

TRADITIONAL KNOWLEDGE: ARE WE CLOSER TO THE ANSWER(S)? THE POTENTIAL ROLE OF GEOGRAPHICAL INDICATIONS

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I. INTRODUCTION¹

The debate concerning the protection of, and access to, “traditional knowledge”² has been going on for some time.³ Academics, governments, non-

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1. Based on a presentation at the International Law Weekend, New York, Oct. 18, 2008.

2. Volumes have been written about the proper definition of this term. The World Intellectual Property Organization (WIPO) rarely uses the term anymore, preferring terms such as “traditional cultural expression” or “expression of folklore.” In a document prepared for the 13th Session of the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore, *infra* note 3, the WIPO Secretariat noted:

Defining the subject matter of protection has long been one of the most fundamental challenges associated with the protection of TCEs. How TCEs are defined can determine the extent to which and how they may be protected by IP. While this draft analysis does not seek to suggest a particular definition of TCEs, some understanding of what is meant by the term is indispensable to the preparation of the analysis.

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The characteristics of TCEs have been discussed at length in earlier documents and materials.

. . . .

In summary, in general terms TCEs:

- a) are the products of creative intellectual activity;
- b) have been handed down from one generation to another, either orally or by imitation;
- c) Reflect a community’s cultural and social identity;
- d) Consist of characteristic elements of a community’s heritage;
- e) Are made by authors unknown and/or unlocatable and/or by communities;

governmental and intergovernmental organizations, and representatives of indigenous communities have made arguments on many different levels. One is obviously definitional: what is traditional knowledge?⁴ However, the most interesting debates are normative in nature: What *should* international law do about traditional knowledge? Is protection desirable? To what end? Equally interesting is the somewhat more technical debate about *how* we can proceed to implement some of the (tentative) normative conclusions.

The normative debate is situated at the confluence of intellectual property law, cultural studies, ethnology, and anthropology. From the point of view of intellectual property law, the debate opens new perspectives on the origins and justificatory theories of “modern” intellectual property. What should be protected, and why? Are intellectual property rules, for example, as embodied in the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)⁵ simply historical accidents? Should we be contemplating changes and adaptations to the intellectual property regime to render it more neutral (from an ethnocentric perspective)? If so, how far can the intellectual property system be extended to meet the perceived needs of holders of traditional knowledge, many of whom are indigenous peoples. If we agree that an effort to render intellectual property more culturally neutral is considered desirable, then how far can we infuse relativism into extant norms without endangering the foundations of the system itself?

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- f) Are often primarily created for spiritual and religious purposes;
 - g) Often make use of natural resources in their creation and reproduction; and
 - h) Are constantly evolving, developing and being recreated within the community.

World Intellectual Property Organization [WIPO], Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore, 13th Sess., *The Protection of Traditional Cultural Expressions: Draft Gap Analysis*, WIPO Doc. WIPO/GRTKF/IC/13/4(b) Rev., (Oct. 11, 2008), available at http://www.wipo.int/edocs/mdocs/tk/en/wipo_grtkf_ic_13/wipo_grtkf_ic_13_4_b_rev.doc (last visited Mar. 2, 2009) [hereinafter *Draft Gap Analysis*].

3. For example, the WIPO Committee held its 13th session in October 2008. This process officially started on September 14, 2000, when the Dominican Republic (on behalf of the Group of Countries of Latin America and the Caribbean (GRULAC) submitted Notes to the WIPO General Assembly, Twenty-Sixth (12th Extraordinary) Session entitled “Traditional Knowledge and the Need to Give it Adequate Intellectual Property Protection” and “WIPO Committee on the Relationship between Intellectual Property, Genetic Resources and Traditional Knowledge,” which were reproduced as Annexes I and II respectively to WIPO, General Assembly, 26th Sess., *Traditional Knowledge and the Need to Give it Adequate Intellectual Property Protection*, WIPO doc. WO/GA/26/9 (Sept. 14, 2000). The Committee was then established and met for the first time in May 2001. See WIPO, *Traditional Knowledge, Genetic Resources and Traditional Cultural Expressions/Folklore*, www.wipo.int/tk/en (last visited Feb. 18, 2009).

