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A study of legal protection of
Geographical Indications in the
European Community and in
Vietnam

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Summary

This thesis addresses the legal protection of geographical indications (GIs) at three levels: the World Trade Organisation (WTO), the European Community (EC) and Vietnam, with the main focus on protection of GIs in the EC.

The 1st part contains some general remarks concerning the rationale, purpose, delimitation, and methodology of this thesis.

The 2nd part introduces some backgrounds on GIs such as their definition and the rationale of their protection and a review of the international legal system on the protection of GIs.

The protection of GIs at international level is addressed in the 3rd part through analysis of the provisions of the Agreement on Trade related Aspect of Intellectual Property Rights (TRIPs) - one of the main pillars of the WTO. This part also deals with the question of how a dispute between WTO Member States is solved before the WTO and the WTO Member States' obligation to comply with TRIPs provisions.

Part 4 and 5 concern the protection of GIs in the EC and in Vietnam. Legislation, case law and practice in the EC and in Vietnam are analysed in order to provide an exhaustive picture of the protection of GIs at regional and national level.

Part 6 is a general summary of the previous parts.

Preface

The idea for this thesis was born when I participated in a seminar on the protection of GIs held in Hanoi, Vietnam within the framework of the EC-Asean Intellectual Property right Co-operation Program (ECAP-II) at the end of 2005. In the seminar, many experts on GIs protection from the European Union (EU) introduced their legal system and practice on GIs protection in the EC. Those speeches indicated that the EC has a long history and traditional protection of GIs with many famous products bearing GIs from over the world. At that time, only three products had been recognised as GIs in Vietnam in spite of the variety of products that can be protected as GIs.

The issue of protection of GIs in Vietnam has rearisen, as Vietnam now becomes an official Member state of the WTO. Among other obligations, Vietnam has to comply with TRIPs provisions, including Section 3 concerning protection of GIs. Examining the TRIPs provision and the protection of GIs in the EC seems be the best way to analyse the current situation of GIs protection in Vietnam.

On this occasion, I would like to express my heartfelt thanks to my supervisor, Professor **Hans Henrik Lidgard**, who supported and gave me valuable comments and suggestions during my work.

Even if I tried my best, my thesis is far from complete. I am grateful for any comments and suggestions for improving it.

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Nguyen Thi Tuyet

Abbreviations

AG	Advocate General
EC	European Community
EU	European Union
ECJ	European Court of Justice
Fn.	Footnote
E.I.P.R	European Intellectual Property Law Review
GI(s)	Geographical indication(s)
Ibid.	Ibidem
IP	Intellectual Property
IPR(s)	Intellectual Property Right(s)
NOIP	National Office of Intellectual Property of Vietnam
PDO(s)	Protected Designation of Origin(s)
PGI(s)	Proteted Geographical Indication(s)
OJ	Official Journal
par.	paragraph(s)
p.	page
TRIPs	Agreement on Trade-Related Aspects of Intellectual Property
U.S	The United State of America
UK	United Kingdom
WIPO	World Intellectual Property Organisation
WTO	World Trade Organisation

1 Introduction

1.1 Rationale

While there are still some who doubt whether the law covering geographical indications (GIs) properly belong within Intellectual Property, the legal and economic significances of GIs protection clearly indicate the important role of GIs, especially to developing countries.

GIs protection is not novelty issue in Europe because the EC has known as the most successful example on protection of GIs in the worldwide with a long history of protecting GIs.¹ Within the EU, GIs play an important role in the Community economic, especially in Common Agricultural Policy.²

In contrast, the issue of GIs protection has just been recognised in Vietnam from 1990s in legislations and has been developed today. Notwithstanding this, the protection of GIs in Vietnam is still very limited and has not yet received adequate attention in legislation and legal practices. With a view to enhance protection of GIs in Vietnam, I chose the topic: ‘**A study of legal protection of GIs in the EC and in Vietnam**’ to write my thesis. I would like to do research on this topic in order to understand general concept of GIs, TRIPs’s provisions on GIs, especially the experiences of the EC on GIs protection and be able to analyse the current situation of Vietnam.

1.2 Purpose and delimitation

This thesis aims to analyse the current legal protection of GIs at three levels: international level (TRIPs Agreement), regional level (the EC) and national (Vietnam), with focus on the situation of GIs protection in the EC. On doing so, I would like to answer the question of how the WTO Member States comply with TRIPs provisions and how they develop their legal systems on GIs protection beyond TRIPs’s minimum standards. With respect to the EC’s GIs protection regime, I would like to learn about a successful example of GIs protection in order to give some recommendations on enhancing protection of GIs in Vietnam.

I am aware that GIs confer protection to all products, however for the purpose of my thesis I focus mainly on protection of GIs for agricultural products and foodstuffs which is center of Agricultural and Rural development in the EC and in Vietnam.

¹ Stacy D.Goldberg, *Who will raise the white flag? The battle between the U.S and EU over the protection of GIs*, University of Pennsylvania Journal Economic law, Spring 2001, p.13

² *Why do GIs matter to us*, at

http://ec.europa.eu/trade/issues/sectoral/intell_property/argu_en.htm, (02/05/2007)

In addition, there are also many issues relating the protection of GIs for agricultural products and foodstuffs. Due to limited time and very limited ability, I cannot research all these issues. In this paper, I try to give the major contents on protection of GIs in legislation, associated with analysing case laws and practical of such activities.

1.3 Method

The main method of research is traditional legal, i.e, studying the relevant legislation and case law. Since the purpose of my thesis is providing an exhaustive picture about the protection of GIs at international, regional and national level, therefore I use analytic and comparative method to fulfil this purpose. These methods are used throughout the thesis, especially when considering the situation of GIs protection in the EC and in Vietnam.

In addition, descriptive and synthetic methods are also used to give the main contents of regulations concerning protection of GIs in TRIPs, the EC and in Vietnam as well as providing the backgrounds to the main contents of thesis.

2 Background on GIs

2.1 What is GIs?

2.1.1 Definition

Geographical indications (GIs) are forms of Intellectual Property Rights (IPRs).³ Like trademarks or other commercial terms, GIs are distinctive signs which permit consumers to distinguish products on the market. However, unlike patents and trademarks, where the basic concepts are practically the same worldwide, GIs are protected under national law and regional level in different forms, thus it is difficult to establish a uniform approach at the international level.⁴ One of the biggest obstacles to the international protection of GIs is the great variety of existing concepts.⁵ Legal notions vary from one legal system to another, and we do not find well-defined common features in subject throughout the world.⁶ Thus, it is useful to look at some of different terms used in that area.

Indication of source is first used in the Paris Convention⁷ and Madrid Agreement⁸ but there is no definition in both Treaties. Generally speaking, indication of source is constituted by any denomination, expression or sign that a product originated from a country, a region or a specific place.⁹ For purpose of indication of source, no particular quality of product is required. Therefore, the name of product itself, for example, 'France', 'Rome'; and adjective connected with place, for example, 'Germany beer', 'Italian ham'; or a label, for example 'Made in Portugal', 'printed in UK', and so on can be regarded as indication of source.¹⁰

Appellation of origin is a specific type of GIs which is defined in Article 2 of the Lisbon Agreement¹¹ as 'the geographical name of a country, region or locality, which serves to designate a product originating therein, the

³ See different view at: Stephen Stern, *Are GIs IP?* E.I.P.R, 2007, I- 2, p39-42.

⁴ Ludwid Baeumer, *Symposium on geographical indications*, Eger, 1997, p10

⁵ Marcus Hopperger, *International protection of GIs- the present situation and prospects for future developments*, Symposium on the International Protection of GIs, Somerset West, Cape Province, South Africa, September 1 and 2, 1999, p.11

⁶ Frederick Abbott, Thomas Cottier and Francis Gurry, *The International Intellectual Property System- Commentary and material*, part 1, Kluwer Law International 1999, p.185

⁷ Paris Convention on protection of industrial property right, at http://www.wipo.int/treaties/en/ip/paris/trtdocs_wo020.html, (02/05/ 2007)

⁸ Madrid agreement for the Repression of False or Deceptive Indication of source on goods, at http://www.wipo.int/treaties/en/ip/madrid/trtdocs_wo032.html, (02/05/2007)

⁹ Marcus Hopperger, Fn.5

¹⁰ Mario Franzosi, "Made in..." , "Made in Ruritana"- "Made in Italy", E.I.P.R 1996, I-18, 613-617

¹¹ Lisbon agreement on protection of appellation of origin and their international registration at http://www.wipo.int/lisbon/en/legal_texts/lisbon_agreement.htm, (02/05/2007)

quality or characteristic of which are due to exclusive or essentially to the geographical environment including natural and human factors'. Under this definition, an appellation of origin must be a geographical name of a country, region or locality which is located in a geographical map of a country. The important feature of an appellation of origin is that it requires products originating from certain area must have a quality *and* characteristics which are 'due to exclusive or essentially to the geographical environment, including natural *and* human factors' (for example, the wines 'Cognac', 'Champagne', 'Porto', or 'Bordeaux').

The term GIs came into use in the WIPO negotiations in the mid-1970s and effectively entered into common usage with the conclusion of TRIPs Agreement.¹² Article 22 of the TRIPs defines GIs as 'indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristics of the good is essentially attributable to its geographical origin'. This definition goes further than that of the Lisbon agreement by including indications which are not actual geographical name.¹³ Furthermore, the criterion for protection of GIs in the TRIPs Agreement are less restrictive than that of the Lisbon Agreement. The TRIPs Agreement protects GIs which have 'merely' certain reputations, *or* other characteristics but not specific qualities being due to their places of origin.¹⁴ Examples of GIs are Basmati rice, Jasmine rice, Habanos tobacco or Long Jin tea, ect.,

Other new terms introduced by the EC's GIs protection regime are Protected Geographical indications (PGIs) and Protected Designation of Origins (PDOs). These terms are used to describe a designation of origin for products that has been registered under the Council Regulation 2081/1992 on protection of GIs on agricultural products or foodstuffs¹⁵ and/or the Regulation 510/2006 replaced Regulation 2081/1992.¹⁶

It is important to note that different terms are used in different international legal instruments. Rights and obligations following from these instruments exist only in relation to specific term to which the instrument refers. Therefore, it may not always be possible to use broadly the term GIs for all case.¹⁷ However, for the purpose of this paper, the term 'GIs' is used to refer both term 'indication of sources' and 'appellation of origin', as well as PDOs and PGIs in case of protection of GIs in the EC.

¹² The Agreement on trade related intellectual property right (TRIPs), Section 3, Part II. See also: *GIs*, at http://www.iprsonline.org/unctadictsd/docs/RB_2.15_update.pdf, (02/05/2007)

¹³ Jeremy Phillips, *Trademark law: A practical anatomy*, Oxford University Press, p.806

¹⁴ Marcus Hopperger, Fn.5, emphasis added

¹⁵ Council Regulation 2081/1992 on protection of Protected designation of origin and Protected Geographical indications on agricultural products and foodstuffs, (hereafter the 1992 Regulation)

¹⁶ Council Regulation 510/2006 on protection of Protected designation of origin and Protected Geographical indications on agricultural products and foodstuffs, replaced the 1992 Regulation (hereafter the Regulation or the new Regulation)

¹⁷ Standing Committee on the law of trademarks, industrial designs and GIs (STC)9/4

2.1.2 The rationale for protection of GIs

The economic significance of possibility of protecting GIs is enormous. While much important is attached to GIs for wine and spirits, many developing countries show an increasing interest in gaining market access for their agricultural products by using GIs, such as Basmati Rice, Jasmine rice, or the like.¹⁸ Further, the protection of GIs is not only a competition tool at the services of producers from a specific region, but also acts as a means of consumer protection.

GIs play a fundamental role by informing consumers about the origin of the goods to which they are affixed.¹⁹ It is clear from their definition that GIs identify products ‘as originating in the territory of a Member, or a region, or locality in that territory’.²⁰ For example, ‘Champagne’ sparkling wines have historically been produced in Champagne, France, while ‘Chianti’ wines come from Tuscany, Italy.²¹

In addition, GIs also assure the consumers that the products concerned have certain of qualities and characteristics. When a GI is affixed to a product, it means that the product comes from an area where a given quality, reputation or other characteristic of the product is essentially attributed to their geographic origin. Accordingly, no other hams can have, for example, the quality or characteristics of the Parma ham that is produced in Parma, Italy and identified by the GI ‘Prosciutto di Parma’.²²

For producers, while trademarks are usually owned by a single producer or trader, GIs are common property of the producers and traders of a specific and determined region. It means that only producers and traders from that region can use GIs to affix to their products, provided that their products satisfy the other criteria called for by the GI. External producers could not use these GIs.

More important, legal considerations show that protection of GIs serve a double purpose.²³ GIs protection helps consumers to protect their interests against wrong or misleading indications on the one side, and protecting the well-earned good will of producers being entitled to use the GI on the other. If GIs are not protected adequately, it may be misrepresented by dishonest commercial operators which is thus detrimental to consumers and legitimate interests of producers.

¹⁸ Chirstopher Heath, *The Importance of GIs*, at <http://www.ecap-project.org/>, (02/05/2007)

¹⁹ Irene Caboli, *Expanding the protection of Geographical indications of origin under TRIPS: “old” debate or “new” opportunity*, Marquette Intellectual property Law Review, Special Issue 2006, Vol 181

²⁰ TRIPs Agreement, Fn.12, Article 22 (1)

²¹ Molly Torsen, *Apple and Oranges (and Wine): Why the international conversation regarding GIs is still at standstill?* Journal of Patent and Trademarks Off. Soc’Y, 31-2005

²² Davide Calderone, *The control and protection of Prosciutto di Parma*, Seminar “GIs, Lands of tradition and opportunities” Bangkok, 28-29 June 2006

²³ Chirstopher Heath, Fn.18

2.1.3 The relationship with trademarks law

Another form of IPRs similar to the GI is the trademark. In general terms, trademarks are signs, which are used in order to distinguish the goods or services of one undertaking from those of another.²⁴ The main function of trademarks is to distinguish the goods and/or services for which trademark is used.

Both trademarks and GIs are used to distinguish goods; however, a GI performs more functions than a trademark does. When GIs are affixed to a good, they inform to consumers that the good bearing GIs has certain qualities, reputation or other characteristics, whereas a trademark does not necessarily perform that function.

Trademarks law gives the owner of a trademark the exclusive right to use that mark in commerce.²⁵ Therefore, the trademark owners can prevent others from using its mark or one that is similar enough to cause consumer confusion. GIs, however indicate not a business, but a group of producers and traders. The exclusivity confers by GIs is not limited to one producer or trader but extend to all producers and traders located in that region, provided that the other conditions for GIs protection are satisfied.

