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The legal protection of designations of origin and of geographical indications in the EU and in international law

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DECLARATION

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I hereby declare that the work submitted is mine and that where I have made use of another's work, I have attributed the source(s) according to the Regulations set in the Student's Handbook.

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Abstract

This dissertation was written as part of the LLM in “Transnational and European Commercial Law, Arbitration, Mediation and Energy Law” at the International Hellenic University with the aim to explain the international legislative framework for geographical indications and designations of origin and a potential full harmonization on this field via a revision of TRIPS. It starts with the terminology used and how incorporated in international legislative instruments so as to become a distinct IP right. It follows with the nature of such indications as signs of authentic and quality products with high rewards to producers and consumers as the key benefit but also the reason of the deep conflict between traditional production countries of continental Europe and industrial production countries of New world. The different philosophy in their legal systems led to a deadlock in negotiations, which resulted in a political compromise and unjustified two-tier system of protection of GIs in TRIPS agreement. However, after scrutinizing the two conflicting models used for GI protection by the EU and USA, this work concludes that both jurisdictions seem to agree impliedly and have already harmonized their basic principles by treating GIs as a protective “device” encompassing IP collective rights with unfair competition. Therefore an extension of the higher protection reserved for wines and spirits only to all goods, including foods, is a feasible solution and opportunity, given that mostly famous GI-denominated products are foods. Since GIs is a powerful tool of unique competitive advantage as the unique reflection of people and its *terroir* with multiple benefits for localities in a globalised free-trade economy, the fear of monopolization of the market by the EU seems exaggerated before the threat of mass-homogenous products without culture identity and exclusive control of private firms.

Keywords: Geographical indications, designations of origin, certification regional marks, trade marks , TRIPS

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ABBREVIATIONS

AO(s): Appellation of Origin(s)

AOC: Controlled Appellation of Origin (in several languages, i.e. Appellation d'origine contrôlée)

CAP: Common Agricultural Policy

CJEU: Court of Justice of European Union

CTM: Community Trademark (EU)

CTMR: Community Trademark Regulation (EU)

DO: Denomination of Origin (in several languages)

EU: European Union

EC: European Communities

GI(s): Geographical Indication(s)

IP or IPR: Intellectual Property (Rights)

n : note

p(p): page(s)

PDO: Protected Designation of Origin (EU)

PGI: Protected Geographical Indication (EU)

TFEU: Treaty on the Functioning of European Union

TK: Traditional Knowledge

TM(s): Trade Mark(s)

TMD: Trade Mark Directive (EU)

TSG: Traditional Specialty Guaranteed (EU)

TRIPS: Trade-Related Aspects of Intellectual Property Rights

TTAB: Trademark Trial and Appeal Board (USPTO, USA)

USA: United States of America

USPTO: United States Patent and Trademark Office

WIPO: World Intellectual Property Organization

WTO: World Trade Organization

Introduction:

In a knowledge-based global economy¹ the differentiation of products is of major importance for producers to gain consumers attraction and thus market power and high income². Consumers prefer mostly well-known products because of the special quality or characteristics there of. Geographical indications or designations of origin have emerged as a new tool³ for promoting this goal⁴ through its recognition as a distinct intellectual property right worldwide mainly in TRIPS Agreement.

However this recognition by WTO member states was essentially a result of compromise⁵ between continental or “Old-World” countries and common-law or “New-World” countries and not an undoubtedly acceptance⁶.

Criticism has focused primarily on the fact that similar and adequate protection is provided already by trademark law⁷. Since designations of origin as later formulated in geographical indications (hereafter GIs) relate mostly in the current to wines or spirit drinks and agricultural products or foods, another issue that had to be resolved was the use of these names as generic for products in the “New-World” countries’ territory.

The result was the two-tier system of protection of GIs in the TRIPS⁸. The definition of geographical indications was broader and more flexible including several terms (among

¹ Teshager Dagne, “The Identity Of Geographical Indications And Their Relation To Traditional Knowledge In Intellectual Property Law”, *IDEA: The Intellectual Property Law Review*, 2014, pp.283-284.

² Philip Matthews, “Increasing revenue in developing nations through intellectual property rights: why a diversified approach to intellectual property protection with a focus on geographical indications is the best method”, *Buffalo Intellectual Property Law Journal*, 2010, p.202.

³ Teshager Dagne (n. 1), 2014, pp.257,263.

⁴ Malobika Banerji, “Geographical Indications: Which Way Should Asean Go?”, *Intellectual Property & Technology Forum at Boston College Law School*, 2012, pp.3,4.

⁵ Tunisia L. Staten, “Geographical Indications Protection Under the TRIPS Agreement: Uniformity Not Extension”, *Journal of the Patent and Trademark Office Society*, 2005, p.221.

⁶ Kal Raustiala and Stephen R. Munzer, “The global struggle over geographic indications”, *European Journal of International Law*, 2007,pp.338-339.

⁷ Inessa Shalevich, “Protection of Trademarks and Geographical Indications”, *Buffalo Intellectual Property Law Journal*, 2008, p.82.

⁸ Anselm Kamperman Sanders, “Geographical indications of origin: when GIs become commodities, all gloves come off”, *International Review of Intellectual Property and Competition Law*, 2015,pp. 763,764. See also Lina Monten, “Geographical Indications of Origin: Should They Be Protected and Why? - An Analysis of the Issue From the U.S. and EU Perspectives”, *Santa Clara Computer and High Technology Law Journal*, 2006, pp. 315,349.

them designations and appellations of origin)⁹; and a minimum standard of protection was set for all products encompassing agricultural products, foodstuffs and handicrafts, while an enhanced protection was reserved for wines and spirits only¹⁰. However, the disputed¹¹ feature of GIs seems to be also the key for the solution of the above problem and the resulted conflict¹². Geographical indications rely their quality or other famous special characteristic on the notion of *terroir*¹³, namely a combination of nature and human factors that alongside with the use of traditional production process and a culture expression offer a unique, special product. The reputation of these geographically designated products follows their unique features and lead to high prices as consumer preferable. GIs link the product with the place of origin, that is a specific locality, region and not with a certain undertaking as trademarks do. They follow a different philosophy and are region-based in a collective manner. The potential of sustainable growth that GIs offer in their regions not only in economic terms but also in social, rural and cultural terms¹⁴ put them in the centre of a crucial debate for interested parties, mainly for developing countries¹⁵, as a new workable effective tool that ensure equal and fair competition in a free-market economy and authenticity against homogenous products of often lower quality or imitation in a globalised environment¹⁶.

⁹ Teshager Dagne (n. 1), 2014, pp.261,262. See also Ch. Heath, A. K. Sanders, “*New Frontiers of Intellectual Property Law, IP and Cultural Heritage – Geographical Indications – Enforcement – Overprotection*”, Hart Publishing, 2005, p.119.

¹⁰ Tesh W. Dagne, “Beyond Economic Considerations: (Re)Conceptualising Geographical Indications For Protecting Traditional Agricultural Products”, *International Review of Intellectual Property and Competition Law*, 2015, pp.682-684. See also Ch. Heath, A. K. Sanders, “*New Frontiers of Intellectual Property Law, IP and Cultural Heritage – Geographical Indications – Enforcement – Overprotection*”, Hart Publishing, 2005, p.119.

¹¹ Teshager Dagne (n. 1), 2014, pp.256-259. See also Lina Montan, “Geographical Indications of Origin: Should They Be Protected and Why? - An Analysis of the Issue From the U.S. and EU Perspectives”, *Santa Clara Computer and High Technology Law Journal*, 2006 pp.315,316.

¹² Inessa Shalevich, (n. 7), p.67.

¹³ See how the terroir is defined in Inessa Shalevich,(n. 7) p.67.

¹⁴ Irene Calboli, “Geographical Indications of origin at The Crossroads Of Local Development, Consumer Protection And Marketing Strategies”, *International Review of Intellectual Property and Competition Law*, 2015, pp.760-762, 766-767.

¹⁵ See that more and more developing countries come in line with EU proposal for expansion of sui generis protection of GIs to all agricultural products in Tesh W. Dagne, (n.10), 2015, pp.682-684.

¹⁶ See how protection on GIs serve general public interests rewarding local communities and their tradition and thus it cannot solely based on economic factors, but must take into consideration also cultural identity in Tesh W. Dagne, (n.10), 2015, pp.682-690. See also Ch. Heath, A. K. Sanders, “*New Frontiers of Intellectual Property Law, IP and Cultural Heritage – Geographical Indications – Enforcement – Overprotection*”, Hart Publishing, 2005, pp. 682,700- 701,707.

The benefits both for consumers and producers and also the preservation of tradition and culture of these qualified and reputable products are huge¹⁷ as the on going debate and the recent developments in multilateral level demonstrate¹⁸. Examples are the bilateral agreements concluded between the European Union and developing countries¹⁹ as well as the Geneva Act amending the Lisbon Agreement on Appellations of Origin and establishing a common registration both for Apellattions of Origin and Geographical Indications²⁰. Harmonization of the different levels of protection worldwide may benefit all market players and thus a better understanding of GIs is a positive step to this direction.

This paper aims to explain the evolution and the rationale behind the protection given by geographical indications and similar terms; their similarities and disparities with trademarks and how they function. The following analysis shows that harmonization is a feasible achievement since the divided jurisdiction approaches share more common than differences. Besides the concept of *terroir* is unique everywhere and a stronger protection of GIs has a lot to give than to lose.

¹⁷ See the benefits as analysed in Irene Calboli, (n. 14), pp.766-769.

¹⁸ Irene Calboli, (n. 14), pp.765-766.

¹⁹ Tim Engelhardt, "Geographical Indications under Recent EU Trade Agreements", *International Review Of Intellectual Property And Competition Law*, 2015, pp.781-782.

²⁰ Marcus Höpperger, Matthijs Geuze, "Negotiators Modernize International System for Registering GIs", *WIPO Magazine 2015*, available at: http://www.wipo.int/wipo_magazine/en/2015/03/article_0001.html (Accessed on 04/02/2015). See also Anselm Kamperman Sanders, (n. 8), pp.756-757.

CHAPTER I: The definition and protection of GIs in international IPR arena

A. The definition of Geographical indication (GI) - Untangling the terminology

Geographical indication (hereafter GI) is an identifier of a product's origin²¹. However, unlike trade marks, geographical indications identify a good as originating from a particular geographic area and not from a specific undertaking²². A specific quality, characteristic or reputation of the product essentially attributable to that area is usually required for the protection of these designations with a geographical implication, which mostly concern foods and beverages. Thus these designations of origin are understood by consumers to denote both the origin and the quality of the product²³. Well-known examples are Idaho potatoes, Port wine, Roquefort cheese and Champagne²⁴. However the use of geographical indications is not confined only to agricultural products but also apply to all products with desirable qualities, like artcrafts demanding special manufacturing skills and traditions, such as Murano glass²⁵.

Geographical indications are often geographic words that may stand alone or be coupled with other generic terms in order to designate a specific country or location, for instance "Irish whiskey" or "Scotch"²⁶. They may direct indicate the place of origin i.e.,

²¹ C. Seville, *"EU Intellectual Property Law and Policy"*, Edward Elgar, 2009, p. 290. See also Malobika Banerji, (n. 4), p. 2.

²² Irina Kireeva and Paolo R. Vergano, "Geographical indications and the interface between trade mark protection and sui generis protection: the example of China, Thailand and Vietnam", *International Trade Law & Regulation*, 2006, p.98. See also Dev Gangjee, "Geographic Indications and Trademarks: Quibbling Siblings: Conflicts Between Trademarks And Geographical Indications", *Chicago-Kent Law Review*, 2007, pp.1255, 1256.

²³ C. Seville, (n. 21), p. 290.

²⁴ Daniele Giovannucci - Tim Josling - William Kerr - Bernard O'Connor - May T. Yeung, "GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin", *International Trade Centre 2009*, p.5, available at: http://www.origin-gi.com/images/stories/PDFs/English/E-Library/geographical_indications.pdf, (accessed on 12 January 2016).

²⁵ C. Seville, (n.21), p. 290.

²⁶ Justin Hughes, "Champagne, Feta, and Bourbon: The Spirited Debate about Geographical Indications", *University of California, Hastings Law Journal*, 2006, pp. 305-306.

the geographical names per se of a country or a town (e.g. “cologne”), and indirect²⁷, i.e., indications expressed via traditional non-geographic names or symbols with a geographical evocation, like the case of “Feta” and “Basmati”²⁸. Moreover, it must be noted that the indication of the product and not the product itself is subject-matter of the protection²⁹.

The terms used for these geographical designations, often known as labels of origin³⁰, vary from country to country following the evolution of GIs protection as IP right worldwide. Certain terms are found in national and international legislation and there is no universally accepted definition³¹ of a GI, but the following description of the concept reflects the international spirit found in international treaties:

“A Geographical Indication identifies a good as originating in a delimited territory or region where a noted quality, reputation or other characteristic of the good is essentially attributable to its geographical origin and/or the human or natural factors there”³².

Although there are additional terms in national level such as denomination of origin (DO)³³, three are the key expressions that are used in the international level for this field: indications of source, geographical indications (GIs) and appellations of origin (AOs). These are supplemented by the European Union's four kinds of agri-food GIs :

²⁷ Malobika Banerji, (n.4), p. 2. See also the reference given by the author of what may constitute an indirect GI, i.e. “depictions of landmarks, familiar landscapes, heraldic signs, [and] well-known persons”, where also is mentioned a traditional type of a bottle for wine, a fact stated in the case of CJEU, C-16/83, “Karl Prantl” in Justin Hughes, “Champagne, Feta, and Bourbon: The Spirited Debate About Geographical Indications”, University of California, Hastings College of Law, Hastings Law Journal, 2006, p. 307. See also for more CJEU C-16/83, “Karl Prantl”, Criminal proceedings against Karl Prantl, 13 March 1984, ECR 1984 - 01299.

²⁸ J. Malbon, Ch. Lawson, M. Davison, “*The WTO Agreement on Trade - Related Aspects of Intellectual Property Rights, A Commentary*”, Edward Elgar, 2014, p. 332.

