

Historical development of geographical indication law under international arena

Dr. Varun Shukla

Guest Lecturer, Govt. Law College Rewa, Madhya Pradesh, India

Abstract

A geographical indication is a name or sign used on certain products which corresponds to a specific geographical location or origin. The use of a geographical indication may act as a certification that the product possesses certain qualities or enjoys a certain reputation due to its geographical origin. Geographical indications are generally traditional products produced by rural communities from generations that have gained reputation for their specific qualities. When products with geographical indications acquire a reputation, some other products may try to pass off themselves as the original geographical indication products. This kind of competition is often seen as unfair as it may discourage traditional producers as well as mislead consumers. Although there was no legal recognitions, geographical indications had earned global recognition even from the medieval and colonial period. The very legal concept of geographical indications as a form of Intellectual property can be traced from Paris convention for the protection of Industrial Property, 1883.

Keywords: Geographical Indications, Reputation, Owners, Consumers, Origin

1. Introduction

A Geographical Indication is a concept having roots within intellectual property rights. Man was supposed to reap benefit of his physical labour from time immemorial. As the society advanced the intellectual inputs gained more importance than the physical labour and it became important that one's intellectual labour gets duly rewarded to that it sustains the motivation of creator to contribute for welfare of society at large. God gifted a wonderful thing called brain to Man and nature endowed him with the abundant biological resources on the earth. He has also been gifted with imagination and creativity. With his imagination and creativity he has been producing various articles or products for his needs and comfort. With the passage of time the importance and value of these creations was realized. The commercial aspect started playing a significant role in these creations. By the end of Twentieth century the things created and invented by the human mind were recognized as an intellectual property of the owner. The owner's right over these properties was accepted and is known as an Intellectual Property Rights. A new set of laws called Intellectual Property Rights laws, were enacted to protect these property rights. These Intellectual Property Right laws provided a protection to the owners under different categories and names like Patents, Copyrights, Geographical Indications, Trademarks etc. Geographical Indication signifies the name or sign used in reference to the products which are corresponding to the particular geographical area. Geographical Indication grants to its holder certification mark which shows that the specified product consists of the same qualities and is enjoying reputation due to its origin from the specified geographical location ^[1].

International agreements

Although there was no legal recognitions, geographical indications had earned global recognition even from the medieval and colonial period. Examples are many to illustrate this; Indian spices impelled Christopher Columbus to sail all

the way from Europe to India. Scotch Whisky, Arabian horses, Dhaka muslin, Kashmiri Carpets, Chinese clay pots, Indian rubber, Damask table cloth etc. are a few to name the age-old examples of globally renowned products representing the fame of certain regions.

It can be presumed that the expression 'appellations of origin' is the precursor of the expression 'geographical indication'. The very legal concept of geographical indications as a form of Intellectual property can be traced from the Paris convention for the Protection of Industrial Property, 1883.

1. The Paris Convention for the Protection of Industrial Property, 1883

The first international legal framework to grant protection for indications of geographical origin on goods was the Paris convention ^[2]. The Paris convention for the protection of Industrial Property was concluded in the year 1883. Thereafter, it was revised at Brussels (1900), Washington (1911), The Hague (1925), London (1934), Lisbon (1958) and Stockholm (1967) ^[3]. This convention arose out of the need of certain countries to protect their industrial property and intellectual property beyond their national territories. It is concerned with all forms of industrial property and intellectual property and not specifically geographical indications.

The Paris convention does not use the term "geographical indications" but it is the first multilateral agreement which provided for protection of "indications of source" and "appellations of origin". Article 1(2) of the convention includes 'indications of source or appellations of origin' as the objects, inter alia, of industrial property protection. The convention, however, does not define 'indications of source' or 'appellations of origin'.

