

**THE PROTECTION OF GEOGRAPHICAL
INDICATIONS FOR AGRICULTURAL
PRODUCTS IN AFRICA USING
TRADEMARKS AND *SUI GENERIS*
LEGISLATION**

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DECLARATION

I
hereby declare that **‘The protection of geographical indications for agricultural products in Africa using trademarks and *sui generis* legislation’** is my own work, and that it has not been submitted before for any degree or examination in any other university. Where another person’s work has been used, it has been duly acknowledged.

Student

Signature:

Date:



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ABSTRACT

A geographical indication (GI) is a sign by which a product is identified as having its origin in a particular territory and as having certain qualities, characteristics and a reputation, which are associated with that origin. There is currently no uniform international mechanism of protecting GIs, however, the framework for the protection of GIs is provided by Articles 22 to 24 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). Article 23.1 provides a distinct advantage for the protection of wines and spirits as compared to the general protection of Article 22 for all other products. This thesis argues that a uniform system of protection for GIs should be established internationally, and that protection would be to the advantage of developing countries.

The purpose of this study is to determine the best available method (i.e. trademark legislation or *sui generis* legislation) for protecting GIs for agricultural products of developing countries, through analysing the international legal framework governing the protection of GIs and the methods of national protection available as applied in Ethiopia, South Africa and India. The central argument advanced is that the use of trademarks should be a stepping stone, *sui generis* legislation is the ideal. *Sui generis* (separate) legislation should be drafted to fulfil the obligations of TRIPS and to ensure the extended protection, through national legislation, of all goods within other Member States. It is highly unlikely that the TRIPS Member States will agree to the extended protection of the Article 23. Therefore, the most suitable method to achieve such protection would be for Member States to extend their national protection through *sui generis* legislation.

KEY WORDS

Agricultural Products

Appellation of Origin

Bilateral Agreements

Collective Marks

Certification Marks

Developing Countries

Generic Terms

Geographical Indications

Indications of Source

Multilateral System

Trademarks

Sui Generis Legislation



LIST OF ABBREVIATIONS

OAPI	<i>Organisation Africaine de la PropriétéIntellectuelle</i> (English: African Intellectual Property Organisation)
ACP	African, Caribbean and Pacific Group of States
ARIPO	African Regional Intellectual Property Organization
Art	Article
AU	African Union
DFID	Department for International Development
DTI	South African Department of Trade and Industry
EAC	East African Community
EIPO	Ethiopian Intellectual Property Office
EPA	Economic Partnership Agreement
ESA	Eastern and Southern Africa
EU	European Union
FDRE	Federal Democratic Republic of Ethiopia
GI	Geographical Indication
IP	Intellectual Property
LA	Lisbon Agreement for the Protection of Appellations of Origin and their Registration
MA	Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods
ORIGIN	Organization for an International Geographical Indications Network
PAIPO	Pan-African Intellectual Property Organisation
PC	Paris Convention for the Protection of Industrial Property
RSA	Republic of South Africa

SADC	Southern African Development Community
SARC	South African Rooibos Council
TK	Traditional Knowledge
TRIPS	Agreement on Trade-Related Aspects of Intellectual Property Rights
USPTO	United States Patent and Trademark Office
WIPO	World Intellectual Property Organization
WTO	World Trade Organization



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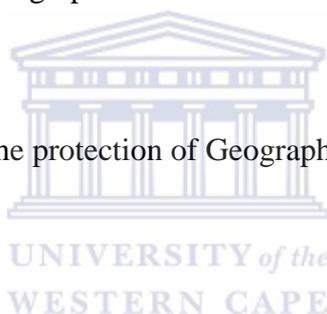
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CHAPTER 1

**BACKGROUND TO THE STUDY AND NATURE OF
GEOGRAPHICAL INDICATIONS**

1.1 BACKGROUND

A geographical indication (GI) is a sign by which a product is identified as having its origin in a particular territory and as having certain qualities, characteristics and a reputation, which are associated with that origin.¹ The protection of GIs evolved under national laws in diverse ways therefore there is no internationally accepted definition for the concept GI. Three main forms of GI may be distinguished: “Geographical Indication” proper, “Indication of source” and “Appellation of Origin”.² The three forms of GIs are closely related however there is a significant difference regarding their legal definition and scope of protection. ‘Geographical Indications’ do not include all ‘indication of source’ by definition. The requirement of a GI is that the product to which the indication is attached needs to originate from the geographical location indicated by it and needs to have a quality, reputation or some other characteristics essentially attributable to that geographical origin. All ‘indications of source’ do not fulfil these additional requirements therefore they do not qualify as a GI. ‘Indications of source’ may be geographical names (such as the name of a city, region or country) which directly indicate the origin of the products which they are attached to. It may also include written or figurative symbols or emblems if it evokes the geographical origin of the product indirectly, e.g. the image of the Taj Mahal. ‘Appellations of origin’ are more restrictive as it must be a geographical

¹ The territory can refer to a town (‘Tequila’ originated from a town Tequila which is located in the States of Jalisco, Mexico) or a region (‘Champagne’ originated from a region in France called Champagne) within a particular country or even a particular country (‘Turkish carpet’ from Turkey); Dogan B & Gokovali U ‘Geographical indications: the aspects of rural development and marketing through the traditional products’ (2012) 62 *Procedia - Social and Behavioural Sciences* 762. ‘Basmati rice’ however is not yet a legal GI is regarded a “mirror image” of a GI due to its standing reputation and quality in the countries where it originated viz. India and Pakistan. Due to its cross-border spread it results in both countries needing to arrive at a joint system of protection. The system of protection is yet to be worked out due to the political sensitiveness between the two countries. Therefore, this case indicates that in determining the geographical area pertaining a GI the political boundary of a country is not always relevant though the inability to determine it may prevent the creation of a GI: Jena P & Grote U ‘Impact Evaluation of traditional Basmati rice Cultivation in Uttarakhand State of northern India: What implications does it hold for Geographical Indications?’ (2012) 40 *World Development* 1896.

² Zografos D *Intellectual Property and Traditional Cultural Expressions* (2010) 175. Traditionally the terminology applied in treaties, administered by the World Intellectual Property Organization (WIPO), in the field of geographical indications distinguished between “indication of source” and “appellations of origin”. Those three treaties are discussed in Chapter 2. The term Geographical Indication for purposes of this thesis presupposes some form of legal protection within various international and/or national frameworks.

name of a locality, region or country which thereby directly indicates the geographical origin of the product to which it is attached. All appellations of origin would qualify as a GI, but not all GIs may be protected as appellations of origin.³

There is currently no uniform international mechanism of protecting GIs, however, the framework for the protection of GIs is provided by Articles 22 to 24 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS).⁴ International harmony demands that there be similar protection in each country to achieve effective international protection of all GIs. Lack of harmony undermines the general objective of TRIPS, namely, establishing a predictable multilateral system of rules to protect Intellectual Property (IP) rights.⁵

The purpose of this study is to determine the best available method for protecting GIs for agricultural products of developing countries, even though most GIs belong to developed countries.⁶ The major problems that developing countries experience in establishing GI protection are the lack of resources and expertise to establish a successful system to fulfil their needs.⁷ This thesis argues that a uniform system of protection for GIs should be established internationally, and that protection would be to the advantage of developing countries. First, the various methods (i.e. trademark legislation and *sui generis* legislation) of protection and their application within some developing countries is discussed, focusing on Ethiopia, South Africa and India.⁸ These two methods of protection and their application are evaluated with the aim of revealing which method is most appropriate to protect the GIs of developing countries.

³ Das K 'Socio-economic Implications of Protecting Geographical Indications in India' available at http://wtocentre.iift.ac.in/papers/Gi_Paper_CWS_August%2009_Revised.pdf (accessed 12 February 2014).

⁴ TRIPS is one of the most important international treaties because it has broad membership, provides detailed rules on enforcement and requires application of minimum standards for protection.

⁵ Caceras E 'International Symposium on Geographical Indications' WIPO/GEO/BEI/07/13 June 22, 2007.

⁶ Forster R 'Rooibos' available at http://www.ens.co.za/news/news_article.aspx?iID=956&iType=4 (accessed 29 August 2013).

⁷ Bramley C 'A review of the socio-economic impact of geographical indications: considerations for the developing world' Paper prepared for the presentation at the WIPO Worldwide Symposium on Geographical Indications June 22-24 2011, Lima, Peru. Available at http://www.wipo.int/edocs/mdocs/geoind/en/wipo_geo_lim_11/wipo_geo_lim_11_9.pdf (accessed 10 August 2014).

⁸ Ethiopia, South Africa and India were chosen because all three countries are developing countries with common law based legal systems. Ethiopia and South Africa contrasts the advantages and disadvantages of implementing trademark legislation to protect GIs against the advantages and disadvantages of using *sui generis* legislation to protect GIs, as in the case of India.

1.2 THE NATURE OF GEOGRAPHICAL INDICATIONS

GIs represents a connection between a geographical area and a product that is produced in the area, and which enables goodwill to accumulate around the GI, allowing for brand development and niche marketing.⁹ The GI, as a form of branding¹⁰, specifically focuses on the names used that are connected to the geographic origin of the particular product.¹¹ Unauthorised use of geographical indications is detrimental to consumers and legitimate producers.¹² GIs and trademarks do coexist in the market place, as goods can be double-branded.¹³

A GI is a generic description which may be used by all traders in a particular geographic location in relation to goods which originate from that location. A trademark is a sign that distinguishes the products of a specific trader from the products of its competitor.¹⁴ Therefore, it is unlikely that a trademark is descriptive and it cannot be generic. All traders from the particular geographical location enjoy the right to protect a GI from wrongful appropriation. On the other hand, trademarks are protected from wrongful appropriation at the suit of the registered proprietor of the trademark.¹⁵ GIs are generally protected and monitored by producer associations from the relevant region. GIs, unlike trademarks, cannot be freely transferred from one user to another because the user needs to have the appropriate association with the geographical region and if there are any particular regional production practices, they must be complied with.¹⁶

⁹ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 210.

¹⁰ Consumers are attracted to buy particular products through the powerful use of branding. A brand is a name, symbol, term or design used to distinguish ones' products/ services from other competitors. Brand image includes the consumers opinions of the brand compared to that of the competitors: Gilaninia S& Mousavian J 'The investigation and analysis impact of brand image in Iran' (2012) 6 *African Journal of Business Management* 7549.

¹¹ Menapace L & Moschini G 'Quality certification by geographical indications, trademarks and firm reputation' (2012) 4 *European Review of Agricultural Economics* 540.

¹² Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 209.

¹³ When a product is double-branded by trademarks and a GI there are usually several producers' that market that kind of product under particular standards, they then use GI or certification mark applicable to the product as well as their own distinct trademarks: International Trademark Association 'Geographical Indications' available at <http://www.inta.org/TrademarkBasics/FactSheets/Pages/GeographicalIndicationsFactSheet.aspx> (accessed 12 September 2013).

¹⁴ Blakeney M *Intellectual Property Rights and Food Security* (2009) 51.

¹⁵ Blakeney M *Intellectual Property Rights and Food Security* (2009) 51.

¹⁶ Blakeney M *Intellectual Property Rights and Food Security* (2009) 52.

1.3 THE IMPORTANCE OF PROTECTING GEOGRAPHICAL INDICATIONS

The function of a GI is to provide information about the attributes of the product that derives from its geographical origin.¹⁷ A GI signals the quality of the product and protects consumers against misrepresentation and free-riding.¹⁸ A successful GI is an asset of the producers authorized to use it, because it can generate goodwill. The lack of protection for GIs would make it difficult for those producers to receive the benefits that are derived from maintaining quality and they would therefore have no incentive to invest in the production of quality goods.¹⁹

The legal protection of GIs is important for cultural and economic purposes. The protection of GIs preserves the traditional/indigenous knowledge (i.e. preserves indigenous products/resources and processes).²⁰ The cultural heritage strengthens the regional identity.²¹ GIs generally have the ability to create value for local communities because the products are often rooted in culture, tradition and geography. GIs are good marketing tools that add economic value to agricultural products through conveying cultural identity by using the region of origin, creating a unique identity for the products, acknowledging the value of natural resources and specific human skills in the production process.²²

GI protection often supports rural development and creates new job opportunities through the production and other related services.²³ The attributes of a product are linked to its particular place of origin through GIs; the association which is created in the consumer's

¹⁷ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 209.

¹⁸ 'Free riding' is an 'act against the ethics of honest commercial activity that misappropriates the reputation of the product'. The investment made in the reputation of the goods are safeguarded against free riders by the protection of GIs through the collective development and improvement process; Hirko SB 'The Legal Protection of Geographical Indications in Ethiopia' (LLM thesis, Munich Intellectual Property Center 2011) 16 available at <http://ssrn.com/abstract=2135428> (accessed 17 June 2014).

¹⁹ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 210.

²⁰ Matthews P 'Increasing revenue in developing nations through intellectual property rights: why a diversified approach to intellectual property protection with a focus on geographical indications is the best method' (2009-2010) 7 *Buffalo Intellectual Property Law Journal* 217.

²¹ Bramley C 'A review of the socio-economic impact of geographical indications: considerations for the developing world' *Paper presented at the WIPO Worldwide Symposium on Geographical Indications June 22-24 2011, Lima, Peru* available at http://www.wipo.int/edocs/mdocs/geoind/en/wipo_geo_lim_11/wipo_geo_lim_11_9.pdf (accessed 10 August 2014).

²² Babcock B.A & Clemens R 'Geographical Indications and Property Rights: Protecting Value-Added Agricultural Products' MATRIC Briefing Paper 04-MBP 7 May 2004 available at <http://www.card.iastate.edu/publications/DBS/PDFfiles/04mbp7.pdf> (accessed 8 August 2014).

²³ European Commission 'Geographical Indications' available at <http://ec.europa.eu/trade/policy/accessing-markets/intellectual-property/geographical-indications/> (accessed 17 February 2014).

mind may add value to the product.²⁴ The ability of GIs to strongly express locality leads to positive rural development. The job opportunities created reduces rural unemployment in the geographical region.²⁵ Goods that are not protected in their country of origin, but which fulfil the requirements of a GI do not enjoy the benefits that such protection could provide, such as: increased income, generating employment and retaining population in certain areas because people will be able to sustain themselves in their local communities.²⁶ Ultimately, the benefits and values of a GI depend on the manner in which it is protected through effective policing, and exploited through good marketing.²⁷

1.4 THE BROAD FRAMEWORK OF PROTECTION IN NATIONAL, REGIONAL AND INTERNATIONAL LAW

1.4.1 The Framework for protection of Geographical Indications in national law

There are four basic approaches to the national legal protection of GIs. First, unfair competition²⁸ and passing-off;²⁹ in order to succeed with one of these claims a claimant must show that the public formed an association or that there was sufficient identification in the mind of the public between the territorial name and the subject good which he/she produces (as distinct from similar goods produced by other persons).³⁰ Secondly, trademark law which is limited to the identification of a particular enterprise or undertaking and not a territory as such.³¹ Countries may, however, use collective and/or

²⁴ Ibele E.W 'The Nature and Functions of Geographical Indications in Law'(2009)10 *The Estey Centre Journal of International Law and Trade Policy* 37.

²⁵ Hirko SB 'The Legal Protection of Geographical Indications in Ethiopia' (LLM thesis, Munich Intellectual Property Center 2011) 18 available at <http://ssrn.com/abstract=2135428> (accessed 17 June 2014).

²⁶ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 211.

²⁷ Zografas D 'Geographical Indications & Socio-Economic Development' *IQsensato Working Paper 3 December 2008* available at <http://ssrn.com/abstract=1628534> (accessed 27 August 2014).

²⁸ Alberts W 'What is unlawful competition?'(2008) August *De Rebus* 57. Unlawful competition refers to the rules that govern the competitiveness between traders. The liability based on unlawful competition is generally accepted to be delictual in nature and therefore the protection is based on *Lex Aquilia*. Competition will be unlawful when the right to goodwill of a competitor is impinged on.

²⁹ Passing-off is based on the injury a business suffers where a competitor makes a false representation that the products come from the same source. *Erven Warnink Besloten Vennootschap and Another v. J. Townend & Sons* 1979 AC 731. A Dutch produced liqueur was imported and sold in England under the name 'Advocaat' which acquired a reputation and goodwill. A similar alcoholic drink manufactured in England which had a different recipe was sold as 'Old English Advocaat'. In this case the court held that the latter drink was passing-off 'Advocaat' as a reputation had been acquired by the name 'Advocaat' with recognizable qualities of taste, appearance, strength and satisfaction. It is not essential that the class be defined by reference to the locality where the goods are produced.

³⁰ Ricupero R *The Resource Book on TRIPS and Development* (2005) 273.

³¹ Ricupero R *The Resource Book on TRIPS and Development* (2005) 273. For example, BMW (Bayerische Motoren Werke AG) does not indicate that the goods come from Bavaria, a state in Germany, but a particular company which has its origins in Bavaria. See para 4.2, *infra*.

certification marks to protect trademark rights to geographical names. Thirdly, appellations of origin and GIs, for the former there needs to be a specific link between some quality or characteristic (including the contribution of human labour) of the goods and the territory.³² There is an international registration system for appellations of origin.³³ Fourthly, administrative schemes, some of which are national regulations which govern labelling and other administrative aspects of production and marketing of products.³⁴

The main national legislation relied upon for the four approaches used to protect GIs, which are based on the international framework for the protection of GIs as provided for in TRIPS, have been classified as a modification of existing trademark laws and *sui generis* (separate) legislation. The majority of countries make use of trademark law.³⁵

1.4.2 The Framework of protection in Regional law for Geographical Indications in Africa

There are two African sub-regional organisations responsible for the management of IP in Africa,³⁶ the African Regional Intellectual Property Organization (ARIPO), and, the African Intellectual Property Organization (OAPI).

ARIPO was established by the Lusaka Agreement, adopted in December 1976. The reasons for establishing ARIPO was to pool resources of its Member States, avoiding duplication of human and financial resources.³⁷ ARIPO has the capacity to process applications for registered trademarks and patents in its Member States who are parties to the Banjul Protocol on Marks and the Harare Protocol on Patents and Industrial Designs, though not all members join both.³⁸ The filing systems under the Protocols coincide with and do not replace the national system of each Member State which acceded and ratified the Protocol. The Banjul Protocol on Marks establishes a trademark filing system. The

³² Ricupero R *The Resource Book on TRIPS and Development* (2005) 276. See para 4.3, *infra*.

³³ Ricupero R *The Resource Book on TRIPS and Development* (2005) 276.

³⁴ Ricupero R *The Resource Book on TRIPS and Development* (2005) 279.

³⁵ Countries which use trademark legislation include: South Africa, Ethiopia, the United States of America, Kenya and Uganda. Blakeney M *Intellectual Property Rights and Food Security* (2009) 199.

³⁶ Mupangavanhu Y *The Regional Integration of African Trade Mark Laws: Challenges and Possibilities* (LLD thesis, University of the Western Cape, 2013) 116.

³⁷ African Regional Intellectual Property Organization 'About us' available at <http://www.aripo.org/index.php/about-aripo> (accessed 19 November 2014).

