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Your guide to geographical indications worldwide

Managing IP asked correspondents in eight jurisdictions that provide some form of protection for GIs or their domestically named equivalent to address the key questions for brand owners

Australia

1

Availability

As a member of the WTO, Australia has numerous obligations under TRIPs in relation to the protection of GIs. In meeting these obligations, Australia relies on a combination of existing legislative provisions and the common law. Thus, with the exception of wine, there is no official register of GIs and protection is afforded where it is demonstrated that *use* of the term constitutes an act of unfair competition. This rule applies both to Australian and international products. With respect to wine, the relevant legislation is the Australian Wine and Brandy Corporation Act 1980 (Cth) (AWBC Act) which not only creates a procedure for determining GIs but also creates a specific register of protected names.

2

Scope of protection

Australia does not subscribe to a single GI protection regime. Accordingly, domestic or foreign parties alleging misuse of a GI are free to determine the most appropriate method of pursuing their claim. Legal avenues include:

- The Trade Practices Act 1974 (Cth) (TPA) which prevents misleading or deceptive conduct, including representations concerning the place of origin of goods.
- The Trademarks Act 1995 (Cth) (TA) which allows for registration of trade marks, including GIs as trade marks, if certain criteria are met.
- The common law tort of 'passing off' which: prohibits one entity from misrepresenting its goods as being the goods of another entity; and prohibits one entity from holding out its goods as having an association or connection with another entity when this is not true.
- The AWBC Act (as detailed above and considered further below).

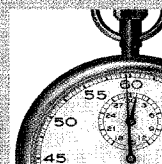
Further, the Australia New Zealand Food Standards Code imposes mandatory country of origin labelling requirements for certain foods and beverages. The code includes a standard in relation to spirits and specifies that "a geographical indication must not be used in relation to a spirit... unless the spirit has been produced in the country, locality or region indicated."

3

Listing

The AWBC Act creates a specific register – the Register of Protected Names (Register) – for wine products. The Register, which is available for viewing at www.wineaustralia.com, is maintained by a Registrar appointed under the AWBC Act. The Register is divided into eight parts and includes: details of GIs relating to wines manufactured in Australia (Section (a)); details of GIs relating to wines manufactured in an "agreement country" (Section (c)); and details of GIs relating to wines manufactured in foreign countries that are not agreement countries (Section (g)). The information in Section (a) of the Register is broken down into state/zone, region and sub-region and, collectively, there are over 119 entries in Section (a) of the Register. Section (c) of the Register details GIs relating to wines manufactured in an "agreement country". Australia has one such agreement in place – the Agreement between Australia and the European Community on Trade in Wine, and Protocol. Consequently the Register contains details of GIs originating in countries of the EC. There are no entries in Section (g) of the Register.

One-minute read



On October 30 and 31, WIPO and the National Institute of Industrial Property (INPI) of Portugal celebrated the 50th anniversary of the adoption of the Lisbon

Agreement for the Protection of Appellations of Origin and their International Registration.

An appellation of origin is a special kind of GI which 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. Notable examples of appellations of origin registered under the Lisbon system include Porto (Portugal), Habana (Cuba), Champagne (France), Tokay (Hungary), Prosciutto di Parma (Italy), Tequila (Mexico), Bohemia Crystal (Czech Republic) or Borjomi mineral water (Georgia). The concept of a GI encompasses appellations of origin. However, aside from the Lisbon Agreement (in which 26 states participate), there are no commonly accepted methods of protection worldwide. With the area fraught with complications.

Managing IP takes a timely look at this area of concern.

4 Registration

The GI Committee (established under the AWBC Act) is empowered to determine the names and boundaries of Australian GIs in relation to wines, based on either its own initiative or an application from a third party. In making an application, an applicant must specify the area and the name of the proposed GI together with any support material showing that the application satisfies the criteria detailed in the AWBC Act. The applicant must also pay an application fee of A\$5,500 (including GST). Upon receipt of an application, the GIC must consult with all declared winemakers' organisations and declared wine grape grower organisations. In addition, an application will not be considered until all relevant trade mark owners have been given the opportunity to object to the proposed GI. Following the consultation the GIC will publish an interim determination for comment. All comments are then considered by the GIC prior to it making a final determination. Following the GIC's final determination, interested parties have 28 days to apply to the Administrative Appeal Tribunal (ATT) for a review of the determination.

5 Conflicts

Registering trade marks containing a GI – the TA defines a trade mark as a sign, used or intended to be used, to distinguish goods provided in trade from other goods – a trade mark must be inherently distinctive. In contrast, a GI cannot be created merely by an intention to use the indication and also is not inherently distinctive. However, a trade mark may incorporate all or part of a GI. A trade mark incorporating all or part of a GI will only be registered if the applicant establishes that, because of the extent to which they have used the proposed trade mark prior to the filing date of the application, it distinguishes their specific product. While the TA does provide grounds for third parties to oppose a trade mark application (for instance, on the grounds that it contains or consists of a sign that is a GI), such an opposition will fail if, among other things, the applicant has used the proposed trade mark in good faith since before January 1 1996 or before the GI was registered (whichever is the earlier). A further factor to be considered is whether the proposed trade mark is likely to mislead or deceive consumers.

The AWBC Act provides that the owner of a trade mark

Questions on GIs

1 Availability: Are geographical indications protected in your jurisdiction? If so, how are they defined, who can apply and are they popular? If not, are there any plans to introduce protection?

2 Scope of protection: What protection is given to GIs and what rights does it provide? Is there any limit on goods/services that can be protected, how long does protection last and is it subject to renewal arrangements? Can foreign GIs be protected? If so, to what extent if at all does this differ to local GIs? Does it depend on local recognition of the GI, or on use – if the latter, in which territory?

3 Listing: Is there a list of GIs that are protected? Who keeps this list and how often is it updated? How many are listed today? Where is it available and is there a system for notifying the public of new applications?

4 Registration: What are the procedures for obtaining protection? Are any fees to be paid? What documents/evidence if any must be filed with the application? What are the criteria for registration? Can a GI be registered as a trade mark and if so in what circumstances? Is the registration office a department of an IP office or a department of agriculture?

5 Conflicts: What happens if there is a conflict between a trade mark and a GI? Are there any examples of such conflicts? What principles are applied to resolve issues of conflict between protected GIs and trade marks?

6 Challenges: In what circumstances can the registration of an existing protected GI be challenged? Does a GI acquire immunity from challenge after a period of time and if so what period? Do private third parties have a right to oppose registration? If so, what preconditions must third parties satisfy and what grounds of opposition are recognised?

