

CONFLICT BETWEEN GEOGRAPHICAL INDICATIONS AND TRADEMARKS: A STUDY

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ABSTRACT

Pasta from Cyprus, Basmati Rice from India, London cure smoked salmon, and Irish Cream from Ireland are some of the Protected Geographical Indications across the world. When someone buys any good or product for its quality, and specific characteristics, its place of origin gives authenticity to that product. In the same way, two products in the market can be recognized and compared through a trademark on it. These two Intellectual Property Rights i.e. Geographical Indications and Trademarks indicate the origin of goods & commercialization of goods & services respectively. There are situations when these two overlap and giving preference to one over another becomes a conflict. The present Article focuses on the treaties, agreements & global law regimes for resolving such conflicts. Adherence to the TRIPS Agreement by WTO member countries by the enactment of laws for Geographical Indications and Trademarks. The significance of trademarks, certification marks & collective marks for the expansion of Geographical Indications and harmonizing relations between Trademarks and Geographical Indications for smooth trade and economic development.

Journal of Legal Research and Juridical Sciences

Keywords: Geographical Indications, Trademarks, Conflict, TRIPS, Regime

INTRODUCTION:

The goods or products we consume in any way have an origin or representation attached to them that indicates authentication and quality of the product. The production and creation of the products by any person or by any community give them exclusive rights over the goods for commercialization through the Intellectual Property Rights legal regime that differs from country to country. A trademark may be refused registration if it contains exclusively marks or indications that designate the geographical origin of the goods. Any foodstuff, agricultural product, artistic product, clothing, or any other good produced in a manner that is known for its geographical origin by protected Geographical Indication, if a trademark, by any entity or

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person who has no connection with the geographical name, is used that suggests its connection with geographical origin it may mislead the public and may be a case of unfair competition. Standing Committee on the Law of Trademarks, Industrial Designs, and Geographical Indications (SCT) are a forum that discusses issues & problems, eases coordination, and provides guidance on the progressive development of International law on Geographical Indications, Trademarks, and Industrial Designs and works in order to harmonize national laws and procedures.

WHAT ARE GEOGRAPHICAL INDICATIONS AND TRADEMARKS?

When it comes to identifying any goods or products, the first way is through visualization or its appearance which is attained by any indication, image, logo, name, tag, or slogan. Geographical Indications and Trademarks are two types of Intellectual Property Rights that protect the commercialization of products either known through their geographical representation or graphical representation. Geographical Indication as the name suggests is an indication of any product that is produced naturally in any locality or area, or manufactured by specific people or communities having traditional knowledge of its quality, reputation, or other characteristics. While Trademarks are graphical representations of any good that can be a logo, name, slogan, or image which distinguishes the goods of one person from another. Article 15(1) of Trade-Related Aspects of Intellectual Property Rights (TRIPS) states that "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."

While Article 22(1) of TRIPS states that "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 characteristics of the good is essentially attributable to its geographical origin." Scotch Whiskey(UK), Darjeeling Tea(India), Cafe de Colombia(Colombia), Swiss Watches(Switzerland), Peruvian Pisco(Peru), Champagne(France), Basmati(India), Bayerisches Bier(Germany) are some of the GI Tags across the world. When it comes to the protection of Geographical Indications tags through Trademarks, the same can be granted through Certification and Collective marks.

BACKGROUND AND EVOLUTION OF GEOGRAPHICAL INDICATIONS

The concept of Geographical Indications¹ has evolved in many phases. It is derived from the French Law related to the “Appellations of Origin” which emerged in 1905. As per Article 2(1) of the WIPO Lisbon Agreement, “an appellation of origin is the geographical denomination of a country, region, or locality, which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors.” An Appellation of origin has a stronger link with place or origin as compared to Geographical Indications. It is a restrictive sub-category of Geographical Indications.

The First International Treaty for the Protection of Geographical Indications was Paris Convention concluded in the year 1883. The motive of this treaty was to protect intellectual property and industrial property beyond national territories. Through this multilateral agreement, protection was provided to “indications of source” and “appellations of origin”. It focused on matters related to false indications. Madrid Agreement was signed in 1891 for the repression of false or deceptive Indications of sources of goods, and the Lisbon Agreement was signed in 1958 to provide protection to the appellations of origin and for their international registration. Further, in 1989, Madrid System was introduced through a Protocol relating to the Madrid Agreement concerning the international registration of marks specifically for the protection of Geographical Indications through the Certification Trademark regime in countries where no specific sui generis rule for the protection of Geographical Indications exist.

The most important international agreement by WTO between² its member countries on “indications of geographical origin” is the Trade-Related Aspects of Intellectual Property Rights (TRIPS) of 1994.