³⁸ Inventa International 'ARIPO Members: Trademarks, Patents, Industrial Designs, Copyright and Domain Names' available at <http://www.inventa.com/aripo> (accessed 19 November 2014).

Banjul Protocol enables an applicant to file a single application in one of the Banjul Protocol Contracting States or directly with the ARIPO Office and designate the states where the protection of the mark is sought.³⁹ The Protocol does not deal with GIs, only with trademarks.

The African Intellectual Property Organization (OAPI), also known as *Organisation Africaine de la Propriété Intellectuelle* in French, was created in 1977 under the Bangui Agreement which regulates regional trade.⁴⁰ OAPI was created to promote social and economic needs, cooperation among Member States. The protection of GIs are also covered by the OAPI. In order to be protected, the GIs must be registered by the OAPI or be treated as having been registered by virtue of an international convention to which Member States are parties.⁴¹ Member States of OAPI need to ‘renounce’ their national sovereignty to a limited extent in order to adopt a single uniform trade mark law. OAPI practically undertakes all forms of registration and acts as the national office for Member States in order to ensure high levels of expertise and save costs: it therefore, serves as the National Office of Industrial Property and the Central Agency for information and documentation of Intellectual Property in each Member State. The OAPI agreement has the effect of national law in all the Member States and applies directly within the territory of each Member State. Trademark applications can be filed with the Member State, the application containing the filing date must be sent to OAPI. Applications filed with OAPI or office of the Member State is deemed equivalent to a national filing in each Member State.⁴²

³⁹ African Regional Intellectual Property Organization ‘Legal Framework’ available at <http://www.aripo.org/index.php/about-aripo/legal-framework> (accessed 19 November 2014).

⁴⁰ The Bangui Agreement has a specific approach to geographical indications in Chapter VII (Provisions on Geographical Indications). Echols M ‘Geographical Indications for Foods, TRIPS and the Doha Development Agenda’ (2003) 47 *Journal of African Law* 207; Cote d’Ivoire made the following submission to the TRIPS Council: ‘The Agreement creating the African Intellectual Property Organization (AIPO) constitutes the basic text for the protection of intellectual property in the AIPO space. . . . The new standards for the protection of intellectual property rights in the TRIPS Agreement led the member States to review their fundamental law, that is, the Bangui Agreement of 2 March 1977. The revised Agreement was signed at Bangui on 24 February 1999, thus according the AIPO States a new text putting them into conformity with the TRIPS Agreement. But the existence of this new community instrument does not absolve any member country from the obligation to take the pertinent dispositions at the national level’.

⁴¹ Otieno-Odek J ‘The Way ahead - What future for Geographical Indications?’ available at http://www.wipo.int/meetings/en/2005/geo_pmf/presentations/doc/wipo_geo_pmf_05_otieno-odek.doc (accessed 20 February 2015).

⁴² Mupangavanhu Y *The Regional Integration of African Trade Mark Laws: Challenges and Possibilities* (LLD thesis, University of the Western Cape, 2013) 159.

A trademark owner who wishes to ensure protection throughout the African region must file separate applications with OAPI and ARIPO, and the national offices of all other countries not affiliated to the two organisations.⁴³ This administrative burden creates a need for a single regional body for Africa where the application may be centrally filed and examined to ensure the trademark owner has community-wide protection.⁴⁴ There have been proposals to establish Pan-African Intellectual Property Organisation (PAIPO) to assist in the integration of laws and cost-effective streamlining of IP management in Africa.⁴⁵ PAIPO will be a specialised agency of the African Union (AU). The OAPI system is based on the unification of laws and the ARIPO system allows for the harmonisation of laws. Prior to establishing the proposed PAIPO African leaders need to decide which of the two systems is preferred considering effectiveness of each system because it would be difficult to reconcile both systems.⁴⁶

During the first 25 years of PAIPO's existence it is proposed that ARIPO and OAPI should co-exist with PAIPO to gradually shift towards a single IP Organisation. PAIPO should first be harmonised because the countries are at different levels of development and they should be allowed to maintain their national laws.⁴⁷ The three organisations must then become one harmonised system under the AU.

1.4.3 The Framework for protection of Geographical Indications in International law: the Agreement on Trade-Related Aspects of Intellectual Property Rights

TRIPS imposes no obligation to protect a GI that is not protected in its country of origin or which has fallen into disuse in such country.⁴⁸ The choice of protection depends on the legal tradition and economic conditions of the jurisdiction concerned. Irrespective of the

⁴³ The Member States of ARIPO :Botswana, The Gambia, Ghana, Kenya, Lesotho, Malawi, Mozambique, Namibia, Sierra Leone, Liberia, Rwanda, São Tomé and Príncipe, Somalia, Sudan, Swaziland, Tanzania, Uganda, Zambia and Zimbabwe. The Member States of OAPI : Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Comoros, Congo, Côte d'Ivoire, Gabon, Guinea, Equatorial Guinea, Mali, Mauritania, Niger, Guinea Bissau, Senegal and Togo. Ethiopia and South Africa are not members of either.

⁴⁴ Mupangavanhu Y *The Regional Integration of African Trade Mark Laws: Challenges and Possibilities* (LLD thesis, University of the Western Cape, 2013) 22.

⁴⁵ Mupangavanhu Y *The Regional Integration of African Trade Mark Laws: Challenges and Possibilities* (LLD thesis, University of the Western Cape, 2013) 167.

⁴⁶ Mupangavanhu Y *The Regional Integration of African Trade Mark Laws: Challenges and Possibilities* (LLD thesis, University of the Western Cape, 2013) 162.

⁴⁷ Mupangavanhu Y *The Regional Integration of African Trade Mark Laws: Challenges and Possibilities* (LLD thesis, University of the Western Cape, 2013) 166.

⁴⁸ Article 24.9 of TRIPS provides: 'There shall be no obligation under this Agreement to protect geographical indications which are not or cease to be protected in their country of origin, or which have fallen into disuse in that country'.

form of domestic protection, any country wishing to protect its own GI abroad needs to comply with the laws and regulations of each country where the protection is sought because there is no true international protection for GIs. Substantial resources and sophisticated expertise are, therefore, necessary to acquire rights over different legal systems.⁴⁹

Article 22.1 of TRIPS contains a definition of a geographical origin.⁵⁰ A GI must relate to or identify a particular “territory” which may include a country, province or locality, from which the goods must originate.⁵¹ There needs to be a relationship between the reputation the goods enjoy (perceptions the public may have which influences the public’s purchasing), quality (objective properties of the goods) or other characteristics, and the originating territory.⁵²

Article 23.1 provides a distinct advantage for the protection of wines and spirits as compared to the general protection of Article 22.⁵³ An action for the infringement of the former requires the proof of neither any unfair commercial practice nor that the public has been misled.⁵⁴ This study will focus on the protection provided for agricultural products and not on the additional protection provided for wines and spirits, as most GIs for wines and spirits are in the hands of developed countries.⁵⁵ Developed countries have more influence on the multilateral system, their interests seem to be more adequately protected.

⁴⁹ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 226.

⁵⁰ Article 22.1 of the TRIPS Agreement provides: ‘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’.

⁵¹ Ricupero R *The Resource Book on TRIPS and Development* (2005) 305. A term is used as a common designation of a kind of product is not a GI as it does not indicate the place of origin of that product: it is generic. The determination of whether a sign is generic often depends on the particular country where the term is used. When a term no longer functions as a geographical indication in a certain country it may refuse to recognise or protect such term as a geographical indication. An example of a generic term is ‘Cologne’, it was produced in the region of Cologne but the term now denotes a certain type of perfumed toilet water regardless of where it was produced. http://www.wipo.int/geo_indications/en/about.html (accessed on 10 September 2013).

⁵² Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 219.

⁵³ Article 23.1 of TRIPS provides: ‘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’.

⁵⁴ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 232.

⁵⁵ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 235. Members of the TRIPS Agreement are mandated in terms of Art 23.4 to undertake negotiations to establish a ‘multilateral system of notification and registration’ for wines, but it does not set out the specific standards. Members may

1.5 CHAPTER OUTLINE

Chapter one undertook a preliminary analysis of the concept of GIs, the framework of its protection and the methods of national protection available to developing countries. The importance of a supreme IP court and regional organisations to manage IP in Africa are discussed with particular reference to ARIPO, OAPI and the proposed PAIPO.

Chapter two explores the scope of protection afforded by the following international conventions relating to GIs prior to TRIPS: the Paris Convention for the protection of Industrial Property, the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods and the Lisbon Agreement for the Protection of Appellations of Origin. The shortcomings of each convention which led to the creation of TRIPS are discussed.

Chapter three provides a detailed analysis of TRIPS as the legal framework for the protection of GIs and other relevant bilateral and multilateral agreements to secure the protection of GIs. The following articles of TRIPS are discussed: Article 22 which relates to the general protection afforded to GIs and Article 23 relates to the additional protection of GIs for wines and spirits.

Chapter four provides a critical assessment of the two methods used to nationally protect GIs, namely: trademark legislation and *sui generis* (separate) legislation. First, the application of trademark legislation to protect coffee in Ethiopia and Rooibos tea in South Africa are discussed. Secondly, *sui generis* legislation with reference to protecting Darjeeling tea in India is also discussed. The differences and obstacles to each method are set out in this chapter.

Chapter five is the concluding chapter which draws together the findings of all preceding chapters.

decide to opt out and not participate in the 'multilateral system'; Article 23.4 of TRIPS provides: 'In order to facilitate the protection of geographical indications for wines, negotiations shall be undertaken in the Council for TRIPS concerning the 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 INTERNATIONAL FRAMEWORK FOR THE PROTECTION OF GEOGRAPHICAL INDICATIONS PRIOR TO THE AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS

2.1 INTRODUCTION

Three multilateral agreements provided the primary international framework for the recognition and protection of geographical indications:⁵⁶ the Paris Convention for the Protection of Industrial Property⁵⁷, the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods,⁵⁸ and the Lisbon Agreement for the Protection of Appellations of Origin⁵⁹.

The World Intellectual Property Organization (WIPO), which is a United Nations agency, administered the international conventions and agreements on intellectual property law prior to TRIPS.⁶⁰ The negotiating parties decided to include provisions for the protection of Geographical Indications (GIs) in TRIPS because the frameworks of the previous agreements failed to provide sufficient protection of GIs.⁶¹ The earlier Agreements also had few members, whereas TRIPS has a broad membership as all the Member States of the World Trade Organization (WTO) are parties to TRIPS.⁶²

The scope of protection afforded geographical indications (GIs) by the three pre-TRIPS international conventions mentioned is now discussed.

⁵⁶ A multilateral agreement is agreements to which there are three or more parties.

⁵⁷ This agreement was concluded in 1883. It was revised at Brussels on 14 December 1900, at Washington on June 1911, at The Hague on 6 November 1925, at London on 2 June 1934, at Lisbon on 31 October 1958, and at Stockholm on 14 July 1967, and as amended on 28 September 1979.

⁵⁸ This agreement was concluded in 1891. It was revised at Washington in 1911, at The Hague in 1925, at London in 1934, at Lisbon in 1958 and at Stockholm in 1967.

⁵⁹ This agreement was concluded in 1958. It was revised at Stockholm in 1967, and amended in 1979.

⁶⁰ Wayne V 'Assessing Multilateral vs. Bilateral Agreements and Geographical Indications through International food and wine' (2005) 14 *Currents International Trade Law Journal* 57.

⁶¹ The TRIPS Agreement became effective on 1 January 1995. It sets out the minimum standards of protection.

⁶² The TRIPS Agreement is discussed in Chapter 3 below.

2.2 THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY

The Paris Convention (PC) was the first multilateral agreement to include ‘indications of source or appellations of origin’ as objects to be protected by national industrial laws.⁶³ Article 1 of the PC sets out that ‘indications of source or appellations of origin’ should be protected but fails to define them.⁶⁴ The PC provides for the protection of geographical indications, trademarks and other indications of source against misleading use.⁶⁵

Article 10(1) provides for the seizure of goods bearing false indications of their source or the identity of the producer upon importation into countries that are parties to the PC, or within the country of importation, or within the country where the unlawful affixation of the indications of source had occurred.⁶⁶ Article 9 of the PC is applied in the cases mentioned in Article 10(1).⁶⁷ The right to prevent such imports, mentioned in Article 10(1), is accorded to the persons mentioned in Article 10(2).⁶⁸



⁶³ Blakeney M, Coulet T, Mengistie G & Mahop MT *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 9.

⁶⁴ WIPO has defined these two concepts as follows: ‘‘indication of source’ means any expression or sign used to indicate that a product or service originates in a country, a region or a specific place, whereas ‘ appellation of origin’ means the geographical name of a country, region or specific place which serves to designate a product originating therein the characteristic qualities of which are due exclusively or essentially to the geographical environment, including natural or human factors or both natural and human factors’’. World Intellectual Property Organization (WIPO) ‘Recent Developments at the International Level in the field of trademarks’ available at http://www.wipo.int/edocs/mdocs/sme/en/wipo_wasme_ipr_ge_03/wipo_wasme_ipr_ge_03_2.pdf(access ed 5 April 2014).

⁶⁵ Evans G & Blakeney M ‘The international protection of geographical indications yesterday, today and tomorrow’ in Westkamp G *Emerging issues in Intellectual Property: Trade, Technology and Market Freedom: Essays in Honour of Herschel Smith* (2007) 266.

⁶⁶ Evans G & Blakeney M ‘The international protection of geographical indications yesterday, today and tomorrow’ in Westkamp G *Emerging issues in Intellectual Property: Trade, Technology and Market Freedom: Essays in Honour of Herschel Smith* (2007) 266; Article 10(1) of the Paris Conventions provides: ‘The provisions of (Article 9) shall apply in cases of direct or indirect use of a false indication of the source of the goods or the identity of the producer, manufacturer or merchant’.

⁶⁷ Article 9 of the PC provides that goods which bears a false indication of source is subject to seizure upon importation into the countries party to the PC, or within the country where the unlawful affixation of the indication of source had occurred, or within the country of importation.

⁶⁸ Blakeney M, Coulet T, Mengistie G & Mahop MT *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 10; Article 10(2) of the Paris Convention: ‘[Any] producer, manufacturer, or merchant whether a natural person or legal entity, engaged in the production or manufacture of or trade in such goods and established either in the locality falsely indicated as the source , or in the region where such locality is situated , or in the country falsely indicated, or in the country where the false indication of source is used, shall in any case be deemed an interested party’.

Article 10*bis* provides for the protection against misleading or false indications of source to repress unfair competition.⁶⁹ The acts that amount to unfair competition and the basic international standard for protection against acts of unfair competition are set out in Article 10*bis*.⁷⁰ The use of false indications of source may be seen as an act of competition contrary to honest practices in commercial or industrial matters and liable to mislead the public.⁷¹

The protection under Article 10 provides for indications of source but makes no special provision for the protection of appellations of origin. Article 9, 10 and 10*ter* have, however, been interpreted as also applying to appellations of origin as the appellation of origin, by definition constitutes an indication of source under the PC.⁷² Appellations of origin requires the characteristics or qualities to be due exclusively or essentially to the geographical environment and GIs requires that the ‘quality, reputation or other characteristic of the good be essentially attributable to its geographical origin’. Therefore, ‘appellations of origin’ and ‘geographical indications’ both require a nexus between the quality and the geographical environment, which indications of source lacks under the PC. The PC thus provides protection for identifying features of goods which would not necessarily qualify as a GI as defined in TRIPS.⁷³

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⁶⁹ Acts of unfair competition include those acts which create confusion, or allegations, the use that are liable to mislead the public in the course of trade, regarding the nature, the characteristics, manufacturing process, or quantity, the suitability for their purpose, of goods: Blakeney M, Coulet T, Mengistie G & Mahop MT *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 10. Article 10*bis* of the Paris Convention: Unfair Competition Prevention reads:

- ‘(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.’

⁷⁰ This is specifically incorporated to protect GIs under Article 22.2(b) of TRIPS: Blakeney M, Coulet T, Mengistie G & Mahop MT *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 10. See para 3.2 on the discussion of Article 22 of TRIPS.

⁷¹ Evans G & Blakeney M ‘The international protection of geographical indications yesterday, today and tomorrow’ in Westkamp G *Emerging issues in Intellectual Property: Trade, Technology and Market Freedom: Essays in Honour of Herschel Smith* (2007) 267.

⁷² Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 214.

⁷³ See para 3.2, *supra*.

The use of false geographical indications was prohibited under the Paris Convention in its original form. The PC failed to define the conditions of protection.⁷⁴ Many PC signatory nations proposed a more comprehensive form of regulation for what they considered a significant intellectual property abuse. The result of the proposal was the Madrid Agreement (MA) for the Repression of False or Deceptive Indications of Source of Goods.⁷⁵

2.3 THE MADRID AGREEMENT FOR THE REPRESSION OF FALSE OR DECEPTIVE INDICATIONS OF SOURCE OF GOODS

The MA operates within the framework of the Paris Union and is aimed at repressing false and deceptive indications of source.⁷⁶ The MA provides a limited extension of Article 10 of the PC which addresses ‘false’ indications of source as well as ‘deceptive’ indications. The addition of ‘deceptive indications’ was aimed at addressing the practice of a geographical name being accompanied by a qualifier or disclaimer (e.g. ‘California Chablis’ or ‘California Burgundy’) when this combination-indication might cause consumer confusion.⁷⁷

Article 1 and 2 of the MA sets out the manner and cases in which seizure or a similar measures may be requested and carried out.⁷⁸ The courts of each country decide which appellations do not fall within the provisions of the MA because of their generic character. According to Article 1, any product must be seized upon importation into any States party to this Agreement if the product bears a deceptive or false indication and one of the States party to it or a place situated in one of the State parties is directly or indirectly indicated as the country or the place of origin.⁷⁹ An indication of source that is literally true may in

⁷⁴ Evans G & Blakeney M ‘The international protection of geographical indications yesterday, today and tomorrow’ in Westkamp G *Emerging issues in Intellectual Property: Trade, Technology and Market Freedom: Essays in Honour of Herschel Smith* (2007) 267.

⁷⁵ Blakeney M, Coulet T, Mengistie G & Mahop MT *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 10.

⁷⁶ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 215.

⁷⁷ Ricupero R *The Resource Book on TRIPS and Development* (2005) 272.

⁷⁸ The main method of enforcement is seizure as provided for in Article 1 of the Madrid Agreement. Private parties are not allowed to request the measures directly, but may apply through a public prosecutor or a competent authority if the States party to the Agreement provides for it. Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 215.

⁷⁹ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 215. Article 1(1) of the Madrid Agreement provides: ‘All goods bearing a false or deceptive indication by which one of the countries to which this Agreement applied, or a place situated therein, is directly or indirectly indicated as being the country of origin shall be seized on importation into any of the said countries’. Article 2(1) of the Madrid Agreement provides: ‘(1) Seizure shall take place at the instance of the customs authorities, who shall immediately inform the interested party, whether an individual person or a legal entity, in order that

certain cases still be deceptive or misleading. One situation in which this occurs is when a geographical name exists in two or more different countries, but it was only used as an indication of source for the products originating from the place mentioned in only one country.⁸⁰

The MA has 30 Member States and its obligations bind only WTO Members that are party to the MA.⁸¹ Subsequent attempts to use the MA to establish a higher level of protection for GIs, failed to receive the support of significant trading nations.⁸² A major problem with the MA was that nations were unable to exempt from its operation geographical indications that became generic within their borders.⁸³

2.4 LISBON AGREEMENT FOR THE PROTECTION OF APPELLATIONS OF ORIGIN AND THEIR REGISTRATION

The Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (LA) was adopted in 1958.⁸⁴ Appellations of Origin, protected under the Lisbon Agreement, are indications in respect of products that possess special features of quality and characteristics attributable to their geographical origin.⁸⁵ There are three important elements in the definition of appellations of origin under the Agreement:

Firstly, the appellation has to be the geographical *name* of a country, region, or locality, which therefore excludes *indirect* geographical indications.