²⁹ Daniel Rogits, “EU geographical indications v US trademarks: TKO against the international harmonisation of the protection of geographical indications?”, *Intellectual Property Quarterly*, 2010, p.404.

³⁰ Inessa Shalevich, (n. 7), p. 67.

³¹ Teshager Dagne, (n.1), 2014, p.259.

³² As GI is defined in Daniele Giovannucci - Tim Josling - William Kerr - Bernard O’Connor - May T. Yeung, “GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin”, *International Trade Centre 2009*, p.5, available at: http://www.origingi.com/images/stories/PDFs/English/ELibrary/geographical_indications.pdf, (accessed on 12 January 2016).

³³ See glossary in Daniele Giovannucci - Tim Josling - William Kerr - Bernard O’Connor - May T. Yeung, “GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin”, *International Trade Centre 2009*, p.xii, available at: http://www.origin-gi.com/images/stories/PDFs/English/ELibrary/geographical_indications.pdf, (accessed on 12 January 2016).

(protected) designations of origin (PDO), (protected) geographical indications (PGI), traditional speciality guarantee (TSG) and optional quality term³⁴. A glance at the basic terms used may be helpful in understanding.

"*Indication of Source*" or also known as an indication of provenance or as simple "geographical indication" refers to a word, symbol, or device which indicates that a product originates in a specific geographic area. It is the most general term used to describe geographical designations and refers simply to a country, region or location as being the place of origin³⁵. These terms are mentioned but not defined in the Paris Convention for the Protection of Industrial Property and in Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods³⁶. The language used though declares that products bearing this type of indication, for instance a sign like "French wine" or "made in USA" simply inform consumers that the product comes from that particular place of origin with no correlation between the quality or characteristics of the product and that place. It is a broader concept including both appellations of origin and geographical indications³⁷ and it is not necessarily protected as GI³⁸ for public domain reasons (as I will explain later in this paper).

"*Geographical Indication*" is a sign or in other words as defined by TRIPS Agreement in Art.22 (1) an " indication 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"³⁹. Given the connection between the geographical place of origin and the particular

³⁴ Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on Quality Schemes for Agricultural Products and Foodstuffs, articles 4,5, 17,27.

³⁵ L. Bently, B. Sherman, "*Intellectual Property Law*", Oxford University Press, Fourth Edition, 2014, p.1112.

³⁶ Andras Jokuti, "Where is the what if the what is in why? A rough guide to the maze of geographical indications", *European Intellectual Property Review*, 2009, p. 118.

³⁷ L. Bently, B. Sherman, (n. 35), p.1112.

³⁸ Daniele Giovannucci - Tim Josling - William Kerr - Bernard O'Connor - May T. Yeung, "GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin", *International Trade Centre 2009*, p. 6,7, available at: http://www.origin-gi.com/images/stories/PDFs/English/E-Library/geographical_indications.pdf, (accessed on 12 January 2016).

³⁹ TRIPS Agreement article 22(1).

quality, reputation or other characteristics of the product, the specific GI on these products is considered qualified for protection⁴⁰.

"*Appellation of Origin*" is a specific type of geographical indication and refers to a "geographic name 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" according to the definition provided in the Lisbon Agreement for the Protection of Origin and their International Registration in Art. 2⁴¹. The term "appellation", because of the focus on the fact that quality or characteristics of the product "are due exclusively or essentially to its geographic environment", is sometimes construed as narrower than "geographical indication".⁴²

"*Protected designations of origin (PDO)*" is a term referred to a designation of origin that has been registered under the (EU) Quality Schemes Regulation for agricultural products and foodstuffs. In this framework a protected designation of origin is defined as "a name which identifies a product:

- (a) originating in a specific place, region or, in exceptional cases, a country;
- (b) whose quality or characteristics are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors; and
- (c) the production steps of which all take place in the defined geographical area"⁴³.

⁴⁰ Inessa Shalevich, (n. 7), p. 71. See also Daniel Rogits, (n. 29), pp. 403-407, *as well as* Daniele Giovannucci - Tim Josling - William Kerr - Bernard O'Connor - May T. Yeung, "GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin", *International Trade Centre 2009*, p. 7, available at: http://www.origin-gi.com/images/stories/PDFs/English/E-Library/geographical_indications.pdf, (accessed on 12 January 2016).

⁴¹ Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of 1958 article 2 (1) in conjunction with par. (3) of the same article.

⁴² See the structure and analysis of terms, including *appellation of origin* in L. Bently, B. Sherman, (n.35), p.1112. See also the explanation of terms in Daniele Giovannucci - Tim Josling - William Kerr - Bernard O'Connor - May T. Yeung, "GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin", *International Trade Centre 2009*, pp. 6,7, available at:http://www.origin-gi.com/images/stories/PDFs/English/E-Library/geographical_indications.pdf, (accessed on 12 January 2016).

⁴³ Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on Quality Schemes for Agricultural Products and Foodstuffs, article 5.

“Protected geographical indications (PGI)” describes a geographical indication that has been also registered under the (EU) Quality Schemes Regulation for agricultural products and foodstuffs. PGI is defined as “a name which identifies a product:

- (a) originating in a specific place, region or country;
- (b) whose given quality, reputation or other characteristic is essentially attributable to its geographical origin; and
- (c) at least one of the production steps of which take place in the defined geographical area”⁴⁴.

“Traditional speciality guarantee (TSG)” is another term used under the above EU Regulation but differentiates in relation to products concerned, which are traditional foods and recipes, namely not raw agricultural products but processed foods by traditional methods. A name is eligible for registration as TSG “where it describes a specific product or foodstuff that (a) results from a mode of production, processing or composition corresponding to traditional practice for that product or foodstuff; or (b) is produced from raw materials or ingredients that are those traditionally used and additionally this name have been traditionally used to refer to the specific product; or identify the traditional character or specific character of the product”⁴⁵.

“Optional quality term” was introduced also by the EU Quality Schemes Regulation with the aim to “facilitate the communication within the internal market of the value-adding characteristics or attributes of agricultural products by the producers thereof”⁴⁶. All the afore-mentioned geographical indications introduced by the EU legislation have a specific logo accompanying them, except the optional quality term⁴⁷.

Since the definitions provided by the EU legal framework depend on the type of protection sought under the basic international treaties on this field, specifically Lisbon-

⁴⁴ Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on Quality Schemes for Agricultural Products and Foodstuffs, article 5.

⁴⁵ Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on Quality Schemes for Agricultural Products and Foodstuffs, article 17.

⁴⁶ Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on Quality Schemes for Agricultural Products and Foodstuffs, article 27.

⁴⁷ See the relevant references and analysis in L. Bently, B. Sherman, (n. 35), p.1113-1114.

style or TRIPS-style generally, a clarification of the evolution and protection of GIs in Intellectual Property Rights (IPR) arena is needed to have a clear understanding of the GI concept.

B. The evolution and protection of GIs as IP rights in international treaties and in European regulatory scheme

Historically geographical or traditional designations are developed in national legislation of continental Europe with traditional methods of production for foods and wines. This is the case especially for France, Italy, Spain and to a lesser extend Germany⁴⁸. Champagne is a notorious example of the special legislation developed in Europe for GIs and more specifically the French system of appellations d'origine controlees (AOC), which is founded on the idea of *terroir* and the latter's embedded meaning of an "essential land/qualities nexus"⁴⁹. On the contrary the "New World" countries based on an industrial method of production⁵⁰ have developed different legislative norms for geographical designations, such as passing off, trade marks and certification marks⁵¹, which is founded on protection of product's reputation⁵². The difference in philosophy between the civil-law countries and common-law countries is illustrated both in protection status and terminology of geographical indications in international Intellectual Property Rights arena.

1. The protection of GIs as IP rights in international treaties

International protection of geographical indications is mainly rely on four international agreements: the Paris Convention of for the Protection of Industrial Property of 1883, the Madrid Agreement for the Repression of False or Deceptive Indications of Source of

⁴⁸ L. Bently, B. Sherman, (n. 35), p. 1111.

⁴⁹ Justin Hughes, (n.26), p. 306.

⁵⁰ Justin Hughes, (n. 26), p.339.

⁵¹ L. Bently, B. Sherman, (n.35), p. 1111.

⁵² See that reputation or goodwill of the producer is protectable under trade mark law and passing off in Anne-Marie Mooney Cotter, "*Intellectual Property Law*", Cavendish publishing, 2003, p. 7. See also Gr. Dutfield, U. Suthersanen, "*Global Intellectual Property Law*", Edward Elgar, 2008, pp. 135-136, 138-139, 154.

Goods of⁵³, the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (as amended by the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications adopted in 2015⁵⁴) and the TRIPS Agreement of 1994 under the WTO. Each agreement has its own unique definition and conditions for geographical indications; however, all the agreements are based on the term “indication” and (Further, it is important to keep in mind that the regulation and protection of a GI) protects only the indication or name and its relationship to the specific product, but not the product itself⁵⁵.

a) The Paris Convention for the Protection of Industrial Property

The Paris Convention was the first multilateral agreement which included geographical indications as one form of industrial property to be protected, among patents, marks, industrial designs etc. Although it refers to “indications of source or appellations of origin” thereby indicating a broad definition on the subject-matter, it fails however to provide a specific definition and a form of protection, leaving thus a very broad obligation of protection. It concerns the repression of unfair competition in the protected areas⁵⁶. Article 10 reading in conjunction with Article 9 imposes the sanction of seizure of goods in import under the “direct or indirect use of false indication of the source of the goods”⁵⁷, limiting thereby the protection to “false” indications only, but

⁵³ See also the Madrid System providing protection of marks via central international registration by one application to the countries designated (the Madrid system concerns trade marks mainly, including also GIs qualified for protection and it consisting of the Madrid Agreement Concerning the International Registration of Marks of 1891 and the Madrid Protocol of 1989 administered by the WIPO) in Daniele Giovannucci - Tim Josling - William Kerr - Bernard O'Connor - May T. Yeung, “GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin”, *International Trade Centre 2009*, pp. 42-43, available at: http://www.origin-gi.com/images/stories/PDFs/English/E-Library/geographical_indications.pdf, (accessed on 12 January 2016).

⁵⁴ Marcus Höpferger, Matthijs Geuze, “Negotiators Modernize International System for Registering GIs”, *WIPO Magazine 2015*, available at: http://www.wipo.int/wipo_magazine/en/2015/03/article_0001.html, (accessed on 12 January 2016).

⁵⁵ Daniel Rogits, (n. 29), p. 404.

⁵⁶ Daniele Giovannucci - Tim Josling - William Kerr - Bernard O'Connor - May T. Yeung, “GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin”, *International Trade Centre 2009*, p. 44, available at: http://www.origin-gi.com/images/stories/PDFs/English/E-Library/geographical_indications.pdf, (accessed on 12 January 2016).

⁵⁷ L. Bentley, B. Sherman, (n. 35), p. 1114.

not “misleading” ones⁵⁸. Although, the convention does not expressly note or include appellations of origin in Article 10, it is acknowledged to apply to both⁵⁹. Furthermore it has been supported that use of a false indication of source may constitute an act of unfair competition covered by Article 10bis (2) (3)⁶⁰.

b) The Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods

The Madrid Agreement went beyond the Paris Convention and offered protection against misleading indications also regardless of fraudulent intention of the user⁶¹, as Paris convention provided prior the Hague Revision of Article 10 to Art. 10bis. The new added article 10bis provided protection against passing off⁶² by imposing seizure or import prohibition for all products bearing such indications⁶³. Moreover, the Madrid agreement protects additionally against “false” or “misleading” indications with additions as “system”, “type”, “style” or the like. However, indications considered to be descriptive or generic are not protected, except the appellations applied to wine and wine-related products. The question whether or not an indication is generic has to be determined by “the tribunals of each country”⁶⁴ with the exclusion of appellations of origin of wine products, as the latter can never be declared generic by the national courts (tribunals). This discretion left to member states to decide about genericness is deemed the serious weakness of the protection under the Madrid agreement⁶⁵. The major advantage of Madrid arrangement however is that simplified the application process for registration through one application filed directly or via the relevant home

⁵⁸ Ch. Heath, A. K. Sanders, *“New Frontiers of Intellectual Property Law, IP and Cultural Heritage – Geographical Indications – Enforcement – Overprotection”*, Hart Publishing, 2005, p.98.

⁵⁹ Daniele Giovannucci - Tim Josling - William Kerr - Bernard O'Connor - May T. Yeung, *“GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin”*, *International Trade Centre 2009*, p. 44, available at: http://www.origin-gi.com/images/stories/PDFs/English/E-Library/geographical_indications.pdf, (accessed on 12 January 2016).

⁶⁰ L. Bently, B. Sherman, (n. 35), p. 1114.

⁶¹ L. Bently, B. Sherman, (n. 35), pp.1114-1115.

⁶² Ch. Heath, A. K. Sanders, (n. 58), p. 99.

⁶³ L. Bently, B. Sherman, (n. 35), pp. 1114-1115.

⁶⁴ Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods article 4.

⁶⁵ Ch. Heath, A. K. Sanders, (n. 58), pp. 98-100.

office to the International Bureau and getting central protection in the designated countries for the same trade mark constituting by a GI⁶⁶.

c) The Lisbon Agreement for the Protection of Appellations of Origin and their International Registration

The Lisbon agreement establishes an international system for the protection of appellations of origin. The agreement defines appellations of origin (AOs) narrower than geographical indications (GIs)⁶⁷, limiting thus the enhanced protection offered by it⁶⁸. It sets an international registration administered by the WIPO. Member-states can apply for registration of a name as AO, when it is protected first in its country of origin. The appellation is published and the member-states are notified to declare their refusal within 12 months. If no declaration is made, the participating states must protect the AO as long as it is protected in its country of origin⁶⁹. After registration of the appellation of origin, the name protected can no longer be considered as generic among the member-states of the agreement⁷⁰. Under the Lisbon agreement, unlike the Madrid agreement, no national court or tribunal, but this of the country of origin, can decide whether a foreign appellation of origin is generic or not, neither it can invalidate the relevant indication or mark, irrespective of if it concerns a wine-product or any other product⁷¹.

The Lisbon agreement obliges member-states to provide protection against misleading use of a protected AO, but moreover it expands the protection against any misuse,

⁶⁶ Daniel Rogits, (n. 29), p. 405.

