the goods would benefit from price premiums.<sup>379</sup> European farmers would also increase their competitive edge in the international commodity market by differentiating goods and creating high end niche products. The price premiums that protected geographical indication products would attract could then replace European Commission agricultural production-based subsidies,<sup>380</sup> “export subsidies, cutting tariffs and reducing trade-distorting payments for farmers.”<sup>381</sup>

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<sup>378</sup> *Ibid* at 577. The *Regulation 2081/92* states the policy reason for using geographical indications is a means by which the European Community can fulfill its objective to contribute to “the diversification of agricultural production...so as to achieve a better balance between supply and demand on the markets; ...[and benefiting] the rural economy, in particular...less-favoured or remote areas, by improving the incomes of farmers. See also European Commission, “Why Do Geographical Indications Matter to Us?” (30 July 2003) available at [http://europa.eu.intl/comm/trade/issues/sectoral/intell\\_property/argu\\_en.htm](http://europa.eu.intl/comm/trade/issues/sectoral/intell_property/argu_en.htm).: “The EU has entered, in good faith, into negotiations with its partners in the WTO with a view to further liberalizing world trade in agricultural commodities. This will mean, in practice, less export subsidies to our farmers. This policy is embodied in the Commission’s proposed review of the Common Agricultural Policy: compete internationally on quality rather than quantity. Yet, efforts to compete on quality would be futile if the main vehicle of our quality products. GIs [geographical indications], are not adequately protected in international markets.”

<sup>379</sup> *Supra* note 366.

<sup>380</sup> *Supra* note 56 [*Blakeney*] at 583.

<sup>381</sup> *Supra* note 54 [*White Flag*] at 358.

Opponents of geographical indications argue that focusing on preserving traditional agricultural processes protects inefficiencies.<sup>382</sup> 'New World' countries are frustrated with European negotiators, who insist on combining World Trade Organization Doha negotiations on agricultural market access with discussions on geographical indications because the New World countries see this as a way of endorsing a furtherance of agricultural subsidies.<sup>383</sup> They view such heavy agricultural subsidies as an indirect form of protectionism and a loophole around the mounting pressure for Europe to open its markets.<sup>384</sup>

### **Conclusion**

The Chapter illustrates reasons why trademarks and geographical indications have come into conflict and the rhetoric of the conflict. The conflict examined is not between countries but between commercial rivals, often global corporations, and trademark is part of the marketing rivalries that emerge between rival businesses as demonstrated by the 'Budweiser' litigation in the United Kingdom discussed in Chapter 3. Geographical indications are not owned by businesses but rather by governing bodies of groups of producers within a region, if a nation states' legislation permits. Geographical indications are thus not part of a company's branding but rather part of its endorsement profile, a form of endorsement enhanced by government regulation

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<sup>382</sup> *ibid.*

<sup>383</sup> *ibid.*

<sup>384</sup> The United States argues that its agricultural import tariffs are much lower than European tariffs. At World Trade Organization talks the United States demands that the Europeans cut tariffs by 90%. 'The WTO development round', Euractive.com online: <<http://www.euractiv.com/en/trade/wto-doha-development-round/article-157082>.>

where a nation state's legislation permits.<sup>385</sup> This finding is consistent with the finding from Chapter 2 that branding literature does not refer to geographical indications.<sup>386</sup>

The thesis establishes that framing tension between proponents of trademark and geographical indications as different ways of creating product market advantage is more accurate than framing the two devices as in conflict with each other. The answer to the question posed by this Chapter (is it possible for geographical indications and registered trademarks to coexist in the *TRIPS Agreement*?) is therefore that coexistence is possible. On the other hand, the entwining of the language of trademarks and geographical indications in the *TRIPS Agreement* in various articles, for instance, Article 24.5<sup>387</sup> in Part 3 Geographical Indications, tends to obscure the separation of the two generally in the *TRIPS Agreement* by placing trademarks in Part 2 and geographical

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<sup>385</sup> *Supra* notes 162 and 163 and corresponding text.

<sup>386</sup> A further study, based on this work, could explore whether there is any literature on endorsement that discusses geographical indications. This author is able to offer the observation that there is no literature on geographical indications that even speculates about a characterization of geographical indications as endorsements. This characterization is one of the important outcomes of this exploratory study.

<sup>387</sup> *Supra* note 1 at Article 24.5 states:

Where a trademark has been applied for or registered in good faith, or where rights to a trademark have been acquired through use in good faith either:

- (a) before the date of application of these provisions in that Member as defined in Part VI; or
- (b) before the geographical indication is protected in its country of origin;

measures adopted to implement this Section shall not prejudice eligibility for or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication.

indications in Part 3. This thesis would tend to indicate that the language of the *TRIPS Agreement* might hopefully be renegotiated in future to entirely separate these devices in the text.

The findings in Chapter 2 confirm that trademarks and geographical indications are neither “equal” nor “identical” from an industry perspective. The devices are therefore not ‘interchangeable’. Trademark and geographic indications represent two different approaches a business can take to achieve market advantage; one, however, is universally available because international agreements have caused trademark to be available in every jurisdiction; geographical indications, on the other hand, are generally available only in jurisdictions that find it economically and culturally advantageous to create the legislative environment to foster them; trademarks are available directly to a business but geographical indications, where available, have to be obtained through the intermediary of a governing body which certifies the eligibility of the business to use the mark; trademarks are unique, where issued, whereas geographical indications must be shared with other businesses from the same region where eligible.

In explaining how coexistence of such distinct devices could occur, this thesis began by suggesting that trademarks and geographical indications would be found to be fundamentally inconsistent and therefore went on to suggest that coexistence between the devices must be achieved through implementation of strategies of conflict resolution. Indeed, the notion that trademarks and geographical indications must be fundamentally inconsistent was, in part, generated by the fact that they are protected

differently, even where protection of both is nested under the same piece of legislation. The two common loci for geographical indication protection are (1) trademark legislation<sup>388</sup> and (2) *sui generis* protection (specially tailored legislation such as the *Regulation* examined in Chapter 3).<sup>389</sup> Countries protecting geographical indications within their trademark regimes tend to favour the First in Time First in Right principle which affords protection to the first sign registered whether trademark or geographical indication.<sup>390</sup> The registered sign then enjoys exclusive rights preventing use by third parties as outlined in *TRIPS* Article 16.1.<sup>391</sup> Countries protecting geographical indications under *sui generis* legislation, such as the European Communities *Regulation*, create the possibility “for subsequent GIs [geographical indications] to prevail over prior trade marks, and in certain circumstances the Regulation envisages coexistence between the two rights [trademarks and geographical indications].”<sup>392</sup> Academic debate has then

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<sup>388</sup> Countries that protect geographical indications through a trademark regime include the United States, Canada and Australia. See generally *supra* note 55, note 3 and Massimo Vittori, “The International Debate on Geographical Indications (GIs): The Point of View of the Global Coalition of GI Producers – oriGIn” 13:2 (2010) *The Journal of World Intellectual Property [oriGIn]*.