Secondly, the appellation of origin has to designate a product that actually does originate in the country, region or locality referred to.

such party may, if he so desires, take appropriate steps in connection with the seizure effected as a conservatory measure. However, the public prosecutor or any other competent authority may demand seizure either at the request of the injured party or ex officio; the procedure shall then follow its normal course’.

⁸⁰ Evans G & Blakeney M ‘The international protection of geographical indications yesterday, today and tomorrow’ in Westkamp G *Emerging issues in Intellectual Property: Trade, Technology and Market Freedom: Essays in Honour of Herschel Smith* (2007) 267.

⁸¹ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 215.

⁸² Evans G & Blakeney M ‘The international protection of geographical indications yesterday, today and tomorrow’ in Westkamp G *Emerging issues in Intellectual Property: Trade, Technology and Market Freedom: Essays in Honour of Herschel Smith* (2007) 267. The significant trading nations which failed to support the MA include Germany, Italy and the United States of America. Blakeney M, Coulet T, Mengistie G & Mahop MT *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 10.

⁸³ Blakeney M, Coulet T, Mengistie G & Mahop MT *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 10.

⁸⁴ Ricupero R *The Resource Book on TRIPS and Development* (2005) 273.

⁸⁵ The LA provides in that Agreement, ‘ “appellation of origin” means the geographical name of a country, region, or locality which serves to designate a product originated therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors (Article2(1)).’

Finally, the ‘quality and characteristics’ needs to be due essentially or exclusively to the geographical environment.⁸⁶

The appellation of origin is only protected where the characteristics and quality of a product are ‘due exclusively or essentially to the geographical environment, including natural and human factors’, the wording of which is adopted from the French definition of appellation of origin.⁸⁷

The registration of appellation of origin which are ‘recognized and protected as such, in their country of origin’ at the International Bureau of WIPO are provided for under the Agreement.⁸⁸ The International Register of Appellations of Origin is kept by the International Bureau which formally notifies the other Contracting States of the registrations. The list of registered appellations of origin is published in the Lisbon system's official bulletin ‘Appellations of Origin’. An internationally registered appellation of origin has a broader scope of protection than that enjoyed by indications of source provided under the Paris Convention and the Madrid Agreement. The LA provides that once an appellation of origin is internationally registered and the one-year objection period has expired under Article 5(3), third parties can no longer or cannot commence use of the appellation.⁸⁹

An appellation of origin must be protected and registered as an appellation of origin in the country of origin and registered at the International Bureau of WIPO.⁹⁰ The LA provides that countries party to the Agreement undertake to protect on their territories the appellation of origin of other countries parties to the LA, recognized and protected as such in the country of origin and registered at the WIPO.⁹¹ The scope of protection the Lisbon Agreement affords extends beyond the literally registered geographical name, as provided

⁸⁶ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 216.

⁸⁷ Blakeney M, Coulet T, Mengistie G & Mahop MT *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 11.

⁸⁸ Article 1(2) of the Lisbon Agreement.

⁸⁹ Evans G & Blakeney M ‘The international protection of geographical indications yesterday, today and tomorrow’ in Westkamp G *Emerging issues in Intellectual Property: Trade, Technology and Market Freedom: Essays in Honour of Herschel Smith* (2007) 268.

⁹⁰ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 216.

⁹¹ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 216

for in Article 3.⁹² Indications of source are provided with stronger protection under the Lisbon Agreement than the Madrid Agreement; although it is only applicable to a special kind of indication of source namely the appellations of origin.⁹³

Countries are free to adopt their own system of designating appellations, by either administrative or judicial decision, or both. The geographical indication is protected in other member nations once it is registered.⁹⁴ There is an onus on the Member State to ensure that there is a legal prohibition in their law for any kind of imitation or usurpation. No appellation that has been granted protection may be deemed generic in any other country for the duration of its protection in its country of origin as an appellation of origin.⁹⁵ No exceptions were made for geographic indications already generic in Member States.⁹⁶ It does not suffice for a country involved to protect its appellations of origin under a general law.⁹⁷

The registration system of the Lisbon Agreement is only available to a small number of geographical indications.⁹⁸ The Lisbon Agreement failed to receive broad international support because of the highly protectionist nature.⁹⁹ The Lisbon Agreement has been largely ignored in the debates of the implementation of Article 23 of TRIPS because only a limited number of countries ratified it.¹⁰⁰

⁹² This is provided for in Article 3 which reads: 'Protection shall be ensured against any usurpation or imitation, even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as 'kind', 'type', 'make', 'imitation', or the 'like'.'

⁹³ Evans G & Blakeney M 'The international protection of geographical indications yesterday, today and tomorrow' in Westkamp G *Emerging issues in Intellectual Property: Trade, Technology and Market Freedom: Essays in Honour of Herschel Smith* (2007) 268. According to Article 5 of the Lisbon Agreement members need to prohibit the use of registered geographic indicators despite the fact that the label discloses the true place of origin of the product or clearly indicates that the indicator is false.

⁹⁴ Blakeney M, Coulet T, Mengistie G & Mahop MT *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 11.

⁹⁵ Article 6 of the Lisbon Agreement.

⁹⁶ Blakeney M, Coulet T, Mengistie G & Mahop MT *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 11.

⁹⁷ Each appellation needs to benefit from express or distinct protection from a specific official or administrative act to ensure that the specific elements of protection such as, the lawful users of the appellation, geographical area, and the nature of the product linked to the given quality, are determined.

Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 216.

⁹⁸ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 216.

⁹⁹ Evans G & Blakeney M 'The international protection of geographical indications yesterday, today and tomorrow' in Westkamp G *Emerging issues in Intellectual Property: Trade, Technology and Market Freedom: Essays in Honour of Herschel Smith* (2007) 269. See the discussion on Article 5(3) of the LA relating to the 'highly protectionist nature' in para 2.4, *supra*.

¹⁰⁰ Blakeney M, Coulet T, Mengistie G & Mahop MT *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 11. The contracting parties of the Lisbon Agreement are: Algeria, Bosnia and Herzegovina, Bulgaria, Burkina Faso, Congo, Costa Rica, Cuba, Czech Republic, Democratic People's Republic of Korea, France, Gabon, Georgia, Greece, Haiti,

The criticism of the Lisbon Agreement was that it was confined to those countries which protect appellations of origin ‘as such’, therefore countries which used consumer protection laws and unfair competition to protect this form of intellectual property were excluded from the protection. The other criticism was that the agreement did not make any exception for GIs that have become generic in Member States.¹⁰¹ The Register of appellation of origin under the Agreement, administered by WIPO, has been suggested as a convenient solution to the establishment of the multilateral register foreseen in Article 23 of TRIPS.¹⁰²

2.5 CONCLUSIONS

The PC introduced protection for ‘appellations of origin’ and ‘indications of source’; however, it fails to define both terms and only regulates the latter. The use of false indications of source is prohibited under the PC, with the emphasis on border measures which includes barring the entry of imports or seizure by customs authorities.¹⁰³

The MA thereafter extended the scope of protection that Article 10 of the PC initially provided for the indications of source by addressing ‘false’ indications of source as well as ‘deceptive’ indications. The MA, however, failed to gain the support of significant trading nations.

The appellation of origin is developed as a separate category of intellectual property under the Lisbon Agreement that recognizes both human and natural factors. An appellation must possess special features of quality and characteristics attributable to their geographical origin: these requirements were lacking under the protection of indications of source provided under the PC and the MA. The Lisbon Agreement establishes an international registration system for appellations of origin; they must be registered in the country of origin and the International Bureau of WIPO.¹⁰⁴ Internationally registered appellations of origin have a broader scope of protection than that enjoyed by indications

Hungary, Iran (Islamic Republic of), Israel, Italy, Mexico, Montenegro, Morocco, Nicaragua, Peru, Portugal, Republic of Moldova, Romania and Serbia.

¹⁰¹ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 216.

¹⁰² Blakeney M, Coulet T, Mengistie G & Mahop MT *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 12.

¹⁰³ See para 2.2, *supra*.

¹⁰⁴ Gangjee D *Relocating the Law of Geographical Indications* (2012) 22.

of source provided under the Paris Convention and the Madrid Agreement.¹⁰⁵ The geographical indication is then protected in other Member nations once it is registered. Due to the high protectionist nature of the Lisbon Agreement under Article 5(3), it failed to receive broad international support.

The three multilateral agreements prior to TRIPS gradually improved the framework of protection for GIs, but the protection they provided was still not sufficient.

The following chapter analyses the protection of GIs under the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS).



¹⁰⁵ Evans G & Blakeney M 'The international protection of geographical indications yesterday, today and tomorrow' in Westkamp G *Emerging issues in Intellectual Property: Trade, Technology and Market Freedom: Essays in Honour of Herschel Smith* (2007) 268.

THE AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS AND THE PROTECTION OF GEOGRAPHICAL INDICATIONS

3.1 INTRODUCTION

The need for TRIPS can be explained as having been due to the failure of the previous three multilateral agreements to provide a sufficient framework to protect intellectual property rights and their lack of international support.¹⁰⁶ The obligations created by TRIPS, the most comprehensive multilateral agreement on intellectual property rights, apply equally to all WTO Member countries, but developing countries had more time to phase them in.¹⁰⁷ The provisions which deal specifically with GIs are Article 22 and 23. Article 22 deals with the general protection afforded to geographical indications and Article 23 relates to the additional protection of geographical indications for wines and spirits. The exceptions to the obligations under Article 22 and 23 are contained in Article 24, the latter is beyond the scope of this paper.¹⁰⁸

In this chapter the framework of protection for GIs under Article 22-23 of TRIPS and bilateral agreements for the protection of GIs is discussed.¹⁰⁹

¹⁰⁶ The Paris Convention for the protection of Industrial Property, the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods, and the Lisbon Agreement for the Protection of Appellations of Origin which were discussed in Chapter 2.

¹⁰⁷ In respect of GIs developing countries had until January 1, 2000 to comply with the TRIPS standards and the least-developed countries until January 1, 2006.

¹⁰⁸ The following exceptions are relevant for the discussion in this paper: when a particular term has become generic for describing the product in question Members are not obliged to bring the geographical indication under protection (Article 24.6); measures to implement the provisions will not prejudice prior trademark rights that had been acquired in good faith (Article 24.5); there is no obligation in terms of Article 24.9 to protect a GI that is not protected in the country of origin or which has fallen into disuse in such country; World Trade Organization, available at http://www.wto.org/english/tratop_e/trips_e/intel2_e.htm (accessed 19 July 2014).

¹⁰⁹ The TRIPS Agreement which is a minimum standards agreement became effective on 1 January 1995. It sets out the minimum standards of protection for GIs.

3.2 THE GENERAL MECHANISM FOR THE PROTECTION OF GEOGRAPHICAL INDICATIONS: ARTICLE 22

Article 22.1 defines the concept of geographical indication.¹¹⁰ The features of the definition as provided under Article 22.1 are now discussed.

First, the protection afforded under Article 22 only applies to goods (not services) but without any limitation on the nature of those goods.¹¹¹ Secondly, the sign needs to 'identify' the good as 'originating' from the specific territory in order to qualify as a GI. Many suppliers may use the same indication, which is in contrast with trademarks where the products of one enterprise need to be distinguished from the products of other enterprises. Thirdly, the GI needs to relate to a particular 'territory' without any political limitation. Therefore, the territory may include a country, province or a smaller locality. The protection afforded by TRIPS is not limited to the name of a territory but extends to images (called indirect indications) which do not name the territory but evokes it.¹¹² Fourthly, the goods must originate (i.e. be mined, grown or manufactured there) from the identified territory.¹¹³ A GI may, therefore, not be licensed or assigned to producers established in another territory; but part of the work may be done outside the designated territory.¹¹⁴

Finally, there must be a relationship established between the goods' reputation, quality or other characteristics and the originating territory. The Member State where protection is sought bears the onus of determining whether this relationship exists.¹¹⁵ The quality, reputation or other characteristics must be 'essentially' attributable to its geographic origin and not necessarily exclusively.¹¹⁶ A presumption that there exists a relationship between

¹¹⁰ Article 22.1 of the TRIPS Agreement provides: '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'; Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 221. The definition resembles that contained in the Lisbon Agreement but it adds 'reputation' as one of the conditions, which need to be met for an indication to attract protection under TRIPS.

¹¹¹ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 217.

¹¹² Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 219.

¹¹³ The term 'originating' is flexible in that some portion of the work that was involved when the goods were created may take place outside the territory without undermining the 'originating' character. There may however be dispute regarding the extent of the flexibility; Ricupero R *The Resource Book on TRIPS and Development* (2005) 290.

¹¹⁴ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 219.

¹¹⁵ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 219.

¹¹⁶ 'Essentially' implies that the production of the goods may partially occur outside the 'territory'. Not exclusively within the designated territory; Correa CM *Trade Related Aspects of Intellectual Property*

the reputation, quality, or other characteristics and the geographical origin is not automatically created when the GI is used;¹¹⁷ it has to be proven according to the law where protection is sought. No provision is made in TRIPS obliging a Member State to protect a GI merely because it is protected in another Member State.¹¹⁸

Article 22.2 sets out the basic standard of protection for geographical indications.¹¹⁹ Various modes of protecting GIs nationally and internationally have been developed. First, protection against acts of ‘passing-off’, which is a misrepresentation of one’s business goods or services as those of another’s, to the injury of the latter. Secondly, protection against acts of unfair competition, as provided under Article 10*bis* of the Paris Convention, which have been committed with the use of geographical indications.¹²⁰ Thirdly, protection against the use of the indication, which misleads the public or is deceptive, as provided in the Madrid Agreement and Article 22.2(a) of TRIPS.¹²¹ Fourthly, ‘absolute’ protection against the use by non-authorized parties whether the public may be misled or not as provided for in the Lisbon Agreement and Article 23 of TRIPS (only for wines and spirits). This *sui generis* protection is based on an administrative or public act.¹²² Fifthly, protection as a certification or collective mark, registered by a private entity or government. Finally, there is protection against ‘false’ use of an indication when the true origin of the product is not indicated.¹²³

Rights (2007) 219. ‘Essentially’ is ‘indispensable or fundamental element or thing’; Concise Oxford Dictionary 329.

¹¹⁷ ‘Reputation’ refers to the perceptions which may influence the decision to purchase by the public, whether or not it is related to measurable qualitative properties. It may be built upon consistent advertising efforts. Whereas ‘quality’, on the other hand, refers to the objective properties of the goods; Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 219. ‘Quality’ is a ‘degree of excellence, relative nature or kind or character’, Concise Oxford Dictionary (1982: Oxford University Press, 7ed) 843. ‘Other characteristics’ may include taste, design, texture, appearance etc of the goods and the absence of elements consumers deem undesirable. A GI is perceived rather than created in contrast to trademarks; Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 220.

¹¹⁸ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 220.

¹¹⁹ Article 22.2 of the TRIPS Agreement provides: ‘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)’.

¹²⁰ This is provided under Article 10*bis* of the Paris Convention.

¹²¹ Gervais D *The TRIPS Agreement: Drafting History and Analysis* (2008) 300.

¹²² Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 221.

¹²³ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 222.

The protection afforded under Article 22.2 for GIs may be enforced by ‘interested parties’. Members need to determine who these parties may be.¹²⁴ Protection of a GI may entail: the right to prevent the use of GIs by unauthorised persons for products by way of legislation, which do not originate from the indicated geographical place; the right to prevent a GI from becoming a generic expression (dealt with in the Lisbon Agreement).¹²⁵

TRIPS determines the acts that have to be prevented but the Member States have leeway to determine the ‘legal means’ to protect GIs.¹²⁶ The legal means may include measures, such as administrative registration of GIs, unfair competition, certification marks, and other means available under certain legal systems (such as passing-off). Article 22.2 of TRIPS permits the protection as a GI of non-geographical names and pictorial or graphical representations, which evoke geographical origin. No true international protection exists for GI hence irrespective of the domestic form of protection any country which wishes to protect its own GIs abroad must comply with the regulations and laws of each country where the protection is sought. Therefore, the acquisition of rights over GIs in foreign countries requires sophisticated expertise and substantial resources. Some countries prescribe formal applications and registration of the indication, but other countries do not.¹²⁷

The protection under Article 22.2(a) is against indications, which mislead the public as to the ‘true place of origin’ of the product.¹²⁸ TRIPS does not specify the conditions under which a product will be considered to truly originate from a particular location. The facts of the particular situation would indicate whether the public was misled by the use of the GI. The determining factor is whether it misleads the public or not therefore, the use of identical or similar indication is not necessarily sufficient.¹²⁹

Generally the decision about the extent the public is deceived is made by the courts. The difference between the Article 22.2(a) of TRIPS and Article 10bis of the PC is that Article

¹²⁴ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 223. ‘Interested parties’ may extend beyond governmental authorities to persons with rights in the GI or may be limited to the collective or organization; Ricupero R *The Resource Book on TRIPS and Development* (2005) 290.

¹²⁵ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 226.

¹²⁶ See Article 22.

¹²⁷ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 226.

¹²⁸ The ‘public’ may include the general consumer with limited knowledge about the origin of the products or it may be understood as a specialized group of consumers who purchases the products in question on a regular basis; Ricupero R *The Resource Book on TRIPS and Development* (2005) 292.

¹²⁹ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 228.

22.2(a) refers to misleading indications as to the ‘geographical origin’ of the good, and Article 10bis suggests specification regarding ‘the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods’ which is absent in Article 22.2(a).¹³⁰ Cases where the public is actually misled are or may be inferred from Article 22.2(a) in the quote ‘in a manner which misleads ...’ and the potential misleading effects is included by the language used in the PC by ‘...is liable to mislead’. Article 22.2(b), through Article 10bis, therefore, incorporates a broader basis of protection than that which is deemed to be allowed under Article 22.2 (a).¹³¹

Article 22.3 addresses the tension between geographical indications and trademarks, which consists of or contains a geographical indication.¹³² The protection of the GI prevails in the case of conflict provided the following conditions are met. First, the trademark consists of or contains a GI.¹³³ This only applies when the trademarked sign is also a GI as defined in TRIPS and not merely, because a territory is designated. Secondly, the designated territory is not where the goods originate. Finally, it must be established that ‘the use of the indication in the trademark for such goods in that Member is of such nature as to mislead the public as to the true place of origin’ has been proven.¹³⁴ The protection in favour of the geographical indication is subject to the determination that the use of the indication as a trademark is able to mislead the public with specific regard to the ‘true origin’ of the goods and is not absolute.