Further, under Article 1(3), the convention says that 'industrial property' shall be understood in the broadest sense and shall apply not only to industry and commerce proper, but likewise to agricultural and extractive industries and to all manufactured

or natural products for example, wines, grain, tobacco leaf, fruit, cattle, minerals, mineral waters, beer, flowers and flour.

A provision prohibiting the use of a false indication of source appeared as early as in the original text of the Paris Convention of 1883. However, that protection was rather limited, since the prohibition was only applicable where the false indication of source was used in conjunction with a fictitious or non-existing trade name. Article 10 of the Paris Convention makes the sanctions and set forth that, in cases of direct or indirect use of a false indication of the source of the goods or the identity of the producer, manufacturer or merchant, Article 9 of the Paris convention should be applicable. Article 9 provides that goods bearing a false indication of source are subject to seizure upon importation into countries party to the Paris convention, or within the country where the unlawful affixation of the indication of source occurred or within the country of importation. However, Article 9(5) and (6) of the Paris convention allow that countries party to the Paris convention whose national laws do not permit seizure on importation or inside the country to replace those remedies by either a prohibition of importation or by any other nationally available remedy.

Article 10(b) of the convention obliges member to assure their nationals effective protection against unfair competition. Unfair competition is defined as any act of competition which is contrary to honest practices in industrial or commercial matters. Paragraph 3, Article 10 (b) of the convention prohibits indications, the use of which are liable to mislead the public as to the nature, manufacturing process, characteristics, the suitability for their purpose or the quantity of the goods since these would amount to unfair competition. Tracing the history of the convention and its various revisions at the 1958 Lisbon conference, a new Article 10 (b) was proposed as follows:

"Indications or appellations, the use of which in the course of trade is liable to mislead the public as to the nature, the origin, the manufacturing process, the characteristics the suitability for their purpose or the quantity of the goods".

Although this proposed was passed and became Paragraph 3(3) of Article 10 (b), the words 'the origin' were struck out by the United States by exercising veto ^[4].

Paris Convention has following Limitations:

- (i) It does not define an appellation of origin or an indication of source.
- (ii) It deals only with false indications and not misleading indications. Though the Paris Convention does not contain any definition of what constitutes a false indication, a reading of Article 10(2), which defines an 'Interested Party', provides an indirect definition of the same. For example, a producer of Darjeeling tea in India would qualify as a person with an interest in the true indication and thus, have the locus standi to object to any use of such indication on a label to describe a product produced in a place other than that identified by the indication. However, there is no clear and direct definition of a false indication.
- (iii) The Paris convention does not deal with genericide of an indication outside the home country.
- (iv) In case, if a country's laws do not permit seizure on importation or prohibition of importation or seizure inside the country, sanctions are to be within the framework of the national laws.

2. The Madrid Agreement (Agreement for the Repression of False or Deceptive Indications of Source of Goods 1891)

Adopted in 1891 and revised at Washington (1911), The Hague (1925), London (1934) and Lisbon (1958), the Madrid Agreement also does not use the term 'geographical indications' ^[5].

The relevant term used in the agreement is 'indications of source' and has almost identical provisions for seizure of goods which use 'false' or 'deceptive' indications of source [Articles 1(1), 1(2) and 1(3)]. The Madrid Agreement accommodated the shortcomings of the Paris convention by specifically providing for 'false' as well as 'deceptive' indications of source.

Further, under Article 3 (b) of the agreement, the use of false representations on the product itself and in advertising or other forms of public announcements is prohibited. Still further, under Article 4, the courts of each member country could decide what appellations, on account of their generic character, are excluded from the provisions of the agreement. However, there is a specific exclusion of 'products of the wine' from the operation of this provision.

The Madrid Agreement, however, does not provide for use of false or deceptive indications used in translation or accompanied by qualifiers such as 'kind', 'type', 'style' etc. For instance, use of expressions such as 'champagne style' for a sparkling white wine produce outside champagne would not be actionable under the provisions of this agreement.

The Madrid agreement is still in force but is not part of the TRIPS Agreement.

