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# Geographical Indications at the WTO: An Unfinished Agenda

**Kasturi Das***

***Abstract:*** Over the recent past, Geographical Indication (GI) has emerged as one of the most contentious categories of intellectual property (IP). Two among the three TRIPS issues presently under discussion at the WTO pertain to GIs, the third being the relationship between the TRIPS and the CBD. Interestingly, in sharp contrast to the archetypical North-South divide on IP issues in the realm of the WTO and beyond, in the sphere of GIs one comes across developing countries joining hands with developed countries either as *demandeurs* or opponents in the ongoing WTO talks, depending on their respective stakes on GIs. The aim of this paper is to provide a concise account of the ongoing WTO discussions on GIs. However, the dynamics of the current negotiations cannot be put into perspective unless judged in the light of the key reasons underlying the discordance between the two sides of this highly contentious area, namely the 'Old World' and the 'New World'. With this aim in view, the paper explores some of the key historical, legal and economic reasons underlying the GI row. Given that the issues presently under discussion have their origin in the Uruguay Round negotiations and the compromise deal on GIs that they culminated into, the paper undertakes a rigorous assessment of the drafting history of the Uruguay Round. It then goes on to track the ongoing negotiations and analyzes various negotiating proposals under consideration on the three GI issues: multilateral register for wines and spirits; extension of the higher level of protection presently available for wines and spirits to all product categories; and the 'claw-back' proposal of the European Communities (under the agriculture agenda). The paper argues that the recent emergence of a strategic alliance of more than 100 Member countries in support of a parallelism on the three IP issues may be helpful in pushing the GI agenda forward, including the case of 'extension' that has been strongly supported by many developing countries including China, India, Pakistan, and Sri Lanka, among others. However, adequate legal protection at the international level through the 'extension' route can at best be regarded as necessary but in no way sufficient for reaping the commercial benefits out of the Southern GIs in the global market. Hence, the developing country proponents of GIs need to weigh the costs and benefits among various issues of interest to them before taking any particular stance at the WTO in the future. Given that the aforesaid strategic alliance was reached at the cost of a significant compromise on the part some of these developing countries on the TRIPS/CBD front, it remains an open question whether such a compromise was worth making for these countries, many of whom could actually have benefited more by getting a better deal on TRIPS/CBD than on GIs!

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## 1. The Context

The protection of Geographical Indications (GIs) has, over the years, emerged as one of the most contentious intellectual property rights (IPRs) issues in the realm of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) of the World Trade Organization (WTO). Interestingly, while the Uruguay Round (1986-94) negotiations were witness to a major North-South divide regarding the inclusion of IP (intellectual property) issues, in general, in the agenda, GIs was the lone IP issue on which there was a significant North-North divide all through the Uruguay Round negotiations. In fact, the torch-bearers of the IP agenda in the Round, namely, the United States and the European Communities (EC)[1] were on the loggerheads on this particular issue. While the EC was aggressively pushing for a full-proof protection for GIs, particularly for those pertaining to wines and spirits, the United States was strictly opposed to even recognizing GIs as a separate category of IP, arguing instead for its inclusion only as a part of the Trademarks field. Divides also existed among other developed countries and among developing countries, exacerbating the difficulties of the negotiations further. The eventual framework of the TRIPS provisions on GIs reflected a very sensitive compromise reached during the Uruguay Round in which a higher level of protection was granted for wines and spirits[2] compared to all other categories of GIs, ostensibly for the political reason of persuading the EC to join consensus on the Uruguay Round package, despite strong opposition on the part of many other countries. The higher protection for wines and spirits, however, was subject to certain prior use exceptions that were granted clearly to take care of the concerns raised by the United States and Australia, among others, at least to an extent. The final text of the Agreement also left room for future negotiations, clearly reflecting the difficulties encountered during the Uruguay Round in arriving at an agreed outcome on some of the important issues. Post-Uruguay Round, negotiations on GIs have focused on two hotly-debated issues: creation of a multilateral system of notification and registration of GIs for wines and spirits; and 'extension' of the higher level of protection presently accorded to wines and spirits to all other categories of GIs (henceforth extension). This time around also the EC is the foremost proponent of both these issues that form part of the TRIPS agenda of the ongoing Doha Round of talks. In addition, the EC has also triggered a third stream of the debate under the agriculture agenda of the Doha Round by way of tabling in the Negotiating Group on Agriculture its proposal on the 'clawback' of a select set of GIs. For the EC, all these three routes are nothing but different procedural means to achieve the long-standing goal of stringent protection for GIs at the global level. This time around also the traditional opponents of a strong GI regime like the United States, Australia, Canada, among others, are leaving no stones unturned to deter the EC from fulfilling its objective. After being forced to swallow the inclusion of GIs as a separate category of IP under TRIPS, these staunch opponents are clearly in no mood to let the EC get away with further strengthening of the GIs regime under the WTO. Interestingly, in sharp contrast with some of the other controversial IP issues in the realm of the WTO, such as access to medicine, on which there exist a clear-cut North-South divide, in case of GIs, particularly on extension, one can find developing countries joining hands with developed countries either as demandeurs or opponents, depending on their respective stakes in GIs. This, certainly, is a striking feature of the current round of negotiations on GIs in the WTO, often referred to as a debate between the 'Old World' (e.g. EC, Switzerland) and the 'New World' (e.g. United States, Australia, Canada, Argentina, Chile)

The aim of this paper is to provide a concise account of the ongoing WTO discussions on GIs and to analyze the positions adopted by the key players in these debates. However, the dynamics of the current negotiations cannot be grasped unless they are analyzed in the light of the key reasons underlying the discordance between the Old World and the New on this highly contentious issue. While the reasons are multi-pronged and hence can be analyzed from various perspectives, an exhaustive coverage of all these issues is outside the scope of the present paper. Nevertheless, at the risk of being selective, an attempt is being made in Section 2 to briefly touch upon some of the key reasons underlying the positions adopted by the Old World and the New World on GIs in the WTO and beyond. Given that the issues currently on the negotiating table have their origin in the Uruguay Round negotiations and the compromise deal on GIs that they culminated into, the current debates can be put into perspective only when assessed in the light of the negotiating history of the Uruguay Round and the resultant TRIPS provisions pertaining to GIs. Section 3 is developed with this objective in mind. Given the historical background, Section 4 focuses on the three tracks of the current WTO negotiations on GIs: multilateral register for wines and spirits; extension; and claw-back. Section 5 concludes the paper.

## 2. The GI Row between the Two 'Worlds': What Lies Beneath?

GIs stand at the intersection of three increasingly central and hotly debated issues in international law: trade, IP and agricultural policy.[3] While economic concerns evidently loom large in the global row over GIs, there are also fundamental differences in the historical and the ideological underpinnings pertaining to GIs between the Old World and the New. Furthermore, the efforts to entrench GI protection in international law draw strength from more diffuse concerns about authenticity, heritage and locality in a rapidly integrating world. For some of its proponents, to assert the necessity of GI protection is, in part, to assert the importance of local culture and tradition in the face of ever-encroaching globalization. The GI question is, as a result, linked to larger, politically sensitive debates about the appropriate level of protection for farmers and rural communities, the degree to which international law ought to trench upon questions of culture and tradition, the necessity of IP protection and, above all, the importance of economic competition.[4] The discordance on what would constitute the most appropriate international legal regime on GIs that has surfaced in WTO and beyond, is also attributable in large measures to the diverse approaches by which GIs have been protected domestically in various countries of the world. In fact, while GIs have long since been well-anchored in the legal systems of many European countries, for a vast majority of countries elsewhere this is indeed a relatively new concept.

History of origin-labelled products in Europe dates back to centuries if not millennia. Certain southern European countries like France, Spain, Italy, Greece and Portugal are home to numerous renowned GIs that carry with them age-old traditions. French law first addressed GIs in 1824. Some commentators have argued that in the history of the privileges of the French wine growers, as illustrated by 'Bordeaux' and 'Champagne', one finds the combination of elements of rural policy, guarantees of authenticity and the search for competitive advantage, which marks the current WTO debate about global regime on GIs. The appellation of origin concept emerged from the privileges that were enjoyed by particular wine producing regions in France since the Middle Ages and continued almost till the end of the eighteenth century.[5] Regulation in the ancient regime was piecemeal and adapted to local political and historical privileges and conditions, rather than based on a uniform national approach. It was very much inspired by the fear of fraudulent admixtures and false attachment of names. At that time, since it was not possible to test adulteration chemically, a very high degree of specific regulation and supervision of production was required to prevent subterfuge. This obviously imposed enormous costs and resulted in regulatory constraints whose effect was anti-competitive. As Caenegem (2003b) has argued, it was only with difficulty that the notion of appellation of origin managed to emerge from this regulatory morass once the privileges were later abolished. Early twentieth-century France saw the beginning of an era of more general regulation of production and trade in foodstuffs, in general and wines, in particular. Uncertainty about the delimitation of wine-producing regions, and adjacent frauds, was finally removed by the Law of 6 May 1919 concerning *Appellations d'Origine Contrôllée* (AOC). This Law fixed the principles of delimitation of regions, defined the characteristics that the products were required to have and also stipulated the protection afforded to them. In 1935, the general system of establishment of AOCs was set up under the Law (*Loi-décret*) of 30 July under the supervision of a Committee, which became the INAO (*Institut National des Appellations d'Origine*) from 1947. Notwithstanding such initiatives, a well-protected AOC like 'Champagne', with all its associated goodwill, continued to remain susceptible to misappropriation by rival traders. Even if such unscrupulous traders did not make direct use of the famous AOCs on their products, they did make attempts to ride on its coat-tails by cunning subterfuge or modification of terms which sometimes allowed them to escape the law. The modern-day approach to registered GIs for wines in the EU, which is very strict and does not permit the use of the GI in combination with other terms, in translations, in the form of '... –style', etc., or with clear disclaimers, basically originated with the aim of combating such cunning ways of misappropriation.[6]

Central to the French AOC, which has influenced the current EU system of GI protection in large measures, is the idea that particular regions bestow unique qualities on foods and wines. This is closely linked to the French word *terroir*.[7] In its increasingly active media campaigns to promote GI-denominated foods, the European Commission defined *le gout du terroir* as 'a distinct, identifiable taste reminiscent of a place, region or locality… Foods and beverages that evoke the term *terroir* have signature qualities that link their taste to a specific soil with particular climate conditions. Only the land, climate and expertise of the local people can produce the product that lives up to its name.'[8] Under the AOC-type of system, production is highly regulated in an endeavour to guarantee its close connection with both the human and the physical characteristics of a narrowly circumscribed region. Stringent quality and production control ensures consistency in product standards over time, to a degree at least, which is considered to be an essential prerequisite for GIs to fulfil their function of a meaningful quality signal.[9]Thus, as per this conceptual underpinning, a GI-product is not only regarded as originating from a place, it is also supposed to have certain unusual, even unique qualities that the place alone can provide.[10] The European system of GI protection based on this conceptual foundation, therefore, prevents producers from outside the designated region associated with a protected GI from using it. This uniqueness principle also forms a core justification for GI protection without a genericness defence, as espoused by the Old World. Going by this principle, the name of a region, when used by producers from outside the region, is unavoidably misleading because the latter products could never have the unique regional characteristics that only the original geographical area could entail. Therefore, the name of a region can, *a forfiori*, never become a general descriptor of a category or kind of goods.

The uniqueness principle is not universally accepted, however. According to an alternative school of thought[11] that questions the European-type protection regime based on this principle, production methods may, in general, be far more significant to the characteristics of agricultural products than geographical origin. While geographical characteristics are obviously not transferable, but are rarely absolutely unique, even the most unusual methods of growing and processing crops can be copied, and skills transferred or learned.[12] Accepting this view, however, has far-reaching consequences, as it not only undermines the uniqueness principle, but also undermines the consumer-protection function of registered GIs. In other words, as per this school of thought, whereas there may be no difficulty in accepting that the law should be structured to ensure that traders indicate the origin of a product correctly (actions against misrepresentation), it is harder to accept that the law should reinforce the arguably questionable perception that goods bear unique characteristics because of their place of origin (as is the case with strong GI registration regimes). Criticism of the uniqueness proposition is particularly significant in the context of the prohibition of any form of generic use of GIs that lies at the heart of the debate between the two worlds. The origin of this debate may be traced back to the past waves of immigration, particularly around the turn of the 19th century, which brought millions of farmers and artisans from Europe to the Americas and elsewhere – commonly referred to as the New World. These immigrants brought with them their food products and, more importantly, their traditional production methods and recipes. Once settled, they often recreated the products they had known back home and promoted them using the geographical names from their home countries that were associated with quality products.[13] In the New World including the United States, Canada, Australia, and some Latin American countries, among others, such place names have been treated as generic names that refer simply to certain types of products rather than the specific place of origin of that product, to the chagrin of the European countries where the regions are actually located (e.g. Champagne and Chablis in France).[14] In fact, a critical difference between the legal frameworks for protecting GIs in the EU and the New World countries lies in the approach towards generic names. The legal regime for GIs protection in the United States is an appropriate case in point in this context.

The United States relies on its trademark law system for protecting GIs rather than the *sui generis* protection afforded by the EU.[15] The trademark regime, however, does not ensure protection as comprehensive as that offered by the EU-type system for a number of reasons. In trademark law, protection is determined by the strength of the mark. This in turn depends on the classification of the mark as either of the following: (i) arbitrary, (ii) descriptive, (iii) suggestive, or (iv) generic. In line with this approach, the United States provides a multi-tiered approach to GIs protection that differentiates between certain terms as being generic, semi-generic or non-generic designations of geographic significance. Examples of names that have become generic terms for types of beverages are 'vermouth' and 'sake'. A semi-generic designation is one that uses a GI, but with a corrective that indicates the true place of origin of the product. An example is 'California Burgundy' that indicates that the wine has some similarity to the wine produced in Burgundy – a place in Europe - but that the wine is actually produced in California. Non-generic names are distinctive designations of specific grape wines, i.e. wines that comport with the European ideal of AOCs. Some examples are 'Chateau Y'quem', 'Chateau Margaux', 'Pommard', 'Montrachet', 'Schloss Johannisberger' and 'Lacryma Christi'.[16]

In the United States and many other New World countries the European GI producers are confronted with registered trademarks which contain their GI names. According to the principle of 'first in time, first in right' applicable to trademarks, it is therefore not possible for an EU producer to seek trademark registration for the geographical origin of his product, as it is already legally owned by another private party. Parma ham is a perfect case in point. In Italy, Parma ham denotes ham from the region of the city of Parma; but in Canada, it has long been a registered trademark for ham made by a particular Canadian company. Hence, Italian producers of 'Prosciutto di Parma' could not sell their Parma ham under that name in Canada because the trademark 'Parma Ham' was reserved for that company in Canada.[17] The Italian producers had to resort to expensive litigation, re-label their products as 'n. 1 ham' and 'compete with a lower-quality product actually labelled "Parma"'.[18] Parma ham has faced similar problems in Mexico, Argentina and many other countries in the world. In such cases, European producers have only two options. Either they can launch proceedings to obtain the cancellation of the registered trademark or they can enter into negotiations with the owner of the trademark in order to buy it. Apparently, in both cases, actions launched by the EU producers have proved very costly and not always successful. Notably, as per the trademark law system, a mark would be rendered invalid if it was found to deceive the consumers, otherwise not. Given such consumer deception test, if it was found that the consumers in the United States did not regard Dijon mustard as coming from Dijon, France and instead considered the term only as an indicator of a type of mustard, it would be hard to argue by the EU producers of Dijon mustard that the consumers were being deceived by such uses of their GI.

There are certain other limitations of the GI protection under trademark law. Most trademark laws, in general, prohibit the registration of a name with a geographical meaning. Therefore, GI names are often protected via a collective or a certification mark when such legal concepts exist. However, in countries where system of protecting GIs as collective or certification mark is not available, GI producers often have to be satisfied with a limited protection - for their logo only - via a figurative trademark registration. In addition, as per the European Commission (2003b), experience of the GI-producers from the EU reveals that IP offices in various countries often reject registration requests on the grounds that GI names are: (i) a simple indication of the place of origin of the goods (i.e. an indication of source); (ii) a description of the product, and/or; (iii) a generic name. Therefore, the use of the name is considered not protectable and allows false use in relation to goods not coming from the place of origin. The difficulty for GI producers in dealing with these problems lies with the fact that the interpretation and analysis regarding the generic or descriptive character of a name varies extensively from one country to another. Moreover, in many cases, it is up to GI producers to prove that their name has not become generic in the market concerned. This is an expensive challenge.

In countries where protection is available via unfair competition and consumer protection acts, the European producers ostensibly have had to spend a considerable amount of money trying to fend off abuses. They had to launch costly legal actions to seek protection of their respective GIs. In such a case, producers are often required to prove that their GI is not a generic name and that it has acquired distinctiveness. This can be done via consumer surveys, which are expensive and not always conclusive. As for securing protection via passing-off actions, according to European Commission (2003b), this is also a difficult, expensive and a largely uncertain process.[19] It may be noted here that the rationales underlying the legal effects of notification of a GI in the proposed multilateral register for wines and spirits, as will be discussed later in this paper, may be found in the aforesaid difficulties confronted by the EU producers in various WTO Member countries, including those in the so-called New World.

Notwithstanding the roles played by historical, ideological and other non-economic factors, in our view, the key driving force in the ongoing effort to entrench GIs in international law is economic. In fact, despite its long history, GIs gained markedly greater political salience over the past few decades against the backdrop of the increasing integration in the global economy. The expansion of globalization and international trade has led to increasing consolidation of formerly discrete local and regional markets, resulting in increased competition as well as opportunities for the traditional producers of GIs. The share of the household income available for niche food products, which are often marketed through GIs, has also shown an increasing trend over the past few decades, particularly in the developed countries. Luxury goods, once limited to a tiny coterie of the wealthy, have become widely accessible. Enhanced global competition in the luxury goods markets has raised the incentives for producers to claim and assert their GIs in the global market as a way of appealing to consumers fascinated by local traditions and authentic products. While globalization has raised the value of property rights in GIs, it has also made them more susceptible to misappropriation, thereby increasing the incentives for various actors to seek to create or strengthen global protection for GIs through international rules as a means to safeguard and enhance market share in these products.[20] The more recent trend towards stronger IP protection, in general, as epitomized by the inclusion of IP under the purview of the WTO, and supported by subsequent developments in various fora, has also contributed to this process.

