

Establishment of a Multilateral System of Notification and the Registration of Geographical Indications for Wines and Spirits pursuant to TRIPS Article 23 (4)

MARQUES is an association created to educate and promote the professional development of brand owners in the selection, management, protection and exploitation of their trade marks within a global economy; to create a forum for the free exchange of ideas and information and to provide an effective platform for the representation of their interests.

MARQUES has followed, with great interest, the ongoing negotiations within the World Trade Organisation (WTO) Council for Trade-Related Aspects of Intellectual Property Rights (TRIPS) on the establishment of a multilateral system for the notification and registration of geographical indications (GIs) for wines and spirits.

MARQUES is also aware that the International Trademark Association (INTA), based in the United States, has proposed an alternative to the proposals before the Special Session of the Council for TRIPS.

MARQUES would like to register its full support for the INTA proposal for a system facilitating the protection of GIs with examination and opposition at Member State level.

MARQUES firmly advocates that the protection of GIs must not prejudice other existing IP rights. Pursuant to the TRIPS Article 1 (2), GIs are recognised as one type of intellectual property. That is to say, GIs are neither inferior nor superior to any other type of intellectual property, such as patents and trademarks. Consequently, GIs must be regarded as standing on equal footing with all other types of IP rights.

MARQUES is convinced that it is possible to achieve a harmonious co-existence of protection systems for GIs and other IP rights and that conflicts between these rights should be resolved in accordance with the well-established intellectual property principles of territoriality, exclusivity and priority.

As with any other IP right, GIs could be administered by a system of protection similar to other systems, for instance the Patent Co-operation Treaty (PCT) and the International Registration (IR) system for trademarks. From these systems a number of important features and conditions could be drawn to facilitate the registration and notification of any IP right within the framework of a system of IP rights' protection:

- International notification and registration should be based on the existence of a national application/registration
- Notification should be facilitated through and administered by an international body, preferably WIPO

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- Examination of whether the IP right at issue meets the protection requirements should be carried out in the country where protection is sought
- Third parties should be able to challenge the application and/or registration before the national offices and/or national courts in the country where protection is sought

In respect of possible conflicts with third-party rights, the PCT and the IR systems are founded upon and are fully compatible with the principles of territoriality, as well as priority and exclusivity. In line with the requirements of Part III of the TRIPS Agreement, they also provide for legal remedies for owners of prior rights.

Under a system operating in a similar way to the PCT and the IR, users of a generic term as well as owners of prior trademarks would be able to seek legal protection before the national offices and/or the national Courts. Those Courts are usually trained and familiar with conflicts of intellectual property rights and are best placed to examine whether a designation constitutes a generic term or conflicts with a prior IP right. Experience shows that such a system would be beneficial for smaller or medium sized companies in particular, since, apart from the prohibitive nature of the costs involved, it is often difficult to persuade a government to take a case to the WTO.

Conclusion

MARQUES shares the belief of INTA that a new multilateral System for GIs should not deviate from the experience gained under the PCT and the IR systems. In line with systems facilitating the international protection of other IP rights, namely patents and trademarks, the ultimate decision on the protection of a GI must rest with the competent authorities of the participating States. Legal remedies must be available for both the users of generic terms and the owners of prior IP rights.

MARQUES therefore supports the proposal from INTA that any system should follow a Madrid-like or PCT-like approach and include the following key elements:

- Notification and registration to the participating States through an international body
- *Ex officio* examination of protectability in the country of protection
- Refusal and opposition on the basis of prior trademark rights
- Ability to challenge the registration in the national courts

It is the view of MARQUES that a system built on these concepts will facilitate the protection of GIs in the same way as the Madrid System facilitates the protection of trademarks and the PCT facilitates the protection of patents. At the same time it will recognise that GIs are what they are deemed to be under TRIPS, an intellectual property right, the importance and value of which equals those of trademarks and patents.

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