There is currently little international consensus on the appropriate framework for GIs protection.²⁶ Some countries, including United States, use only trademark law to protect both GIs and trademarks. Other countries, led by the EU, advocate separate GIs protection in co-existence with trademark law. The U.S- EU debate over the protection of GIs has center around economically significant industries such as wine and spirits, but it extends to other products such as agricultural products and foodstuffs.²⁷

2.2 Protection of GIs under multilateral Agreement

Historically, GIs have received little international protection. Before 1994, the protection of GIs at international level was limited to three instruments: The Paris Convention, the Madrid Agreement, and the Lisbon Agreement.

2.2.1 The Paris Convention

The Paris Convention was established in 1883, which is the first multilateral agreement to consider the protection of GIs under the term ‘indications of source’ or ‘appellation of origin’, however, neither term is defined in the

²⁴ SCT/5/3

²⁵ Ava Gutierrez, *Geographical indicators: a unique European perspective on intellectual property*, Hasting International and Comparative law Review, Fall 2005, Vol 29

²⁶ Ibid

²⁷ Stacy D.Goldberg, Fn.1, p.1

Convention.²⁸

Under the Paris Convention, the main remedies against the unlawful use of an indication of source are the seizure of the product upon importation, or the prohibition of importation, or the seizure within the country.²⁹ Article 10 provides for border measures to be taken against the importation of goods bearing false representation of origin, though the Agreement does not define what constitute a false indication.³⁰ In addition, the use of a false indication of sources may constitute an act of unfair competition within Article 10 bis (2) (3).

2.2.2 The Madrid Agreement

The Madrid agreement confers additional protection for GIs as compared to the Paris Convention on following points:

First, the Madrid agreement binds Member States to prevent not only the use of ‘false’ indications of sources, but also the uses of sources which are ‘deceptive’, i.e., literally true but nevertheless misleading.³¹

Second, Article 3bis prohibits the use of false representation not only on the products itself but also in advertising or other form of commercial communication³². Further more, Article 4 prohibits member countries from treating ‘regional’ geographical indication of as generic term. This article is noteworthy, since it constitutes a departure from the general rule that the condition of protection of an indication of source, especially when a specific indication of source is considered as generic term, it is determined by the country in which the protection is sought.³³ However, the application of this article is limited to only wine products.

Due to the small number of member countries as well as divergent views on the construction of the text (for example, the use of term such as ‘style’ or ‘type’)³⁴, the treaty has not been effective to rule out false or deceptive uses of GIs in practice.

2.2.3 The Lisbon Agreement

By 1958, there had been several failed attempts to strengthen the protection of GIs. The successful end-result was the adoption of the Lisbon Agreement at the Lisbon Diplomatic Conference in 1958. The Lisbon Agreement is not

²⁸ The Paris Convention, Fn.7, Article 1(2)

²⁹ SCT/ 8/4, par 44

³⁰ It make no reference to the situation where a term is translated or where the name is accompanied by words such as ‘type’, ‘style’, or ‘like’

³¹ SCT/8/4, par 48

³² Jinghua Zou, *Rice and Cheese, anyone? The fight over TRIPS GIs continues*, Brooklyn Journal of International Law, 2005, p. 3.

³³ SCT/8/4, par 49

³⁴ Jinghua Zou, Fn.32, p.3

restricted to border system like previous Treaty, but also provides for their international Registration.³⁵

Unlike the Paris and Madrid Treaties, the Lisbon Agreement restricts protected GIs to only geographical name of a country, region, or locality, and which designate the quality and characteristics of the product that are 'exclusive or essentially due to the geographical environment, including natural and human factors',³⁶.

The Lisbon Agreement expands the protection of GIs by comparison with the previous Treaties. Article 3 controls 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', 'make', 'imitation', or the like.³⁷ It also extends protection against GIs becoming generic to cover all products.³⁸

2.2.4 The TRIPs Agreement

The Uruguay Round of Multilateral Trade Negotiation under GATT³⁹ contributed much to the protection of IPRs in general and of GIs in particular. On the negotiation, the EU, with support of Switzerland, saw an opportunity to enhance the international protection of GIs under French-style of protection, whereas US favoured using trademark law system.⁴⁰ In the end, Section 3 of the TRIPs Agreement contains provisions which provide relatively strong and effective protection of GIs.⁴¹ It could be said that TRIPs Agreement represents an important step toward the universal recognition of GIs, since unlike the previous Treaties, the TRIPs Agreement is the standard subscribed by all Member States of World Trade Organization (WTO).⁴²

The TRIPs Agreement contains some minimum standards for protection of GIs covering their definition, scope, and legal means for protection. Similar to the Lisbon Agreement, TRIPs limits its protection to certain type of GIs but the requirement of protection is less stringent than that of the Lisbon Agreement.⁴³ The TRIPs Agreement also confers the additional protection

³⁵ See also: *Lisbon System for the International Registration of Appellations of Origin*, available at: <http://www.wipo.int/lisbon/en/>, (02/05/2007)

³⁶ The Lisbon Agreement, Fn.11, Article 2

³⁷ Oskari Rovamo, *Monopolising names? The Protection of GIs in the European Community*, Mater thesis, Faculty of law- Helsinki University, August 2006, p. 22. See also SCT/8/4, par.55

³⁸ SCT/8/4, par.54

³⁹ General Agreement on Tariff and Trade (GATT)

⁴⁰ IPR Helpdesk, *Geographical indications*, at <http://www.ipr-helpdesk.org>, last updated on July 2006, p.5

⁴¹ Oskari Rovamo, Fn.37

⁴² David VIVAS-EUGUI (ICTSD) and Christophe SPENNEMANN (UNCTAD), *The Treatment of GIs in recent WTO Discussions and in Regional and Bilateral Agreements, Recent Multilateral and Bilateral Trends in IP Policy Making: Lessons and Challenges for Africa*, 6 of October 2006, p 1.

⁴³ Oskari Rovamo, Fn.37

of GIs for wine and spirits under Article 23. Article 24 provides some exceptions to GIs protection and international negotiation. It is important to note that failure to comply with TRIPs obligation is subject to the dispute settlement under Dispute Settlement Body (DSB).

The recent developments on protection of GIs under TRIPs are attracted much of discussion at international level. The Doha Round⁴⁴ mandates further debates on two separate issues concerning the protection of GIs: creating a multilateral register for wines and spirits and extending the higher level of protection beyond wine and spirits, discussed in Section III below.

⁴⁴The November 2001 declaration of the Fourth Ministerial Conference in Doha, Qatar, provides the mandate for negotiations on a range of subjects and other works. The negotiations include those on agriculture and services, which began in early 2000. The original mandate has now been refined by work at Cancún in 2003, Geneva in 2004, and Hong Kong in 2005.
See also http://www.wto.org/English/tratop_e/dda_e/dda_e.htm ,(02/05/2007)

3 Protection of GIs under TRIPs

3.1 Provisions in TRIPs

3.1.1 Definition of GIs

TRIPs defines GIs as “...indications which identify a good as originating in the territory of a Member or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attribute to its geographical origin”.⁴⁵ This provision in TRIPs constitutes a development on definition of GIs because neither the Paris Convention nor the Madrid Agreement contains a similar provision while the definition in the Lisbon Agreement was very restrictive.⁴⁶

The protection of GIs under Article 22 only offers for products whose qualities, reputation and other characteristics are essential attributable to their origin, though TRIPs does not specify any requirement for what is considered an ‘essentially attribute’.⁴⁷ Another restrictive and significant feature of the definition of GIs in the TRIPs Agreement is that only ‘goods’ are included, thus GIs for services are not covered.⁴⁸ The remained issue is the questions of which goods are protected under Article 22. Some scholars argued that the protection of GIs under Article 22 excludes goods which include ‘other human factor’, such as methods of production or manufacture, since TRIPs does not contain the words ‘including natural and human factors’ as did in the Lisbon Agreement.⁴⁹ This would mean that the scope of protection under Article 22 may be restricted to agriculture product and foodstuff. Others, however, argued that the wording of TRIPs does not so limit the protection but covers all kind of goods, as the definition of GIs in TRIPs does not expressly product-specific that limits to the scope of protection under the Agreement.⁵⁰

3.1.2 Substantive Standards

Article 22 (2) provides the substantive standards that the TRIPs Agreement was trying to accomplish throughout its Member States.⁵¹ It still leaves

⁴⁵ TRIPs Agreement, Fn.12, Article 22 (1)

⁴⁶ Graeme B. Dinwoodie, William O. Hennessy , and Shira Perlmutter, *International Intellectual Property Law and Policy*, LexisNexis, 2001, p.322

⁴⁷ Ibid

⁴⁸ Ibid

⁴⁹ Eva Gutierrez, Fn.25, p.4

⁵⁰ Comparing the TRIPS definition with some EC Regulation, Council Regulation 2081/92 or 509/2006, which contains language limiting the application to certain agricultural products and foodstuff

⁵¹ Graeme B. Dinwoodie, William O. Hennessy , and Shira Perlmutter, Fn.46, p.323

room for Members countries to apply their national concepts. GIs are protected by way of general prohibition on deceptive use, similar to the Madrid Agreement, and against unfair competition within the meaning of Article 10 bis of the Paris Convention.⁵² According to Article 22 (2) (a), two requirements must be fulfilled if a violation is alleged. First of all, a representation on a certain good must suggest its origin; second, such suggestion must be false or misleading.⁵³ Additionally, Article 22 (4) prohibits the use of a GI that is ‘literally true as to the territory, regional, or locality in which the goods originate’ but ‘falsely represents to the public that the goods originate in another territory’. This may be the case where a given geographical name exists in two different countries, but it is in use as an indication of source only for products originating from the place in one country. Use of such indication of source by a producer from the other country cannot be regard as use of ‘false’ GI, although consumers may be deceived by such use.⁵⁴

Further more, Article 22 (3) provides that Member States should refuse or invalidate the registration of a trademark which contains or consists of a GI, but only if such use of a trademark would be misleading.⁵⁵

3.1.3 Additional protection for wines and spirits

Article 23 provides a higher level of protection for wines and spirits. First, it provides legal means for interested parties to prevent the use of GIs to identify wines and spirits which do not originate in the place suggested by the GIs in question, even where the true origin of the goods is indicated.⁵⁶ Moreover, this prohibition applies to where ‘the GIs is used in translation form or accompanied by expression such as ‘type’, ‘kind’, ‘style’, ‘imitation’ or the like’.⁵⁷ Therefore, usages such as ‘American champagne’, or ‘type Champagne’ would fail this requirement even if they were truthful indicate.⁵⁸ The higher protection is clear under Article 23 (1) because GIs for wines and spirits are protected even when there is no danger that the public may be misled.⁵⁹

In additional, Article 23 (2) provides the refusal or validation of the registration of a trademark for wine or spirits which contains or consist of a GI, again at the request of an interested party. Finally, Article 24 (1) calls on Members to negotiate for increased protection of GIs under Article 23.

⁵² Jose Manuel Cortes Martin, *TRIPS agreement: toward a better protection for GIs?* Brooklyn Journal of International Law No. 117, 2004, p. 1

⁵³ Graeme B, Fn.46, p324

⁵⁴ Marcus Hopperger, *International protection of GIs- the present situation and prospect for future development*; Symposium on International protection of GIs- South Africa 1999.

⁵⁵ TRIPS Agreement, Fn.12, Article 22 (3)

⁵⁶ Ibid, Article 23 (1)

⁵⁷ Ibid

⁵⁸ Jinghua Zou, Fn.32, p.5

⁵⁹ TRIPs Agreement, Fn.12, Article 23

3.1.4 Recent developments on protection of GIs

WIPO has long been interested in developing and international approach to GIs. From early on, the draft Treaty on GIs and Model law for developing countries on appellation of origin and indication of source has been in existence.⁶⁰ The issue of GIs features regularly on the agenda of the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical indications (SCT).⁶¹ The protection of GIs is also one of two TRIPS issues to be discussed in The Doha Development Agenda and Ministerial Conference which opened in Doha, Qatar 2001. The Doha Declaration notes in its paragraph 18 that the TRIPS Council will handle the extension of GI protection under paragraph 12 (which deals with implementation issues).⁶² Since then, the Doha Round experienced some progress in the GIs discussion and negotiation albeit no ready solution to the further harmonization of GIs has been found.⁶³ Two remained issues concerning the protection of GIs are the establishment of a multilateral system for the notification and registration for GIs for wines and spirits, and the extension of additional protection provided for wines and spirits in Article 23 to all products. We have here, in fact the battle between the EU and the US concerning the means of protection which effects further progress on the harmonisation for the protection of GIs in the future.

3.2 A WTO case on GIs

3.2.1 Background and facts of case

There has been a long-standing disagreement between the EC and various other countries, including the US and Australia, over legal issues relating to GIs for agricultural products and foodstuffs.⁶⁴ This disagreement manifested itself in the recent dispute at the WTO, *European Communities- Protection of GIs for agricultural products and foodstuffs*.⁶⁵

The EC, influenced by its Members such as France and Italy which has long

⁶⁰ See WIPO Doc. TAO/II/2 (1975), WIPO Pub. No.809 (E) (1975)

⁶¹ See also: SCT/8/5; SCT/9/5, SCT/9/6; SCT/10/4, all SCT documents available at: <http://www.wipo.int/news/en/index.html> , (02/05/2007)

⁶² Par 18 of Doha Declaration states that “with a view to completing the works started in the Council for Trade Related Aspect of Intellectual Property Rights under the implementation of Article 23 (4) we agree to negotiate the establishment of a multilateral of notification and registration of GIs for wines and spirits by the 5th Section of the Ministerial Conference.

We note that issues related to the extension of the protection of GIs provided for in Article 23 to products other than wines and spirits will be addressed in the Council for TRIPS pursuant to par. 12 of this declaration”, WTO, WT/MIN (01)/ DEC/1 of 20 December 2001

⁶³ Hong Kong Ministerial Declaration did not record any notable progress concerning both issues, see Caluse 29 and 30, Six Session, Hong Kong, 13-18 December,2005

⁶⁴ Michael Handler, *The WTO Geographical indications Dispute*, the Modern Law Review Limited 2006, Vol 69 (1), p.70

⁶⁵ WTO documents WT/DS174R (15 March 2005) (EU-US Report), WT/DS290R (15 march 2005) (EC- Australia Report), Panel Finding WT/DS174/23 and WT/DS290/21 (25 April 2005).

history of protection of GIs for agricultural products, has considered such protection to be a part of agricultural and rural development policy. To this end, the EC has established through Council Regulation 2081/92, a Community-wide notification and registration system for its Members' GIs for agricultural products and foodstuffs.⁶⁶

The dispute was initiated by the US in June 1999.⁶⁷ At this time, the above Regulation provided that only parties within the EC Members could apply for or oppose against the registration of a GI in the EC and that only rights of owners of earlier *registered* trademarks would remain unaffected by a conflicting GI. The EC, implicitly accepting that the Regulation might not have complied with its international obligations, amended the Regulation in April 2003.⁶⁸ The amendment established GI registration procedures and rights of objection for non- EC nationals and provided safeguard for owners of earlier *unregistered* trademarks. However, the US continued to challenge the Regulation by sending the request for consultation in April 2003. Australia also participated, leading to a Dispute being heard by a Panel of the DSB in 2004.