An appropriate example, and one that is absolutely central to the current debate over GIs, is the case of the world wine industry. For centuries Europe, particularly France, dominated the world wine market, though the vast majority of production was meant for local consumption only. While in the 1960s, only less than 10 per cent of global wine production was traded internationally, in the 2000s, the proportion has exceeded 25 per cent, and rising rapidly. For the US and the EU, the two major powers in world trade, wine now is a highly traded product and is overlain with cultural conflict: New World technique versus Old World *terroir*.[21] Large segments of the wine industry in the member countries of the EU, particularly France, operate according to a classification system based on geographical origin (e.g. 'Beaujolais', 'Bordeaux'). In the global wine market, this geographic system is in direct competition with a largely New World system based on the grape variety used in the production of the wine (e.g. Chardonnay, Riesling). The battle over what indicates wine quality is being vigorously contested and there are large and valuable markets at stake. It is a battle over the shaping of consumer perceptions of quality and taste of wines.[22] Not surprisingly, the French are unwilling to abandon their long-established system for protecting the goodwill of their wines, particularly when the French wine industry is going through a critical phase owing to fierce competition from the New World wines that are capturing an increasing share of the global wine market and are also increasingly being imported into the EU, as well. The legal powers to restrict the use of the words 'Chianti', 'Champagne', or 'Rioja' to the products of European origin could certainly confer a significant economic advantage to the EU against competition from the New World.[23] The fierce attempt on the part of the EU to ensure GI status for all terms long since being considered as generic names in various New World countries needs to be assessed from this economic angle. The recuperation of geographical names currently considered to be generic is likely to bring the greatest and most immediate economic returns to the EU, as its producers would be able to reap the benefits of years (or even centuries) of expenditures on marketing, brand-building and product refinement undertaken not only by their forebears, but also by the producers from the New World who had thus far been using these terms as generic.[24] However, it is this latter group of producers from the New World who would have to bear the economic burden of adjustments, while at the same time losing the fruits of all their past investments and efforts towards building their brands. One notable example is Budweiser beer, made in the United States by Anheuser- Busch, but also made in the Czech Republic by Budweiser Budvar, which lays claim to the title of the 'original' Budweiser beer producer. Notably, Budweiser 'US' is the number one selling beer in the world, reflecting years of adroit advertising strategy as well as significant expenditure. It would be naive to assume that Anheuser-Busch would relinquish the European name without a struggle, and the same holds true for many other corporations worldwide that find themselves in similar situations. Such conflicting interests make compromises in negotiations extremely difficult to reach as revealed by the dynamics of the GIs negotiations during the Uruguay Round.[25] Although the EU tried hard to get rid of what it considered to be the 'sins' of the past in the New World, owing to vehement opposition put forward by some of the major players from the New World, such as the United States and Australia, it could not succeed in its endeavour. The end-result was a hierarchical system of protection for GIs under TRIPS coupled with a series of exceptions (under Article 24) that created room for continuation of prior good faith uses in the New World. These are some of the lacunae of TRIPS regime on GIs that the EU is trying to rectify in the negotiations under the ongoing Doha Round. Importantly, the attempts on the part of the EU towards further strengthening of the GIs protection under this Round is part of a larger strategy to shield its agricultural producers from increasing New World price-based competition, in the face of mounting pressure to curtail its bloated farm subsidies by reforming the Common Agricultural Policy. According to the EU, in the Doha negotiations it is ready to make 'very significant concessions' on agriculture by eliminating export subsidies, considerably reducing domestic trade distorting support and agreeing to unprecedented tariff cuts. However, in view of the increased competition resulting from such 'concessions', its farmers must have the opportunity to compete where they were competitive, namely in the high quality processed food sector related to the area where they were produced. Notably, this stance is in tune with the European Commission's policy to compete internationally on quality rather than quantity. In this context, the EU argues that the efforts to compete on quality would be futile if the main vehicle of its quality products, GIs, were not adequately protected in international markets.[26] The aggressive stance taken by the EC on GIs may be better understood in the light of the fact that the EC has in its possession some 4800 registered GIs, 4200 for wines and spirits and another 600 for other categories, mainly food products.[27]

## 3. The Uruguay Round in Retrospect

At the international level, TRIPS sets out the minimum standards of protection for GIs that WTO Members[28] are bound to comply with in their respective national legislations. However, there is a problem of hierarchy in the levels of protection based on an arbitrary categorization of goods. This is because, although TRIPS contains a single, identical definition for all GIs, irrespective of product categories, it mandates a two-level system of protection: a basic protection applicable to all GIs in general; and an additional protection applicable only to the GIs denominating wines and spirits. This is a striking feature of the TRIPS provisions on GIs, because such hierarchical protection is not found in case of any other categories of IPs covered by TRIPS. This, despite the fact that GI stands on an equal footing with all other IPs under TRIPS.[29] While it is difficult to find any logical or legal justification for the hierarchical protection granted to GIs under TRIPS, it can be explained quite clearly in the light of the Uruguay Round negotiations. That the present form of GIs protection under TRIPS was eventually agreed upon as a sort of compromise between different Parties with conflicting opinions and interests, becomes evident if one looks closely at the drafting history of TRIPS. Starting with a brief outline of the key TRIPS provisions on GIs, this section dwells on the drafting history of these provisions in some detail.

### 3.1 Highlights of the TRIPS Provisions on GIs

TRIPS provides the minimum standards of IP protection that WTO Members are obliged to comply with in their respective domestic legislations. Members, however, are free to implement more extensive protection, provided such protection does not contravene the provisions of the Agreement. TRIPS also leaves it up to the Member countries to determine the appropriate method of implementing the provisions of the Agreement within their own legal system and practice (Article 1.1 of TRIPS).

Section 3 of Part II of the TRIPS Agreement incorporates provisions for protection of GIs in three articles:

- Article 22 contains a definition of GIs and sets out the general standards of protection that must be available to all GIs;
- Article 23 deals with the additional protection granted to GIs for wines and spirits; and
- Article 24 lays out certain exceptions and also creates room for future negotiations on GIs.

### *3.1.1 Article 22: Basic Protection*

Section 3 of Part II of TRIPS begins by defining GIs in Article 22.1, as follows:

> *Geographical indications are, for the purposes of this Agreement, 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.*

Implicit in the TRIPS definition is the idea that the indication must evoke the geographical origin of the good. However, it need not necessarily be a geographical name. Any other symbol (e.g. 'Feta' cheese) would suffice as long as it succeeds in evoking the geographical origin of the good. Notably, the definition categorically refers to 'good', thereby leaving out services from the scope of GI protection.[30] As per the definition, the good must necessarily possess 'a given quality', 'reputation' or 'other characteristic' essentially attributable to the designated geographical area of origin. It is important to note that, *ceterius paribus*, each one of these qualifiers is in its own merit a sufficient condition for the grant of GI protection. However, TRIPS does not define any of these qualifiers, leaving it to the discretion of WTO Members. Given such flexibilities available in the definition of the subject matter (GIs) under TRIPS, its counter parts in the national legislations of Member countries vary widely.[31]

Article 22.2 requires WTO Members to provide the legal means for interested parties to prevent 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. It further prohibits any use, which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention (1967).[32]

Article 22.3 obliges Members to refuse or invalidate the registration of a trademark, which contains or consists of a GI with respect to goods not originating in the territory purported, when this could mislead the public as to the true place of origin of the product. This provision, among a few others, has been included with the aim of tackling the conflicts that may arise between GIs and trademarks.

Article 22.4 extends the protection enshrined in the previous three paragraphs of Article 22 to a GI, which, although literally true as to the territory, region or locality in which the good originates, falsely represents to the public that the good originates in another territory. In other words, this provision relates to 'homonymous' GIs. 'Homonymous' GIs are geographical names, which are spelled and pronounced alike, but which designate the geographical origin of products stemming from entirely different geographical locations. For instance, 'Rioja' is the name of a region in Spain as well as a region in Argentina and the designation is used for wines produced in both countries.[33] This kind of situation often arises in the case of former colonies. For instance, when people from one country, say France, emigrated to another country and set up a village/town there, they might have given that new village/town the name of their native village/region of origin, which may be famous for a special kind of good, say, cheese. In such a case, if the new village/town produced cheese under its name it could (depending on the circumstances of each case, of course) falsely represent to the public the origin of the cheese.[34]

### *3.1.2 Article 23: Additional Protection for Wines and Spirits*

In contrast to Article 22, which relates to any good, Article 23 deals exclusively with wines and spirits. Under Article 23.1, using a GI identifying wine/spirit for wine/spirit not originating in the place indicated by the GI is prohibited, even where the true origin of the wine/spirit concerned is indicated and/or a translation is used and/or the indication is accompanied by expressions such as ‘kind’, ‘type’, ‘style’, ‘imitation’ or the like.

Article 23.2 is, in a way, the counterpart of Article 22(3), with the difference that unlike the latter, the former allows refusal or invalidation of registration of a trade mark irrespective of whether the public is being misled.

Article 23.3 deals with the case of ‘homonymous’ GIs for wines (not spirits), whose use is not misleading (or deceptive) under Article 22(4) of TRIPS. In such cases both the indications have to be protected and each Member must determine the practical conditions under which such homonymous indications will be differentiated from each other. In doing so, each Member must ensure that consumers are not misled and that the producers concerned are treated equitably.

Finally, to facilitate the protection of GIs for wines, Article 23.4 requires negotiations to be undertaken in the TRIPS Council for ‘establishment of a multilateral system of notification and registration of geographical indications for wines eligible for protection in those Members participating in the system’. The Singapore Ministerial Declaration of 1996 extended this provision to spirits as well.[35] The ongoing negotiations on the multilateral register are as per the mandate enshrined in this provision.

### *3.1.3 Article 24: International Negotiations and Exceptions*

Article 24 of TRIPS deals with international negotiations and also includes a series of exceptions, most notably in relation to continued and similar use of GIs for wines and spirits; prior ‘good faith’ trade mark rights; and generic designations. These exceptions and concessions were included in this Article to take into account the concerns raised by some Old World countries that protection of GIs would challenge what they considered to be ‘acquired rights’, as will be discussed later in this paper.

For instance, by virtue of the exception included in Article 24.4 of TRIPS, a Member country is not obliged to prevent continued and similar use of a particular GI of another Member identifying wines or spirits where such an use takes place in connection with goods or services by any of its nationals or domiciliaries who have used that GI in a continuous manner with regard to the same or related goods or services in its territory either (a) for at least ten years preceding 15 April 1994[36] or (b) in good faith preceding that date.

In order to take care of the potential conflicts that may arise between GIs and trademarks, Article 24.5 contains what is often called the 'grandfather clause'[37] in favour of trademarks that are identical with or similar to GIs, provided certain conditions are satisfied. This provision states that:

> *Where a trademark has been applied for or registered in good faith, or where rights to a trademark have been acquired through use in good faith either:*
>
> *(a) before the date of application of these provisions in that Member as defined in Part VI; or*
>
> *(b) before the geographical indication is protected in its country of origin;*
>
> *measures adopted to implement this Section shall not prejudice eligibility for or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication.*

Another exception contained in Article 24.6 relating to generic names states that:

> *Nothing in this Section shall require a Member to apply its provisions in respect of a geographical indication of any other Member with respect to goods or services for which the relevant indication is identical with the term customary in common language as the common name for such goods or services in the territory of that Member. Nothing in this Section shall require a Member to apply its provisions in respect of a geographical indication of any other Member with respect to products of the vine for which the relevant indication is identical with the customary name of a grape variety existing in the territory of that Member as of the date of entry into force of the WTO Agreement.*

Article 24.8 relating to patronymic GIs upholds the right of any person to use, in the course of trade, his/her name or the name of his/her predecessor in business, except where such name is used in such a manner as to mislead the public.

As per Article 24.1, Members undertake 'to enter into negotiations aimed at increasing the protection of individual geographical indications under Article 23'. The provision further clarifies that the exceptions provided for in Article 24 'shall not' be used by any Member to refuse to conduct negotiations or to conclude bilateral or multilateral agreements. However, it further stipulates that in the context of such negotiations, 'Members shall be willing to consider the continued applicability of these provisions' to individual GIs under negotiation. This means that, notwithstanding the exceptions granted under Article 24, WTO Members may be required to enter into negotiations to phase out these exceptions. Notably, Article 24 exceptions, coupled with the provision for future negotiations implies that the additional protection granted to wines and spirits under Article 23 is also subject to certain exceptions, which are open to future negotiations, leaving room for bilateral or multilateral agreements among WTO Members to phase out such prior rights.

Article 24.9 relieves Members from any obligation to protect a GI, which (i) is not protected in its country of origin, or, (ii) ceases to be protected in that country, or, (iii) has fallen into disuse in that country. This provision underscores the need for ensuring appropriate GI protection at the national level of a WTO Member, in the absence of which other WTO Members would have no obligation whatsoever to protect the GIs of the former country within their respective territories.

## 3.2 Drafting History of the TRIPS Provisions on GIs[38]

Prior to the advent of TRIPS, there were mainly three international conventions dealing with protection of geographical appellations: the Paris Convention for the Protection of Industrial Property (1883), the Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods (1891) and the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (1958).[39] However, given the restricted scope of protection afforded by these multilateral conventions and the limited number of signatory states, none of these treaties could render any significant impact on the global protection of these indicators. In the 1956 Lisbon Conference for the Revision of the Paris Convention, the EU made an attempt to include the term 'origin' in Article 10*bis*, so as to make the application of principles of unfair competition on geographical appellations explicit. However, this initiative was defeated by a single vote of the United States. Other efforts at the World Intellectual Property Organization (WIPO), such as the preparation of a multilateral treaty on GIs in 1974-75, or deliberations in the 1990s on the WIPO's Committee of Experts on geographical indicators remained unsuccessful.[40] The aggressive push by the European Communities (EC) and its member states for including GIs in the Uruguay Round agenda may be understood in the light of their high stakes in GIs and their frustrated attempts in strengthening the global protection for these appellations under the international conventions that pre-existed TRIPS.

When the Uruguay Round got underway, 14 Negotiating Groups were established under the 'Group of Negotiation on Goods', including the 'Negotiating Group on Trade-Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods'.[41] Participants in this Negotiating Group were allowed to make 'suggestions' on various aspects of IPRs. As regards GIs, the EC and Switzerland were the countries that placed enormous emphasis on this area throughout the Uruguay Round negotiations. From the very beginning, the EC proposal emphasized the major trade distortions that were arising, in their view, because of widespread misleading use of GIs, in particular the misuse of names of geographical areas located in the European territory, which represented products specific to the natural and/ or human environment in which they were elaborated,[42] with special importance being attached to the GIs associated with wines. These views were consolidated in treaty language in the 'Draft Agreement on Trade-Related Aspects of Intellectual Property', which was tabled by the EC on 29 March 1990,[43] and covered all categories of IP. This proposal required that 'all' GIs 'shall be protected against any use which constitutes an act of unfair competition, including use which is susceptible to mislead the public as to the true origin of the product'. The proposal also included a list of 'acts', which were to be considered as such. These were:

- *any direct or indirect use in trade in respect of products not coming from the place indicated or evoked by the geographical indication in question;*
- *any usurpation, imitation or evocation, even where the true origin of the product is indicated or the appellation or designation is used in translation or accompanied by expressions such as 'kind', 'type', 'style', 'imitation' or the like;*
- *the use of any means in the designation or presentation of the product likely to suggest a link between the product and any geographical area other than the true place of origin.*

Thus, while the proposal required protection against 'unfair competition' and against consumers being misled for all categories of GIs (and not only for those associated with wines), the 'acts', which were proposed to be prohibited actually meant a stringent protection against any misappropriation of GIs. In fact, it is the second kind of 'acts' that figured in the EC proposal, which visibly formed the basis of the stringent protection ultimately being granted to wines and spirits under Article 23.1 of TRIPS.

The corresponding provision in the Draft Agreement tabled by Switzerland[44] required that GIs 'shall' be protected against any use which is likely to mislead the public, while including exactly the same set of (three kinds of ) 'acts' as specified in the EC Draft as examples of such 'misleading' use. Though the Swiss proposal closely resembled that of the EC, it was stronger in two respects. First, unlike the EC proposal, it did not make any reference to 'unfair competition'. The reason was that Switzerland believed in absolute protection for GIs, with no undue 'burden of proof' being imposed on the plaintiff.[45] Second, while the EC proposal required protection against any use, which is 'susceptible to mislead the public as to the true origin of the product', the Swiss proposal required protection against any use, which is 'likely to mislead the public'. The Swiss viewpoint was that the misleading of the public should not be limited to matters of origin. It could relate to quality characteristics as well. According to them, basically it was the goodwill linked to a GI or an 'appellation of origin' that warranted protection.[46]

Another major difference between the Draft Agreements tabled by the EC and Switzerland was that the EC proposal specifically required that, where appropriate, protection should be granted to 'appellations of origin', in particular for products of the vine, to the extent that it was provided in the country of origin. The Swiss Draft, however, did not include any such particular reference to 'products of the vine'. It clearly reveals the difference in approach between the EC and Switzerland. Although the EC proposed a somewhat all-encompassing protection for all GIs, its interest basically lay in ensuring 'absolute' protection for wines. Switzerland, on the contrary, always maintained that 'absolute' protection was required not only for wines and other agricultural products but also for other goods as well as services.[47]

The United States, however, was grossly opposed to dealing with the case of GIs as a separate IP. Rather, it wanted GIs to be protected as a part of the trademark law,[48] a proposal that was supported by Canada as well.[49] Hence, the Draft Agreement tabled by the United States[50] merely proposed that the contracting parties 'shall' protect GIs that certify regional origin by providing for their registration as certification or collective marks,[51] while the form of protection proposed to be provided for registered trademarks was nothing more than protection against consumer confusion and any act of unfair competition.[52] The EC, however, regarded such trademark protection as unsatisfactory due to its formal requirements, such as registration and the use requirement.[53] While the Unites States felt that the protection of GIs should be based on the fundamental principle of avoidance of consumer confusion, the EC was concerned about the trade problems that could arise if the only form of protection granted was that of consumers against deception.[54] In the EC's view, the use of a GI for products not originating from the source purported by the GI concerned was always a parasitical and therefore unfair act, even when no consumer deception was involved.[55]

Another alternative form of protection was proposed in the 'Draft text on Geographical Indications' tabled by Australia in June 1990.[56] This text provided for protection by requiring Parties to refuse registration or to invalidate a trademark suggesting the territory or part thereof of a Party with respect to goods not originating in that territory, when this could mislead or confuse the public, and by prohibiting the use of such an indication.[57]

Interestingly, somewhat similar provisions had already been proposed in both the EC and the Swiss drafts.[58] However, the difference lay in the fact that while Australia wanted GIs to be protected solely through refusal or invalidation of registration of such trademarks, for the EC or Switzerland, it constituted only one of a whole lot of provisions, which they had proposed for protection of GIs. Eventually, the latter approach was adopted in the TRIPS Agreement. However, while an 'unconditional' refusal or invalidation of registration of a trademark, as was proposed in the EC proposal, has been provided to trademarks associated with wines and spirits under Article 23.2 of TRIPS, for all other trademarks such actions have been made conditional on the 'misleading test', under Article 22.3, following the Swiss approach.