7 Refusal: What grounds exist for refusal of registration? Do applicants for GIs have a right of appeal against refusal to register? What institution or body is responsible for determining appeals?

8 Enforcement: Who has standing to enforce rights in a GI? Is the enforcement process administrative or judicial? What enforcement remedies are available (e.g. injunctions, declarations, damages, account of profits etc.)?

may oppose a GI determination on the grounds that the trade mark is identical or confusingly similar to the proposed GI. Upon receiving such an objection, the Registrar of Trade Marks must decide whether or not the grounds for the objection are made out and may make a recommendation to the GIC in relation to the proposed determination. Any decision by the Registrar of Trade Marks can be appealed to the Federal Court. If a GI is registered then it places some limitation on the use of a prior registered trade mark incorporating the GI. For example, wine bearing the trade mark (and therefore also the GI) must contain a minimum percentage of wine made from grapes emanating from the relevant geographical area.

6 Challenges

Trade mark owners have the opportunity to object to a GI determination during the application process and thus have the capability of challenging the introduction of a GI – both via opposing the determination, and, if this is not initially successful, appealing any determination made by the GIC. Once determined, there are a limited number of ways to challenge a GI. However, a GI can be challenged on the grounds that it is no longer in use or no longer registered.

7 Refusal

The GIC will consider a large number of factors in determining a GI application. Such factors include the type of area, the history of the area, the existence of words used to indicate the particular area, whether the proposed GI is known to wine retailers beyond the boundaries of

the area and the homogeneity of the product produced in the area. Based on consideration of these factors, the GIC may refuse an application for a GI. In addition, trade mark owners have the right to oppose a GI determination. If a trade mark owner makes out its grounds for objection, the GIC may refuse a proposed GI. If an application for a proposed GI is refused, the applicant can appeal the determination to the ATT.

8 Enforcement

The Australian Wine and Brandy Corporation monitors wine industry compliance on the use of GIs for wine through its audit and export approval programmes. The AWBC Act also provides for a wide range of interested parties

to take action (such as seeking injunctions) to enforce GIs for wine. In addition, domestic or foreign parties alleging misuse of a GI are free to determine the most appropriate method of pursuing their claim – whether this is through pursuing a claim under relevant legislation such as the TPA or through the tort of passing off.



Greg Hipwell (left), partner, and Allison McLeod, lawyer, Deacons, Melbourne

Canada

1 Availability

In Canada, the Trade-marks Act (the Act) limits GIs to wines and spirits of a WTO member where quality, reputation or other characteristics of the wine or spirit is attributable to its geographic origin and is protected by the laws of the WTO member where it originates. Any responsible authority in relation to the wine or spirit may seek to have the applicable GI included on a list of GIs that is kept by the Registrar of Trade-marks. There is no plan to increase protection for GIs in Canada beyond wines and spirits under the Act. However, Canada continues to participate in the worldwide debate with respect to increased protection for GIs. The definition of geographical indication found in the Trade-marks Act does not explicitly exclude products that are not wines or spirits as being GIs. However, in order to have a GI added to the list, a statement that the proposed GI identifies a wine or spirit is required. Hence, trade marks and certification marks are used to protect GIs concerning all other wares in Canada. Additional protection may be available through other Canadian laws and regulations, eg Cognac Brandy and Cognac are regulated under the Food and Drug Regulations.

2 Scope of protection

Once a GI for a wine or spirit has been entered on to the list and is therefore protected as a GI in Canada it may not be used in association with wines or spirits if it does not originate in the place indicated by the GI even absent consumer deception or unfair competition, a concept commonly referred to as “enhanced protection”. There is neither a time limitation nor a renewal period for GIs on the list. GI rights are limited in the following respects: (i) they cannot prevent a person from using their own name (except where the name is used in a manner as to mislead the public); (ii) if the GI is used in comparative advertising; (iii) or if the GI has been used by a Canadian in good faith before April 15 1994 or for at least 10 years before that date. Moreover, the Act provides specific lists of names that are considered to be generic for wine and spirits that may be adopted, used or registered as a trade mark or otherwise in connection with a business, eg Champagne, Porto. Protection for GIs through the use of certification marks is provided in Canada without restriction as to the type of product or service that is certified and which are identifiable by words and/or symbols used in association with goods and services that meet a defined standard; and may be licensed but not be used by their owners. In Canada, certification marks have been registered for such products as Stilton Cheese and

Parmigiano Reggiano Cheese, both of which are recognised as GIs in the EC. Certification marks are valid for a period of 15 years, and may be renewed upon the payment of the government fee of C\$350.

3 Listing

Section 11.12 of the Act creates a list of protected GIs, to be maintained by the Registrar. A complete list of GIs for wines and spirits is available on the Canadian Intellectual Property Office website. There are 545 GIs on the list, which was last modified on September 18 2008. Prior to being added to the list, requests are published in the *Canada Gazette* to notify the public of the request and to provide interested persons with an opportunity to object within three months to their addition.

4 Registration

Although GIs are administered by the Registrar, requests for protection of a GI are submitted to Agriculture and Agri-Food Canada care of the Canadian Intellectual Property Office. A request must include details of the GI such as whether the indication identifies a wine or a spirit, the WTO Member Territory where the wine or spirit is identified as originating (including a description and address), name of responsible authority (including address), reference to applicable law(s), description of the quality, reputation or other characteristic of the wine or spirit that is attributable to its geographical origin, and the date upon which the GI was officially recognised and protected in the WTO member territory. Additional information may also be provided, such as data on production, sales and historical exports to Canada, a copy of labels, and references in authoritative publications regarding the wine or spirit. A separate request must be submitted for each GI, including sub-regions of a GI, together with the government fee of C\$450.

5 Conflicts

To date, the majority of disputes relating to GIs in Canada have occurred as oppositions to trade mark applications or as expungement proceedings before the Registrar to applications for registration or registered marks that may include a GI. These decisions may be appealed to the Federal Court of Canada. In determining such disputes the main principle applied has been whether the average consumer would be misled by the mark with respect to the origin of its wares. In *Institut National des Appellations d'Origine v Pepperidge Farm, Inc* (1997) 84 CPR (3d) 540 (TMOB), the Opposition Board rejected the opposition against the word Bordeaux for cookies since it was unlikely that the average consumer would be misled into believing they originated in the Bordeaux region of France and were associated with Bourdeaux wine. In *Consorzio del Prosciutto di Parma v Maple Leaf Meats Inc* (2001) 11 CPR (4th) 48 (FCTD), the Federal Court dismissed the application for the expungement of Maple Leaf's Parma mark since the Consorzio was not able to prove that Parma was understood in Canada to signify meat products as originating from Parma, Italy. More recently, in *Scotch Whisky Association v Glenora Distillers International Ltd* (2008), 65 CPR (4th) 441, the Federal Court overturned a decision of the Opposition Board to allow an application for Glen Breton for single malt whisky made in Nova Scotia, Canada. On Appeal, the Federal Court found that confusion arose from the word “glen” and not from the fact that Glen Breton is a single malt whisky.