<sup>389</sup> Approximately “76 countries protect GIs today through specific legal systems (commonly referred to as *sui generis*), which provide for the registration of geographical names as a separate kind of intellectual property right.” *Ibid [oriGIn]* at 304.

<sup>390</sup> *Supra* note 3.

<sup>391</sup> See discussion in Chapter 3.

<sup>392</sup> *Supra* note 55 at 446.

ensued analyzing the advantages and disadvantages of both systems of protection of geographical indication.<sup>393</sup>

Rather than finding trademarks and geographic indications fundamentally inconsistent, through this research the contrary research proposition, that trademarks and geographical indications are not fundamentally inconsistent, has emerged as more accurate. Indeed, even the World Trade Organization Panel's definition of 'coexistence' does not imply that trademarks and geographical indications are interchangeable.<sup>394</sup> As discussed in Chapter 3, the World Trade Organization Panel defined 'coexistence' with respect to the *World Trade Organization Dispute* as "a legal regime under which a GI [geographical indication] and a trademark can both be used concurrently to **some extent** even though the use of one or both of them would otherwise infringe the rights conferred by the other [emphasis added]."<sup>395</sup> This definition implies that legislation may allow for simultaneous trademark and geographical indication protection. The definition also notes that some overlap may exist between the trademark and geographical indication regimes such that otherwise infringed rights are tolerated and

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<sup>393</sup> See generally *supra* note 3, note 55, and note 382 [*oriGIn*] outlining FITFIR principle and geographical indication dominance protection.

<sup>394</sup> *Supra* note 56 [*Blakeney*] at 598 is therefore incorrect when Blakeney states that:

In response, **the ECs [European Communities] successfully argued that GIs [geographical indications] and trademarks constitute independent but equal forms of intellectual property** in accordance with the structure of the TRIPS Agreement and that the boundary between GIs and trademarks is further defined by Article 24.5, which may be interpreted as providing for the coexistence of GIs with earlier trademarks [emphasis added].

<sup>395</sup> *Supra* note 35 [*EC-US Report*] at para 7.514. Note that the World Trade Organization Panel Report clarified that its "use of the term does not imply any view on whether such a regime is justified."

not actionable by the 'infringed' party.<sup>396</sup> The British Budweiser situation illustrates that two marks may coexist in the same goods sector without infringing upon the other's mark such that the World Trade Organization Panel's caveat, while technically valid, may not prove to be an insurmountable judicial issue.<sup>397</sup> It is important to recall that Budvar is not the only brewery that would be entitled to the 'Budweiser' and 'Budvar' geographical indication designations: it is simply that history has dictated that it is the only company in existence currently that meets the requirements for the designations. Given it is the only company using these geographical indication designations, it is easy to confuse its use of the geographical indications as being the same as its use of its trademarks. Of course, it is actually only uniquely entitled to its trademarks.

Where a nation state is fully supportive of the concept of geographical indications, it tends to implement *sui generis* legislation. Where a nation state is less enamoured, it tends to implement geographical indications in trademark legislation.

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<sup>396</sup> The Oxford Dictionary defines 'concurrent' as:

"existing, happening, or done at the same time: *there are three concurrent art fairs around the city* (of two or more prison sentences) to be served at the same time."

The Oxford dictionary defines 'interchangeable' as:

"(of two things) able to be interchanged: eyepiece are interchangeable and one can use any eyepiece with any telescope; the V8 engines are all interchangeable with each other; apparently identical; very similar."

Source: [www.oxforddictionaries.com](http://www.oxforddictionaries.com)

<sup>397</sup> The World Trade Organization Panel's definition of 'coexistence' is not synonymous with 'equal' as some have interpreted the decision. The definition of 'coexistence' is also not synonymous with 'identical'. This is because the definition states that trademarks and geographical indications may "be used concurrently" but does not equate the concepts as 'equal' or 'identical'.

Thus, despite the initial apparent conflict engendered by the inclusion of geographical indications in the *TRIPS Agreement* alongside trademark, the commonality of the concepts of source and reputation in both, this thesis has empirically and analytically established that the two are not in conflict as they do not engage the interests of the same types of parties nor accomplish the same business goals. Because this thesis has established that trademarks and geographical indications are not fundamentally inconsistent, it has emerged from the research that there is no systemic conflict to resolve and hence conflict resolution principles are not helpful to developing a greater understanding between the two devices.

If legislation can concurrently protect trademarks and geographical indications and the devices are not interchangeable, strategies of conflict resolution may be irrelevant because this coexistence implies that the devices are not in conflict. As the thesis will expand upon below, perhaps trademarks and geographical indications can coexist because they operate on different planes.

In the protracted and multi forum Budweiser dispute discussed in Chapter Three, the British courts and most recently, the European Court of Justice, have held that the two Budweisers may coexist under the British doctrine of 'honest and concurrent use'. Both Anheuser-Busch and Budvar continue to successfully sell 'Budweiser' beer in the United Kingdom thereby demonstrating that coexistence of geographical indications and trademarks is definitely possible from a business point of view. This leads to the observation that "consumers are far more resilient and capable of more nuanced



perceptions than trademark doctrine has thus far presumed.”<sup>398</sup> Coexistence of geographical indication beer trademark beer is a particularly interesting example of coexistence because “one would assume that if there’s any scope for paternalistic concerns about fuzzy confusion, consumers of lager are likely candidates.”<sup>399</sup> The decisions throughout the British Budweiser litigation processes reinforce the World Trade Organization Panel’s finding that coexistence between geographical indications and trademarks is possible. Despite this declaration from the *World Trade Organization Dispute* resolution Panel, this thesis has shown in Chapter 2 that trademarks and geographical indications do not co-exist in the marketing literature. And the ongoing battle between countries in the Doha round of negotiations, discussed in Chapter 1, indicates that states are not accepting ‘co-existence’ easily.