The EC proposal further required that appropriate measures 'shall' be taken under national law for interested parties to prevent a GI from developing into a designation of generic character as a result of the use in trade for products from a different origin, with a particular mention that appellations of origin for products of the vine shall not be susceptible to develop into generic designations. The Swiss Draft also included a similar provision, but without a particular reference to the 'products of the vine'.[59]

One of Australia's prime concerns with the texts on GIs submitted by the EC and Switzerland lay in the proposition that standards for the protection of GIs should require contracting parties to protect GIs, which had a history of traditional use in many countries (such as Australia) and, as a result of such use, had become 'generic'. Australia maintained that such indications no longer reflected a geographical region or locality; these had rather become associated with a general set of characteristics pertaining to a particular product, or alternatively were names, which, like China for porcelain, were in the common language. Australia acknowledged that there was some justification for extending the scope of protection to GIs, which had acquired a reputation in relation to certain goods, not only against misleading use, but also to prevent the degeneration of such indications into 'generic names'. However, at the same time it maintained that acquired 'prior rights' relating to an indication identical with or similar to a GI, where acquired in good faith, should be preserved by a 'grandfather clause'.[60] The Australian proposal, therefore, required that the provisions regarding protection of GIs should not apply:

- *to the prejudice of holders of rights relating to an indication identical with or similar to a GI or name and used or filed in good faith before the date of entry into force of this [amendment] [Annex] in the contracting party;*
- *with regard to goods for which the GI or name is in the common language the common name of goods in the territory of that contracting party, or is identical with a term customary in common language.*[61]

The United States' Draft also made an attempt to safeguard the interests of those who were relying on terms, which, according to the it, had long since become 'generic' in their countries.[62] Hence, the sole provision proposed by the United States geographical appellations associated with wines applied only to 'non-generic' appellations:

> *Contracting parties shall provide protection for non-generic appellations of origin for wine by prohibiting their use when such use would mislead the public as to the true geographic origin of the wine. To aid in providing this protection, contracting parties are encouraged to submit to other contracting parties evidence to show that each such appellation of origin is a country, state, province, territory, or similar political subdivision of a country equivalent to a state or county; or a viticultural area.*

It may be noted that the United States' proposal fell far short of the EC's ambition regarding protection of appellations of origin associated with wines. First, the United States proposed to make such protection conditional on the 'misleading test', instead of the 'absolute' protection proposed by the EC. Second, it proposed to protect only 'non-generic' appellations for wine.

The kind of stringent protection that has ultimately been accorded to GIs for wines and spirits under TRIPS can be regarded adequate in safeguarding against the possibility of their degeneration into 'generic names', as was demanded by the EC. However, a similar safeguard has not been provided for all other GIs, as proposed by Switzerland. The safeguard included in Article 24.4 of TRIPS, which relates to wines and spirits alone, seems to be influenced by the first exception proposed in the Australian proposal. The second exception proposed by Australia seems to have influenced the first sentence of Article 24.6 of TRIPS, while its second sentence is a specific insertion for products of the vine.

The foregoing discussion clearly reveals that the TRIPS provisions on GIs have taken shape as a combination of the proposals put forward by some of the key players from the Old World and the New, with their conflicting interests. The eventual framework reflects a very sensitive compromise in an area that was one of the most difficult to negotiate during the Uruguay Round. Notably, the 'Commission on Intellectual Property Rights' appointed by the British Government has clearly stated in its final report that the difficulty of negotiations '…stemmed from clear divisions between the main proponents of the TRIPS Agreement – the US and EU. In addition, divisions also exist among other developed countries and among developing countries. The final text of the agreement reflects these divisions and, in mandating further work (in Article 24), recognises that agreement could not be reached in a number of important areas.'[63] These provisions are basically the result of tradeoffs, which were specific to the circumstances prevailing at the time of the Uruguay Round negotiations, in particular, the Brussels Ministerial Conference (1990). This was, to some extent, due to the link at that time between the negotiations on GIs and the negotiations on agriculture.[64] Given this link, the higher level of protection for wines and spirits[65] was granted solely for the political reason of persuading the EC to join consensus on the Uruguay Round package, despite strong opposition on the part of many other countries. Notably, Commission on Intellectual Property Rights (2002) has observed that the outcome of the difficult negotiations in the field of GIs '…was that the current text of TRIPS provides a basic standard of protection, and a higher standard specifically for wines and spirits'. The Commission has clearly stated that '(t)he inclusion of this higher standard does not refer to the unique characteristics of wines and spirits, but was rather a compromise reached in negotiations'.

Importantly, Article 24 of TRIPS is also a direct consequence of difficult negotiations between a number of wine-producing participants, notably in the EC, who wished to protect indications for wines and spirits fully, i.e. without legitimizing 'past sins' for all posterity, and others (e.g. Australia, the United States) who were afraid that it might affect rights more or less considered to be acquired rights in certain appellations. The result of the negotiations was only partly satisfactory for both sides, because, while protection was granted, it was not done exactly in the way proposed by the former group. Similarly, while safeguards for 'acquired rights' were included, these were neither complete nor permanent, given the scope for further negotiations and agreements regarding these issues (under Article 24.1). In fact, the only feasible option not blocking the negotiations was to agree to further talks. In this context, Article 24.1 established the principle, clearly with a view to increasing the protection. Since safeguards were added to satisfy one group, negotiators clearly stated in Article 24.1 that (a) those safeguards (i.e. exceptions granted under Article 24.4 through Article 24.8) '…shall not be used by a Member to refuse to conduct negotiations or to conclude bilateral or multilateral agreements', but (b) that in the context of such negotiations, 'Members shall be willing to consider' the continued applicability of the safeguards for individual GIs.[66] As for the multilateral register, originally it was the EC Draft Act that proposed the establishment of an international register, presumably for all GIs.[67] However, this provision was restricted to wines only in the original legal text of TRIPS (Article 23.4). The provision was extended to spirits also in the Singapore Ministerial Declaration later in 1996.[68]

## 4. Ongoing Negotiations on GIs in the WTO

Currently there are three GI issues on the negotiating table at the WTO: (i) creation of a multilateral system of notification and registration of wines and spirits GIs; (ii) extension of the ambit of the higher level of protection currently granted only to wines and spirits to all other GIs; and (iii) the 'claw-back' proposal on a select set of GIs put forward by the EC. While the first two issues come under the purview of TRIPS, deliberations on the last one - exclusively an EC agenda – is part of the agriculture negotiation. However, for the EC, all the aforesaid three tracks are three different but closely-interlinked routes of reaching the ultimate destination of a strong GI regime at the global level. The European Commission has clearly declared that the EU has three issues of interest on GIs:

1. *A multilateral register for geographical indications (TRIPS): The EU envisages a simple, cost-effective system of world-wide registration for geographical indications so that farmers and SMEs can protect their GIs, even if they don't have deep pockets.*
2. *The extension of the additional GI protection (TRIPS): Ensuring that not only wines & spirits but also cheeses, rices and teas can enjoy the benefit of not being copied by producers from other countries by simply indicating "made in USA" or "style of Roquefort.*
3. *Ensuring market access for EU GI products (Agriculture): By asking WTO members, for a selected group of GIs, to remove prior trademarks and, if necessary, grant protection for EU GIs that were previously used or have become generic so that our GI products can gain market access.*[69]

This section dwells on in some detail on each of the three GI issues on the negotiating table at the WTO. Given the long-drawn nature of the debates and the plethora of arguments and counter-arguments that have over time been put forward by the WTO Members, a complete exposition of these debates is outside the scope of this chapter. Nevertheless, while in no way exhaustive, an attempt is being made in this section to bring to the fore some of the key contours of these debates.

## 4.1 Multilateral Register for Wines and Spirits

In order to facilitate the protection of GIs for wines, Article 23.4 of TRIPS mandates negotiations for the establishment of a multilateral system of notification and registration of GIs for wines eligible for protection in those Members participating in the system. The Singapore Ministerial Declaration of 1996 extended the scope of the provision to cover spirits as well. In the

Singapore Ministerial, Article 23.4 was also identified by the TRIPS Council as one of the built-in agenda items (i.e. unfinished business of the Uruguay Round) of the TRIPS Agreement.[70] The work began in the TRIPS Council in 1997 and was subsequently subsumed by the Doha Development Agenda. According Paragraph 18 of the Doha Ministerial Declaration (DMD), with a view to completing the work started in the TRIPS Council on the implementation of Article 23.4, Members ‘agree to negotiate the establishment of a multilateral system of notification and registration of geographical indications for wines and spirits by the Fifth Session of the Ministerial Conference’ (i.e. the Cancún Ministerial of 2003). Thus, the DMD set an earlier deadline for completing the negotiations on the register than for the rest of the Doha package. For purposes of negotiations regarding the register, an ad hoc negotiating group - the Special Session of the Council for TRIPS - was established. Legally speaking, the Special Session is distinct from the Council for TRIPS which had hitherto been dealing with all TRIPS matters and is now referred to as the ‘Regular Session’ of the Council for TRIPS.[71] The Special Session, however, was unable to meet the deadline stipulated by the DMD owing to wide-spread divergences in views. In the Hong Kong Ministerial Declaration, Ministers took note of the progress made in these negotiations and agreed to intensify them in order to complete them within the overall timeframe for the conclusion of the negotiations that were foreseen in the DMD.[72] Since then negotiations are taking place within the overall time-frame of the Doha Round.

However, even after years of negotiations, Members have not been able to reach a consensus on this contentious issue. The core issues have turned out to be the following two: (i) the consequences or legal effects, if any, of registration of a GI in the multilateral system; and (ii) nature of participation in the system (i.e. voluntary or mandatory, and if it is voluntary, to what extent the effects of registration would apply to the non-participating Members). In addition, there are various other elements including notification and registration; fees, costs, and administrative burdens, particularly as they impact on developing and least developed country Members; special and differential treatment; duration of registrations and procedures for their modification and withdrawal; and arrangements for review; among others.

### *4.1.1 Highlights of the Key Proposals*

There are mainly three key positions pertaining to this debate as contained in three formal proposals.[73] On the one end of the spectrum there is the EC – the prime proponent of the proposed multilateral register – demanding a mandatory system with strong legal effect. At the other end, there is the so-called 'joint proposal group' (Argentina, Australia, Canada, Chile, Costa Rica, Dominican Republic, Ecuador, El Salvador, Honduras, Mexico, New Zealand, Nicaragua, Paraguay, Chinese Taipei and the United States, among others), which is in favour of a voluntary system with very little legal effect. A middle-ground is put forward by Hong Kong, China, that proposes a voluntary system with some legal effects, though more limited than those espoused by the EC. While Hong Kong, China is not a producer of wines and spirits, it has made the proposal for its strong systematic interests. Its concern is that failure in this negotiating group might endanger Doha Round as a whole.[74] As for the legal form of the register, while the EC envisages inclusion of an annex to TRIPS (Article 23.4) through an amendment, the 'Joint Proposal Group' conceives it in the form of a TRIPS Council decision.

The EC proposal (ECP),[75] envisages a multilateral system for notification and registration of GIs pertaining to wines and spirits that would be applicable to all WTO Members. Each Member may 'elect' to participate in the system by notifying its GIs for registration under the system. Members choosing not to notify GIs for registration will be deemed to be 'non-participating Members'. An international administering body at the WTO level will be responsible for the notification and registration of GIs. Each participating Member shall be entitled to notify GIs that meet the definition of a GI specified in Article 22.1 of TRIPS; and is protected in its territory and has not fallen into disuse in that territory. Upon receipt, the notification shall be circulated to all WTO Members and published on the internet. Within 18 months from the date of circulation and publication, any Member may lodge a reservation with the administering body to the effect that it considers the notified GI not to be eligible for protection in its territory. Such reservation may be based on any of the following grounds and needs to be duly substantiated: (1) the notified GI does not meet the definition of a GI specified in Article 22.1; (2) the notified GI is false-homonymous, i.e. although it is literally true as to the territory, region or locality in which the goods identified by it originate, falsely represents to the public that the goods originate in the territory of the Member lodging reservation (as per Article 22.4); or (3) the notified GI is considered a generic term for a type of wine or spirit in the territory of the challenging Member, or with respect to products of the vine, the notified GI is a generic term of a grape variety existing in the territory of the challenging Member as of the date of entry into force of the WTO Agreement (as per Article 24.6 exception). While according to this proposal, the other two important Article 24 exceptions, namely Article 24.4 (on prior good-faith use) and Article 24.5 (on prior good faith trademarks or the 'grandfather' clause) cannot form the basis of a reservation, these may be invoked under domestic law of Member countries at any time (if legislation so permits). Where a reservation has been lodged in respect of a notified GI within the 18-month period, the notifying Member and the challenging Member shall, before the expiry of that period, enter into negotiations aimed at resolving the disagreement if so requested by the notifying country, in line with Article 24.1 of TRIPS. At the expiry of the 18-month period, the GI will be registered on the Multilateral Register. If there is any reservation in respect of that GI that has not been withdrawn by the challenging Member at the time of registration, the registration shall be accompanied by an annotation referring to the reservation by the particular Member. The Register shall take the form of a searchable on-line database, freely accessible to all Members and to the public. As for the legal effects of the registration, the EC proposal suggests that each participating Member which has not lodged a reservation in respect of a notified GI within the 18-month period or which has withdrawn such a reservation, shall provide the legal means for interested parties to use the registration of the GI as a 'rebuttable presumption of the eligibility for protection' of that GI in its territory. Furthermore, upon registration, neither participating nor non-participating Members shall refuse protection of the GI on any of the grounds that could have justified a reservation. Thus, where no opposition is being raised by a WTO Member in respect of a notified GI on any of the three grounds on which oppositions could be raised within the 18-month period or a reservation is being withdrawn, that Member would lose the possibility of denying protection to the GI concerned on those three grounds later; that is to say, an irrebuttable presumption would be created with respect to those three grounds.

Under the ‘Joint Proposal’ (JP), participation in the Multilateral Register would be strictly voluntary. To participate, a Member shall submit a written notification to the WTO Secretariat expressing such intention. Each Participating Member may notify a GI that identifies a wine or a spirit originating in its territory. The WTO Secretariat shall, following receipt of the notification, register the GI on the Database of GIs for Wines and Spirits (‘the Database’). The Database shall be searchable on-line, free of charge, accessible to all WTO Members and the public, and provide a means to access the original notifications. Each Participating Member may, at any time, withdraw a previously notified GI by a written notification to the WTO Secretariat to that effect. The previously-registered GI under question will thereupon be removed from the Database. A Member may also terminate, at any time, its participation in the System by making a written notification to the WTO. Upon termination of participation in the system by a Member, all GIs previously notified by that Member will be removed from the Database. In terms of the legal effect of the registration suggested by the proposal, each participating Member will ‘commit to ensure’ that its domestic legal procedures include the provision to consult the Database when making decisions regarding registration and protection of trademarks and GIs for wines and spirits in accordance with its domestic law. Non-participating Members will be encouraged, but not obliged, to make similar consultations of the Database.

The Hong Kong, China proposal (HKCP) attempts to span the divide between the aforesaid two extremes. In line with the JP, participation in the system is voluntary in the sense that Members should be free to participate and notify GIs protected in their territories. But like the EC proposal, registration creates certain legal effects that would be binding only upon Members choosing to participate in the system. An administering body will be responsible for notification and registration of GIs as per HKCP. Members wishing to participate in the system may notify the administering body of any domestic GIs for wines and spirits which are protected under their domestic legislation, judicial decisions or administrative measures. After receiving notifications from Participating Members, the administering body shall undertake formality examination of the notifications and ensure that documents submitted are in order, following which the GI will be recorded in the Register of GIs. For each GI recorded on the Register, the administering body will issue an official copy of the Certificate of Registration to the relevant Participating Member. The Register will be made available on the WTO website for access and search by the public and the administering body will distribute a copy of the Register to every Participating Member on an annual basis. As for the legal effects of registration, HKCP proposes that in any domestic courts, tribunals or administrative bodies of the Participating Members in any judicial, quasi-judicial or administrative proceedings related to the GI, registration of an indication on the Register shall be admitted as *prima facie* evidence to prove: (a) ownership of the indication; (b) that the indication satisfies the definition enshrined in Article 22.1 of TRIPS; and (c) that the indication is protected in the country of origin (i.e. Article 24.9 of TRIPS does not apply). The issues will be deemed to have been proved unless evidence to the contrary is produced by the other party to the proceedings. In effect, a 'rebuttable presumption' will be created in relation to the above three issues. Importantly, HKCP provides that any Participating Member may refuse protection of a GI in accordance with its domestic laws, if any of the grounds or exceptions under Articles 22 to 24 of TRIPS is found to be applicable by its domestic courts, tribunals or administrative bodies having regard to the relevant local circumstances. Thus, HKCP envisages legal effects of registration that would, in a way, be more limited than those suggested by the ECP, but more extensive than those in the JP. Moreover, evidently with the aim of reaching a compromise deal, HKCP suggests that the notification and registration system shall be subject to review after four years from establishment of the system. In particular, the question of scope of participation should be re-visited as part of the review.

### *4.1.2 Key Arguments on the Proposals*[76]

While a range of issues have come to the fore in the course of the deliberation at the WTO on each of the aforesaid three proposals, the following discussion briefly touches upon some of the main issues raised and views expressed by the key players.

*Participation*

The EC has argued that a voluntary register would not meet the mandate of Article 23.4, because it denies the basic principle that any multilateral instrument should, in WTO terms, have effects in all Members. A voluntary system would not add value and hence would not 'facilitate' the protection of GIs, as mandated by Article 23.4. In response, it has been argued by the supporters of a voluntary system that the words 'in those Members participating in the system' in Article 23.4 meant that the system had to be voluntary; in other words, that there could be Members 'not' participating in the system. A system with mandatory participation would go beyond the mandate of Article 23.4 and would also disturb the balance in TRIPS. The JP, they maintain, had a multilateral character as all Members would participate in the negotiations to establish the system, have access to the system once it was established, and if they so wished, have the opportunity to participate in the system. Such a system, they argue, would fully meet the mandate of Article 23.4 and of paragraph 18 of the Doha Declaration. By way of reaction, the EC has further argued that the reference to 'geographical indications eligible for protection in those Members participating in the system' in Article 23.4 meant that Members would only have to participate if they wished their indications to enjoy the benefits of the multilateral register. Members would be free to choose whether or not to benefit from the multilateral system by notifying and registering their GIs under it and, in that sense, to participate in the system. However, once a GI was included in the system, protection should be facilitated in all Members, because the system was supposed to be multilateral. The JP Group has, however, criticized this argument on grounds that it meant that non-participating Members would not be able to benefit from the system but would nevertheless be obligated to protect the terms of those countries that did participate in it. Such a mandatory system would impose onerous obligations and undue burdens on developing countries, many of which would have no economic interest in participating in such a system.