The probability of the public being confused is, however, a sufficient ground for applying this provision.¹³⁵ A Member State is not prevented from registering trademarks consisting of or containing geographical indications if they are used with regard to goods that originate from the designated territory.¹³⁶

¹³⁰Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 229. A general frame of the doctrine of unfair competition is established in the Paris Convention of which the rules are found in all legal systems but legislated and implemented in different ways; Ricupero R *The Resource Book on TRIPS and Development* (2005) 293.

¹³¹Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 229.

¹³²Article 22.3 of the TRIPS Agreement provides: ‘A Member shall, *ex officio* if its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in that Member is of such a nature as to mislead the public as to the true place of origin’.

¹³³Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 230.

¹³⁴Article 22.3 of TRIPS.

¹³⁵Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 230.

¹³⁶Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 231.

Article 22.4¹³⁷ addresses the use of ‘homonymous’ geographical indications.¹³⁸ The use of such indications is prevented even though it is literally true regarding the territory, region or locality where the goods originate provided it falsely represents to the public that the goods originate in another territory.¹³⁹ The corresponding GI is used to take advantage of the reputation the other has built up.¹⁴⁰ There is consequently no absolute ban on the use of ‘homonymous’ geographical indications; they are only banned when it is proven that the public believes that the goods originate in another territory. The competent authority of the Member where protection is sought has the exclusive right to determine whether the use of the designation misleads or deceives the public or constitutes an act of unfair competition.¹⁴¹

3.3 ADDITIONAL PROTECTION OF GEOGRAPHICAL INDICATIONS FOR WINES AND SPIRITS: ARTICLE 23

‘Absolute’ or enhanced protection for geographical indications relating to wines¹⁴² and spirits¹⁴³ relating to geographical indications is allowed under Article 23.¹⁴⁴ The advantage of the protection Article 23 provides for wines and spirits, over Article 22 which relates to other products is that it does not require the proof of any unfair commercial practices or proof that the public has been misled. Any entities or persons may be prevented from using the corresponding denomination if they do not produce within the territory alluded

¹³⁷ Article 22.4 of the TRIPS Agreement provides: ‘The protection under paragraph 1,2 and 3 shall be applicable against a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory’.

¹³⁸ Homonymous means ‘when two or more words having the same spelling or pronunciation but different meanings and origins (e.g. pole and pole)’. A pole may be defined as: a square or linear rod; or a long rounded slender piece of wood or metal typically used with one end placed in the ground as a support for something ; <http://www.oxforddictionaries.com/definition/english/homonym> (accessed on 28 April 2014).

¹³⁹ An example of the conflict is in the case of ‘Champagne’, which is a well- known French designation but is also used by producers in the Swiss locality of Champagne; Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 231

¹⁴⁰ Ricupero R *The Resource Book on TRIPS and Development* (2005) 295.

¹⁴¹ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 231.

¹⁴² ‘Wines’ may include beverages derived from grapes and other alcoholic beverages, such as fruit and rice wines; Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 232.

¹⁴³ The concept of ‘spirits’ is not entirely clear because some beverages with low alcohol content may not be included in the concept, it may therefore only be limited to beverages with a higher alcohol content.; Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 232.

¹⁴⁴ Article 23.1 of TRIPS provides: ‘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’.

by the geographical indication.¹⁴⁵ This protection greatly facilitates the enforcement of rights despite the fact that right-holders still face substantial costs of litigation. Another advantage of this level of protection is that it would permit WTO Members *ex officio* action against false indications of origin therefore reducing costs of protection in foreign markets.¹⁴⁶

Members are required under Article 23.1 to provide legal means for interested parties to prevent the use of GIs identifying wines and spirits for interested parties. It merely sets out the objective of the measures and not how it has to be achieved, which allows Members to determine the nature of the measures.¹⁴⁷ Article 23.1 precludes the potential cure by labelling. Neither the use of the terms ‘kind’, ‘type’, ‘style’, ‘imitation’ or ‘the like’ nor an accompanying indication of the true origin of the good in conjunction with the GI, is acceptable as a cure for the use of the indication under Article 23.¹⁴⁸

This protection means that ‘homonymous’ indications are prohibited and that there is no need to prove that the public has been misled by the use of the indication. The protection afforded under Article 23.1 does not apply to similar indications as covered under Article 22(2): the protection only applies to the use of *identical* indications.¹⁴⁹ Proof that the public is or may be misled is not needed for GIs protected under Article 23, however compliance with the conditions in Article 22.1 may be disputed and the party seeking protection might need to provide proof.¹⁵⁰

Article 23.2 governs the relationship between GIs for wines and spirits and trademarks, which contain such GIs.¹⁵¹ Members are only obliged to act *ex officio* if their domestic law provides for the possibility, however they are obliged to provide ‘interested parties’ an opportunity to request such invalidation or refusal of the trademarks. There is also

¹⁴⁵ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 232.

¹⁴⁶ *Ex officio* means ‘from the office’ which describe someone who has a right due to the office he/she holds; Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 232. An example of an *ex officio* action under Article 23.2 may be an action to revoke trademarks that consist of GIs; Ricupero R *The Resource Book on TRIPS and Development* (2005) 299.

¹⁴⁷ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 232.

¹⁴⁸ Ricupero R *The Resource Book on TRIPS and Development* (2005) 296.

¹⁴⁹ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 233.

¹⁵⁰ Ricupero R *The Resource Book on TRIPS and Development* (2005) 297.

¹⁵¹ Article 23.2 of TRIPS provides: ‘The registration of a trademark for wines which contain or consist of a geographical indication identifying wines or spirits which contain or consist of a geographical indication identifying spirits shall be refused or invalidated, *ex officio* if a Member’s legislation so permits or at the request of an interested party, which respect to such wines or spirits not having this origin’.

protection under Article 23.2 for foreign or domestic GIs for wines and spirits against use as trademarks. Producers within the territory where the wines or spirits originate are not prevented from applying for and owning trademarks that consist of or contain the respective indications. The difference between this provision and that of Article 22.3 is that in the case of wines and spirits one does not need to prove the trademarks are of the nature to mislead the public.¹⁵²

Article 23.3, which addresses the same issues as Article 22.4, places an additional obligation on Members when the products concerned are wines.¹⁵³ The Members are bound to ‘determine the practical conditions under which the homonymous indications in question will be differentiated from each other’.¹⁵⁴ An example is those situations where two different geographic regions *bona fide* use the same name for a type of wine.¹⁵⁵ The conditions need to be determined on a case-by-case basis and the adopted conditions need to be sufficient to differentiate the goods from the different origin. The conditions adopted need to be sufficient to differentiate the goods from different origin.¹⁵⁶ Article 23.3 provides for two criteria to determine the conditions: the consumers are not misled,¹⁵⁷ and the producers concerned are treated equally.¹⁵⁸ The latter requirement that relates to ‘equitable treatment’ clarifies that none of the parties in the conflict has any right to prevail over the other. The Member where the dispute about the ‘homonymous’ indication arises has to determine the conditions under which there is sufficient differentiation.¹⁵⁹

¹⁵² Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 234.

¹⁵³ Article 23.3 of TRIPS provides: ‘In the case of homonymous geographical indications for wines, protection shall be accorded to each indication, subject to the provisions of paragraph 4 of Article 22. Each Member shall determine the practical conditions under which the homonymous indications in question will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled’. Article 23.3 (homonymous indications) only applies to wines, there is no reference to spirits in Article 23.3.

¹⁵⁴ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 234.

¹⁵⁵ Ricupero R *The Resource Book on TRIPS and Development* (2005) 298.

¹⁵⁶ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 234.

¹⁵⁷ It could require that the country of origin is stated on the label in a specific way and the system adopted need to clearly inform the consumer; Ricupero R *The Resource Book on TRIPS and Development* (2005) 298.

¹⁵⁸ The fact that some producers in a particular territory used a designation for a longer period than producers in another territory would not give the former an advantage above the latter; Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 235.

¹⁵⁹ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 235.

Members are required under Article 23.4 of TRIPS to undertake negotiations to establish a ‘multilateral system of notification and registration’ for wines.¹⁶⁰ The specific standard of protection is not set out. Some members may decide not to participate in the system. The proposed system has caused much controversy. Despite the fact that Article 23.4 only refers to ‘wines’ some Members sought to develop a system including ‘spirits’.¹⁶¹

3.4 BILATERAL AGREEMENTS FOR THE PROTECTION OF GEOGRAPHICAL INDICATIONS

There has been no concrete progress on extending absolute protection to all products under the multilateral negotiations of TRIPS, therefore due to the lack of progress there has been a surge in the number of bilateral negotiations. Bilateral agreements complement the multilateral system, some of them ensuring a higher level of protection for GIs than the multilateral agreements.¹⁶² The parties involved in a bilateral agreement, those parties who sign the bilateral agreement, decide which GIs will be included in the agreement. GIs are generally protected in the mutual recognition between two or more states for the protection of their domestic GIs in the contracting states. Once a GI in a bilateral agreement is registered in the country of origin, the foreign country does not evaluate the existence of the criterion for the validity of the GI. Therefore, each party accepts the other party’s examinations as sufficient for their own domestic market. It contrasts with the approach of international protection for GIs under TRIPS in which GIs are defined and producers directly apply for the protection of their GIs in each foreign country.¹⁶³

The trend of using bilateral agreements, therefore, places complete reliance on the domestic evaluation for the protection of GIs. The list of GIs evolves according to the countries party to the bilateral agreement. Bilateral agreements may also prohibit the use of the other party’s GI which does not have the origin indicated by the GI or it may

¹⁶⁰Article 23.4 of TRIPS provides: ‘In order to facilitate the protection of geographical indications for wines, negotiations shall be undertaken in the Council for TRIPS concerning the establishment of a multilateral system of notification and registration of geographical indications for wines eligible for protection in those Members participating in the system’.

¹⁶¹Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 235.

¹⁶²Bilateral Agreements are concluded between two or more countries to increase the protection of the GIs of those countries among themselves. Regional Trade Agreements are agreements between countries that are geographically in proximity with one another: Fiorentino R.V, Verdeja L & Toqueboeuf C ‘The Changing Landscape of Regional Trade Agreements: 2006 Update’ available at http://www.wto.org/english/res_e/booksp_e/discussion_papers12a_e.pdf (accessed 5 April 2014).

¹⁶³Vivas-Eugui D & Spennemann C ‘The treatment of Geographical Indications in recent WTO discussions and in regional and bilateral agreements’ available at <http://www.ictsd.org/downloads/2009/01/gis20dv2020cs20rev2020sa20dialogue-pdf.pdf> (accessed 19 November 2014).

provide for extraterritorial applications of the other country's national law to protect the GIs.¹⁶⁴ Bilateral agreements could provide a way to overcome difficulties that relate to the operation of GIs under different national systems of protection in order to ensure effective protection of listed GIs.

The EU is one of the biggest trading partners of developing countries, in particularly the trade of agricultural products. The EU and the African, Caribbean and Pacific Group of States (ACP) are currently negotiating Economic Partnerships Agreements (EPAs).¹⁶⁵ These trade negotiations contain a chapter of Intellectual Property Rights (IPR), including GIs. There is a risk of imbalance because the EU lists dozens of GIs and other developing countries have few.¹⁶⁶

3.5 CONCLUSIONS

TRIPS is the most comprehensive multilateral agreement on IPRs. Article 22 of TRIPS contains the framework for the general protection of GIs and Article 23 the additional protection of GIs for wines and spirits.

Article 22 defines the concept of a GI, which previous multilateral agreements failed to do, and it sets out the basic standard of protection for GIs. The definition of GIs under Article 22 is restricted to goods (excluding services) which are identified as 'originating' from the specific identified territory. Although the goods need to originate from the identified territory, part of the work in preparing for the market may still be done outside the designated territory. This is a minimum standard for the protection of GIs, however

¹⁶⁴ SCT/6/3, The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, Sixth Session, Geneva, March 12 to 16, 2001, *Document prepared by the International Bureau*, available at http://www.wipo.int/edocs/mdocs/sct/en/sct_6/sct_6_3.pdf (accessed 27 November 2014).

¹⁶⁵ A group of countries in African, Caribbean and the Pacific forms the African, Caribbean and Pacific Group of States (ACP), which aims to reach sustainable development and poverty reduction within its member states. The African ACP countries negotiate in five Economic Partnership Agreements groups with the EU. The ACP groups are: Eastern and Southern Africa (ESA), Southern African Development Community (SADC), East African Community (EAC), West Africa, and CEMAC. Ethiopia is part of ESA and SA is part of SADC. European Commission 'Political and economic relations' available at http://eeas.europa.eu/delegations/ethiopia/eu_ethiopia/political_relations/index_en.htm (accessed 19 November 2014). EPAs are trade and development agreements negotiated between ACP regions and the EU engaged in a regional economic integration process. EPAs are 'tailor-made' to suit specific regional circumstances. European Commission 'Economic partnerships' <http://ec.europa.eu/trade/policy/countries-and-regions/development/economic-partnerships/> (accessed 19 November 2014).

¹⁶⁶ The EPA between the EU and SADC relating to South Africa's GIs, in particular rooibos tea, is discussed in chapter 4. See also para 2.2., *supra* for the discussion of the EU-SADC Economic Partnership Agreement.

countries may implement more restrictive national legislation.¹⁶⁷ There must be a relationship between the good's reputation, quality or other characteristics and the originating territory. The quality, reputation or other characteristics must be 'essentially' attributable to its geographic origin. Article 22.2 sets out the basic standard of protection for GIs but it remains the responsibility of each Member State to implement national legislation to protect their local GIs.¹⁶⁸

The advantage of the protection Article 23 provides for wines and spirits, over Article 22 relating to other products is that it does not require the proof of any unfair commercial practices or proof that the public has been misled. Producers of goods, which merely have general protection under Article 22 of TRIPS bear the burden of the 'misleading test': that the public has been misled as to the geographic origin of the goods. There is no such burden on a producer (plaintiff) under Article 23 which, therefore, provides absolute protection. The 'misleading test' leads to legal uncertainty at an international level, because the national courts and administrative authorities need to decide whether a particular GI has misled the public and decisions may differ from country to country. According to Article 23 neither the use of the terms 'kind', 'type', 'style', 'imitation' or 'the like' nor an accompanying indication of the true origin of the good in conjunction with the GI, is acceptable as a cure for the use of the indication.¹⁶⁹

There have been many proposals to extend the protection that Article 23 affords on an international level to all goods, however these attempts were unsuccessful. The bargaining power and political influence of the developed world makes it highly unlikely that TRIPS will afford absolute level of protection to all goods (including agricultural goods) on an international scale. The absolute protection under Article 23 allows for an increase in investments and gain in market power.¹⁷⁰

Bilateral agreements complement the multilateral system, some of them ensuring a higher level of protection for GIs than TRIPS. This could provide a way to overcome the

¹⁶⁷ See para 4.1.2 on India's discussion of the defining GIs under their *sui generis* national legislation, *supra*.

¹⁶⁸ The main national legislation relied upon have been classified as a modification of existing trademark \ laws and *sui generis* (separate) legislation, discussed in more detail in Chapter 4.

¹⁶⁹ See para 3.3, *supra*.

¹⁷⁰ Lang A 'On the need to expand Article 23 of the TRIPS Agreement' (2006) 16 *Duke Journal of Comparative & International Law* 500.

difficulties of protecting GIs under different national systems. No true international protection exists for GIs hence irrespective of the domestic form of protection any country that wishes to protect its own GIs abroad must comply with the regulations and laws of each country where the protection is sought; however, under many a bilateral agreement the foreign country does not need to ascertain the validity of a GI registered in the country of origin who is part of the agreement. TRIPS provisions should therefore be supplemented by bilateral agreements to suit the specific circumstances of particular trading nations.¹⁷¹

The next chapter discusses the national protection of GIs in three developing countries to determine which system of protection should be used universally, first, Ethiopia's and South Africa's protection through trademark legislation and, secondly, India's protection through *sui generis* legislation.

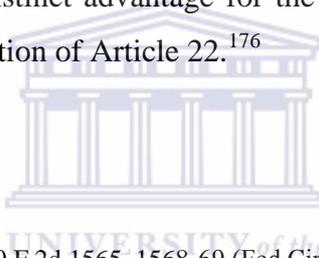


¹⁷¹ See para 3.4, *supra*.

THE NATIONAL PROTECTION OF GEOGRAPHICAL INDICATIONS IN DEVELOPING COUNTRIES

4.1. INTRODUCTION

TRIPS is part of the international framework for the protection of GIs which came subsequent to the advent of the national protection of GIs. TRIPS sets out the framework for the minimum standard of protection for GIs which Member States should provide, and despite its importance, national protection still has the principal impact because of the territoriality principle.¹⁷² TRIPS imposes no obligation on Member States to protect a GI that is not protected in its country of origin or which has fallen into disuse in that country.¹⁷³ The two important provisions in TRIPS regarding GIs are:¹⁷⁴ Article 22.1 that defines geographical indications and provides for the general protection of GIs,¹⁷⁵ and Article 23.1 that provides a distinct advantage for the protection of wines and spirits as compared to the general protection of Article 22.¹⁷⁶



¹⁷² *Person's Co, Ltd v Christman*, 900 F.2d 1565, 1568-69 (Fed Cir 1990) : 'The concept of territoriality is basic to trademark law; trademark rights exist in each country solely according to that country's statutory scheme'.

¹⁷³ Article 24.9 of TRIPS provides: 'There shall be no obligation under this Agreement to protect geographical indications which are not or cease to be protected in their country of origin, or which have fallen into disuse in that country'.

¹⁷⁴ These were discussed in Chapter 3 above.

¹⁷⁵ Article 22.1 of the TRIPS provides: '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'.

¹⁷⁶ Article 23.1 of TRIPS provides: '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'. An action for the infringement of the wines or spirits requires the proof of neither any unfair commercial practice nor that the public has been misled: Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 232. Members of the TRIPS Agreement are mandated in terms of Art 23.4 to undertake negotiations to establish a 'multilateral system of notification and registration' for wines, but it does not set out the specific standards. Members may decide to opt out and not participate in the 'multilateral system'. Article 23.4 of TRIPS provides: 'In order to facilitate the protection of geographical indications for wines, negotiations shall be undertaken in the Council for TRIPS concerning the establishment of a multilateral system of notification and registration of geographical indications for wines eligible for protection in those Members participating in the system'; Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 235.

TRIPS leaves it up to each Member State to determine the appropriate method of implementing its provisions within the Member State's own legal framework.¹⁷⁷ The choice of protection in the country of origin depends on the legal tradition and economic conditions of the jurisdiction concerned.¹⁷⁸

The main forms of national legislation relied upon to protect GIs are the modification of existing trademark laws and *sui generis* (separate) legislation. The European Union (EU), France and India have used the latter.¹⁷⁹ The majority of countries make use of trademark law.¹⁸⁰ Trademark legislation was initially relied on to protect GIs, and the protection of GIs through *sui generis* legislation developed later.

This chapter discusses both forms of protection using three countries as examples, first, Ethiopia's and South Africa's protection through trademark legislation and, secondly, India's protection through *sui generis* legislation.