GLOBALIZED LEGAL REGIME ON THE PROTECTION OF GEOGRAPHICAL INDICATIONS

The term “Geographical Indications” was used for the first time in this Agreement and the rules are binding on all the WTO members. Articles 22, 23 & 24 of the TRIPS Agreements cover

¹ Bassem Awad and Marsha S. Cadogan, “History of and Rationale for the Protection of GIs” (CETA and the Future of Geographical Indications Protection in Canada (2017) 3-4, <<https://www.jstor.org/stable/resrep15528.8>> accessed 19 March 2023

² Dr. Varun Shukla, “Historical development of geographical indication law under international arena” (2016) 2(4) 01-04 ILJ <<https://www.lawjournals.org/download/36/2-5-16-949.pdf>> accessed 19 March 2023

the provisions related to Geographical Indications. Member countries can make laws for the protection of Geographical Indications in a stricter sense but not contrary to the TRIPS Agreement as it gives the wider scope for Geographical Indications Protection. The national protection of geographical indication is provided through the sui generis system³ against any indirect use of Geographical Indications and their imitation as well. Some countries have Trademark Law Regimes and specific Geographical Indications Regimes for the protection of Geographical Indications Protection.

The objective behind the Geographical Indications Law Regime is to maintain the standard of products that have attained their quality and characteristics from a particular origin, to protect the consumers, producers, and communities from misleading information and products in the market, to protect against unfair competition, to appreciate, elevate and protect the art, skills, traditional knowledge, geographical conditions on an international level. A Geographical Indication can only be protected under the umbrella of the TRIPS Agreement, only when the member state recognizes and protects a Geographical Indication. TRIPS agreement favors the wide protection of wine and spirits as Geographical Indications against infringement in WTO member countries. The protection of non-wine & spirit has a narrower scope in the TRIPS Agreement which is getting the light of safeguard with advancement and judicial pronouncements. Feta Cheese from Greece, Moroccan Oil from Morocco, etc. are some of these Geographical Indication tags.⁴

As per SCT, 2010,⁵ in the context of examination proceedings, a conflict between a Trademark and a protected Geographical Indication, it has been observed that the Trademarks are excluded from registration in many jurisdictions if they contain or consist of a protected geographical indication (including an appellation of origin). In Brazil, the denomination “CA’del SACRAMENTO FRANCIACORTA” applied for beverages was refused registration as Trademark on the ground that it consists of a wine appellation of origin from Italy.

³ International Intellectual Property Institute, “Is A Sui Generis System Necessary?” ITPF Luncheon (2004) <<https://iipi.org/wp-content/uploads/2010/07/NewYork011404.pdf>> accessed 18 March 2023

⁴ Bassem Awad and Marsha S. Cadogan, “The Development of Legal Protection for GIs around the World” (CETA and the Future of Geographical Indications Protection in Canada (2017) 4-7 <<http://www.jstor.com/stable/resrep15528.9>> accessed 19 March 2023

⁵ WIPO, “Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications” WIPO/STrad/INF/5 (2010) para 50 <https://www.wipo.int/export/sites/www/sct/en/meetings/pdf/wipo_strad_inf_5.pdf> accessed 19 March 2023

Though the TRIPS agreement was a major step forward for the protection of Geographical indications worldwide, due to the large number of signatories to it, divided approaches couldn't make the expansion of Geographical Indications beyond wines and spirits. Countries like The United States, Canada, and Australia have opposed the expansion and favor Trademarks over Geographical Indications when it comes to the conflict, while the European Union with other developing countries supports the expansion of Geographical Indications to establish a sui generis form of Geographical Indications that prevails over Trademarks.

OVERLAPPING BETWEEN GEOGRAPHICAL INDICATIONS AND TRADEMARKS

Trademarks and Geographical Indications overlap at times, as a Trademark may contain or consists of any Geographical name or any name descriptive of the place of origin. Trademark protection is granted to the person who is commercializing the goods or services through that trademark which denotes that it is private property. Geographical Indications are protected in favor of the community or people who belong to the origin of products.

For example, 'Cognac' is a brandy under the word 'Maria®' and other 'Cognac' brandy with a label bearing 'Henry®'. Here, Cognac is an appellation of origin from France which is identified by a phrase labeled on bottles 'Produce of France' and 'Henry®' and 'Maria®' are individual trademarks for enterprises that produce the products.⁶

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Trademarks and Geographical Indications go hand in hand. If any trademark contains a geographic name that also has an origin for any good, then the trademark (collective or certification) provides the best coverage to Geographical Indications, if the same is within the limits of fair competition and not misleading the potential consumers. Distinctive and non-descriptive Trademarks are considered to be good Trademarks, when it comes to their application for geographical names or signs, these trademarks can be considered if such signs describe the geographical origin of the product rather than its commercial or trade origin.