⁶⁷ Lisbon Agreement for the Protection of Appellations of Origin and their International Registration article 2 “the geographical name of a country, region, or locality, which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors.”

⁶⁸ Ch. Heath, A. K. Sanders, (n. 58), p. 101. See also the reference of the authors that the definition in Lisbon excludes all geographical indications for industrial products from protection in the same page.

⁶⁹ L. Bently, B. Sherman, (n. 35), p. 1115.

⁷⁰ Lisbon Agreement for the Protection of Appellations of Origin and their International Registration article 6 and Ch. Heath, A. K. Sanders, (n. 35), pp. 104, 108. See also Daniele Giovannucci - Tim Josling - William Kerr - Bernard O’Connor - May T. Yeung, “GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin”, *International Trade Centre 2009*, p. 43, available at: http://www.origin-gi.com/images/stories/PDFs/English/E-Library/geographical_indications.pdf, (accessed on 12 January 2016).

⁷¹ See the analysis provided with the relevant case-law in Ch. Heath, A. K. Sanders, (n. 58), pp. 101-118.

usurpation or imitation, even if the true origin of the good is indicated, or if the appellation is translated or accompanied by suffixes such as “kind”, “type”, “make” or “imitation”. This absolute protection is offered without the condition of misleading the consumers in relation to product’s origin, as set by the previous conventions⁷². Furthermore, the agreement lays down the requirements for AOs, the procedure for acquiring protection as it has mentioned, the rights conferred and a conflict rule between appellations of origin and marks, rendering thus the protection provided as proprietary in nature⁷³.

It must be noted that the Lisbon agreement has been revised and updated by the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications, adopted in 2015, in an attempt to close the gap⁷⁴ in protection between Lisbon system for AOs and TRIPS system for GIs.

d) The TRIPS Agreement

In 1994, all member countries of the WTO have concluded to a universal treatment of GIs under the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS).⁷⁵ The TRIPS Agreement introduces the new term "geographical indications" providing the most extensive definition⁷⁶ of GIs. Article 22 (1) states that GIs are "... 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."⁷⁷ This definition requires for protection a link⁷⁸ established between the product and the GI based either on quality or reputation or other characteristics independently, provided that these

⁷² L. Bently, B. Sherman, (n.35), p. 1115.

⁷³ Ch. Heath, A. K. Sanders, (n. 58), p. 102.

⁷⁴ Daniel J. Gervais, “Reinventing Lisbon: The Case for a Protocol to the Lisbon Agreement (Geographical Indications)”, *Chicago Journal of International Law*, 2010, p. 86.

⁷⁵ Daniel Rogits, (n. 29), p. 406.

⁷⁶ Teshager Dagne, (n. 1), 2014, p. 262.

⁷⁷ TRIPS Agreement article 22 (1).

⁷⁸ Inessa Shalevich, (n. 7), p. 71.

characteristics are attributable to the place of product's origin⁷⁹. Therefore it is broader than the definition used in Lisbon agreement and applies also to all products, including industrial or artisan products which enjoy a particular reputation due to their know-how special technique⁸⁰. TRIPS agreement sets also the minimum standards⁸¹ for protection against misleading use or act of unfair competition according to Paris Convention Article 10bis⁸², but leaves the legal means for this purpose to be chosen by member-states⁸³. Additionally it offers the WTO international dispute settlement mechanism⁸⁴.

However, TRIPS agreement, as a compromise⁸⁵ of interests of Old world and New World countries, provides a two-tier system of protection, one of low protection applicable to all products and one of higher protection (Lisbon-style)⁸⁶ applicable only to wines and spirits⁸⁷. Moreover, the agreement sets forth detailed conflict rules between trade marks and geographical indications, following the above distinction between all goods (agri-food, industrial or artisan product) from one hand and wine and spirits from the other. Further it provides some exceptions to applicable rules and an obligation for further negotiations⁸⁸.

The key features of the granted protection are the following:

First, protection to all goods is non proprietary in principle but it is afforded only against act of unfair competition or use which "misleads the public as to the geographical origin of the good"⁸⁹. The language of "indicates or suggests" leads to the conclusion that the misleading perception may be resulted by a wrongful "evocation" of a place, like *Feta*

⁷⁹ Bernard O Connor, "Sui Generis Protection of Geographical Indications", *Drake Journal of Agricultural Law*, 2004, pp. 362-363.

⁸⁰ Ch. Heath, A. K. Sanders, (n. 58), p. 119.

⁸¹ Daniele Giovannucci - Tim Josling - William Kerr - Bernard O'Connor - May T. Yeung, "GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin", *International Trade Centre 2009*, p. 43, available at: http://www.origin-gi.com/images/stories/PDFs/English/E-Library/geographical_indications.pdf, (accessed on 12 January 2016).

⁸² L. Bently, B. Sherman, (n. 35), p. 1116.

⁸³ Kal Raustiala and Stephen R. Munzer, (n. 6), p. 343. See also Teshager Dagne, (n. 1), pp. 281-282.

⁸⁴ Daniele Giovannucci - Tim Josling - William Kerr - Bernard O'Connor - May T. Yeung, "GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin", *International Trade Centre 2009*, p. 41, available at: http://www.origin-gi.com/images/stories/PDFs/English/E-Library/geographical_indications.pdf, (accessed on 12 January 2016).

⁸⁵ Justin Hughes, (n. 26), p. 301.

⁸⁶ See the reference of the author that TRIPS "provide Lisbon-type protection (that is, even in the absence of consumer confusion) for geographical indications" in Daniel J. Gervais, (n. 74), p. 81.

⁸⁷ Tunisia L. Staten, (n. 5), pp. 221-222, 224-225.

⁸⁸ TRIPS Agreement art. 22-24.

⁸⁹ TRIPS Agreement article 22(2).

for Greek cheese or *Basmati* for Indian rice⁹⁰. Further, the public misled is deemed that in the country where the protection is sought. To the extent that the relevant public in a specific country does not consider a GI as generic, namely the “common name for such goods”⁹¹ no misconception can happen. Moreover, the protection is granted as long as the GI is protected as such in its country of origin.

Second, the higher protection to wines and spirits is given without the above condition of misleading use or act of unfair competition, even if the true origin of the goods is indicated, the GI is translated or is accompanied by expressions as “type”, “style”, “imitation” or the like. An exception to this rule is provided in Art. 24(4) for prior use in good faith or for use at least 10 years before the conclusion of TRIPS agreement.

Third, TRIPS follows two-tier conflict rules between trade marks and GIs for all products and for wines and spirits only. Under these provisions, trade marks consisting of geographical indications, the use of which is misleading in relation to the true place of origin, have to be refused or invalidated, in the first case, whereas, In the second case, the trade mark must me refused or invalidated, even in absence of misconception of the public. Again an exception is provided for trade marks that have been applied or registered or acquired by use in good faith before the TRIPS came to force.

Finally, a “grand father or Champagne” exception is prescribed in Art. 24(6), according to which member-states are not obliged to protect a GI , both for wines and other goods, if the term used is generic⁹², i.e. “customary in common language as the common name for such goods or services in the territory of that member”⁹³. Therefore the protection of generic names or indications has been left to the discretion of each member⁹⁴ along with the determination of the status of homonymous names⁹⁵, for example in prior colonies⁹⁶ of Europe in the USA or elsewhere.

Nonetheless, not all geographical designations fit in the definition and protection of the TRIPS. This becomes apparent in the case of appellations of origin under Lisbon

⁹⁰ J. Malbon, Ch. Lawson, M. Davison, (n. 28), p.332.

⁹¹ TRIPS Agreement article 24(6).

⁹² See the structure of protection in TRIPS as analysed in Ch. Heath, A. K. Sanders, (n. 58), pp. 120-121.

⁹³ TRIPS Agreement article 24(6).

⁹⁴ Daniel Rogits, (n.29), p. 407.

⁹⁵ L. Bently, B. Sherman, (n. 35), p. 1116. See also TRIPS Agreement art. 22(4), 23(3).

⁹⁶ Kal Raustiala and Stephen R. Munzer, (n. 6), p. 349.

agreement. A comparison between them arises three main differences: a) the wording used in Lisbon agreement seems to refer exclusively to direct geographical indications of origin, i.e. geographic names of a place per se, excluding thus indirect indications, like *Feta* or *Basmati* or *Bud*⁹⁷, or other signs and symbols with a geographical evocation in mind of consumers (such as the Taj Mahal for Indian goods)⁹⁸; b) the unique quality and features of a product protected as AO must be “due exclusively or essentially to the geographical environment, including natural and human factors”⁹⁹, establishing thus a link based on the idea of *terroir*¹⁰⁰, namely a combination of natural *and* human factors that gives the product's distinctive quality *and* characteristics with the nature as essential component; c) the reputation is not included as criterion for a product to be qualified and protected as AO. In contrast, TRIPS gives a more flexible definition expanding the scope of protection to all products which meet the conditionality list of quality, reputation or other characteristics taken into account independently of each other and with the ability of products to be indicated directly or indirectly by any word, sign or symbol¹⁰¹.

However, as the reputation seems to be assumed in Lisbon agreement and its French version using the term “designation” instead of “name” *stricto sensu*, there are not crucial functional differences¹⁰² between the Lisbon and TRIPS agreement. This position has been adopted by the WIPO by the Geneva Act and the subsequent revision of the Lisbon agreement as a step to close the regulatory gap between them. Specifically, the updated Lisbon agreement sets an international register both for AOs and GIs. Moreover, not only member-states can apply for registration to the international bureau of WIPO, but also international organizations (like the EU) and legal or natural persons, meaning producers¹⁰³. For a name to be registered must first be protected in

⁹⁷ See that “*Bud*” which is an indirect geographical indication for Czech beer it has been accepted as appellation of origin under Lisbon agreement by the CJEU in Joined cases T-225/06, T-255/06, T-257/06 and T-309/06, “*Budejovický Budvar národní podnik vs Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*”, 16 December 2008.

⁹⁸ Inessa Shalevich, (n. 7), p. 69.

⁹⁹ Lisbon Agreement for the Protection of Origin and their International Registration of 1958 article 2 (1).

¹⁰⁰ Kal Raustiala and Stephen R. Munzer, (n. 6), p. 344. See also Justin Hughes, (n. 26), pp. 301, 304.

¹⁰¹ Daniel J. Gervais, (n. 74), pp. 83-86.

¹⁰² See the reference that the CJEU has defined appellations of origin and indications of source in similar terms in “*Exportur*” in Ch. Heath, A. K. Sanders, (n.58),p. 134 and see CJEU “*Exportur*” case, C-3/91, *Exportur SA v LOR SA and Confiserie du Tech SA*, 10 November 1992.

¹⁰³ Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications article 5.

the country of origin. The appellation or the indication is published and member-states are notified to declare their refusal within a time period. If no refusal has been made, the registration is valid and the AO or GI can no longer be considered as generic in contracting states. Registration therefore triggers the protection afforded, which will be granted and be enforced pursuant to the legal system of each member-state¹⁰⁴.

The protection of GIs in EU regulatory scheme

a) The EU legal framework in general

The European Union created a *sui generis* protection system for the geographical indications due to the importance given to them as part of the common agricultural policy (CAP). Regulation 1151/2012 establishes a uniform legislative framework for all agricultural products and foods, whereas there are different regulations for wine (Regulation 1308/2013)¹⁰⁵ and spirits (Regulation 110/2008)¹⁰⁶ in line with the Regulation for agricultural products, except the use of PDO for spirits. It is worth to be mentioned that no protection is afforded to non-agricultural products, like handicrafts, under the EU law¹⁰⁷.

Moreover, there is a separate legal regime for individual and collective trade marks at Community level¹⁰⁸, which can be used complementary or exclusively¹⁰⁹ to the above *sui generis* regulation system.

¹⁰⁴ Teshager Dagne, (n. 1), pp. 281-282.

¹⁰⁵ Regulation (EU) No 1308/2013 of the European Parliament and of the Council of 17 December 2013 establishing a common organisation of the markets in agricultural products.

¹⁰⁶ Regulation (EC) No 110/2008 of the European Parliament and of the Council of 15 January 2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit.

¹⁰⁷ Roland Knaak, "Geographical indications and their relationship with trade marks in EU law", *International Review of Intellectual Property and Competition Law*, 2015, pp. 846-849.

¹⁰⁸ See the relevant Trade mark Directive (TMD) 2008/95/EC and Community Trade mark Regulation (CTMR) (EC) 207/2009.

¹⁰⁹ Roland Knaak, "Geographical indications and their relationship with trade marks in EU law", *International Review of Intellectual Property and Competition Law*, 2015, pp. 857.

b) EU Regulation 1151/2012 on quality schemes for agricultural products and food stuffs

The EU Regulation 1151/2012 or Quality Scheme Regulation (hereafter the EU GI Regulation) replaced both the 2006 GI Regulation and the 2006 Traditional Specialities Regulation, encompassing the relevant regulatory schemes (PDO, PGI, TSG), while it added one more “Optional Quality Terms”¹¹⁰. The aim is the simplification of the legislation under a single legal instrument with more efficient application procedure and more strict standards of certification and enforcement¹¹¹. The provided regulatory schemes are different both as to the products covered and the protection granted. The two main designations, i.e. PDO and PGI concern almost all agricultural products and basic foods like meat, fish and dairy for human consumption, while the TSG refers to recipes and prepared meals or foods, like pasta or ice-cream, with traditional character on production method or the raw materials used¹¹². Further, the Optional Quality Term relates to any specific characteristic of a product, or a farming or processing attribute that adds value to it and it is not technical, like “reduced fat” or “first pressure” for olive oils. This new scheme seems to be more appropriate for marketing standards or labeling of products than an industrial property right¹¹³.

It is worth to be noted that the requirements for protection and the definitions of protected designation of origin (PDO) and protected geographical indication correspond to the TRIPS agreement¹¹⁴. However, the difference with TRIPS is that the enhanced protection for wines and spirits is given to all agri-food products bearing the both afore designations. Specifically, the PDO is defined strict, similar to AO in Lisbon agreement, as it implies that the product must exhibit particular quality or characteristics that are essentially due to the geographical environment, including natural and human factors, requiring thus a strong land/quality nexus. This link based on the notion of *terroir* must

¹¹⁰ L. Bently, B. Sherman, (35), p. 1118.

