

Geographical Indications Beyond Doha: Possible “Extension” Scenarios

PAPER BY:
MBOI E. MISATI (B.Sc., M.I.P.)
SENIOR PATENT EXAMINER AND
CHAIRMAN OF OUTREACH, RESEARCH & COLLABORATIONS
KENYA INDUSTRIAL PROPERTY INSTITUTE – NAIROBI
© 2009

FOR PRESENTATION AT:
THE IV GENERAL ASSEMBLY OF ORIGIN

ORGANISED BY:
ORIGIN

AT:
THE TERUEL CONFERENCE CENTRE, SPAIN

FROM:
24TH – 26TH JUNE 2009

Mboi E. Misati
© 2009

Objective of Paper

- The objectives of this paper are:
 - To introduce the subject matter of GIs, and in particular “Extention” of GIs to all products, under WTO ;
 - To highlight for discussion benefits of an Extension from a developing country perspective; and
 - **To propose for discussion options available for, and possible challenges to, supporters of the “Extention” in case Doha ends without granting the Extension or an express negotiating mandate for the same**
- It is not exhaustive, but aims at developing a general understanding of the issues in manner sufficient enough to stimulate discussion and share information, experiences and way forward as regards the Extension with the oriGIn IV General assembly participants.

Outline of Paper

- GIs Protection Under the TRIPS Agreement;
- GIs Extension under Doha;
- GIs Extension and Draft Modalities for the TRIPS Related Issues;
- Conceived Reasons for Developing Countries supporting the Draft Modalities; and
- **Possible scenarios, and associated possible challenges to supporters of the “Extention”, in case Doha ends without granting the Extension or an express negotiating mandate for the same**

GIs Extension: TRIPS Derivative

- Article 23 of the TRIPS Agreement provides for “Additional Protection for Geographical Indications for wines and Spirits”. Article 23.1 obligates Members to provide “the legal means for interested parties to prevent use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as “kind”, “type”, “style”, “imitation” or the like^[1]”.
- The limitation of this article to wines and spirits, is the basis for the Extension.

^[1] Notwithstanding the first sentence of Article 42, Members may, with respect to these obligations, instead provide for enforcement by administrative action.

GIs Extension: Doha Mandate

- Par. 18 Doha Declaration:

“... We note that issues related to the extension of the protection geographical indications provided for in article 23 to products other than wines and spirits will be addressed in the Council for TRIPS pursuant to paragraph 12 of this Declaration.”

that recognizes it as an implementation related issue and concern that “shall be addressed as a matter of priority” by the Council for TRIPS and be reported to the Trade Negotiations Committee “by the end of 2002 for appropriate action”.

GI Extension: WTO Process

- Discussions have been going on at the TRIPS Council and its supervisory structures at the WTO with a division amongst the Membership necessitating reference back to the other WTO organs by the two MCs: Cancun, Mexico in 2003 and Hong Kong in 2005.
- the debate has included the question of whether Paragraph 12 of the Doha Declaration provides a mandate for negotiations.

GI Extension: WTO Proponents

- Many developing and European countries - mainly the Group of Friends of Geographical Indications (Friend of GIs) [1] - argue that the so-called outstanding implementation issues are already part of the negotiation and its package of results (the “single undertaking”).
- They see the higher level of protection as a way to improve marketing their products by differentiating them more effectively from their competitors’; and they object to other countries “usurping” their terms.
- One of the substantive proposals in this respect calls for the amendment of the TRIPS Agreement so that all products would be eligible for the higher level of protection in Article 23, and the exceptions in Article 24, together with the multilateral registration system currently being negotiated for wines and spirits.

GI Extension: WTO Opponents

- Others (about 17) argue that the Extension can only become negotiating subjects if the Trade Negotiations Committee decides to include them in the talks — and so far it has not done so.
- They oppose the Extension alleging that the existing (Article 22) level of protection is adequate.
- They caution that providing enhanced protection would be a burden and would disrupt existing legitimate marketing practices.
- They also reject the “usurping” accusation particularly when migrants have taken the methods of making the products and the names with them to their new homes and have been using them in good faith.

GI Extension: Tradeoff Indications

- Some countries have said that progress in this aspect of geographical indications would make it easier for them to agree to a significant deal in agriculture while some others reject the view that the Doha Declaration makes this part of the balance of the negotiations.
- At the same time, the EU has also proposed negotiating the protection of specific names of specific agricultural products as part of the agriculture negotiations.