6. The Lisbon Agreement (1958)

This agreement was concluded in Lisbon in 1958 and subsequently, revised in Stockholm in 1967 and amended in 1979 ^[6].

This agreement sets a relatively higher standard of protection and was relied upon as a model while drafting the TRIPS provisions on geographical indications.

The Lisbon agreement is the first of such agreements to define the term "appellation of origin". However, it does not use the term 'geographical indications'.

Under Article 1 of the agreement, once registered, an appellation of origin is protected in other member countries. Article 2(1) of the agreement defines 'appellations of origin' to mean the geographical name of a country, region, or locality, which serves to designate a product originating therein, the quality, and characteristics of which are exclusively or essentially due to the geographical environment, including natural and human factors'.

Hence, an appellation of origin to be protected under the agreement has to be necessarily a geographical name. Further, the quality and characteristics of such appellation of origin should be essentially linked to the geographical environment.

Under Article 3 of the agreement, protection is extended to include any usurpation or imitation, even if the true origin of the product is indicated in translated form or accompanied by terms such as "kind", "type", "make", "imitation" or "the like". The expression used here is 'usurpation' and may be interpreted to include any kind of wrongful usage.

Hence, member countries would have to ensure that kind of usurpation or imitation including use of qualifiers such as 'kind' 'type' 'style' etc. as referred to in this article is prohibited under their laws. Further, use of an appellation of origin a dissimilar goods may also be considered an usurpation of the appellation.

The Lisbon agreement, therefore, takes care of the shortcomings of the Paris convention and the Madrid agreement.

1. The Lisbon agreement has following limitations:-
2. The name to be protected must be a proper geographical name. This limitation would exclude as ineligible subject matter non-geo-graphical names which have acquired secondary meaning as geographical indications (such as Basmati, Feta, Cava etc.).
3. The agreement does not cover those appellations of origin which possess merely a certain reputation, for protection under the agreement, it is necessary that certain qualities and characteristics of the product must be essentially linked to the geographical region. For instance, Sheffield cutlery, although a well-known geographical indication may not be eligible for protection under the Lisbon agreement since the only criterion relevant to its protect ability is the availability of raw materials such as iron ore in Sheffield, and not human factors such as skill and craftsmanship handed over generations.
4. The definition of 'appellation' of origin would, by the large, be applicable to agricultural products or handicrafts which have a nexus, natural or human, with the geographical region in question. It may not be applicable to products of industry for the reason that the qualitative link stipulated under the agreement between the product and the region may not be applicable to all industrial products. However, there may be products of human labour or endeavour which do not have any qualitative nexus with human skills and thus, may not be the subject matter of a Lisbon registration.
5. The member countries are obliged to protect without exception even those appellations which have become generic in other member countries.

3. The Draft Treaty on the Protection of Geographical Indications (1975)

This treaty drafted with a view to enacting a new multilateral treaty instrument on the protection of geographical indications. The work started in 1974 and the first draft of the treaty was ready in 1975. The treaty adopted a new definition of geographical indications for the provided to both appellations of origin and geographical indications. The scope of the definition was larger than that provided under the Lisbon agreement. It was not mandatory for the signatories to the treaty to have domestic laws for the protection of appellations of origin.

The treaty provided for prohibition of registration or use of denominations, expressions or signs which constitute or directly or indirectly contain false or deceptive geographical indications as to the source of products or services.

Under the treaty a geographical indication which fulfills any of the following conditions was considered eligible for international registration.

- (i) The geographical indication must consist of the official or usual name of the filing state or the name of a major circumscription of a state or of a denomination which serves to indicate the source of a product.
- (ii) The indication is declared by the filing state to be a reference to itself as the state of origin;
- (iii) The indication is used in the course of trade in relation to products originating in the state, and the said state certifies such use.