*Reservation and Bilateral Negotiations*

The reservation system and the corresponding bilateral negotiations, as suggested by the ECP, have attracted significant criticism from the opposite camp. According to the EC, since the system envisioned in the ECP should have legal effects and presumptions in all Members in order to fulfil the mandate, it also made sense to open the challenge procedures to all Members and give them the opportunity to examine the notifications made within a stipulated time period (i.e. 18 months). This would allow Members to be able to prevent certain legal effects from unfolding in their territories by raising a reservation. The EC argues that the idea of oppositions and objections was something that was well known in international registration systems for intellectual property. The JP Group, however, argues that the ECP would upset the balance of rights and obligations established under TRIPS in regard to the protection of GIs. Article 23.4 required the implementation of a two-phase system, comprised of a notification phase and a registration phase. However, the ECP provided for three additional phases, i.e. examination, reservation and bilateral negotiations, which would substantially change the existing obligations under TRIPS. In contrast, the voluntary JP system did not include any of these additional phases with a view to keep within the mandate. Under JP, both examination and opposition procedures would remain at the national level and consequently the balance of rights and obligations, as carefully negotiated in TRIPS, would not be disturbed. Moreover, the reservation system would limit Members' rights to use certain TRIPS exceptions by making them conditional on reservations and negotiations. If a Member failed to object to a notified GI within the 18-month period, it would then have waived its ability to object to that GI later and have removed the ability of its domestic producers to object to it in court proceedings later. There was nothing in TRIPS or the negotiating mandate which placed an expiry date on the rights of Members to access these exceptions, the JP Group underscores. Hence, according to them, it was an attempt on the part of the EC to renegotiate the text agreed upon in the Uruguay Round, an exercise not part of the present negotiations. Furthermore, objecting Members would have to duly substantiate the grounds for their reservations which were not a condition of using Article 24 exceptions. If a Member had placed any objections to a notification, it would then be forced into bilateral negotiations with the notifying Member. The JP group is apprehensive that these negotiations would be stacked in favour of increased protection for the notified GI given the link in the EC proposal to

Article 24.1 of TRIPS. The JP Group maintains that requiring Members' governments to pursue reservations regarding, and negotiations on, what had traditionally been private rights to be determined and enforced at the national level in each Members' individual territory would go against the well established norm, expressly recognized in the preamble of TRIPS that IPRs were private rights. Such bilateral negotiations between states dealing with what were private property rights would result in less legal certainty and transparency in national systems of protection, they argue. Furthermore, the reservation system would itself erode the principle of territoriality by forcing Members to be proactive in denying IP rights to GI right holders rather than providing the framework of minimum standards within which IPRs could be acquired in relation to their territories, in accordance with TRIPS. Members would be expected in negotiations to be open to trading away legal judgements made by their domestic courts or authorities and that such compulsory bilateral negotiations therefore constituted an attempt to bypass national legal systems. This would be inconsistent with the principle of territoriality, according to the JP Group.

The question has been raised by the JP Group as to why the reservation system proposed by the ECP differentiated between different types of exceptions granted under Article 24 of TRIPS, while the negotiating mandate appeared to provide no such basis. This, according to them, changed the balance of rights and obligations by unjustifiably creating a hierarchy between different exceptions. The EC, in response, has clarified that Article 24 exceptions would continue to apply under the EC proposal; some of them should be exercised within the 18 month reservation period, while others could be invoked at the national level at any time. It did not propose a reservation system for all exceptions, because not all exceptions were 'optional' and the nature of these exceptions themselves were different.

The reference to Article 24.1 that the ECP contains with respect to the proposed system of bilateral negotiations, has been criticized by the JP Group on the grounds that it was illegitimate since Article 24.1 defined the aim of the bilateral negotiations to be that of 'increasing the protection of the individual geographical indications' while Article 23.4 referred to 'facilitating protection'. Article 24.1 appeared under Article 24 and not under Article 23, particularly its paragraph 4. If Members had agreed in the Uruguay Round to increase the protection of individual GIs through a register of GIs for wines and spirits, both Articles 23.4 and 24.1 would have been in the same article, which was not the case, they argue. The provisions in Articles 23.4 and 24.1 could not be combined, as intended by the EC, to justify replacing the neutral way to resolve disputes under the WTO dispute settlement system with a politically oriented dispute mechanism, the JP Group maintains. In response, the EC has argued that while Articles 23.4 and 24.1 of the TRIPS Agreement were not in the same provision, Article 23.4 referred to a register that was meant to facilitate the protection of GIs. Such protection was certainly the one provided for in Articles 22, 23 and 24 of TRIPS. Since Article 24.1 was part of these three provisions, surely there would be a place for that provision within the register to facilitate its application. That was why the ECP had included a reference to Article 24.1.

*Consequences/Legal Effects of Registration*

A number of criticisms have been put forward by the JP Group on the presumptions envisaged both in ECP and HKCP. The presumptions, they maintain, would essentially create a GI right in each WTO Member without any national examination as it would allow for a notifying country to use its country of origin protection as a basis to receive protection in another country without having to comply with the statutory requirements of that country. Such a system could not be reconciled with the notion that IPRs were territorial, that rights had to be established and asserted under the laws of the country where protection was being sought, and that such rights typically had effects only within the territory of the Member that had granted them. Moreover, the effect of such presumptions would be to shift the burden of proof and thereby substantively alter the balance of rights and obligations under TRIPS. This reversal of the burden of proof would place GIs at a higher level than any other form of IPR under TRIPS. Such a reversal would force trademark owners and generic users to prove their right to continue use of their trademark or of a generic term, respectively, if a laterintime GI was notified. As a matter of public policy, it was questionable why the burden should be on users of generic terms, i.e. terms in the public domain, to justify their continued use, rather than on the IP owner seeking the monopoly. Commercially, such a limitation on Article 24.6 posed particular risks in export markets. The EC proposal would give GI right holders presumptive rights in all markets without giving other legitimate users any certainty that they would have an opportunity to rebut the presumption. For those who already had rights, this reversal put a burden on them to defend the rights they thought they already had. Shifting the burden of proof away from the right holder, where it traditionally and logically belonged,[77] would impose higher costs on those producers seeking to avoid disruption of trade.

Commenting on the ECP, in particular, the JP Group argues that the substantive legal effects included in it for the participating Members were not foreseen in the current standards of TRIPS. Under TRIPS, there were carefully negotiated relationships between trademarks and GIs, with neither of them having preference over the other. The ECP, they maintain, would upset this balance by creating a presumption that a notified term should be automatically protected in all WTO Members, whether or not it was considered a GI in those Members. The EC proposal wanted to rely on Article 24.1 of TRIPS to eradicate the generic exception under Article 24.6, which was a matter to be decided by the domestic courts of each Member according to their domestic legislation, taking into account local circumstances.

The reversal of the burden of proof would transfer directly to national governments all the country-by-country costs that currently were the responsibility of individual producers. This meant that the majority of countries, particularly developing ones, would have to assume all the costs of examining the notified GIs. The GI right holders, especially the ones from countries with greater purchasing power, would save in litigation costs because they would be able to litigate in other countries solely based on the protection given in their own territories. Producers of third countries would be the ones who would have to go to courts to defend their rights. Hence, the JP Group believes that the system proposed by the ECP would grant supranational exclusive rights to some producers who would have an additional competitive advantage over other competitors in third markets. The proposal entailed a supranational approach whereby one single action taken at international level would trigger immediate and automatic global effects regardless of any intent of the right holder to actively market a term in any particular country, thereby potentially foreclosing markets that otherwise would not be foreclosed. This system would therefore facilitate a type of 'automatic claiming' of a broad range of terms throughout the WTO membership. By contrast, the underlying general approach for existing international IPR systems was that a person filing an application in various countries had an interest in operating in those countries.

In response, the EC has argued that its proposal would not bypass national administrations because it gave Members' national authorities a reasonable period of time of 18 months to review an application and decide whether a GI could be protected in their territories. The EC further points out that the possibility of seeking global protection on the basis of the protection granted in the country of origin was not new to intellectual property systems. It was based on the TRIPS Agreement itself, which introduced the notion of country of origin. For example, trademarks registered in one country enjoyed certain priority rights in others. It was on the basis of the protection in the 'country of origin', i.e. the country of first registration, that priority rights could be obtained in other third countries if applications were lodged within a certain period of time.

Regarding the consequences of registration under the JP, its proponents have argued that a registration itself would have no impact on the legal rights and obligations of Members in terms of the status of individual GIs. However, Members choosing to participate in the system would make a commitment to 'consult' the database when making national decisions about protecting GIs. It would be up to the Member consulting the database to determine, according to the provisions of its domestic laws and registration requirements, what evidentiary weight to give to the registration of a GI included in the database when making determinations on whether or not to protect a trademark or a GI. Nationals from Members seeking protection would still be able to apply directly to national offices. There would be no legal consequences for non-participating Members, who would, however, have free access to the database. Consistent with the principle of territoriality, all decisions about GIs, including the applicability of the Article 24 exceptions, would therefore be left with national decision-makers in IP offices. Hence, neither would the JP system upset the current balance of rights and obligations of WTO Members under TRIPS, nor would it generate burdens for developing countries. However, the EC and Switzerland have argued that the obligation to consult the register, without any mechanism to ensure that such an obligation would be respected, would not be sufficient to truly 'facilitate' the protection of GIs, as mandated by Article 23.4. It would only create an illusion of facilitation, the EC argues. Switzerland maintains that a database that simply compiled national information would be merely a source of information which would not 'facilitate' the protection of GIs in other WTO Members. The objective of 'facilitation' of protection could not be achieved without providing, as the ECP and HKCP proposals did, that a registration would have as a legal effect the presumption of validity of the registered GI in all the Members that had not opposed it. This presumption should be rebuttable at any time and on any applicable ground, Switzerland argues. The EC has argued that had the drafters of Article 23.4 had the intention of simply establishing a list of GIs, they would have clearly mandated that. In contrast to provisions in TRIPS, which explicitly indicated that some notification obligations were simply for the purposes of exchanging information, Article 23.4 went beyond that and mandated the establishment of a multilateral system for the notification and registration of GIs. Multilateral systems of registration carried certain legal effects. Therefore, it still remained for Members to ensure that any proposed legal effects actually met the mandate of facilitating the protection of GIs.

In response, the JP Group has argued that the obligation to consult the GI database was a serious and meaningful new commitment that would need to be built into Members' systems and procedures, and was one that participating Members would be expected to honour. The register would be an unprecedented source of information that would 'facilitate' protection by increasing awareness of notified GIs and would provide a useful tool in helping IP offices anywhere in the world avoid possible conflicts between trademarks and GIs.

*Costs and Burden*

The questions of the range of costs and burdens that could be entailed by the ECP and the extent to which they would be covered by the fees proposed and could be handled using existing administrative arrangements have been discussed. The JP Group has expressed the view that there were grounds for concern on these counts, since the EC system would entail costs and burdens on several counts, such as, monitoring GIs notifications; examining notifications; identifying the applicable grounds for reservations and duly substantiating them; lodging reservations; entering into bilateral negotiations; monitoring trademarks and fees for trademark searches for purposes of notification of trademarks, which were normally carried out by lawyers or trademark practitioners; and costs for notifying such trademarks. In addition, there would be costs for governments to set up systems to deal with a flood of applications, including those associated with the additional human resources required and their capacity building and equipment; and costs relating to enforcement, including border controls. Members would also have the obligation to set up efficient processes for the purpose of collating the representations of their traders so as to lodge reservations within the short period of 18 months. There would also be costs associated with liaising closely with traders and businesses so as to competently negotiate bilaterally on their behalf. Many of the costs, the JP Group maintains, are hidden costs that would be borne by national administrations and would not be recoverable by fee mechanism proposed by ECP. Hence, the ECP system would be burdensome for developed and developing country Members alike. Developing countries, in particular, would face greater difficulties, for they would not be able to react appropriately to notifications under that system. The only valid alternative for developing countries, they believe, is the JP system, which would be user-friendly, accessible, simple, effective, non-costly and non-burdensome.

### *4.1.3 Recent Developments and State of Play*

*EC's 'New Thinking'*

More recently, there have been some significant developments in the negotiations that are worth a discussion in some detail. The EC, for instance, has put forward some 'new thinking' ostensibly with the aim of narrowing the gaps among different positions. In informal consultations held in November 2007 the EC shared with the participants a 'non-paper' on its 'new thinking'. While there was no formal submission on the part of the EC on its 'new thinking', it was discussed in some detail in an informal meeting of the Special Session held on 29 April 2008[78] and subsequently formed the basis of the EC's position reflected in the Chair' report on the multilateral register issued on 9 June 2008.[79] Collating the bits and pieces of this 'new thinking' from these two sources one can identify the following key divergences from the EC's original proposal (discussed above):

First, the EC has dropped the proposed system of lodging reservation within an 18-month period along with the provision for subsequent bilateral negotiations. On participation, the EC still forsees the system as mandatory: 'In accordance with paragraph 4 of Article 23 of the TRIPS Agreement, the system is multilateral, that is, applicable to all WTO Members'. However, while the 2005 proposal defined participating Members as those that would notify and register GIs in the system, the 'new thinking' contains the following criterion: 'Participating Members are Members above a certain share in world trade'. The logic underlying this new definition, however, remains unclear.

As for legal effects, the 'new thinking' proposes the following:

(i) Commitment to consult the Register when making decisions on registration and protection of trademarks and GIs in accordance with domestic law.

(ii) Rebuttable presumptions that the notified GI:
- is a GI in accordance with the definition in Article 22.1 TRIPS;
- is not a generic term (Article 24.6 TRIPS);
- does not falsely represent to the public the true origin of the goods (Article 22.4 TRIPS).

It may be noted that by removing the provision for lodging reservation within the 18-month period, the EC, in its 'new thinking' has also removed the effect of creating an irrebuttable presumption on the three grounds, as included in its 2005 proposal. Though presumptions would still be created on the three grounds, all of them would be rebuttable, at any point in time in future. It would no longer be necessary to take action in the WTO within a given time-frame, and any Member would be able to take decisions according to its own national system and at any time. Challenges could be made at any time in the country where protection was sought after the notification had been made. However, unless proven otherwise at any time and according to the legislation of each of the WTO Members, a notified GI would be considered valid. But, a notification in the register would not ensure automatic protection for it in every WTO Member. The right holder of the GI would still have to approach a country's administration where it seeks protection and register its GI as per the domestic system of that country. However, what the EC is suggesting is that contrary to the current situation in the legal systems of many WTO Members, the domestic authorities in that country (where the protection is sought ) would no longer be able to ask the GI right holder to prove, say the GI was not generic. It would be upon any third party challenging the GI on the ground of genericness in that country to prove that the GI was generic. The EC further emphasized that its proposals were forward-looking and did not aim at correcting history. The system proposed would have no retroactive effects: no names would have to be given up as a result of a deal, it clarified in the 29 April 2008 informal meeting of the Special Session.[80]

While the EC claimed that 'in order to maintain momentum the EC had over the years drastically reduced its level of ambition', the 'new thinking' did not find many takers, particularly in the JP group. It rather triggered another round of arguments and counter-arguments, as discussed briefly below.

Criticizing the 'new thinking' on several counts the JP group pointed out that the EC continued to go beyond the mandate of facilitating protection and proposed a system with mandatory participation and obligations for all Members, with a reversal of the burden of proof. As regards the legal presumptions and their implications for the principle of territoriality, the EC's 'new thinking' did not seem to be very different from their 2005 proposal to the JP Group. The main difference between the EC's 2005 proposal and the ‘new thinking’ was the removal of the cumbersome state-to-state multilateral reservations and negotiations mechanism. While some members of the JP group like Australia welcomed this reduction of excessive and inappropriate government involvement in asserting and defending GI rights under the register by no longer subjecting determinations of a GI status to political negotiations, it still argued that the reservation system was a function of the legal presumptions; hence, one could not be removed without the other; otherwise the system would in fact get worse. Whereas previously a Member could object to a notification and consequently did not have to provide the legal presumption in its law, now all participating Members would be required to implement the presumption that a foreign GI was a GI in their respective territories. While it might be possible to rebut this presumption somewhere and somehow, this remained to be elaborated, Australia argued.

Elaborating further on the implications of the legal effects, the United States argued that even under the ‘new thinking’, a notified term would be presumed to meet the TRIPS definition. Thus, it implied that one Member’s determination regarding a GI would still have a certain legal standing in the territory of other Members. Moreover, by virtue of this short circuiting or circumvention of domestic examination and procedures, the validity of any conflicting use in the receiving country would automatically and immediately be called into question, notably before the courts. These presumptions and the reversal of the burden of proof were fundamental shifts. Furthermore, as regards the exceptions under Article 24, it is believed that they were not even sacrosanct because the EC proposal put forward that a notified GI would be presumed to be non-generic, and that would be a limitation. Such a system would clearly be at odds with the most basic principles underlying the TRIPS Agreement and IPR protection more generally. It would also be unworkable in its legal framework, based on trademark law, where consumer perception played a crucial role. Under the EC proposal the act of notification would be deemed to artificially create knowledge of perceptions of consumers in the receiving Member or create a presumption that the consumers in the United States identified a particular GI with a particular good. The United States argued that the

EC was asking it to create this consumer perception by statute or regulation rather than by inferring it from actual consumers' experience. This was a radical shift in the concepts and in the legal foundations of the trademark field. It would significantly impact the operation of national trademark systems in a profound and far-reaching and quite unpredictable way. The United States felt that under the EC's revised concepts where the presumption would be rebuttable, there were still significant questions as to whether, at what cost to existing right holders, and through what procedures that presumption could be rebutted even within the United States system. Thus, it appeared that this process would unleash domestic litigation on a scale undetermined, and could be quite significant. Moreover, this extremely burdensome process would also have to be repeated in every Member's territory in which existing right holders sought to maintain those rights. That mandate provided neither for the expansion of the GI protection nor the encroachment upon other IP rights. They were not in any manner mandated through this negotiation to weaken or potentially negate other rights that were currently existing within the territories of WTO Members, the United States underscored.