4.2. TRADEMARK PROTECTION OF GEOGRAPHICAL INDICATIONS

A trademark is a sign that distinguishes the products of a specific trader from the products of its competitor;¹⁸¹ therefore, it is unlikely that a trademark is descriptive and it cannot be generic.¹⁸² Consumers use trademarks to identify goods that meet their needs or wants;

¹⁷⁷ Despite their general opposition to the TRIPS Agreement, some developing countries (such as Brazil and India) now view GIs as the best available means to protect their Traditional Knowledge (TK) at the Doha Developing Round (The Doha Developing Round is a new series of World Trade Organization negotiations launched in Doha, Qatar in November 2001 in order to redefine the rules of international trade. The Doha Round provides developing countries with an opportunity to negotiate provisions, which cater for their particular circumstances).

¹⁷⁸ World Intellectual Property Organization 'Geographical Indications' available at http://www.wipo.int/geo_indications/en/ (accessed 20 August 2014).

¹⁷⁹ The EU has long contended that GIs are the preferred method of protection for agricultural goods that originate from a specific region. It requested the development of a multilateral registry for GIs in 2003 as well as the extension of absolute legal protection to all GIs; O'Kicki M 'Lessons Learned from Ethiopia's Trademarking and Licensing Initiative: is the European Union's position on Geographical Indications really beneficial for developing nations?' (2008-2009) 6 *Loyola University Chicago International Law Review* 313. 'Absolute' or enhanced protection for geographical indications relating to wines and spirits is allowed under Article 23. The advantage of the protection Article 23 provides for wines and spirits, over Article 22 relating to other products is that it does not require the proof of any unfair commercial practices or proof that the public has been misled. Any entities or persons may be prevented from using the corresponding denomination if they do not produce within the territory alluded by the geographical indication. Neither the use of the terms 'kind', 'type', 'style', 'imitation' or 'the like' nor an accompanying indication of the true origin of the good in conjunction with the GI, is acceptable as a cure for the use of the indication ;See para 3.3, *supra*.

¹⁸⁰ Blakeney M *Intellectual Property Rights and Food Security* (2009) 199.

¹⁸¹ Blakeney M, Coulet T, Mengistie G & Mahop MT *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 9.

¹⁸² Blakeney M, Coulet T, Mengistie G & Mahop MT *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 9.

trademarks provide manufacturers and distributors with an incentive to meet the reasonable product quality expectations of their consumers. The use of trademarks, therefore, encourages trademark owners to maintain standards of quality for their goods and services sold or supplied under the marks.¹⁸³

Intellectual property rights are territorial in nature; therefore one country's trademarks are not automatically valid in another country.¹⁸⁴ The territorial nature of the trademark, therefore, results in the trademark owner having to establish its rights afresh in every country in which they wish to enjoy protection.¹⁸⁵ The receiving country, i.e. the country in which the product is marketed, might merely accept the originating country's determination that the definition under TRIPS is met without any examination. The alternative is that the receiving country examines the product according to its national standards to determine whether the definition of TRIPS has been met.

There are special types of registered trademarks, such as collective and certification marks.¹⁸⁶ The difference between 'ordinary' trademarks and the special types of trademarks are that the former distinguishes the goods and services of one particular trader (a single trade source) from those of other traders.

A collective mark is a trademark that 'may be registered by an association whose members may use it if they comply with the requirements fixed in the regulations concerning the use of the collective mark'.¹⁸⁷ A person or an enterprise that uses a collective mark may also use another trademark in addition to the collective mark to identify the particular goods, which it produces, and places on the market. The owner of a collective mark, i.e. the

¹⁸³ Blakeney M *Intellectual Property Rights and Food Security* (2009) 47.

¹⁸⁴ Article 15.1 of the TRIPS Agreement provides that: 'any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of another undertakings, shall be capable of constituting a trademark'. See Blakeney M, Coulet T, Mengistie G & Mahop MT *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 9.

¹⁸⁵ The owner of a trademark is an individual person or legal entity (i.e. a firm).

¹⁸⁶ Trademarks are broadly divided into two categories namely registered trademarks and common law (unregistered) trademarks. A trademark may enjoy protection either under trademark legislation (Trade Marks Act 194 of 1993 as in the case of South Africa) or under the common law. The proprietor may choose to register the trademark or not to register it. In the event that the proprietor chooses not to register it the protection will be restricted to common law, more specifically an action based on unlawful competition or passing-off; Klopper H, Pistorius T, Rutherford B, Tong L, Van der Spuy P & Van der Merwe A *Law of Intellectual Property in South Africa* (2011) 75.

¹⁸⁷ Blakeney M *Intellectual Property Rights and Food Security* (2009) 49.

association which registers it, does not render services or sell its own goods, but promotes the goods and services of the members.¹⁸⁸

A certification mark may only be used in accordance with defined standards.¹⁸⁹ The standards are defined by the owner of the certification mark.¹⁹⁰ The main difference between a collective mark and a certification mark is that the collective mark may only be used by members of particular enterprises (e.g. an association that owns the collective mark), whereas any individual, whether or not he or she is a member of an association, that complies with the defined standards may use a certification mark. The owner of a certification mark needs to be the representative (individual or organization) for the products to which the certification mark is applied.¹⁹¹ The use of a certification mark is not confined to a particular membership. The system of registered certification marks departs from the general trademark principle that one cannot obtain an exclusive right in geographic names, which other traders may legitimately wish to use in trade. The EU, therefore, prefers that such marks be registered as GIs.¹⁹²

Ethiopia's use of its trademark system to protect its coffee as a GI is now discussed, followed by an examination of South Africa's protection of its Rooibos tea.

4.2.1 Trademark protection of some Ethiopian coffees

The Federal Republic of Ethiopia is one of the world's largest producers of coffee. Coffee is the major source of Ethiopia's export earnings and it provides many employment opportunities.¹⁹³ Ethiopia does not have any *sui generis* GI law; GIs are protected under the Trademark Registration and Protection Proclamation, No 501/2006 (hereafter called

¹⁸⁸ International Symposium on Geographical Indications, WIPO/GEO/BEI/07/9, 14 June 2007 available at <http://www.wipo.int/tools/en/gsearch.html?cx=016458537594905406506%3Ahmturfvzzq&cof=FORID%3A11&q=International+Symposium+on+Geographical+Indications%2C+WIPO%2FGEO%2FBEI%2F07%2F9%2C+14+June+2007>. (accessed 15 July 2014).

¹⁸⁹ A certification mark is used to certify the origin or nature of goods or services to which it has been applied. It can also certify the provision of services or manufacture by members of a union or other organizations to certain defined standards; International Trademark Association 'Certification Marks' available at <http://www.inta.org/TrademarkBasics/FactSheets/Pages/CertificationMarks.aspx> (accessed 07 November 2013).

¹⁹⁰ World Intellectual Property Organization 'Certification Marks' available at http://www.wipo.int/sme/en/ip_business/collective_marks/certification_marks.htm (accessed 08 October 2014).

¹⁹¹ Blakeney M *Intellectual Property Rights and Food Security* (2009) 49.

¹⁹² Blakeney M *Intellectual Property Rights and Food Security* (2009) 50.

¹⁹³ Blakeney, Coulet & Mengistie et al *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 151.

the Ethiopian Trademark Proclamation) as collective marks.¹⁹⁴ The trademarks Sidamo, Harrar, Harar and Yirgacheffe are now registered to the Ethiopian Government, not to the producers of the Ethiopian coffee bearing those trademarks.¹⁹⁵ These Ethiopian trademarks are owned by a government entity: the Ethiopian government decides to whom licenses will be granted because all the land in Ethiopia is owned by the Government.¹⁹⁶

The Ethiopian Intellectual Property Office (EIPO) is the principal IP institution and the office carries out administrative functions including registration of trademarks.¹⁹⁷ The EIPO made applications in 34 countries between 2005 and 2007 for the registration of three coffee designations as trademarks: Harar/Harrar, Sidamo and Yirgacheffe.¹⁹⁸

The Stakeholders Committee decided that three coffee brands, namely, Yirgacheffe, Sidamo and Harar be protected as trademarks in major coffee import destinations and countries seen as potential future markets.¹⁹⁹ The process of obtaining trademarks for Ethiopian coffee was, however, not without incident. Starbucks in the US applied to register 'Shirkina Sun-Dried Sidamo' as a trademark in 2004 but Ethiopia requested it to withdraw the application to allow Ethiopia's own trademark application, of the names

¹⁹⁴ Blakeney, Coulet, Mengistie & Mahop *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 59. The Ethiopian Government launched the Ethiopian Coffee Trademarking and Licensing Initiative in 2004 run by the Ethiopian Fine Coffee Stakeholder Committee, comprising of private exporters cooperative with the Ethiopian Intellectual Property Office (EIPO) and other government bodies. The Ethiopian Fine Coffee Stakeholders Committee decided to use trademark law to protect its brands and determined a list of countries where the trademark applications should be made; World Intellectual Property Organization 'The Coffee War: Ethiopia and the Starbucks Story' <http://www.wipo.int/ipadvantage/en/details.jsp?id=2621> (accessed 20 August 2013). The Ethiopian trademark system is registration-based. Hirko SB 'The Legal Protection of Geographical Indications in Ethiopia' (Munich Intellectual Property Center 2011) 36 available at <http://ssrn.com/abstract=2135428> (accessed 17 June 2014).

¹⁹⁵ Matthews P 'Increasing revenue in developing nations through intellectual property rights: why a diversified approach to intellectual property protection with a focus on geographical indications is the best method' (2009-2010) 7 *Buffalo Intellectual Property Law Journal* 217.

¹⁹⁶ Matthews P 'Increasing revenue in developing nations through intellectual property rights: why a diversified approach to intellectual property protection with a focus on geographical indications is the best method' (2009-2010) 7 *Buffalo Intellectual Property Law Journal* 217. The Constitution of the Federal Democratic Republic of Ethiopia (FDRE) unequivocally states that land shall not be individual's property. 'The right to ownership of rural land and urban land, as well as of all natural resources is exclusively vested in the state and the peoples of Ethiopia. Land is a common property of the nations, nationalities and peoples of Ethiopia.' The government owns all land in Ethiopia (including the land on which the coffee is grown) thus it has primary control over the land use.

¹⁹⁷ Hirko SB 'The Legal Protection of Geographical Indications in Ethiopia' (Munich Intellectual Property Center 2011) 41 available at <http://ssrn.com/abstract=2135428> (accessed 17 June 2014).

¹⁹⁸ Johnson DZ 'The International Intellectual Property Scholars Series: Using Intellectual Property Rights to Create Value in the Coffee Industry' (2012) 16 *Marquette Intellectual Property Law Review* 303.

¹⁹⁹ The Stakeholders Committee consists of private coffee exporters association, leaders of coffee producers, cooperative unions, and representatives of the relevant governmental organizations; Blakeney, Coulet, Mengistie & Mahop *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 156.

Hara and Sidamo, to proceed,²⁰⁰ which it did in 2006.²⁰¹ The government of Ethiopia filed successful trademark applications with the United States Patent and Trademark Office (“USPTO”) for three of Ethiopia’s coffees. All twenty-six member countries of the EU have also registered the Ethiopian trademarks.²⁰² The trademarks prevent other countries from receiving any benefits from the products that originated in Ethiopia and which had the goodwill.²⁰³ The provisions of the Ethiopian Trademark Proclamation that are used for the protection of GIs will now be discussed.

4.2.1.1 The Ethiopian Trade Mark Proclamation

The Ethiopian Trademark Proclamation regulates collective and ordinary trademarks.²⁰⁴ Article 2(12) of the Proclamation defines a trademark as ‘any visible sign capable of distinguishing goods or services of one person from those of other persons; it includes words, designs, letters, numerals, colours or the shape of goods or their packaging or the combinations thereof’. This thesis will focus on the protection of GIs as collective trademarks under Ethiopian legislation.

The definition of a GI may be included in that of a collective trademark under Art.2 (1) of the Ethiopian Trademark Proclamation which provides:

“a trademark distinguishing the goods or services of members of an association, which is the owner of the trademark, from those of other undertakings”.

A collective trademark is, therefore, by definition owned by an association. The term ‘geographical indication’ is not mentioned explicitly in the definition of collective

²⁰⁰ Rotstein F ‘A Teaching Case for WIPO by Intellectual Research Institute of Australia (IPRA)’ http://www.wipo.int/export/sites/www/academy/en/about/global_network/educational_materials/cs4_sid_amo.pdf (accessed 11 February 2014). Once Starbucks attained a trademark certification it would receive the following benefits: possible trademark registration in foreign countries, nationwide notice of its trademark ownership, exclusive use of the trademarked name; DePass D ‘Starbucks vs. Ethiopia : Corporate Strategy and Ethical Sourcing in the Coffee Industry’ available at <https://nationalethicscenter.org/resources/906/download/Starbucks.pdf> (accessed 17 June 2014).

²⁰¹ O’Kicki M ‘Lessons Learned from Ethiopia’s Trademarking and Licensing Initiative: is the European Union’s position on Geographical Indications really beneficial for developing nations?’ (2008-2009) 6 *Loyola University Chicago International Law Review* 330.

²⁰² O’Kicki M ‘Lessons Learned from Ethiopia’s Trademarking and Licensing Initiative: is the European Union’s position on Geographical Indications really beneficial for developing nations?’ (2008-2009) 6 *Loyola University Chicago International Law Review* 312.

²⁰³ ‘Goodwill’ inherent in a trademark may be a valuable intangible property asset that belongs to the trademark owner. The trademark owner is allowed to prevent unauthorised uses of the trademark which may diminish the value of the mark; Blakeney M *Intellectual Property Rights and Food Security* (2009) 47.

²⁰⁴ The Proclamation makes no mention of certification marks. There is no certification mark system in Ethiopia; Hirko SB ‘The Legal Protection of Geographical Indications in Ethiopia’ (Munich Intellectual Property Center 2011) 56 available at <http://ssrn.com/abstract=2135428> (accessed 17 June 2014).

trademarks, but it is arguably implied.²⁰⁵ Once a GI is registered as a collective trademark at the EIPO, the collective trademark will be renewed every seven years at the office upon the application of the owner.

The definition of the collective trademark under the Trademark Proclamation is not appropriate for most GIs for a number of reasons:

First, the link required under TRIPS between the geographical origin and the “essential attributes” is lacking under the definition of a trademark: the definition should be amended because it merely serves the function of ordinary trademarks in a collective manner: an association owns the collective trademark and is used collectively by its members. Secondly, the requirement of distinctiveness for trademarks in effect excludes most GIs,²⁰⁶ which primarily designate geographical origin,²⁰⁷ because most geographical names describe localities. Descriptive names are, therefore, excluded under the Ethiopian Trademark Proclamation despite their capacity to serve as a GI under TRIPS:²⁰⁸ GI protection as collective trademarks is, therefore, not positively authorized under the current trademark law.²⁰⁹

GIs are only protected indirectly once they are protected as collective trademarks through the prohibition of registering other trademarks that mislead the public as to the true geographical origin of the goods.²¹⁰ Terms that are on the face of it descriptive terms will not qualify for registration without proof of distinctiveness. Article 6(1)(h) of the Ethiopian Trademark Proclamation states that a trademark may not be registered if it

²⁰⁵ The definition of collective trademarks under the Proclamation partly includes collective trademarks that serve as GIs because GIs are not limited to geographical names (i.e. the name of a town, region or country) under TRIPS; Hirko SB ‘The Legal Protection of Geographical Indications in Ethiopia’ (Munich Intellectual Property Center 2011) 27 available at <http://ssrn.com/abstract=2135428> (accessed 17 June 2014).

²⁰⁶ ‘Any visible sign’ may qualify for registration as a trademark if it possesses a distinctive character for registration; Hirko SB ‘The Legal Protection of Geographical Indications in Ethiopia’ (Munich Intellectual Property Center 2011) 27 available at <http://ssrn.com/abstract=2135428> (accessed 17 June 2014).

²⁰⁷ Geographical origin refers to a designated place (e.g. country, region or town), whereas trademark refers to the person under whose auspices the goods are placed on the market in that jurisdiction.

²⁰⁸ Hirko SB ‘The Legal Protection of Geographical Indications in Ethiopia’ (Munich Intellectual Property Centre 2011) 28 available at <http://ssrn.com/abstract=2135428> (accessed 17 June 2014).

²⁰⁹ Hirko SB ‘The Legal Protection of Geographical Indications in Ethiopia’ (Munich Intellectual Property Center 2011) 31 available at <http://ssrn.com/abstract=2135428> (accessed 17 June 2014).

²¹⁰ Hirko SB ‘The Legal Protection of Geographical Indications in Ethiopia’ (Munich Intellectual Property Center 2011) 31 available at <http://ssrn.com/abstract=2135428> (accessed 17 June 2014).

misleads the public, with particular reference to the geographical origin of the goods.²¹¹ The legislation does not make provision for the additional protection which wines and spirits enjoy under the TRIPS. The protection of Ethiopian coffee, therefore, falls short of the level of protection required by TRIPS, which in any event does not bind Ethiopia at present.²¹²

4.2.1.2 The reasons Ethiopia chose trademark legislation to protect GIs

The Ethiopian Government launched the Ethiopian Coffee Trademarking and Licensing Initiative (herein after called the Initiative) in 2004 in an effort to bridge the divide between the amount farmers are paid when they sell their coffee beans and the amount that retailers charge when the coffee is sold in other countries.²¹³ The aim was also to protect the fine coffee brands through trademarks.²¹⁴ The Initiative had preliminary funding from the UK's Department for International Development (DFID) and to date receives pro bono legal services from a US based law firm and assistance from a non-profit IP organization.²¹⁵ The DFID funded the first phase of the Initiative, Ethiopia sought to obtain trademarks worldwide for 12 heritage coffees, but did not support the second phase (ensuring sustainability). The Initiative therefore lacked a contingency plan in the event that funding was discontinued. The failure of the DFID to continue with the funding was partly mitigated by the contributions of the stakeholders, government, and other parties to the Initiative. A sustainable source of funding is still a problem.²¹⁶

On the face of it, it may seem that registering three brands of Ethiopian coffee as a GIs is the best option, however, there are unique circumstances surrounding the coffee

²¹¹ Article 6(1)(h) of the Trademark Proclamation states that.... 'a trademark that is likely to mislead the public or the business community, in particular as regards the geographical origin of the goods or services concerned, or their nature or characteristics'. The language of the 'misleading test' in the Ethiopian Trademark Proclamation is similar to that of Article 10bis (3) of the Paris Convention which defines the act of unfair competition.

²¹² Ethiopia is not a Member of the WTO. Only once Ethiopia accedes to the WTO it will be bound by TRIPS.

²¹³ The Initiative is organized by the Ethiopian Fine Coffee Stakeholder Committee which comprises of the EIPO, private exporters and other concerned government bodies ;World Intellectual Property Organization 'The Coffee War: Ethiopia and the Starbucks Story' available at <http://www.wipo.int/ipadvantage/en/details.jsp?id=2621> (accessed 17 June 2014).

²¹⁴ Blakeney, Coulet , Mengistie & Mahop *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 155.

²¹⁵ O'Kicki M 'Lessons Learned from Ethiopia's Trademarking and Licensing Initiative: is the European Union's position on Geographical Indications really beneficial for developing nations?'(2008-2009) 6 *Loyola University Chicago International Law Review* 329.