4. A version of this question is: what *kinds* of traditional knowledge deserve protection?

5. See Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments—Results of the Uruguay Round, 33 I.L.M. 1197 (1994) [hereinafter TRIPS Agreement], available at www.wto.org/english/docs_e/legal_e/27-TRIPS.pdf (last visited Feb. 27, 2009).

In this short paper, I will take a brief tour of this policy garden (Part II) and suggest that, for at least some forms of traditional knowledge, the protection of geographical indications may offer a partial solution (Part III), and that implementing this protection would not be inordinately difficult.

II. TRADITIONAL KNOWLEDGE AND THE “DISCRIMINATIVE” NATURE OF INTELLECTUAL PROPERTY RULES

Claims that IP rights as they appear in the Berne⁶ and Paris Conventions⁷ and in the TRIPS Agreement are discriminatory resonate in many parts of the world. Intellectual property rights are seen as “children of the Enlightenment,”⁸ a geographically and temporally limited period of human history. In more critical analyses, TRIPS is described as “the historical legacy of colonial disdain, exclusion, derogation, and appropriation as a policy framework for dealing with local knowledge.”⁹ Indeed, both major Conventions were signed and revised almost exclusively in Western Europe.¹⁰ Most participants at the

6. Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, *revised* July 24, 1971, 25 U.S.T. 1341, 1161 U.N.T.S. 3 [hereinafter *Berne Convention*].

7. Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, 21 U.S.T. 1583, 828 U.N.T.S. 305, *as revised* at Stockholm on July 14, 1967, and *as amended* on Sept. 28, 1979 [hereinafter *Paris Convention*].

8. See Wenwei Guan, *The Poverty of Intellectual Property Philosophy*, 38 HONG KONG L. J. 359, 389 (2008).

... faith in knowledge has fallen into something mysterious in its extreme and modern law has become mythology, as ‘the Enlightenment appears to have failed in its own terms.’ The Enlightenment has failed in defeating myths and become totalitarian, and ‘the myths which fell victim to the Enlightenment were themselves its products.’ Rousseau’s social contract theory, as the jurisprudential move of the Enlightenment project which marks the beginning of modern law, borrows wholesale from mediaeval theology. It is in this sense that modern law is claimed to be a mythology which can be traced back to the Enlightenment. All this brings us to question the faith in knowledge and delegitimation of the authenticity of the Author. As we revealed above, intellectual property rights are not natural rights but a historical social construction from privileges to rights protecting the Author. Foucault’s research confirms this point arguing that ‘the notion of author constitutes the privileged moment of individualisation in the history of ideas, knowledge, literature, philosophy, and the sciences’.

Id. [footnotes omitted].

9. Chidi Oguamanam, *Local Knowledge as Trapped Knowledge*, 11 J. WORLD INT. PROP. 29, 32 (2008). See also O. B. Arewa, *TRIPS and Traditional Knowledge: Local Communities, Local Knowledge in Global Intellectual Property Frameworks*, 10 MARQUETTE INTELL. PROP. L. REV. 155 (2006).

10. The Paris Convention was signed in Paris (France) in 1883 and revised in Brussels (1900), Washington (1911), the Hague (1925), London (1934), Lisbon (1958) and finally in Stockholm (1967). See Wenwei Guan, *supra* note 8. The Berne Convention was signed in Berne (Switzerland) in 1886 and revised in Paris (1896), Berlin (1908), Rome (1928), Brussels (1948), Stockholm (1967) and Paris (1971). See *Berne Convention*, *supra* note 6.

negotiations were representatives of western countries, especially until the massive decolonization process started in Africa and other parts of the world the late 1950s.¹¹ Haiti was one of the few developing nations active in the discussions.¹²

Naturally, the “knowledge” that the Paris and Berne Conventions were designed to protect is knowledge considered valuable by the negotiators, whose value system depended on the cultural and economic developments prevalent in Europe and the “West.” The conflation of the Enlightenment’s focus on individual authorship, inventorship, and in goods Lockean tradition, ownership of intellectual property, on the one hand, and the belief that industrial progress through the protection (by providing exclusivity of commercially relevant uses) of innovation was essential, on the other hand, were the pillars on which modern intellectual property rules were built.¹³ The United States perspective was not dissimilar.¹⁴