Canada argued that while it was negotiating with the EC the bilateral wines and spirits agreement, the EC had provided a list of approximately 10,000 names that were supposedly wines and spirits GIs. For one, it was difficult and time-consuming for Canada to analyze each of these names and determine whether they were eligible for protection. More importantly, after analysis, only approximately 1500 names had qualified for consideration for protection, while the rest had to be eliminated either because they were not for a wine or a spirit; or they were not GIs; or they were not protected in their respective countries of origin. The EC was asking other Members to accept in good faith that anything notified to the system would constitute a wine and spirit GI unless proven otherwise. However, the point of concern based on the Canadian experience was that the notification of so many GIs with the addition of a rebuttable presumption, i.e. a reversal of the burden of proof, would create a daunting situation for users and others dealing with the proposed system, Canada pointed out.

*Run-up to the July 2008 Mini Ministerial*

In the informal meeting of the Special Session held on 29 April 2008, in which the EC's 'new thinking' came under the scanner, the EC expressed the view that on the issue of multilateral register and also extension, the potential for progress in the negotiations at the technical level had been exhausted for quite some time. Without any political guidance, discussions were going round in circles. It therefore sought guidance for two issues at the time of modalities of the Doha Round so that a legal draft of the register could be produced:  (i) the effects of the register; and (ii) which Members would be bound by these effects. While Switzerland supported this view, it was severely criticized by various Members of the JP Group who thought much more technical work still remained to be done.

The United States expressed the view that the horizontal modalities exercise should focus on Agriculture, Non-agricultural Market Access (NAMA), and Services. It feared that adding other issues would seriously undercut the Round's chances of success. The EC, however, reiterated its long-standing position on linkages between GIs and the agriculture issues in the Doha negotiations and underscored that an agreement on further agriculture liberalization and improved GIs protection had to be achieved at the same time, that is at the time of modalities.

The issue of linkages among the multilateral register and other two TRIPS issues, namely, GI extension and TRIPS/CBD, also came up in the discussion. India, for instance, urged the need for parallelism in terms of the process between GIs and TRIPS/CBD. India was of the view that the linkages among them were well-established and that all of them should be considered together for ministerial guidance. Brazil argued that consideration of these three issues in a broader context could overcome a deadlock which, if left unresolved, could become an obstacle to progress in the horizontal modalities for the core negotiations of the Round. Switzerland also recognized these linkages and stressed that time was pressing for the GI issues – register and extension–and the TRIPS/CBD issue to make real progress for an overall result in the Doha round.

In the subsequent negotiations prior to the July 2008 Mini Ministerial in Geneva, all three TRIPS issues got clubbed together more firmly. An informal 'non-paper' dated 26 May 2008 was circulated at the WTO linking the efforts of proponents of the three key IP issues and urging that they be included in upcoming talks. The text of the 'non-paper' was as follows:

> *Proponents of the TRIPS related issues under the Doha work programme (GI register, GI extension and TRIPS disclosure requirement) agree to include these issues as part of the horizontal process in order to have modality texts that reflect ministerial agreement on the key parameters for negotiating final draft legal texts with respect to each of these issues as part of the single undertaking.*[81]

The 'non-paper' was reportedly submitted by the EC and Switzerland – the key proponents of a stronger GIs regime, and Brazil and India – staunch supporters of disclosure.[82] This was indeed a significant development, because this was the first time that the proponents of both the issues joined hands to come up with a joint submission. While this strategic alliance was the outcome of some significant compromises on the part of some Members in some important respects, it meant that the 'non-paper' linking all the three TRIPS issues now had the backing of a overwhelming majority of some 110-odd WTO Members out of the total strength of 153. As far as the multilateral register was concerned, while thus far the EC proposal had some backing only from a few Members (like Switzerland), this compromise meant that the EC now managed to get the support of a vast majority of WTO Members for its agenda on the multilateral register.

Meanwhile, a small group of countries, including the United States, Canada, Chile, Korea, Australia, among others, came together to issue another 'non-paper' dated 6 June 2008 as a response to the earlier 'non-paper' by the joint demadeurs of TRIPS issues. 'We … wish to express our strong opposition to this proposal, and our conviction that it would substantially set back efforts to arrive at a viable way forward for the Doha negotiations', said the group of countries who, claimed to be 'united by a joint concern that the current delicate stage in the DDA negotiations should not be unnecessarily disrupted by efforts to rush, revisit, reinterpret or change' the 'existing negotiating mandates'. This group rejected the 'artificial parallelism' in the 26 May 'non-paper' by the proponents of TRIPS issues, arguing that each of the three TRIPs issues had its own terms of reference, and particular subject matter. 'Many technical issues remain, and the extent and interest of members in the content and potential outcomes for each issue varies considerably', they argued.

Against the backdrop of this heated debate fuelled particularly by the two 'non-papers', on 9 June 2008, the WTO released two reports on TRIPS issues: the Report by Ambassador Manzoor Ahmad of Pakistan - the Chairman of the Special Session dealing with the multilateral register;[83] and the Report by Pascal Lamy - the Director General of the WTO on the issues of GI extension and TRIPS/CBD.[84]

While the 26 May non-paper by the joint proponents of TRIPS issues was intended to be a 'draft text for inclusion' in the aforesaid two reports, the exact wording of this non-paper did not make it into either.[85] However, the DG's Report acknowledged that 'Different views have been expressed about linkages between the issues of GI extension and TRIPS/CBD and also between these issues and work elsewhere', referring to both the aforesaid non-papers. Ahmad's Report, on the other hand, declined to describe the range of views on the linkage among the three IP issues on the ground that the TRIPS/CBD and GI extension issues related to matters that went 'beyond the mandate' of the Special Session, which was limited only to issues regarding the GI registry for wines and spirits.

Ahmad's Report was basically a state-of-play kind of document that reflected various positions on the table on the GI Register. Notably, the EC's position reflected in this Report was based on its 2005 written submission as well as the 'new thinking' discussed above. On the two key issues, i.e. participation and legal effects, the Report pointed out that there continued to remain 'fundamental differences', notwithstanding some movements in the past months. The Report also mentioned that there were different views on whether the work on the multilateral register should be addressed in the context of the modalities decision.

*Draft Modality Text*

On 18 July 2008, just prior to the Mini Ministerial, the joint proponents of TRIPS issues submitted to the Trade Negotiations Committee a joint 'Draft Modalities on TRIPS Related Issues' (henceforth referred to as W/52 after the symbol of the document) that included the draft modality texts sponsored by them on each of the three IP issues.[86] The document laid out a set of substantive and procedural steps for movement towards text-based negotiations on the three IP issues, including provision for special and differential treatment. While reiterating the stand taken by the coalition in the 26 May 2008 'non-paper' regarding inclusion of all the three TRIPS issues in the horizontal modalities process, the opening para of W/52 also stated: 'The central objective of the proponents remains the adoption of a procedural decision that would open up the way for negotiations on the three issues'.

Be it the outcome of the strategic compromise reached among the sponsors of W/52 or not, the text on the multilateral register was in some respects different from the EC's 'new thinking' elaborated above. The text read as follows:

1. *Members agree to establish a register open to geographical indications for wines and spirits protected by any of the WTO Members as per TRIPS. Following receipt of a notification of a geographical indication, the WTO Secretariat shall register the notified geographical indication on the register. The elements of the notification will be agreed.*

2. *Each WTO Member shall provide that domestic authorities will consult the Register and take its information into account when making decisions regarding registration and protection of trademarks and geographical indications in accordance with its domestic procedures. In the framework of these procedures, and in the absence of proof to the contrary in the course of these, the Register shall be considered as a prima facie evidence that, in*

*that Member, the registered geographical indication meets the definition of "geographical indication" laid down in TRIPS Article 22.1. In the framework of these procedures, domestic authorities shall consider assertions on the genericness exception laid down in TRIPS Article 24.6 only if these are substantiated.*

3. *Text based negotiations shall be intensified, in Special Sessions of the TRIPS Council and as an integral part of the Single Undertaking, to amend the TRIPS Agreement in order to establish the Register accordingly.*

Notably, unlike in the 'new thinking' by the EC, the modalities text does not make any reference to the term 'participating member' separately. However, the reference to 'Each WTO Member' in the second para clearly reflects the EC's continued support for a mandatory system that would be binding upon all Members. It may also be noted that instead of using the term 'rebuttable presumption' used in the EC's 'new thinking', the modalities text uses the term '*prima facie* evidence'. However, a close look at the text seems to reveal that effectively there is not much difference. For one, though put in a different language, the text basically suggests that registration would create a presumption in all WTO Members that the registered GI satisfies the definition of GI as enshrined in Article 22.1. However, any WTO Member may any time rebut this presumption provided it has got 'proof to the contrary'. As regards genericness, the text suggests that domestic authorities would be required to 'consider' an assertion in this regard, 'only if' such an assertion is substantiated, clearly by those who would make such assertion. In other words, it implies that unless any such assertion is put forward by some interested party, WTO Members would be obliged to presume that the registered term is not generic, which in effect would create a rebuttable presumption about genericness in all Members. Importantly, even as per the modality text, the burden of proof would continue to remain on the interested parties who might oppose the GI on certain grounds and not on the right holders of the GI. This would hold true for any exception enshrined in Article 24 of TRIPS and not only for genericness. The only significant difference in the modality text compared to the earlier proposals of the EC is that it has dropped from the proposed legal effects the provision pertaining to homonymy. This is a step that the EC has claimed to be part of an overall compromise on its part.

### *TRIPS Issues in the Collapsed Mini-Ministerial*

Notwithstanding the support of the vast majority of the WTO Membership for inclusion of all the three TRIPS issues in the horizontal modalities exercise, the opposite camp, including Australia, Chile, Costa Rica, Mexico, New Zealand and the United States, among others, kept on insisting that none of the IP issues should be discussed in the Mini Ministerial. When the Mini Ministerial was finally underway in Geneva, beginning on 21 July 2008, the focus of deliberations was squarely on the two core areas, namely agriculture and NAMA, with even services taking a rather back-seat. While the three IP issues were discussed by the IP negotiators, the discussions were mostly limited to 'process' matters only. In fact these issues never got a chance to rise to the level of full negotiations at the ministerial level during the meeting that lasted for nine days.[87] Finally, in a major blow to the chances of a possible conclusion of the Doha Round by the end of 2008, the Ministerial collapsed on 29 July, purportedly owing to the discordance among some of the key players on the issue of special safeguard mechanism (SSM) in agriculture, among a few other issues.

### *Since Then*

When Doha talks resumed in September 2008, *albeit* slowly, the 110-odd co-sponsors of W/52 continued with their efforts to keep their strategic coalition alive. Members like the EC, India, Switzerland, Turkey, Brazil, among others extended their support for continuation of discussions on the TRIPS issues. Meanwhile, Ambassador Trevor Clarke of Barbados joined as the new chair of the Special Session of TRIPS Council dealing with the multilateral register, as the former chair Ambassador Manzoor Ahmad of Pakistan returned to his capital. In the 29 October 2008 meeting of the Special Session that confirmed Ambassador Clarke as the new chair, talks turned into a lengthy discussion over whether the mandated negotiations on the register could progress without simultaneous movement on two other IP issues. The co-sponsors of W/52 continued to support parallelism among the three IP issues in this meeting. While Ambassador Clarke expressed the view that discussion on the other two IP issues would have to be pursued elsewhere, as the mandate of the special session currently was limited only to handle the GI register, the EC voiced strong reservation about this approach. The EC argued that the GI register was linked to the other two IP issues, which must be dealt with together. The proposal in W/52 represents a relaxing of some of the more strict protection measures the EC had originally been seeking with the GI register. But these compromises are an inextricable part of a three-pillar plan, the EC maintained and hence the other two pillars - GI extension and TRIPS/CBD - must also be discussed.[88] Countries like Chile and Argentina, however, questioned the parallelism, and noted that there was no mandate for extension and TRIPS/CBD. The United States voiced the opinion that there was broad agreement on intensifying work in the special session, but was firm that the mandate of the group does not include issues beyond the register.[89] The opponents also met with the Director General in order to reinforce the view that the three TRIPS issues have different merits and mandates and it is not appropriate to deal with them together. [90]

In a meeting of the Special Session held on 4 December 2008 in which the substantive issues of the GI register proposal contained in W/52 came up for a discussion for the first time, the Joint Proposal (JP) group submitted a list of 61 ‘initial questions’ seeking clarification on the proposal. Singapore also submitted a separate list of five questions for clarification, in its capacity as a non-wine producing Member.[91] At an informal meeting on 4 and 5 December 2008, as well as at the formal meeting on 5 March 2009, there were intensive discussions on the aforesaid sets of questions as the EC provided its responses.

In 2009 there were altogether four formal meetings and several informal consultations, including open-ended meetings, *albeit* without any significant progress. At the fag end of the year, the Chair of the Special Session Ambassador Trevor Clarke moved to become an assistant director general at the World Intellectual Property Organization. In his parting informal meeting on 20 November 2009 Ambassador Clarke submitted a report[92] on his own responsibility on the progress of the negotiations on the register during his tenure as the chair of the Special Session. The report further provided certain suggestions for the future course of actions.

In order to move from a repetition of positions and proposals to a discussion on the substantive issues and negotiations, Ambassador Clarke suggested that delegations focus on the following four questions that he posed on his own responsibility:

(i) What legal obligations would be acceptable for the Register to facilitate the protection of geographical indications for wines and spirits, as mandated by Article 23.4 of the TRIPS Agreement?

(ii) When making decisions regarding the registration and protection of trademarks and geographical indications, what significance and weight should national authorities give to the information on the Register?

(iii) Are there any options regarding participation, other than voluntary and mandatory participation? If so, what criteria could be envisaged?

(iv) What form could special and differential treatment take with regard to the Register?

Ambassador Clarke further proposed that the future work be guided by the following five principles (Box 1 for further details):

(i) The purpose of the Register is to facilitate, not to increase, the protection of GIs for wines and spirits.

(ii) The Register should be useful and meaningful to both notifying Members and consulting Members.

(iii) The territorial nature of intellectual property rights should be preserved.

(iv) The Register should not impose undue financial and administrative burdens on Members.

(v) Special and differential treatment should be precise, effective and operational.

In an informal meeting of the Special Session held on 5 February 2010[93] WTO Members decided to focus on 'practical' issues instead of 'rhetorical' debates and also accepted the five 'guiding principles' put forward by Ambassador Clarke. It remains to be seen whether the 'practical' approach coupled with the 'guiding principles' help Members reaching a breakthrough on this long-drawn debate some time in the near future!

### BOX 1: Guiding Principles for Future Work Suggested by Ambassador Trevor Clarke

**(i) The purpose of the Register is to facilitate, not to increase, the protection of GIs for wines and spirits.**

The establishment of the Register is intended to facilitate, rather than to increase, the level of substantive protection, which exists under the TRIPS Agreement. At the same time, it seems reasonable to expect that "facilitation" would make obtaining such protection easier. It is also clear that the Register is intended to facilitate protection of wine and spirit GIs, not only the examination process. In my view, Members' negotiations should focus on the crucial question of what are acceptable means of facilitating achievement of the existing level of protection, while ensuring that the substantive level of protection remains the same.

**(ii) The Register should be useful and meaningful to both notifying Members and consulting Members.**

The Register should be an accurate, reliable and authentic source of information. The primary responsibility for providing such information to the Register should rest with the notifying Member. It should also be explored how the nature and quality of the information on the system may influence the manner in which Members may take this information into account in their domestic legal systems.

**(iii) The territorial nature of intellectual property rights should be preserved.**

The territorial nature of intellectual property rights embodies the accepted view that intellectual property rights are valid only in the territory for which they have been established or granted. While this concept is not questioned by Members in these negotiations, the question is whether and under what circumstances Country A is prepared to give recognition to a protected GI from Country B, or recognize the facts that gave rise to such protection in Country B. Such recognition of legal or factual elements from another jurisdiction is practised under various international agreements and is the consequence of a sovereign decision by countries to do so.

**(iv) The Register should not impose undue financial and administrative burdens on Members.**

With respect to financial and administrative burdens, Members seem to accept that *some* financial and administrative burden may be necessary to fulfil the mandate, but that it should as much as possible be proportionate to the use and benefits of the Register.

**(v) Special and differential treatment should be precise, effective and operational.**

Special and differential treatment should be provided through precise and effective provisions targeting developing and least-developed countries, including those that wish to benefit from participating in the system.

***Source*****:** WTO document TN/IP/19 of 25 November 2009.

## 4.2 Extension of Article 23 Protection to All GIs

As discussed earlier, TRIPS stipulates a hierarchical system of protection in which a basic protection is granted for all GIs under Article 22 whereas an additional protection is afforded to GIs designating wines and spirits under Article 23. The proponents of extension (such as, Bulgaria, China, the Czech Republic, the EC, Hungary, India, Kenya, Liechtenstein, Mauritius, Nigeria, Pakistan, the Slovak Republic, Slovenia, Sri Lanka, Switzerland, Thailand, Turkey, among others) are demanding an extension of the ambit of Article 23 to cover all GIs irrespective of product categories. The opponent camp (comprising Argentina, Australia, Canada, Chile, Guatemala, New Zealand, the United States, Uruguay, among others) is, however, trying to resist the proposed extension by all means.

The issue of 'extension' was a part of the discussions in Doha Ministerial held in November 2001. In particular, paragraph 18 of the Doha Ministerial Declaration (DMD) notes that the '…issues related to the extension of the protection of 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'. Notably, Paragraph 12 of the DMD declares that the negotiations on 'outstanding implementation issues' shall be an integral part of the Doha Work Programme. It further states that (a) those implementation issues, on which the DMD provides a specific negotiating mandate, shall be addressed under that mandate, whereas, (b) the other outstanding implementation issues shall be addressed as a matter of priority by the relevant WTO bodies, which shall report to the Trade Negotiations Committee (TNC) by the end of 2002 for appropriate action. Members have different views on the interpretation of this paragraph with regard to the issue of 'extension': proponents of extension argue that there is a clear mandate to launch negotiations while opponents claim that there is no mandate in the DMD to negotiate any extension.

Paragraph 39 of the Hong Kong Ministerial Declaration (HKMD) requested the WTO Director General to intensify his consultative process on the issue of 'extension'. It further stipulated that the General Council should review progress and take any appropriate action no later than 31

July 2006. For the past several years, discussions on the issue of extension are going on pursuant to the mandate relating to outstanding implementation issues in paragraph 39 of HKMD.

The following discussion focuses on the extension debate that has turned out to be a contentious issue in the ongoing negotiations in the WTO. Putting the nuances of this debate in perspective, however, requires a close look at the implications of the two-tiered system of protection stipulated by TRIPS. An attempt is being made in that direction below.