A view from the potato fields

Idaho Potato Commission's Patrick J Kole is a long-time member of INTA's GI Committee and a defender of the US certification mark system

"The certification mark system is certainly misunderstood," says Patrick J Kole. "The essence of it is that you're certifying something that has a particular quality. It conceptually says there are these standards to which you must measure up, so it is the third party verification that is important."

Protected under the US Federal Trademark Act, certification marks have not proven particularly popular in the US where there remains a degree of scepticism over the validity of a concept of geographical indication.

General counsel of state agency Idaho Potato Commission, Kole believes GIs are a way of enhancing value. "In the minds of the consumer it can create the perception of better value, which is an important marketing tool."

And he is convinced – based on enquiries he has received personally and the level of interest he has seen at INTA meetings – the number of applications for certification mark registration will soon rise as their value becomes better understood. "There is the beginning of a renaissance," he says.

The Idaho Potato Commission is tasked with many responsibilities, one of which is promotion of Idaho Potatoes. The Commission is funded by a tax levied on all Idaho-grown potatoes, and the funds generated are used to advertise, promote and do research to expand the markets for Idaho-grown potatoes.

While the Commission itself is celebrating 71 years of service, Kole himself has played a role



on INTA's GI Committee since the early 1990s – when there were very few certification mark holders who were members of INTA. "INTA was a place where you could achieve multiple objectives," he says.

Although a fan of the European GI system, he sees plenty of merit in the US certification mark system – which covers a broad range of goods and services (even agricultural products like Idaho potatoes).

"Nothing provides perfect protection," he says. "Under a trade mark regime, there are always grounds by which a trade mark can be cancelled. There are a lot of good points to

both the European GI system and the US trade mark system, and there is room to bring both systems in closer harmonisation."

INTA itself has proposed a middle-of-the-road compromise, which has been on the table for the last two years. But although the latest version received a pretty good airing at INTA's recent meeting in Berlin, there remain major disagreements over 30 to 40% of the proposals.

Kole says these will need to be ironed out. "Ideally you would have a multilateral register where you are

not required to go country-by-country and spend considerable amounts of money. It's a question of balancing the effectiveness with the cost."

But he adds that while there is a greater need for a thorough understanding of GIs, further development is unlikely in the short term. "Everything seems to be quite paralysed at the moment. We're just nearing the end of a long political campaign here in the US, and there has been the recent economic development. Once this all stabilises, it will make a huge difference and maybe this will move forward again."

6

Challenges

Once a GI is on the protected list, its use or misuse in Canada by a third party may be challenged by the responsible authority of the GI in court. A responsible authority, as defined by the Act, is a person or entity by reason of state or commercial interest that is sufficiently connected with the GI to be a party to the proceedings. Presumably GIs remain open to challenge at any time if a third party can find sufficient grounds for judicial review of the decision by the Registrar and can explain the delay in challenging the decision to add the GI to the list.

7

Refusal

Agriculture and Agri-Food Canada can refuse to add a GI to the protected list if the substantive evidentiary requirements, as previously discussed, are not met. The Act provides that a person may file a Statement of Objection within three months from the date of publication in the *Canada Gazette* of a statement detailing the GI that is to be added to the list. The sole ground that may be alleged in a Statement of Objection is that the indication is not a GI. The government fee is C\$1,000. The objector must demonstrate that the applied for indication is deceptively misdescriptive of a geographical locality. The Registrar is responsible for the admin-

istration of the objection procedure, which is similar to that of an opposition proceeding, with pleadings, evidence and a hearing and is vested with the authority to decide that the indication is not a GI or reject the objection. The decision of the Registrar may be appealed to the Federal Court of Canada within two months from the date of the decision.

8

Enforcement

GIs are to be enforced by their owners (the responsible authority). Enforcement may be either administrative or judicial. If the GI owner is enforcing its mark against an applied-for trade mark application they may launch an opposition proceeding as previously discussed. There are no cost consequences in these proceedings and each party must bear their own costs. If the GI owner believes that another individual is using a mark, trade name or word, then the GI may launch an action in the Federal Court of Canada to restrain that party and seek various remedies including injunctions, declarations, damages and/or an accounting of profits. Parties in these proceedings are subject to costs being awarded against them.

Keri AF Johnston, partner, and Andrea Long, associate, and Alpesh Patel, student-at-law, Johnston Wassenaar, Toronto

Chile

1 Availability

GIs and denominations of origin are protected by our legislation in title IX of law 19.039 concerning IP, in Supreme Decree 464 of the Ministry of Agriculture and 18.455 of the law of alcohol. Law 19.039 gives the following definition:

- a) It is understood by geographic indication that which identifies a product as originating from a country or from a region or locality of the national territory, when the quality, reputation or other characteristic of the same are imputed, fundamentally, to their geographic origin.
- b) It is understood as a denomination of origin that which identifies a product that originates from the country, from a region or from a locality of the national territory, when the quality, reputation or another characteristic of the same is imputed fundamentally to its geographic origin, taking into consideration also other natural and human factors that influence that characterization of the product.

Any person, natural or legal, can request the registration of a GI or a denomination of origin, as long as it represents a significant group of products, fabricants or artisans, whose fields or establishments of extraction, production, transformation or elaboration are to be found within the zone of delimitation established by the GI or denomination of origin requested and, that fulfil the other requirements indicated by the law. We could say that the GIs and denominations of origin have not reached a significant degree of popularity but, by all means, its recognition and importance have increased with time. Also recognition of a GI or denomination of origin can be requested by national, regional, provincial or communal authorities, when the GI or denominations of origin are located within its respective territories.