¹¹¹ G.E. Evans, “The simplification of European legislation for the protection of geographical indications: the proposed Regulation on Agricultural Product Quality Schemes”, *European Intellectual Property Review*, 2012, p. 770.

¹¹² G.E. Evans, (n. 111), 2012, p. 770.

¹¹³ G.E. Evans, (n. 111), 2012, pp. 772,773.

¹¹⁴ L. Bently, B. Sherman, (n. 35), p. 1118. See also G.E. Evans, (n. 111), pp. 773-775.

be also accompanied by the stringent condition that the production and processing of the product, i.e. all production steps have to take place within the defined geographic area. On the other hand, the PGI is defined broadly (like GI in TRIPS) requiring a quality or reputation or other characteristics to be generally "attributable" to the geographic area, establishing thus a looser link between the product and the reputation of the place, while the product must be produced or processed in that defined area¹¹⁵, with the consequence that all the raw materials may be sourced from outside¹¹⁶.

The scope of protection is the same for both terms, since registered names as PDO or PGI shall be protected against commercial use for identical or "comparable" products, against misuse, imitation or evocation, even if the true origin is indicated and against of false or misleading use, incorporating translations of the name or use accompanied with expressions such as "style", "type", "imitation" or the like¹¹⁷. Although the term "name" is used in the definitions of PDO, PGI, the protection is accorded to direct and indirect geographical indications, such as *Feta* used for Greek cheese, which refers to the Latin word "slice" provided that "evokes" a certain geographic area; in other words it must not be considered generic¹¹⁸ to get protection.

The protection is afforded by registration via a one-step application procedure by groups of producers or processors of the same product in the defined area and a two-fold examination by national authorities and the Commission, with the provision of an opposition procedure within short time limits. Generic names are excluded from protection, as also do names of plant varieties or animal breeds or homonymous or names conflict with trade marks in case of misleading the public¹¹⁹. Moreover, a product specification is established and the right to use of a registered PDO or PGI is afforded to any operator complying with the relevant rules¹²⁰. In the end, if a name is registered as

¹¹⁵ See the corresponding to definitions in Lisbon and TRIPS agreement as well as the structure of registration procedure in Roland Knaak, (n. 107), pp. 844-845, 849-855.

¹¹⁶ Gail Evans, "The protection of geographical indications in the European Union and the United States under sui generis and trade mark systems: signs of harmonization?", *Intellectual Property Quarterly*, 2013, p.22.

¹¹⁷ Regulation (EU) 1151/12 article 13(1). See also C. Seville, (n. 21), p. 302.

¹¹⁸ L. Bently, B. Sherman, (n. 35), p. 1124. See also Ch. Heath, A. K. Sanders, (n. 58), p. 126, as well as C. Seville, (n. 21), pp. 297-298. See moreover J. Malbon, Ch. Lawson, M. Davison, (n.28), p. 332.

¹¹⁹ Regulation (EU) 1151/12 article 6.

¹²⁰ Regulation (EU) 1151/12 article 46.

PDO or PGI it is protected indefinitely and it cannot become generic¹²¹, with the only option remaining of amending or cancellation. Additionally a strict *ex officio* enforcement and monitoring procedure for compliance is set¹²².

The same is true a for traditional specialities guarantee (TSG) as to the procedure and protection given in general¹²³, except the scope of protection, which is lower than provided in PDO and PGI, because it refers only to misuse, imitation or evocation or any other misleading practice¹²⁴.

Optional quality term is vaguely defined as any characteristic adding value to a product and has a European dimension¹²⁵ “in order to facilitate the communication of these value-adding features of the product in the internal market”¹²⁶. There are no stringent requirements for protection, but the exclusion of technical and marketing standards, while there is reservation and conditions of use instead of registration and specification of the product. The reserved term “may only be used to describe products conforming to the conditions of use”¹²⁷. It seems as a transitional form of legal instrument with more informing nature than IP right.

It is important also to keep in mind that the nature of the Quality Schemes Regulation is exhaustive in nature, as they were and the previous ones, in the sense that geographical indications qualified for protection under this EU Regulation may not be regulated and protected under national laws, except simple geographical indications¹²⁸ and optional quality terms¹²⁹.

¹²¹ Regulation (EU) 1151/12 article 13(2).

¹²² GailEvans,(n.116),2013,pp.21-24. See also Regulation 1151/12 art. 53,54,13(3),7(1)(g),37-40.

¹²³ Roland Knaak, (n. 107), 2015, pp.849-855. See also the specific provisions of Regulation 1151/12 art. 17-26 in conjunction with the common provisions art.35-57.

¹²⁴ Regulation (EU) 1151/12 article 24.

¹²⁵ Regulation (EU) 1151/12 article 29.

¹²⁶ Regulation (EU) 1151/12 article 27.

¹²⁷ Regulation (EU) 1151/12 article 33.

¹²⁸ Roland Knaak, (n.107), pp.855-856. See also CJEU “*Salame Felino*”, C-35/13, Assica - Associazione Industriali delle Carni e dei Salumi v Associazione fra produttori per la tutela del 'Salame Felino', 8 May 2014, where the exhaustive nature of EU Regulation is affirmed and also is stated that “[that] geographical designation may be protected, should the case arise, under national legislation concerning geographical designations relating to products for which there is no specific link between their characteristics and their geographical origin, provided, however, that, first, the implementation of that legislation does not undermine the objectives pursued by Regulation No 2081/92 as amended by Council Regulation (EC) No 535/97 and, secondly, it does not contravene the principle of the free movement of goods under Article 28 EC”.

¹²⁹ EU Regulation (EU) 1151/12 article 28.

CHAPTER II: Scrutinizing the two antagonistic basic models of protection : the common law and the civil law approaches

As a form of intellectual property the geographical indication (GI) is protected in several different ways. However, two are the basic models of protecting GIs as defined in TRIPS; the *sui generis* system of the EU (analysed above) and the trademark law system of the USA, which each one reflects the rationale of civil-law and common-law jurisdictions for product identifiers based both on origin and quality respectively¹³⁰.

A. Common-law perspective : the USA trademark model

The United States and other common-law jurisdictions don't have a register for GIs, neither special law, because they view GIs as a subsection of Trademark law and unfair competition law in general, due to their similar function to trade marks as source identifiers, guarantees of quality and valuable business assets¹³¹.

Marks which function as signs in the marketplace are protected as trade marks under trade mark law, usually based on registration or actual use in trade. A sub-category is the common-law action of passing off, covering mainly unregistered marks with goodwill¹³² or reputation, but providing less protection than the broader - all inclusive - concept of unfair competition applicable to all IP rights¹³³.

Unfair competition acts parallel to competition law by regulating the behavior of competitors in the marketplace in accordance to "honest practices in industrial or

¹³⁰ Daniele Giovannucci - Tim Josling - William Kerr - Bernard O'Connor - May T. Yeung, "GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin", *International Trade Centre 2009*, pp.49,54-55,59-62,64-67, available at: http://www.origingi.com/images/stories/PDFs/English/ELibrary/geographical_indications.pdf, (accessed on 12 January 2016). See also Gail Evans, (n. 116),2013, p. 18. See also Inessa Shalevich, (n. 7), p. 67.

¹³¹ Daniele Giovannucci - Tim Josling - William Kerr - Bernard O'Connor - May T. Yeung, "GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin", *International Trade Centre 2009*, p. 65, available at: http://www.origingi.com/images/stories/PDFs/English/ELibrary/geographical_indications.pdf, (accessed on 12 January 2016).

¹³² See also for the notion of goodwill the "Fage" case for Greek yoghurt by UK Court of Appeal between Fage UK Ltd & Anor v Chobani UK Ltd & Anor, 28th January 2014, [2014] EWCA Civ 5, available at: www.bailii.org/ew/cases/EWCA/Civ/2014/5.html, (accessed on 12 January 2016).

¹³³ Gr. Dutfield, U. Suthersanen, (n. 133), pp. 14, 136,152-158. See also Anne-Marie Mooney Cotter, (n.52), 2003, p. 21.

commercial matters”¹³⁴ with the aim the competition not be stifled nor be threatened by dishonest acts of imitating products or confusing or misleading consumers as to the origin, quality and other characteristics of the products¹³⁵.

Passing off is formulated mainly by case-law in common-law countries, rather than statutory law and “allows a trader to prevent another trader from passing their goods off as if they were the first traders”. It requires no registration of the mark but the claimant to had goodwill, (i.e. reputation,) the misrepresentation by the defendant in any form likely to deceive prospective customers and also likely to damage the claimant¹³⁶.

The United States law defines *trademarks* as “any word, name, symbol, or device, or any combination thereof,” used by a person to identify and distinguish her goods from those produced and sold by others. Collective marks are those marks used by associations, unions, cooperatives, or other organized collective groups, while certification marks are those marks used by a party or parties other than the owner of the mark to certify some aspect of the third parties' goods and services¹³⁷.

Collective marks belong only to public or private groups, like trade associations and are used by the members of the group to identify their goods or services and distinguish them from those of non-members. Use of a collective mark requires membership in the group owning the mark. Collective marks indicate commercial origin of products as regular trade marks do, but they indicate origin as membership of a group rather than origin in any one member or party of the collective association. All members of the group use the mark so no one member can individually own the mark, while the collective organization holds the title of the owner of the collective mark and it can use

¹³⁴ Paris Convention for Protection of Industrial property article 10bis.

¹³⁵ Gr. Dutfield, U. Suthersanen, (n. 133), pp. 156-158.

¹³⁶ Gr. Dutfield, U. Suthersanen, (n. 133), pp. 154-155. See also Anne-Marie Mooney Cotter, (n. 52), pp. 21-22.

¹³⁷ Inessa Shalevich, (n. 7), p. 68.

it to produce and promote its own goods and those sold by its members under the mark¹³⁸.

However, Geographic names or signs cannot be registered as trade marks or collective marks because they are geographically descriptive¹³⁹, namely they lack of a necessary distinctiveness or secondary meaning, i.e. indicating the public a specific commercial origin-producer of the good¹⁴⁰. For this reason, a statutory derogation¹⁴¹ has been provided in order such marks can be registered as certification marks under the U.S. Trademark Act without showing any acquired distinctiveness¹⁴².

Certification marks can be used to certify more than one characteristic of the goods, such as regional or national origin, material, mode of manufacture or quality in more than one certification category¹⁴³. They convey the afore information to consumers like regular trade marks, but they have three distinct differences. First, a certification mark owner does not use it. Second, a certification mark does not indicate commercial source nor distinguish the goods of one producer to another. Third, certification marks affirm that the goods have met specific required standards set and controlled by the certification mark owner. Any entity that meets the certifying standards, which may include designation of geographical area or certain qualities of the product, is entitled to use the certification mark and its owner or any other person cannot stop its use.

For a certification mark to serve as a GI requires: a) consumers to understand that the specific mark refers only to goods produced in the named and designated area (specified geographic area); b) the specific products meet the standards set by the mark owner (compliance with explicit certification standards and product specification); and c) the certification mark owner to control the use of the geographic name and limit the

¹³⁸ Daniele Giovannucci - Tim Josling - William Kerr - Bernard O'Connor - May T. Yeung, "GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin", *International Trade Centre 2009*, p.67, available at: http://www.origingi.com/images/stories/PDFs/English/ELibrary/geographical_indications.pdf, (accessed on 12 January 2016). See also Inessa Shalevich, (n. 7), p. 72.

¹³⁹ Inessa Shalevich, (n. 7), pp. 72-73.

¹⁴⁰ Dev Gangjee, "Geographic Indications And Trademarks: Quibbling Siblings: Conflicts Between Trademarks And Geographical Indications", *Chicago-Kent Law Review*, 2007, pp. 1258, 1284.

¹⁴¹ Gail Evans, (n. 116), 2013, p. 24.

¹⁴² Inessa Shalevich, (n. 7), pp. 72-73.

¹⁴³ Inessa Shalevich, (n. 7), p. 73.

use of the mark only to those goods meeting the certification standards¹⁴⁴. A geographical term indicating regional geographical origin cannot be owned by individual or group producers, but only to be used as a mark that certifies the geographical origin of goods of its members¹⁴⁵. Moreover, in the USA usually a governmental body controls the use of geographical terms as certification marks to safeguard the freedom of all persons in the region to use the term and preventing abuses or illegal uses of the mark¹⁴⁶. However, the inspection of compliance with certification standards and the legal action against any unauthorized use is vested in principle¹⁴⁷ on mark owners, both in cases of collective or certification marks¹⁴⁸.

B. Scrutinizing the two antagonistic models of protection of GIs

A comparison between the two models of protection of GIs it makes clear that the two models have many similarities, but also and key differences. Particularly, certification mark when serves as a regional mark, the most close one to the EU GI Regulation¹⁴⁹, indicates that certain goods come from a designated geographical area, like PDO,PGI or TSG in EU Regulation, but in contrast to EU GI Regulation it does not confine its use in the specified area; further, it indicates that goods exhibit certain qualities or characteristics in conformity with certifier's standards, the respective product specification in both regulatory systems, without though requiring a product linkage with the place of production, as it is the case in the EU GI Regulation; moreover the

¹⁴⁴ Daniele Giovannucci - Tim Josling - William Kerr - Bernard O'Connor - May T. Yeung, "GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin", *International Trade Centre 2009*, p.66, available at: http://www.origingi.com/images/stories/PDFs/English/ELibrary/geographical_indications.pdf, (accessed on 12 January 2016). See also Tunisia L. Staten, (n. 5), p. 236-240.

¹⁴⁵ Tunisia L. Staten, (n. 5), p. 237.

¹⁴⁶ Inessa Shalevich, (n. 7), pp. 73-74. See also in p. 74 of the same article the reference of the author that "The USPTO has stated that "a private individual is generally not in the best position to fulfill these objectives satisfactorily." The government of a region must control the use of a region's name, preserve the right of all persons, and prevent abuse or illegal use of the mark (either directly or through a body) to which it has given authority."