### *4.2.1 Implications of the Hierarchical Protection*

Article 22 of TRIPS merely stipulates the general standards of protection that must be made available by the WTO Members for all GIs against unfair and misleading business practices. However, there are certain genuine lacunae ingrained in the general protection enshrined in this article that may often make GIs, other than those pertaining to wines and spirits, susceptible to misappropriation, as elaborated below.

In the first place, it may be recalled that in order to be successful in a law suit pertaining to a passing-off action or an action relating to unfair competition against an allegedly unauthorized use of a GI, the plaintiff (i.e. the right holders of the GI concerned) must show, *inter alia*, that the use of the GI by an unauthorized party is misleading and, as the case may be, that damages or a likelihood of damages result from such use. This can only be done by demonstrating that the GI in question has acquired distinctiveness or, in other words, the relevant public associates the good sold under that GI with a distinct geographical origin and/or certain qualities. Moreover, since lawsuits based on passing-off actions or unfair competition are only effective between the parties of the proceedings, the distinctiveness of a given GI must be shown every time the GI is to be enforced.[94]

Furthermore, a right holder of a GI may find it difficult to pass the ‘misleading test’ if the good allegedly misusing the GI contains information about its true geographical origin on its label. For instance, a producer not belonging to Switzerland may use the GI ‘Swiss-made’ prominently on the face of a watch, and engrave the true origin somewhere on the back of it in a rather illegible manner. While doing so may actually allow the producer to free-ride on the renown of a famous GI, chances are there that s/he can get away from any legal action against such an unscrupulous business practice by claiming that such an use is not misleading the consumer, since the true place of origin is mentioned on the back of the watch.

The requirement of the 'misleading test' also leads to legal uncertainty regarding the protection and enforcement of a GI at the international level. This is because it is up to the national courts and national administrative authorities to decide whether the public is being misled by a particular misuse of a GI. Since, such decisions are bound to differ from one country to another, the very provision of the 'misleading test' leaves room for legal uncertainty.[95]

Article 23, however, ensures that GIs associated with wines/spirits are afforded an additional protective shield against misuse by the same category of products, i.e. wines/spirits, respectively (but not in cases where they are misused by other categories of products, such as cheese or coffee). The protection of Article 23 is an extra weapon in the hands of the right holders of GIs identifying wines and spirits, complementing the basic protection they enjoy under Article 22 (like all other categories of GIs). The ambit of the higher level of protection of Article 23 covers those cases where a GI associated with a wine/spirit is wrongfully used on wines/spirits not originating from the place identified by it. In addition, the general protection of Article 22 applies to those cases where a GI associated with a wine/spirit is misused on goods other than wine/spirit, respectively. This would be the case if, for instance, the French GI 'Champagne', identifying sparkling wine produced in the Champagne region of France, were used on say, grape juice produced in California. Since GIs identify designations with respect to a specific product category, the misuse is likely to be more attractive in the case of the same category of product compared to that on other categories of products. Hence, misuse of a GI by competitors producing the same category of product is more commonly observed and results in the greatest financial losses for the genuine right holders. It is in these more common and pertinent cases that the additional protection of Article 23 ensures an effective protection for GIs identifying wines and spirits, than that provided under Article 22 of TRIPS.[96]

First, the additional protection in the case of GIs for wines and spirits implies that they need to be protected by WTO Members irrespective of whether the consumers are misled or whether the use of such indications constitutes an act of unfair competition. Moreover, the use of accompanying expressions such as 'style, 'type', 'kind', 'imitation' or the like in connection with wines and spirits is prohibited under Article 23.1. Protection is also provided against the use of indications in translated forms. No such protection is available for GIs associated with other categories of goods, which do not come under the ambit of Article 23. Producers not belonging to the geographical region indicated by a GI associated with wines/spirits are also not allowed to use these indications in or as their trade marks (Article 23.2). In contrast, the refusal or invalidation of registration of a trade mark for any other goods (than wines and spirits), on similar grounds, is conditional on the 'misleading test' (Article 22.3).

If Article 23 were amended to include all other GIs, it would prevent any tea company belonging to, say, Kenya from marketing its tea as 'Darjeeling tea, produce of Kenya'; or 'Kenyan Darjeeling tea'; or 'Darjeeling type tea', with the true origin of the product indicated elsewhere on the label. However, since Article 22 does not provide this kind of protection, India may find it difficult to prevent any such misuse of the reputation and goodwill associated with its renowned GI 'Darjeeling' in the international arena. The allowance of such use, however, puts the GIs at risk of becoming 'generic names' over time.

It is the aforesaid lacunae of the current TRIPS framework that the demandeurs of extension are seeking to rectify through an amendment of the agreement. The extension, if granted, would mean that: (a) the protection of Article 23 would apply, irrespective of the goods concerned, if a GI identifying a specific category of good is wrongfully used on the same category of good, whereas (b) the protection of Article 22 would apply in cases when the GI concerned is wrongfully used on a different category of good.[97]

### *4.2.2 Key Arguments for and against 'Extension'*[98]

The demandeurs of extension question the basis of the existing differential treatment to GIs identifying goods other than wines and spirits and point out the inadequacy of protection under Article 22. They argue that the requirement of the 'misleading test' in Article 22 is tailored to suit unfair competition or consumer protection regulations, but not IP protection. Article 22, they say, allows competitors, not belonging to the geographical region purported by a GI, to easily 'usurp' a GI and free-ride on its reputation without leaving any scope for the legitimate right holders to prevent such misappropriation, as long as the true origin of the product is mentioned. Furthermore, in lieu of such illegitimate use, these GIs run the risk of becoming generic terms over time, thereby losing all their economic potential and value.[99] In contrast, Article 23 provides protection against the use of a GI with a '*délocalisant*' indicating the true origin and against use in translation or with expressions such as 'kind', 'type', 'style', 'imitation' or the like.[100] These provisions (under Article 23) not only prevent free riding but also provide an adequate protective shield against the risk of GIs becoming generic terms.

In response, the opponents argue that the perceived insufficiency of protection afforded under Article 22 is largely due to the failure of WTO Members to implement fully and appropriately its existing obligations. The ability of many Members to make use of the existing provisions of TRIPS is often constrained by their failure to protect their respective GIs domestically.[101]Article 22 protection, they maintain, is sufficient to ensure that GIs do not become generic. They are not convinced that there are chances of GIs becoming generic under a regime that fully implements the existing provisions of TRIPS. Moreover, the opponents claim that the proponents have not demonstrated adequately why such protection is insufficient. They suggest that the TRIPS Council should be provided with concrete examples of the problems Members have had, or are currently encountering, in obtaining satisfactory protection under Article 22.[102]

The opponents are apprehensive of the possible impacts of extension on producers who do not belong to the geographical region designated by a

GI, but have been using the GI concerned. Such producers, they argue, might face considerable adjustment and other costs and burdens, including the marketing costs associated with developing substitute terms; changing current packaging and labelling; generating consumer awareness, among others. The relabelling and marketing process, the opponents apprehend, would be complicated, because in many cases, producers would have to try and market what would appear to be 'new' products (which previously had different names), but without the benefits of those products actually having any new characteristics.[103] These costs, the opponents feel, should not be underestimated, particularly when there is a need to launch a marketing campaign in an overseas market.[104]

Opponents further argue that re-labelling of goods as a result of extension would lead to consumer confusion, as consumers would no longer be able to recognise the products that they were used to purchasing. Moreover, extension would lead to a smaller number of producers making a particular product. As the supply of the named products would fall, prices would rise. Moreover, the increase in the costs to the industry to rename, relabel, and repackage would be passed on to the consumers resulting in higher priced goods.[105] Hence, extension would leave consumers worse-off, they apprehend.

The proponents, however, are of the view that such re-labelling would not be necessary because the exceptions contained in Article 24 would apply *mutatis mutandis* to the extended protection under Article 23.[106] The extension proposal was designed only for future effects and would not affect the existing uses of terms that coincided with protected GIs, as long as they were in conformity with the exceptions included under Article 24 of TRIPS.[107] If, however, such prior use had taken place in 'bad faith', with the intention to free ride on the reputation of a GI, then Article 24 exceptions would not apply. In such cases, the demandeurs of extension feel that the obligation to re-label a specific product seemed an appropriate consequence. Moreover, the long-term economic benefits of extension would, in any case, outweigh the costs of a few cases where re-labelling might be necessary, according to them.[108]

As regards the concern that extension of Article 23 protection would lead to consumer confusion, the proponents believe that it is not possible to understand how consumers could be confused if it had been agreed that only a product that had originated in a given geographic territory could bear a term identifying it as originating from a territory where a given quality, reputation and other characteristic of the good was essentially attributable to its geographical origin.[109]

The demandeurs accept that extension could indeed result in higher prices for the products bearing GIs, which would ultimately be paid by consumers. However, they argue that consumers would not necessarily have to pay those higher prices, unlike the case of patents or copyrights, because they would be free to decide whether to buy a good with a specific GI indicating specific characteristics and qualities or to buy another good belonging to the same category but without those specific qualities/characteristics. The prices of such goods (without the GI) could even fall as a result of extension.[110]

The proponents feel that unlike Article 22, which led to legal uncertainty, protection under Article 23, by providing greater clarity and legal certainty as to the situations in which use of a GI was lawful or not, would ensure that the legitimate users of GIs do not have to undergo costly procedures to demonstrate that the consumer was confused, involving expensive, and often inconclusive, opinion polls. The test under Article 23 was more objective and judicial decisions would be more uniform and harmonious as the final decision would not be left to the judge's appreciation on whether the public was actually misled.[111] The proponents argue that offering small producers and associations the less-costly and legally-secure protection of Article 23 would give them a better way to prevent the abusive use of their GIs in a foreign country than going through the difficult and burdensome procedure of 'misleading test', or the requirement to prove that there was an act of unfair competition.[112] It is further argued that basing investment and export decisions on potentially contradictory and changing judicial interpretations was a risk that producers of GI products, especially those from the developing countries could not afford. The improved legal security at the multilateral level (under Article 23) would encourage producers to use GIs as an efficient marketing tool. It would constitute an incentive for producers to market their goods internationally, thus promoting international trade.[113] Thus, the benefits resulting from extension would also foster the development of local rural communities.[114]

The opponents, however, are of the view that extension would not obviate the need for producers to take action to enforce their rights and bear the associated costs. Thus, the extent to which producers would actually benefit from a higher level of protection would also depend on how far producers would be willing and able to enforce their rights.[115] Extension, they argue, could not in itself make GIs for quality products a valuable marketing tool. It was the hard work of establishing a quality product and promoting that product in the marketplace that would turn a GI from simply a place name into a valuable marketing tool.[116]

The opponents further argue that 'extension' could create an additional dichotomy between the benefits that WTO Members with many GIs would receive and the costs to be borne by Members with only a few GIs,[117] for, the latter group might be obligated to protect hundreds or thousands of GIs from other Members. The demandeurs, in turn, argue that there is no evidence of this alleged 'imbalance in numbers'. Rather, there was evidence to the contrary. For instance, since 1996, Brazil, which had already applied extension domestically, had registered or received applications for only five GIs from the EC. Paraguay, another country applying 'extension' domestically, received none. In neither country had there been any GI-related litigation. The 'imbalance in numbers' argument, according to the proponents, did not recognise the fundamental principle that GI protection within the TRIPS Agreement was an 'on-demand' protection, i.e. right holders had to invoke such protection in third country courts. Right holders only went to a third country to benefit from that protection when they had the export capacity to make the investment worthwhile, and when they had an interest. Moreover, the issue of 'imbalance in numbers' was not relevant when assessing the economic benefits of an 'extended' GI protection and resulting market opportunities. What were important were the existing and potential trade flows emanating from each individual GI, the value of which varied greatly. A single GI like ‘Basmati’ (rice), which generated some US $300 million in exports, for example, could be far more important than many GIs which were not used for export. The proponents further argue that if it were felt that ‘imbalance in numbers’ was an issue, this would suggest radical solutions when it came to trademarks or patents. For example, the USPTO (United States Patents and Trademark Office) had registered more than 2.5 million trademarks, yet no one had claimed that, because the United States was the biggest beneficiary of trademark protection, that section of the TRIPS Agreement should be abolished.[118]

Another argument put forward by the opponents, on grounds of preservation of cultural identity, is that, considering that a number of Members had received many immigrants who had brought with them their cultural traditions, including names and terms, it would be culturally insensitive for Members, predominantly those from which these people had migrated, to try to reclaim terms that had been used for decades without being contested.[119] Immigrants’ customs were acquired rights, which Members could not wipe out in the course of negotiations.[120] In response, it is argued by the proponents that the continued availability of all the exceptions under Article 24, including the ‘grandfather clause’, would adequately take care of this important non-trade concern. According to them, Article 23.3 on ‘homonymous’ GIs provided additional proof that extension was not contrary to the preservation of cultural diversity.[121] It is argued by the proponents that the GIs designating goods, such as tea, coffee, rice, banana, carpet and handicrafts and the associated cultural heritage in their own countries were also at stake and that was something they sought to protect through extension.[122]

Regarding the extent to which extension would require new or modified legislation and institutions, the proponents feel that since all Members were already obligated to provide protection to GIs according to Articles 22 and 23, extension would imply only minimum administrative changes. These might be limited to a modification of legislative provisions so that the protection of GIs for wines and spirits could be extended to GIs for all other products.[123] Therefore, the implementation of protection envisaged in Article 23 for all GIs would not necessarily require the establishment of a completely new protection system,[124]nor would it entail disproportionate costs and administrative burdens.[125]

The opponents, however, maintain that extension would require more complicated implementation than in the case of Article 22. Because, countries would have to institute a system that protected a wide variety of products, necessitating change in the fundamental concepts in their laws. For instance, amending the trademark and unfair competition laws to provide Article 23-level of protection for all GIs would be to stand those laws on their heads.[126]This would necessitate a substantial overhaul of the entire trademark and unfair competition regime, a cost that must be acknowledged.[127]

The proponents also base their argument on the provision included in Article 24.1 of TRIPS, which requires Members to enter into negotiations aimed at increasing the protection of individual GIs under Article 23. This provision had been identified by the Singapore Ministerial Declaration (1996) as one of the built-in agenda items.[128] However, the interpretation of this provision is a highly debated issue. The opponents of extension maintain that the built-in mandate under Article 24.1 should 'only' cover an increase or extension of the protection of GIs for wines and spirits and nothing else. The advocates of extension, however, argue that this provision basically mandates negotiations to extend the additional protection of Article 23 to goods other than wines and spirits. They are of the view that in order to address all issues left for further clarification and improvement by the Uruguay Round compromise, the negotiations required by the built-in agenda of Article 24.1 should include not only the question of additional protection for GIs for wines and spirits and/or of mitigating the exceptions to protection contained in paragraphs 4 to 8 of Article 24, but should also deal with the issue of increasing the protection of individual GIs to products other than wines and spirits.[129]

### *4.2.3 Recent Developments and State of Play*

For the past several years, discussions on the issue of extension as well as on the relationship between the TRIPS and the Convention on Biological

Diversity (commonly referred to as the TRIPS/CBD issue) are going on pursuant to the mandate relating to outstanding implementation issues in paragraph 39 of HKMD. Proponents of each of these issues call for amending TRIPS for addressing their respective concerns.

TRIPS/CBD has traditionally been a North-South issue under TRIPS. Developing countries, like India, Brazil, China, Peru, among others, have argued that while the patent regime introduced by TRIPS affords protection to technologies that have been developed using biological material, the rights of countries providing the material, as recognized by the CBD, are completely ignored. Notably, it is the countries of the South that are endowed with the lion's share of the biological materials and the associated traditional knowledge (TK). With a view to rectifying the aforesaid lacunae of TRIPS and ensuring implementation of both TRIPS and CBD in a mutually supportive manner, developing countries have been insisting on an amendment of TRIPS for the past several years. The original proposal[130] called for an amendment establishing an obligation for WTO Members to require patent applicants to meet the following conditions: (i) disclose the origin of biological resources and/or associated TK; (ii) provide evidence of PIC; and (iii) provide evidence of benefit sharing. The proposal further suggested that in cases where insufficient, wrongful or lack of disclosure would be discovered after the grant of a patent, the legal regime would include provisions for revocation of the patent in question.[131]

In December 2007, the proponents of GI-extension and TRIPS/CBD explicitly linked these two IP issues and put forward new papers calling for both these issues to be made part of the 'single undertaking' of the Doha Round.[132] The proponents of these two issues got together to make a submission on 15 February 2008[133] on extension that included the following text intended to be included in the horizontal modalities decision of the Doha Round:

Members agree to the extension of the protection of Article 23 of the TRIPS Agreement to geographical indications of all products. Negotiations shall be undertaken, in Special Sessions of the TRIPS Council and as 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 of all products as well as to apply the exceptions provided in Article 24 of the TRIPS Agreement *mutatis mutandis.*

As discussed earlier, these two IP issues subsequently got clubbed together with the issue of multilateral register as a result of a strategic coalition among the proponents of these three issues that came up with a 'non-paper' dated 26 May 2008 demanding all the three issues to be made part of the horizontal modalities of the Doha Round. This was followed by another 'non-paper' dated 6 June 2008, issued by a small group of WTO Members including the United States, Canada, Chile, Korea, Australia, among others, which opposed the linking of all three TRIPS issues and their inclusion in the horizontal modalities exercise. The Report by the Director General released on 19 June 2008,[134] which was basically a state-of-play kind of document, acknowledged that 'Different views have been expressed about linkages between the issues of GI extension and TRIPS/CBD and also between these issues and work elsewhere', referring to both the aforesaid non-papers. On the issue of extension, the Report stated that:

> *The work continues to be characterized by different views on both the merits of GI extension and on whether it was agreed at Doha that this is part of the negotiations and of the Single Undertaking. There are also different views on whether this matter should be addressed in the context of the modalities decision.*

The Report further mentioned that on the one hand, there were a number of Members who supported GI extension and who wanted clear guidance on this question as part of the modalities decision, while on the other there were others who were opposed to negotiations on extension, who believed that

> *...the case has not been made for such extension and that even basic objectives are far apart. In their view, the issue of GI extension should not be addressed in the context of the modalities decision and the suggested draft modalities text*

*presented by the demandeurs would prejudge an outcome. Some of these Members are willing to continue fact-based discussions under the present process of work as agreed in paragraph 39 of the Hong Kong Ministerial Declaration but without prejudice to the outcome and the positions of Members and provided that there is a readiness to engage meaningfully on technical matters.*

On 18 July 2008, just prior to the Mini Ministerial, the joint proponents of TRIPS issues submitted to the Trade Negotiations Committee a joint 'Draft Modalities on TRIPS Related Issues' (W/52) that included the draft modality text sponsored by them on each of the three IP issues.[135] The modality text on extension comprised the following two paragraphs:

- *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.*
- *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.*

In the July 2008 Mini Ministerial in Geneva that ended up in a collapse, the focus was squarely on agriculture and NAMA and the IP issues never got a chance to rise to the level of full negotiations at the ministerial level.

