

January 24, 2025

2025 Special 301 Review: oriGIn submission

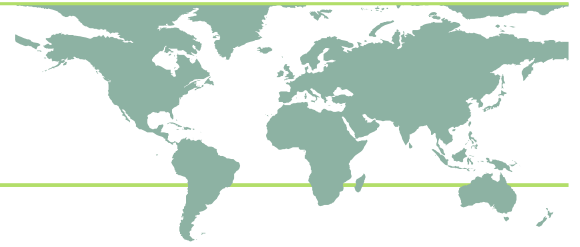
oriGIn is pleased to submit these comments to the Office of the United States Trade Representative (USTR) for the 2025 Special 301 Report.

oriGIn is the global alliance of Geographical Indications (GIs), representing some 600 associations in the agriculture, wines, spirits and craft sectors from 40 countries, including the United States of America (USA).

The 2024 Special 301 Report (hereinafter the Report) maintains a number of criticisms with respect to the legislative initiatives in the field of GIs at the national, bilateral and international level of the European Union (EU), its Member States, of other countries (among others China, Indonesia, Brazil, Ecuador, Mexico, Thailand, Vietnam), and of the World Intellectual Property Organization (WIPO):

- i. First of all, the Report says that the EU GI system impairs the scope of trademark protection and may result in consumer confusion, as it permits the registration and protection of GIs that are confusingly similar to prior trademarks.

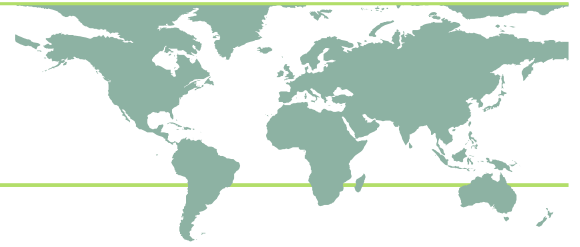
In response to this, **we would like to underline that the EU GI system does not allow the registration of a name as a geographical indication where, in light of an earlier trade mark's reputation and renown and the length of time that it has been used, such registration would be liable to mislead the consumer as to the true identity of the product (current art. 30 of Regulation 2024/1143; the same approach was consistently adopted in previous Regulations).** On the other hand, **the coexistence between an earlier trademark (which has not acquired a specific reputation and renown) and a GI – which registration has been requested at a later stage – is allowed in the EU under specific circumstances, set out in article 31(3) of Regulation 2024/1143 (the same approach was consistently adopted in previous Regulations).** This rule (which is present in other national legislations beyond the EU) is compatible with the TRIPS Agreement and internationally recognized intellectual property rights (IPRs) principles. In 2005, the World Trade Organization (WTO) Panel which had to analyze such rule following a complaint by the USA, agreed with the EC point of view. While the rule at issue allows the registration of a GI even when it conflicts with a prior trademark, as written, it was considered sufficiently constrained to qualify as a “limited exception” to trademark rights. This is in line with article 17 of the WTO TRIPS Agreement, according to which members may provide limited exceptions to the rights conferred by a trademark.



- ii. Second, the Report says that the EU GI system and strategy (of negotiating and concluding trade agreements covering GIs with third countries) adversely impact access for U.S. and other producers in the EU market and other markets by granting protection to terms that are considered in those markets to be the common name for products.

In response to this, we would like to stress that GIs are IPRs as provided, among others, in article 1.2 of the TRIPS Agreement. A large majority of national laws protect GIs as an independent category of IPRs. **Even countries – such as the USA – relying on trademarks (i.e. certification marks) do not question the IP nature of such rights. GIs represent a well-established legal concept, defined in multilateral treaties, bilateral agreements and national legislations. Notwithstanding whether they are protected through independent systems or trademarks – GIs have precise criteria concerning definition, registration, oppositions, length of protection and exceptions.** Exceptions to GI rights, like any other IPRs, exist and ensure an equilibrium with public domain interests. Those exceptions – including the one based on the fact that the corresponding term has acquired a **generic nature** – are **evaluated and implemented by the EU and third countries individually, with respect to their own jurisdiction. Such evaluations have consistently been applied on a national basis, in line with the territorial nature of IP rights. When a GI is applied for in the EU and/or in a third country via direct application or through a bilateral or international agreement, an open and transparent opposition process is held, to allow third parties to claim, among others, the genericity of the corresponding name (administrative and judicial remedies are also available).** If a GI is registered or protected in the EU and/or in a third country via direct application or through a bilateral or international agreement, it means that genericity was not proved in that jurisdiction. We would like to recall here that, in legal terms, the fact of simply producing or importing a quantity of a product bearing the GI name does not amount automatically to reach the genericity threshold: all relevant factors (legal, economic, technical, historical, cultural and social) must be taken into account.

Furthermore, the Report seems to suggest the existence of common names for food products to be considered generic internationally. This would conflict with the territorial nature of IPRs. If we follow such an approach, the names at issue would be considered of free use in each and every jurisdiction around the world. Now, over the years, several GIs groups, including some of those mentioned in the Report, have obtained protection in certain foreign markets via direct application of the GI or, in jurisdictions where independent GI systems were not available yet, through trademark. **The above-mentioned approach would therefore consider generic altogether a number of valid GIs and trademarks, without any evaluation as to whether the corresponding names became effectively generic in a given jurisdiction.**



We believe this would be extremely dangerous not only for GIs, but for the international IP rights system in its entirety.

- iii. The Report also mentions that, within its borders, the EU is enlarging its system beyond agricultural products and foodstuffs to encompass non-agricultural products, including apparel, ceramics, glass, handicrafts, manufactured goods, minerals, salts, stones, and textiles.

In response to this, we would like to mention that the uniform recognition and protection throughout the Union for craft and industrial GIs intends to ensure a similar treatment to all products, instead of regulating craft and industrial GIs at Member States level. This facilitates transparency as well as harmonized procedures. **The unitary system for craft and industrial GIs – achieved through the EU Regulation 2023/2411 – follows the same principles of Regulation 2024/1143 in terms of registration, length of protection, relations with earlier trademarks, opposition and exceptions to protection (including genericity). As a result, the respect of internationally recognized IPRs is ensured.** In this respect, the system will be formally managed by the European Union Intellectual Property Office (EUIPO).

- iv. Finally, the Report maintains its criticism for the WIPO Geneva Act of the Lisbon Agreement for the Protection of Appellations of Origin and Geographical Indications.

In response to this, we would like to mention that **the Geneva Act codifies some of the above-mentioned internationally recognized IPRs principles. It ensures that the rights derived from trademarks applied for, registered or acquired through use in good faith before the protection of a GI, are safeguarded (Article 13(1)) and that Contracting Parties may refuse protection in their territory (Article 15).** While the grounds of refusal are not listed in the relevant articles of the Lisbon Agreement and the Geneva Act, the practice shows that **genericity of a given name in the country scrutinizing an international application can be invoked as a ground to refuse GI protection**. In this regard, it should also be mentioned the footnote which has been included in Article 12 of the Geneva Act.