The protection under the draft treaty was unlimited in time; however, continued protection depended on the payment of maintenance fees. Although the draft treaty had provisions for sanctions and the right to bring an action, it was still possible to settle disputes through diplomatic channels.

However, when preparations for the revision of the Paris convention started in the late 1970s, it became apparent that those preparations also extended to geographical indications, and consequently, to avoid overlap, the work on the draft treaty was not continued.

4. TRIPS Agreement

The most recent international agreement on 'Indications of geographical origin' is the Agreement on Trade – Related Aspects of Intellectual Property, Rights, of 1994 (TRIPS). TRIPS as part of the WTO Agreement, is binding on all WTO Member states. It is, in addition, the first international legal instrument in which the term geographical indications (GIs) appears. Section 3 of the TRIPS agreement consisting of Articles 22, 23 and 24, deals exclusively with geographical indications.

Article 22.1 of TRIPS Agreement defines geographical indications as follows:

“Indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristics of the good is essentially attributable to its geographical origin”.

Under Article 23, there is a more specific level of protection extended to wines and spirits alone. Such additional protection entails that even where there is no possibility of misleading the public, such geographical indications are protected.

Article 24 of TRIPS Agreement provides certain minimum exceptions to the protection of geographical indications. However, members are free to implement in their law more extensive protection than is required by TRIPS, thereby leaving it open to them to dispense with these exceptions. The only prohibition is that such protection must not contravene the provisions of the TRIPS Agreement.

Comparing the TRIPS definition with the definition of 'appellations of origin' in the Lisbon Agreement

Article 22 (1) resembles at first glance to Article 2 of the Lisbon Agreement, yet it differs from Lisbon on a number of points:

- (i) Appellations of origin' under the Lisbon Agreement are necessarily geographical indication name of a country, region, or locality, while geographical indication under TRIPS are any indication pointing to a given country' region or locality.
- (ii) 'Appellations of origin' under Lisbon designate a product while a geographical indications under TRIPS identifies a good, the term traditionally used in GATT/WTO contexts to differentiate goods from services. It is not clear, however, that a different meaning (between "product" and "good") was intended.
- (iii) Lisbon limits appellation to the quality and characteristics of a product, while TRIPS also mention its reputation.
- (iv) The mechanism for the registration of appellation of origin under the Lisbon Agreement is in the hands of the government/states with their inherent bureaucratic delays and processes. On the other hand, TRIPS leaves such

mechanism to the member countries without laying down any specific guidelines in this behalf.

The Additional Protection for wines and Spirits under Article 23 of the TRIPS Agreement

Article 23 of the TRIPS Agreement provides additional Protection for geographical indications for wines and spirits only, which is expressed in two ways. Firstly, Article 23 (1) provides that Member states shall provide the legal means, for interested parties to prevent use of a geographical indications identifying, wines and spirits not originating in the place indicated by the geographical indications. This protection should be available even where such use would not misled the public, would not amount to unfair competition, where the true origin of the goods would be indicated or where the geographical indication would be used in translation or accompanied by expressions such as "Kind", "Style", "imitation", or the like. Secondly, Article 23 (2) permits the refused or spirits, which contain or Consist of a geographical indications, where such wines and spirits do not have the stated origin. Here again, the additional protection would also be granted in situations where the public is not misled.

The preamble of the TRIPS Agreement states that "Members, Desiring to reduce the distortions and impediments to international trade, and taking into account the need to promote effective and adequate protection of intellectual property rights and to ensure that measures and procedures to enforce intellection property rights do not themselves become barriers to legitimate trade".

However, Article 23 of TRIPS Agreement, while provides the preferential and discriminatory treatment to geographical indications relating to Wines and Spirits, does not appears in the line of the preamble of TRIPS Agreement. The intellectual property community seems to have turned bipolar with one end taking a view that Article 23 must be extended to geographical indications relating to products other than wines and spirits as well and the other end taking the view that there is no need for such an extension and that the status quo should be maintained.

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