2 Scope of protection

The law gives owners of GIs and denominations of origin a civil action (compensation for damages), a criminal action (fine for malicious use) and a special protection akin to those of trade marks, when an expression that contains or is confusing with a denomination of origin or GI is attempted to be registered. The law gives owners a restricted and non-exclusive right to use. Owners cannot exercise faculties of disposition with regards to a GI or denomination of origin (transfer or tax) and they only have a right to an excluding use with regards to those that use GI or denomination of origin in an illicit manner. GIs and denominations of origin only protect wine-growing, agricultural or food products. Within these three, the greatest amount of protection falls generally over the first. Industrial and artisans' products that are not agricultural are accompanied by indications of origin. Services are not the object of protection in this field. The protection that is given by the registration of a GI or denomination of origin is unlimited, except in two cases: 1) that it is a foreign GI or denomination of origin and that it loses its quality as such in its country of origin; 2) that the nullity of the registration be declared. Despite this, registration must be modified when the circumstances indicated by the law change. GIs and denominations of origin can be registered in Chile but cannot be protected or they will lose their protection (if they

had any) when they cease being protected or fall into disuse in their country of origin.

3 Listing

The Department of Industrial Property is in charge of overseeing the registration of GIs and denominations of origin. It is updated every time a new registration is granted or a new GI or denomination of origin is recognised by international treaties or special laws. Every application is published in the official newspaper. There are six applications awaiting registration.

4 Registration

The procedure for registration consists in the presentation of an application before the Department of Industrial Property that must fulfil certain formal requirements established by law. The applications must be accompanied by: a technical study, elaborated by a competent professional that gives precedents in the sense of characteristics or qualities that are attributed to the product or exclusivity to its geographic origin; and a project of specific rules of use and control of the indication or requested denomination.

There is a registration fee of approximately \$220. For a GI or denomination of origin to be accepted by an authority, it must adjust to the definition established by the law and fulfill the requirements indicated in Art. 95 detailed below. Also, for the approval of a GI or denomination of origin relating to products of forestry, livestock and livestock development or agro-industry a favourable report from the Ministry of Agriculture is required, in accordance with the records supplied by the applicant.

A GI or denomination of origin will not have protection as such and will be registered as a trade mark when it has been used continuously by nationals or residents in the national territory to identify wines or spirits in Chile, in good faith, before April 15 1994 or for 10 years, as a minimum, before this date unless the contrary has been established by an international treaty ratified by Chile. When the Department of Industrial Property comes to the conviction that the co-existence between trade marks and GIs or denominations of origin, or of these among each other is possible, it will determine in its resolution the conditions in which the GIs or denominations of origin or trade marks are to be used, to avoid the induction of error or confusion of the consuming public.

When one or more of the products has a characteristic as a product of forestry, livestock and livestock development or agro-industry, the Department, in order to form its conviction regarding the possibility of co-existence, must request a report to the Ministry of Agriculture. The process or registration of a GI or a denomination of origin is subordinate to the knowledge or competence of the authority of industrial property. However, this endeavour is also given support to by the Ministry of Agriculture.

5 Conflicts

Regulation only exists from the trade mark perspective; in the sense no sign can be registered as a commercial trade mark that can induce the consuming public into error or confusion regarding the origin or attributes of the product that pretends in Chile to distinguish a GI or denomination of origin. Given that the number of GIs and denomination of origins registered with the Department of Industrial Property is zero (there are only six applications), there is no jurisprudence regarding the incompatibility of registered GIs or denominations of origin versus commercial trade marks. In

China

A GI is a sign that identifies a particular good as originating in a region, where a given quality, reputation or other characteristic of the good is essentially attributable to its natural or human factors. Most commonly, a GI includes the name of the place of origin of the good. Agricultural products typically have qualities that derive from their place of production and are influenced by specific local factors, such as climate and soil. In China, GIs are protected by three different government departments based on different laws and regulations.

Applicable laws and regulations

Trade Mark Law amended in December 2001

Article 16 (2) of the trade mark law clearly indicates that GIs are under protection. From a trade mark aspect, GIs are registered as certification marks or collective marks.

Regulations for Protection of Geographical Indication Products effected on July 15 2005

The State Administration of Quality Supervision, Inspection and Quarantine promulgated the above regulation, authorising itself to have the power on GI registration, administration and supervision on the quality of products bearing GIs.

Regulations for Protection of Geographical Indication on Agricultural Products effected on February 1 2008

The Ministry of Agriculture issued the above regulation, but limited its power to only agricultural products for geographical indication.

Governing bodies

From a trade mark aspect, the trade mark office is in charge of the registration procedure, and the administrative authorities at different levels (AICs) have the right of administration and supervision. For the other two types of GIs, both the State Administration of Quality Supervision and the Inspection and Quarantine and the Ministry of Agriculture claim to be the authorities within their own scope.

Registration for foreign right holders

Although both of the two administrative regulations have provided that foreign GI holders can register their GIs according to the specific regulations, unfortunately, no such regulations for foreign registration have ever been published. The only applicable registration for foreign GI holders is through CTMO for certification mark or collective mark.



Rae Yan, Lovells, Beijing

any case, the trade mark authority tends to reject trade mark applications that contain expressions that, without constituting a GI or denomination of origin, possess certain characteristics that are similar to them and that, therefore, may tend to induce errors or confusion regarding the origins of the product or its essential qualities. An example of this was the recent rejection of the trade mark Ruta Pica Sour required to distinguish Pisco (a type of alcoholic beverage). Pica constitutes a denomination of origin application in process to distinguish a specific type of lemon (class 29). On the other hand, the appli-

cation Ruta Pica Sour, number 691915 was requested to distinguish products in class 33. The authority signalled in its judgment in first instance of September 5 2008, that while Pica does not constitute a registered denomination of origin, its social recognition was such that its incorporation in the requested trade mark would be inductive of an error in regards to the nature and origin of the products that it pretends to distinguish.

6

Challenges

Specifically, industrial property law allows a GI or denomination of origin application to be contested or to void a GI or denomination of origin that has been registered (cancellation), when the prohibitions for registration of the latter are infringed as stated in article 95 of the Law of Industrial Property (defined in answer 8). The actions can be presented by any third party. In the case of oppositions, the deadline to present the action is 30 days following the publication of the application in the official gazette. In the case of cancellation actions there is no deadline to initiate the action.

7

Refusal

The Law of Industrial Property establishes in its Article 95 the causes of unregistrability or prohibition of registration of GI or denomination of origin in Chile: that they do not conform to the definitions established in the law (defined in answer 1); that they are contrary to morals or public order; that they induce the public to an error regarding the GI, the nature, the mode of fabrication, the characteristics or qualities, or the aptitude for employment or consumption of the product; that they are common or generic indications to distinguish the products that it deals with, understanding by that those considered as such not only by those with special knowledge, but also by the public in general; that they are the same or similar to another GI or denomination of origin for the same product.