An implication with respect to the coexistence of trademarks and geographical indications is the requirement for some producers to rename, or re-launch, their products. This is a requirement for producers who do not benefit from geographical indication protection but whose goods compete with goods that receive enhanced geographical indication protection such as is provided for in Article 23 of the *TRIPS Agreement*. For example vineyards outside of the Champagne region cannot produce ‘champagne’ so they have renamed their product ‘sparkling wine’. From the perspective of a geographical indication holder, goods produced outside of the region are different products no matter how similar the production methods and inputs. A

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<sup>398</sup> *Supra* note 3 at footnote 190.

<sup>399</sup> *Ibid* at circa footnote 194.

producer of a good not subject to a geographical indication may therefore maintain every aspect of production currently employed. The only required change is the name. A North American corporation such as Kraft produces ‘parmesan’ in North America where there is no geographical indication protection for the cheese. In Europe, Kraft is prohibited by the *Regulation* from using ‘parmesan’ but may continue to sell the same product it produces in North America. The only difference is that, in Europe, Kraft has been forced to rename the cheese and decided on ‘pamesello’. The company maintains brand value as the trademark ‘Kraft’ still appears on the pamesello package in Europe just as it appears on the parmesan package in North America and Kraft is increasing brand value in ‘pamesello’.

Industry expresses concern over the costs associated with marketing ‘new’ products. Arguments have been made that North American corporations operating in ‘Old World’ countries, whose registered geographical indications force the North American corporations to change branding strategies, lose significant amounts of money previously spent on marketing words such as ‘parmesan’ and are additionally required to spend more money marketing on new terms such as ‘pamesello’.<sup>400</sup> Two things should be pointed out in this conversation. First, that corporate advertising is not

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<sup>400</sup> *Supra* note 8 at 432 “an EU [European Union] win [in the area of GI protection] would create gridlock and confusion in U.S. supermarket aisles and force American companies to spend hundreds of millions repackaging and rebranding their products.”

“Parmesan cheese is not on the tip of everyone’s tongue because of anything anyone in Parma, Italy, ever did. It’s because dairy processors, led by Kraft, have spent tens of millions of dollars promoting this terminology so that the vast majority of Americans would put a can in their refrigerator.” *Supra* note 8 at 434.

merely for the product but rather for the corporation by advertising the corporation's product. Kraft has advertised *Kraft* parmesan, not merely parmesan. The requirement to 'replace' a product through the launch of a 'new product' product by Kraft does not imply that Kraft has necessarily lost brand value because the trademark 'Kraft' can be applied to the 'new product', 'pamesello', as it was to the 'parmesan'. Second, experience has shown that corporations such as Kraft can spread the costs of marketing a new product name by creating a certification mark of their own as in the case of 'Meritage' wine.<sup>401</sup>

The Meritage Alliance is a group of American vintners who created their own version of wine blended from the Bordeaux varieties.<sup>402</sup> The term 'Meritage' was invented by combining 'merit' and 'heritage'.<sup>403</sup> The creation of 'Meritage' allows North American vintners to produce 'Bordeaux-style' wine without infringing the 'Bordeaux' geographical indication held by a region in France. Indeed, Meritage may given its own reputation for excellence and surpass Bordeaux in popularity with consumers. Moreover, if demand increases for Meritage, supply can be created from anywhere in the world, whereas if demand for Bordeaux increases, then demand can only be satisfied if it is possible to increase supply from within the Bordeaux region of France. An example of this supply constraint for geographical indication is that France has increased the 'champagne' region at least three times in the 20<sup>th</sup> Century.

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<sup>401</sup> Meritage Producers: <http://www.meritagealliance.com/our-story>

<sup>402</sup> *ibid.*

<sup>403</sup> *ibid.*

In the *World Trade Organization Dispute*, the United States and Australia objected to the European Communities' *Regulation* allowing a registered trademark to coexist with a geographical indication registered after the trademark existed.<sup>404</sup> The United States and Australia alleged that the *Regulation* violated Article 16.1 of the *TRIPS Agreement* "because it [the *Regulation*] does not ensure that a trademark owner may prevent uses of GIs [geographical indications] which would result in a likelihood of confusion with a prior trademark."<sup>405</sup> As discussed in Chapter 3, The European Communities successfully argued that the coexistence of geographical indications and trademarks in its regulation was a 'fair use of descriptive terms' under Article 17 of the *TRIPS Agreement*.<sup>406</sup>

As trademarks and geographical indications are unique devices that are not interchangeable and it is possible for legislation to simultaneously protect both, then trademarks and geographical indications are not in conflict and can instead be viewed as harmonious tools.

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<sup>404</sup> See discussion in Chapter 3.

<sup>405</sup> *Supra* note 35 [*EC-US Report*] at para 7.512. The claim only concerns valid prior trademarks, not trademarks liable to invalidation because they lack distinctiveness or mislead consumers as to the origin of goods.

<sup>406</sup> *Supra* note 55 at footnote 13 "except for cases when prior trade marks are very well known."

**Appendix A**

**Council Regulation (EEC) no 2081/92**

**of July 1992**

This document is meant purely as a documentation tool and the institutions do not assume any liability for its contents

► **B****COUNCIL REGULATION (EEC) No 2081/92****of 14 July 1992****on the protection of geographical indications and designations of origin for agricultural products and foodstuffs**

(OJ L 208, 24.7.1992, p. 1)

Amended by:

	Official Journal		
	No	page	date
► <b><u>M1</u></b> Council Regulation (EC) No 535/97 of 17 March 1997	L 83	3	25.3.1997
► <b><u>M2</u></b> Commission Regulation (EC) No 1068/97 of 12 June 1997	L 156	10	13.6.1997
► <b><u>M3</u></b> Commission Regulation (EC) No 2796/2000 of 20 December 2000	L 324	26	21.12.2000
► <b><u>M4</u></b> Council Regulation (EC) No 692/2003 of 8 April 2003	L 99	1	17.4.2003
► <b><u>M5</u></b> Council Regulation (EC) No 806/2003 of 14 April 2003	L 122	1	16.5.2003

Amended by:

► <b><u>A1</u></b> Act of Accession of Austria, Sweden and Finland	C 241	21	29.8.1994
(adapted by Council Decision 95/1/EC, Euratom, ECSC)	L 1	1	1.1.1995
► <b><u>A2</u></b> Act concerning the conditions of accession of the Czech Republic, the Republic of Estonia, the Republic of Cyprus, the Republic of Latvia, the Republic of Lithuania, the Republic of Hungary, the Republic of Malta, the Republic of Poland, the Republic of Slovenia and the Slovak Republic and the adjustments to the Treaties on which the European Union is founded	L 236	33	23.9.2003



