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Question B: What rules should govern claims by suppliers about the national or geographic origin of their goods or services?

International Rapporteur

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General Question:

What rules should govern claims by suppliers about the national or geographic origin of their goods or services?

Background

The indication of the geographic origin of a product or service can be valuable information used by manufacturers and suppliers to differentiate their products and this information might increase revenues for local producers and satisfy the desire of more locally-conscious and demanding customers to reduce search costs.

Historically, there have been different legal concepts dealing with the indication of the geographic origin of goods and services. The terminology used internationally varies. For the purposes of this questionnaire, the following terms are used:

- **Indication of source:** meaning an indication perceived by the relevant public as indicating the origin of the goods. Indications of source simply denote the geographical places of origin of products, for example, "Product from XY". There need not be any definable characteristic of the product that derives from its place of origin.
- **Geographical indication:** meaning a geographical indication (GI) in the sense of Article 22(1) TRIPS and also for services. A geographical indication is a sign used for goods or services that have a specific geographic origin and possess qualities or a reputation that are due to that origin. In order to function as a GI, a sign must identify a product as originating in a given place. In addition, the qualities, characteristics or reputation of the product should be essentially due to the place of origin. Since the qualities depend on the geographical place of production, there is a clear link between the product and its original place of production.
- **Appellation of origin:** meaning a geographical indication used to designate goods or services which originate from the region or place in question. Appellations of origin are recognized as referring to the quality or other characteristics of specific products. Not all GIs are appellations of origin. Usually, appellations of origin only refer to geographical names, such as Bordeaux, Champagne, etc. while a symbol such as the Eiffel Tower in Paris or the Matterhorn in Switzerland could function as a GI. In addition, appellations of origin are usually registered in special registers and their use is normally regulated by explicit specifications.

Hereinafter, the term **indication of origin** will be used as an umbrella term that encompasses indications of source, geographical indications and appellations of origin.

The different concepts for how to address the use of indications of source are closely embedded in the different legal and institutional frameworks. During the TRIPS negotiations and thereafter a divisive debate ensued regarding the nature and scope of protection to be granted to GIs.

Fundamentally, two different approaches emerged. The first relies on existing intellectual property (in particular including trademarks) and unfair competition law systems. A number of countries argued that GIs are sufficiently protected within this existing framework.

The second approach deals with geographical indications through specific legislation designed for this purpose (i.e. *sui generis* protection).

The divergent approaches *inter alia* differ with respect to the degree of government involvement, ownership and enforcement. The merits of the divergent concepts have been widely debated and will not be explored in detail in this questionnaire.

A number of countries have entered into various bilateral, multilateral and international arrangements regarding the use and protection of sources of origin. In particular, the following international agreements deal with the use and protection of sources of origin:

- Paris Convention for the Protection of Industrial Property (1883)
- Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods (1891)
- General Agreement on Tariffs and Trade (GATT) (1947)
- Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (1958) and Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications (2015)
- Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) (1994)

The TRIPS Agreement is not prescriptive in its approach to GI protection and requires merely that member countries provide the “legal means” by which to prevent “(a) [...] the use of any means [...] which misleads the public as to the geographical origin of the good [...] or (b) any use which constitutes an act of unfair competition [...]”. WTO members are therefore free to regulate the protection of GIs at national or regional level, provided it complies with the minimum standards of the TRIPS.

Questions to National Rapporteurs

1. Do your jurisdiction’s laws have provisions dealing with indications of origin that are used by manufacturers, distributors and service providers to commercialise their goods and services (e.g. passing off, unfair competition law, trademark law, *sui generis* law regulating the use of indications of source, geographical indications, or appellations of origin)? If yes, please provide the text of those provisions.
2. What requirements in your jurisdiction must be met in order for goods to be marketed with an indication of origin? What are the requirements for services?
3. Are there different provisions for different types of goods (e.g. for wines and spirits, foodstuffs, natural goods, industrial products, etc.)? If so, what are the respective requirements?
4. Do the same provisions apply to domestic indications of origin as to foreign indications of origin? Does your jurisdiction for example apply the country-of-origin principle, according to which foreign indications of origin are judged according to the law of their country of origin?