While this may strike the Western reader as obvious, when “western” norms, as embodied in the TRIPS Agreement,¹⁵ were exported to the legal systems of dozens of developing (and some least-developed nations although they have much more time to implement TRIPS), questions were raised about the normative foundations for those rules.¹⁶ Countries wanted to “understand” the rules. Initially, the realization that TRIPS offered relatively little flexibility

11. I am taking the very pragmatic approach of looking at countries taking part in international negotiations. From that perspective, the massive wave of decolonization of developing countries started with Libya which gained its independence from Italy on December 24, 1951. Historians might disagree of course.

12. Haiti gained its independence much earlier than African countries (with the exception of Ethiopia), namely during *Haitian Revolution (1791–1804)*. See FEDERAL RESEARCH DIVISION, LIBRARY OF CONGRESS, COUNTRY PROFILE: HAITI, (May 2006), <http://lcweb2.loc.gov/frd/cs/profiles/Haiti.pdf> (last visited Feb. 26, 2009). It participated actively in the Berne.

13. See BRAD SHERMAN & LIONEL BENTLY, *THE MAKING OF MODERN INTELLECTUAL PROPERTY LAW* (1999). See Guan, *supra* note 8. See also Daniel Gervais, *Spiritual but Not Intellectual? The Protection of Sacred Intangible Traditional Knowledge*, 11 *CARDOZO J. INT'L & COMP. L.* 467, 479 (2003) [hereinafter *Intangible Traditional Knowledge*].

14. See Guan, *supra* note 8 and accompanying text. In patent law, the focus has traditionally been on “competitive research” and assumed the system was designed to allow/incite firms to invent around and beyond competitors. See also WALTON HAMILTON, *TEMPORARY NATIONAL ECONOMIC COMMITTEE, MONOGRAPH NO. 31, 76th CONG., 3D SESS., PATENTS AND FREE ENTERPRISE* (Sen. Comm. Print 1941).

15. TRIPS incorporated the most advanced (highest) set of intellectual property rules that major Western powers could agree on among themselves as of 1990, giving developing countries and least-developed countries transitional periods to adapt. See DANIEL GERVAIS, *THE TRIPS AGREEMENT: DRAFTING HISTORY AND ANALYSIS 12–27* (3d ed. 2008) [hereinafter *DRAFTING HISTORY*]. For developing countries (other than least-developed ones), the transitional period ended in January 2000, except for certain provisions concerning pharmaceutical patents, for which an extension until January 2005 was in place for countries that did not grant such patents previously.

16. See Ruth L. Okediji, *The International Relations of Intellectual Property: Narratives of Developing Country Participation in the Global Intellectual Property System*, 7 *SING. J. INT'L & COMP. L.* 315 (2003).

combined with major health crises such as the HIV/AIDS pandemic led to resistance to TRIPS. More recently, however, developing countries have taken a much more proactive and multifaceted approach.¹⁷ They are calibrating TRIPS implementation and, more broadly, their intellectual property system to match their strategic innovation needs.¹⁸ They are also confronting intellectual property rules with other normative concerns, such as those based on human rights¹⁹ or biodiversity.²⁰ This in turn allows them to switch between various fora to negotiate different sets of possibly competing rules.²¹

I previously argued that one of the dimensions that TRIPS is seen as not being able to encompass is the encroachment on rights in sacred material.²² The intellectual property system is primarily designed to prevent unauthorized commercial exploitation. This implies (a) that the protected product or process is designed to be commercialized and (b) that at some point protection ceases to exist. In other words, intellectual property is typically used in the West to organize markets, not suppress them.²³ In the case of sacred knowledge, the product or process was not created with commercial exploitation in mind. Such

17. See Daniel Gervais, *TRIPS & Development*, in *INTELLECTUAL PROPERTY, TRADE AND DEVELOPMENT* 5-17 (2007) [hereinafter *TRADE AND DEVELOPMENT*].