**COUNCIL REGULATION (EEC) No 2081/92**

**of 14 July 1992**

**on the protection of geographical indications and designations of origin for agricultural products and foodstuffs**

THE COUNCIL OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Economic Community, and in particular Article 43,

Having regard to the proposal from the Commission <sup>(1)</sup>,

Having regard to the opinion of the European Parliament <sup>(2)</sup>,

Having regard to the opinion of the Economic and Social Committee <sup>(3)</sup>,

Whereas the production, manufacture and distribution of agricultural products and foodstuffs play an important role in the Community economy;

Whereas, as part of the adjustment of the common agricultural policy the diversification of agricultural production should be encouraged so as to achieve a better balance between supply and demand on the markets; whereas the promotion of products having certain characteristics could be of considerable benefit to the rural economy, in particular to less-favoured or remote areas, by improving the incomes of farmers and by retaining the rural population in these areas;

Whereas, moreover, it has been observed in recent years that consumers are tending to attach greater importance to the quality of foodstuffs rather than to quantity; whereas this quest for specific products generates a growing demand for agricultural products or foodstuffs with an identifiable geographical origin;

Whereas in view of the wide variety of products marketed and of the abundance of information concerning them provided, consumers must, in order to be able to make the best choice, be given clear and succinct information regarding the origin of the product;

Whereas the labelling of agricultural products and foodstuffs is subject to the general rules laid down in Council Directive 79/112/EEC of 18 December 1978 on the approximation of the laws of the Member States relating to the labelling, presentation and advertising of foodstuffs <sup>(4)</sup>; whereas, in view of their specific nature, additional special provisions should be adopted for agricultural products and foodstuffs from a specified geographical area;

Whereas the desire to protect agricultural products or foodstuffs which have an identifiable geographical origin has led certain Member States to introduce 'registered designations of origin'; whereas these have proved successful with producers, who have secured higher incomes in return for a genuine effort to improve quality, and with consumers, who can purchase high quality products with guarantees as to the method of production and origin;

Whereas, however, there is diversity in the national practices for implementing registered designations or origin and geographical indications; whereas a Community approach should be envisaged; whereas a framework of Community rules on protection will permit the development of geographical indications and designations of origin since, by providing a more uniform approach, such a framework will ensure fair competition between the producers of products bearing such indications and enhance the credibility of the products in the consumers' eyes;

<sup>(1)</sup> OJ No C 30, 6. 2. 1991, p. 9 and OJ No C 69, 18. 3. 1992, p. 15.

<sup>(2)</sup> OJ No C 326, 16. 12. 1991, p. 35.

<sup>(3)</sup> OJ No C 269, 14. 10. 1991, p. 62.

<sup>(4)</sup> OJ No L 33, 8. 2. 1979, p. 1. Last amended by Directive 91/72/EEC (OJ No L 42, 15. 2. 1991, p. 27).

**▼B**

Whereas the planned rules should take account of existing Community legislation on wines and spirit drinks, which provide for a higher level of protection;

Whereas the scope of this Regulation is limited to certain agricultural products and foodstuffs for which a link between product or foodstuff characteristics and geographical origin exists; whereas, however, this scope could be enlarged to encompass other products or foodstuffs;

Whereas existing practices make it appropriate to define two different types of geographical description, namely protected geographical indications and protected designations of origin;

Whereas an agricultural product or foodstuff bearing such an indication must meet certain conditions set out in a specification;

Whereas to enjoy protection in every Member State geographical indications and designations of origin must be registered at Community level; whereas entry in a register should also provide information to those involved in trade and to consumers;

Whereas the registration procedure should enable any person individually and directly concerned in a Member State to exercise his rights by notifying the Commission of his opposition;

Whereas there should be procedures to permit amendment of the specification, after registration, in the light of technological progress or withdrawal from the register of the geographical indication or designation of origin of an agricultural product or foodstuff if that product or foodstuff ceases to conform to the specification on the basis of which the geographical indication or designation of origin was granted;

Whereas provision should be made for trade with third countries offering equivalent guarantees for the issue and inspection of geographical indications or designations of origin granted on their territory;

Whereas provision should be made for a procedure establishing close cooperation between the Member States and the Commission through a Regulatory Committee set up for that purpose,

HAS ADOPTED THIS REGULATION:

*Article 1*

**▼M4**

1. This Regulation lays down rules on the protection of designations of origin and geographical indications of agricultural products intended for human consumption referred to in Annex I to the Treaty and of the foodstuffs referred to in Annex I to this Regulation and the agricultural products referred to in Annex II to this Regulation.

However, this Regulation shall not apply to wine-sector products, except wine vinegars, or to spirit drinks. This paragraph shall be without prejudice to the application of Regulation (EC) No 1493/1999 on the common organisation of the market in wine.

Annexes I and II to this Regulation may be amended using the procedure specified in Article 15.

**▼B**

2. This Regulation shall apply without prejudice to other specific Community provisions.

3. Council Directive 83/189/EEC of 28 March 1983 laying down a procedure for the provision of information in the field of technical standards and regulations<sup>(1)</sup> shall not apply to the designations of origin and geographical indications covered by this Regulation.

<sup>(1)</sup> OJ No L 109, 26. 4. 1983, p. 8. Last amended by Decision 90/230/EEC (OJ No L 128, 18. 5. 1990, p. 15).



## ▼B

*Article 2*

1. Community protection of designations of origin and of geographical indications of agricultural products and foodstuffs shall be obtained in accordance with this Regulation.
2. For the purposes of this Regulation:
  - (a) *designation of origin*: means the name of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff:
    - originating in that region, specific place or country, and
    - the quality or characteristics of which are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors, and the production, processing and preparation of which take place in the defined geographical area;
  - (b) *geographical indication*: means the name of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff:
    - originating in that region, specific place or country, and
    - which possesses a specific quality, reputation or other characteristics attributable to that geographical origin and the production and/or processing and/or preparation of which take place in the defined geographical area.
3. Certain traditional geographical or non-geographical names designating an agricultural product or a foodstuff originating in a region or a specific place, which fulfil the conditions referred to in the second indent of paragraph 2 (a) shall also be considered as designations of origin.
4. By way of derogation from Article 2 (a), certain geographical designations shall be treated as designations of origin where the raw materials of the products concerned come from a geographical area larger than or different from the processing area, provided that:
  - the production area of the raw materials is limited,
  - special conditions for the production of the raw materials exist, and
  - there are inspection arrangements to ensure that those conditions are adhered to.
5. For the purposes of paragraph 4, only live animals, meat and milk may be considered as raw materials. Use of other raw materials may be authorized in accordance with the procedure laid down in Article 15.
6. In order to be eligible for the derogation provided for in paragraph 4, the designations in question may be or have already been recognized as designations of origin with national protection by the Member State concerned, or, if no such scheme exists, have a proven, traditional character and an exceptional reputation and renown.
7. In order to be eligible for the derogation provided for in paragraph 4, applications for registration must be lodged within two years of the entry into force of this Regulation. ►A1 In the case of Austria, Finland, and Sweden, the above period shall begin from the date of their accession. ◀ ►A2 In the case of the Czech Republic, Estonia, Cyprus, Latvia, Lithuania, Hungary, Malta, Poland, Slovenia and Slovakia the above period shall begin from the date of their accession. ◀

*Article 3*

1. Names that have become generic may not be registered.

For the purposes of this Regulation, a ‘name that has become generic’ means the name of an 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.