In this case, Australia and the US raised a number of arguments before the Panel claimed that the amended Regulation was inconsistent with various international instruments, TRIPs Agreement in particular. Two main arguments were:

- The 1992 Regulation did not comply with national treatment rules where non-EC nationals with regard to the protection of non-EC GIs were concerned; and
- The 1992 Regulation denied owners of earlier registered trademarks the exclusive right to prevent third parties using later, conflicting GIs.

3.2.2 The national treatment argument

Australia and the US claimed that Article 12(1) of the 1992 Regulation as amended, which deals with the registration of GIs from non-EC countries, violated the principle of national treatment in Article 3(1) of the TRIPs Agreement.

Article 12(1) of the Regulation reads as follow:

...this Regulation may apply to an agricultural product or foodstuff from a third country provided that:

- the third country is able to give guarantees identical or equivalent to those referred to in Article 4,⁶⁹
- the third country concern has inspection arrangements and a right to objection

⁶⁶ Although the Regulation creates two categories of registered GI, namely PDOs and PGIs, both will be referred to as GIs

⁶⁷ Request for Consultation from the US, IP/D/19, WT/DS174/1, at <http://docsonline.wto.org>

⁶⁸ Council Regulation (EC) 692/2003, OJ L99/1

⁶⁹ Article 4 requires that the goods produced under the GIs must comply with specification.

- equivalent to those laid down in this Regulation,⁷⁰
- the third country concern is prepared to provide protection equivalent to that available in the Community to corresponding agricultural products for foodstuffs coming from the Community

The US and Australia claimed that the Regulation 2081/92 did not provide the same treatment to other nations and products originating outside the EC as it provides to the EC Member State and its products. They argued that these conditions under the Regulation made registration of non- EC members' GIs more difficult because it requires reciprocal and equivalent protection for GIs under their own laws. Given the standards of protection for GIs in Australia and the US, this meant that GIs from those countries could not be registered in the EC.⁷¹

The complainants also alleged that other provisions of the Regulation setting out registration procedures for non-EC GI owners violated the national treatment provisions of the TRIPs Agreement.⁷² The same argument is made to the provision which requires non-EC governmental authorities to intervene in these processes.⁷³

The EC, in its defense, argued that none of the above provisions discriminated on the grounds of nationality. Rather, it suggested that the Regulation merely set out different application and registration procedures based on whether the GI was located within or outside the EC, which it argued was unrelated to the nationality of the applicant for the GI. Second, the EC contended that the mere existence of these different procedures did not mean that it was applying less favourable treatment to non-EC nationals; rather, it claimed that the obligations placed on non-EC governments relating to applications and objections in fact corresponded with those placed on EC Members.

Concerning the discriminatory conditions, especially the registration of foreign GIs and requirement for reciprocal and equivalent for protection, the Panel held in favour of the US and Australia. The Panel noted that the key issue was whether the Regulation provided for the 'effective equality of opportunities' for EC and non-EC nationals.⁷⁴ In relation to Article 12(1), it held that this was clearly not the case since the equivalence and reciprocity conditions imposed a significant extra burden for non-EC nationals to register their GIs within the EC. It also held the application procedures and objection procedures constituted a less favour treatment to non- EC member countries. Finally, the Panel found that the 'government participation' requirement under the inspection structures violated TRIPs Article 3 (1) by

⁷⁰ The 1992 Regulation, Fn.15, Article 6-7

⁷¹ See WT/DS290/R, Complaint by Australia- Report of the Panel, par.7.301

⁷² See The 1992 Regulation, Fn.15, Article 12 (a) (1)-(2) which requires such parties to send application for registration to their government to be verified as to compliance with the Regulation

⁷³ See The 1992 Regulation, Fn.15, Article 12 (b) (d) which requires statement of objection to be sent to the objectors's governemtn before transmitted to the Commission

⁷⁴ Micheal Handler, Fn.64, p.74

providing an ‘extra hurdle’ to third-country applicants.⁷⁵

Pursuant to Article 19 of DSB, the Panel recommended that the EC brings the Regulation 2081/1992 into conformity with the TRIPs Agreement and GATT 1994 by amending the Regulation by 3 April 2006.⁷⁶

3.2.3 The trademarks argument

In relation with trademarks, Australia and the US also argued that the Regulation was inconsistent with Art 16 (1) of TRIPs. They argued that Article 14(2) of the Regulation breached Article 16(1) of TRIPs by allowing the co-existence of a later GI with an earlier registered trademark. This was said to deprive the exclusive right trademark owners to prevent the use of a confusingly similar GI. The US further claimed that Regulation 2081/92 was inconsistent with the EC’s obligation under Article 24 (5) of the TRIPs Agreement, since the Regulation failed to provide sufficient protection to pre-existing trademarks that was similar or identical to a GI.

In reply, the EC first relied on Article 14(3) of the 1992 Regulation which provided means for an earlier well-known trademark to prevent the registration of later GIs if such registration would be liable to mislead consumers.⁷⁷ It also argued that the co-existence of GIs and earlier registered trademarks was justified by either Article 24 (5) or Article 17 of TRIPs.

The Panel’s decision held that the EC could not rely on Article 14(3), since it limits exclusive right of trademark owner is so far as it can not prevent all situations from occurring in which Article 14 (2) would creates to limit the rights provided in Article 16 of TRIPs Agreement.⁷⁸ An example of its limitation is the usage of GIs ‘Bayerisches Bier’ (German for ‘Bavarian beer’) and ‘Budejovicke pivo’ (Czech for ‘Budweiser beer’) notwithstanding the EC’s acknowledge that their use might result in a likelihood of confusion with the earlier registered trademarks BAVARIA and BUDWEISER.⁷⁹ Therefore, the Panel concluded that the Regulation was *prima facie* inconsistent with Article 16.1 of TRIPs.

The Panel went on to consider whether Article 14(2) of the Regulation was justified, based on an exception to Article 16(1) of TRIPs. Article 24(5)

⁷⁵ See also Summary of WTO case at:

http://www.wto.org/english/tratop_e/dispu_e/cases_e/1pagesum_e/ds290sum_e.pdf
(02/05/2007)

⁷⁶ Ibid

⁷⁷ Article 14 (3) reads as: ‘a designation of origin or geographical indication shall not be registered where, in the light of a trade mark’s reputation and renown and the length of time it has been used, registration is liable to mislead the consumer as to the true identity of the product’

⁷⁸ G.E.Evans and Michael Blakeney, *The protection of Geographical indications*, Journal of International economic Law, No 9(3), p.601 which referred the case of a ‘little well-known’ trademark

⁷⁹ EC-US Report at 7.572-573, EC- Australia Report at 7.573-574

provides that a WTO Member's implementation of GI protection 'shall not prejudice . . . *the right to use*' an earlier trademark that is similar or identical to the later GI. The EC argued that it was implicit in this Article that WTO Members could prejudice *other rights* of trade mark owners, such as the right to prevent third parties from using confusingly similar signs as provided in Article 16. However, the Panel rejected this argument, concluded that nothing could be implied from Article 24(5) beyond its strict terms.⁸⁰ The Article stipulated merely that Member were not to prejudice the 'right to use' an earlier mark, it neither preserved the right of prevention in Article 16(1) nor authorised Members to prejudice such a right.⁸¹ The Panel held that Article 24(5) provides no guidance as to the scope of a trade mark owner's rights in relation to later, confusingly similar GIs. Therefore, the issue in question fell to be considered solely under Article 17 of TRIPs Agreement.

Article 17 permits WTO Members to provide limited exceptions to the right conferred by a trademark, which include the right provided in article 16(1) of TRIPs Agreement, such as 'fair use of descriptive terms'. The Panel concluded that Article 14(2) of the Regulation 2081/1992 was a permissible exception under Article 17 of TRIPs. It held that Article 14(2) was a 'limited' exception because it restricted a trademark owner's rights only in relation to those goods in respect of which the GI is registered, those parties entitled to use the GI, and the use of the GI in the precise form registered (that is, not in translation)

3.2.4 Conclusion

Perhaps the most striking about the outcome of the dispute is the limited practical impact it had on the protection of GIs at international level. It was said that the US's challenge to the co-existence provisions of the Regulation 2081/1992 could be explained by a desire to assist the American company Anheuser-Busch in its ongoing global dispute with Czech brewery Budjovický Budvar over the use of BUD and BUDWEISER,⁸² the Panel's findings are unlikely to resolve many of the outstanding issues between those parties.⁸³

While the US views the Panel Report as a victory against EC discriminatory policies, the EC views it as a validation of separate GIs protection regimes, supporting their arguments for stronger GIs protection at the WTO/national level.⁸⁴ Peter Mandelson, the EU Commissioner for Trade, described the

⁸⁰ Michael Handelt, Fn.64, p.75

⁸¹ Ibid

⁸² C- 216/01, *Budjovický Budvar, národní podnik v Rudolf Ammersin GmbH*, Rec.2003,p.I-13617

⁸³ The Panel's finding that the Regulation does not confer a positive right to use registered GIs in translation, meaning that the trademark owners can potentially prevent the use of such GIs, might however be relevant in continuing litigation in Europe between those parties.

⁸⁴ Jenifer Chu, *The latest development in the transatlantic big stink over cheese and other GIs*, Winter 2006, p.29

decision as “confirming that GIs are both legal and compatible with existing trademark systems, [and] this WTO decision will help the EU ensure wider recognition of GIs and protection of regional and local product identities.”⁸⁵

Inconformity with the Panel Decision, the Regulation 2081/1992 was replaced by Regulation 510/2006, which came into force on 31 March 2006. The new Regulation applied equivalent conditions to the procedures for registration of GIs located outside the EU.

⁸⁵ Press Release, European Commission, *Origin Labeling—WTO Panel Upholds EU System of Protection of 'Geographical Indications'* (Mar. 15, 2005)

4 Protection of GIs in the EC

4.1 Background on protection of GIs in EC

Europe is known for the diversity of its agriculture and its food and drink products. These products derive from Europe's natural environment and its farming methods, developed over centuries of agricultural activities. It is said that one of European agriculture's greatest assets is its reputation for producing quality foodstuffs, especially the products come from specific region as known as GIs.⁸⁶

GIs are an important matter for Europe. They also constitute one of the main pillars of the EU's Common Agricultural Policy.⁸⁷ Therefore, protection of GIs can be considered as crucial for consumer's protection and agricultural development in the EU. Commentators say that if TRIPs confers additional protection for wines and spirits, the EU regime provides strong position for protection of agricultural products and foodstuffs.⁸⁸

The need for EC-wide rules on GIs for agricultural products and foodstuffs became apparent almost immediately after the "Cassi de Dijon" case.⁸⁹ The judgment of the ECJ held that products legally produced and marketed in one Member state could be freely marketed in another. The Court's affirmation of the principle of the free movement of goods within the Community thereby removed any protection agricultural and food producers might have enjoyed in respect of measures having equivalent effect to quantity restrictions between Member states.⁹⁰

Before 1992, there is no common rule on the protection of GIs. Each Member state has its own approach for GIs protection either through general or specific rule. At EC level, several acts regulating product designation for wines and spirits were adopted from 1970s but there were no specific rules for agricultural products and foodstuffs.⁹¹ Council Regulation 2081/92 established a system of notification and registration of GIs and thus expanded the protection covering agricultural products and foodstuffs. This

⁸⁶ European Policy for Quality Agricultural products, January 2001, at http://ec.europa.eu/agriculture/publi/fact/quality/2007_en.pdf, (02/05/2007)

⁸⁷ Why do GIs matter to us?, Fn.2

⁸⁸ Kevin M. Murphy, *Conflict, confusion and bias under TRIPs Article 22-24*, American University International Law Review, 1181- 2004

⁸⁹ Case 120/78, *Rewe Centrale v. Bundesmonopolverwaltung für Branntwein* [1979] E.C.R. 649 (Cassi de Dijon)

⁹⁰ G.E.Evan and Michael Blakeney, Fn.78, p.853

⁹¹ Regulation 1576/89 laying own general rule on the definition, description and presentation of spirit drinks; Regulation 1601/91 laying down general rule on the definition, description and presentation of aromatized wines, aromatized wine-based drinks and aromatized wine-product cocktail.

Regulation created a *sui generis* system of indications of origin throughout the common market.⁹² Based on this system, many local producers are benefit from protection of their products. As of 20 March 2006, the number of regional and specific products other than wines and spirits for which names are registered under the 2081/92 Regulation was 727 and continues to grow.⁹³

In recent development on protection of GIs, the EU has adopted the New Regulation, replaced the 1992 Regulation as to comply with the ruling of the WTO Panel. It also adopted Regulation 1898/2006 laying down detailed rules of implementing of the New Regulation. The New Regulation does not differ too much from the 1992 one but it does introduce some new elements concerning the procedures for registration from non-EC Member countries and national opposition procedure for third parties who wish to oppose the registration of a GI. Because the New Regulation only recently came into force,⁹⁴ the ECJ has not many chances to rule on it. Therefore, much case law based on the 1992 Regulation may still be effective for the interpretation of the New Regulation.

4.2 Community protected-GIs.

4.2.1 PDO(s) and PGI(s).

The Regulation distinguishes between two types of GIs: Protected Designation of origins (PDOs) and Protected Geographical Indications (PGIs). The main difference between the two is the proximity of the connection between the product qualities and the geographical area.⁹⁵

PDOs, according to Article 2(1) (a), means the name of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff. In order to be protected under this Regulation, a PDO must fulfill three cumulative conditions:

- the product must originate in a specific geographical area;
- the quality or characteristic of the product must be essentially or exclusively due to a particular geographical environment with its inherent natural and human factors, and
- the production, processing and preparation of the product must be taken in the defined geographical area.

Traditional designations, i.e, those not using geographical name, are also considered as designation of origin if it fulfils the three conditions. The best illustration of such name is Feta, for cheese. Other designations, such as

⁹² G.E. Van and Michael Blakeney, Fn.78

⁹³ IP/06/339, *Council adopts improved on agricultural quality products*, at http://europa.eu.int/comm/agriculture/foodqual/quali1_en.htm, (02/05/2007)

⁹⁴ As of 31 March 2006

⁹⁵ Oskari Rovamo, Fn.37, p.38

symbol or image, are not eligible for registration as a PDO. A PDO requires products must have the quality or characteristic to be essentially or exclusively due to a particular geographical environment with its inherent natural and human factors. It is necessary to show that all stage of production, processing and preparation must be taken in the defined geographical area. There are some well-known PDOs in the EC including Roquefort cheese (France), Gorgonzola (Italy), Feta (Greece), Chianti Classico olive oil (Italy), and Prosciutto di Parma (Italy).