¹⁴⁷ Daniele Giovannucci - Tim Josling - William Kerr - Bernard O'Connor - May T. Yeung, "GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin", *International Trade Centre 2009*, p. 54, available at: http://www.origingi.com/images/stories/PDFs/English/ELibrary/geographical_indications.pdf, (accessed on 12 January 2016).

¹⁴⁸ Tunisia L. Staten, (n. 5), pp. 238,240.

¹⁴⁹ Gail Evans, (n. 116), 2013, p. 23.

specified standards are set by a certification mark owner alone along with the regulations governing the use of mark¹⁵⁰, a private party usually, instead the law¹⁵¹ and the following guarantee of a public authority¹⁵². Whereas both regulatory models reserve geographic terms under control of governmental authority and safeguard that the ownership of the sign (mark or protected GI) is collective and a right to use is afforded to anyone satisfy the requirements set by the rules, the protection however differs. The EU GI Regulation grants an absolute protection in nature of indefinite duration for protected PDO or PGI so long as the conditions of product specification are met and the relevant names or signs have been registered¹⁵³. More specifically the EU GI Regulation prevents any direct or indirect commercial use, any misuse, imitation, evocation or other misleading use, even when the true origin of the good is indicated or even in case that the protected name is translated or accompanied with suffixes “type” and the like. The protection is given for identical and “comparable” meaning similar products¹⁵⁴ with the additional option of covering dissimilar products in the event of exploitation of the name’s reputation¹⁵⁵ (e.g. “Champagne shampoo”)¹⁵⁶; in other words the Regulation offers also anti-dilution protection¹⁵⁷.

¹⁵⁰ See also Daniele Giovannucci - Tim Josling - William Kerr - Bernard O’Connor - May T. Yeung, “GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin”, *International Trade Centre 2009*, p.66, available at: http://www.origingi.com/images/stories/PDFs/English/ELibrary/geographical_indications.pdf, (accessed on 12 January 2016). See also Ch. Heath, A. K. Sanders, (n. 58), p. 137.

¹⁵¹ Regulation (EU) 1151/12 articles 7, 19, 46 for product specification and right of use EU schemes.

¹⁵² See that law and government is considered essential to protect and enable democratic and equitable participation to all people as GIs is deemed “public property” in Daniele Giovannucci - Tim Josling - William Kerr - Bernard O’Connor - May T. Yeung, “GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin”, *International Trade Centre 2009*, pp. 55, 93, 101, available at: http://www.origin-gi.com/images/stories/PDFs/English/E-Library/geographical_indications.pdf, (accessed on 12 January 2016).

¹⁵³ Gail Evans, (n. 116), 2013, pp. 21-26.

¹⁵⁴ See how the CJEU defines “comparable” products in “Cognac” case for spirit drinks, CJEU Joined Cases C-4/10 and C-27/10, of 14 July 2011, *Bureau national interprofessionnel du Cognac v Gust. Ranin Oy*, para 54 where “products comparable to the spirit drink registered under that geographical indication. Regardless of their various categories, ‘spirit drinks’ covers drinks which have common objective characteristics and which are consumed, from the point of view of the relevant public, on occasions which are broadly identical. Furthermore, they are frequently distributed through the same channels and subject to similar marketing rules.”. See also the comment on protection given in comparable products in Gail Evans, “The protection of geographical indications in the European Union and the United States under sui generis and trade mark systems: signs of harmonization?”, *Intellectual Property Quarterly*, 2013, pp. 39-40.

¹⁵⁵ Regulation (EU) 1151/12 article 13.

On the contrary, the USA trade mark law as the passing off in common-law countries does not require registration to grant protection, but certainly actual use in trade and distinctiveness¹⁵⁸ with reputation¹⁵⁹; further the rights of trade mark owners are protected under the double identity/similarity of trade marks and products only against misleading or confusing¹⁶⁰ or deceptive use¹⁶¹ of other traders, allowing thus the slavish imitation with labeling of true origin or by use of expressions “type”, “style” and the like. Moreover, anti-dilution protection covering dissimilar products for the safeguarding of the distinctiveness or reputation of the mark is afforded only to *famous* and distinctive trade marks, a separate category of marks with higher standards¹⁶². Furthermore, the EU GI Regulation provides that generic terms are not eligible for registration¹⁶³ and consequently for protection, by prescribing also a definition of “generic”¹⁶⁴ and the criteria for that assessment¹⁶⁵. Additionally, under the EU GI Regulation once a name or

¹⁵⁶ See the reference of the author that the use of the slogans "Champagne Shampoo" and "Champagne everyday" has been successfully challenged by The Comité Interprofessionnel du Vin de Champagne (CIVC), the body representing the interests of champagne houses and wine-growers, as an action infringing the prohibition against "any direct or indirect commercial use of a protected name" before the court of The Hague in Gail Evans, "The protection of geographical indications in the European Union and the United States under sui generis and trade mark systems: signs of harmonization?", *Intellectual Property Quarterly*, 2013, p. 36.

¹⁵⁷ Gail Evans, (n. 116), 2013, p. 36.

¹⁵⁸ See also Gr. Dinwoodie and M. D. Janis, *Trademark Law and Theory, A Handbook of Contemporary Research*, Edward Elgar, 2008, p. 268-273. See further C. Seville, (n. 21), p. 318.

¹⁵⁹ See that confusion only is not sufficient under passing off and an established trade reputation is required also to grant protection in Gr. Dutfield, U. Suthersanen, (n. 133), p. 155. See further that the aim of protection in passing off focus on the goodwill of a business in trade, i.e. sufficient reputation capable of create confusion and mislead the public as to the producer in Anne-Marie Mooney Cotter, (n. 52). See specifically for goodwill the “Fage” case for Greek yogurt by UK Court of Appeal UK FAGE Ltd v Chobani UK Ltd of 28 January 2014, available at [2014] EWCA Civ 5; [2014] E.T.M.R. 26.

¹⁶⁰ See also that tort or harm in classic Trade mark law is defined as likelihood of consumer confusion in Gr. Dinwoodie and M. D. Janis, (n. 158), p. 273.

¹⁶¹ See also that deceptive means fraud, the second purpose of TM protection after confusion in C. Seville, (n. 21), p. 318. See further the full requirements as prescribed in Lanham Act “where such use is likely to cause confusion, or to cause mistake, or to deceive” in Gr. Dinwoodie and M. D. Janis, (n. 158), p. 134.

¹⁶² See that common-law trademark law in general is analogous to EU trade mark rules (especially the rules of double identity or similarity and famous or well-known trade marks) and read them in conjunction in order to understand the disparities, as analysed in Gr. Dutfield, U. Suthersanen, (n. 133), pp. 150-156 and pp. 146-150. See also for famous trade mark definition and standards, which result “restricting dilution protection to marks that are famous nationwide” in Gail Evans, (n. 116), 2013, p. 35.

¹⁶³ EU Regulation 1151/12 article 6.

¹⁶⁴ EU Regulation 1151/12 article 3 “‘generic terms’ means the names of products which, although relating to the place, region or country where the product was originally produced or marketed, have become the common name of a product in the Union”.

¹⁶⁵ Regulation (EU) 1151/12 article 41(2).

sign registered as PDO or PGI or TSG cannot become generic¹⁶⁶. This is not the case under the USA trade mark law, since there are general provisions for the assessment of generic term according to public perception in USA only¹⁶⁷, while neither a registration as trade mark can prevent a name or sign of a product to become generic¹⁶⁸, namely loss of its distinctiveness in consumer eyes, but this burden along with the onus of monitoring and enforcement of the right is left on trade mark owner's shoulders. Trade mark holder has to prove eligibility for registration first (namely distinctiveness of the mark) and then he has to protect and enforce the right by commencing legal action against any unauthorized use that it is likely to harm his legal interests within the limits of "fair use" or "honest practice in commerce" as defense¹⁶⁹. Moreover, under trade mark law quality, method of production or geographical origin are not statutory obligations¹⁷⁰. On the contrary, in the EU GI Regulation the protection and enforcement of the right is a mix of private legal proceedings and administrative process carried out by national authorities, responsible also for the monitoring and verification of compliance with product specification¹⁷¹. Hence product quality, standards of production and geographical origin and thus authenticity are obligations embedded in the EU GI Regulation¹⁷².

An alternative solution with same requirements and results in protection as USA trade mark law is provided also in the EU law, under Trade mark Directive (TMD) and Community Trade Mark Regulation (CTMR). Pursuant to art. 7(1)(c) CTMR and art. 3(1)(c) TMD, signs that consist exclusively of a geographical indication are subject to an absolute ground for refusal of registration and such signs are allowed to be registered as individual trade marks only when they have acquired a sufficient distinctive character¹⁷³

¹⁶⁶ Regulation (EU) 1151/12 article 13(2).

¹⁶⁷ Daniel Rogits, (n. 29), pp. 404, 408-409.

¹⁶⁸ Ch. Heath, A. K. Sanders, (n. 58), p.153.

¹⁶⁹ Gail Evans, (n. 116), 2013, pp. 28, 32-35.

¹⁷⁰ J. Curci, *"The Protection of Biodiversity and Traditional Knowledge in International Law of Intellectual Property"*, Cambridge University Press, 2010, p. 323.

¹⁷¹ Roland Knaak, (n. 107), pp. 853-856. See also Gail Evans, (n. 116), 2013, p. 44.

¹⁷² Regulation (EU) 1151/12 articles 1, 4,5,7,8,17,19,20,27,29,34,38,46. See also the preamble of the regulation.

¹⁷³ Roland Knaak, (n. 107), pp. 856-857. See also CTMR article 7(1)(c) "trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the

or secondary meaning, that is indicating in minds of consumers a specific undertaking-producer ("*Chiemsee*" case)¹⁷⁴. This occurs only¹⁷⁵ where a mark combines a geographical indication (a GI) with other (mostly graphic) elements. However, in this combination mark the GI itself is precluded from protection, as an indication that must be left on public domain use¹⁷⁶. A derogation¹⁷⁷ from proof of distinctiveness in relation to GIs as part of a trade mark is provided both for collective national (under TMD) and Community trade marks (under CTMR). Generic names are also precluded from registration according to CTMR¹⁷⁸, while the question whether GIs can be registered as certification marks is regulated free by national laws in line with TMD provisions. Further, the other requirements, such the lack of a statutory obligation of a link with the place of production or use only in a demarcated geographical area along with a "flexible" product specification for quality or production standards set by the mark owner, are the same as under US trade mark law. The same is true also for the enforcement and protection of the mark by the trade mark holders in principal, while the scope of protection is limited only in misleading or confusing use and the exclusive Union-wide effect of right to use the mark cannot be invoked against entitled persons to use a GI under the EU GI Regulation¹⁷⁹.

service, or other characteristics of the goods or service" and TMD article 3(1)(c) "trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services".

¹⁷⁴ CJEU "*Chiemsee*" case, Joined cases C-108/97 and C-109/97, *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber and Franz Attenberger*, 4 May 1999. See also the comments in G.E. Evans, "The strategic exploitation of geographical indications and Community trade marks for the marketing of agricultural products in the European Union", *WIPO Journal*, 2010, p. 166.

¹⁷⁵ See that another distinguishing element is necessary for TM, otherwise it privatises expressions of the common language or is not distinctive in Andras Jokuti, (n. 36), p. 122 and in Roland Knaak, (n. 107), p. 857.

¹⁷⁶ Roland Knaak, (n. 107), p. 857. See also Daniele Giovannucci - Tim Josling - William Kerr - Bernard O'Connor - May T. Yeung, "GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin", *International Trade Centre 2009*, p. 56, available at: http://www.origin-gi.com/images/stories/PDFs/English/E-Library/geographical_indications.pdf, (accessed on 12 January 2016).

¹⁷⁷ See also G.E. Evans, "The strategic exploitation of geographical indications and Community trade marks for the marketing of agricultural products in the European Union", *WIPO Journal*, 2010, p. 167.

¹⁷⁸ See also G.E. Evans, (n. 177), p. 168.

¹⁷⁹ Roland Knaak, (n. 107), pp. 857-861.

The differences in protection between the two basic models of civil-law and common-law states become more apparent in the following case-law relating to genericness and conflict rules of priority and co-existence applicable between TM and GIs.

1. Genericness

The determination of whether a geographical designation is considered as generic, in the sense that it is no longer a geographical connotation but a mere sign referring to a type of product, is a hot issue, since generic terms cannot be registered as trade marks or GIs protected under the USA trade mark law and the EU GI Regulation respectively, with the consequence of exclusion from any protection and enforcement of the relevant right¹⁸⁰. The CJEU has ruled several times on the interpretation of "generic" and has developed a set of factors applicable to its assessment in such cases as "*Feta*", "*Parmesan*" and "*Bayerisches Bier*". The CJEU ruled that a term has become generic only when the direct link between the geographical origin of the product and its reputation or a specific quality of that product has disappeared, so that the name does no more than describe a style or type of product. Several factors must be taken into account to reach in that conclusion and in particular: a) the existing situation in the Member States and in areas of consumption and production; and b) the relevant national or Community laws. It is important to provide evidence that the product in question is still made by using traditional methods and how the relevant consumers perceive the sign. It is worthy to be noted that the new EU GI Regulation (EU Reg. 1151/12) confined the relevant public only to those areas of consumption and not also of production areas¹⁸¹, after the repeated applications for annulment of the registration of "*Feta*" as a PDO by Germany, Denmark, France and the United Kingdom, who were also producers of "*Feta*" cheese. The concentration of mass production and consumption of "*Feta*" in Greece and the majority of consumers perception that "*Feta*" is a geographical connotation evident by survey and marketing with labels referring to Greek cultural traditions and civilization, along with the traditional methods of

¹⁸⁰ Inessa Shalevich, (n. 7), p. 74. See also Regulation (EU) 1151/12 art.3, 6, 13(2) and that the same was true in the replaced EU Regulation in Gail Evans, (n. 116), 2013, p. 28.