Since the resumption of talks in September 2008 efforts continued on the part of the 110-odd co-sponsors of W/52 to keep their strategic coalition alive. They continued to call for parallelism among the three IP issues and the importance of including all of them in the horizontal modalities process. A group, including China, Ecuador, the EC, India, Switzerland and Thailand, on behalf of the W/52 alliance, called on the Director General Lamy in November 2008 to stress the importance to them of the two issues, namely GI-extension and TRIPS/CBD, and to request a process involving dedicated consultations on the issues.[136] Such efforts, however, continued to face steadfast opposition from the opposite camp, which includes Australia, Canada, Chile, New Zealand, and the United States, among others. The latter group still maintains that to negotiate on GI-extension or TRIPS/CBD a significant change in mandate would be required in an already delicate Doha round. This group called on Lamy to reinforce the view that the three TRIPS issues have different merits and mandates and it was not appropriate to deal with them together.[137]

While the issue of multilateral register saw at least some movements over the recent past, uncertain future continues to loom large over the issue of extension. While the co-sponsors of W/52 continue to insist that the negotiations on the GI register are to be seen as part of a framework including all three IP issues,[138] among them extension still remains the most difficult to crack even after so many years of sustained efforts on the part of its proponents.

### 4.3 'Claw-back' Proposal of the European Communities

Prior to the 2003 Cancun Ministerial Conference, the EC submitted to the WTO a list of 41 geographical terms of European origin[139] that have long been used by countries of the 'New World'. The EC proposal aimed at recouping exclusivity for its producers for these terms. According to the EC, the names contained in the list were included in the EU's register of GIs and had been selected on the basis of the fact that, in many third countries, they were claimed to be generic terms and/or had been registered as trademarks by local producers. In preparing this list the EC focused its attention on those third countries where these kinds of abuses had been most frequently observed and which were also the most important markets for these products.[140] This proposal is widely referred to as the 'claw back' proposal because it represents a move to make many terms that are in widespread use internationally, exclusive.[141] If accepted, the proposal would require WTO Members to remove prior conflicting trademarks and to grant protection to EU GIs that have become generic. Such obligations would effectively erase the exceptions available under Article 24 TRIPS (paragraphs 4, 5, and 6).

The list contained the following 22 names pertaining to wines and spirits: (1) Beaujolais; (2) Bordeaux; (3) Bourgogne; (4) Chablis; (5) Champagne; (6) Chianti; (7) Cognac; (8) Grappa di Barolo, del Piemonte, di Lombardia, del Trentino, del Friuli, del Veneto, dell'Alto Adige; (9) Graves; (10) Liebfrau(en)milch; (11) Malaga; (12) Marsala; (13) Madeira; (14) Médoc; (15) Moselle; (16) Ouzo; (17) Porto; (18) Rhin; (19) Rioja; (20) Saint-Emilion; (21) Sauternes; and (22) Jerez, Xerez.

Nineteen names relating to other products in the list were: (1) Asiago; (2) Azafrán de la Mancha; (3) Comté; (4) Feta; (5) Fontina; (6) Gorgonzola; (7) Grana Padano; (8) Jijona y Turrón de Alicante; (9) Manchego; (10) Mortadella Bologna; (11) Mozzarella di Bufala Campana; (12) Parmigiano Reggiano; (13) Pecorino Romano; (14) Prosciutto di Parma; (15) Prosciutto di San Daniele; (16) Prosciutto Toscano; (17) Queijo São Jorge; (18) Reblochon; and (19) Roquefort.

The protection proposed also covered translations, such as 'Burgundy', 'Champaña', 'Coñac', 'Port', 'Sherry', 'Parmesan/o', 'Parma ham', etc. Transliterations in other alphabets, such as 'ÊÎÍÜßÊ' for Cognac, are also covered.

Interestingly, the list was submitted as a market access issue under the agriculture negotiations of the Doha Round and not in the TRIPS Council. This, despite the fact that the EC clearly acknowledged the interlink ages between the other two GIs issues in the negotiating agenda of TRIPS and this third issue. This is not a surprising stance on the part of the EC, however, given that GIs assume enormous significance in the context of the EU agriculture, as discussed earlier. Moreover, in view of the slow progress in the negotiations on the other two issues under the purview of TRIPS, the EC might have attempted to open up another window of opportunity under the agriculture agenda. Whatever it was, the move received significant criticism from some WTO Members on grounds that the negotiating mandate on agriculture set by the Doha Ministerial Declaration did not mention GIs. And quite expectedly, the United States and a number of other countries expressed their strong opposition to the 'claw-back' proposal. Nevertheless, the EC has tried hard since then to keep the issue alive in the agriculture negotiations. The framework for agriculture modalities of the Doha Round adopted by WTO Members as Annex A of the Framework Agreement of July 2004, which was stitched together after the failed Ministerial Conference in Cancún, identified GIs as an issue 'of interest but not agreed'.[142] Annex A of the Hong Kong Ministerial Declaration of 2005 dealing with agriculture again mentioned GIs as among the 'issues that remain of interest but not agreed'.[143]

Importantly, on 16 June 2006, just prior to the issuance by the WTO of the first draft modalities text on agriculture, the EC submitted a communication titled 'European Communities proposal on market access issues'[144] to the special session of the Committee on Agriculture in which GIs appeared on the top of its list of demands. Notably, the proposal all the three GI issues, clearly reflecting their inter-linkages from the EC's perspective. The communication stated that 'geographical indications are of paramount importance for the EC due to their place in the EC's quality policy. All GI issues on the table in the various areas of negotiation should be addressed in an integrated manner with a view to achieving satisfactory results.' Notwithstanding this communication by the EC, the first draft modalities text on agriculture circulated on 22 June 2006[145] mentioned GIs within square brackets without any elaboration on the subject whatsoever. All the subsequent revised drafts on agriculture modalities[146] also maintained the same approach. While the inclusion of GIs within square brackets clearly indicate a lack of agreement as to whether it should form part of the agriculture modalities of the Doha Round, the fact that not even a single word has been spent on the issue may be regarded as a signal of its lost importance in the context of the agriculture negotiations.

It may also be noted that in the context of the negotiations on the multilateral register that includes the issue of genericness in a big way, albeit thus far limited only to wines and spirits, the EC has of late underscored that its proposals are forward-looking and not intended at correcting history. Having taken this position on the register issue, it would indeed be very difficult for the EC to continue to vouch for the 'claw-back' proposal aimed at correcting history.

It may be noted here that while the EU has thus far not been able to make such obligations acceptable at the multilateral level, the Article 24 exceptions have increasingly become the target of its regional and bilateral agreements, such as with Australia, Chile, Mexico, South Africa, and the United States. All of these agreements relate to wines and/or spirits. The provisions included in these agreements imply a state's obligation to remove prior conflicting trademarks and to grant protection to the EU GIs that have become 'generic'.[147]

## 5. Concluding Remarks

The origin of the long-drawn debate over GIs in the realm of the WTO can be traced back to the history of the Old world and the New. For some of the major players in the WTO belonging to either of these two 'Worlds', GI is an area that is intertwined with larger, politically sensitive debates about the appropriate level of protection for farmers and rural communities, the degree to which international law ought to trench upon questions of culture and tradition, the necessity of IPRs protection and the nature and scope of that protection and, above all, the economic implications of a stronger GI regime for their respective domestic interests, often with significant lobbying powers. It is such multi-faceted complexities which has made compromise rather difficult to reach for the major players.

While there has been some movement on the multilateral register of late, it may still be difficult to reach a consensus based on the modality text included in W/52 on the issue of the register. Because, even this text is highly tilted in favour of the GI right holders and is likely to result in significant financial and legal burden on the beneficiaries of prior rights in the New World. However, it needs to be recognized that the emergence of the strategic alliance of some 110 WTO Members, who are supporters of a parallelism among the three IP issues, is a positive development from the EC's angle, at least as far as the register is concerned. While earlier it was only the EC and Switzerland backing a register with strong legal effects, now the camp has backing of more than two-thirds of the WTO Membership. This may be helpful for the EC to achieve a favourable outcome on the register, provided of course the strategic alliance succeeds in maintaining their unity in upholding the linkages among all the three IP issues. This may also be helpful in pushing the agenda on GI-extension. This is an issue on which a number of developing countries have long since been supporting the EC. As discussed in this chapter, the hierarchical protection enshrined in TRIPS in its present form does not have any logical or legal justification whatsoever. It was nothing but a political compromise reached in the Uruguay Round. Hence, in our view, the proponents have a point in demanding the level playing field. Because, Article 22-type protection indeed leaves adequate room for misappropriation of GIs other than those relating to wines and spirits. This is crucial from the point of view of some of the developing countries (such as India, China) that have in their possession a number of potential or already-protected GIs belonging to other product categories, such as handlooms, handicrafts or food/beverages other than wines/spirits. In many of these countries, GI is also regarded as an important tool for protection of traditional knowledge and promoting rural development. Extension of the Article 23 armour to all GIs can go a long way towards ensuring better protection for the GIs belonging to the countries of the South. However, it needs to be underscored here that reaping commercial benefits from GIs in the global market would require multi-pronged strategies and efforts on the part of these countries, including *inter alia* identification of valuable GIs for export purpose; brand-building and promotion and tapping appropriate marketing channels and strategies. Hence, adequate legal protection at the international level can at best be regarded as necessary but in no way sufficient to reap commercial benefits out of GIs in the global market. Many developing countries (e.g. India[148]) have only recently begun to develop their national GI systems; it will take time before substantial commercial benefits will arise. Meanwhile, there are difficult questions to resolve, such as delineating the geographic boundaries of a GI, defining its quality attributes and other characteristics, establishing quality control mechanisms, and collectively managing and promoting an indication. Addressing these challenges will require concerted efforts regardless of what emerges from the GI discussions at the WTO.[149]

Finally, in our view, proponents of the GI agenda from the South need to weigh costs and benefits among various issues of interest to them before taking any particular stance on the issue. While the strategic alliance reached among the proponents of the three IP issues may be helpful for pushing the GIs agenda, it may be noted that the alliance was reached at the cost of a significant compromise on the TRIPS/CBD front on the part of the proponents of this crucial issue. While originally they were demanding a strong legal effect in the disclosure proposal tabled by them, the modality text included in W/52 did not include this important part of the disclosure proposal. Even on the issues of prior informed consent and access and benefit sharing, W/52 only mentioned that 'Members agree to define the nature and extent of a reference to Prior Informed Consent and Access and Benefit Sharing'. This was again a significant departure from the original proposal put forward by the proponents of the disclosure requirement. Whether such compromises are worth making for some of the developing countries that evidently have a higher stake in getting a better deal on TRIPS/CBD than on GIs remains an open question for their policy makers to ponder. Such cost-benefit analysis may turn out to be even more significant in the future course of negotiations on Doha Round, if the proponents succeed in making all the TRIPS issues a part of the single undertaking. Because even if they succeed in getting a good deal on GIs, it is most likely to be a *quid-pro-quo* for concessions to be granted elsewhere.

## Endnotes

1 For legal reasons, the European Union is known officially as the European Communities in WTO business. The EU is a WTO member in its own right as are each of its 27 member States — making 28 WTO members altogether. While the member States coordinate their position in Brussels and Geneva, the European Commission alone speaks for the EU and its members at almost all WTO meetings and in almost all WTO affairs. For this reason, in most issues, WTO materials refer to the 'EU', or the legally-official 'EC'.

2 The addition of spirits occurred at the end of the negotiations. See WTO document MTN.TNC/W/89 of 7 November 1991.

3 Raustiala and Munzer (2007), p. 338.

4 Raustiala and Munzer (2007), p. 339.

5 For further details, refer to Caenegem (2003b).

6 Caenegem (2003b), pp.865-66.

7 For further details on French AOC and terroir, refer to, Barham(2003).

8 Raustiala and Munzer (2007), p. 344.

9 The system of regulation and control of Champagne is consider ed to be the model of an Appellation d'Origine Contrôllée (AOC). A set of thirty-five rules controls every aspect of the production of Champagne: the grape varieties used; planting and pruning of vines; limited yields; harvest by hand; minimum ageing periods. The 'protected designations of origin' (PDOs)

of the EU requires all elements of production, processing and preparation to occur within the designated area. By contrast, the ‘protected geographical indications (PGIs) requirements are relatively more flexible: only one facet of production, processing or preparation needs to take place within the designated area.

10 In the case of Feta cheese, this interplay was said to include: ‘The development of small native breeds of sheep and goats which are extremely tough and resilient, fitted for survival in an environment that offers little food in quantitative terms but, in terms of quality, is endowed with an extremely diversified flora, thus giving the finished product its own specific aroma and flavour. The in terplay between the natural factors and the specific human factors, in particular the traditional production method, which requires straining without pressure, has thus given Feta cheese its remarkable international reputation (ECJ press release on the Fet a judgment: Press release No 92/05.25 Oct. 2005).

11 In case of wine, for instance, it may be the case that if grapes come from a very small denomination that is geographically homogenous and distinct, and the wine is consistently produced by idiosyncratic methods, it cannot be replicated anywhere else. This proposition is difficult to test, but it becomes more doubtful the larger the denomination and the more varied the geography. For other products, the proposition may be even more doubtful. For cheese, for instance, there is unlikely to be a discernable difference between products from Qfferent regions as long as certain transferable methods are observed in the derivation and making (See Moran (1993)).

12 Caenegem (2003a), p. 712.

13 Raustiala and Munzer (2007), p. 349.

14 Caenegem (2003a), p. 712.

15 In 1946, the current legislation over trademarks came into place as the Lanham Act. Under this act, the US Patent & Trademark Office maintains a register of trademarks, allowing the owner to enforce its rights against those infringing the mark. Section 43 of the Lanham Act titled, ‘False Designations of Origin, False Descriptions, and Dilution Forbidden’, offers a thorough means by which to challenge the use of a mark that misleads consumers based on GI concepts. The Bureau of Alcohol Tobacco and Firearms (BATF) regulated domestic and international GIs until a January 2003 amendment under the Homeland Security Act. The BATF was also the governmental body responsible for establishing viticultural areas in the United States and approving future ones. The BATF established over 150 American Viticultural Areas, ranging from Napa Valley to the Ohio River Valley. In January 2003, the new Alcohol and Tobacco Tax and Trade Bureau (TTB) was designated to administer the regulation of wine label content. The TTB oversees proper grape variety representations and appellation designations, and monitors the inclusion of health statements on wine labels. (Torsen, Molly (2005),pp.30-32).

16 Torsen (2005), p.1431.

17 A Ham and Cheese Sandwich by Any Other Name, Deutsche Welle, Aug. 29, 2003, available at: http://www.dw-world.de/dw/article/0,1564,958339,00.html

18 European Commission (2003b), p.4.

19 European Commission (2005), p.13-15.

20 Raustiala and Munzer (2007), pp. 339 and 347.

21 Raustiala and Munzer (2007), pp. 348-49.

22 Yeung and Kerr (2008), p.13.

23 Raustiala and Munzer (2007), pp. 348-49.

24 Yeung and Kerr (2008), p.13.

25 Barham (2003),pp. 128-29.

26 For further details on the EU’s stakes in GIs, see European Commission (2003b).

27 European Commission (2003b), p.2.

[28] The WTO has 153 Members as on 31 December 2008.

[29] See WTO document: IP/C/W/247/Rev.1 dated 17 May 2001, paragraph 15.

[30] Notwithstanding this, Articles 24.4 and 24.6 of TRIPS contain explicit reference to services. A close look at the negotiating history of the TRIPS Agreement, however, reveals that the preferred term in this context was 'product'. it is only in the Brussels draft dated 3 December 1990 that the term 'good' is found to replace 'product' with the simultaneous removal of the bracketed term 'services' [For further details, Das, 2007, pp. 19-20. However, in some countries services are also included, for example in Azerbaijan, Bahrain, Croatia, Jamaica, Saint Lucia, and Singapore.

[31] For further details, refer to WTO (2001).

[32] Article 10*bis* of the Paris Convention reads as follows:

(1) The countries of the Union are bound to assure to nationals of such countries effective protection against unfair competition.

(2) Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition.

(3) The following in particular shall be prohibited:

1. All acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor;
2. False allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor;
3. Indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.

[33] See Addor and Grazioli, 2002, p. 879.

[34] See Gervais, 1998, p. 128.

[35] See WTO Document IP/C/8 dated 6 November 1996, paragraph 34.

[36] This is the date of the Ministerial Meeting concluding the Uruguay Round of Multilateral Trade Negotiations.

[37] The grandfather clause is the TRIPS provision, which allows right holders to maintain certain acquired rights, even if TRIPS inconsistent (see Addor and Grazioli, 2002, p. 872).

[38] This discussion draws heavily on Das (2008a), pp.487-93.

[39] For a discussion on the relevant provisions of these agreements, see European Commission (2005), pp.2-5.

[40] For further details, refer Rangnekar (2003), p.15.

[41] Gervais (1998), p.12.

[42] See WTO document MTN.GNG/NG11/14, dated 12 September 1989, paragraph 53.

[43] See WTO document MTN.GNG/NG11/W/68 dated 29 March 1990.

[44] See WTO document MTN.GNG/NG11/W/73.

[45] WTO document MTN.GNG/NG11/21, dated 22 June 1990, paragraph 41.

[46] Ibid.

[47] See WTO document MTN.GNG/NG11/14, dated 12 September 1989, paragraph 55.

[48] See WTO document MTN.GNG/NG11/14, dated 12 September 1989, paragraph 56.

[49] The Canadian proposal also placed special emphasis on meeting the relevant provisions of the Paris Convention to ensure adequate protection for GIs including appellations of origin. In addition to the general provisions of the Paris Convention on trademarks and the specific provision of Article 7 bis requiring protection of collective marks, the Canadian proposal drew attention to Articles 9, 10 and 10ter of the Paris Convention requiring members to provide appropriate legal remedies effectively to repress the direct or indirect use of false indications of the source of the goods or of the identity of the producer, manufacturer or merchant (see

WTO document MTN.GNG/NG11/16, dated 4 December 1989, paragraph 19).

50 WTO document MTN.GNG/NG11/W/70, dated 11 May 1990.

51 The proposals regarding trademarks in the US Draft clarified that 'The term "trademark" shall include service marks, collective and certification marks'.