GI Extension: Draft Modalities-1

- In July 2008, the greater majority of WTO members^[1] called for a “procedural decision” - Draft Modalities for the TRIPS Related Issues^[2] - for “parallelism” in the negotiation of three intellectual property: the extension, the multilateral register, and disclosure.
- ^[1] Albania, Brazil, China, Colombia, Croatia, Ecuador, the European Communities, Georgia, Iceland, India, Indonesia, the Kyrgyz Republic, Liechtenstein, the Former Yugoslav Republic of Macedonia, Moldova, Pakistan, Peru, Sri Lanka, Switzerland, Thailand, Turkey, the ACP Group and the African Group.

GI Extension: Draft Modalities-2

Paragraph 7-9 of the Draft Modalities:

- “7. Members agree to the extension of the protection of Article 23 of the TRIPS Agreement to geographical indications for all products, including the extension of the Register.
- 8. Text based negotiations shall be undertaken, in Special Sessions of the TRIPS Council and as an integral part of the Single Undertaking, to amend the TRIPS Agreement in order to extend the protection of Article 23 of the TRIPS Agreement to geographical indications for all products as well as to apply to these the exceptions provided in Article 24 of the TRIPS Agreement *mutatis mutandis*.
- 9. Special and Differential treatment shall be an integral part of negotiations in the three areas above, as well as special measures in favour of developing countries and in particular least-developed countries.”

GI Extension: Draft Modalities & Developing Countries Support

- The proponents of the Draft Modalities who are developing countries and countries in transition agree with developed countries in the Group that the higher level of protection can:
 - Improve marketing of their products by differentiating them more effectively from their competitors,
 - Prevent other countries “usurping” their terms (Gis),
 - Open, and help to retains, new market opportunities by preventing trade distortions and misappropriation,
 - Foster development of local rural communities and encourage a quality agricultural and industrial policy, and
 - Be hand in this time of trade liberalization in vital sectors of their economies, by being a valuable tool for the marketing and promotion of quality products not only from developing, but also developed countries.

GI Extension: Possible Scenerios Beyond Doha

- The way foward will heavily depend on the policy priorities of every advocating Member for the extension and may include:
 - Accepting the lose;
 - Abandoning the WTO process for a WIPO one based on the Lisbon and Madrid Agreements on appellation of origin.
 - Invoking bilateral arrangements with other like-minded Members;
 - Invoking pluralateral arrangements amongst like-minded Members;
 - Devising new or continuing with strategies to secure a multilateral arrangement, and
 - Invoking pluralateral arrangements amongst like-minded Members; and using same as platform for securing a multilateral arrangement

GI Extension: Lose Scenarios after Doha

- Wasted effort and resources for the proponents of the Extension translating to:
 - Weaknesses in the marketing of their products due to ineffective differentiation between theirs and those of their competitors,
 - Continued “usurpation” of their terms (GIs) by other countries,
 - Continued trade distortions and misappropriation,
 - Weaknesses in the development of local rural communities and encouragement a quality agricultural and industrial policy, and
 - Less friendly tools in this time of trade liberalization in vital sectors of their economies, thus weaknesses in valuable tools for the marketing and promotion of quality products not only from developing, but also developed countries.

GI Extension: Bilateral Approach Beyond Doha

- The effective approach being exercised by WTO Members and occasionally achieving what was, or could be impossible/difficult to under the multilateral system.
- The effect of National Treatment?
- The effect of MFN?

GI Extension: Prulateral Approach Beyond Doha - 1

- Lessons to learn from other related arrangements:
 - The Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods
 - Substantive Provisions?
 - Non-existence of Union?
 - Lisbon Agreement for the Protection of Appellations of Origin
 - Substantive Provisions?
 - Existence of Union?

GI Extension: Prulateral Approach Beyond Doha - 2

- A single-package for Extension, Register or Disclosure?
- The effect of National Treatment?
- The effect of MFN?
- Applicability of S&D
 - Transitional arrangements? Benefits?
 - Technical and financial assistance?
- The potential to platform multilateral approach?

GI Extension: Beyond Doha

- Well researched answers to the above listed questions could influence policy decisions of Members in favour of Gis Extension Beyond Doha.

GI Extension: My View Now & Beyond Doha

- My personal opinion is that:
 - Member proponents start or intensify technical / financial assistance programs in developing country proponents to build or strengthen their institutional, policy and legal frameworks in GI systems,
 - Member proponents embark on bilateral arrangements that encompass the issue of Extension, and
 - Member proponents continue the fight beyond Doha for a prulateral arrangement e.g. by pursuing the Draft Modalities.

End: For Your Attention

- Imbuya Mono
- Asante Sana
- Thanks
- Muchas Gracias
- Merci Beaucoup
- Arigato Gosaimasi