It is in these prohibitions that opposition demands or cancellation actions against an application or registration of a GI or denomination of origin must be founded. If the judgment in first instance by the Chief of the Department of Intellectual Property rejects the registration of the GI or denomination of origin, the applicant can appeal within 15 days at the Tribunal of Industrial Property which constitutes the second instance for such matters in Chile.

8

Enforcement

The infraction of IP rights over a GI or denomination of origin allows for the exercise of civil or criminal actions against the offender. Among the measures that can be requested to the Tribunals are: the culmination of the actions that violate the protected rights; the naming of one or more inspectors; the seizure of the products that are the object of the alleged infraction and of the materials and mediums that served principally to realise it; the prohibition to publish or promote, by any means, the products that are the motive of the alleged infraction; the retention, in the power of the establishment of a credit or of a third party, or of goods, monies or values that come from the sale or commercialisation of those products, in whatever form; and the compensation for harms and damages.



Juan Pablo Silva (left) and Arturo Covarrubias, Silva & Cia, Santiago

EU

1 Availability

The EU has three systems of registration for GIs: for (1) agricultural products and foodstuffs, (2) wines and (3) spirits. The expression GI includes the protected designation of origin (PDO) and the protected GI (PGI). Both are available for wines and agricultural products and foodstuffs, but only PGIs for spirit drinks.

Generally speaking, GI is a name describing a good that owes its characteristics or its reputation to the geographical area from which it originates. In the case of PDOs, all the steps of production must in principle take place in the geographical area and the product's characteristics must be exclusively or essentially due to its geographical origin, while for PGIs at least one step of production has to take place in the area, and the link to the area concerned can be justified by reason of a specific quality, reputation or other characteristic linked to the geographical area.

Wines have additional requirements (eg, the product must be obtained from certain vine varieties). The above system for wines will be applied from August 1 2009. Until then, Quality Wines Produced in Specified Regions, or abbreviated as QWPSR (what in the future will be protected designations of origin), is the name used to differentiate certain wines of higher quality with a specific origin from others like table wines. Only a "group" (namely, any association, irrespective of its legal form or composition, of producers or processors working with the good in question) shall be entitled to apply for registration. A natural or legal person can be considered a group under certain conditions. Other interested parties may participate.

2 Scope of protection

Registered GIs can be used for the goods for which they are protected by any person who complies with the specifications. They are protected against any direct or indirect commercial use in respect of products not covered by the registration in so far as those products are comparable to

The principles laid down by EC regulations are that in cases where the GI is prior to a trade mark, the GI prevails

the products registered under that name or in so far as using the name exploits the reputation of the protected name. They are also protected against 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 expressions such as "type". and against any other false or misleading indication as to the provenance, origin or other qualities of the product. And finally against any other practice liable to mislead the consumer as to the true origin of the product.

GIs and denominations of origin enjoy the same protection. The protection has no time limit and no need to be renewed. The goods protected by the GIs are certain agricultural goods and foodstuffs, wines and spirits. Foreign GIs can be protected in an equivalent way to the EU GIs. They have to be protected in their own countries in order to be apt to be protected in the EU.

3 Listing

The listings kept by the EC are updated each time that a new GI is registered. The database (DOOR) for agricultural products and foodstuffs and the database for wines (E-BACCCHUS) are both available on the official website of the EU. There are about 3,000 GIs (including those already registered and those under examination). The system for notifying the public of new applications is their publication in the corresponding official gazette. In all cases the applications will be published in the official journal of the EU and in certain cases also a previous publication at national level will take place.

4 Registration

As a general rule, a group of producers in the EU files an application where the product is defined according to precise product specifications and which includes a "single document" (which sets out the main points of the specification: name and description of the product, a definition of the geographical area, and a description of the link between the product and that geographical area) with the competent national authority in their country, who will check formal aspects and initiate a national objection procedure setting a term for oppositions.

Once the national stage is passed, it is sent by the national authorities to the Commission, who will scrutinise the application to check that it is justified and meets the conditions laid down in the regulations and shall either reject or publish the single document concerning the corresponding GI in the official journal of the EU. Within six months from that publication in the official journal of the EU any member state or third country may object to the registration. Also any natural or legal person having a legitimate interest established or resident in a member state other than that applying for registration or a third country may object. The Commission will finally take a decision.

Producers outside the EU can file the application directly to the Commission or via their national authority. Member states may charge a fee to cover their costs. A GI can be registered as a Community collective mark with the OHIM when it is capable of distinguishing the goods or services of the members of the association which is the owner of the mark from those of other undertakings. Associations of manufacturers, producers, suppliers of services or traders which have the capacity in their own name to have rights and obligations of all kinds, as well as legal persons governed by public law, may apply for Community collective marks.

5 Conflicts

As a general rule, the principles laid down by EC regulations are that in cases where the GI is prior to a trade mark, the GI prevails. In case that the trade mark predates the GI, the result is coexistence, unless the prior trade mark has a reputation and renown and has been used for a length of time that would make that the new GI is liable to mislead the consumer. An example at EU level is case T-291/03, in which the CFI declared that the registration of a CTM for Grana Biraghi infringed the rights deriving from the PDO Grana Padano.

6 Challenges

A GI registration can be cancelled where compliance of the conditions of the specification for a product to be covered by the protected name is no longer ensured. No

deadlines have been set for cancellation. Any legal or natural person having a legitimate interest can challenge a registered GI or oppose to its registration. The opposition grounds are mainly generic nature, homonyms and trade marks. The Regulation on agricultural products and foodstuffs also mentions plant varieties and animal breeds.

7

Refusal

The grounds for refusal are those for opposition and the non-compliance with more formal requirements (eg if the applicant fails to prove that the protection of the GI is justified or to submit proper documents or fulfil the conditions for its registration). At the national stage, applicants have the appeals provided by national legislation. As to the decision adopted by the Commission, it must be understood that the general system of appeals in the EU applies.

8

Enforcement

Mainly the owner has it. Some examples are oppositions based on GIs against trade mark applications (administrative) or criminal actions in counterfeit proceedings or civil actions for infringement (judicial). Furthermore, public authorities or private certification bodies carry out checks that the use of the GI complies with the product specification and member states conduct administrative controls on the use of registered names on products in distribution and retail under specific legislation on wines and spirits and as part of the official control of EU food law for other products.



Miguel Angel Medina, partner, Elzaburu, Madrid

An example of a foreign GI registered is Pisco filed by the India Embassy of Peru

goods detailed in The Fourth Schedule of the Act that classifies goods from class 1 to 34. The registration of a GI is valid for a period of 10 years and can be renewed from time to time [Section 18]. The fee for renewal of registration of a GI at the expiration of last registration is Rs 3,000 per class and the related Form is GI-4 (first schedule). If the GI is not renewed, it is liable to be removed from the Register.

