

---

***GEOGRAPHICAL INDICATIONS AND TRADEMARKS – A TANDEM FOR  
GEOGRAPHICAL NAMES PROTECTION***

**Nicoleta Rodica Dominte, Assist. Prof., PhD, "Al. Ioan Cuza" University of Iași**

*Abstract: The paper will focus on the following question: why geographical names, protected under geographical indications umbrella, need a double protection through trademark system? The arguments for raising this question are the impoverished map of international protection for geographical indications and the juridical diversity in geographical indications status at national level. As an illustration, we mention the American system of protecting the geographical indications through trademark pattern.*

**Keywords:** *geographical indication, appellation of origin, trademark, Lisbon Agreement, TRIPS Agreement*

Geographical names can be registered as geographical indication or appellations of origin and as trademarks. The concept of geographical indication encompasses protected geographical indications and protected appellations of origin, which are signs applied on products that have a specific geographical origin and are endowed with qualities and reputation that are due to that geographical origin (Susan Hall, 2013, p. 252).

Why geographical names, protected under geographical indications umbrella, would need a double protection through the trademark system? The main arguments for the statement of double protection are the impoverished map of international protection for appellation of origin, the two-tier system from TRIPS Agreement that do not accord equal protection, the problems raised by European geographical indications and appellations of origin protection on non-European Union territories and the co-existence of trademark and IG. Also, an argument for the double protection can be the juridical diversity in geographical indications status at national level. As an illustration, we mention the adoption of a law regarding the registration and protection of GI in India at the end of the XX century, a country with a rich history in geographical indications, and the American system of protecting the geographical indications through trademark pattern.

In this article, we will analyse the arguments mentioned above in order to sustain the significance of a double protection for geographical names, that were registered first as geographical indications or appellations of origin.

At international level, the TRIPS Agreement has developed a two-tier system of protection only for geographical indications. Article 22 stipulates a standard level of protection for the geographical indications that were registered for any product. The protection is awarded if the geographical indication is used, by an unauthorized third party, in a manner which misleads the public or constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention (1967). On the other hand, article 23 is the framework of an additional protection for geographical indications registered for wines and spirits. The protection is granted even if their use, by an unauthorized third party, will not mislead the public.

It can be noticed a major difference between the two systems of protection. Article 22 does not create an adequate juridical framework, because it was possible for an American company RiceTec to register the name "*Basmati*", as the title of an invention patented in USA, for aromatic rice outside India. A national Act for the protection of geographical indications has entered into law on the 15<sup>th</sup> of September 2003 in order to prevent abroad unauthorized use of Indian geographical indications. Even if the registration is not compulsory, a lot of producers started to register their geographical indications in order to be able to invoke a better protection outside India (Ritika Benerjee, Mohar Majumdar, 2011, p. 659, 661 – 663).

In this juridical structure, the registration of a geographical name, as a trademark, highlights an alternative solution to the standard level of protection from article 22 from the TRIPS Agreement. Additionally, an international trademark registered has juridical protection beyond the national borders of protection for a geographical indication. This will avoid unauthorized acts of misleading the public and of unfair competition. As a result, the double protection may sustain efficiently the application of article 22 from the TRIPS Agreement.

The juridical protection from article 23 of TRIPS Agreement do not forbid the use of homonym geographical indications for wines, if their use will not mislead the consumers. In that direction, it was accepted the co-existence of the geographical indication "La Rioja Argentina" for wine with the appellation of origin "Rioja" for wine from Spain. In the decision pronounced by the Court of Appeals, it was mentioned that the name of the country Argentina creates the difference, which confirms that the products is not from Spain. Although, geographical indications for wines can be registered on Argentinian territory since the adoption of the Law 25.163 from 1999 (Pablo A. Palazzi, 2013, p. 759-760).

In principle, in case of a conflict between a trademark and a geographical indication, it is not accepted the co-existence of the two signs. The owner of the trademark has an exclusive right in comparison with the owner of a geographical indication who has only the right of use. The key word that differentiates the features of the two rights is the adjective "*exclusive*". Nevertheless, the double protection should not be used in an inequitable way only for obtaining an exclusive right that will ban the use of a homonym geographical name for identical products by another producer.

Another juridical coordinate of the international protection is the Lisbon Agreement for the protection of appellation of origin and their international registration, which was adopted at 31 October 1958. The original text was revised in Stockholm, 14 July 1967, and amended in Lisbon, 28 September 1979. Romania signed the Lisbon Agreement on 31 October 1958, but has never ratified the text. The contracting parties are the 28th state members of the Lisbon Union.