18. See *id.* at 44-52.

19. See Daniel Gervais, *Intellectual Property and Human Rights: Learning to Live Together*, in *INTELLECTUAL PROPERTY AND HUMAN RIGHTS* 1-17 (2008).

20. See GAIA/GRAIN, *TRIPS versus CBD: Conflicts between the WTO Regime of Intellectual Property Rights and Sustainable Biodiversity Management*, *GLOBAL TRADE AND BIODIVERSITY IN CONFLICT*, Apr. 1998, available at <http://www.grain.org/briefings/?id=24> (last visited Jan. 7, 2009). See also Lorna Dwyer, *Biopiracy, Trade, and Sustainable Development*, 19 *COLO. J. INT'L ENVTL. L. & POL'Y* 219, 256 (2008).

The WTO, UPOV, and developed countries advocate for the expansion of IPRs on PGRs and oppose the establishment of a unified IPR system that significantly protects the interests of TK holders. They also oppose the amendment of TRIPS to include a patent applicant's obligation to disclose TK or to guarantee benefit sharing with indigenous communities. In contrast, the UN, WIPO, and developing countries are more concerned with the recognition of sovereignty over PGRs and the establishment of an international system to protect traditional knowledge. However, unlike TRIPS, neither the WIPO nor CBD establish enforcement mechanisms. Consequently, TRIPS has imposed a globally dominant IP system that completely neglects TK concerns.

Id. For a different perspective, see Jean-Frédéric Morin, *The Strategic Use of Ethical Arguments in International Patent Lawmaking*, 3 *ASIAN J. WTO & INT'L HEALTH L. & POL'Y* 503 (2008).

21. See Ruth L. Okediji, *The Institutions Of Intellectual Property: New Trends In An Old Debate*, 98 *AM. SOC'Y INT'L L. PROC.* 219, 220 (2004). The WTO's willingness to integrate relevant external norms in its dispute-settlement proceedings means that this effort is far from have only theoretical interest.

22. See *Intangible Traditional Knowledge*, *supra* note 13, at 478.

23. It is true that a large percentage of patents ("blocking patents") and other exclusive rights are used to prevent certain goods from reaching the market but arguably this coheres with the traditional rationale because it protects the market for other (presumably competitive) goods. Certain uses of moral rights as they exist in, e.g., France, where authors retain a "right to change their minds" (*droit de repentir*) have had clear noncommercial motivations, but those anecdotal cases are few and far between.

knowledge is often old (and thus no longer protected or protectable under, e.g., patent or copyright law) and its ownership is also harder to pinpoint.²⁴ In terms of patents based in whole or part on traditional medicinal knowledge and/or using genetic resources belonging to indigenous communities, solutions have been suggested and are well known.²⁵ The real issue is whether, and if so where, the relevant disclosure (and possibly benefit-sharing) norms might be adopted. This is what led WIPO and others to focus on “gap analysis,” namely the identification of areas where current intellectual property norms leave traditional knowledge holders in the dark.²⁶

WIPO proposed a number of adaptations to the application of existing intellectual property rights, and possible new (*sui generis*) adjuncts.²⁷ The suggested adjustments are characterized teleologically as either “defensive” (preventing misappropriation by requiring, for example, additional disclosures from applicants under the International Patent Classification System and the Patent Cooperation Treaty Minimum Documentation)²⁸ or as “positive.”²⁹ Proposals are also divided in terms of subject matter: WIPO suggests a series of measures for genetic resources, on the one hand, and others for Traditional Cultural Expressions (TCEs), on the other. As to the latter, the model provisions³⁰ propose a three-tier system. Article 3 of the model provisions contains a (new) right against misappropriation of TCEs including the ability to prevent the following acts taking place without the “free, prior, and informed consent” of the holders of TCEs:

[T]he reproduction, publication, adaptation, broadcasting, public performance, communication to the public, distribution, rental, making available to the public and fixation (including by still photography) of the traditional cultural expressions/expressions of folklore or derivatives thereof;

24. The latter issue can be resolved by recognizing communal ownership of rights, which is not incompatible with the dominant intellectual property paradigm (for example, most countries allow collective marks). See *Intangible Traditional Knowledge*, *supra* note 13, at 481–82.