GIs of foreign origin are also protected, under Section 84 of the Act. Once registered, these GIs are given the same protection as local GIs. An example of a foreign GI registered is Pisco filed by the India Embassy of Peru. The GI falls under class 33 for 'alcoholic beverage'. Pisco is liquor made from Pisquera grapes, obtained by distilling fresh must of recently fermented grapes in accordance with traditional methods and maintaining qualities

established in the production areas. It must fulfil the requirements established by the Peruvian technical standard. The production zones are all located in Peru. The Peruvian origin of the word Pisco has been at great length recognised worldwide.

3

Listing

An index of registered/pending applications is kept under the direction and supervision of the Registrar of GI [Section 77 of the Act]. The list is also published in the Geographical Indication Journal which is published from time to time and made available to public in the form of a hard copy and CD through a subscription fee. To-date a total numbers of approximately 97 GIs have been registered and 141 applications are pending at the GI Registry. These journals can also be viewed the official web site of the Intellectual Property Office in India.

4

Registration

Application for a GI is made under FORM GI-1 A and FORM GI-1 B for a convention application, on a payment of Rs5,000 per class. The application should include the various requirements and criteria for processing a geographical application as specified in Rule 32(1) which details inter alia: how the indication serves to designate the goods as a GI; the class of goods; the territory; the particulars of appearance; particulars of producers; an affidavit of how the applicant claims to represent the interest of producers; the standard bench mark or other characteristics of the GI; the particulars of special characteristics; textual description of the proposed boundary; the growth attributes in relation to the GI pertinent to the application; certified copies of the map of the territory; special human skill involved, if any; number of producers; and particulars of inspection structures, if any, to regulate the use of a GI.

On receipt of the application, a number is allotted. Thereafter, the application is examined to check whether it meets the requirements of the Act and Rules. For this purpose the Registrar ordinarily constitutes a consultative group of experts to ascertain the correctness of the particulars furnished. After issuance of the examination report, submissions are considered. If no objection is raised the GI would be accepted and would be advertised in the Geographical Indications Journal. An opposition can be lodged within a maximum four-month period. If the opposition is dismissed, the application will proceed to registration in Part A of the

India

1

Availability

GIs in India are protected and governed under the Geographical Indications of Goods (Registration and Protection) Act, 1999 and Geographical Indications of Goods (Registration and Protection) Rules, 2002. The Act came into force with effect from September 15 2003. GIs are defined under Section 2(e) of the Act, as an indication which is used to identify agricultural, natural or manufactured goods originating in an area. The said GI should originate from a definite territory and should have a special quality or characteristic unique to the geographical location.

Any association of persons or producers as defined under Section 2 (k) of the Act or any organisation or authority, established by or under the law, representing the interest of producers of the concerned goods can apply to the Registrar for the registration of GI [Section 11 of the Act]. Prior to the Act, GIs in India were registered as certification marks falling under the Trade Marks Act.

2

Scope of protection

Registration of a GI affords better legal protection to facilitate an action for infringement. The registered owner and authorised users can initiate infringement actions. GIs under the Act can be registered under the classification of

Register unless the central government otherwise directs. After a GI is registered any person claiming to be the producer of the registered GI can file an application for registration as an authorised user in Part B of the Register.

The procedure for registration as an authorised user is similar to that for the registration of a geographical indication. A GI cannot be registered as a trade mark but for an exception provided under Section 26 of the Act which states:

- A trade mark which contains or consists of a GI which has been applied for or registered in good faith under the trade mark law or where such trade marks have been used in good faith before the commencement of the proposed legislation or before the date of filing of an application for registration of a GI;

- which comprises or contains scandalous or obscene matter; or
- which comprises or contains any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India; or
- which would otherwise be disentitled to protection in a court; or
- which are determined to be generic names or indication of goods and are, therefore, not or ceased to be protected in their country of origin, or which have fallen into disuse in that country; or
- which although literally true as to the territory, region or locality in which the goods originate, but falsely represent to the persons that the goods originate in another territory, region or locality. This objection is also taken by the

Registrar while accepting or rejecting the registration of a GI.

South Africa has ceased using GIs such as Champagne and Burgundy

- Where goods or class or classes of goods have become the common name of such goods in India or on or before January 1 1995;
- It protects the right of any person to use his name or the name of his predecessor in business except where such name is liable to cause confusion or mislead the public;
- No action in connection with the use of registration of a trade mark shall be taken after five years from the date from which such use or registration which infringes any GI registered under the Act has become known to the registered proprietor or the authorised user (acquiescence).

Applications for registration of a GI are filed at Geographical Indication Registry in Chennai.

5 Conflicts
Section 25 of the Act stipulates that the Registrar shall refuse the registration of a trade mark which contains a GI. If an application for a GI is filed as a trade mark, the following measures/principles are adopted: addressing a cease and desist letter to the concerned party to refrain from using the GI as a trade mark; a request for refusal or invalidation of a trade mark shall be made in Form TM-73 or TM-74 of the Trade Marks Act 1999; a notice of opposition is filed under the Trade Marks Act.

6 Challenges
An existing registered GI can be challenged on the ground of rectification petition under Section 27 of the Act. The registration can either be challenged before the Registrar or the Appellate Board for the contravention or failure to observe the conditions entered on the Register or by an aggrieved party who may have an interest in the registered GI. The main precondition to file a rectification against a registered GI is that the party must be able to establish that it is the "person aggrieved". Since there is no statutory deadline to file the rectification, a GI does not acquire immunity from challenge after it is registered.

Any person having an interest in the GI can oppose the GI. The third party can oppose the GI either on the ground that it has prior rights over the GI (common law and or statutory rights) on the grounds laid down in section 9 of the Act:

- the use of which would be likely to deceive or cause confusion; or
- the use of which would be contrary to any law for the time being in force; or

7 Refusal
The Registration of a GI is prohibited on the grounds laid down under Section 9 of the Act if the application of GI is opposed, and the Registrar is convinced by the grounds of objection, he may refuse the application. The applicant has a right to appeal to the Appellate Board under Section 31 of the Act.

8 Enforcement
The registered owner and authorised user have standing to enforce rights in a GI. The enforcement proceedings are judicial and shall not be instituted in any court inferior to a district court having jurisdiction to try the suit [Section 66 of the Act]. Section 67 of the Act provides that the relief which a court can grant in any suit for infringement or for passing off includes an injunction and, at the option of the plaintiff, either damages or account of profits.