¹⁸¹ Regulation (EU) 1151/12 article 41.

production was the basis of reasoning that “*Feta*” continues to be a geographical indication to a specific type of Greek cheese and consequently it has not been generic. The same was ruled by the CJEU for “*Parmesan*” a name alleged that it is used for hard cheeses of diverse origins, grated or intended to be grated, as distinct from the PDO “*Parmigiano Reggiano*” and in the case of the PGI “*Bayerisches Bier*” for beer produced in accordance with “the Bavarian method”, where the Court rejected these allegations and stated that there is an infringement of PDO or PGI even if the term is translated or used in compound designations and not only in the exact form in which the terms are registered¹⁸².

The broad scope of the granted protection by the EU Regulations for PDO and PGI is further becomes clear in the cases of “*Cognac*” and “*Parma ham*”, where the specification of the product can prevent or invalidate any registration of sign, including trade mark, which “evokes” the geographical indication but it does not conform with its product specification ensuring its quality. The CJEU found that a registration of a mark consisting of a geographical indication, or term corresponding to that indication and its translation, when it does not meet the specifications for that indication must be refused or be invalidated, even though it did not seek to mislead consumers about the origin of the product. An “evocation” is sufficient for that type of protection to be given and it occurs when the consumer in front of the name of the product, the image triggered in his mind is that of the product whose designation is protected¹⁸³. Moreover, the slicing

¹⁸² CJEU cases: “*Feta*”, Joined Cases C-465/02 and C-466/02, Federal Republic of Germany (C-465/02) and Kingdom of Denmark (C-466/02) v Commission of the European Communities, 25 October 2005, Joined cases C-289/96, C-293/96 and C-299/96, Kingdom of Denmark, Federal Republic of Germany and French Republic v Commission of the European Communities, 16 March 1999; “*Parmesan*”, C-132/05, Commission of the European Communities v Germany, 26 February 2008; “*Bayerisches Bier*”, C-120/08, Bavaria NV v Bayerischer Brauerbund eV, 22 December 2010; “*Bavaria*”, C-343/07, Bavaria NV and Bavaria Italia Srl v Bayerischer Brauerbund, 2 July 2009. See also the analysis of cases in Gail Evans, “The protection of geographical indications in the European Union and the United States under sui generis and trade mark systems: signs of harmonization?”, *Intellectual Property Quarterly*, 2013, pp. 28-32.

¹⁸³ CJEU cases: “*Cognac*” Joined cases C-4/10 and C-27/10, Bureau national interprofessionnel du Cognac v Gust. Ranin Oy, 14 July 2011; “*Parma ham*” C-108/01 of 20 May 2003, Consorzio del Prosciutto di Parma and Salumificio S. Rita SpA v Asda Stores Ltd and Hygrade Foods Ltd. See also the elaboration of cases in Gail Evans, “The protection of geographical indications in the European Union and the United States under sui generis and trade mark systems: signs of harmonization?”, *Intellectual Property Quarterly*, 2013, pp. 38-40.

and packaging of a product in the region of production may be in the content of a product specification and thus such a PDO ("Prosciutto di Parma"), may be reserved in the exclusive use of those producers only, as it was ruled in "Parma ham" case¹⁸⁴.

2. Conflict rules, priority or co-existence?

The interrelationship of marks and GIs is regulated¹⁸⁵ according to the principle of priority or co-existence depending on the date of application or registration and the kind of the sign as PDO or PGI or as a trade mark. The priority rule, namely the supremacy of prior right, applies in conflicts between trade marks. However, the same solution is not followed¹⁸⁶ under EU GI Regulation Art. 14 (1), (2) and CJEU case-law. In the event of conflict between a trade mark and a later registered GI, the latter may continue to co-exist nonetheless the earlier registered trade mark, except the mark is so famous or well-known that consumers would be misled by use of the name as a geographical indication. The "co-existence" principle was affirmed by the CJEU in "*Bavaria*" case¹⁸⁷ for beer, on condition that the later application for registration of a PGI was made in accordance with honest practice or in good faith. However, a prior registered GI, under the EU law for GIs, which is identical or similar¹⁸⁸ to an existing trade mark is an absolute ground of refusal or cancellation of a later trade mark¹⁸⁹, as it was ruled in "*Cognac*" decision by the CJEU¹⁹⁰.

¹⁸⁴ CJEU "*Parma ham*" case, C-108/01, Consorzio del Prosciutto di Parma and Salumificio S. Rita SpA v Asda Stores Ltd and Hygrade Foods Ltd, 20 May 2003. See also comments on the case that this kind of specification must be well-founded so as not be contrary to the free movement of goods in Roland Knaak, (n. 107), p. 851.

¹⁸⁵ Regulation (EU) 1151/12 article 14.

¹⁸⁶ Ch. Heath, A. K. Sanders, (n. 58), p. 152.

¹⁸⁷ CJEU "*Bavaria*" C-343/07, Regione autonoma Friuli-Venezia Giulia and Agenzia regionale per lo sviluppo rurale (ERSA) v Ministero delle Politiche Agricole e Forestali, 12 May 2005 and CJEU C-120/08, Bavaria NV v Bayerischer Brauerbund eV, 22 December 2010.

¹⁸⁸ See CJEU "*Gorgonzola*" C-87/97, Consorzio pela Tutela de lFormaggioGorgonzola v Käserei Champignon Hofmeister GmbH&Co.KGand EduardBracharzGmbH, 4 March 1999, where similarity is defined when "the result that the phonetic and visual similarity between the two terms is obvious".

¹⁸⁹ See CJEU "*Grana Padano*" T-291/03, Consorzio per la Tutela del formaggio Grana Padano v OHIM, 12 September 2007. See also A. Kur, Th. Dreier, "*European Intellectual Property Law, Text, Cases and Materials*", Edward Elgar, 2013, pp. 347-348.

¹⁹⁰ CJEU "*Cognac*" Joined cases C-4/10 and C-27/10, Bureau national interprofessionnel du Cognac v Gust. Ranin Oy, 14 July 2011. See also Roland Knaak, "Geographical indications and their relationship with trade marks in EU law", *International Review of Intellectual Property and Competition Law*, 2015, pp. 862-863.

The priority rule was found to apply in favor of an earlier trade mark in “Bud” case for beer also, between *Anheuser-Busch Inc v Budejovicky Budvar (C-96/09)*¹⁹¹. In particular, a non-registered trade mark or of another sign, like a geographical indication protected in a Member State, used in the course of trade of more than mere local significance could prevent the registration of a subsequent Community trade mark, provided that: a) the sign must be actually used in good faith or in accordance with honest practices in industrial or commercial matters¹⁹² and in a sufficiently significant manner as well as in a substantial part of the territory in which it is protected; b) the rights have to confer on its proprietor the right to prohibit the use of a subsequent trade mark and they have to be acquired prior to the date of application for registration of the Community trade mark¹⁹³.

In sum, the restrictive interpretation of genericness¹⁹⁴ with the broad scope of protection under the EU GI Regulation compared to the defense of “fair use”¹⁹⁵ and the lack or the “compromised” protection under the USA or similar EU trade mark law, as well as the advantage position of GI in case of conflict with a trade mark illustrate that a more certain and stronger protection of geographical designations is provided under the shield of the *sui generis* system of the EU law¹⁹⁶.

¹⁹¹ CJEU “Bud” case, C-96/09, *Anheuser-Busch Inc.V. von Bomhard and B. Goebel, Rechtsanwälte*, 29 March 2011.

¹⁹² See the good faith interpretation in “Gorgonzola” C-87/97 of 4 March 1999 as “a concept which must be interpreted in the light of all the legislation, national and international, applicable at the time when the application for registration of the trademark was lodged” and that the use in accordance with honest practice is the only assessment criterion as in “Bud” case ruled and referred in Raimund Raith, “Recent WTO and EC jurisprudence concerning the protection of geographical indications”, *International Trade Law & Regulation*, 2009, p. 124.

¹⁹³ See the reference and analysis of the cases in Gail Evans, (n. 116), 2013, pp. 40-44.

¹⁹⁴ Gail Evans, (n. 116) , 2013, p. 31.

¹⁹⁵ See the definition in Gr. Dinwoodie and M. D. Janis, (n. 158), pp. 279-280.

¹⁹⁶ Gail Evans, (n. 116), 2013, pp. 45-46.

CHAPTER III: Why sui generis protection is needed?

Both GIs and trade marks indicate origin and quality of a product¹⁹⁷. Geographical indications identify a specific place or region of production that confers particular characteristics and qualities on the product, putting therefore emphasis on the fact that the product derives its qualities and reputation from its place of origin, such as the French cheese Roquefort. On the contrary, trade marks designate not a geographical place as the source of products but a commercial source, that is a certain producer or group of producers in case of collective trade marks. Therefore products derive its special qualities or reputation from the specific producers situated anywhere, who guarantee the particular quality standards of production of goods bearing its mark, like Coca-Cola. This is the key difference in function between GIs and trade marks¹⁹⁸, which illustrates the philosophy behind each system of protection.

Rationale of sui generis protection

A good start for understanding the rationale supporting the *sui generis* protection of GIs is to examine in parallel the common principles justifying trade marks protection and the unique features of GIs reasoning a different protection.

A. Economic reasons

Geographical indications like trade marks identify a product but while the first attach the product to its particular place of origin, the latter attach the good to its particular producer. The fundamental concept behind GIs is that specific geographic locations afford product qualities that cannot be replicated elsewhere, since the link is the *terroir* and its special climate, soil and other characteristic, like human tradition or culture that

¹⁹⁷ CHARLIE FU, "Trademarks in International and Comparative Law: Geographical Indications in Multinational Agreements", *The Journal of Contemporary Legal Issues*, 2010, p. 451.

¹⁹⁸ Irina Kireeva and Paolo R. Vergano, (n. 22), p. 97-98.

make products unique¹⁹⁹. GIs reduce information asymmetry by convey credible information about origin and quality to consumers and thus limit their confusion and searching costs²⁰⁰. Producers also are encouraged to invest on quality products as they are rewarded by premium prices as consumer preferable ones²⁰¹. The same do trade marks²⁰², but on a different basis with different results.

Trade marks rely its function solely on economic reasons and view the conferring rights of use and prevent others as an exclusivity²⁰³ based on “individual” property²⁰⁴. Private parties who labor, create and invest time, money to build a reputable good should be rewarded and gain all the profit of the market attraction. That is the reason why a mark as valuable business asset may be sold, licensed or being transferred in any way²⁰⁵. Limits to that exclusivity set the defense of “fair use”²⁰⁶ by other traders to describe their products in the market place. Hence a limited free-riding is permissible in consideration of interests of other traders in the context of “fair competition”²⁰⁷.

However, although economic rhetoric applies for GIs also, this reasoning solely fails to take into consideration the different features of GIs and the multiple interests of public policy that they serve. GIs are attached to the land inextricably and thus its use is collective and non-transferable²⁰⁸. Geographical indications give a collective use to all producers in a certain geographical area who comply with product specification for quality. Therefore, "property" in the context of GIs is interpreted in a strict sense of

¹⁹⁹ Kal Raustiala and Stephen R. Munzer, (n. 6), pp. 338, 341-342.

²⁰⁰ Daniele Giovannucci - Tim Josling - William Kerr - Bernard O'Connor - May T. Yeung, “GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin”, *International Trade Centre 2009*, pp. 89-90, available at: http://www.origin-gi.com/images/stories/PDFs/English/E-Library/geographical_indications.pdf, (accessed on 12 January 2016). See also Ch. Heath, A. K. Sanders, (n. 58), p. 139.

²⁰¹ Daniel Rogits, (n. 29), p. 412. See also Malobika Banerji, (n. 4), pp.3-4.

²⁰² Philip Matthews, (n. 2), p. 202.

²⁰³ See the double purpose of protecting GIs and TMs which justifies exclusivity in Dev Gangjee, (n. 147), pp. 1258-1259.

²⁰⁴ C. Seville, (n. 21), p. 318. See also Teshager Dagne,(n.1) , 2014, p. 264.

²⁰⁵ Teshager Dagne, (n.1), 2014, pp. 263-268. See also the justification provided in general for all IP rights, thus for trademarks too (Labour and Desert, Firstness, Moral Right of the Author and the Community, Incentives to Innovate, Maintain Quality and Market, Preventing Confusion) in Kal Raustiala and Stephen R. Munzer, (n. 6), pp. 353-363.

²⁰⁶ See the definition and requirements of fair use in Gr. Dutfield, U. Suthersanen, (n. 133), p. 152.

²⁰⁷ See “fair competition” in contrast of “acts of unfair competition” as defined in the Paris Convention for Protection of Industrial Property Article 10bis.

²⁰⁸ Teshager Dagne, (n.1), 2014, pp. 263-268.

“rights to something rather than to the thing that is 'owned'”²⁰⁹. These special features of GIs categorize them as a special form of IP that relate to agricultural development²¹⁰ by preserving also cultural heritage and tradition know-how, biodiversity, sustainability of environment and locality, food quality and safety in a context of increasing also fair competition on a level playing field²¹¹.

B. Blending economy with tradition and culture

Tradition Knowledge (TK) is defined within the CBD²¹² as “[t]he knowledge, innovations and practices of indigenous and local communities embodying traditional lifestyles” as well as indigenous and local technologies.”²¹³ “Culture” further in its social sense is a particular way of life²¹⁴, but in the context of “community” are conceptualized as synonymous as knowledge of indigenous people in a distinct community, which excludes individual ownership and control over indigenous knowledge²¹⁵. Whereas Traditional knowledge and indigenous knowledge are not synonymous neither static but it is developed over time, however this term is used to distinguish that type of knowledge from scientific knowledge of industrial communities. The holders though of traditional knowledge are distinct from the knowledge itself²¹⁶.

Consequently, the CBD definition seeks to cover GIs as a device of protecting the collective property rights of TK holders who employ traditional methods of production with local wisdom in certain geographic regions and product goods unique

²⁰⁹ Teshager Dagne, (n.1), 2014, p. 266. See also that property in GIs is collective and it is indirectly linked with national economies and society that’s why GIs “cannot be owned nor commercialized as other rights can be” in Irene Calboli, (n. 14), p. 766.

²¹⁰ Teshager Dagne, (n.1), 2014, pp. 266-267. See also Tesh W. Dagne, (n. 10), 2015, p. 69.