²¹⁶ Blakeney, Coulet, Mengistie & Mahop *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 167.

production in Ethiopia that may make GI registration less suitable.²¹⁷ Ethiopia is one of the world's poorest countries.²¹⁸ Ethiopia opted to use its resources on developing crops, the reputation of the products and building partnerships with the coffee distributors.²¹⁹ The general director of the EIPO stated that setting up a certification system would have been too expensive and impractical therefore trademarking was more appropriate for Ethiopia.²²⁰ The trademarks allow Ethiopia control of its commercial asset.²²¹ The implementation and development of an internal GI system would be difficult due to Ethiopia's limited resources. Identifying all the coffee farmers, creating and monitoring internal certification standards would be resource intensive.²²² The producers, lawyers and judges need to be trained in the GI system; the growers and government also need to be educated.²²³

The registration of a GI, to indicate regional origin of a particular product, would require that the goods be produced in a specific area of the country and under specific circumstances.²²⁴ The trademarks selected are indirect indications of their Ethiopian origin,

²¹⁷ World Intellectual Property Organization 'The Coffee War: Ethiopia and the Starbucks Story' available at <http://www.wipo.int/ipadvantage/en/details.jsp?id=2621> (accessed 17 June 2014).

²¹⁸ DePass D 'Starbucks vs. Ethiopia: Corporate Strategy and Ethical Sourcing in the Coffee Industry' available at : <https://nationalethicscenter.org/resources/906/download/Starbucks.pdf> (accessed 17 June 2014).

²¹⁹ O'Kicki M 'Lessons Learned from Ethiopia's Trademarking and Licensing Initiative: is the European Union's position on Geographical Indications really beneficial for developing nations?'(2008-2009) 6 *Loyola University Chicago International Law Review* 329.

²²⁰ DePass D 'Starbucks vs. Ethiopia : Corporate Strategy and Ethical Sourcing in the Coffee Industry' available at : <https://nationalethicscenter.org/resources/906/download/Starbucks.pdf> (accessed 17 June 2014). The terms 'trademark' and 'brand' are used interchangeably in marketing. Trademark is the legal term that designates the word or mark associated with the product, whereas the word brand refers to the 'successes of a trademark in terms of contribution to market share, sales, profit margins, and loyalty and market awareness.' O'Kicki M 'Lessons Learned from Ethiopia's Trademarking and Licensing Initiative: is the European Union's position on Geographical Indications really beneficial for developing nations?'(2008-2009) 6 *Loyola University Chicago International Law Review* 320.

²²¹ DePass D 'Starbucks vs. Ethiopia : Corporate Strategy and Ethical Sourcing in the Coffee Industry' available at : <https://nationalethicscenter.org/resources/906/download/Starbucks.pdf> (accessed 17 June 2014).

²²² O'Kicki M 'Lessons Learned from Ethiopia's Trademarking and Licensing Initiative: is the European Union's position on Geographical Indications really beneficial for developing nations?'(2008-2009) 6 *Loyola University Chicago International Law Review* 328.

²²³ Matthews P 'Increasing revenue in developing nations through intellectual property rights: why a diversified approach to intellectual property protection with a focus on geographical indications is the best method' (2009-2010) 7 *Buffalo Intellectual Property Law Journal* 217.

²²⁴ Ethiopian coffee is grown on over four million small plots of land spread throughout the country. Each Ethiopian specialty coffee if registered as a GI would need to be produced in a specific area of the country under specific circumstances. Therefore every bag of Sidamo coffee has to be produced , processed and prepared in the Sidamo region and the quality has to be directly dependant on the unique properties of the region' Although Ethiopian coffees Harrar and Sidamo are named after specific regions, all of it is not produced in the same circumstances and under the same region; World Intellectual Property Organization 'The Coffee War: Ethiopia and the Starbucks Story' available at

therefore, to realize the objectives of the Initiative trademarks were chosen.²²⁵The government thought it best to protect its commercial origin instead of geographical origin.²²⁶ The use of trademark registration allowed greater numbers of specialty coffees to be produced across the country since each producer can have their own individual trademark.²²⁷ The Ethiopian government owns the marks which gives it greater and more effective control over the distribution of the coffee. This had the impact of increasing revenue through the export of more goods, and has also generated a rise in prices.²²⁸

There are some challenges and limitations, the principal ones being: lack of capacity, lack of awareness, the difficulty of unifying diverse stakeholders, and the absence of secured and sustainable funding for the Initiative. There is thus a need to establish a scheme (perhaps some sort of coffee fund) to finance the Initiative and other related activities for the development of the coffee sector in Ethiopia.²²⁹ These challenges and limitations have resulted in Ethiopia's existing level of protection for GIs being far below the minimum standard prescribed by TRIPS. Mandatory compliance with TRIPS, once Ethiopia accedes to the WTO, will drive legal reform of the protection of geographical indications in Ethiopia.²³⁰ There will need to be consistency between the relevant national legislation of Ethiopia and the provisions of TRIPS.²³¹ Ethiopia by becoming a WTO Member State will form more partnerships with other nations which may then provide them with greater legal assistance and financial support to establish a more sophisticated *sui generis* system in future to suit its own needs.

<http://www.wipo.int/ipadvantage/en/details.jsp?id=2621> (accessed 17 June 2014). 'Yirgacheffee' is the name of a village in Southern nations, but the coffee produced in the area are not all Yirgacheffee. The designations 'Harar' and 'Sidamo' do not represent the specific geographical locations where the coffee is grown. Harrar and Sidamo are named after specific regions, but not all the coffee bearing either name is produced under the same circumstances in the same region; Blakeney, Coulet, Mengistie & Mahop *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 156.

²²⁵ Blakeney, Coulet, Mengistie & Mahop *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 156.

²²⁶ World Intellectual Property Organization 'The Coffee War: Ethiopia and the Starbucks Story' available at <http://www.wipo.int/ipadvantage/en/details.jsp?id=2621> (accessed 17 June 2014).

²²⁷ World Intellectual Property Organization 'The Coffee War: Ethiopia and the Starbucks Story' available at <http://www.wipo.int/ipadvantage/en/details.jsp?id=2621> (accessed 17 June 2014).

²²⁸ World Intellectual Property Organization 'The Coffee War: Ethiopia and the Starbucks Story' available at <http://www.wipo.int/ipadvantage/en/details.jsp?id=2621> (accessed 17 June 2014).

²²⁹ Blakeney, Coulet & Mengistie et al *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 167.

²³⁰ Hirko SB 'The Legal Protection of Geographical Indications in Ethiopia' (Munich Intellectual Property Center 2011) 50 available at <http://ssrn.com/abstract=2135428> (accessed 17 June 2014).

²³¹ Hirko SB 'The Legal Protection of Geographical Indications in Ethiopia' (Munich Intellectual Property Center 2011) 30 available at <http://ssrn.com/abstract=2135428> (accessed 17 June 2014).

4.2.2 South Africa's Rooibos tea

The trademark system is also used to protect South Africa's Rooibos tea GI. The protection of "Rooibos", which has twice been the subject of an attempt at registration by a foreign company, is now discussed.

Rooibos has become a very popular tea worldwide appreciated for its health benefits and there has been an increase in international demand. The South African indigenous plant of the fynbos biome that produces the herbal tea "rooibos" is the *Aspalathus linearis* variety of the plant.²³² Rooibos meets all the requirements to be protected as a GI: there is a strong link between the farmers that grow rooibos and rooibos itself because they have traditional knowledge of the way to cultivate and produce the plant; South Africa is the only known part of the world where it grows; the unique geographical conditions in which rooibos grows gives rise to the properties of the plant; in short, the plant has a South African identity.²³³

The most recent SA government initiative to protect the term "rooibos" arose because a French company, the Compagnie de Trucy,²³⁴ attempted to trademark "rooibos" as its own.²³⁵ The Minister of Trade and Industry sent a request during April 2013 to the European Union (EU) for the protection of "South African rooibos" and "rooibos" which are terms a French company wanted to trademark.²³⁶ Ironically, SA had to mount a similar battle with a company in the US eight years ago, and should have protected it locally then, after an out-of-court settlement was reached by South Africa and the US.

²³² South African Rooibos Council 'Rooibos Plant' available at <http://www.sarooibos.org.za/rooibos-plant-factfile-74> (accessed 19 November 2014).

²³³ Forster R 'Rooibos' available at <https://www.ensafrika.com/news/Rooibos?Id=956&STitle=IP%20ENSight> (accessed 29 August 2013). Edward Nathan Sonnenbergs Africa (ENS) is a South African law firm which specialises in intellectual property law.

²³⁴ 'Rooibos protected in the EU trade pact' available at <http://www.timeslive.co.za/politics/2014/07/21/rooibos-protected-in-eu-trade-pact> (accessed 10 August 2014).

²³⁵ Smith D 'South Africa fights to protect rooibos tea name after French trademark bid' available at <http://www.theguardian.com/world/2013/jul/25/south-africa-rooibos-tea-france> (accessed 19 August 2013).

²³⁶ Smith D 'South Africa fights to protect rooibos tea name after French trademark bid' available at <http://www.theguardian.com/world/2013/jul/25/south-africa-rooibos-tea-france> (accessed 19 August 2013).

South Africa does not have legislation that deals exclusively with the protection of GIs but protection is found in various statutes that deal with related legal matters.²³⁷ The Trade Marks Act²³⁸ makes provision for the registration of geographical names or other indications of geographical origin, which includes certification and collective trademarks.²³⁹ The protection, therefore, for Rooibos relies on the trademark regime.²⁴⁰

The South African Rooibos Council (SARC) appears to have found it difficult to determine the best protection for the tea in 2005.²⁴¹ The problem was that SA law did not cater for “geographical indications”, or a name or sign that is used on products which correspond to a geographical origin or location. The EU rules demand that prior to the EU accepting a GI it must be protected domestically.²⁴² Protection in SA would enable the government to secure the rights to “rooibos” in Europe.

4.2.2.1 The EU-SADC Economic Partnership Agreement

The EU, as part of the process of negotiating an Economic Partnership Agreement (EPA) with the Southern African Development Community (SADC), requested the names of certain products to be protected on the grounds that they are GIs.²⁴³ On the 4th February 2014 the South African Department of Trade and Industry (DTI) issued a notice to declare

²³⁷ Merchandise Marks Act 17 of 1941, Counterfeit goods Act 37 of 1997, Liquor Products Act 60 of 1989, Trademarks Act 194 of 1993. Van Der Merwe A ‘Geographical Indication protection in South Africa with particular reference to wines and the EU connection’ (2008) 33 *Journal for Juridical Science* 111-117.

²³⁸ Trade Mark Act 194 of 1993.

²³⁹ Section 46 and s47 of Trade Marks Act 194 of 1993.

²⁴⁰ Blakeney M, Coulet T, Mengistie G & Mahop MT *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 324.

²⁴¹ The SARC, a non-profit company, was established in April 2005. Its objective is to promote the interests of the SA Rooibos industry internationally and locally. The members consist of processors, producers, manufacturers, local marketers and exporters: South African Rooibos Council ‘Welcome to the SA Rooibos Council!’ <http://www.sarooibos.org.za/rooibos-council-mainmenu-34> (accessed 25 November 2014).

²⁴² Forster R ‘Rooibos’ available at <https://www.ensafrica.com/news/Rooibos?Id=956&STitle=IP%20ENSight> (accessed 29 August 2013). In the EU the creation of a GI requires an elaborate code of conduct (or product specification) that has key information regarding the product at issue. According to “Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs on the protection of Geographical Indications and Designations of Origin for agricultural products and foodstuffs, replacing the Council Regulation (EC) No 510/2006”, the product specification needs to fulfil the elements as stated in Article 7 of the Regulation (EU) No 1151/2012 of the European Parliament to receive protection. Organization for an International Geographical Indications Network (ORIGIN) ‘Key – Concepts of GIs’ available at <http://www.origin-gi.com/index.php/en/your-gi-kit/key-concepts-of-gis.html#.UwXPk6K1dLM> (accessed on 19 February 2014).

²⁴³ The members of SADC which concluded negotiations included: Lesotho, Mozambique, South Africa, Namibia, Botswana and Swaziland. Angola has the option to join the agreement in future. These countries are members of the WTO.

rooibos a prohibited mark, and the protection of the proposed GIs was made under the Merchandise Marks Act.²⁴⁴ Section 15 of the Merchandise Marks Act provides that the Minister of Trade and Industry may as he or she deems fit after investigation prohibit, absolutely or conditionally, the use of any word or mark in connection with any trade or business by notice in the Government Gazette. South Africa in turn requested the protection of three names of agricultural product/food stuffs (honeybush, rooibos and Karoo lamb) and SA was given the latitude to include other GIs in future.²⁴⁵ The labelling of products emanating from the EU with the terms honeybush, rooibos and karoo lamb are, therefore, banned. The notice contains a partial 'GI request list' from the EU and the specifics of the protection will only be published once the process is complete. The SADC has concluded negotiating an EPA with the EU, which is SADC's largest trading partner; and once the EPA is signed by the SADC EPA Group and all the EU Member States the prohibition of the listed GIs will become effective eight months later.

The EU-SADC EPA also includes a bilateral protocol, on the protection of GIs and the trade in wines and spirits, between South Africa and the EU is included in the EPA. The EU will protect names such as honeybush, rooibos, karoo lamb and numerous wine names such as Paarl and Stellenbosch.²⁴⁶ South Africa will, in return, protect more than 250 EU names, which are spread over the categories of wines, spirits and food.²⁴⁷ The outcome of the GI negotiations did not affect the product names currently used by producers in South Africa.²⁴⁸ Mutual recognition has, therefore, been achieved on a range of GIs, but the EPA allows for the 'coexistence of already registered trademarks'.²⁴⁹ Once GI protection is

²⁴⁴Currently there have been proposed regulations published in the Government Gazette to protect the word 'rooibos' in terms of the Merchandise Marks Act 17 of 1941. General Notice: Notice 578 of 2012. In February 2014 Rooibos was declared a prohibited mark by the DTI under the Merchandise Marks Act. Moolman S 'Rooibos on its way to becoming a geographical indication..' available at <http://www.techtransfer.csir.co.za/2013/08/rooibos-on-its-way-to-becoming-a-geographical-indication/> (accessed 19 September 2013). Merchandise Marks Act 17 of 1941. Final prohibition on the use of the words 'Rooibos', 'Red Bush', 'Rooibostee', 'Rooibos Tea', 'Rooitee', and 'Rooibosch' and *The labelling of Rooibos and the Rules of Use of Rooibos* published (GenN 911 in GG 36807 of 6 September 2013) 55.

²⁴⁵Even though the proposed GIs need to be registered under the Trade Mark Act the government still needs to prohibit the use of some of the product names under s 15 of the Merchandise Marks Act.

²⁴⁶The final list of the product names and rules of protection has not yet been published.

²⁴⁷European Commission 'South African Development Community' available at <http://ec.europa.eu/trade/policy/countries-and-regions/regions/sadc/> (29 October 2014).

²⁴⁸ Davies R 'The SADC EPA and beyond' available at http://ecdpm.org/wp-content/uploads/Great_Insights_Vol3_Issue9_Oct-Nov_2014.pdf (accessed 27 November 2014).

²⁴⁹The existing SA producers of feta cheese is allowed to continue use of the name, but new entrants are barred from using this designation. The South African manufacturers of rooibos tea will have ownership of the name and the term will only be applicable to products from and approved by the SARC; Agritrade 'Making the most of GI protection under the SADC-EU EPA Agreement' available at

granted to the proposed names it will prohibit producers located outside of the EU from selling those products to South Africa using those protected names. Producers affected by the agreement need to develop new brand names to continue exporting to SA. South Africa, therefore, has protection for rooibos in the EU and the Southern African markets.²⁵⁰ The EPA will give greater access for SA to the EU market, which includes better trading terms mainly in agriculture and fisheries, and impose flexible export taxes on certain products.²⁵¹

The conclusion of the EPA with the EU is not the only step SA has taken to protect its GIs: it has also made a legislative amendment to include them within the existing protective framework.

4.2.2.2 The inclusion of ‘Geographical Indications’ in SA legislation

The Intellectual Property Laws Amendment Act²⁵² introduced the concept of Geographical Indication in South African legislation and defined it as:

‘an indication which identifies goods as originating in the territory of the Republic or in a region or locality in that territory, and where a particular quality, reputation or other characteristic of the goods is essentially attributable to the geographic origin of the goods, including natural and human factors’.

The Act provides for the registration of GIs as collective marks or certification marks, the mention in the Act may have the result that it is used more frequently.²⁵³ The Act included the amendment to the Trade Marks Act 194 of 1993, which provided for the further

<http://agritrade.cta.int/Agriculture/Topics/Product-differentiation/Making-the-most-of-GI-protection-under-the-SADC-EU-EPA-agreement> (accessed 18 October 2014).

²⁵⁰ Fabricius P ‘EU made concessions to SADC for strategic EPA’ *Business Report* 28 July 2014 available at <http://www.iol.co.za/business/news/eu-made-big-concessions-to-sadc-for-strategic-epa-1.1726392#.VDvKIWf9wd4> (accessed 16 October 2014).

²⁵¹ European Commission ‘South African Development Community’ available at <http://ec.europa.eu/trade/policy/countries-and-regions/regions/sadc/> (29 October 2014). ‘Market access for goods in the WTO means the conditions, tariff and non-tariff measures, agreed by members for the entry of specific goods into their markets’; WTO ‘Market access for goods’ available at http://www.wto.org/english/tratop_e/markacc_e/markacc_e.htm (29 October 2014).

²⁵² Act 28 of 2013 is now in force in RSA. New forms of intellectual property are created by the Act where there was previously been no form of protection for these particular forms. The new forms of IP were created through the amendment of certain IP Acts as opposed to the creation of *sui generis* legislation. Van Der Merwe A ‘The old and the new: A concise overview of the Intellectual Property Laws Amendment Act’ (September 2014) *De Rebus* 28.

²⁵³ Du Plessis I ‘Geographical Indications on South Africa’ *IP ENSight* 26 March 2014 available at <http://www.ensafrica.com/news/geographical-indications-on-South-Africa?Id=1367> (accessed 10 August 2014). The Trade Mark Act does make provision for the registration of collective marks and certification marks.

protection of geographical indications.²⁵⁴ Only products which are produced in those designated areas may be marketed under those trade names. The same trademark protection that rooibos was given applies to Karoo lamb and honey bush(tea), therefore, only products which have been produced in those particular areas may be marketed under those trade names.²⁵⁵ Trademarks distinguish the product of a specific trader from the products of its competitor. Trademark owners are then encouraged through its use to maintain standards of quality for their goods sold or services supplied under the marks.²⁵⁶

4.2.3 The South African and Ethiopian trademark protection compared

The Ethiopian trademark system merely makes provision for the protection of GIs through collective marks, whereas South Africa makes provision for collective and certification marks. The reason for Ethiopia's decision not to use the certification mark system is that it would be too expensive. Ethiopia, classified as a Least Developed Country, is dependent on the financial assistance of other countries.²⁵⁷ The Ethiopian trademark legislation does not mention or define the term 'geographical indication', whereas the SA trademark legislation has been amended to include geographical indications. Both SA and Ethiopian trademark legislation do not make provision for the additional protection of wines and spirits; therefore, the use of bilateral agreements will be beneficial for both countries.²⁵⁸ South Africa seems to provide greater protection for its local GIs as it is now defined in legislation and bilateral agreements have been entered into to protect it.