25. See Daniel Gervais, *Traditional Knowledge & Intellectual Property: A TRIPS-Compatible Approach*, 2005(1) MICH. ST. L. REV. 137 (2005).

26. See *generally Draft Gap Analysis*, *supra* note 2.

27. I use this term based on the assumption that due to existing treaty obligations, those new rights would not replace existing rights. As I have argued elsewhere, however, countries could agree, for example in a WTO Ministerial Declaration, on certain “interpretations” of existing instruments. See TRADE AND DEVELOPMENT, *supra* note 17.

28. See WIPO, *Traditional Knowledge*, <http://www.wipo.int/tk/en/tk/> (last visited Jan. 9, 2009).

29. Interestingly, the term “offensive” was not used in the binary classification proposed here.

30. See WIPO, REVISED PROVISIONS FOR THE PROTECTION OF TRADITIONAL CULTURAL EXPRESSIONS/EXPRESSIONS OF FOLKLORE (extract from WIPO Doc. WIPO/GRTKF/IC/9/4), available at http://www.wipo.int/export/sites/www/tk/en/consultations/draft_provisions/pdf/tce-provisions.pdf (last visited Jan. 9, 2009) [hereinafter the REVISED PROVISIONS].

any use of the traditional cultural expressions/expressions of folklore or adaptation thereof which does not acknowledge in an appropriate way the community as the source of the traditional cultural expressions/expressions of folklore;

any distortion, mutilation or other modification of, or other derogatory action in relation to, the traditional cultural expressions/expressions of folklore;

....

in respect of words, signs, names and symbols which are such traditional cultural expressions/expressions of folklore, any use of the traditional cultural expressions/expressions of folklore or derivatives thereof, or the acquisition or exercise of IP rights over the traditional cultural expressions/expressions of folklore or derivatives thereof, which disparages, offends or falsely suggests a connection with the community concerned, or brings the community into contempt or disrepute.³¹

The proposal further proposes

[A]dequate and effective legal and practical measures to ensure that:

(i) the relevant community is identified as the source of any work or other production adapted from the traditional cultural expression/expression of folklore;

(ii) any distortion, mutilation or other modification of, or other derogatory action in relation to, a traditional cultural expression/expression of folklore can be prevented and/or is subject to civil or criminal sanctions;

(iii) any false, confusing or misleading indications or allegations which, in relation to goods or services that refer to, draw upon or evoke the traditional cultural expression/expression of folklore of a community, suggest any endorsement by or linkage with that community, can be prevented and/or is subject to civil or criminal sanctions.³²

Readers who recognized in those suggested provisions copyright (both economic and moral rights) and, in the second text, certain aspects of trademark law concerning false indications of origin³³ might be forgiven. Indeed, WIPO's text is arguably an effort to adapt the "concept" of copyright to communal

31. *Id.* at 19.

32. *Id.* at 19–20.

33. *See, e.g., Lanham Act*, 15 U.S.C. § 1125(a)(1) (2008), which refers to "false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which . . . is likely to cause confusion . . . as to the origin . . . of [its] goods." In terms of how this right may interface with copyright under U.S. law, *see Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003).

ownership, with a partial recognition of the noncommercial nature of certain offending acts³⁴ (as the current moral right regime also acknowledges).³⁵

The similarity between the proposal and extant systems suggests one of two things: either that WIPO lacks imagination (and/or is so tied to existing paradigms that it cannot think “out of the box”) or that the current system(s) are difficult to replace with truly fresh options. Given that many new stakeholders, especially on behalf of developing countries, have been pushing options, few of which have gained traction, the latter explanation seems at least partly correct. Yet, although I do not have the time here to explore this further, it is clear that the sum total of the WIPO proposals will tend to increase overall levels of protection (by adding new rights and using registration systems defensively); they seem to jettison options which would disregard the current frameworks. WIPO hands are tied for valid reasons.³⁶ As a theoretical matter, not knowing how a truly clean slate (one not tied by legacy regulation) would or could have yielded different results, because WIPO did not try that option, a firm answer to the question posed above remains elusive, a victim, one might say, of path dependency.