**▼B**

To establish whether or not a name has become generic, account shall be taken of all factors, in particular:

- the existing situation in the Member State in which the name originates and in areas of consumption,
- the existing situation in other Member States,
- the relevant national or Community laws.

Where, following the procedure laid down in Articles 6 and 7, an application of registration is rejected because a name has become generic, the Commission shall publish that decision in the *Official Journal of the European Communities*.

2. A name may not be registered as a designation of origin or a geographical indication where it conflicts with the name of a plant variety or an animal breed and as a result is likely to mislead the public as to the true origin of the product.

3. Before the entry into force of this Regulation, the Council, acting by a qualified majority on a proposal from the Commission, shall draw up and publish in the *Official Journal of the European Communities* a non-exhaustive, indicative list of the names of agricultural products or foodstuffs which are within the scope of this Regulation and are regarded under the terms of paragraph 1 as being generic and thus not able to be registered under this Regulation.

*Article 4*

1. To be eligible to use a protected designation of origin (PDO) or a protected geographical indication (PGI) an agricultural product or foodstuff must comply with a specification.

2. The product specification shall include at least:

- (a) the name of the agricultural product or foodstuffs, including the designation of origin or the geographical indication;
- (b) a description of the agricultural product or foodstuff including the raw materials, if appropriate, and principal physical, chemical, microbiological and/or organoleptic characteristics of the product or the foodstuff;
- (c) the definition of the geographical area and, if appropriate, details indicating compliance with the requirements in Article 2 (4);
- (d) evidence that the agricultural product or the foodstuff originates in the geographical area, within the meaning of Article 2 (2) (a) or (b), whichever is applicable;

**▼M4**

- (e) a description of the method of obtaining the agricultural product or foodstuff and, if appropriate, the authentic and unvarying local methods as well as information concerning the packaging, if the group making the request determines and justifies that the packaging must take place in the limited geographical area to safeguard quality, ensure traceability or ensure control;

**▼B**

- (f) the details bearing out the link with the geographical environment or the geographical origin within the meaning of Article 2 (2) (a) or (b), whichever is applicable;
- (g) details of the inspection structures provided for in Article 10;
- (h) the specific labelling details relating to the indication PDO or PGI, whichever is applicable, or the equivalent traditional national indications;
- (i) any requirements laid down by Community and/or national provisions.

*Article 5*

1. Only a group or, subject to certain conditions to be laid down in accordance with the procedure provided for in Article 15, a natural or legal person, shall be entitled to apply for registration.

**▼B**

For the purposes of this Article, ‘Group’ means any association, irrespective of its legal form or composition, of producers and/or processors working with the same agricultural product or foodstuff. Other interested parties may participate in the group.

2. A group or a natural or legal person may apply for registration only in respect of agricultural products or foodstuffs which it produces or obtains within the meaning of Article 2 (2) (a) or (b).
3. The application for registration shall include the product specification referred to in Article 4.
4. The application shall be sent to the Member State in which the geographical area is located.
5. The Member State shall check that the application is justified and shall forward the application, including the product specification referred to in Article 4 and other documents on which it has based its decision, to the Commission, if it considers that it satisfies the requirements of this Regulation.

**▼M1**

That Member State may, on a transitional basis only, grant on the national level a protection in the sense of the present Regulation to the name forwarded in the manner prescribed, and, where appropriate, an adjustment period, as from the date of such forwarding; these may also be granted transitionally subject to the same conditions in connection with an application for the amendment of the product specification.

Such transitional national protection shall cease on the date on which a decision on registration under this Regulation is taken. When that decision is taken, a period of up to five years may be allowed for adjustment, on condition that the undertakings concerned have legally marketed the products in question, using the names concerned continuously, for at least five years prior to the date of the publication provided for in Article 6 (2).

The consequences of such national protection, where a name is not registered under this Regulation, shall be the sole responsibility of the Member State concerned.

The measures taken by Member States under the second subparagraph shall produce effects at national level only; they shall have no effect on intra-Community trade.

**▼M4**

If the application concerns a name that also designates a border geographical area, or a traditional name connected to that geographical area, situated in another Member State or in a third country recognised under the procedure provided for in Article 12(3), the Member State to which the application was sent shall consult the Member State or the third country concerned before transmitting the application.

If, following consultations, the groups or natural or legal persons from the States concerned agree on an overall solution, the States concerned may submit a joint application for registration to the Commission.

Specific provisions may be adopted by the procedure laid down in Article 15.

**▼B**

6. Member States shall introduce the laws, regulations and administrative provisions necessary to comply with this Article.

*Article 6*

1. Within a period of six months the Commission shall verify, by means of a formal investigation, whether the registration application includes all the particulars provided for in Article 4.

The Commission shall inform the Member State concerned of its findings.

**▼M4**

The Commission shall make public any application for registration, stating the date on which the application was made.

**▼B**

2. If, after taking account of paragraph 1, the Commission concludes that the name qualifies for protection, it shall publish in the *Official Journal of the European Communities* the name and address of the applicant, the name of the product, the main points of the application, the references to national provisions governing the preparation, production or manufacture of the product and, if necessary, the grounds for its conclusions.

3. If no statement of objections is notified to the Commission in accordance with Article 7, the name shall be entered in a register kept by the Commission entitled 'Register of protected designations of origin and protected geographical indications', which shall contain the names of the groups and the inspection bodies concerned.

4. The Commission shall publish in the *Official Journal of the European Communities*:

- the names entered in the Register,
- amendments to the Register made in accordance with Article 9 and 11.