The second type of protected GI under the Regulation is known as PGIs. According to Article 2(1) (b), a PGI means the name of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff. Similar to PDOs, a PGI is also subject to three cumulative conditions:

- the product must originate in a specific geographical area;
- possesses a specific quality, reputation or other characteristic attributable to that geographical origin; and
- the production and/or processing and/or preparation of the product must take place in the defined geographical area.

Compare to PDO, a PGI is boarder in scope of protection in so far as it requires the product to be produced, process, or prepare in the geographical area. The requirements for a PGI less stricter than those pertaining to a PDO,⁹⁶ since the product need not originate entirely from the designate region and need only have one particular quality attribute to geographical are, compare to the majority of food's characteristic is exclusively due to the geographical area. A non-geographical name indicating a region or a specific place is also subject to register as a PGI provided that it fulfil the requirements above.⁹⁷ A number of different geographical names have been registered as PGIs, such as Newcastle Brown Ale for beer (UK), Pimiento Riojano for pepper (Spain), Toscano for olive oil (Italy)...

The New Regulation also provides that once PDOs or PGIs are registered under this Regulation, the indications 'Protected Designation of Origin' and 'Protected Geographical Indication' or the Community symbols associated with them must be appear on the labeling when products are marketed in the Community, however this obligation only applies to product placed in the market after 30 April 2009.⁹⁸

4.2.2 Criterion for protection

There are a number of difference criteria that must be satisfied for a name of an agricultural product or foodstuff to be registered as a PDO or PGI. It is helpful to distinguish between criteria relating to the 'name', and criteria that apply to the 'products' to which the name applies. Regarding the

⁹⁶ G.E.Van and Michael Blakeney, Fn.78, p.585

⁹⁷ The Regulation, Fn.16, Article 2(2)

⁹⁸ The Regulation, Fn.16, Article 8(2) and Article 20. Symbols are available at: http://ec.europa.eu/agriculture/foodqual/quali1_en.htm

criteria applies to products, it also necessary to note that only certain agricultural products and foodstuffs are subject matter to the Regulation.⁹⁹ However, there are two important requirements which a PDO or PGI must fulfil: they relate to the geographical area and products specification.

4.2.2.1 Geographical area

One of the most important elements in definition of PDOs or PGIs is geographical area. This definition helps GIs fulfil their origin and source functions;¹⁰⁰ it is also a characteristic of GIs which distinguishes them from other types of IPRs, especially trademarks. Under the Regulation, both PDOs and PGIs require the products must originate from a specific region, place or country.¹⁰¹ However, Article 2 (3) provides some exceptions, which certain geographical designations shall be treated as designation of origin where the raw material for the products concerned come from a geographical area larger than, or different from, the processing area, provided that:

- the production area of raw material is defined;
- special conditions for the production of the raw materials exist; and
- there are inspection arrangements to ensure that the conditions of raw material are fulfilled.

The geographical area matter was addressed in case T-109/97¹⁰² concerned the PDO - 'Altenburger Ziegenkäse' (goat cheese made in the Altenburg region, which must contain a minimum percentage of goat's milk).¹⁰³ The PDO- 'Altenburger Ziegenkäse' was registered by Germany under the previously effective Regulation No 2081/92. On 20 December 1993 the German authorities adopted a regulation on cheese, which identified 'Altenburger Ziegenkäse' as a designation of origin, the geographical area of manufacture corresponding to that designation comprised the districts of Altenburg, Schmölln, Gera, Zeitz, Geithain, Grimma, Wurzen and Borna and the city of Gera.

The applicants complained to several German Ministries on the ground that the German regulations on cheese had defined the area of manufacture of 'Altenburger Ziegenkäse' too widely, including in particular the district of Wurzen in Saxony, the place of establishment of the cheese maker Zimmermann GmbH, which has likewise manufactured a cheese, sold under the name 'Altenburger Ziegenkäse' since 1936. The applicants requested that the area of manufacture should be limited to the district of Altenburger Land, as the product 'Altenburger Ziegenkäse' could come only from the district which had given it its name. The Ministry rejected that request. The

⁹⁹The Regulation, Fn.16, Article 1

¹⁰⁰ Oskari Rovamo, Fn.37, p.40

¹⁰¹ The Regulation, Fn.16, Article 2 (1)

¹⁰² Case T-109/97, *Molkerei Großbraunshain GmbH and Bene Nahrungsmittel GmbH v Commission*, [1998] ECR II-3533

¹⁰³ See at

http://www.smul.sachsen.de/de/wu/sg/verbraucherservice/genuss_sachsen/tradi_spezi/alpha_gruppe/1566.htm, (automatically translate from Germany), (02/05/2007)

applicants then complained to the Commission, asking for an action for failure to fulfil obligations to be brought against Germany under Article 169 (now Article 226) of the EC Treaty.

The Court took the view that the German legislature was better placed than the Community legislature to define the geographical area, taking account of the particular features of production and marketing in the region.¹⁰⁴ In the present case, it was for the applicants to produce specific evidence of disadvantage to them and they had not succeeded at national level to provide the reason for having the designation restricted to a smaller geographical area, namely the district of Altenburger. They had not provided any evidence to show that the contested provisions were detrimental of their rights. Consequently, the application was dismissed.

Other case, such as Prosciutto di Parma (Parma ham) also illustrates this exception under Article 2 (3). The material to produce Parma ham does not only come from Parma, but extends to manufacturers using meat from pigs born and raised in 11 regions of central northern Italy.¹⁰⁵ As Oskari Rovamo said in his paper, if any PDO was always imply that raw material must come from the geographical area of production, the producers of Parma ham would not be provided with sufficient raw material to be able to continue their business.¹⁰⁶

The requirement of geographical area for PGIs is laxer than that for PDOs. It is clearly from the definition of PGIs that only one of the stages of production, processing, or preparation takes place in the geographical area that has given the designation of its name.

The issue of PGIs was considered in case C-269/99¹⁰⁷, which concerned the validity of 'Spreewälder Gurken' PGI, a kind of gherkins originating from Spreewald, Germany. A number of interested third parties raised objections to the application for registration of the designation 'Spreewälder Gurken'. They claimed that the geographical area referred to in the application applied only to the Spreewald (inland delta region), and not to the entire Wirtschaftsraum Spreewald (Spreewald economic zone, actually double the size of Spreewald), and that the processed product should not contain any raw materials from other production areas.

The national court referred the question to the ECJ. Among other questions, the national court considered that, since the true geographical area would be reflected in the case of product bearing the designation 'Spreewälder Gurken', the registration of a name as a PGI would mislead consumers.

¹⁰⁴ IPR Helpdesk, Fn.40

¹⁰⁵ Cosorzio del Prosciutto di Parma, Production Info, the pigs, at <http://www.prosciuttodiparma.com/eng/info/pigs/>, (02/05/ 2007)

¹⁰⁶ Oskari Ovamo, Fn.37, p. 40

¹⁰⁷ C-269/99, *Carl Kühne GmbH & Co. KG, Rich. Hengstenberg GmbH & Co., Ernst Nowka GmbH & Co. KG v Jütro Konservenfabrik GmbH & Co. KG* ('Spreewälder Gurken'), (2001), E.C.R. I-9517

The ECJ ruled that it was for the national courts to rule on the lawfulness of an application for registration of a designation. However, the Court held that the Commission could properly register the designation 'Spreewälder Gurken' as a PGI, because a foodstuff may be treated as originating from the geographical area concerned if it is processed or produced in that area, even if the raw materials are produced in another region.¹⁰⁸

In the most recent case, the Court of Appeals of UK has asked the ECJ for a preliminary ruling on whether the Department of the Environment, Food and Rural Affairs (Defra) was misapplication of the concept 'geographical area' in the 1992 Regulation when it decided to forward to the European Commission an application made by the Melton Mowbray Pork Pie Association (MMPPA) for the registration of "Melton Mowbray Pork Pie" as a PGI under the 1992 Regulation.¹⁰⁹ In this case, difference view on interpretation of phrase 'defined geographical area' in Article 2(2) (b) and Article 4 (2) of the 1992 Regulation are presented before the Court.¹¹⁰ Given geographical area in the specification which MMPPA applied for PGI was a large one which included not only Melton Mowbray¹¹¹ but other areas.¹¹² The claimant, Northern Food Plc, argued that the 'defined geographical area' refers to the same specific place (or region or country in appropriate cases) and to the same geographical origin. Hence, the 'geographical area' in this case must be Melton Mowbray, although it conceded that this could include the immediate vicinity of Melton Mowbray.¹¹³ The Defra and the MMPPA however, said that the 'defined geographical area' could be a wider area. They submit that the wording itself points to that conclusion, since if the 'defined geographical area' is the same 'the specific place', why use the different words?¹¹⁴

The Administrative Court, in considering the factual, referred to the judgment of the case *Commission of the European Communities v. Federal Republic of Germany*,¹¹⁵ concerned an application of the appellation "Sekt" and "Weinbrand" by Germany. In this case, the ECJ ruled that "an area of origin which is defined on the basis of either of the extent of national territory or a linguistic criterion can not constitute a geographical area capable of justifying an indication of origin".¹¹⁶ However, the Court of Appeal decided to refer the case to the ECJ for a preliminary ruling on

¹⁰⁸ Ibid, par. 61

¹⁰⁹ C-169/06, *Northern Food Pls v. Secretary of State for the Environment, Food and Rural Affairs* (Melton Mowbray pork pie), order of 15 February 200.

¹¹⁰ Crane J., *Northern Foods Plc v. Department for Environment Food and Rural Affairs, Melton Mowbray Pork Pie Association*, Queen's Bench Division (Administrative Court), 21 December 2005, E.T.M.R. 31

¹¹¹ In the county of Leicestershire

¹¹² Including the adjacent counties of Nottinghamshire, Northamptonshire and Lincolnshire.

¹¹³ See Crane J, Fn.110, par. 22

¹¹⁴ Ibid, par 23

¹¹⁵ C-12/74, judgment, 20 February 1975.

¹¹⁶ Ibid, par 8

March 2006.

The Defra has now adopted a decision which provides that manufacturers of Melton Mowbray Pork Pies, based outside the Melton Mowbray area in the British Midlands, could be given five years to transfer production if the European Commission grants the PGI status.¹¹⁷ Following the news from Defra, Northern Foods has decided to withdraw its appeal. The Court of Appeals has therefore sent a letter to the ECJ on 20 February 2007, informing it that it was withdrawing its request for a preliminary ruling.¹¹⁸

Although the ECJ did not rule on this case, however it seems that it will have to clarify the ‘geographical area’ definition in order to clarify the scope of GIs protection and consumers’ interests therein.

4.2.2.2 Product specification

‘Products specification’ is one of the central elements of the scheme established for the protection of GIs under the Regulation.¹¹⁹ The specification plays a number of different roles. During the registration process, it details the information that is used to determine whether a name should be protected. Once a name is registered, the specification sets out the standards that producers and processors must comply with if they wish to use the protected name. The specification also delineates the scope of GI protection.

Article 4 (2) provides a non-exhaustive list of the information that needs to be included in a product specification. The link between the quality and/or characteristic of the protected products and the geographical area is the key element, since it often involves different technical methods. If product specification requires an express link between products and its geographical origin, it could preclude protection for many geographical names because of lack scientific evidence on how the different element of the specification affect the products’ quality, especially in case of a PDO.¹²⁰ Therefore, Advocate General (AG) Colomer has suggested that the determination of the essential or exclusive link between the products and its *terroir* is not based on strict or exact science but on global evaluation of all factors from climate to the flora and from the fauna to the people.¹²¹

Product specification is mandatory, but is subject to amendment under Article 9 of the Regulation. This provides a way for groups of producers or

¹¹⁷ ‘Relief for Northern in Pie wars’, at:

<http://www.meatnews.com/index.cfm?fuseaction=article&artNum=12900>, updated April 14, 2007.

¹¹⁸ <http://curia.europa.eu>

¹¹⁹ Lionel Bently and Brad Sherman, *Intellectual Property law*, second edition, Oxford university Press, 2004, p.792

¹²⁰ Because the requirement on the link between product and its geographical origin of PDO is stricter than that of PGI

¹²¹ Opinion of AG Colomer in joint case C-465/02 and C-466/02, *Federal Republic of Germany and Kingdom of Denmark v. Commission of the European Communities* (“Feta II”), [2005] E.C.R., pars 194-196

individual with a legitimate interest to request an amendment of product specification, in particular in case of developments in scientific and technical knowledge or if the intention to refine the geographical area. It is necessary to describe and give reason for the amendment requested.¹²²

Developments in scientific and technical knowledge and refinement of geographical could each lead to an admenment of product specification. However, the question of whethere one can amend for commercial reason is unclear. An example here is the case of the Newcastle Brown Ale PGI, which covers a very famous UK dark brown beer, which has been produced since April 1927. The story began when Scottish and Newcastle Plc decided to close its Tyne Brewery in Newcastle and move the production of the beer across the river Tyne to Dunston and Gateshead with a view to cost reduction.¹²³ The products specification for Newcastle Brown Ale PGI limits production to the city of Newcastle upon Tyne and states that the production methods take water exclusive from that area. An application to cancel the registration of Newcastle Brown Ale is currently being considered at the European Commission.¹²⁴

The future of Newcastle Brown Ale PGI status is uncertain, it could be well said, though, that changing the traditional elements in production clearly breaks any links between the GIs and its underlying tradition.¹²⁵

4.2.3 Name may not protected as PDO or PGI

There are number of restrictions that are placed on the types of names that are registrable as PDOs or PGIs. Even if the criteria are otherwise satisfied, the proposed name may not be able to be registered as a PDO or PGI if it falls within Article 3 of the Regulation.

4.2.3.1 Feta- generic name or PDO

Article 3(1) provides that ‘names have become generic cannot be registered as PDO or PGI’. According to this article, ‘a name that has become generic’ means the name of an agricultural product or a foodstuff which, although it relates to a place or the region where this product or foodstuff was originally produced or marketed, has become a common name of an agricultural product or foodstuff in the Community. Issue concerning generic name are significant, since among some 700 GIs registered under 1992 Regulation, a considerable number name could be generic and thus not able to register. Example are Cheddar, Brie, Camembert, and Gouda.¹²⁶

¹²² The Regulation, Fn.16, Article 9 (1)

¹²³Newcastle Brown Ale, http://en.wikipedia.org/wiki/Newcastle_Brown_Ale , (02/05/2007)

¹²⁴ See at <http://www.defra.gov.uk/foodrin/foodname/UKingdom/newbrown.htm>, (02/05/2007)

¹²⁵ Okari Rovamo, Fn.37, p.44

¹²⁶ As is required by the 1992 Regulation, Article 3 (3), a non-exhaustive indicative list of a name of agricultural products and foodstuffs regarded as generic was presented by the Commission in 1996. However, it was not passed. See Proposal for a Council Decision

In order to determine whether a name is generic, the Regulation provides that all factors must be taken into account, in particular the situation in the Member States in which the name originates and in the area where the products are consumed, as well as the relevant national laws or Community laws. However, the Regulation also provides that once a name is registered, it cannot become generic.¹²⁷

The main discussion in relation to the generic character of GIs has concerned the 'Feta' case. The 12-year battle for the right to use the name 'Feta' for cheese is the best illustration for the difficulties involved in assessing the generic character of GIs.¹²⁸ As of October 2005, the judgment of the ECJ, which ruled that the term 'Feta' had not become generic, seems to be in favour of the Greek Government which restricted the use of the name 'Feta' to producers in Greece.¹²⁹

The name 'Feta' derives from Italian, which means 'slice' or 'piece'-designates a traditional white cheese in brine which has been made since time immemorial throughout Greece and in other Balkan states too. Its characteristics are dense texture, a natural whitish colour, a distinctive smell and a slightly acidic, salty, fatty taste.¹³⁰ By letter dated 21 January 1994, the Greek Government requested registration of the term 'Feta' as a PDO under the 1992 Regulation.