²¹¹ Tesh W. Dagne, (n. 10), 2015, pp. 686-687. See also Daniele Giovannucci - Tim Josling - William Kerr - Bernard O’Connor - May T. Yeung, “GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin”, *International Trade Centre 2009*, pp. 89-90, available at: http://www.origin-gi.com/images/stories/PDFs/English/E-Library/geographical_indications.pdf, (accessed on 12 January 2016). See also J. Curci, (n. 170), p. 317.

²¹² Convention on Biological Diversity of 1992.

²¹³ J. Curci, (n. 170), p. 316.

²¹⁴ J. E. Anderson, “*Law, Knowledge, Culture, The Production of Indigenous Knowledge in Intellectual Property Law*”, Edward Elgar, 2009, p. 190

²¹⁵ J. E. Anderson, (n. 214), pp. 190-198.

²¹⁶ Ch. R. McManis, “*Biodiversity and the Law Intellectual Property, Biotechnology and Traditional Knowledge*”, Earthscan, 2007, p. 301.

distinguishable from “generic”, without however affording monopoly use over certain information, reversing it thereby in public domain sphere. Further, registration is a useful step to that protection against even “biopiracy”²¹⁷ as the case of “Basmati rice” demonstrates²¹⁸.

A *sui generis* protection of GIs aims by protection to reward TK holders via its economic potential benefits for regions and its indigenous people and thus incentivize them to continue to invest in the quality and authenticity of the GI-denominated goods, maintaining thus traditional production methods, culture heritage and biodiversity that give its products their unique special quality, reputation or other characteristics.²¹⁹ Moreover, in re-embed a product in the natural processes and social context of its territory, GIs facilitate local communities to equitably participate in global economic processes by preserving its cultural identity and national resources. In addition, food quality and food safety along with a sustainable environment and rural development are goals ensured by GIs²²⁰, since GIs as collective rights extend the economic benefits to all producers, who subscribe to the traditional practices belonging to the culture of their community in a demarcated territory and mobilize them to develop sustainable practices of agricultural production in the long-term in order to have sustainable development and profits²²¹. Moreover, by tying producers to the land, GIs place the “cost” of the damage that some producers may cause to a region primarily with the producers' group. Therefore, GIs through product specification, which incorporates traditional methods and natural resources in a strong tie, encourage producers to adopt environmentally friendly methods of production, genetically modified-free production, and maintenance of production conditions free of chemical pesticides and contaminants or other means with negative effects to ecological environment. Further, the compliance with this specification as an indispensable condition of protection, which is

²¹⁷ See that “biopiracy” means accusations against companies that proceed to the following acts of “misappropriation of genetic resources and/or traditional knowledge through the patent system, and the unauthorised collection of commercial ends of genetic resources and/or traditional knowledge” in Gr. Dutfield, U. Suthersanen, (n. 133), p. 333.

²¹⁸ J. Curci, (n. 170), p. 316. See also the definition of “biopiracy” and the analysis of case of Basmati by the author concluding that a higher protection of GIs similar to existing for wines would had prevent the “theft” of use by an American undertaking in Tesh W. Dagne, (n. 10), 2015, pp. 698-700.

²¹⁹ Irene Calboli, (n. 14), pp. 766-767.

²²⁰ Tesh W. Dagne, (n. 10), 2015, pp. 687-692.

²²¹ Tesh W. Dagne, (n. 10), pp. 693-694.

monitored both by public and private partners, guarantees the quality and safety of foods or goods ending in hands of consumers²²².

Furthermore, GIs do not allow free-riding of similar products and thus they leave no room for consumer confusion about geographical origin of goods, neither permit signs to lose its distinctiveness, i.e. becoming generic, or its reputation to be harmed by unfair competition or misappropriation of it²²³. Moreover, GIs grant exclusive rights of use like other forms of intellectual property rights²²⁴ and consequently they can create barriers to trade²²⁵. However, the CJEU repeatedly has ruled (“Sekt” and “Warsteiner”, “Guimont”, “Exportur”, “Alfa Vita Vassilopoulos AE”, “Kakavetsos-Fragkopoulos AE”, “Prosciutto di Parma”)²²⁶ that GIs are in principle justified quantitative restrictions in free movement of goods in the internal market because they fall within the scope of art.36 TFEU (prior art. 30 TFEU) for “the protection of industrial and commercial property”, which accords higher protection compared to the *Cassis De Dijon* exception for cases under art.28 TFEU²²⁷. A balanced system of GI protection therefore does not stifle competition, as GI opponents have argued but on the contrary GIs increase the competition among producers of the same kind of goods, such as sparkle wine, by preventing competitors situated outside of the defined area from using “the same nomenclature” to identify their products and make them to produce the same type of product by employing innovative techniques improving thus product quality and further to promote their products under their own trade name or their own geographical indication of locality²²⁸. The notion of *terroir* as combination of land and expertise of the

²²² Irene Calboli, (n. 14), pp. 767-768. See also Tesh W. Dagne, (n. 10), 2015, pp. 692-699.

²²³ See Regulation (EU) 1151/12 in conjunction with Irene Calboli, (n. 14), p. 768.

²²⁴ Dev Gangjee, (n. 147), pp. 254-255, 258-259. See also Irene Calboli, (n. 14), p. 769.

²²⁵ C. Seville, (n. 21), p. 326.

²²⁶ CJEU cases: *CJEU cases: “Sekt” and “Weinbrand” C-12/74, Commission of the European Communities v Federal Republic of Germany, 20 February 1975, “Guimont”, C-448/98, Criminal proceedings against Jean-Pierre Guimont, of 5 December 2000, “Exportur” C-3/91, Exportur SA v LOR SA and Confiserie du Tech SA, 10 November 1992, “Alfa Vita Vassilopoulos AE”, Joined Cases C-158/04 and C-159/04, Alfa Vita Vassilopoulos AE (C-158/04) and Carrefour Marinopoulos AE (C-159/04) v Elliniko Dimosio and Nomarchiaki Aftodioikisi Ioanninon Alfa Vita Vassilopoulos AE Joined Cases C-158/04 and C-159/04, 14 September 2006, “Kakavetsos-Fragkopoulos AE”, C-161/09, Kakavetsos-Fragkopoulos AE Epexergasias kai Emporias Stafidas v Nomarchiaki Aftodioikisi Korinthias, 3 March 2011.*

²²⁷ G. Tritton, *“Intellectual Property In Europe”*, London Sweet & Maxwell, Third Edition, 2008, pp. 730-734.

²²⁸ Irene Calboli, (n. 14), pp. 769-771.

local people²²⁹ is unique everywhere and available to any locality, so the disparity lies that the monopolization of market through differentiation of products²³⁰ becomes “regional” by GIs instead of “individual”²³¹ according to trade mark system²³², which furthermore fails to address the afore public policy concerns or at least compensate local people and territories for their unique culture and authentic goods²³³. This tie with the land and the prevention of de-localization of production²³⁴ with signs embedding tradition knowledge through GI protects and rewards quality and authenticity in a global market and in parallel correct market distortion caused by large companies, giving small farmers and communities the opportunity to entry into global market and compete on equal basis. Thus producers using TK via GI protection offer high quality and secure goods with unique characteristics and make higher profits, for example the Jamaica blue coffee case²³⁵, while consumers can make more informed choice among a variety of superior and safe goods. In the end, GIs serve the purpose of any IP right to maximize public benefit with the minimum cost²³⁶.

²²⁹ Kal Raustiala and Stephen R. Munzer, (n. 6), p. 344.

²³⁰ Malobika Banerji, (n. 4), pp.3-4. See also Philip Matthews, (n.2), p. 205.

²³¹ See that “the concept of individual intellectual property rights is primarily a Western notion” in Sonali Maulik, “Skirting the Issue: How International Law Fails to Protect Traditional Cultural Marks from IP Theft”, *Chicago Journal of International Law*, p. 248.

²³² Kal Raustiala and Stephen R. Munzer, (n. 6), p. 341.

²³³ Dev Gangjee, (n. 147), pp. 267-269. See also Kal Raustiala and Stephen R. Munzer, (n. 6), pp. 345-347.

²³⁴ Inessa Shalevich, (n7), pp. 75-78.

²³⁵ See that “The main advantage of geographical indicators as a means of protection for informal innovation is the 'relative impersonality' of the right, i.e. the protected subject matter is related to the product itself and is therefore not dependant on a specific right holder.” For this very reason, a GI offers more opportunity for local producers to control their product and make a profit. Although a trademark may add value, depending on the level of demand for the good, the GI gives the IP right to the producer. In theory, the producer will own a greater link to the buyer, therefore reaping a greater reward.” in Philip Matthews, (n. 2), pp. 216-220.

²³⁶ See the overall justification for protection of GIs in J. Curci, (n. 170), pp.316-321.

CHAPTER IV: The extension of enhanced protection of wines to all agricultural-food products and a multilateral registration: a one way solution?

A. General observations

Like trademarks, GIs are signs that function in a similar way that is as: source-identifiers, guarantees of quality, and valuable business assets²³⁷. That is why are eligible for protection as IP rights under the economic philosophy²³⁸ for reducing information asymmetry between producers and consumers²³⁹. The two-fold objective of avoidance consumer confusion and prevention of unfair competition under trade mark law is also applicable to GIs²⁴⁰. However, as it has already been mentioned GIs protect the legitimate interests of consumers and producers but on a different basis and scope. GIs adds in rationale and protection a culture feature and entail to denote a product's origin through a sign that connotes "quality, reputation or other characteristics" attributable to the product because of a culturally and traditionally defined agricultural practice in a territory²⁴¹, thereby giving the good the cultural identity of this specific geographical area and its population²⁴². Further, unlike trademarks that grant monopolistic IP rights to a single owner²⁴³, GIs grant protection to all producers within a certain area whose products meet the quality (specification) requirements. The spatial tie further and the right of collective use and interests involved make GIs non-transferable, e.g. sold or licensed, unlike trade marks, so if a producers moves outside the certain territory loses

²³⁷ Inessa Shalevich, (n. 7), p. 71.

²³⁸ Justin M. Waggoner, "Andrew P. Vance Memorial Writing Competition Winner: Acquiring A European Taste For Geographical Indications", *Brooklyn Journal of International Law*, 2008, p. 581.

²³⁹ Tunisia L. Staten, (n. 5), p. 224. See also Daniele Giovannucci - Tim Josling - William Kerr - Bernard O'Connor - May T. Yeung, "GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin", *International Trade Centre 2009*, pp. 89-90, available at: http://www.origin-gi.com/images/stories/PDFs/English/E-Library/geographical_indications.pdf, (accessed on 12 January 2016).

²⁴⁰ Justin M. Waggoner, (n. 238), p. 582.

²⁴¹ Teshager Dagne, (n. 1), 2014, p.283.

²⁴² Inessa Shalevich, (n. 7), p. 71.

²⁴³ Justin M. Waggoner, (n. 238), p. 583.

the right to use the protected GI²⁴⁴. Thus GIs rewards local people and sustainable agricultural development, as EU supports. Collective or certification regional marks under USA law or EU trade mark law function mainly on the same basis like individual trade marks²⁴⁵, leaving thereby a considerable gap in protection²⁴⁶ and loss in economic, social, traditional and environmental wealth.

TRIPS agreement does not provide the legal means for protection²⁴⁷ of GIs, neither determines a solution for generic²⁴⁸ and homonymous names²⁴⁹, but instead provides a two-tier system of GI protection, one for all goods (Art.22) and one of higher level applicable only to wines and spirits (Art.23). TRIPS moreover provide several exceptions and limitations to GI protection in Art. 24, which allows a trade mark to continue to be used if it was registered or was actually used in good faith before the implementation of TRIPS or prior the GI be protected in its country of origin²⁵⁰. This is explained as a political compromise between continental traditional countries and common-law industrial countries, with the USA continuing to oppose to a possible extension of the higher protection to all goods²⁵¹. The reality though remains that under national law the protection of GIs is inadequate and varies from country to country, thereby causing legal uncertainty and unequal results²⁵². This is why harmonization by a uniform legal framework at international level is a strong necessity in a free-market global economy. An adoption of EU proposal for extension of the enhanced protection for wines and spirits only to all products²⁵³ in a revised form of TRIPS under a common multilateral registry is a feasible and appropriate solution to accomplish better protection with multiple benefits for all parties.

²⁴⁴ See also that “GIs are not analogous to other IP rights” and its key feature of relative “impersonality” and its consequently non-transferability is the main advantage in its protection in Inessa Shalevich, (n. 7), pp. 75-77.

²⁴⁵ In the sense of economic rationale alone and on basis of individual property perception and private enforcement of the “owned” exclusive and thus transferable right, as it has been analysed above.

²⁴⁶ Gail Evans, (n. 116), 2013, pp. 45-46.

²⁴⁷ TRIPS Agreement art. 22(2),23(1). See also Gail Evans, (n. 116), 2013, pp. 19-20.

²⁴⁸ TRIPS Agreement article. 24(6)(9).

²⁴⁹ TRIPS Agreement art. 23(3), 22(4).

²⁵⁰ TRIPS Agreement article 24. See also Irene Calboli, (n. 14), p. 764.

²⁵¹ Tunisia L. Staten, (n. 5), pp. 221-222. See also Malobika Banerji, (n. 4), p. 1.

²⁵² Irina Kireeva and Paolo R. Vergano, (n. 22), p. 99. See also Malobika Banerji, (n. 4), p. 5, as well as see Daniel Rogits, (n. 29), p. 406.

²⁵³ Inessa Shalevich, (n. 7), p. 72. See also Justin M. Waggoner, (n. 238), pp. 574, 578.

B. Addressing an extension of Article 23 of TRIPS to all products

Article 23 is referred exclusively to wine and spirits by granting protection against any misuse of geographical indication identifying wines or spirits not truly originating in the place indicated and it applies even where the true origin of the goods is indicated, or the geographical indication is translated or accompanied by suffixes such as “kind”, “type”, “style” or “imitation”.