²⁵⁴ Section 43B(8) of the Intellectual Property Laws Amendment Act: 'A traditional term or expression or geographical indication shall only be registrable as per this section if-

- (a) the traditional term or expression or geographical indication is a derivative indigenous term or expression or geographical indication and was created on or after the date of commencement of the Intellectual Property Laws Amendment Act, 2013, and the community from which the term or expression, or a substantial part thereof originated, is or was an indigenous community when the term or expression was created; or
- (b) The traditional term or expression or geographical indication was passed down from a previous generation.'

²⁵⁵ 'Rooibos protected in the EU trade pact' available at <http://www.timeslive.co.za/politics/2014/07/21/rooibos-protected-in-eu-trade-pact> (accessed 10 August 2014). Honeybush grows wild in the Western and Eastern Cape provinces of SA; South African Honeybush Tea Association 'The honeybush plant' available at <http://www.sahta.co.za/honeybush/6.html> (accessed 12 October 2014). Karoo lamb is free range mutton and lamb which grazes on indigenous Karoo veldt vegetation which has been produced and slaughtered in the Karoo region (as defined in the Karoo Development Foundation); Karoo Meat of Origin 'How does it work?' available at <http://www.karooomeatoforigin.com/howitworks/> (accessed 12 October 2014).

²⁵⁶ See para 4.2 on the discussion of the trademark protection of geographical indications, *supra*.

²⁵⁷ See para 2.1.2, *supra*.

²⁵⁸ See para 4.2.2.1 for the discussion of the EU-SADC EPA, *supra*. Ethiopia, as part of the Eastern Southern Africa Group (ESA), has not entered into an EPA with the EU relating to GIs.

4.3. SUI GENERIS PROTECTION

TRIPS Member States may enact *sui generis* legislation to protect GIs. The predominant method used to provide such protection is the registration of GIs as defined in TRIPS. One of the primary requirements for registration of a GI in a *sui generis* GI system is a link between the product and the region, production practices or other factors that may contribute to the specific characteristics of the product. The explicitly defined link between a GI product and its origin in a *sui generis* GI system, must meet the requirements set to determine whether the ‘production and/or the processing and/or the preparation of the GI product needs to take place in the specific region’.²⁵⁹

GIs are classified as a type of industrial property that is separate or distinct from trademarks.²⁶⁰ GIs, unlike trademarks, cannot be freely transferred from one owner to another because the user needs to have the appropriate association with the geographical region and if there are any particular production practices of the region, they must be complied with.²⁶¹

Trademarks and GIs are private rights however; the level of public intervention in protecting a GI right in general is higher in *sui generis* GI systems than trademark systems. The *sui generis* system views GIs as resulting from collective decision-making. On the other hand, trademarks are usually privately owned and are not the products of collective decision making or public examination and support.²⁶² Regardless of the manufacturing process or the location of the manufacturing process a trademark still attaches to the good or service; however, GI protection through *sui generis* legislation

²⁵⁹ Bramley, Bienabe & Kirsten *Developing Geographical Indications in the South: The Southern African experience* (2013) 25.

²⁶⁰ Ibele E.W ‘The Nature and Functions of Geographical Indications in Law’(2009)10 *The Estey Centre Journal of International Law and Trade Policy* 39.

²⁶¹ Blakeney, Coulet, Mengistie & Mahop *Extending the Protection of Geographical Indications: Case studies of Agricultural Products in Africa* (2012) 9. The production and usage rules for GIs (codes of practice or specifications) is important to define in order to preserve the specific qualities and the associated reputation; Food and Agriculture Organization of the United Nations ‘Geographical Indications, Local Regulations and Protection’ available at http://www.fao.org/fileadmin/user_upload/foodquality/fichefiles/en/c2.3.pdf(accessed 05 October 2014). ‘Specifications’ are drawn up when a request to register a GI is made. The producers’ association, which requests that the label develops this text, will become the owner of the GI as a collective right. The detailed conditions for harvesting, production, processing and transforming a regional specialty is described in the specifications. The following institutions are required in a GI system: institutions authorized to review registration applications, insure production conformity, and award geographical indications; Roussel B & Verdeaux F ‘Natural Patrimony and Local Communities in Ethiopia: Advantages and limitations of a system of geographical indications’ (2007) 77 *Africa* 135.

²⁶² Bramley, Bienabe & Kirsten *Developing Geographical Indications in the South: The Southern African experience* (2013) 26.

relates to the place of origin. A trademark distinguishes one producer's goods from those of another; it indicates consumer-perceived quality.²⁶³

There are two important distinctions between the protection under the *sui generis* and certification trademark system.

First, in a *sui generis* protection system, the indication belongs to the State and a regulating authority administers the product. It is a public or private property right. The certification trademark generally belongs to an association of producers or manufacturers, which also administers the trademark.²⁶⁴

Secondly, a *sui generis* system is designed to protect the identification of the origin and its link with reputation and quality,²⁶⁵ whereas certification trademarks are designed to certify: quality assurance, any definable characteristic of the goods or services, materials, origin, mode or method of manufacture, location or region or origin.²⁶⁶

India's *sui generis* protection of GIs is now discussed, using Darjeeling tea as an example.

4.3.1 India- Darjeeling tea

Darjeeling tea is only produced in the Darjeeling district of the State of West Bengal, India.²⁶⁷ Darjeeling tea has distinctive characteristics of flavour and quality for which has a global reputation. This tea is one of the most expensive teas and it has a very high trade potential due to its global popularity.²⁶⁸ India introduced the Geographical Indications of Goods (Registration and Protection) Act (hereafter the Indian GI Act)²⁶⁹ to protect Darjeeling tea. GIs were not protected by separate legislation prior to the this Act: the Indian legal system did, however, protect GIs by preventing their misuse under its

²⁶³O'Kicki M 'Lessons Learned from Ethiopia's Trademarking and Licensing Initiative: is the European Union's position on Geographical Indications really beneficial for developing nations?'(2008-2009) 6 *Loyola University Chicago International Law Review* 319

²⁶⁴ Certification trademarks on rare occasions belong to the government.

²⁶⁵ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 224.

²⁶⁶International Trademarks Association 'Certification marks' available at <http://www.inta.org/TrademarkBasics/FactSheets/Pages/CertificationMarks.aspx>(accessed 20 August 2014).

²⁶⁷Jena PR & Grote U 'Changing Institutions to protect Regional Heritage: A case for geographical indications in the Indian Agrifood Sector' (2010) *Development Policy Review* 229. The tea plantations in the Darjeeling hills are mostly owned by large corporate companies. Therefore the Indian tea sector lies in the private sector; Jena PR & Grote U 'Changing Institutions to protect Regional Heritage: A case for geographical indications in the Indian Agrifood Sector' (2010) *Development Policy Review* 230.

²⁶⁸ Soam SK 'Analysis of Prospective Geographical Indications of India' (2005) *The Journal of World Intellectual Property* 689.

²⁶⁹ The Geographical Indications of Goods (Registries and Protection) Act,1999, came into force in September 2003.

trademark law the common law remedy of ‘passing off’.²⁷⁰ The following section discusses the establishment of India’s *sui generis* legislation.

4.3.1.1 The establishment of protection for Darjeeling tea as a geographical indication

The Tea Board of India applied for the registration of the ‘Darjeeling logo’²⁷¹ and the word ‘Darjeeling’ under the Indian GI Act.²⁷² This was done at high cost such as the administrative expenses, which included the costs of setting up monitoring mechanisms, salaries for personnel working for the Tea Board, software development and marketing costs.²⁷³

The Indian GI Act established a GI registry and set out an elaborate procedure to register GIs at an office in the southern city of Chennai.²⁷⁴ The registration of a GI for a period of ten years, subject to the renewal for an additional ten years, if it is not renewed it may be

²⁷⁰ The process of protecting GIs under the Trade Mark Act 47 of 1999 is of a private nature, there is no government oversight and the enforcement depends on the costly private action. Therefore, there was a need for a publicly administered system of protection by a centralized authority. On the other hand, an action for passing off is the result of a business presenting its product as being that of a competitor. The behaviour that misleads the consumer is central to this action. The level of proof for consumer confusion would not allow GIs which are lesser known or GIs which were recently introduced in the Indian market, to obtain protection through the action of passing off; Bramley, Bienabe & Kirsten *Developing Geographical Indications in the South: The Southern African experience* (2013) 44.



²⁷¹ The Darjeeling Tea Logo: ; World Intellectual Property Organization ‘Darjeeling Tea-Challenges in the Protection and Enforcement of Intellectual Property Rights’ available at http://www.wipo.int/sme/en/case_studies/darjeeling_tea.htm (accessed 06 October 2014).

²⁷² The Tea Board was set up under the Tea Act, 1953. The Tea Board of India, the tea producers’ in India’s sole representative, has the responsibility of implementing the government’s policies and regulations. The Act incorporated a compulsory system of certifying the authenticity before Darjeeling tea is exported. Dealers need to enter into an agreement with the Tea Board of India; See Srivastava SC ‘Protecting the Geographical Indication for Darjeeling Tea’ available at http://www.wto.org/english/res_e/booksp_e/casestudies_e/case16_e.htm (accessed 23 June 2014). All tea produced and grown in the tea growing areas of India, including Darjeeling Tea are administered by the Tea Board under the Tea Act, 1953. The Board has developed its own logo known as the DARJEELING logo. The Tea Board is the owner of the DARJEELING word and logo under common law and the following statutes in India: the Copyright Act, 1957: the logo is protected under copyright and registered as an artistic work with the copyright office; The Geographical Indication of Goods (Registration and Protection) Act, 1999: the word and logo was registered as a GI in India in the name of the Tea Board.; and Trade Marks Act 1999: word and logo a registered certification marks of the Tea Board.

²⁷³ Jena PR & Grote U ‘Changing Institutions to protect Regional Heritage: A case for geographical indications in the Indian Agrifood Sector’ (2010) *Development Policy Review* 233.

²⁷⁴ The Controller General of Patents, Designs and Trade Marks, administers the GI Act as the Registrar of GIs: Jena PR & Grote U ‘Changing Institutions to protect Regional Heritage: A case for geographical indications in the Indian Agrifood Sector’ (2010) *Development Policy Review* 225. Section 6 (1) of the Indian GI Act provides that ‘.the Register of geographical indications shall be kept at the Head office of the Geographical Indications Registry, wherein shall be entered all the registered geographical indications with the names, addresses and descriptions of the proprietors, the names, addresses and descriptions of authorised users and such other matters relating to registered geographical indications.’.

removed from the register.²⁷⁵ Once a GI is registered, any person who claims to be a producer of the designated goods by the registered GI may file an application to be registered as an authorized user.²⁷⁶

The first step in the registration process is that the collective body of producers (like the Tea Board) or producers' organization must file an application with the Registrar in the prescribed form.²⁷⁷ Experts appointed by the GI registry then examine the application and if it is accepted, it will be advertised in the GI journal for public scrutiny.²⁷⁸ A hearing will take place in a special court, which is designated for GI purposes, if the experts object to the application.²⁷⁹ An application, which has been examined by the experts, receives no objections from an individual or any public organization after it has been advertised in a GI journal it is deemed accepted and is awarded a GI certification.²⁸⁰ An application for the registration of a GI from foreign applicants is governed by Rule 24.1 under the Indian GI Act, which provides that foreigners from 'convention countries' need to provide a certificate from the registry (or other competent authority) of the GI office of their country of origin.²⁸¹

4.3.1.2 The content of the protection under the Indian GI Act

India's *sui generis* legislation provides greater protection for GIs than the TRIPS minimum standards, but it is still in harmony with TRIPS.

²⁷⁵ Section 18 of the Indian GI Act. A GI is generally protected as long as there is a distinctive link between the good and the place is maintained and the indication is not rendered as generic. There are certain systems of GI protection which require the registration and subsequent renewal of the GI. India does not make provision for the perpetual registration of a GI under Section 18 of the Indian GI Act; Das K 'Protection of Geographical Indications: An Overview of select issues with particular reference to India' available at <http://ssrn.com/abstract=1587372> (accessed 17 June 2014).

²⁷⁶ Section 17(1) of the Indian GI Act.

²⁷⁷ Section 11(1) of the Indian GI Act. The application for the registration of a GI may only be made by an 'association of persons or producers or any organization or authority established', unlike a trademark for registration of which any person may apply. See Kailasam KC & Vedaraman R *Law of Trade Marks & Geographical Indications: Law, Practice & Procedure* 2 ed (2009) 870.

²⁷⁸ Rule 38 of the Geographical Indications of Goods (Registration and Protection) Rules, 2002. The Central Government made the Geographical Indications of Goods (Registration and Protection) Rules, 2002 in the exercise of the powers conferred by sub-section 87 of the Indian GI Act.

²⁷⁹ Rule 50 of the Geographical Indications of Goods (Registration and Protection) Rules, 2002.

²⁸⁰ Section 16 of the Indian GI Act.

²⁸¹ 'Convention country' refers to a Member State of the WTO or one of the countries mentioned under Section 84.1 of the GI Act. The citizens of countries that are unable to protect GIs in India are from those countries not covered by this Section of the Act; Soam SK 'Analysis of Prospective geographical Indications of India' (2005) *Journal of World Intellectual Property* 680.

There are two very important differences between India's protection of GIs and the average protection under Article 22 of TRIPS: a more restrictive definition of a GI and the provision of more extended protection (these are both discussed below).

The definition of a GI in the Indian GI Act is more restrictive than the one in TRIPS as the latter merely provides that the goods must originate from the identified territory.²⁸² There is an additional condition in the Indian GI Act regarding one of the activities, which is more stringent than Article 22.1 of TRIPS.²⁸³ TRIPS allows the final product to be designated as Darjeeling tea despite the fact that processing takes place outside of the designated region, because irrespective of the place of processing, the relevant quality or characteristics of the final product is 'essentially attributable' to its geographical origin through its growth within the designated region.²⁸⁴ In terms of the Indian GI Act a producer who applies for a GI for manufactured goods needs to ensure that at least one of the activities of the processing or production or preparation of the goods takes place in the place of its geographical origin.²⁸⁵ The definition of a GI in TRIPS refers to goods in general whereas the Indian GI Act is more specific as it states that 'agricultural goods or natural goods or manufactured goods' may qualify as a GI.²⁸⁶ The Indian GI Act restriction means fewer goods may qualify for GI protection because of the place where the manufacturing/processing activities take place.

²⁸² A geographical indication is defined in Article 22 of the TRIPS Agreement (as stated in Chapter 2 of thesis).

²⁸³ Das K 'Protection of India's 'Geographical Indications': An Overview of the Indian Legislation and the TRIPS Scenario' (2006) 46 (1)*Indian Journal of International Law*11.

²⁸⁴ Das K 'Protection of India's 'Geographical Indications': An Overview of the Indian Legislation and the TRIPS Scenario' (2006) 46 (1)*Indian Journal of International Law*11. Article 22.1 of the TRIPS Agreement provides: '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' (emphasis added).

²⁸⁵ The Indian GI Act provides that not only must Darjeeling tea leaves be plucked in the Darjeeling region, in addition the tea must be processed within the region, because Darjeeling tea is a manufactured good. The leaves need to be plucked by the bushes and then need to go through a range of processing stages. Therefore, the Indian GI Act will not allow a final product to be designated as Darjeeling tea if the processing did not take place within the Darjeeling region. The TRIPS definition does not require the processing to take place in the region, therefore under the TRIPS the final product will still be designated as Darjeeling tea if the processing takes place outside the Darjeeling region, as long as the given characteristics of the final product is essentially attributable to its geographical origin; Jena PR & Grote U 'Changing Institutions to protect Regional Heritage: A case for geographical indications in the Indian Agrifood Sector' (2010) *Development Policy Review* 227.

²⁸⁶ Jena PR & Grote U 'Changing Institutions to protect Regional Heritage: A case for geographical indications in the Indian Agrifood Sector' (2010) *Development Policy Review* 227. The majority of GI products in India are agricultural products, mostly beverages and food. The non-agricultural products which may enjoy GI protection include jewellery, textiles and handicrafts; Das K 'Protection of India's 'Geographical Indications': An Overview of the Indian Legislation and the TRIPS Scenario' (2006) 46 (1)*Indian Journal of International Law* 2.

The extended protection is based on the definition of a geographical indication in section 2(1)(e) of the Indian GI Act which reads as follows :

*“geographical indication in relation to goods means an indication which identifies such goods as agricultural goods, natural goods or manufactured goods as originating, or manufactured, in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of such goods is essentially attributable to its geographical origin and in cases where such goods are manufactured goods one of the activities of either the production or processing or preparation of the goods concerned takes place in such territory, region or locality, as the case may be.”*²⁸⁷

Article 23.1 of TRIPS affords a higher level of protection to GIs relating to wines and spirits whereas the Indian GI Act does not restrict such “absolute protection” to wines and spirits. Member States of the WTO are free to extend ‘absolute’ protection to cover all products other than wines and spirits.²⁸⁸ The Government of a TRIPS Member State has the discretion to choose which product should receive higher protection.²⁸⁹ Additional protection is made available to certain goods or certain classes of goods of national interest on a case-to-case basis as notified by the Central Government under Section 22.2 of the Indian GI Act.²⁹⁰ This protection is not conferred automatically, but must be applied for.²⁹¹ The additional protection is provided by s 22.3 under Rule 79 of the Indian GI Act.²⁹² The result is that the misuse of a GI, which enjoys additional protection such as use of the phrase “Darjeeling type tea”, is an infringement.

4.3.1.3 India’s reason for choosing *sui generis* legislation

The EU and a number of developing countries, including India, want greater protection for products other than wines and spirits and have registered it at the TRIPS Council of the

²⁸⁷ Section 2(1)(f) of the Indian GI Act states that : ‘ “ goods” means any agricultural, natural or manufactured goods or any goods of handicraft or of industry and includes food stuff.’

²⁸⁸ Das K ‘International Protection of India’s Geographical Indications with special reference to ‘Darjeeling’ Tea’ (2006) 9 *The Journal of World Intellectual Property* 466.

²⁸⁹ Jena PR & Grote U ‘Changing Institutions to protect Regional Heritage: A case for geographical indications in the Indian Agrifood Sector’ (2010) *Development Policy Review* 227.

²⁹⁰ Kailasam KC & Vedaraman R *Law of Trade Marks & Geographical Indications: Law, Practice & Procedure* 2 ed (2009) 909.

²⁹¹ See per Rule 77 under the Indian GI Act: Soam SK ‘Analysis of Prospective geographical Indications of India’ (2005) *Journal of World Intellectual Property* 682.

²⁹² The additional protections against the use of expressions such as “type”, “kind”, “style” , “like” and “imitations” irrespective whether the true origin of the good is indicated; Soam SK ‘Analysis of Prospective geographical Indications of India’ (2005) *Journal of World Intellectual Property* 682.