A collective mark can be used by the right holder, while a Certification mark can be used by the certification agency, depending on the law of any country. In the USA, the 'Idaho' label is used as a certification mark by Idaho Potato Commission for geographical significance. The

⁶WTO, "Geographical Indications" Module IV, 76

<https://www.wto.org/english/tratop_e/trips_e/ta_docs_e/modules4_e.pdf> accessed 20 March 2023

term ‘Café de Colombia’ is protected as a Geographical Indication in European Union. In The US and Canada, “Columbian” is used as a Certification mark for coffee. The Café de Colombia image is a registered trademark in numerous jurisdictions, including Switzerland.⁷

In relation to cheese, the term ‘Roquefort’ is protected as Geographical Indications, certification marks, and collective marks in various categories. For Example, The term ‘Roquefort’ is registered as an appellation of origin under the WIPO Lisbon Agreement. Various Roquefort labels are registered as trademark labels under the WIPO Madrid system and in many national jurisdictions, including as certification trademarks like in France, and Australia.

IN CASE OF CONFLICT BETWEEN GEOGRAPHICAL INDICATIONS AND TRADEMARKS

When Trademarks and Geographical Indications are used for referring to a particular origin and serve a two-fold purpose, one recognition of the producer in that origin and other commercialization of goods. Article 24(5) of the TRIPS Agreement, specifies “*the first in time first in right*” principle that a trademark registered in good faith prior to the protection of Geographical Indication in the country of origin will continue to be registered as a trademark, even though it is identical or similar to the Geographical Indication. This provision supersedes in case of any conflict between Geographical Indication and Trademark if the public would not be misled by prior trademark about the true origin of the product.

In many countries, Trademark law governs Geographical Indications, which gives narrower protection to Geographical Indications when it comes to choosing one between the two. But, there are instances where Geographical Indication is preferred over Trademark in conflict. In a famous case of dispute over “Budweiser” where the Trademark was canceled for Anheuser-Busch and Geographical Indication proprietor⁸ Ceske Budejovice won the battle.

In a dispute⁹ over PARMA HAM, both Geographical Indication and Trademark subsist together. The Court opined that the petitioner has expended great efforts to promote prosciutto

⁷ WTO, 78, n 6

⁸ Loucks, Melissa A., "Trademarks and Geographical Indications: Conflict or Coexistence?" (2012) Electronic Thesis and Dissertation Repository. 850 <<https://ir.lib.uwo.ca/cgi/viewcontent.cgi?article=2044&context=etd>> accessed 20 march 2023

⁹ Dev Gangjee, “Quibbling Siblings: Conflicts between Trademarks and Geographical Indications” 82 Chi.-Kent L. Rev. 1253 (2007) 1270

from Parma through certification marks and apparently developed a worldwide reputation. But, it faced problems to register in the US because of the respondent's registration. On the other hand, the respondent has been using its Parma brand for more than 35 years and owned a registration for more than 20 years which shows that the mark was neither geographically deceptively misdescriptive nor geographically deceptive.

WTO member countries abide by the TRIPS Agreement, but they have different approaches to the conflicting situation. In the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, 2015, the Delegation of the US states that a mark which, when used on or in connection with the goods of the applicant is primarily geographically descriptive of them could be refused registration as a trademark. The Delegation of Colombia indicated that the name "Colombia" and the national symbols of the country could be included in a trademark only if the mark is not deceptive, misleading with regard to the origin of the goods or services, not likely to create confusion or association with a protected appellation of origin, does not take unfair advantage of the notoriety of the country.

CONCLUSION

Geographical Indications expand the wavelength of goods possessing quality, reputation, and characteristics that originate from a particular geographical region, and protect the rights of the community in securing and transferring the inherited knowledge to future generations. As per WIPO Indicator Report 2022,¹⁰ countries in European Union have regional and national Geographical Indication protection, when it comes to foreign Geographical Protection, the countries are fewer in number. This difference occurs due to the diverse approach of signatories to TRIPS in applying the Geographical Indication Law Regime.

High-income economies and middle-income economies should utilize the platforms of WIPO and WTO to regulate and enforce the harmonizing law regime for conflicts between Trademarks and Geographical Indications. Judicial Pronouncements, Precedents for the settlement of conflict at the global level can give light on making common rules & policies for situations related to overlap and conflict between Trademarks and Geographical Indications.

<<https://scholarship.kentlaw.iit.edu/cgi/viewcontent.cgi?article=3618&context=cklawreview>> accessed 20 March 2023

¹⁰ WIPO, "World Intellectual Property Indicators 2022" <<https://www.wipo.int/edocs/pubdocs/en/wipo-pub-941-2022-en-world-intellectual-property-indicators-2022.pdf>> accessed 20 March 2023

Intellectual Property Rights are the future and trade of goods and services is essential for the economic growth of any country. Harmonization between Trademarks and Geographical Indication will improve IP valuation for the benefit of communities, producers, artisans, and upliftment of geographical origin of goods.