Shruttee Sondhi and Pravin Anand, Anand and Anand, Noida

South Africa

1 Availability
As a WTO member South Africa has an obligation to provide means for the protection of GIs as set out in the TRIPs Agreement. South Africa has not yet adopted specific legislation aimed at the protection of GIs *per se* but GIs are indirectly protected through certain provisions contained in various other statutes and bilateral trade agreements, as well as the common law remedy of unlawful competition.

- GIs are indirectly protected by legislation such as:
- The Trade Marks Act 194 of 1993. GIs could be protected by registering a collective or certification mark that relates to a specific geographical area or incorporates a GI as part of the trade mark. Furthermore, trade marks which may mislead the public as to the true origin of the goods or services are not registrable.
 - The Merchandise Marks Act 17 of 1941 prohibits the application of false trade descriptions, including indications as to the country where the goods were produced, to goods as well as the sale of such products.

- According to the Liquor Products Act 60 of 1989, no liquor product may be sold by using the name of any country, or a word or expression containing such a name, in a manner that indicates, or creates the impression, that the liquor product is a product of a country other than its country of origin.
- The Wine of Origin Scheme, promulgated under the Liquor Products Act, is an administrative tool for the protection of GIs for wine.

2 Scope of protection

As mentioned above, GIs are indirectly protected through statutes, including the Trade Marks Act and the Liquor Products Act, and bilateral trade agreements. The rights obtained by the registration of collective and certification trade marks are protected under the Trade Marks Act and the marks are renewable every 10 years. Furthermore, these rights are protected against infringement as provided for in the Trade Marks Act with regard to all trade marks.

The Wine of Origin Scheme protects geographical wine producing areas. According to the regulations promulgated under the Liquor Products Act, no claims to origin may be made in respect of wine, unless the claim has been verified and certified by the Wine & Spirits Board. Where a producer intends producing a wine of origin, it is obliged to notify the Board of its intention to do so before harvesting grapes and to give the relevant officials of the Board the opportunity to verify the origin of the grapes concerned. There are also strict regulations as to the labelling of wines.

Foreign GIs are mainly protected through bilateral trade agreements. South Africa has recognised GIs since the 1930s when it entered into an agreement (the Crayfish agreement) with France in terms of which South Africa agreed to protect certain appellations of origin. South Africa has subsequently further ceased using GIs such as Champagne and Burgundy. In 1999, the EC and South Africa signed an Agreement on Trade, Development and Cooperation. In terms of this agreement South Africa may not use the words Port and Sherry for exports to the EC. For the domestic market, South Africa may use the names Port and Sherry until January 1 2012. In terms of this agreement provision was also made for the phasing out of words such as Grappa and Ouzo. In 2002, the EC and South Africa negotiated a further agreement for the protection of GIs for wines and spirits. The Trade Marks Act, the Merchandise Marks Act, the Liquor Products Act and the Wine of Origin Scheme include provisions excluding the unauthorised use of recognised GIs.

International GIs not recognised by South Africa include Parma ham, Calamata olives, Feta and Parmesan cheese (these GIs are all used customarily/generically in South Africa).

3 Listing

South Africa does not have a register of protected GIs. A list of the registered production areas under the Wine of Origin Scheme is however available from SA Wine Industry Information & Systems at <http://www.sawis.co.za>. The Wine of Origin Scheme is administered by the Wine and Spirit Board of South Africa. South African wines are certified under the Wine of Origin Scheme in respect of specific areas of production and cultivars, which areas are divided into regions, districts, wards or estates. Collective or certification trade marks that indirectly offer protection of GIs are reflected on the Trade Marks Office register, which can be accessed by the public.

4 Registration

As pointed out before, only indirect protection can be obtained. Under the Wine of Origin Scheme, a wine

producer must apply to the Wine and Spirits Board for classification/certification of his wine. Wines can be certified as wines of origin of a particular production area only if the grapes were harvested in that area. The fees associated with an application are minimal.

The Demarcation Committee of the Wine and Spirits Board investigates applications relating to the definition and amendment of production areas (geographical units, regions, districts, wards) and units for the production of estate and single vineyard wines. The fees associated with an application are minimal. Under the Trade Marks Act, protection can be obtained through registration of a certification or collective trade mark at the Trade Marks Office in the usual manner in which trade marks are registered.

A collective trade mark is owned and used by a group of producers – generally the members of an association. The group that owns the mark may not use the trade mark directly, but only through its members. Application for registration of a collective trade mark is similar to the procedure for registering an ordinary trade mark. The application must be accompanied by rules governing the use of the mark. The rules must specify the persons authorised to use the mark, the conditions of membership of the association and, where applicable, the conditions of use of the mark, including any sanctions against misuse. If acceptable, the trade mark is registered in the ordinary way after having been published for opposition purposes.

A certification trade mark may not be registered in the name of a person who carries on a trade in the goods or provides the services in respect of which registration is sought. The application must be accompanied by a statement by the applicant that it does not carry on a trade in the goods and services in respect of which registration is sought and by rules governing the use of the mark. The rules must specify the conditions of use of the mark as well as the circumstances and characteristics of certification.

5 Conflicts

There are no specific provisions relating to the conflict between a GI and a trade mark and any conflict would be treated in terms of legislation such as the Trade Marks Act and Liquor Products Act.

6 Challenges

A GI protected through registration as a collective or certification mark could generally be challenged on the same grounds as an ordinary trade mark. The Trade Marks Act provides that any entry wrongly made or remaining on the register, or any error or defect in an entry made in the Register may be challenged on application to the Registrar of Trade Marks.

Section 27 of the Trade Marks Act further provides for removal of a registered trade mark on three grounds:

- where there was no *bona fide* intention to use the trade mark when the application for registration was made;
- where there was no use of the trade mark for a continuous period of five years up to the date three months before the application for removal is made; or
- where a trade mark registered in the name of a body corporate or natural person has not been assigned to a new proprietor for a period of two years after the date of dissolution of the body corporate or death of the natural person.

The grounds listed above cannot be invoked against a trade mark in respect of which protection may be claimed under the Paris Convention as a well-known trade mark. Section 21 of the Trade Marks Act provides that any interested person may

oppose a trade mark application. The South African courts have held that an interested person must be more than simply the general interests of a member of the public. A real or direct interest in the mark or the subject matter of the application is required in order to qualify as an interested person.