5. If, in the light of the investigation provided for in paragraph 1, the Commission concludes that the name does not qualify for protection, it shall decide, in accordance with the procedure provided for in Article 15, not to proceed with the publication provided for in paragraph 2 of this Article.

Before publication as provided for in paragraphs 2 and 4 and registration as provided for in paragraph 3, the Commission may request the opinion of the Committee provided for in Article 15.

**▼M4**

6. If the application concerns a homonym of an already registered name from the European Union or a third country recognised in accordance with the procedure in Article 12(3), the Commission may request the opinion of the Committee provided for in Article 15 prior to registration under paragraph 3 of this Article.

A homonymous name meeting the requirements of this Regulation shall be registered with due regard for local and traditional usage and the actual risk of confusion, in particular:

- a homonymous name which misleads the public into believing that products come from another territory shall not be registered even if the name is accurate as far as its wording is concerned for the actual territory, region or place of origin of the agricultural products or foodstuffs in question;
- the use of a registered homonymous name shall be subject to there being a clear distinction in practice between the homonym registered subsequently and the name already on the register, having regard to the need to treat the producers concerned in an equitable manner and not to mislead consumers.

**▼B***Article 7*

1. Within six months of the date of publication in the *Official Journal of the European Communities* referred to in Article 6 (2), any Member State may object to the registration.

2. The competent authorities of the Member States shall ensure that all persons who can demonstrate a legitimate economic interest are authorized to consult the application. In addition and in accordance with the existing situation in the Member States, the Member States may provide access to other parties with a legitimate interest.

3. Any legitimately concerned natural or legal person may object to the proposed registration by sending a duly substantiated statement to the competent authority of the Member State in which he resides or is

**▼B**

established. The competent authority shall take the necessary measures to consider these comments or objection within the deadlines laid down.

4. A statement of objection shall be admissible only if it:

— either shows non-compliance with the conditions referred to in Article 2,

**▼M1**

— shows that the registration of the name proposed would jeopardize the existence of an entirely or partly identical name or of a mark or the existence of products which have been legally on the market for at least five years preceding the date of the publication provided for in Article 6 (2).

**▼B**

— or indicates the features which demonstrate that the name whose registration is applied for is generic in nature.

5. Where an objection is admissible within the meaning of paragraph 4, the Commission shall ask the Member States concerned to seek agreement among themselves in accordance with their internal procedures within three months. If:

(a) agreement is reached, the Member States in question shall communicate to the Commission all the factors which made agreement possible together with the applicant's opinion and that of the objector. Where there has been no change to the information received under Article 5, the Commission shall proceed in accordance with Article 6 (4). If there has been a change, it shall again initiate the procedure laid down in Article 7;

(b) no agreement is reached, the Commission shall take a decision in accordance with the procedure laid down in Article 15, having regard to traditional fair practice and of the actual likelihood of confusion. Should it decide to proceed with registration, the Commission shall carry out publication in accordance with Article 6 (4).

*Article 8*

The indications PDO, PGI or equivalent traditional national indications may appear only on agricultural products and foodstuffs that comply with this Regulation.

*Article 9*

The Member State concerned may request the amendment of a specification, in particular to take account of developments in scientific and technical knowledge or to redefine the geographical area.

The Article 6 procedure shall apply *mutatis mutandis*.

The Commission may, however, decide, under the procedure laid down in Article 15, not to apply the Article 6 procedure in the case of a minor amendment.

*Article 10*

1. Member States shall ensure that not later than six months after the entry into force of this Regulation inspection structures are in place, the function of which shall be to ensure that agricultural products and foodstuffs bearing a protected name meet the requirements laid down in the specifications. ►**A1** In the case of Austria, Finland and Sweden, the above period shall begin from the date of their accession. ◀  
►**A2** In the case of the Czech Republic, Estonia, Cyprus, Latvia, Lithuania, Hungary, Malta, Poland, Slovenia and Slovakia the above period shall begin from the date of their accession. ◀

2. An inspection structure may comprise one or more designated inspection authorities and/or private bodies approved for that purpose by the Member State. Member States shall send the Commission lists of the authorities and/or bodies approved and their respective powers.

**▼B**

The Commission shall publish those particulars in the *Official Journal of the European Communities*.

3. Designated inspection authorities and/or approved private bodies must offer adequate guarantees of objectivity and impartiality with regard to all producers or processors subject to their control and have permanently at their disposal the qualified staff and resources necessary to carry out inspection of agricultural products and foodstuffs bearing a protected name.

If an inspection structure uses the services of another body for some inspections, that body must offer the same guarantees. In that event the designated inspection authorities and/or approved private bodies shall, however, continue to be responsible *vis-à-vis* the Member State for all inspections.

As from 1 January 1998, in order to be approved by the Member States for the purpose of this Regulation, private bodies must fulfil the requirements laid down in standard EN 45011 of 26 June 1989.

**▼M4**

The standard or the applicable version of standard EN 45011, whose requirements private bodies must fulfil for approval purposes, shall be established or amended in accordance with the procedure laid down in Article 15.

The equivalent standard or the applicable version of the equivalent standard in the case of third countries recognised pursuant to Article 12(3), whose requirements private bodies must fulfil for approval purposes, shall be established or amended in accordance with the procedure laid down in Article 15.

**▼B**

4. If a designated inspection authority and/or private body in a Member State establishes that an agricultural product or a foodstuff bearing a protected name of origin in that Member State does not meet the criteria of the specification, they shall take the steps necessary to ensure that this Regulation is complied with. They shall inform the Member State of the measures taken in carrying out their inspections. The parties concerned must be notified of all decisions taken.

5. A Member State must withdraw approval from an inspection body where the criteria referred to in paragraphs 2 and 3 are no longer fulfilled. It shall inform the Commission, which shall publish in the *Official Journal of the European Communities* a revised list of approved bodies.

6. The Member States shall adopt the measures necessary to ensure that a producer who complies with this Regulation has access to the inspection system.

7. The costs of inspections provided for under this Regulation shall be borne by the producers using the protected name.

*Article 11*

1. Any Member State may submit that a condition laid down in the product specification of an agricultural product or foodstuff covered by a protected name has not been met.

2. The Member State referred to in paragraph 1 shall make its submission to the Member State concerned. The Member State concerned shall examine the complaint and inform the other Member State of its findings and of any measures taken.

3. In the event of repeated irregularities and the failure of the Member States concerned to come to an agreement, a duly substantiated application must be sent to the Commission.

4. The Commission shall examine the application by consulting the Member States concerned. Where appropriate, having consulted the committee referred to in Article 15, the Commission shall take the necessary steps. These may include cancellation of the registration.

