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FOLLOW-UP TO THE REVIEW OF LEGISLATION ON TRADEMARKS, GEOGRAPHICAL INDICATIONS AND INDUSTRIAL DESIGNS

Questions posed by India

By means of communications from the Permanent Mission of India, dated 17 February 1997, the Secretariat has received follow-up questions posed by India to the following WTO Members concerning the review of national implementing legislation in the areas of trademarks, geographical indications and industrial designs:

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EUROPEAN COMMUNITIES

Original Question 1 and Answer

1. *How far is Article 12 of the Council Regulation (EEC) No. 2081/92 in compliance with the TRIPS Agreement? Please particularly explain how:*

- (i) *the guarantees under Article 4 as required under Article 12.1 take into account geographical indications where the reputation of the good is critically attributable to its geographical origin?*

In accordance with Article 22 of TRIPS, reputation as such is a sufficient element to obtain the protection as geographical indication under Article 2.2(b) of Regulation (EEC) No. 2081/92.

- (ii) *having inspection arrangements equivalent to Article 10 can be a requirement for non-members of the EC, when this is not a requirement under TRIPS?*

It is important to stress that, in general, conditions provided in Article 12 of Regulation (EEC) No. 2081/92 are only required when a bilateral agreement is concluded between the EC and a WTO Member. This means that it only occurs when two parties voluntarily wish a higher level of protection ("ex officio") than this provided under TRIPS. So, this is not a compulsory condition but another option that can be used when systems are equivalent, in particular conditions under Article 4 (specifications) and Article 10 (inspection).

- (iii) *the reciprocity provision in Article 12 (3rd indent) is compatible with Article 3 of the TRIPS Agreement, especially for countries which are still availing of transition periods under Article 65.2 of that Agreement?*

See answer (ii).

Follow-up Question 1 to Answer to Question 1

1. *While the definition of geographical indications under Article 2.2(b) of the EC Regulation 2081/92 includes products originating in a region, specific place or country, and possessing, inter alia, reputation, Article 4 imposes the requirement of complying with a product specification which includes a minimum of eight specific conditions and a general condition encompassing any requirements laid down by the Community and/or national provisions. It is not clear why a geographical indication based on reputation alone should have to comply with such specifications, especially those in Article 4.2(b) and (e). Should geographical indications from third countries based on reputation alone be subject to such conditions, especially when under Article 12 it appears that the registration will have to be processed through the third country government, which should be a sufficient check on the validity of the claim?*

Follow-up Question 2 to Answer to Question 1

2. *How would Article 10 of the EC Regulation 2081/92 be applied to third countries, especially in regard to judging the "adequate guarantees of objectivity and impartiality" as required under 10.3? Would it satisfy the EC if the third country government was to certify all conditions given in Article 10?*

Further, do not the conditions in Article 10 constitute an unjustifiable discrimination, especially for the developing countries?

Follow-up Question 3 to Answer to Question 1

3. *Protection for registered names is defined under Article 13 of EC Regulation 2081/92. This protection is an advantage granted by EC to its nationals who meet the requirements of Article 4 and Article 10. In such a case, does not Article 3 of TRIPS require EC to accord treatment no less favourable to the nationals of other WTO Members?*

Follow-up Question 4 to Answer to Question 1

4. *Similarly when a third country which is a Member of WTO avails itself of the advantage of registration, does not Article 4 of TRIPS require EC to accord the same advantage immediately and unconditionally to the nationals of all other WTO Members?*

Original Question 3 and Answer

3. *Are EC Regulations directly applicable law in all Member States?*

Which are the exceptions and what steps have these Member States taken to apply the relevant EC Regulations?

Regulations (ex. Regulation (EEC) No. 2081/92) are directly applicable law in all Member States; this means that no supplementary steps (ex. transposition by national law) are necessary to apply Regulations.

Follow-up Question 1 to Answer to Question 3

1. *Even while EC Regulation 2081/92 is directly applicable law in Member States, Germany has incorporated this in its domestic law. Under Chapter 1 of Part 6 of the German Trade Mark Law of April 1996, Protection of Indications of Geographic Origin is defined, while under Chapter 2 Protection of Geographical Indications and Designation of Origin under EC Regulation 2081/92 is incorporated. Please clarify whether applications in Germany from third countries who are WTO Members for the protection of geographical indications will be considered under Chapter 1 or Chapter 2 or both? Further, if protection is sought only for Germany, is there a requirement to register the geographical indication or not?*

UNITED STATES

Original Question 1 and Answer

1. *Does the US provide protection of geographical indications as required under Article 22 of TRIPS only through registration as collective marks and certifications marks? Can passing-off action be initiated in US Courts without registration in such a manner?*

Protection is provided through Section 43(a) of the Trademark Act of 1946, as amended. It states:

(a)(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which -

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities,

...

shall be liable in a civil action by any person who believes that he or she is likely to be damaged by such act.

Note that registration of the geographic indication is not required to invoke the protection offered by Section 43(a) of the Trademark Act.

Protection is also available under the laws and regulations administered by the Bureau of Alcohol, Tobacco, and Firearms. The pertinent law covering geographic indications is the Federal Alcohol Administration Act and implementing regulations. These regulations include 27 CFR Parts 4 and 12 for wine, 27 CFR Part 5 for distilled spirits, and 27 CFR Part 7 for malt beverages. Under these regulations, ATF has the authority to prevent the misleading use of geographical indications for distilled spirits, wine and malt beverages. Thus registration is not required before an action can be brought in Federal Court.

Follow-up Question 1 to Answer to Question 1

1. *Is the answer given by the US that registration is not required before an action can be brought in Federal Court, applicable only to alcohol, tobacco and firearms or does it apply to all products?*

Follow-up Question 2 to Answer to Question 1

2. *How does the US provide legal means for any party to prevent unfair competition within Article 10bis of the Paris Convention, in particular in respect of any act of competition contrary to honest practices?*

Original Question 2 and Answer

2. *Article 24.9 of TRIPS states, inter alia, that there shall be no obligation under the Agreement to protect geographic indications which are not protected in their country of origin. If the geographic indication is protected in the country of origin by courts under a passing-off action, will the United States allow it to be similarly protected in its territory?*

Whether the geographic indication is protected in its country of origin might be one factor which a court would consider. However, the issues to be considered under Article 43(a) of the Trademark Act is whether the geographical term is a false designation of origin or whether the term causes confusion, mistake or is deceptive and use of the term damages the interests of another.

Follow-up Question 1 to Answer to Question 2

1. *Is it to be understood from the answer given by the US that, if false designation of origin causes confusion or mistake or can be considered as deceptive then the geographical indication is protected in the US even when it is protected only under passing-off action in the country of origin?*

Follow-up Question 2 to Answer to Question 2

2. *Is there any provision in the US Law which requires geographical indications to be protected in the country of origin before remedies can be made available under Article 43(a) of the Trade Mark Act of 1946, as amended?*