The dispute began from 1996, when the Commission registered 'Feta' as a PDO under Regulation 1107/96.¹³¹ The registration meant that the other cheese producer, for example Denmark, France and Germany, would have to cease using the name 'Feta' in labeling their cheese products. These countries then brought an action for annulment of Feta PDO before the ECJ.¹³² The main arguments in their submission were that 'Feta' did not meet the conditions for the registration as a PDO, since there is no link between the product and its geographical area and they considered 'Feta' to be a generic name within the meaning of the 1992 Regulation.

On this occasion, Germany, Denmark and France were successful in

drawing up a non-exhaustive, indicative list of the names of agricultural products and foodstuffs regarded as being generic, as provided for in Article 3 (3) of the Council Regulation 2081/92, COM/96/0038/FINAL, not published in the OJ.

See also, Lionel Bently and Brad Sherman, Fn.119, p.978.

¹²⁷ The Regulation, Fn.16, Article 13 (2)

¹²⁸ Oskari Romo, Fn.36, p.52

¹²⁹ Jeremy Reed, *Feta: A cheese or a fude? Federal Republic of Germany v. Commission*, E.I.P.R 2006, 28 (10), p.535

¹³⁰ Opinion of AG La Pergola on joint case C-289/96, C- 293/96 and C-299/96, *Kingdom of Denmark, Federal Republic of Germany and French Republic v. Commission of European Communities*, 15 September 1998.

¹³¹ Regulation 1107/96 on the registration of geographical indications and designation of origin under the procedure laid down in Article 17 of Council Regulation 2081/92.

¹³² Case C-289/96, C- 293/96 and C-299/96, *Kingdom of Denmark, Federal Republic of Germany and French Republic v. Commission of European Communities* ('Feta I'), [1999] E.C.R. I-1541.

applying for cancellation of the registration on the ground that 'Feta' had become a generic term for soft, white cheese made from sheep's or cow's milk.¹³³ The reason given by the ECJ was that the Commission had 'minimised' the importance of the situation existing in the Member countries other than State of origin, and had considered their national law to be entirely irrelevant.¹³⁴ It suggested that the Commission should have taken into account the existence of products marketed legally under the name 'Feta' in other countries.¹³⁵

Subsequently, having requested a survey of Member State in relation to the use of the name 'Feta' and its marketing in their territory, the Commission carried out its own survey in order to provide an exhaustive picture of the production and consumption of Feta in all Member countries.¹³⁶ Based on the result of survey and the Scientific Committee's Opinion¹³⁷, the Commission again concluded that the name 'Feta' had not become generic and approved the registration of 'Feta' as a PDO for Greek cheese.¹³⁸

Denmark and Germany appealed again to the ECJ for the similar.¹³⁹ In their argument, in addition to the argument used in the 'Feta I', they further stated that they had produced 'Feta' cheese for more than fifty years and the name had thus become generic.¹⁴⁰ However, the ECJ on this occasion upheld the legality of registration, holding that white cheese soaked in brine and called 'Feta' must originate from specific area in Greece.¹⁴¹

Although the Court acknowledges that the production of Feta in some European countries have been significant and of substantial duration, it noted that the production of Feta has remain concentrated in Greece, accounting 85% of consumption of Feta, per person and per year.¹⁴² Another reason for its judgment is that the labels used by non-Greek producers on their Feta cheese often referred the cultural tradition and civilization of Greece.¹⁴³ Taking account of these and similar factors, the Court concluded that the name 'Feta' had not become the generic name and it continued to invoke a Greek origin.

The ruling dramatically illustrates the breadth of the EU Regulation and its

¹³³ The name 'Feta' was deleted from Regulation 1107/96 by Regulation 1070/1999.

¹³⁴ C- 289/96, C-293/96 and C-299/96, Fn.132, par 87.

¹³⁵ Ibid

¹³⁶ Oskari Romavo, Fn.37, p.53

¹³⁷ The scientific Committee's Opinion, 24 April 2001

¹³⁸ Regulation 1829/2002 amending the Annex to Regulation 1107/96 with regard to the name 'Feta'. Point 30 of the recital identifies the reason for the re-instatement.

¹³⁹ C-465/02 and C-466/02, *Kingdom of Denmark and Federal Republic of Germany v. Commission of European Communities* ('Feta II'), [2005], <http://www.curia.eu.int/>

¹⁴⁰ Ibid, par 74

¹⁴¹ G.E. Evans and Michael Blakeney, Fn.78 , p.592;

See also the judgment , Fn.139, par.76

¹⁴² Case -465/02 and C-466/02, Fn.139, par.83, 85.

¹⁴³ Ibid, par.87

capacity to offer protection terms previously considered generic.¹⁴⁴ It also indicates how complicated it is to assess the character of a potentially generic name. Although a designation may be altered as a result of changes in production or processing techniques, it cannot be lost as a result of changes in understanding or usage of the protected name.¹⁴⁵

4.2.3.2 Homonymous name

The term ‘homonymous’ is used to describe the situation where there is two or more words that are spelt or pronounced in the same way but have different meanings. This is relevant to the case where there are two or more identical GIs which are used to designate the geographical origin of products stemming from different countries.¹⁴⁶ As SCT indicated, this situation often happen with region is situated along a river running through several countries, such as Rhine River,¹⁴⁷ or it may result from immigration.

In principle, a homonymous name that meets the requirement of the Regulation can be registered as a PDO or PGI, provided that there is clear distinction (in practice) between the registered name and the subsequent homonymous name.¹⁴⁸ However, if a homonymous name misleads the public into believing that products come from another country, it will not be registered, even if the name is used accurately for the territory, region or place that products come from.¹⁴⁹ In order to decide whether a homonymous name will be registered, the Regulation provides that it is necessary to ‘having regard to the need to treat the producers concern in an equitable manner and not to mislead the consumer’.¹⁵⁰

The Regulation, does allows the co-existence of the registered GI and the unregistered homonymous name provided that the homonymous name had legally and equitably been used for at least 25 years before 24 July 1993.¹⁵¹ In addition, the homonymous name has to satisfy other requirements, such as not exploiting the reputation of registered GI, the public could not be mislead as to the true origin of the product and all problem resulting from the conflict being raise before registration of name.¹⁵² Further, the Regulation states that even if these conditions are met, the homonymous name can only be used for a maximum of 15 years and producers must clearly indicate the true of origin on labeling.¹⁵³

4.2.3.3 Trademarks

In the light of a well-know trademarks, Article 3 (4) provides an absolute ground for refusing a registration of a GI. Further, a GI may be subject to an

¹⁴⁴G.E. Evans and Michael Balnkeney, Fn.78, p.593

¹⁴⁵The Regulation, Fn.16, Article 13 (3).

¹⁴⁶SCT/5/3

¹⁴⁷Ibid

¹⁴⁸The Regulation, Fn.16, Article 3 (3)

¹⁴⁹Ibid, Article 3 (3) (a)

¹⁵⁰Ibid, Article 3 (3) (b)

¹⁵¹Ibid, Article 13 (4) (a)

¹⁵²Ibid, Article 13 (4) (b) (c)

¹⁵³Ibid

objection made by legal or natural person of Member State or by third country if the registration of the GI would jeopardize the existence of a trademark which has been legally on the market for at least five years preceding the date of the publication.¹⁵⁴

Under the Regulation, registered GIs have priority over both prior or subsequent trademarks. However, a trademark is allowed to co-exist with the GI, provided that it was applied for, registered, established by use in good faith within the territory of the Community, before either the date of protection of PDO or PGI in the country of origin or before 1 January 1996.¹⁵⁵ The co-existence of GIs and trademarks is subject for many disputes over the years. Before the amended 1992 Regulation adopted, the issue in question was raised in mineral waters field, and related to the use of the words 'Kerry Spring' as a GI on mineral water bottles. This was in conflict with the mark 'Gerri' for products of the same description.¹⁵⁶ The question referred to the ECJ was whether a provision in a Trademark Directive,¹⁵⁷ limiting the ability of a trademark to prevent the use of a GI in 'honest practice' was applicable in this case.

The ECJ said that the provision in Trademark Directive only relate to the test whether the GI is used in accordance with 'honest practice' in industrial or commercial matters, bearing in mind the legitimate interested of the trademark owners. The Court concluded that the mere existence of likelihood of confusion between a mark and a GIs is insufficient to conclude that the use of that GIs is not in accordance with honest practices.¹⁵⁸ Therefore, infringement can only arise if GI is not in use honestly; it does not depend on whether the indication is used as a mark.¹⁵⁹

The phrases 'honest practices' and 'in good faith' in Article 14 (2) of the Regulation seem similar. In *Cambozola* case,¹⁶⁰ the ECJ suggested that the concept of 'good faith' must be viewed in the light of the entire body of legislation, both national and international, in force at the time when the application for registration of the trademark was lodged. The trademark owners cannot benefit from a presumption of good faith if the legislation in force at the material time clearly precluded acceptance of his application.¹⁶¹

In the light of recent cases concerning the co-existence of GIs with prior trademark, such as ruling on conflict between trademarks 'Budweiser' and

¹⁵⁴ Ibid, Article 7 (3) (c).

¹⁵⁵ Ibid, Article 14 (2).

¹⁵⁶ C-100/02, *Gerolsteiner Brunnen GmbH and Co. v Putsch GmbH*, judgment 07 January 2004, OJ C 47, 21.02.2004

¹⁵⁷ Article 6 (1) (b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate of law of the Member State relating to trademarks.

¹⁵⁸ C-100/2002, Fn.156, par. 25

¹⁵⁹ G.E.Evans and Michael Blakeney, Fn.78, p.595

¹⁶⁰ C-87/97, *Conorzio per la tutela del formaggio Gorgonzola v Käserei Champignon Hofmeister GmbH & Co. KG and Eduard Bracharz GmbH* ('Cambozola'), [1999] E.C.R-1301

¹⁶¹ Ibid, par.35

GIs ‘Budejovicke pivo’ (Czech for ‘Budweiser’ beer);¹⁶² taking into account the view of WTO Panel on GIs protection there, the EU again affirmed the high level of protection for GIs in the Community.

4.3 Protection of Community protected-GIs

A key element for IPRs owners in general, and for the owners of GIs in particular, is how their rights be protected against infringements. In this section, we will look at the situation where a registered name is infringed and what legal means the EC law confers on the the owners of GIs. While trademarks law confers ‘positive right’ on trademark owners, i.e., right to use the trademark, GIs regulations only give owners the ‘negative right’ to sue any party who infringes their rights..

4.3.1 Scope of protection

Article 13 (1) of the Regulation provides as follow:

Registered names shall be protected against:

- (a) any direct or indirect commercial use of a registered name in respect of products not covered by the registration in so far as those products are comparable to the products registered under that name or in so far as using the name exploits the reputation of the protected name;
- (b) any misuse, imitation or evocation, even if the true origin of the product is indicated or if the protected name is translated or accompanied by an expression such as ‘style’, ‘type’, ‘method’, ‘as produced in’, ‘imitation’ or similar;
- (c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product, on the inner or outer packaging, advertising material or documents relating to the product concerned, and the packing of the product in a container liable to convey a false impression as to its origin;
- (d) any other practice liable to mislead the consumer as to the true origin of the product.

In additionally, Article 13 also provides the protection of GIs against generic name and homonymous name. This Article sets out both types of activities that infringe, and how the underlying property interest is to be construed.¹⁶³ However, Article 13(1) implies that, for a GI to be infringed, it must be in ‘commercial use’, and are subject to ‘comparable products’. These requirements should be read while taking into account the exceptions provided in the Regulation, such as the use ‘in good faith’, or the similar concept of ‘fair use’ on trademarks law.

¹⁶² See C-245/02, *Österreichischer Zuchtverband für Ponys, Kleinpferde und Spezialrassen v Burgenländische Landesregierung*, Judgment 16/11/2002, Rec. 2004, I-10989

¹⁶³ Lionel Bently and Sherman, Fn.119, p.893

4.3.2 Protection of product specification

The starting point for ascertaining the scope of protection available for a PDO or PGI is the product specification.¹⁶⁴ Products specification contains all products' informations to be eligible for a protected PDO or PGI provided in Article 4 (2) of the Regulation. Products which do not comply with the product specification, therefore are prohibited from the use of such designation.

In order to ensure that products put on the market under PDOs or PGIs are compliance with the specification, the Regulation requires Member State to designate the competent authority or an authorized independent inspection body.¹⁶⁵ These authorities shall take all necessary procedures to verify that products are in compliance with the specification before being placed on the market. In case of non-EC Member countries' PDOs/PGIs, the responsibility lies on the public authorities or product certification bodies designated by that country.¹⁶⁶

One issue that has attracted a lot of attention is whether registration confers protection over what might be called 'secondary use of protected agricultural products'.¹⁶⁷ While the product specification requires the production, processing and preparation of the products must be carried out in the defined geographical area (for PDOs) or at least one of such stages above (for PGIs) must take place in that area, is it acceptable for specification to stipulate that the specific secondary activities- such as grating, slicing, bottling or packaging of products- must take place there? This question has been addressed several times by the ECJ.

In the early case on wine sector- 'Rioja',¹⁶⁸ the ECJ was asked for a preliminary ruling on whether Spanish national legislation, which imposed the obligation to bottle wine in the place of origin before it is exported to another member country, constitutes a measure having an equivalent effect on exports, contrary to Article 34 EC (now Article 29).