**▼B**

►**M4** Notice of cancellation shall be published in the *Official Journal of the European Union*. ◀

**▼M4***Article 11a*

In accordance with the procedure laid down in Article 15, the Commission may cancel the registration of a name in the following cases:

- (a) Where the State which submitted the original application for registration checks that a request for cancellation, submitted by the group or by a natural or legal person concerned, is justified and forwards it to the Commission.
- (b) For well-founded reasons, where compliance with the specifications laid down for an agricultural product or a foodstuff bearing a protected name can no longer be ensured.

Specific provisions may be adopted by the procedure laid down in Article 15.

Notice of cancellation shall be published in the *Official Journal of the European Union*.

**▼B***Article 12*

1. Without prejudice to international agreements, this Regulation may apply to an agricultural product or foodstuff from a third country provided that:

— the third country is able to give guarantees identical or equivalent to those referred to in Article 4,

**▼M4**

— the third country concerned has inspection arrangements and a right to objection equivalent to those laid down in this Regulation,

**▼B**

— the third country concerned is prepared to provide protection equivalent to that available in the Community to corresponding agricultural products for foodstuffs coming from the Community.

2. If a protected name of a third country is identical to a Community protected name, registration shall be granted with due regard for local and traditional usage and the practical risks of confusion.

Use of such names shall be authorized only if the country of origin of the product is clearly and visibly indicated on the label.

**▼M4**

3. The Commission shall examine, at the request of the country concerned, and in accordance with the procedure laid down in Article 15 whether a third country satisfies the equivalence conditions and offers guarantees within the meaning of paragraph 1 as a result of its national legislation. Where the Commission decision is in the affirmative, the procedure set out in Article 12a shall apply.

*Article 12a*

1. In the case provided for in Article 12(3), if a group or a natural or legal person as referred to in Article 5(1) and (2) in a third country wishes to have a name registered under this Regulation it shall send a registration application to the authorities in the country in which the geographical area is located. Applications must be accompanied by the specification referred to in Article 4 for each name.

If the application concerns a name that also designates a border geographical area or a traditional name connected to that geographical area in a Member State, the third country to which the application was sent shall consult the Member State concerned before transmitting the application.

▼ **M4**

If, following consultations, the groups or natural or legal persons from the States concerned agree on an overall solution, the said States may submit a joint application for registration to the Commission.

Specific provisions may be adopted by the procedure laid down in Article 15.

2. If the third country referred to in paragraph 1 deems the requirements of this Regulation to be satisfied it shall transmit the registration application to the Commission accompanied by:

- (a) a description of the legal provisions and the usage on the basis of which the designation of origin or the geographical indication is protected or established in the country,
- (b) a declaration that the structures provided for in Article 10 are established on its territory, and
- (c) other documents on which it has based its assessment.

3. The application and all documents forwarded to the Commission shall be in one of the official Community languages or accompanied by a translation into one of the official Community languages.

*Article 12b*

1. The Commission shall verify within six months whether the registration request sent by the third country contains all the necessary elements and shall inform the country concerned of its conclusions.

If the Commission:

- (a) concludes that the name satisfies the conditions for protection, it shall publish the application in accordance with Article 6(2). Prior to publication the Commission may ask the Committee provided for in Article 15 for its opinion;
- (b) concludes that the name does not satisfy the conditions for protection, it shall decide, after consulting the country having transmitted the application, in accordance with the procedure provided for in Article 15, not to proceed with publication as provided for in (a).

2. Within six months of the date of publication as provided for in paragraph 1(a), any natural or legal person with a legitimate interest may object to the application published in accordance with paragraph 1(a) on the following terms:

- (a) where the objection comes from a Member State of the European Union or a WTO member, Article 7(1), (2) and (3) or Article 12d respectively shall apply;
- (b) where the objection comes from a third country meeting the equivalence conditions of Article 12(3), a duly substantiated statement of objection shall be addressed to the country in which the abovementioned natural or legal person resides or is established, which shall forward it to the Commission.

The statement of objection and all documents forwarded to the Commission shall be in one of the official Community languages or accompanied by a translation into one of the official Community languages.

3. The Commission shall examine admissibility in accordance with the criteria set out in Article 7(4). Those criteria must be demonstrated in regard to the territory of the Community. Where one or more objections are admissible the Commission shall adopt a decision in accordance with the procedure laid down in Article 15 after consulting the country which transmitted the application, taking account of traditional and fair usage and the actual risk of confusion on Community territory. If the decision is to proceed with registration the name shall be entered in the register provided for in Article 6(3) and published in accordance with Article 6(4).

4. If the Commission receives no statement of objection it shall enter the name(s) in question in the register provided for in Article 6(3) and publish the name(s) as provided for in Article 6(4).



▼ **M4***Article 12c*

The group or natural or legal person referred to in Article 5(1) and (2) may request amendment of the specification for a name registered under Articles 12a and 12b, in particular to take account of the development of scientific and technical knowledge or to revise the geographical zone.

The procedure in accordance with Articles 12a and 12c shall apply.

However, the Commission may decide, in accordance with the Article 15 procedure, not to apply the procedure provided for in Articles 12a and 12b if the amendment is of a minor nature.

*Article 12d*

1. Within six months of the date of the notice in the *Official Journal of the European Union* specified in Article 6(2) relating to a registration application submitted by a Member State, any natural or legal person that has a legitimate interest and is from a WTO member country or a third country recognised under the procedure provided for in Article 12(3) may object to the proposed registration by sending a duly substantiated statement to the country in which it resides or is established, which shall transmit it, made out or translated into a Community language, to the Commission. Member States shall ensure that any person from a WTO member country or a third country recognised under the procedure provided for in Article 12(3) who can demonstrate a legitimate economic interest is authorised to consult the application.

2. The Commission shall examine the admissibility of objections in accordance with the criteria laid down in Article 7(4). These criteria must be proved and assessed with regard to the territory of the Community.

3. If an objection is admissible the Commission shall, after consulting the country that transmitted the objection, adopt a decision using the procedure specified in Article 15, taking account of traditional and fair usage and the actual risk of confusion. If the decision is to proceed with registration, publication shall be made in accordance with Article 6(4).

▼ **B***Article 13*

1. Registered names shall be protected against:

- (a) any direct or indirect commercial use of a name registered in respect of products not covered by the registration in so far as those products are comparable to the products registered under that name or insofar as using the name exploits the reputation of the protected name;
- (b) any misuse, imitation or evocation, even if the true origin of the product is indicated or if the protected name is translated or accompanied by an expression such as 'style', 'type', 'method', 'as produced in', 'imitation' or similar;
- (c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product, on the inner or outer packaging, advertising material or documents relating to the product concerned, and the packing of the product in a container liable to convey a false impression as to its origin;
- (d) any other practice liable to mislead the public as to the true origin of the product.