7

Refusal

An application to register a certification or collective mark to protect a GI is examined in terms of the Trade Marks Act. Section 10(2), (12) and (13) of the Trade Marks Act provides that a mark (and by implication a GI) shall not be registrable if it is a mark which:

- a) is not capable of distinguishing, or
- b) consists exclusively of a sign or an indication which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services, or the mode or time of production of the goods or of rendering of the services; or
- c) consists exclusively of a sign or an indication which has become customary in the current language or in the *bona fide* and established practices of the trade;
- d) is inherently deceptive or the use of which would be likely to deceive or cause confusion, be contrary to law, be *contra bonos mores*, or be likely to give offence to any class of persons;
- e) as a result of the manner in which it has been used, would be likely to cause deception or confusion.

However, an exception to (b) above applies to collective trade marks as geographical names or other indications of geographical origin may be registered as collective marks. Furthermore, a mark capable of distinguishing the geographical origin of goods or services may be registered as a certification trade mark. If an application for registration of a collective or certification mark containing a GI is refused, an applicant may, in terms of section 53 of the Trade Marks Act, apply to the High Court of South Africa within three months of such decision being made, for relief. The Court has the power to consider the merits of any matter, receive further evidence and make any order it sees fit. An appeal against a decision made by the Wine and Spirits Board is dealt with by the Management Committee of the Wine of Origin Scheme.

8

Enforcement

Subject to the fact that no direct protection for GIs exists in South Africa, the Trade Marks Act provides that the owner of a trade mark, which could include a GI, may institute infringement proceedings. In addition, a person recorded as registered user may, subject to any agreement between the parties, call upon the owner to institute infringement proceedings, and if the owner refuses or neglects to do so, the registered user may institute infringement proceedings in his own name as if he were the owner. The owner is then cited as a co-defendant in the action. The enforcement process is judicial and is dealt with in the High Court.

The Trade Marks Act 194 of 1993 provides for the following remedies in respect of trade mark infringement: an interdict against the defendant; an order for removal of the mark or delivery up of the goods; a claim for damages or an alternative claim for damages in the form of a reasonable royalty; a cost order.



Eben van Wyk, director, Cliffe Dekker Hofmeyr, Cape Town

United States

1

Availability

There is not a separate national scheme for protection of GIs, as such, in the US. Rather, GIs are protectable under the Federal Trademark Act as trade marks, certification marks, and/or collective marks. A certification mark may be registered by an entity which controls the characteristics and requirements of the products. Certification marks may be owned by governmental entities or by non-governmental organisations that set standards and exercise supervision over the certified products of others. However the registrant may not itself produce the products sold under the mark. A collective mark may be registered by an organisation such as a co-op or union for use only by its members. Where a GI has acquired secondary meaning, it may also be registered as a trade mark by any entity that controls the goods and services provided under the mark.

In addition to rights based on registration, in the US, common law trade mark rights also may arise through use and acquired reputation. This principle applies to certification marks and collective marks as well as trade marks and service marks. For example, Cognac was held to be a valid common law regional certification mark for brandy originating in the Cognac region of France. There are also numerous state laws in the US protecting various geographical terms within the jurisdictions of particular states, often for agricultural products. Many of those terms also are federally registered as certification marks. In addition, there are extensive federal regulations related to alcoholic beverages which, inter alia, prescribe nomenclature requirements for beer, wine and spirits that have geographical connotations.

The owner of a registered or common law certification mark, collective mark or trade mark also may prevent misleading or deceptive use of similar geographical terms through actions for false advertising and unfair competition under both federal and state laws in the US. Collective and certification marks protecting GIs are not extremely popular in the US and the number of applications for such registrations is relatively small.

2

Scope of protection

A registered collective mark or certification mark may cover any goods or services for which it is used. Registration is for a 10-year term. Foreign GIs are entitled to the same protection as local GIs. An application for registration may be based on intent-to-use the mark; however, proof of actual use is a prerequisite to registration unless the applicant is the owner of a registration for a corresponding collective mark or certification mark in its home country. In order to maintain the registration, the mark must be used in the US.

3

Listing

There is no separate listing of protected GIs. However, individual registrations and applications may be found by searching the USPTO database at www.uspto.gov.

4

Registration

The procedures for obtaining protection are essentially the same as those for registering a trade mark. The application is filed in the USPTO. The filing fee is \$345 per class, and the application may be filed electronically or on paper. No documents must be submitted with the application.

except for a drawing if the mark includes a design and a specimen of use if the application is based on use.

Unlike a geographical trade mark, which can only be registered if the applicant shows "secondary meaning" acquired through use, under the US Trademark Act, indications of regional origin may be registered as certification marks without any showing of secondary meaning in the US. The USPTO processes such applications in the same way as all other applications for trade marks, service marks, collective marks and certification marks. The application is examined for formalities, inherent registrability and on relative grounds. If the application is not based on use, either proof of use in the US or evidence of a home country registration must be filed before a registration may issue. There is no separate registration office for GIs.

5 Conflicts

A conflict between a trade mark and a GI would be resolved in accordance with general trade mark law principles.

6 Challenges

An application to register any mark in the US is published for opposition after it is approved by the Trademark Examining Division of the USPTO. Any persons who believe they may be damaged by the registration may file an opposition. Grounds for opposition include confusing similarity to a prior common law or registered mark of the opposer, as well as all grounds of inherent registrability including that the mark is descriptive or deceptively misdescriptive or that it is a generic term. For example, the Court of Appeals for the Federal Circuit has held that the Scotch Whiskey Association had standing to seek cancellation of a trade mark registration that allegedly implied Scottish origin of a whiskey made in Canada. Such cases arise only rarely, however. GIs enjoy no special protection against claims of genericness.

7 Refusal

GIs may be refused on all of the usual grounds for refusal of trade marks except that a geographical name may be registered as a certification mark despite being

geographically descriptive, unlike a trade mark consisting of a geographical term which can not be registered without a showing of secondary meaning. If an application is refused, an *ex parte* appeal may be taken to the Trademark Trial and Appeal Board (TTAB) of the USPTO which is the same body that hears *inter partes* oppositions and cancellation actions. Subsequent appeals from TTAB decisions may be filed in any Federal District Court having jurisdiction or directly to the Court of Appeals for the Federal Circuit.

8 Enforcement

Rights in a registered GI may be enforced by the registrant and rights in a common law GI may be enforced by any party that can demonstrate a legitimate legal interest in the common law right. Judicial enforcement actions can be brought in either federal or state courts and the available remedies include injunctions, declarations of rights, damages, accounting for profits, and in exceptional cases of wilful infringement, awards of attorneys' fees. In addition, as noted above, oppositions to published applications or cancellation actions against registered marks may be filed with the TTAB.



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