The Court accepted that the bottling of wines is an important operation which, if not carried out in accordance with strict requirements, could seriously impair the quality of the product. It further stated that bottling does not involve merely filling empty containers but normally entails, before filling, a series of complex oenological operations (filtering, clarifying, cooling, and so on) which, if not carried out in accordance with the prescribed rules of the trade, may adversely affect the quality and alter the characteristics of the wine.¹⁶⁹ Despite this, the ECJ ruled Spanish national

¹⁶⁴ Ibid

¹⁶⁵ The Regulation, Fn.16, Article 10

¹⁶⁶ Ibid, Article 11

¹⁶⁷ Lionel Bently and Sherman, Fn.119, p.893

¹⁶⁸ C-47/90, *Établissements Delhaize frères et Compagnie Le Lion SA v Promalvin SA and AGE Bodegas Unidas SA* ('Rioja I'), [1992] E.C.R. I-3669

¹⁶⁹ Ibid, par.18

constituted a measure having equivalent effect to export within the meaning of EC law.

Until 'Rioja' was brought sencond time before ECJ by Belgium,¹⁷⁰ the ECJ was persuaded by the EC Comission's wine experts and ruled that the requirement at issue, whose aim was to preserve the considerable reputation of Rioja wine by strengthening control over its particular characteristics and its quality, was justified as a measure protecting the '*denominación de origen calificada*' and was not contrary to freevoment of goods in the EC Treaty.¹⁷¹

Although, this case related to wine sector and in relation to free movement of goods, it has been applied in subsequent case law to the field of agricultural products and foodstuffs.

4.3.2.1 The Grana Padano Cheese Case

This case¹⁷² concerned the PDO 'Grana Padano', which was registered for cheeses. This registration was subject to the condition that the grating of the cheese be carried out in the region of production and packaging. The defendant, Ravil, imported, grated, pre-packaged and distributes 'Grana Padano' cheese in France which it marketed under the designation 'Grana Padano râpé frais' (Grana Padano freshly grated). Two Italian cheese producers brought an action against the defendant in the Commercial Court, Marseille (France) seeking an injunction and damages. The Court granted both applications and on appeal, the Court of Appeal upheld the judgment; stayed proceeding and referred question on interpretation of Article 29 EC to the ECJ. The question was whether Article 29 EC was to be interpreted as precluding national legislation reserving the Grana Padano designation of origin for cheese grated in the region of production, in so far as such an obligation is not indispensable for preserving the specific characteristics which the product has acquired.

In its ruling, the ECJ agreed with Avocate General Alber on ground that the requirement for grating and packaging cheese in the region of production constitutes a measure having equivalent effect to a quantitative restriction on export within the meaning of Article 29 EC. However, the Court concluded that the grating and packaging of cheese constitute an important operation which, if they are carried out in conditions that result in a product not possessing the organoleptic qualities expected, may harm the quality and reputation of designation of origin.¹⁷³ With reference to 'Rioja II' case, the ECJ then held that the measure in question was justified under Article 30 EC.¹⁷⁴

¹⁷⁰ C-388/95, *Kingdom of Belgium v. Kingdom of Spain* ('Rioja II'), [2000], E.C.R. 3123.

¹⁷¹ *Ibid*, par. 75 & 76

¹⁷² Case C-469/00, *Societe Ravil v Societe Bellon Import and Societe SPA Biraghi*, judgment of May 20, 2003

¹⁷³ *Ibid*, par. 53

¹⁷⁴ *Ibid*, par. 48, 49

4.3.2.2 The Parma ham case

Similar issue was raised before the ECJ in the Parma ham case,¹⁷⁵ which concerned the dispute between the Consorzio del Prosciutti di Parma (Consorzio) and Asda Store Ltd and Hygrade relating to the secondary use of Parma ham (which is translation from English of Prosciutto di Parma) in UK.

‘Prosciutto di Parma’ is registered as a PDO under the 1992 Regulation and Consorzio is registered as an inspection body for the PDO under Article 10 (2) of the Regulation. In addition, Italian Law No 26 on the protection of the designation of origin ‘Prosciutto di Parma’ reserves the designation ‘Prosciutto di Parma’ exclusive to ham market with a distinguished mark allowing it to be identified at any time, obtained from fresh legs of pigs raised and slaughtered in mainland Italy, produced in accordance with provisions laid down by law.¹⁷⁶ Further more, Article 25 of the implementing Regulation of that law prescribed that the slicing and packaging of Parma ham must be taken place in the designated area, which approved by Consorzio.¹⁷⁷

The dispute arose when Hygrade purchased Parma ham that had been boned but not sliced, from a Member of Consorzio. There was no dispute until Hygrade then sliced the ham, placed it into packets, and sold it to the British supermarket chain, Asda. After that, the ham was sold in Asda’s supermarkets, where the packet bore the phrase ‘Asda: A taste of Italy PARMA HAM Genuine of Italian Parma ham’. The back of the packets states ‘PARMA HAM all authentic Asda continental meats are made by traditional method to guarantee their authentic flavour and quality’ and ‘Produce in Italy, packed in the UK for Asda Stores Limited’.¹⁷⁸

The Consorzio brought an action against Asda and Hygrade in the UK, seeking injunctions to prohibit their activity on the ground that it was contrary to the specification for the PDO ‘Prosciutto di Parma’. After failing in the first and second instances, Consorzio appealed to the House of Lord, who referred a number of questions to the ECJ. In particular, the ECJ was asked whether the Italian legislation reads with Regulation 1107/96 and the specification for PDO ‘Prosciutto di Parma’ created an enforceable right for Consorzio to restrain the retail sale of Parma ham which not had been sliced, packaged and labeled in accordance with the product specification.

Applying the judgment ‘Rioja’ case, the Court held that the condition of the PDO ‘Prosciutto di Parma’ requires the product must be sliced and packaged in the region of production constitutes a measure having

¹⁷⁵ Case C-108/01, *Consorzio del Prosciutto di Parma and Salumificio S. Rita SpA v Asda Stores Ltd and Hygrade Foods Ltd*, judgment of May 20, 2003

¹⁷⁶ *Ibid*, par. 3

¹⁷⁷ *Ibid*, par.7

¹⁷⁸ *Ibid*, par 22-24

equivalent effect to a quantitative restriction on exports.¹⁷⁹ The issue was whether the measure in question was justified under EC law. The Advocate General did not support Consorzio's arguments on the ground that it had not put forward a convincing argument in support of the contention that the slicing of ham in the region of production was a process which conferred particular characteristic on that ham, or which was essential in order to preserve the specific quality of the ham during the production.¹⁸⁰ However, contrary to the Opinion of Advocate General, the Court accepted that the measure in question was justified for the purpose of guaranteeing the authenticity and quality of the product.¹⁸¹ The Court further noted that the slicing and packaging of Parma ham constituted important operations which may harm the quality and the reputation of the PDO if they were carried out in conditions that result in a product not possessing the organoleptic qualities expected.¹⁸² Consequently, the Court ruled that the condition of slicing and packaging in the region of production, whose aim was to preserve the reputation of Parma ham may be regarded as justified as a measure protecting the PDO.¹⁸³

The central point of these two judgments is the discussion of the extent to which the content of specifications is crucial to the designations of origin.¹⁸⁴ Both specifications of 'Grana Padano' and 'Prosciutto di Parma' preclude the secondary use of protected products, i.e. slicing, grating and packaging, from taking place outside the region of production so as to guarantee the quality and authenticity of the PDOs.

4.3.3 Protection against misuse of registered name

Registered names are protected against any direct or indirect commercial use in respect of products not covered by the products specification. Article 13 (1) (b) provides the protection for registered GIs against any 'misuse, imitation or evocation' even if the true origin of the product is indicated. This is also case when the name is translated or accompanied by an expression such as 'type', 'style', 'method' etc...

None of the regulations on GIs provides a definition or specifies what is meant by 'misuse', 'imitation' or 'invocation'.¹⁸⁵ A name is considered as 'evocation' where the term used to designate a product incorporates part of a protected designation, so that 'when a consumer is confronted with the name of a product, the image triggered in his mind is that of the product

¹⁷⁹ Ibid, par. 59

¹⁸⁰ Bernard O'Connor, *Overview of the EC case law protecting Geographical indications. The slicing of Parma ham and the grating of Grana Padano Cheese*, E.I.P.R., [2004], p315
See also, Opinion of Avocate General Alber in C-108/01, Fn.175, par 76-81

¹⁸¹ Case 108/01, Fn.175, par.60

¹⁸² Ibid, par.68

¹⁸³ Ibid, par 78

¹⁸⁴ Bernard O'Connor, Fn.180, p.317

¹⁸⁵ Osaki Romavo, Fn.37, p.69

whose designation is protected'.¹⁸⁶ In this case, producers of Gorgonzola had brought proceeding against Hofmeister in order to stop it from making blue cheese in Austria under the name 'Cambozola' on the ground that the use of 'Cambozola' infringed their protected name, Gorgonzola. The ECJ concluded that the name Gorgonzola had been evoked, since Cambozola is a soft blue cheese which is clearly phonetically and visually similar in appearance to 'Gorgonzola' because both product ending in the same two syllables and contains the same number of syllables.¹⁸⁷

Like trademarks law, Article 13 (1) (a) of the Regulation also provides protection for registered name against exploitation of its reputation. The concept of exploiting includes where there is a clear taking of unfair advantaged and free-riding on the coat-tails of a famous or an attempt to trade upon its reputation.¹⁸⁸ The Ruling of the Court of Appeal of Paris on 15 December 1993 cancelled the registration of the name 'Champagne' for perfume emphasized its consistence with EC law. The National Institute for Appellation of Origin (INAO) and Inter-professional Committee for Champagne Wine (CIVI) brought proceeding against Yves Saint Laurent when it launched its new perfume 'Champagne', seeking termination of the unlawful misappropriation of the word "champagne". The Court held that 'the defendants had deliberately adopted a parasitic behaviour and diverted the fame of the name "champagne" which only producers and traders of this wine could exploit.¹⁸⁹

The judgment of Court of Appeal of Paris was consistence with the ruling of the ECJ in *Winzersekt*¹⁹⁰ which concerned the use of the term 'bottle-fermented by the champagne method' to describe certain quality of sparkling wine after 31 August 1994.¹⁹¹ Because the Regulation 2333/92 precludes persons who were not entitle to indicate their sparkling wines as 'champagne' from using the word 'champagne method', a German wine growers' association challenged the Council Regulation on the ground that the Regulation would deprive them of the right to do business fairly and affect their economic interests.

The ECJ said that the GI has a purpose beyond that of protecting the consumer against confusion about the origin of goods. It also protected the goodwill arising from investment in a region which produces genuine goods against misappropriation by others who have not made the same investment. In other words, 'champagne method' has a value because of the investment of French sparkling wines producers in producing their specific product, and

¹⁸⁶ Case C-87/97, *Consorzio per la Tutela del Formaggio Gorgonzola v. Kaserei Champignon Hofmeister*, [1999], ECR I-103, par. 25

¹⁸⁷ *Ibid*, par. 27

¹⁸⁸ C-375/97, *General Motors Corporation v. Yplon SA*, [1999], E.C.R I-5421

¹⁸⁹ 'Champagne' perfume by Yves Saint Laurent, Court of Appeal of Paris, 15 December 1993, E.I.P.R-II (1994), National Report, D-74

¹⁹⁰ C-306/93, *SMW Winzersekt GmnH v. Land Rheinland-Pfalz* [1995] 2 CMLR 718

¹⁹¹ The entry into force of Regulation 2333/92 laying down general rules for description and presentation of sparkling wines and aerated sparkling wines.

German wine producers may not free ride on this investment.

The registered name 'Champagne' come before the Germany Court once again in a case concerning the use of the word 'Champagne' to sell IBM computer. It was decided under German Trademark Act which also protected GIs.¹⁹² The defendant had used the slogan 'Get Champagne for the price of sparkling wine: IBM Aptiva now at a bargain price' to distribute his products. The plaintiff claimed that the advertising unfairly exploited the special reputation of designation of origin 'Champagne' without complying with the specification. The Federal Supreme Court held that by comparing the term Champagne to sparkling wine, the defendant conveyed the idea to the reader that in buying an IBM Aptiva computer he would be buying an exclusive and high-quality product at a bargain price. The Court found that this exploitation was unfair.

4.3.4 Protection against unfair competition

Article 13 (1) (c) provides that the registered names are protected against 'any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product, on the inner or outer packaging, advertising material or documents relating to the product concerned, and the packaging of the product in a container liable to convey a false impression as to its origin'.¹⁹³ In addition, registered name are also protected against 'any other practice liable to mislead the public as to the true origin of the product'.¹⁹⁴

The scope for the protection of GIs against unfair competition is thus very wide. It may be hard to specify all possible situations where unfair competition law can supplement to the products specification and national law protection. According to Article 13 (1) (c) (d), registered names are protected against any kind of activities which would be deceptive. This may have been the case where the Court of Appeal of Paris decided under French law that it was misleading advertising by displaying '*Café de Paris Brut ou demi sec*' bottles on a catalogue page title 'champagne' whereas those bottles was sparkling wine.¹⁹⁵ The court ruled that the place of the term 'champagne' in the advertisement could lead consumer to believe that the bottles shown on the same catalogue page belonged to the champagne category. The fact that the price between the sparkling wine and champagne bottles was very different and the prices were indicated in the catalogue did not remove the possibility that consumers might be misled since an average consumer is not aware of the lowest possible price for champagne.¹⁹⁶

¹⁹² IZR-290/99 – '*Get Champagne, Pay for Sparkling Wine*', International Review of Intellectual Property and Competition Law, Vol.33, No8/2002

¹⁹³ The Regulation, Fn.16, Article 13 (1) (c)

¹⁹⁴ Ibid, Article 12(3) (d)

¹⁹⁵ Misleading advertising: Champagne wine, AIDV/IWLA Bulletin N°29 Juillet/July 2002, at http://www.aidv.org/bulletin/bull29_07-2002.htm, (02/05/2007)

¹⁹⁶ Ibid

Oskari Romavo suggested that it might be useful to look at the Misleading and Comparative Advertising Directive¹⁹⁷ as guidance for understanding the scope of protection against deception provide by the Regulation.¹⁹⁸ The Misleading and Comparative Advertising Directive states that in order to determine whether an advertising is misleading, all its features must be taken into account, in particular, any of information it contains concerning geographical or commercial origin or the results to be expected from their use.¹⁹⁹

4.4 Protection of third countries' GIs

In compliance with the WTO Panel, the New Regulation introduces new procedure for registration GIs from third countries. The key elements introduced by the New Regulation as follows:

- *Amended registration procedure for PDOs and PGIs from producers from third countries*

The provisions concerning equivalence and reciprocity for products from third countries have been deleted in order to allow names corresponding to geographical areas in those countries to have access to the European system for the protection of GIs. Article 5 provides that registration is open to associations of producers from third countries provided that the name is protected in its country of origin and comply with the application.²⁰⁰ Under the amended procedure, foreign applicants will no longer have to seek examination and transmission of applications from their national governments. From 3 April 2006, applications for registration of PDOs and PGIs from producers in third countries may be made directly with the European Commission on a single form, reducing the time needed for the application and approval process.²⁰¹

- *Amended objection procedures applicable for groups and individuals in third countries*

With respect to the objection procedures, the new Regulation deleted the former requirement of verification and transmission of objections by third party governments. The amended Regulation provides the opportunity for any natural or legal person having a legitimate interest in a Member State or a third country to notify their objection to the proposed registration.²⁰² From 3 April 2006, therefore, objections to applications by groups, organizations or individuals in third countries, can be made directly to the European

¹⁹⁷ Directive 84/450/EEC relating to the approximate of laws, regulations and administrative provisions of the Member states concerning misleading advertising

¹⁹⁸ Oskari Romavo, Fn.37, p. 77

¹⁹⁹ Directive, Fn.197, Article 3 (a)

²⁰⁰ The Regulation, Fn.16, Article 5 (9)

²⁰¹ Ibid.