Where a registered name contains within it the name of an agricultural product or foodstuff which is considered generic, the use of that generic name on the appropriate agricultural product or foodstuff shall not be considered to be contrary to (a) or (b) in the first subparagraph.

**▼M4****▼B**

3. Protected names may not become generic.

**▼M4**

4. In the case of names for which registration has been applied for under Article 5 or Article 12a, provision may be made for a maximum transitional period of five years under Article 7(5)(b) or under Article 12b(3) or Article 12d(3), solely where a statement of objection has been declared admissible on the ground that the registration of the proposed name would jeopardise the existence of an entirely or partly homonymous name or the existence of products which have been legally on the market for at least five years preceding the date of the publication provided for in Article 6(2).

Such transitional period may be provided for only where undertakings have legally marketed the products in question by using the names in question continuously for at least five years preceding the date of the publication provided for in Article 6(2).

5. Without prejudice to the application of Article 14, the Commission may decide to allow, under the procedure provided for in Article 15, the coexistence of a registered name and an unregistered name designating a place in a Member State or in a third country recognised under the procedure provided for in Article 12(3) where that name is identical to the registered name, provided that the following conditions are met:

- the identical unregistered name has been in legal use consistently and equitably for at least 25 years prior to the entry into force of Regulation (EEC) No 2081/92, and
- it is shown that the purpose of its use has not at any time been to profit from the reputation of the registered name and that the public has not been nor could be misled as to the true origin of the product, and
- the problem resulting from the identical names was raised before registration of the name.

The registered name and the identical unregistered name concerned may co-exist for a period not exceeding a maximum of fifteen years, after which the unregistered name shall cease to be used.

Use of the unregistered geographical name concerned shall be authorised only where the country of origin is clearly and visibly indicated on the label.

**▼B***Article 14***▼M4**

1. Where a designation of origin or geographical indication is registered under this Regulation, any application for registration of a trademark that is for a product of the same type and use of which will engender one of the situations indicated in Article 13 shall be refused if made after the date of submission to the Commission of the application for registration of the designation of origin or geographical indication.

Trademarks registered in breach of the first subparagraph shall be invalidated.

2. With due regard to Community law, a trademark the use of which engenders one of the situations indicated in Article 13 and which has been applied for, registered, or established by use, if that possibility is provided for by the legislation concerned, in good faith within the territory of the Community, before either the date of protection in the country of origin or the date of submission to the Commission of the application for registration of the designation of origin or geographical indication, may continue to be used notwithstanding the registration of a designation of origin or geographical indication, provided that no grounds for its invalidity or revocation exist as specified by Council Directive 89/104/EEC of 21 December 1998 to approximate the laws

**▼M4**

of the Member States relating to trade marks <sup>(1)</sup> and/or Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark <sup>(2)</sup>.

**▼B**

3. A designation of origin or geographical indication shall not be registered where, in the light of a trade mark's reputation and renown and the length of time it has been used, registration is liable to mislead the consumer as to the true identity of the product.

**▼M5***Article 15*

1. The Commission shall be assisted by a committee.
2. Where reference is made to this Article, Articles 5 and 7 of Decision 1999/468/EC <sup>(3)</sup> shall apply.

The period laid down in Article 5(6) of Decision 1999/468/EC shall be set at three months.

3. The Committee shall adopt its Rules of Procedure.

**▼B***Article 16*

Detailed rules for applying this Regulation shall be adopted in accordance with the procedure laid down in Article 15.

**▼M4****▼B***Article 18*

This Regulation shall enter into force twelve months after the date of its publication in the *Official Journal of the European Communities*.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

<sup>(1)</sup> OJ L 40, 11.2.1989, p. 1.

<sup>(2)</sup> OJ L 11, 14.1.1994, p. 1.

<sup>(3)</sup> OJ L 184, 17.7.1999, p. 23.

▼ **M4**

*ANNEX I*

Foodstuffs referred to in Article 1(1):

- Beer
- Beverages made from plant extracts
- Bread, pastry, cakes, confectionery and other baker's wares
- Natural gums and resins
- Mustard paste
- Pasta.

▼ **M4**

*ANNEX II*

Agricultural products referred to in Article 1(1)

- Hay
- Essential oils
- Cork
- Cochineal (raw product of animal origin)
- Flowers and ornamental plants
- Wool
- Osier.

## Appendix B

**Search Terms: 'trademark' and 'brand'**  
**Database: Business Source Complete**

**Search Date: April 14, 2012**

### Citation

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## Appendix C

Search Terms: 'trademark' and 'brand'  
 Database: ABI/INFORM Global

Search Date: April 14, 2012

### Citation

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**Search Terms: 'trademark' and 'brand'**  
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## Appendix C

**Search Terms: 'trademark' and 'brand'**  
**Database: ABI/INFORM Global**

**Search Date: April 14, 2012**

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**Search Terms: 'trademark' and 'brand'**  
**Database: ABI/INFORM Global**

**Search Date: April 14, 2012**

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**Search Terms: 'trademark' and 'brand'**  
**Database: ABI/INFORM Global**

**Search Date: April 14, 2012**

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Search Terms: 'trademark' and 'brand'  
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## Appendix C

Search Terms: 'trademark' and 'brand'  
 Database: ABI/INFORM Global

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## Appendix C

Search Terms: 'trademark' and 'brand'  
Database: ABI/INFORM Global

Search Date: April 14, 2012

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## Appendix C

Search Terms: 'trademark' and 'brand'  
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## Appendix D

Search Terms: 'geographical indication' and 'brand'

Search Date: April 14, 2012

Database: ABI/INFORM Global

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## Appendix E

Search Terms: 'geographical indication' and 'brand'

Search Date: April 14, 2012

Database: Business Source Complete

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Post-secondary Education and Degrees: Carleton University  
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Academic year 2004-2005 (International Exchange)

University of Western Ontario  
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2006-2009 J.D. (Juris Doctor with a concentration in Intellectual Property, Information and Technology Law)

Academic Awards Recipient of the President's Scholarship (2002)

Recipient of the E.W.R. Steacie Scholarship (2003)

Recipient of the WeirFoulds LLP Writing Prize (2008)

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Related Work Experience Called to the Ontario Bar: 2010

Summer Intern  
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