5. Is there a special register for the registration of indications of origin for goods and/or services within your jurisdiction? If yes, what goods or services and what kind of indications of origin can be registered in this register? Please provide a brief description of the registration process and the effects of such a registration and the scope of protection of registered indications of origin. Is it possible that a registered indication of origin becomes a non-protected generic term or are there specific rules that prevent a registered indication from becoming generic?
6. Is the registration of certain indications of origin mandatory in order for them to be protected and their use to be regulated? If yes, to which indications of origin and for what kind of goods and services does such registration requirement apply?
7. Who is entitled to apply for the registration of an indication of origin (any market player, manufacturer organisations only, etc.)? Does the registration of an indication of origin confer property rights upon a specific owner?
8. If your jurisdiction provides for a registration of certain indications of origin, who defines the rules that have to be followed and the requirements that have to be met when using the registered indication for certain goods or services (the applicants, the lawmaker, a combination of both, others)? If the applicants are competent to define those rules and requirements (e.g. in specifications), are there any provisions or principles that limit the applicant's power and have to be considered by the applicants (e.g. antitrust law, free speech arguments, free movement of goods, etc.)?
9. Is it possible that manufacturers, suppliers and distributors of goods or services which have lawfully advertised their goods or services with an indication of origin for a long time be excluded from using the indication of origin after the indication's registration (e.g. because they cannot comply with new use requirements that apply after the registration of the indication of origin)? Does your jurisdiction have any provisions which try to prevent such exclusions of previous legitimate users of indications of origin?
10. Do your country's laws provide for the registration of indications of origin as trademarks or service marks, i.e. as certification marks, collective marks or individual marks? If so, what are the requirements?
11. How are conflicts between trademarks and non-registered indications of origin or indications of origin that are subject to *sui generis* protection resolved under your country's laws? Are there specific rules or case law governing such conflicts?
12. If during the manufacturing process of a certain product a certain manufacturing step has taken place at a particular location or in a specific geographical area XY, but other steps have taken place in other geographical areas so that the conditions are not satisfied that the product as a whole can be considered to originate from XY, is it possible in your jurisdiction to highlight in the advertisement for this product that one specific manufacturing step took place in XY, e.g. by highlight for example "Research & Development in XY" or "Filled in XY" if those activities actually took place in XY but the product as such does not originate from XY? Do your country's laws have provisions which regulate the reference to the geographic origin of certain manufacturing steps? If so, can you please provide the wording of these provisions?

13. Do your jurisdiction's laws have specific provisions or is there any case law with regard to the requirements that have to be met to use of the indication "Made in XY" for goods?
14. Do provisions in the laws of your jurisdiction provide that for certain goods or services the geographic origin must be indicated (mandatory labelling requirements for example in the legislation with respect to foodstuffs, cosmetics, pharmaceuticals or customs)? If so, what is the wording of these provisions? To which goods or services do these provisions apply? What kind of indications must be made? Are such mandatory labelling requirements considered to be trade restraints in your jurisdiction?
15. If your jurisdiction has mandatory labelling requirements with respect to the geographic origin of certain goods or services is there a risk of conflicts between the mandatory labelling requirements and the provisions regarding the voluntary use of geographical indications? In other words, is it possible that the mandatory labelling requirements require that a product is labelled with a certain geographic origin while the provisions dealing with the voluntary use of indications of origin would not allow the use of this indication of origin, e.g. because the link between the product and the indicated geographic origin does not seem to be sufficient.
16. What courts, authorities, or other bodies in your country have jurisdiction to hear cases concerning the protection of indications of origin or are entitled to take measures to protect indications of origin (e.g. civil courts, criminal courts, customs authorities, food safety authorities, chambers of commerce, etc.)?
17. In your personal opinion which rules and concepts of your jurisdiction with respect to the use of indications of source for goods and services do you particularly endorse? Which rules or concepts would you prefer to be amended or abandoned?

Please send your National Reports to the International Rapporteur, the Secretariat of the League, the General Rapporteur and his Deputy and the Chairman of Question B **no later than 15 May 2016.**