52 Article 12 of the US Draft Agreement (WTO Document MTN.GNG/NG11/W/70, dated 11 May 1990) included the following two provisions:

(1) The owner of a registered trademark shall have exclusive rights therein. He shall be entitled to prevent all third parties not having his consent from using in commerce identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is protected, where such use would result in a likelihood of confusion. However, in case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

(2) The owner of a trademark shall be entitled to take action against any unauthorized use which constitutes an act of unfair competition or passing off.

53 See WTO document MTN.GNG/NG11/16, dated 4 December 1989, paragraph 53.

54 See WTO document MTN.GNG/NG11/14, dated 12 September 1989, paragraphs 56 and 60.

55 See WTO document MTN.GNG/NG11/16, dated 4 December 1989, paragraph 53.

56 WTO document MTN.GNG/NG11/W/75, dated 13 June 1990.

57 Gervais (1998), p.16.

58 The EC Draft required that 'the registration of a t rademark which contains or consists of a geographical or other indication denominating or suggesting a country, region or locality with respect to goods not having this origin shall be refused or invalidated and that national laws shall provide the possibility for interested parties to oppose the use of such a trademark'. It should be noted here that unlike the Australian proposal, this proposal of the EC did not want such protection to be conditional upon the 'misleading test'. The Swiss proposal, however, was even closer to the Australian proposal as it included the 'misleading test' as well.

It required that 'The registration of a trademark which contains or consists of a geographical or other indication designating or suggesting a country, region or locality with respect to products not having this origin shall be refused or invalidated, if the use of such indication is likely to mislead the public.'

59 The Swiss proposal reads as follows:

Appropriate measures shall be taken so as to prevent a geographical indication from developing into a designation of a generic character as a result of its use in trade for products of a different origin.

60 WTO document MTN.GNG/NG11/22 dated 22 August 1990, paragraph 2.

61 WTO document MTN.GNG/NG11/W/75, dated 13 June 1990.

62 WTO document MTN.GNG/NG11/21, dated 22 June 1990, paragraph 12.

63 Commission on Intellectual Property Rights (2002).

64 See WTO document: IP/C/W/204/Rev.1, dated 2 October 2000, paragraph 6.

65 The addition of spirits occurred at the end of the negotiations. See WTO document MTN.TNC/W/89, dated 7 November 1991.

66 See Gervais (1998), pp.134-35.

67 The EC proposal was that:

In order to facilitate the protection of geographical indications including appellations of origin, an international register for protected indications shall be established. In appropriate cases the use of documents certifying the right to use the relevant geographical indication should be provided for.

68 See WTO document: IP/C/8, dated 6 November 1996, Section-III.

69 European Commission (2003b), p.2.

70 See WTO document: IP/C/8 of 6 November 1996, Section-III.

71 Wasescha (2007), p.7.

72 See, WTO document: WT/MIN(05)/DEC of 22 December 2005, para 29.

73 The formal proposals on the three positions are contained in the following three WTO documents: TN/IP/W/11 of 14 June 2005 (EC); TN/IP/W/10 of 1 April 2005 (Joint Proposal Group) and TN/IP/W/8 of 23 April 2003 (Hong Kong, China). The key points of these three formal proposals have been compiled and put side by side in the WTO document TN/IP/W/12 of 14 September 2005.

74 Wasescha (2007), p.8.

75 Discussion here is based on the official submission of the EC contained in the WTO document TN/IP/W/11 of 14 June 2005. More recently, the EC has made some alterations in its position. These new developments are discussed at a later stage in this paper.

76 For want of space, the discussion here is only selective and in no way exhaustive. For a detailed exposition of the points raised and views expressed on these proposals, refer the WTO document: TN/IP/W/12/Add.1 of 4 May 2007.

77 It is only in Article 34 of TRIPS with regard to process patents that the reversal of the burden of proof is expressly provided for.

78 For minutes of this meeting, see WTO document TN/IP/M/19 of 19 July 2008.

79 See, WTO document TN/IP/18 of 9 June 2008.

80 See TN/IP/M/19 of 19 July 2008, p.4.

81 http://www.ip-watch.org/weblog/index.php?p=1085

82 http://www.ip-watch.org/weblog/index.php?p=1085

83 See WTO document: TN/IP/18 of 9 June 2008.

84 See WTO document: WT/GC/W/591 and TN/C/W/50 of 9 June 2008.

85 http://www.ip-watch.org/weblog/index.php?p=1085

86 The communication was circulated by the WTO at the request of delegations of Brazil, the EC, India and Switzerland in the form of the WTO document TN/C/W/52 of 19 July 2008.

87 http://www.ip-watch.org/weblog/index.php?p=1184

88 The EC further pointed out that the W/52 document was a landmark not only because it was supported by nearly three-quarters of the WTO membership, but also because it represented a key compromise of groups that were not originally in agreement. It was not a coalition of like-minded countries. The document was the result of ‘difficult negotiations’ in which everyone had to make compromises on their original positions. There were reportedly only eight nations that were supporting both the GI issues and the CBD issues before the parallelism came to the fore.

89 http://www.ip-watch.org/weblog/index.php?p=1294

90 http://www.ip-watch.org/weblog/index.php?p=1336

91 http://www.ip-watch.org/weblog/index.php?p=1351

92 WTO document TN/IP/19 of 25 November 2009.

93 The negotiations of the Special Session are being chaired temporarily by Ambassador Karen Tan of Singapore, following the departure of previous Chair Ambassador Trevor Clarke.

94 WIPO (2000), pp.12 and 16.

95 See WTO Document: IP/C/W/247/Rev.1 dated 17 May 2001, paragraph 13.

96 Addor and Grazioli (2002), p. 882.

97 Addor and Grazioli (2002), p. 895.

98 For want of space, the discussion here is only selective and in no way exhaustive. For a detailed exposition on the arguments for and against extension, refer to the WTO document: WT/GC/W/546 and TN/C/W/25 of 18 May 2005.

[99] WTO document TN/C/4, p.2.
[100] WTO documents: IP/C/W/353, paragraph 13; TN/C/W/14, p.2; JOB(05)/61, p.4.
[101] WTO documents: IP/C/W/386, paragraph 6; New Zealand, IP/C/M/37/Add.1, paragraph 166; Australia, IP/C/M/38, paragraph 76.
[102] WTO documents: Canada, IP/C/M/37/Add.1, paragraph 121; New Zealand, DDG consultations, 7 February 2005; Chinese Taipei, DDG consultations, 25 April 2005.
[103] WTO documents: New Zealand, IP/C/M/38, paragraph 89; United States, DG consultations, 30 June 2003.
[104] WTO document: Australia, IP/C/M/38, paragraph 80.
[105] WTO documents: IP/C/W/386, paragraph 26; Australia, IP/C/M/38, paragraph 81.
[106] WTO documents: IP/C/W/353, paragraph 41; EC, DDG consultations, 10 March 2005; WT/GC/W/540/Rev.1 and TN/C/W/21/Rev.1, paragraph 13; JOB(03)/119, p.2.
[107] WTO documents: IP/C/W/353, paragraph 3; Czech Republic, IP/C/M/37/Add.1, paragraph 169; JOB(05)/61, paragraph 5.
[108] WTO document: Switzerland, IP/C/M/38, paragraph 70.
[109] WTO document: Hungary, IP/C/M/38, paragraph 117.
[110] WTO document: Bulgaria, IP/C/M/38, paragraph 124 and DDG consultations, 25 April 2005.
[111] WTO documents: IP/C/W/353, paragraph 13; TN/C/W14, p.2; Switzerland, DDG consultations, 7 February 2005; WT/GC/W/540/Rev.1 and TN/C/W/21/Rev.1, paragraph 12.
[112] WTO documents: Pakistan, IP/C/M/37/Add.1, paragraph 167; WT/GC/W/540/Rev.1 and TN/C/W/21/Rev.1, paragraph 6.
[113] WTO documents: Switzerland, IP/C/M/38, paragraph 69; WT/GC/W/540/Rev.1 and TN/C/W/21/Rev.1, paragraph 8.
[114] WTO documents: India, DG consultations, 30 June 2003; WT/GC/W/540/Rev.1 and TN/C/W/21/Rev.1, paragraph 8.
[115] WTO document: Australia, IP/C/M/38, paragraph 78.
[116] WTO documents: New Zealand and Chile, IP/C/M/38, paragraphs 87 and 113, respectively; United States and New Zealand, DDG consultations, 7 February 2005.
[117] WTO documents: Uruguay, IP/C/M/37/Add.1, paragraph 172; IP/C/W/386, paragraphs 3-4; United States, DG consultations, 30 June 2003; Singapore, DDG consultations, 10 March 2005; Chinese Taipei, DDG consultations, 25 April 2005.
[118] WTO documents: EC, Hungary and Malta, IP/C/M/37/Add.1, respectively, paragraphs 142 (also citing annex, pp. 77-79), 148 and 157; EC, JOB(03)/119, p.3; EC, DG consultations, 30 June 2003.
[119] WTO document: Australia, IP/C/M/35, paragraph 146.
[120] WTO document: Argentina, IP/C/M/36/Add.1, paragraph 86.
[121] WTO document: Hungary, IP/C/M/37/Add.1, paragraphs 150-51
[122] WTO document: India, IP/C/M/36/Add.1, paragraph 59.
[123] WTO documents: Switzerland, IP/C/M/38, paragraph 203; TN/C/W/14, p.2; EC, JOB(03)/119, p.5; WT/GC/W/540/Rev.1 and TN/C/W/21/Rev.1, paragraphs 10-11.
[124] WTO document: Switzerland, IP/C/M/38, paragraph 203.
[125] WTO documents: Switzerland, IP/C/M/38, paragraphs 204-05; WT/GC/W/540/Rev.1 and TN/C/W/21/Rev.1, paragraphs 10-11.
[126] WTO document: United States, IP/C/M/38, paragraph 175.
[127] WTO document: IP/C/W/386, paragraphs16 and 20.
[128] See WTO document: IP/C/8, dated 6 November 1996, Section-III.
[129] WTO document: IP/C/W/204/Rev.1, dated 2 October 2000, paragraph 12.
[130] See WTO document: WT/GC/W/564/Rev.2 of 5 July 2006.
[131] Das (2008b).
[132] http://www.ip-watch.org/weblog/index.php?p=859

[133] The submission was made by the European Communities, Guinea, India, Jamaica, Kenya, the Kyrgyz Republic, the Former Yugoslav Republic of Macedonia, Madagascar, Morocco, Pakistan, Sri Lanka, Switzerland, Tanzania, Thailand and Turkey. See WTO document TN/C/W/48 of 19 February 2008.

[134] See WTO document: TN/C/W/50 of 19 June 2008.

[135] The communication was circulated by the WTO at the request of delegations of Brazil, the EC, India and Switzerland in the form of the WTO document TN/C/W/52 of 19 July 2008.

[136] http://www.ip-watch.org/weblog/2008/11/21/push-for-trips-changes-reaches-highest-level-at-wto-as-meetings-intensify/

[137] http://www.ip-watch.org/weblog/2008/11/28/wto-ip-discussion-in-question-with-possible-ministerial-on-horizon/

[138] http://www.ip-watch.org/weblog/index.php?p=1351

[139] The EC mentioned that the list would be completed with GIs originating in the Acceding States to the EU.

[140] See European Commission (2003a).

[141] 'This is not about protectionism. It is about fairness. It is simply not acceptable that the EU cannot sell its genuine Italian Parma Ham in Canada because the trade mark "Parma Ham"is reserved for a ham produced in Canada', the then EU Farm Commissioner Franz Fischler said regarding this move. The then EU Trade Commissioner Pascal Lamy added 'Geographical Indications offer the best protection to quality products which are marketed by relying on their origin and reputation and other special characteristics linked to such an origin. They reward investment in quality by our producers. Abuses in third countries undermine the reputation of EU products and create confusion for consumers. We want this to cease for the most usurped products in the world' (See European Commission (2003a)).

[142] See WTO document WT/L/579 of 2 August 2004, p. A-7.

[143] See WTO document WT/MIN(05)/DEC of 22 December 2005, p. A-7.

[144] See WTO document: JOB(06)/190 of 16 June 2006.

[145] See WTO document TN/AG/W/3 of 12 July 2006.

[146] See WTO documents: TN/AG/W/4 and Corr.1 of 1 August 2007; TN/AG/W/4/Rev.1 of 8 February 2008; TN/AG/W/4/Rev.2 of 19 May 2008; TN/AG/W/4/Rev.3 of 10 July 2008; and TN/AG/W/4/Rev.4 of 6 December 2008.

[147] For further details, see Maximiliano 2007.

[148] For challenges confronting the Indian GIs initiatives, refer to Das, Kasturi, 2010.

[149] CTA (2008), p. 13.

## References


- Addor, Felix, and Alexandra Grazioli. 2002. 'Geographical Indications beyond Wines and Spirits: A Roadmap for a Better Protection for Geographical Indications in the WTO TRIPS Agreement'. *Journal of World Intellectual Property*, Vol. 5(6), 863-97.
- Barham, Elizabeth. 2003. Translating Terroir: The Global Challenge of French AOC Labeling. *Journal of Rural Studies*, 19, 127–138.
- Caenegem, William van. 2003a. 'Registered Geographical Indications: Between Intellectual Property and Rural Policy-Part I'. *Journal of World Intellectual Property*,6 (5), 699-719.
- Caenegem, William van. 2003b. 'Registered Geographical Indications: Between Intellectual Property and Rural Policy-Part II'. *Journal of World Intellectual Property*, 6 (6), 861-74.

- Commission on Intellectual Property Rights (CIPR). 2002. *Integrating Intellectual Property Rights and Development Policy*. Commission on Intellectual Property Rights,London, UK.
- Correa, Carlos M. 2002. 'Protection of Geographical Indications in Caricom Countries'. available at: http://www.crnm.org/documents/studies/Geographical%20Indications%20-%20Correa.pdf
- Das, Kasturi. 2006a. 'International Protection of India's Geographical Indications with Special Reference to "Darjeeling" Tea'. *Journal of World Intellectual Property*, Vol. 9 (5), 459-95, Blackwell Publishing Ltd.
- Das, Kasturi. 2006b. 'Protection of India's "Geographical Indications": An Overview of the Indian Legislation and the TRIPS Scenario'. *Indian Journal of International Law*, Vol. 46 (1), 39-73, Indian Society of International Law, India.
- Das, Kasturi. 2007. 'Protection of Geographical Indications: An Overview of Select Issues with Particular Reference to India'. *Working Paper 8*, Centre for Trade & Development (Centad), New Delhi. Available at: http://www.centad.org/download/WorkingPaper_FinalPDF_4June07.pdf
- Das, Kasturi. 2008a. 'Select Issues and Debates around Geographical Indications with Particular Reference to India'. *Journal of World Trade,* Vol. 42(3), 461-507, Kluwer Law International.
- Das, Kasturi. 2008b. 'WTO Ministerial Must Address Biopiracy Concerns'. *The Economic Times*, New Delhi, India, 14 July.
- Das, Kasturi. 2010. 'Prospects and Challenges of Geographical Indications in India'. *Journal of World Intellectual Property [Special Issue on Law and Economics of Geographical Indications]*, Blackwell Publishing, Canada, Vol. 13 (2),148-201.
- European Commission. 2003a. WTO Talks: EU Steps up Bid for Better Protection of Regional Quality Products, Press release of the European Commission, Brussels, 28 August 2003, available at: http://europe.eu.int.
- European Commission. 2003b. 'Why Do Geographical Indications Matter to Us?' 30 July, available at: http://europa.eu.int/comm/trade/issues/sectoral /intell_property/argu_en.htm
- European Commission. 2005. 'Geographical Indications and TRIPS: 10 Years Later…: A Roadmap for EU GI Holders to get Protection in Other WTO Members'.
- Fink, Carsten and Keith Maskus. 2006. 'The Debate on Geographical Indications in the WTO', in Newfarmer, Richard (ed.), *Trade, Doha, and Development: A Window into the Issues*, The International Bank for Reconstruction and Development/The World Bank, Washington, DC, USA.
- Gangjee, Dev. 2007. Say Cheese! A Sharper Image of Generic Use through the Lens of Feta, available at: http://papers.ssrn.com/sol3/papers.cfm?abstract_id=980543
- Gervais, Daniel. 1998. *The TRIPS Agreement: Drafting History and Analysis* (London: Sweet & Maxwell).
- Maximiliano Santa Cruz S. 2007. 'Intellectual Property Provisions in European Union Trade Agreements: Implications for Developing Countries', International Centre for Trade and Sustainable Development (ICTSD).

- Moran, W. 1993. ‘Rural Space as Intellectual Property’. *Political Geography*, 12.
- Nieuwveld, Lisa Bench. 2007. ‘Is This Really about What We Call Our Food or Something Else? The WTO Food Name Case over the Protection of Geographical Indications’. *The International Lawyer,* 41(3), 891-922.
- Rangnekar, Dwijen. 2003. ‘Geographical Indications - A Review of Proposals at the TRIPS Council: Extending Article 23 to Products other than Wines and Spirits’. International Centre for Trade and Sustainable Development (ICTSD).
- Raustiala, Kal and Stephen R. Munzer. 2007. ‘The Global Struggle over Geographic Indications’. *The European Journal on International Law, 18(2),* 337-65.
- Technical Centre for Agricultural and Rural Cooperation ACP-EU (CTA) 2008. ‘Executive Brief: WTO Negotiations on Agriculture’, April.
- Torsen, Molly. 2005. ‘Apples and Oranges: French and American Models of Geographic Indications Policies Demonstrate an International Lack of Consensus’. *The Trademark Reporter*, 95(6), 1415-45.
- Vivas-Eugui, David, and Christophe Spennemann. 2006. ‘The Treatment of Geographical Indications in Recent Regional and Bilateral Free Trade Agreements’, UNCTAD/ICTSD Project on Intellectual Property and Sustainable Development.
- Wasescha, Thu-Lang Tran. 2007. ‘Geographical Indications in the International Arena: The Current Situation’, WIPO/GEO/BEI/07/15 OF 23 JUNE.
- World Intellectual Property Organisation (WIPO). 2000. ‘Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications’, Fifth Session, Geneva, 11-15 September.
- World Trade Organisation (WTO). 2001. Council for Trade-Related Aspects of Intellectual Property Rights, ‘Review Under Article 24.2 of the Application of the Provisions of the Section of the TRIPS Agreement on Geographical Indications: Summary of the Responses to the Checklist of Questions’, IP/C/W/253, 4 April.
- Yeung, May T. and William A. Kerr. 2008. ‘Increasing Protection of GIs at the WTO: Clawbacks, Greenfields and Monopoly Rents’. *CATPRN Working Paper 2008-02,* Canadian Agricultural Trade Policy Research Network (CATPRN), March.

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