²⁰² The Regulation, Fn.16, Article 7 (1) (2)

Commission on a single form statement of objection.²⁰³

- *Amended inspection requirements in respect of third country registrations*

The requirements of government participation in the inspection structures and the provision of the declaration by governments under the 1992 Regulation have been amended by Article 11(2). According to this article, products, before placing on the market, shall be verified as being in compliance with the products specification by one or more public authorities designated by the third country and/or one or more product certification bodies.²⁰⁴

Notwithstanding the above amendments, the impact of the WTO decision in EC–Geographical Indications and consequent amendments remains to be seen. To what extent can developing countries benefit from the European model of GI protection? Will the outcome in fact make easier for third countries, developing countries in particular to protect their GIs in Europe? More broadly, in view of the Commission’s aim to obtain, by means of the TRIPs Agreement, the international promulgation of the European regulatory model, can it actual offer developing countries the promised advantages?²⁰⁵

²⁰³ Ibid

²⁰⁴ The Regulation, Fn,16, Article 11 (2)

²⁰⁵ E.G.Evan, Fn.78, p. 603

5 Protection of GIs in Vietnam

As mentioned earlier, GIs is a legal norm originating in Europe and reflects to a large extent the view of the European countries. Through the WTO's TRIPs Agreement, this norm has been transplanted to nationals around the world, including the countries of Asian.²⁰⁶

Vietnam, like other Asian countries, has not had their own type of GIs protection in the past. The law on GIs is made by implementing international treaties, especially TRIPs provisions in their domestic laws. However, by comparison with other countries in the ASEAN,²⁰⁷ Vietnam has led the way in protecting GIs by adopting the Civil code 1995 and the Decree implementing the Civil code which contains provisions for the protection of GIs.²⁰⁸ On the accession of Vietnam into the WTO, Vietnam revised its rules to provide adequately protection for IPRs in general and for GIs particular in order to comply with TRIPs provisions. To the end, the specific IP law was adopted in 2005 and came into force at 1 July 2006.²⁰⁹

5.1 Protection of GIs in legislations

5.1.1 Current legislations on GIs

Originally, Vietnam had no legal rules dealing specifically with GIs. Before the IP law was adopted in 2005, regulations on GIs were regulated in the 1995 Civil code and implementing regulations of the Civil code, such as Decree No.63/CP²¹⁰; Decree No.54/2000/ND-CP²¹¹; Circular No.30055-TT/SHCN²¹². Although framework for GIs protection existed in the national provisions, it only provided general principles, which was not easy to actualise.²¹³ It was difficult for foreign and local GI users to understand what the criteria for recognition of a GI and how to enforce its provisions.

²⁰⁶ Min Chiuang Wang, *The Asian Consciousness and Interest in GIs*, The Trademark Reporter, Vol 906, July-August 2006, p.1

²⁰⁷ Association of South Earth Asian Nationals (ASEAN)

²⁰⁸ Tran Viet Hung, Deputy General Director National Office of Intellectual Property of , speech at Seminar " EU-ASEAN on GIs: the way to enter into market", Hanoi-Vietnam, 7-8 October, 2003, at: <http://www.vnn.vn/kinhte/toancanh/2003/10/31626>, (02/05/2007)

²⁰⁹ Law on Intellectual Property, 2005 (hereafter the IP law)

²¹⁰ Decree 63/CP of October, 1996 of Government on detailed provisions concerns industrial property rights, as amended and supplemented by the Decree No.06/2001/ND-CP of February 1, 2001 of the Government

²¹¹ Decree No. 54/2000/ND-CP of 3 October 2000 of the government on the protection of industrial property rights to business secrets, GIs, trade names and on protection against unfair competition in respect of industrial property

²¹² Circular No. 30055-TT/SHCN of December 31, 1996 of the Ministry of Science, Technology and environment guiding the implementation of the regulations on the procedures for establishing industrial property rights and other regulations in Decree No. 63- CP

²¹³ *Geographical indications, an urgent need of legal frame for protection*, available at <http://vietnamnews.vnnet.vn/2004-04-07/columns/talkinglaw.htm>, (02/05/2007)

For one example, the provisions provided for the protection of both appellation of origins and of GIs, however there was no clear definition of GIs, though there was for appellation of origins.²¹⁴ In addition, the laws failed to distinguish between an appellation of origin and a GI, since it did not provide an explicit criterion of either one. As a consequent, some fish sauce producers in Phu Quoc Island were unclear whether their products, made in Phu Quoc but bottled elsewhere, could have GI protection.²¹⁵

It is noteworthy that in former regulations concerning the protection of GIs, the rights to a GI arose automatically without the need for registration with competent of State agencies, provided that all conditions for the protection are satisfied.²¹⁶ This provision made things very difficult in practice, since it is not easy to provide efficient evidences that all requisite conditions exist nor how public can recognize them. It appears even more difficult to foreign GI users to obtain GI recognition and protection in Vietnam. In fact, there are very few foreign GIs official recognised in Vietnam: Cognac brandy is one.²¹⁷ A further problem was the lack of uniformity in the various provisions, extending even to conflict between them.

In its effort to integrate globally, especially on the accession to the WTO, Vietnam has been doing its best to improve the legal system. The Civil code 1995 was revised in 2005 and contained some changes concerning GI protection.²¹⁸ More important, the new IP law- the first independent legislation on IPRs, has officially come into effect on 1 July 2006 which addresses almost every aspect of IPRs protection including GIs. The Government has also adopted the guiding implementing regulations of the law, such as Decree No.103/2006/ND-CP²¹⁹; Decree No.105/2006/ND-CP²²⁰; Decree No. 106/2006/ND-CP²²¹.

The new IP law and its detailed provisions provide a sufficient and adequate

²¹⁴ Article 786 of Civil Code defines appellation of origin as ‘a geographical name of a country or locality that is used to indicate the origin of the goods as being in that country or locality, provided that the goods have characteristics or qualities that reflect the specific and advantageous geographical conditions of a natural or human character or the combination of thereof; Article 10, 11, 12, 13 of Decree 54/2000/ND-CP provide the protection of GI but there is no definition of a GI.

²¹⁵ See *Geographical indications, an urgent need of legal frame for protection*, Fn.213

²¹⁶ Decree 54/2000/ND-CP, Fn.211, Article 5

²¹⁷ NOIP, Industrial property statistic, available at http://www.ecap-project.org/fileadmin/ecapII/pdf/en/information/vietnam/ip_vn_statistics_2006.pdf, 02/05/2007

²¹⁸ Article 750 stipulates the objects of industrial property rights and rights to plant varieties, including rights to GIs

²¹⁹ Decree No.103/2006/ND-CP of the Government of September 22, 2006 making detailed provisions and providing guidelines for implementing certain Articles of the Intellectual Property Law concerning industrial property.

²²⁰ Decree No.105/2006/ND-CP of the Government of September 22, 2006, making detailed provisions and providing guidelines for implementation of certain Articles of the Law on Intellectual Property regarding Protection of Intellectual Property Rights and State management of intellectual property

²²¹ Decree No. 106/2006/ND-CP of 22 September 2006 the Government on handling administrative violations in the field of industrial property;

framework for the protection of IPRs in general and of GIs in particular. They comply fully with BTA²²² and the TRIPs provisions.²²³ Furthermore, the protection of GIs in Vietnam is supported by miscellaneous laws, such as the Criminal Code of 1997, Criminal Procedure Code of 2003, Civil Procedure Code of 2005, the Custom Law of 2001, the law on Competition 2004 and other implementing regulations.

5.1.2 Protection of GIs in the IP law

With respect to GI protection, the IP law comprises many new progressive regulations which are well suited to the situation of Vietnam but also satisfy the standard of international treaties, especially the TRIPs Agreements. In comparison with former regulations, the IP Law provides essential legal procedures and has clear and flexible structure. It will be fully effective and should achieve the goal of encouraging initiative, luring investment and promoting development.

5.1.2.1 Criterion for GIs protection

In Vietnam legal system, GI is object of industrial property rights.²²⁴ The 2005 IP Law provides for a single model of protection applicable to all types of GIs, including appellations of origin.²²⁵ However, Article 36 of Decree No.103/2006/ND-CP stipulates that applications for registration of GIs after 1 January 2006 and before 1 July 2006 shall be processed as application for registration of appellations of origin in accordance with the 1995 Civil code.²²⁶ Therefore, some GIs continue to be protected as an appellation of origin, whereas later applications for registration under the IP law will be protected as GIs.

The concept of a GI is interpreted in Article 4 as ‘a sign used to indicate a product originating in a specific area, locality, region or country’. Compare to the concept of GIs in Decree No.54/2000/ND-CP, the IP law does not limit GIs as ‘information is expressed in words, signs, symbols or images’²²⁷, but only ‘sign’. This provision can be interpreted in such a way that a three dimensional image, a smell or a sound can be protected as a GI.²²⁸ This regulation is not contrary to the TRIPs Agreement, since TRIPs defines GI as ‘indications’, but is not limited to any particular kind of indications. Furthermore, if the TRIPs provides GIs protection for ‘goods’ only, the EC Council Regulation 510/2006 limits GIs protection for agricultural products and foodstuffs, the IP law and its implementing

²²² Bilateral Agreement on Trade between United State of American and Vietnam July 2000

²²³ WTO documents, WT/ACC/VNM/48 27 October 2006, Report of the Working Party on the Accession of Viet Nam enter into the WTO

²²⁴ Article 750 of the Civil Code and Article 3 of the IP law

²²⁵ WTO documents, Fn.223

²²⁶ The Decree No.103/2006/ND-CP, Fn.219, Article 36

²²⁷ Decree No.54/2000/ND-CP, Fn. 211, Article 10

²²⁸ Vu Hai Yen, *Protection of GIs in Vietnam*, Special subject on protection of GIs, Hanoi Law University, 2005

regulations allow any kind of product to have GIs protection. Hence, the scope of GIs protection under the IP law is very board, including industrial products or handicrafts like Ha Dong silk for example.

A GI shall be eligible for protection if it meets the following conditions:

- the product originates in the area, locality, territory or country corresponding to such geographical indication;
- the product has reputation, quality or characteristic essentially attributable to geographical conditions of the area, locality, territory or country corresponding to such GI.²²⁹

The conditions for protection of GIs in Vietnam are fully in compliance with the requirements of TRIPs Agreement. In additional, the IP law tracks TRIPs in some of its elements, such as requiring that the geographical conditions relevant to a GI shall include natural and human factors attributable to the reputation, quality and characteristics of protected products,²³⁰ or the geographical area corresponding to a GI shall be accurately determined by words and a map.²³¹ Furthermore, the IP law provides the criterion for determining the reputation, quality and characteristic of the product having a GI.²³² For exapmle, the special characteristics of Phu Quoc fish sauce is described with dark red-brown, purity color; delicate special smell without fishy ammonia odor since fish sauce is produced from fresh fishes; and salty, strong sweet with natural fatty taste; aftertaste is sweet and fatty as to natural protein and fish grease.²³³

5.1.2.2 Subject matter not protected as GIs

Arcording to Article 80 of the IP law, the following subject matters shall not be protected as GIs:

- Designations, indications having become generic names of goods in Vietnam;

This provision is similar to other GIs law systems, such as the EC; however, the IP law does not define ‘generic names’. In Viet nam, the issue related to GI has not been attracted much attention from consumers in general and bussiness in particular, and there is no ongoing dispute concerning the generic characteristic of any geographical name.

²²⁹ The IP law, Fn 209, Article 79

²³⁰ Ibid, Article 82 (1)

²³¹ Ibid, Article 83

²³² Ibid, Article 81 reads as follow:

- Reputation of the product having a geographical indication shall be determined on the basis of trust consumers have in the product through the extent of wideness to which it known and selected by consumers.
- Quality and characteristics of the product having a geographical indication shall defined by one or several qualitative, quantitative or physical, chemical, microbiological perceptible norms which shall be testable by technical means or experts with appropriate testing methods.

²³³ Decision No.01/QD-DK of the Ministry of Science and Technology on the registration of appellation of origin with respect to Phu Quoc fish sauce, Article 1

- GIs of a foreign country where it is not or no longer protected or no longer used;

This article is fully complied with Article 24 (9) of the TRIPs Agreement which stipulates that *'there shall be no obligation under this Agreement to protect GIs which are not or cease to be protected in their country of origin'*. This is also common of almost law relating to GIs of other countries in the world such as the EC, Indian, China, Thailand, Canada and so on. The example of Thai Jasmine rice- a kind of rice associated with the specific aromatic characteristic clearly indicates the important of registration of GIs in the country of origin. In 1993, an American company filed an application to register mark 'Jasmati' for rice which was grown in Texas. The Thai Government submitted a complaint to the WTO so as to stop the registration proceeding of mark and themselves applied for registration GIs 'Jasmine' in certain other countries. However, both complaint and registration proceeding were not successful as 'Jasmine' was not protected as a GI in Thailand, the country of origin. At this time, Thailand did not have any regulations on GIs. This dispute determined Thai Government to pass the the Protection of GIs Act in November 2002.²³⁴ This kind of provision may also be problem with Vietnam GIs' protection, since there are only five (5) products are being protected as appellation of origin in Vietnam.²³⁵

- GIs identical with or similar to a mark having been protected if their use will cause confusion as to the origin of the products;
- GIs misleading consumers as to the true geographical origin of products bearing such geographical indications.

These provisions are similar to those of the Regulation 510/2006 of the EC.²³⁶ However, the IP law does not limit itself to 'homonymous name' but covers kind of GIs or marks would be misleading or cause confusion to consumers of protected GI.