An extension of the enhanced protection for wines and spirits will offer adequate system of protection of GIs to all goods and clear out any uncertainty or genericness or unfair free-riding by similar products²⁵⁴. Article 23 protects beyond the test of consumer confusion and an act constituting unfair competition within the meaning of Paris Convention Art. 10bis. The higher level of protection benefits both consumers to make well-informed choices about origin, quality and authenticity, while in parallel protects legitimate producers from free-riding and tarnishing or blurring²⁵⁵ the sign, helping thus GIs not become generic or loss its connotation with premium quality and reputation and thereby in resulting to loss of premium prices. The latter is the core of protection of any IP right under the monopolistic rents for creative works²⁵⁶ and the ultimate goal for trade marks also.

The two-tier protection of GIs in TRIPS is arbitrary²⁵⁷ and unjustified²⁵⁸, since the notion of *terroir* as the key input in special characteristic of product exists also for foods. Moreover, foods, like beverages, are expressions of local tradition methods and culture too²⁵⁹. It should be noted that the concept of *terroir* as unique combination of land and human local skills and wisdom which produces unique products may apply to handicrafts also. It seems that the privileged protection for wine makers was driven by

²⁵⁴ Irina Kireeva and Paolo R. Vergano, (n. 22), p. 99.

²⁵⁵ See that “tarnishing” means harm the reputation of the sign, whereas “blurring” means that the sign loses its distinctiveness in minds of consumers ,i.e. it becomes generic as indicating a type of product and not its origin in Gr. Dinwoodie and M. D. Janis, (n. 158), pp. 324-325.

²⁵⁶ Justin M. Waggoner(n. 238), p. 581. See also Ch. Heath, A. K. SanTERS, (n. 58), p. 142.

²⁵⁷ Daniel Rogits, (n. 29), p. 413.

²⁵⁸ See also Dev S. Gangjee, “Geographical indications and cultural heritage”, *WIPO Journal*, 2012, pp. 94-95.

²⁵⁹ Tesh W. Dagne, (n. 10), pp. 701-702.

economic and political reasons for both sides of Atlantic and it was a compromise between them, mostly with USA and Australia having already high income from selling wine products. The recent amendment in USA trade mark law that offers anti-dilution protection to wines only supports the afore mentioned view²⁶⁰.

C. The way of potential benefits becoming reality

The basic arguments by opponents are that an enhanced *sui generis* protection of GIs will cause additional administrative burdens to enforcement of rights and will act in a protectionist and anti-competitive manner for non-EU producers by monopolization of prior public domain use, with the possible also harm of consumers by limiting their choice to low-priced similar products.

The additional administrative costs are exaggerated, since “are normal for any multilateralization of IP rights and are no different from what the USA expects many other countries to spend on IP enforcement matters”²⁶¹. Moreover, as GIs are collective in nature, the burdens of enforcement are administrated collectively resulting in lower costs than what required from individuals alone²⁶². Additionally, it should be noted that in USA a governmental structure of controlling and helping enforcement of certification regional marks is already in place²⁶³.

The monopoly concerns are also exaggerated, because first the geographical denomination itself as well as traditional knowledge itself is precluded from exclusivity of GI holders, remaining thus free to others producers and public domain. Second, competitors from other regions are able to distinguish its products by other factor than a GI, like graphic logos, packaging, labeling and other elements related to appearance (e.g. colour) and “compete on their own merits”, strengthening thereby competition.

The advantage of low-priced goods would continue to favor companies of mass-

²⁶⁰ Daniel Rogits, (n. 29), p. 413.

²⁶¹ Justin M. Waggoner, (n. 238), p. 588.

²⁶² Vicki Waye, “Assessing Multilateral vs. Bilateral Agreements and Geographic Indications through international food and wine”, *Currents: International Trade Law Journal*, 2005, p. 60.

²⁶³ See that in both systems there is a governmental involvement for monitoring and enforcement, as well as the example of Idaho potatoes Commission in Gail Evans, (n. 116), 2013, pp. 24-25.

produced items and economies scale, since many consumers still will choose to buy the similar low-priced good instead of the premium GI-protected product.

Furthermore, any potential administrative and producer cost of re-labeling would be happen once within a simultaneously transitional period of adaptation and declaration of protected GIs or TMs, as it was the case of wines in TRIPS.

The benefits of an extension of the higher GI protection to all goods outweighs any disadvantage, as any country in the world, such as developing countries, beyond New World ones, can benefit from the inherent value of GI products and reap the economic, social and culture fruits of its environment, by protecting already existing GIs or creating new ones. The sustainable and healthy agriculture development offered by sui generis enhanced protection of GIs is open to anyone²⁶⁴, on the contrary of what opponents argue²⁶⁵.

However, an establishment of multilateral registration system for all GIs in TRIPS is considered necessary for the smooth operation and elimination of legal uncertainty and searching costs in trade²⁶⁶. Such a step is already occurred by the revision of Lisbon agreement for AOs, in which GIs included in the common registration and umbrella of protection²⁶⁷. The USA yet is not a member of Lisbon²⁶⁸, as many other countries, leaving major market players outside of binding obligations to strongly protect geographical designations connoting quality and linked with the land of production. A potential revision of TRIPS towards an enhanced and broader GI protection for all goods seems a feasible solution²⁶⁹ and an opportunity for removing the deal-breakers from international scene. Harmonization by a single uniform legislative framework with the most possible participation is a suitable device for providing legal certainty and ensuring fair trade without barriers.

²⁶⁴ *Since* the notion of terroir is unique everywhere and that's why it cannot be replicated as its foods and beverages evokes the particular soil and expertise of a particular land and people in Kal Raustiala and Stephen R. Munzer, (n. 6), pp.338, 344.

²⁶⁵ Tunisia L. Staten, (n. 5), pp.229-231.

²⁶⁶ Justin M. Waggoner, (n. 238), pp. 586-590. *See also* Ch. Heath, A. K. Sanders, (n. 58), pp.138-145.

²⁶⁷ Geneva Act of 2015 amending Lisbon Agreement. *See also* Anselm Kamperman Sanders, (n. 8), pp. 755-756.

²⁶⁸ Gail Evans, (n. 116), 2013, p. 27.

²⁶⁹ Before the common multilateral register of updated Lisbon agreement, the potential commercial benefits and the common rules existing in international law.

The generic and homonymous problem

The generic and homonymous issue express the legitimate interests of immigrants to use in new countries transferred names and traditional methods from their home countries²⁷⁰. TRIPS agreement has not taken any position on this, as it has been mentioned, but instead it adopted the test of consumer confusion as basis for according protection to all goods. This test allows the use of generic and homonymous names by immigrants in their new home for goods produced there²⁷¹. The criterion of consumer confusion about the true source of products is the foundation principle of unfair competition and trade mark law with its subset of passing off. This test allows the copying and free-riding on reputation by imitation or similar products within the same classification of product²⁷². However, an assessment of what constitutes generic term and thus not eligible of enhanced GI protection may rely on whether the term is considered generic in its home country of origin. This constitutes the most relevant test to consumer confusion and public policy concerns, such culture or quality²⁷³. This solution is similar to that found in all international conventions, including TRIPS, applicable for granting protection provided that GIs are protected in its country of origin²⁷⁴. Further, homonymous names may be differentiated easily by suffixes indicating the new place of geographical origin, like “New Roquefort” cheese, under the common rule of “fair use” or “honest practice” or generally prescribed as good faith, which also applies as limitation to TMs and GIs²⁷⁵. The concept of good faith means that a trader must take into account legitimate interests of other competitors and limit the use of its sign to what is necessary to describe its product and not capitalize the

²⁷⁰ Vicki Wayne, (n. 262), pp.58-59.

²⁷¹ Gail Evans, (n. 116), 2013, p. 27. See also A. Kur, Th. Dreier, “European Intellectual Property Law, Text, Cases and Materials”, Edward Elgar, 2013, pp. 338-339.

²⁷² Gr. Dinwoodie and M. D. Janis, (n. 158), pp. 324-326, 192-193, should *read* in conjunction with Gr. Dutfield, U. Suthersanen, (n. 133), pp. 154-158.

²⁷³ Daniel Rogits, (n. 29), pp. 404,408-411,414-415.

²⁷⁴ See that the protection in the home country is condition of granting protection to foreign GIs in Paris, Madrid, Lisbon and in TRIPS agreements.

²⁷⁵ See that fair use means in common-law countries as “those circumstances where third parties needed to use the mark for denominative purposes, such to describe the geographical origin of goods in good faith, but not to indicate commercial origin ‘as mark’” while European approach focus on the ‘honesty’ of the trader in Gr. Dutfield, U. Suthersanen, (n. 133), p. 196.

reputation of another similar sign²⁷⁶. Moreover, it is important to note that a potential extension of a strong protection of GIs should be further limited within similar type of products, excluding thereby consumer confusion²⁷⁷ or deception, while it takes into consideration other human rights such as freedom of expression²⁷⁸ (e.g. name of a restaurant) or legitimate interests of other traders. The anti-dilution protection of GIs²⁷⁹ therefore is advisable to be confined to prevention of genericism²⁸⁰ only and not be expanded to the extent of famous trade marks covering thus dissimilar products²⁸¹.

²⁷⁶ See the meaning of homonymous and the purpose behind the relevant art.22 (4) of TRIPS in J. Malbon, Ch. Lawson, M. Davison, (n. 28), p. 349. See also the exceptions to the rights of trade marks in TRIPS art. 17, European Community Trade Mark Regulation art.12 and US trade mark law as referred in Gr. Dutfield, U. Suthersanen, (n. 133), pp. 151-152. See also the interpretation given by the CJEU in Gr. Dinwoodie and M. D. Janis, (n. 158), pp. 186-191.

²⁷⁷ H. Hansen, *“U.S. Intellectual Property Law and Policy”*, Edward Elgar, 2006, p. 76.

²⁷⁸ Gr. Dinwoodie and M. D. Janis, (n. 158), pp. 313-314.

²⁷⁹ Ch. Heath, A. K. Sanders, (n. 58), pp.139-141. See also for USA anti-dilution in H. Hansen, (n. 277), p. 75-77.

²⁸⁰ Ch. Heath, A. K. Sanders, (n. 58), p. 142.

²⁸¹ Gr. Dutfield, U. Suthersanen, (n. 133), 2008, pp. 150-154,158. See also H. Hansen, (n. 277), p. 76-77.

Conclusion

Geographical indications or designations of origin are strongly connected with the land and traditional knowledge and for that reason they are often used as indicators of agri-food and spirit products with particular characteristics²⁸², like Feta cheese or Scotch whiskey. The division though between the industrial method of production and traditional one of New World countries and continental Europe respectively is reflected both on their legal systems of protection and in the two-tier system of protection adopted in TRIPS²⁸³. Geographical indications now stand as an hybrid of legal framework combining both unfair competition law and intellectual property law²⁸⁴.

However, the comparative analysis between the two antagonistic models of EU *sui generis* and USA trade mark law for the protection of GIs under the obligation of TRIPS agreement, the most successful international convention on this field²⁸⁵, demonstrates that both legal systems share similar collective use and control structure as well as common rules. The basic difference though remains not in the collective right of use but in the concept of "individual property" and "personal" exploitation by de-location²⁸⁶ of production ignoring other public policy considerations, such as culture heritage²⁸⁷ and sustainable social and agricultural development.

Nonetheless, a harmonization under an amendment of TRIPS agreement based on the

²⁸² G. Ghidini, *"Innovation, Competition and Consumer Welfare in Intellectual Property Law"*, Edward Elgar, 2010, pp. 199-200.

²⁸³ Irina Kireeva and Paolo R. Vergano, (n. 22), pp. 98-100.

²⁸⁴ See the legal protection provided in TRIPS article 22 (2) "to prevent:

(a) the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good;

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

²⁸⁵ C. Seville, (n.21), p. 292.

²⁸⁶ See that de-location relates to power distributors interested for competition on price than quality via the 'advertising' value of a sign and not its actual distinguishable quality in G. Ghidini, (n. 282), pp.199-200.

²⁸⁷ See that cultural heritage is defined as "This intangible heritage is constantly recreated in response to the community's "environment, their interaction with nature and their history, and provides them with a sense of identity and continuity, thus promoting respect for cultural diversity and human creativity." in Dev S. Gangjee, (n. 258), p. 100.

shared key principles of “anti-dilution” protection²⁸⁸, “unfair competition”²⁸⁹ and “fair use”²⁹⁰ between the divided jurisdictions of Old and New World countries by employing the prominent competitive advantage of unique *terroir* inherent in GIs seems a feasible solution and the answer to threat of homogenizing culture in a global context²⁹¹. In other words *terroir* is “the epitomic opposite of globalization: an exemplary reflection of place and people”²⁹² holding simultaneously the keys for multiple benefits both for producers and consumers in a viable and balanced manner for all localities through the simple form of *sui generis* GI protection, which connects producers with the land directly. The extension of the enhanced protection for wines and spirits to all products would level playing field and facilitate the entry into the market for even small farmers with the guarantee of legal certainty and focus on a competition by authentic and quality products²⁹³.

²⁸⁸ See that “anti-dilution” protection concerns dissimilar products and it is defined in USA TM law as “protection against any act which dilutes the distinctiveness of famous marks as to identify and distinguish goods regardless of the presence or absence of (1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake or deception” in Gr. Dutfield, U. Suthersanen, (n. 133), p. 153. See also the respective characterization of well-known GIs in Ch. Heath, A. K. Sanders, (n. 58), p. 154.

²⁸⁹ Paris Convention article 10bis

²⁹⁰ Daniele Giovannucci - Tim Josling - William Kerr - Bernard O'Connor - May T. Yeung, “GUIDE TO GEOGRAPHICAL INDICATIONS, Linking Products and Their Origin”, *International Trade Centre 2009*, p. 56, available at: http://www.origin-gi.com/images/stories/PDFs/English/E-Library/geographical_indications.pdf, (accessed on 12 January 2016).

²⁹¹ Inessa Shalevich, (n. 7), pp. 71,78,79,81.

²⁹² As it is referred in Justin Hughes, (n. 26), p. 340.

²⁹³ J. Curci, (n. 170), pp. 317-321. See also Ch. Heath, A. K. Sanders, (n. 58), pp. 139-145. See also that the ‘wealth of nations’ is deemed the competitive advantage embodied in GIs and that its quality as well as its protection is based mainly on their link with the land and not in their ‘advertising’ value as trade marks in G. Ghidini, (n. 282), pp. 199-200.

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