

**SUGGESTED METHOD FOR DOMESTIC RECOGNITION OF GEOGRAPHICAL
INDICATIONS FOR WTO MEMBERS TO PRODUCE A LIST OF NATIONALLY-
PROTECTED GEOGRAPHICAL INDICATIONS**

Communication from the United States

The following suggested method for domestic recognition of geographical indications for WTO Members to produce a list of nationally-protected geographical indications has been received from the delegation of the United States, on 17 February 1999.

**REGISTRATION OF GEOGRAPHICAL INDICATIONS UNDER TRADEMARK
REGIMES AS COLLECTIVE OR CERTIFICATION MARKS**

There are many acceptable means of protecting geographical indications ("GIs") that meet the requirements of the TRIPS Agreement. For example, some Members protect GIs under their unfair competition regimes, or as trademarks, or in other ways. However, in order to produce a list of GIs for notification under Article 23.4 of the TRIPS Agreement, it may be desirable to employ a method which results in an easily-identifiable list of nationally-protected geographical indications. One such method of both protecting geographical indications producing a list of protected GIs is to use the trademark regime for registering GIs as collective or certification marks.

1. "Geographical Indications" are defined, at Article 22.1 of the TRIPS Agreement, as " ... indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographic origin."
2. Article 22.2 of the TRIPS Agreement requires that Members provide the legal means for interested parties to prevent use of geographical indications in connection with goods in a way that implies the goods originate somewhere other than where they actually originate, or that otherwise constitute unfair competition as defined by Article 10*bis* of the Paris Convention for the Protection of Industrial Property.¹

¹ Article 22.2 is as follows: "In respect of geographical indications, Members shall provide the legal means for interested parties to prevent:

- (a) 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;
- (b) any use which constitutes an act of unfair competition within the meaning of Article 10*bis* of the Paris Convention (1967).

3. Article 23.1 of the TRIPS Agreement further requires, with respect to geographical indications identifying wines and spirits, that Members provide protection against use of geographical indications in connection with wines or spirits that, even when identifying the true origin of those wines or spirits, imply that they originated from another place and against use of a geographical indication in translation or in conjunction with words like "kind", "type", "style", "imitation", etc.²
4. Nothing in either Article 22 or Article 23 requires that Members establish any particular system for protection of geographical indications. In fact, there exist many ways to protect geographical indications in a manner consistent with the requirements of Articles 22 and 23. One way to protect geographical indications which may be accomplished easily, adequately, and in a completely TRIPS-consistent manner is through registration of geographical indications under trademark regimes as collective or certification marks.
5. Using the trademark system to protect geographical indications has the following advantages:
 - It employs the existing trademark regime. No additional commitment of resources (e.g., personnel, money) is required. A government's use of its existing trademark regime to protect geographical indications will involve the use only of government resources already committed to the trademark system for applications, registrations, oppositions, cancellations, adjudication, and enforcement. The existing trademark system is a known quantity to the business community and provides a transparent, tested system for notification and adjudication of rights.
 - It is fully TRIPS compliant. In addition to fulfilling all of the requirements of Section 3 of Part II of the TRIPS Agreement, the use of the national trademark system meets the TRIPS requirement for national treatment and the obligations in Part III of the TRIPS Agreement regarding enforcement.
 - It is self-policing. Stakeholders, (i.e., competitors, businesses in the geographic area, the mark owner) would raise issues of infringement, failure to comply with certification standards, among other things. Members would not have to commit additional enforcement resources to ensure compliance.
 - Finally, Article 7bis of the Paris Convention requires that Paris Union Members provide protection for collective marks. That obligation is incorporated into the TRIPS Agreement by Article 2.1 thereof. Protecting geographical indications through registration as collective marks will use a system that is already required to exist.

² Article 23.1 is as follows: "Each Member shall provide the legal means for interested parties to prevent use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like.