5.1.2.3 Establishment of rights and scope of right to GIs

GIs are only protected on the basis of registration with the state management authority on industrial property (NOIP).²³⁷ Differing from the EC Regulation which stipulates only a group shall be entitled to apply for registration, the IP law regulates that the right to register GIs in Vietnam belongs to the State.²³⁸ The State allows organizations and individuals producing the product bearing the GIs, collective organizations or their representative, or the administrative authorities of the locality to which the

²³⁴ *The example of Jasmine rice*, at http://www.ecaproject.org/articles_publications/specific_topics/the_example_of_jasmine_rice.html ,(02/05/2007)

²³⁵ NOIP, Industrial property statistic, Fn.211

²³⁶ The Regulation, Fn.16, Article 3 (3)

²³⁷ The 2005 Civil code, Article 752 (1), The IP law, Fn.209, Article 6 (3) (a)

²³⁸ The IP law, Fn.209, Article 88

GIs belong, to apply for such GIs to be registered

A further difference is that the owner of GIs is always the State and it grants the right to use and manage GIs to organizations and individuals making and trading products bearing GIs, provided that such organizations and individuals satisfy the requisite criteria.²³⁹ This provision conforms to traditional of producing in Vietnam. A product with a reputation or peculiar characteristic is a result of hundreds years experience and will not belong to individual. Another reason is that the acknowledge of locality producers about GIs is very limited, even some producers do not understand the concept of GIs. Therefore, the State through its representative carries out the registration procedure and protects GIs in order to protect their legitimate interests.²⁴⁰

Other difference is that the IP law regulates how GIs are to be used, which is thus similar to trademarks law. According to Article 124 (7), organizations or individuals who are granted to use GIs shall have the right to use and prohibit other person from using such GIs. The use of a GI including:

- Affixing the protected GI to goods or packages of goods, means of business and transaction documents during business activities;
- Circulating, or offering, advertising, storing for sale of, goods bearing the protected GI;
- Importing goods bearing the protected GI.

With those provisions, the right confers to GI users is not negative right, but a positive one. They are also helpful to determine an act of infringement to the protected GIs.

In addition, Article 129(3) of the IP Law provides for additional protection for wines and spirits. Under this Article, the use of a protected GI identifying wines or spirits that are not originating in the territories corresponding to the GI, even where the true origin of the goods was indicated or the GI was used in translation or transcription or accompanied by words such as 'kind', 'type', 'style', 'imitation' or the like, was considered an infringement of the rights to a protected GI. It also states that infringements could be dealt with under civil, administrative or criminal procedures. These provisions are in consistent with the requirements of Article 23(1) of the TRIPs Agreement.

5.1.2.4 Relation to trademarks

As to the relationship between the protection of GIs and trademarks, Articles 73 (5) and 74(2)(dd) of the IP Law prohibits the registration of a trademark identical with or confusingly similar to protected geographical indications, including appellations of origin, if the use of such trademark was likely to mislead consumers as to the geographical origin of the goods.

²³⁹ Ibid , Article 121 (4)

²⁴⁰ Tran Viet Hung- Deputy of NOIP, *GIs are communities' property*, at <http://www.vnexpress.net/Vietnam/Kinh-doanh/2004/05/3B9D3137> , (02/05/ 2007)

With respect to an earlier trademark, the IP Law excludes the protection of GIs which are identical with or confusingly similar to an already protected trademark where actual use thereof would create confusion as to the origin of the goods.²⁴¹ For example, Da Lat is a famous region in Central Highland of Vietnam on producing sparkling wine. However, Da Lat could not be protected as GI since it has been registered as trademark in 2002 by the NOIP. Other similar examples are Ha Noi and Sai Gon for beer, Sa Dec for shrimp-chips. The time to be taken into consideration for the protection of GIs is the priority date of the trademark application.

The IP law also deal with the issue of whether Viet Nam would protect and register GIs of foreign GIs that provided protection to GIs through a means other than registration, such as through certification marks or unfair competition laws. It is said that since a form of protection is accorded to GIs in the country of origin, even if such protection was through means other than through registration, foreign's GIs could be registered and recorded in the NOIP

It can be said that the provisions concerning the protection of GIs in Vietnam's legislation fully consistent with requirements of international treaties to which Vietnam is party, especially TRIPs's obligations and they are appropriate to both trend in international intellectual property legislation and the current situation of Vietnam.

5.2 Protection of GIs in practice

While the framework for GIs protection has already existed in Vietnam from 1990s and has been recently updated, the exercise of GIs protection has not attracted the attention of producers or other citizens. In addition, Vietnam has plenty of products with reputation, quality and characteristic which could be registered as GIs, but the number of products protected as GIs is very limited. As of early 2007, only five GIs were protected as appellation of origin in Vietnam. There are Phu Quoc fish sauce, Shan Tuyet Moc Chau green tea, Buon Ma Thuot coffee, Doan Hung grapefruit and Binh Thuan Dragon fruit.²⁴²

Phu Quoc fish sauce was registered as appellation in Vietnam in 2001 by the Phu Quoc Fish sauce Producing Association. Before that time, Phu Quoc fish sauce was very famous in Vietnam and Asian countries. Some fish sauce producers in Thailand had produced fish sauce bearing mark 'Phu Quoc' and put it on market in Thailand and other countries. The Phu Quoc Fish sauce Producing Association was not then successful in this dispute because the name 'Phu Quoc' was not protected as trademarks or GIs in

²⁴¹ The IP law, Fn. 209, Article 80 (3)

²⁴² http://www.ecap-project.org/asean_ip_legislation_international_treaties/vietnam.html, (02/05/2007)

Vietnam. The failure of GIs protection in this occasion aroused local producers and competent authorities. Therefore, the Phu Quoc fish sauce Producing Association had successful in applying for registration of the name 'Phu Quoc' for their fish sauce products in 2001. After the registration of Phu Quoc fish sauce, the NOIP also granted decision on application of the name 'Shan Tuyet Moc Chau' for tea in June 2001 and Buon Ma Thuot for coffee in 2005. It is clear that the value of products bearing GIs has increased after GIs registration. According to latest report from the Ministry of Agricultural and Rural Development, the value of Moc Chau tea has increased 15 % since it registered its GI in 2001.²⁴³

The economic benefits of GIs protection have been recognised by many producers and competent authorities. Within the framework of the Program on support of enterprises in developing of intellectual property assets, which includes the recovery, maintenance and development of products bearing GIs,²⁴⁴ and the EC-Asean Intellectual Property right Co-operation Program (ECAP-II Project), producers in general and local authorities' competent have been paying more attention on protection of GIs. In 2006, two more Vietnamese products has just received GIs protection: Doan Hung grapefruit and Binh Thuan Dragon fruit. Both products were registered on the request of local authorities. According to Mr Tran Viet Hung- Deputy Head of the NOIP of Vietnam, about 150 kinds of Vietnamese farm products, including Phu Quoc pepper, Tan Cuong tea, Hai Hau rice and so on are being considered to be recognised as GIs over the next 10 years.²⁴⁵ In addition, the Ministry of Agricultural and Rural Development has acknowledged the importance of GIs protection and step by step encouraged localities to implement technical measures to ensure the protection of GIs. To be specific, the Agricultural Science Institute of Vietnam (VASI) has been conducting the analysis in order to help Thanh Ha litchi producers' Association register Thanh Ha litchi.²⁴⁶

Beside the protection of protected GIs in national level, Vietnam has been considering the importance of international registration of their GIs. At present, Phu Quoc fish sauce is protected as GIs in the EU and Shan Tuyet Moc Chau tea was recognised and protected in France in 2001.²⁴⁷

However, in comparing with the large number of traditional products which could be registered as GIs in Vietnam, it is clear that the number of

²⁴³ *Local trademarks guard export prices*, http://english.vietnamnet.vn/article_id=738584, (02/05/2007)

²⁴⁴ Decision No.68/2005/QĐ-TTg of 4 May 2005 on approval the Program on support of enterprise in developing their intellectual property assets

²⁴⁵ Seminar ' Geographical indications: A land of opportunities', Hanoi on November 15, 2005

²⁴⁶ Trinh Khac Quang, *The situation of special agricultural products and the need for the protection of agricultural products in Vietnam*, Report of the Ministry of Agricultural and Rural Development of Vietnam, 2005

²⁴⁷ *How to enhance protection of Vietnamese agricultural products*, at <http://www.mof.gov.vn/ItemPrint.aspx?ItemID=3025> , (02/05/2007)

See also, Trinh Khac Quang, Fn.246

protected GIs at the present is very limited and the protection of such protected products in practice is also not very effective. According to Phu Quoc Fish sauce Association, there are only 6% genuine Phu Quoc fish sauce in market which has been manufactured at Phu Quoc island. With the output of 12 million litres per year, Phu Quoc fish sauce Association cannot provide sufficient production for demanding of 200 million of 82 billion people of Vietnam per year. Therefore, many producers produce counterfeit Phu Quoc fish sauce and put it on the market.²⁴⁸ One of the main obstacles to the protection of GIs in Vietnam is that few consumers can distinguish between genuine products and counterfeit ones. As the traditional values of registered products, there is an increasing numbers of counterfeit, thus causing economic damages to producers of localities.

5.3 Enhance protection of GIs in Vietnam

One of the main obstacles to enhancing the protection of GIs in Vietnam is the lack of awareness of the importance of GIs protection in the minds of both producers and localities. According to Mr. Passeri, the few in the Vietnamese population understand the concept of GIs and how they gain from GIs protection.²⁴⁹ He further stated that if some special products are not protected as GIs, such products would lose value in next 20 years since the producers will not receive the profit from their products and market force will take them out from the market.

In addition, the identification and assessment of the special quality and characteristics of protected products face many difficulties due to the lack of equipment, examiners, analyzing methodology, etc. One of the most important requirements for GIs protection is providing evidence of the link between the special products characteristic with the geographical origin. The lack of experience in identifying such elements as the natural ones (climate, soil, water resources), and human factors (methodology, process, know-how, skills) make it difficult to state the necessary and sufficient conditions that are attributable to the quality and characteristics of products

In Vietnam, the group of producers are not appreciating. Producers usually work alone and compete against each other. It is the fact that the model of group of producers has been very successful in the EC. The group is usually responsible for producing a PDO or PGI products and ensuring the quality of their products. Producers in the group have to be aware that if one of them breaks the rules, all the others and the reputation of the product will suffer from the damage. Further, when they break the rules, the group can take away their licence until they show that they want to work with

²⁴⁸ Vietnam registered Phu Quoc fish sauce as GIs in the EC, at http://www.rfa.org/vietnamese/in_depth/2005/09/04/PhuQuocFishSauce_NNguyen/ (02/05 2007)

²⁴⁹ Stephane Passeri, expert on GIs come from France, speech at seminar “Geographical indications: A land of opportunities”, Hanoi, 15 and 16 November, 2005

honestly.²⁵⁰ The group of producers plays an important role on protection of GIs because they control all production of the products, from raw material to the market and they give the consumers the guarantee that they are buying the product that has passed all necessary stages to be considered as a GIs.

Finally, that GI protection is very limited can be linked to the living standards and level of income of the bulk of the Vietnamese population. General, GI protected products with their special quality and characteristic are more expensive than unprotected ones. This is not a problem in France where people are willing to pay more for products protected as PDOs,²⁵¹ but it may be a problem in Vietnam with a part of population living with very low standards of living. In other words, producers of GIs products in Vietnam do not received sufficient motivation from.

To ensure the effective protection of GIs in the coming time, the following activities should be implemented:

First, we should have a master plan to support the registration of GIs with a view to raising awareness of the value of IPRs, especially GIs. In doing so, localities and export enterprises should take the lead in developing and exploiting their intellectual assets and in improving the competitiveness of Vietnam's special agricultural products in both the domestic market and foreign markets with the focus on strategic products, having exporting potential;

Secondly, we should also raise the awareness of the competent authorities regarding the importance of the protection of GIs. Building on that, they must assume responsibilities in the acquisition and management of their GI rights. This does not mean that the localities should control the registration proceeding for producers or association of producers, but rather support their acquisition and management.

Third, we should pay more attention to the role of producers association, taking the view that they are the representative of producers and responsible for the quality of products bearing GIs. Group of producers should be aware that they work in their own interest as well as that of consumers.

In additional, the State should strengthen the measures on protection of GIs so as to prevent producers from producing counterfeits and other infringing products. However, the most important element here is educating the public on the importance of such protection.

²⁵⁰Maria de Jesus Ceia, *An Example of the role of a producer group, in the path of the future*, Seminar 'GIs: A land of opportunities', Hanoi 15 and 16 November 2005

²⁵¹ Stephane Passeri, Fn.249

6 Conclusion

Although there are some doubt remains on whether GIs are the norm of IP, the economic and legal significance clearly indicates the important of GIs protection.

TRIPs provisions are widely recognized as having set new standards for the international protection of GIs, having succeeded in recognizing them as a major category of IP alongside patents, trademarks and copyrights. However, the 'dual model' of protection under TRIPs with additional protection provided for wines and spirits does not satisfy some Member countries which have a greater interest in using GIs. The future protection of GIs in the WTO seems an intractable problem as does the multilateral registration system for wine and spirits and the extension of the higher level of protection to other products. It can be said that the global regulation of GIs is now at a 'crossroads' and what will happen cannot be foreseeable.²⁵²

As shown by the negotiation on the conclusion of the TRIPs Agreement and by its own GI protection system regime, the EC has long been in favour of enhanced protection of GIs for agricultural products and foodstuffs. In recent developments of GIs protection at the international level, the EC submitted a proposal which is designed to meet the need of developing countries on extending the protection and establishment by way of a mandatory multilateral system of registration for all products other than wines and spirits.²⁵³ It is clear that Europeans have more numerous GIs to protect than developing countries. Even though products such as coffee, tea and rice would become eligible for GI protection, the costs for most developing countries involved in the implementation and administration of a system of GI protection would far outweigh the benefits. Thus, it is suggested that any gains that would materialize in the form of price premiums for protected goods, would probably not offset the costs (administrative and financial) of the establishment of such a system of protection.

Vietnam, like other developing countries has a short history where GI protection is concerned. Although national legislation provides adequate and efficient protection of GIs, legal use of it is still very limited. At present, Vietnam does not have a position on GI negotiations. However, the existence of a framework for GIs and the actual situation of Vietnam shows that it has many reasons to support the EU and other developing countries. For almost all developing countries, including Vietnam, GIs protection has a close relationship with traditional knowledge, since, through the GI protection system, traditional knowledge is transformed into intellectual

²⁵² G.E.Evans and Michael Blankeney, Fn.78, p.578

²⁵³ WTO, General Council, Trade negotiations Committee, Council for Trade related Aspect of Intellectual Property Rights, Special Section on GIs, Communication from the EC of 14 June 2005, WT/GC/W/547, TN/C/W/26, TN/IP/W/11

capital. Beside satisfying consumers and producers' interests, the protection of GIs thus also offers a means of protecting traditional knowledge. This protection is an important element which developing countries should take into account when deciding whether to extend the protection of GIs.

The differing views on which GIs should be regulated shows that their protection remains a contentious issue. If developed countries, such as the US and the EU, continue to debate the issue, other developing countries should take into consideration the opportunities and risks, and the benefits and burdens of participation before deciding which party they favour. Moreover, lawmakers should form their own view on the harmonisation of GIs at the international level.

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