An appellation of origin is registered at international level in accordance with article 5 from the Lisbon Agreement. The national appellation of origin is registered on the basis of the proposal made by the national authorities from a member state of the Lisbon Union. In that direction, the owner of the national appellation of origin will register a request at the International Bureau. On the contrary, an appellation of origin from a non-member state cannot be registered. To that effect, we underline the limited effect of the international protection on the grounds of the Lisbon Agreement due to the small number of contracting

countries. As a consequence, a geographical indications from the XIX century, as „Darjeeling” used for Indian tea is registered, by unauthorized third parties, as trademark in other countries (Caroline Le Goffic, 2008, p. 152 - 154).

From a comparative perspective, the international protection of the two notions is inequitable, because the Lisbon Agreement, administered by World Intellectual Property Organisation, has 28 contracting countries<sup>1</sup>, while the TRIPS Agreement, administered by World Trade Organisation, has 161 contracting countries<sup>2</sup>. With this view in mind, the registration of a geographical name as a trademark emerges as an alternative solution, especially in the countries that are not members of the Lisbon Union.

The first regulation referring to geographical indications was Regulation 2081/1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, which was adopted in the beginning of the 1990 due to a restrictive movement of the national agricultural goods. The limitation of the free movement of goods was influenced by national laws from France, Italy and Spain, that were adopted to enforce protection for appellations of origin in the beginning of the XX century. Nowadays, geographical indications can be registered for agricultural and foodstuff products, wines, aromatised wines and spirits and can not be protected for handicraft products at European Union level (Matteo Gragnani, 2012, p. 271-272). One of the critical comments referring to the Regulation 2081/1992 was about the theory of co-existence between previous trademarks and geographical indications, because the two objects of industrial property law are different and independent (G.E. Evans, Michael Blakeney, 2006, p. 596 - 599). However, this theory is sustained within the concept of good-faith, which is analysed on the basis of the national and international legislation from this field. Also, the concept of good-faith is broaden in various cases, for example in the case of "Bavaria" trademark for beer and "Bayerisches Bier" geographical indication, also for beer (Paul Reeskamp and Eva den Ouden, 2009, p. 857 - 859).

From a different perspective, in the American law, geographical indications are protected through the trademark system. As a result, the owner of a geographical indication has an exclusive right to prevent the use by unauthorized third parties and to prevent the registration of a similar or identical geographical name for identical or similar products by other producers if the consumers would be confused. Moreover, geographical indications are qualified as certification trademarks (United States Patent and Trademark Office, p. 2). With this view in mind, the European theory of co-existence between trademarks and geographical indications may not be applied on the United States of America territory.

As a conclusion, we would like to empathize the importance of trademarks, as an alternative juridical solution for geographical names that can not be protected as geographical indications outside national borders. The differences between national laws sustain the idea of a double protection for geographical names around the globe.

---

<sup>1</sup> The list with the contracting parties of the Lisbon Agreement: [http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty\\_id=10](http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=10)

<sup>2</sup> The list with the contracting parties of the World Trade Organisation: [https://www.wto.org/english/thewto\\_e/whatis\\_e/tif\\_e/org6\\_e.htm](https://www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm)

**BIBLIOGRAPHY:**

Benerjee, Ritika and Majumdar, Mohar *In the mood to compromise? Extended protection of geographical indications under TRIPS Article 23*, Journal of Intellectual Property Law & Practice, vol. 6, no. 9/2011.

Evans, G.E. and Blakeney, Michael, *The protection of geographical indications after Doha: Quo vadis?*, Journal of International Economic Law, vol. 9, no. 3/2006.

Le Goffic, Caroline, *Cancellation of a trade mark based on a prior foreign geographical indication related to different products*, in Journal of Intellectual Property Law & Practice, vol. 3, no. 3/2008.

Hall, Susan, *Geographical indications: a signposted route to the future or an impenetrable labyrinth?*, Journal of Intellectual Property Law & Practice vol. 8, no.3/2013.

Gragani, Matteo *The law of geographical indications in the EU*, Journal of Intellectual Property Law & Practice vol. 7, no.4/2012.

Palazzi, Pablo A., *Argentine courts validates GI 'La Rioja Argentina' against challenge from Spain*, Journal of Intellectual Property Law & Practice, vol. 8, no. 10/2013.

Reeskamp, Paul and Ouden den, Eva, *Bavaria and Bayerisches Bier may co-exist*, Journal of Intellectual Property Law & Practice, vol. 4, no. 12/2009.

United States Patent and Trademark Office, *Geographical Indication Protection in the United States*,

[http://www.uspto.gov/sites/default/files/web/offices/dcom/olia/globalip/pdf/gi\\_system.pdf](http://www.uspto.gov/sites/default/files/web/offices/dcom/olia/globalip/pdf/gi_system.pdf)