

Intellectual Property Watch

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Proponents Seek To Develop Policy Potential Of US Geographical Indications

By [Catherine Saez](#) @ 11:08 am

Advocates of stronger protection of geographical indications are working to develop greater awareness in Geneva policy circles, trying to win over countries reluctant to adopt a specific GI protection system.

In an effort to open a dialogue about geographical indications in the United States, a European-based advocacy group presented a handbook on the subject on 23 March, showing the interest of more effective protection of products of origin in the country.

Synchronised with last week's "stock-taking" assessment of the World Trade Organization (WTO) Doha Round negotiations, the Geneva-based Organization for an International Geographical Indications Network (OriGIN) held a presentation of its handbook as a way to both campaign in favour of GIs but also to present specific means of protection that could agree with the present US system.

One of the issues of the Doha Round is the creation of a multilateral system for notifying and registering GIs for wines and spirits, and whether or not the international register should be binding, its impact on current national legislation.

Separately, WTO members are discussing the extension to other products of the higher level of protection that wines and spirits enjoy under the Article 23 of the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS).

Currently GIs for all products are covered by [TRIPS Art. 22](#), which provides a definition of GIs, describing them as "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."

According to Massimo Vittori, secretary general of OriGIN, GIs are a new concept in the United States but they are gathering growing interest from selective consumers, scholars, lawyers, and producers. International producers are also showing interest in modifying the system of GI protection in the US as the exercise seems to be both costly and difficult, according to Vittori.

Following this observation, OriGIN issued a manual titled: American Origin Products (AOPs): Protecting a Legacy, in order to "start the analysis" and open a debate with a variety of stakeholders in the US, Vittori said.

The US government has specific views on the issue of GIs and considers that adequate protection is achieved through trademark, said Stanton Lovenworth, one of the authors of the manual and US lawyer for Dewey & LeBoeuf.

Three kinds of protection currently exist in the US for GIs: Commercial trademarks, collective marks, and certification marks, Lovenworth said. Although certification marks seem to be the most favourable for producers, they still carry a number of problems, he said. One of the major problems is that the owner of a certification mark cannot be the user of the mark. The second flaw of the certification mark system, according to the manual, is the costs involved. The registration costs are high, but the "costs of maintaining a US certification mark can be prohibitive," the handbook said.

Improving the Current US System

Several solutions to improve the US system of GIs registration and protection are available, according to the handbook, one of them is the establishment of a national listing of US GIs. Another one would be to adapt the existing US certification mark system to make it friendlier to producers, said Lovenworth.

For example, "allowing the certification mark owner to use the mark would allow it to finance some of the expenses of maintaining and enforcing the mark through sales of its own product," according to the manual. Another step could be to create a new class of certification marks, especially designed for GIs.

The US has traditionally resisted the principle of the establishment of a multilateral register of GIs with an automatic international protection, while the European Union has supported the idea. To date, the US is in favour of a non-binding multilateral register of GIs. However, in order to enforce GIs in foreign jurisdictions, "the register should apply to all countries," and "the territorial nature of intellectual property rights should be preserved," the advocacy manual said.

OriGIN is positioning itself as a think tank, Vittori told *Intellectual Property Watch*, and the handbook is meant to promote a cross cultural dialogue among countries discussing the TRIPS mission.

The GIs extension is perceived as a sui generis system, much like the EU system, which has brought reticence among those content with the status quo, but the publication shows that the trademark system

can be amended to incorporate the extension, he added. About 100 countries are currently using a sui generis system to protect GIs, Vittori said.

For Jürg Simon, Swiss IP lawyer and president of the Swiss emmentaler appellation of origin, "time is ripe for a thorough debate." He added that in the US, certification marks were challenging for foreign producers.

The problem of GI registration not only lies in the US, said Federico Desimoni, legal advisor at the "Consorzio del Prosciutto di Parma." Problems are encountered in many patent offices internationally where GIs are registered as commercial trademarks, with no real link to the geographical area. He suggested to provide more information to patent offices. He also said that in Japan, regionally-based collective marks were made possible thanks to a slight change to the Japanese trademark law.

On the establishment of an international register, questions remain in the debate such as the legal obligations that would be brought by the register, the role of the register in national decision-making when awarding a GI, and whether the register should be voluntary or mandatory. The question of the administrative and financial costs associated with the register for each government is also at the heart of the debate, according to the WTO website.

A recent initiative of the US Department of Agriculture, through the Rural Development Agency, and led by the University of Arkansas, is aiming "to take a first inventory of US GI 'nominee' products on a state-by-state basis as an initial step towards creating a national listing," according to the handbook. A website is being dedicated to the project. <http://aop.uark.edu/>