WTO. These countries argue that the protection afforded by Article 22 is insufficient to protect GIs. India and the EU want the extended protection for all products for the following reasons: it is easier to implement absolute protection due to the absence of the 'misleading test' which would save litigation costs because goodwill and reputation does not need to be proven, and it prevents the qualified use of the GI terms.²⁹³ Consumers will then be able to trust the geographical designations on the products and associate certain characteristics and production processes instead of speculating whether there is qualified use by third parties.²⁹⁴ The Article 23 level of protection would help localize economic control and ensure higher economic returns.²⁹⁵

Developing and least developed countries have been economically and politically pressured by the Developed countries, which are not likely to renegotiate TRIPS to extend Article 23 level of protection to all goods.²⁹⁶ Bilateral agreements have continued to be used to protect GIs even after TRIPS was concluded; this shows the importance of protecting specific GIs and how difficult it is to achieve on the international level. Absolute protection is easily awarded to all goods if *sui generis* legislation is used, but politics makes it unlikely that Article 23 will be extended: the countries that oppose the extension of Article 23 protection to all products fear that GIs would then act as a non-transparent protection measures that would lead to the loss of export opportunities.²⁹⁷ Those countries fear that the lack of qualified use of the GI would have the effect of other countries not being willing to import those products.

The use of *sui generis* legislation gives the Member State the opportunity to extend absolute protection to all products, including agricultural products, and encourages a culture of protecting national products.²⁹⁸ One of the main arguments in favour of the increased protection of products other than wines and spirits, is that the absence of

²⁹³ Chandola HV 'Basmati Rice: Geographical Indication or Mis-Indication' (2006) 9:2 *The Journal of World Intellectual Property* 176.

²⁹⁴ Gangjee D *Relocating the Law of Geographical Indications* (2012) 271.

²⁹⁵ Jena PR & Grote U 'Changing Institutions to protect Regional Heritage: A case for geographical indications in the Indian Agrifood Sector' (2010) *Development Policy Review* 217.

²⁹⁶ Chandola HV 'Basmati Rice: Geographical Indication or Mis-Indication' (2006) 9:2 *The Journal of World Intellectual Property* 166.

²⁹⁷ Jena PR & Grote U 'Changing Institutions to protect Regional Heritage: A case for geographical indications in the Indian Agrifood Sector' (2010) *Development Policy Review* 218.

²⁹⁸ The following countries are moving from a trademark based system to a *sui generis* system by drafting Geographical Indication legislation: Kenya (draft Geographical Indications Bill, 2010), Ghana (Geographical Indications Act 2003), Mauritius (Geographical Indications Act (2002) was drafted, yet it has not yet been adopted), and Uganda (draft Geographical Indications Bill 2008).

additional protection, makes free-riding possible and creates a great risk that the GI will become generic.²⁹⁹

The ‘misleading test’ leads to legal uncertainty at an international level,³⁰⁰ because the national courts and administrative authorities need to decide whether a particular GI has misled the public and decisions may differ from country to country.³⁰¹ A producer who seeks to enforce protection of a GI under Article 22 bears a costly burden of proof: to show that there has been an act of unfair competition, or that the public has been misled.³⁰² It is beneficial that the Article 23 protection be extended to all other products for these reasons. Absolute protection is easily awarded to all goods if *sui generis* legislation is used. A *sui generis* GI protection framework provides stronger producer protection compared to that of trademark law.³⁰³ Each WTO-sanctioned GI covers a single product which is protected within all WTO Member Countries and is valid indefinitely whereas trademarks need to be periodically renewed.³⁰⁴ Therefore, more developing countries are moving towards *sui generis* protection. Anyone who satisfies the product specifications may use the GI designation and several brands may exist within the designated regions.³⁰⁵

4.4. CONCLUSIONS

Ethiopia used a trademark system that avoided the cost of establishing and implementing a GI system. The establishment of a national GI registry and certification process is resource-intensive and difficult to establish due to lack of resources and expertise.

²⁹⁹ See footnote 18 relating to ‘free riding’ and footnote 51 relating to ‘generic’ terms, *supra*.

³⁰⁰ Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 243. The national courts and national administrative authorities need to decide whether the specific GI has misled the public and enforce such decision. However, the question as to whether the public has been misled and the manner in which the administrative and legal authorities apply and interpret ‘misleading the public’ differs from one country to another, which leads to inconsistent decisions. It can therefore be avoided by extending Article 23 protection to all GIs; Jain S ‘Effects of the Extension of Geographical Indications: A South Asian Experience’(2009)16 *Asia Pacific Development Journal* 75.

³⁰¹ Das K ‘Protection of India’s ‘Geographical Indications’: An Overview of the Indian Legislation and the TRIPS Scenario’ (2006) 46 (1)*Indian Journal of International Law*18.

³⁰² Correa CM *Trade Related Aspects of Intellectual Property Rights* (2007) 243.

³⁰³ Gangjee D ‘Quibbling Siblings: Conflicts between Trademarks and Geographical Indications’ (2007) 82:3 *Chicago-Kent Law Review* 1267.

³⁰⁴ Babcock B.A & Clemens R ‘Geographical Indications and Property Rights: Protecting Value-Added Agricultural Products’ MATRIC Briefing Paper 04-MBP 7 May 2004 available at <http://www.card.iastate.edu/publications/DBS/PDFFiles/04mbp7.pdf> (accessed 8 August 2014). 5

³⁰⁵ Gangjee D ‘Quibbling Siblings: Conflicts between Trademarks and Geographical Indications’ (2007) 82:3 *Chicago-Kent Law Review* 1268. Consumers are attracted to buy particular products through the powerful use of branding. A brand is a name, symbol, term or design used to distinguish ones’ products/ services from other competitors. Brand image includes the consumers opinions of the brand compared to that of the competitors; Gilaninia S& Mousavian J ‘The investigation and analysis impact of brand image in Iran’ (2012) 6(25) *African Journal of Business Management* 7549.

Ethiopia's existing level of protection for GIs is below the minimum standard in TRIPS. Once Ethiopia accedes to the WTO, the mandatory compliance with TRIPS will determine the legal reforms regarding the protection of geographical indications in Ethiopia. Ethiopia, as a Member State of the WTO, will form more partnerships with other nations, which may then provide them with more legal assistance and financial support to establish a more sophisticated *sui generis* system in future to suit its own needs.³⁰⁶

The EU agreed to accept the protection of rooibos as a geographical indication under the EPA with South Africa.³⁰⁷ The implication of the Agreement is that all EU Member States are prohibited from using the stipulated terms unless the South African Rooibos Council (SARC) has given express permission. The EU trademark office is required to refuse trademark applications, which contain any of the prohibited words. Rooibos tea has, therefore, been granted the equivalent of GI status in the EU. Rooibos tea manufacturers of RSA would have ownership of the name and the term may only be applied to products which originate in the designated area and which are approved by the relevant authority, the SARC. The reciprocity between RSA and the EU in terms of the EPA is mutually beneficial. SA may in the future use the GI protection to increase the price of certain other unique items of local produce. The GI status provides an assurance of the quality of the products.³⁰⁸ The GIs in South Africa have not been locally protected in the past, the current trademark system and bilateral agreements with significant trading nations will assist in protecting these goods. *Sui generis* legislation should however be used in future to ensure the absolute protection of all goods.³⁰⁹

India uses *sui generis* legislation to protect its GIs. The India GI Act establishes a GI registry and sets out an elaborate procedure to register GIs. Any person may file an application to be registered as an authorized user of the registered GI if such person claims to be the producer of the designated goods. The main advantages of the *sui generis* system of protection in India are that it allows for the extension of Article 23 protection to all

³⁰⁶ See para 4.2.1.2, *supra*.

³⁰⁷ The EU has concluded bilateral agreements with other ACP groups as well as the USA, which is beyond the scope of this thesis.

³⁰⁸ See para 4.2.2.1, *supra*.

³⁰⁹ The BRICS (Brazil, Russia, India, China and South Africa) Forum is an independent international organization that works for an environmentally sustainable, structured social and economic BRICS block. BRICS has no laws aimed at protecting GIs. <http://www.bricsforum.org/brics-forum/> (accessed 10 February 2015).

products and also allows for restrictions as to which goods would qualify for protection by means of a geographical indication.³¹⁰

My argument is that trademarks be used as a stepping stone to the eventual adoption of *sui generis* legislation, is presented in the next and concluding chapter.³¹¹



³¹⁰ Relating to the activities of manufactured goods as discussed earlier, See para 3.1.2, *supra*.

³¹¹ 'Countries in transition' may at first find it easier to protect GIs through the trademark system rather than between two separate systems by introducing new *sui generis* GI legislation. Gangjee D 'Quibbling Siblings: Conflicts between Trademarks and Geographical Indications' (2007) 82:3 *Chicago-Kent Law Review* 1267.

CONCLUSIONS

Currently there is no uniform international mechanism of protecting GIs, however, the framework for the protection of GIs is provided by TRIPS. In Chapter 2 the three multilateral agreements prior to TRIPS, which gradually improved the framework of protecting GIs were discussed, but the protection they provided was not sufficient.

The advantage of the protection Article 23 of TRIPS provides for wines and spirits, over Article 22 relating to other products is that it does not require the proof of any unfair commercial practices or proof that the public has been misled. Producers of goods, which merely have general protection under Article 22 of TRIPS, bear the burden of the 'misleading test': that the public has been misled as to the geographic origin of the goods. The 'misleading test' leads to legal uncertainty at an international level, because the national courts and administrative authorities need to decide whether a particular GI has misled the public, and decisions may differ from country to country.³¹² It is beneficial for developing countries that the Article 23 protection be extended to all other products to avoid the burden of the 'misleading test' which leads to legal uncertainty and high litigation costs. Bilateral agreements complement the multilateral system, some of them ensuring a higher level of protection for GIs than TRIPS.³¹³ This could be a way to overcome the difficulties of protecting GIs under different national systems.

The choice of a mechanism for the national protection for GIs depends on the legal tradition and economic conditions of the jurisdiction concerned. The main forms of national legislation relied upon have been classified as a modification of existing trademark laws and *sui generis* legislation.³¹⁴ The purpose of this study is to determine the most appropriate method for protecting GIs for agricultural products of developing countries because most GIs belong to developed countries with fewer belonging to developing countries.

This thesis argues that a uniform system of protection for GIs should be established internationally as it would be to the advantage of developing countries. This is because the major problems that developing countries experience are the lack of resources and

³¹² See para 3.3, *supra*.

³¹³ See para 3.4, *supra*.

³¹⁴ See para 1.4, *supra*.

expertise to establish a successful system of protection to fulfil their needs.³¹⁵ These and some of the other problems of developing countries can be seen in the application of trademark laws in Ethiopia and South Africa, and *sui generis* legislation in India as discussed in Chapter 4.

Ethiopia does not have any *sui generis* GI law; GIs are protected under the Ethiopian Trademark Proclamation as collective marks. Ethiopia used the trademark system to avoid the cost of establishing and implementing a separate GI system. The trademarks Sidamo, Harrar, Harar and Yirgacheffe are now registered by the Ethiopian Government, not the producers of the Ethiopian coffee bearing those trademarks.³¹⁶ The implementation and development of an internal GI system would be difficult due to Ethiopia's limited resources. Identifying all the coffee farmers, creating and monitoring internal certification standards would be resource intensive. The use of trademark registration allowed greater numbers of specialty coffees to be produced across the country since each producer can have their own individual trademark.³¹⁷ The trademark legislation used to protect GIs does not provide for the additional protection for wines and spirits under TRIPS.³¹⁸ The protection of Ethiopian coffee, therefore, falls short of the level of protection required by TRIPS, which in any event does not bind Ethiopia at present.³¹⁹ Once Ethiopia accedes to the WTO, the mandatory compliance with TRIPS will determine the legal reforms regarding the protection of geographical indications in Ethiopia. Ethiopia, as a Member State of the WTO, will form more partnerships with other nations, which may then provide them with more legal assistance and financial support to establish a more sophisticated *sui generis* system in future to suit its own needs.³²⁰

The trademark system is also used to protect South Africa's Rooibos tea GI. South Africa does not have legislation that deals exclusively with the protection of GIs. The Trade Marks Act makes provision for the registration of geographical names or other indications of geographical origin, which includes certification and collective trademarks. The protection of GIs in SA would enable the government to secure the rights to "rooibos" in

³¹⁵ See para 1.1, *supra*.

³¹⁶ See para 4.2.1, *supra*.

³¹⁷ See para 4.2.1.2, *supra*.

³¹⁸ See para 4.2.3, *supra*.

³¹⁹ See para 4.2.1.1, *supra*.

³²⁰ See para 4.2.1.2, *supra*.

Europe.³²¹ The EU, during the negotiation of an EPA with the SADC, requested the names of certain products to be protected on the grounds that they are GIs. On the 4th February 2014, the DTI issued a notice to this effect, and the protection of the proposed GIs was made under the Merchandise Marks Act. The labelling of products emanating from the EU with the terms honeybush, rooibos and karoo lamb are, therefore, banned. The notice contains a partial ‘GI request list’ from the EU and the specifics of the protection will only be published once the process is complete. The SADC concluded the negotiations of the EPA with the EU, which is SADC’s largest trading partner. Once the EPA is signed by the SADC EPA Group and all the EU Member States the prohibition of the listed GIs is expected to become effective eight months later. Once GI protection is granted to the proposed names it will prohibit producers located outside of the EU from selling those products to South Africa using those protected names. Producers affected by the agreement need to develop new brand names to continue exporting to SA. South Africa, therefore, has protection for rooibos in the EU and the Southern African markets, but not anywhere else. The EPA will give greater access for SA to the EU market, which includes better trading terms mainly in agriculture and fisheries, and impose flexible export taxes on certain products.³²²

The conclusion of the EPA with the EU is not the only step SA has taken to protect its GIs: it has also made a legislative amendment to include them within the existing protective framework. The Intellectual Property Laws Amendment Act introduced the concept of ‘Geographical Indication’ in South African legislation. The Act provides for the registration of GIs as collective marks or certification marks, the mention in the Act may have the result that it is used more frequently. The Act included the amendment to the Trade Marks Act 194 of 1993, which provided for the further protection of geographical indications. Only products which are produced in those designated areas may be marketed under those trade names.³²³

The trademark legislation of Ethiopia does not mention or define the term ‘geographical indication’, whereas the trademark legislation in SA has been amended to include geographical indications. Both SA and Ethiopian trademark legislation do not make provision for the additional protection of wines and spirits, therefore, the use of bilateral

³²¹ See para 4.2.2, *supra*.

³²² See para 4.2.2.1, *supra*.

³²³ See para 4.2.2.2, *supra*.

agreements will benefit both countries. South Africa seems to provide more protection for its local GIs as it is now defined in legislation and bilateral agreements have been entered into to protect it.³²⁴

India introduced the Geographical Indications of Goods (Registration and Protection) Act to protect Darjeeling tea.³²⁵ India's *sui generis* legislation is still in harmony with TRIPS even though it provides greater protection for GIs than the minimum standards. The definition of a GI in the Indian GI Act is more restrictive than the one in TRIPS as the latter merely provides that the goods must originate from the identified territory. There is an additional condition in the Indian GI Act regarding one of the activities, which is more stringent than Article 22.1 of TRIPS.³²⁶ In terms of the Indian GI Act a producer who applies for a GI for manufactured goods needs to ensure that at least one of the activities of the processing or production or preparation of the goods takes place in the place of its geographical origin. Article 23.1 of TRIPS affords a higher level of protection to GIs relating to wines and spirits whereas the Indian GI Act does not restrict such 'absolute protection' to wines and spirits. Member States of the WTO are free to extend absolute protection to cover all products other than wines and spirits. The Government of a Member State has the discretion to choose which product should receive higher protection. Additional protection is made available to certain goods or certain classes of goods of national interest on a case-to-case basis as notified by the Central Government under Section 22.2 of the Indian GI Act. This protection is not conferred automatically, but must be applied for.³²⁷

The main advantages of the *sui generis* system of protection in India are that it allows for the extension of Article 23 protection to all products and also allows for restrictions as to which goods would qualify for protection by means of a geographical indication. Absolute protection is easily awarded to all goods if *sui generis* legislation is used. A *sui generis* GI protection framework provides stronger producer protection compared to that of trademark law. WTO-sanctioned GIs cover a single product which is protected within all WTO Member Countries and is valid indefinitely whereas trademarks need to be periodically renewed. Therefore, more developing countries are moving towards *sui generis*

³²⁴ See para 4.2.2.2, *supra*.

³²⁵ See para 4.3.1, *supra*.

³²⁶ See para 4.3.1.2, *supra*.

³²⁷ See para 4.3.1.2, *supra*.

protection.³²⁸ Anyone who satisfies the product specifications may use the GI designation and several brands may exist within the designated regions. One of the main arguments in favour of the increased protection of products other than wines and spirits, is that the absence of additional protection, makes free-riding possible and creates a great risk that the GI will become generic.³²⁹

Trademark owners in Africa need to file separate applications with OAPI, ARIPO and national offices of all other countries not affiliated with the two organisations to ensure protection throughout the region.³³⁰ PAIPO has been proposed to integrate IP laws in Africa to allow for a one-stop shop for all African countries. The implementation of PAIPO will assist African countries in establishing a unified trademark system that may be used to protect GIs across Africa, because all African countries have trademark systems in place and not *sui generis* legislation to protect GIs. A unified trademark system would then help in the transition to a *sui generis* system where all African countries implement *sui generis* legislation.³³¹

The use of trademarks should be a stepping stone, *sui generis* legislation is the ideal. Drafting separate (*sui generis*) legislation allows for a more stringent system and provides encouragement to protect more goods. The legal protection of GIs is important for cultural and economic purposes. The increased protection creates new job opportunities through the production and other related services.³³² Separate legislation should be drafted to fulfil the obligations of TRIPS and to ensure the extended protection, through national legislation, of all goods within other Member States. It is highly unlikely that the TRIPS Member States will agree to the extended protection of the Article 23. *Sui generis* legislation will not solve all problems, but it still provides the most suitable method by which developing countries, whether they are TRIPS Member States or not, can achieve optimal protection for their GIs.³³³

³²⁸ The following countries are moving from a trademark based system to a *sui generis* system by drafting Geographical Indication legislation: Kenya (draft Geographical Indications Bill, 2010), Ghana (Geographical Indications Act 2003), Mauritius (Geographical Indications Act (2002) was drafted, yet it has not yet been adopted), and Uganda (draft Geographical Indications Bill 2008).

³²⁹ See para 4.3.1.3, *supra*.

³³⁰ See para 1.4.2, *supra*.

³³¹ See para 1.4.2, *supra*.

³³² See para 1.3, *supra*.

³³³ See para 4.4, *supra*.

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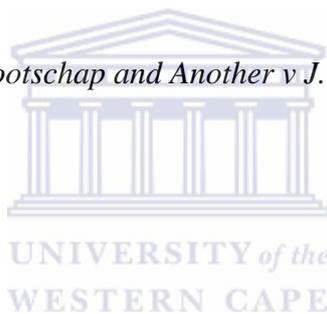
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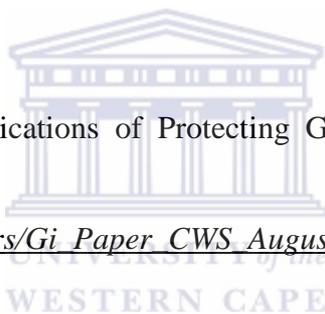
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