One must bear in mind also that introducing any *sui generis* system entails substantial transition costs and, unless it formed part of a multilateral “bargain” such as the Doha Round,³⁷ it would likely only be adhered to or ratified by its proponents.

Not all solutions require extensive changes to the existing system, however. I argue in the following section that the “gap”³⁸ between traditional knowledge and intellectual property can be partially filled using the law of geographical indications, an area of intellectual property law regulated, to a certain extent at least, in TRIPS.³⁹

34. This is reinforced by the following additional proposal: “There shall be adequate and effective legal and practical measures to ensure that communities have the means to prevent the unauthorized disclosure, subsequent use of and acquisition and exercise of IP rights over secret traditional cultural expressions/expressions of folklore.” See REVISED PROVISIONS, *supra* note 30, at 20.

35. For example, under Canadian Copyright Act, R.S.C., ch. C-42 (1985).

36. See TRADE AND DEVELOPMENT, *supra* note 17.

37. The Doha “Round” was launched in Doha (Qatar) in 2001 as a round of multilateral trade negotiations. As for previous rounds conducted under the aegis of the General Agreement on Tariffs and Trade (GATT), its purpose is to liberalize and update trade rules. Because the previous (Uruguay) Round led both to the establishment of the World Trade Organization (WTO) and the adoption of the TRIPS Agreement, the Doha Round includes, for the first time, possible amendments to that Agreement. In fact, one such amendment, namely Article 31 *bis*, was already adopted (though it is not in force as of January 2009) to allow broader compulsory licensing for export of certain pharmaceutical products. See DRAFTING HISTORY, *supra* note 15, at 46–69.

38. See *Draft Gap Analysis*, *supra* note 2.

39. See Ruth L. Okediji, *The International Intellectual Property Roots of Geographical Indications*, 82 CHI.-KENT L. REV. 1329, 1356 (2007). See also DRAFTING HISTORY, *supra* note 15, at 293–303.

III. GEOGRAPHICAL INDICATIONS AS PART OF THE ANSWER

A. What is a “Geographical Indication”?

A good place to start is to define what we are talking about. Before looking at TRIPS let us consider the Lisbon Agreement.⁴⁰ This agreement defines “appellations of origin,” as follows: “In this Agreement, ‘appellation of origin’ means the geographical name of a country, region, or locality, which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors.”⁴¹

This definition is also used to define the same term used in the Paris Convention and in the Convention on the Use of Appellations of Origin and Denominations of Cheeses.⁴²

Appellations of origin are terms or symbols that designate a geographical location, which may be as small as a village or as big as a country, to distinguish products produced in that geographical location and produced either according to regulations or “local, constant, and trusted usage”⁴³ in such location which results in certain quality or characteristics of the product, and/or its fame. Typically, this will be due to a method of production or of extraction of certain local resources. The notion is not, however, confined to food products or indeed products that require that certain local natural resources be used. Industrial products may also be protected by an appellation due to the availability of specialized skills and know-how.⁴⁴ Protection may also extend to a certain presentation of products for sale.⁴⁵

40. Lisbon Agreement for the Protection of Appellations of Origin and their International Registration art. 5(1), Oct. 31, 1958, 923 U.N.T.S. 205, *as revised* at Stockholm on July 14, 1967, and *as amended* on Sept. 28, 1979, [hereinafter Lisbon Agreement]. The Lisbon Agreement includes a registration system similar to that used in respect of trademarks. Member countries are relatively free as to the form of implementation.

41. *Id.* art. 2(1).

42. Convention internationale sur l’emploi des appellations d’origine et denominations de fromages, [International Convention for the Use of Designations of Origin and Names of Cheeses], art. 3, June 1, 1951, <http://www.admin.ch/ch/f/rs/i8/0.817.142.1.fr.pdf> (last visited Feb. 26, 2009).

43. See UNION INTERNATIONALE POUR LA PROTECTION DE LA PROPRIÉTÉ INDUSTRIELLE, ACTES DE LA CONFÉRENCE DE LISBONNE RÉUNIE À LISBONNE DU 6 AU 31 OCTOBRE 1958 831 (1963) [hereinafter ACTES]. The Acts of the Lisbon Conference were published in French. All translations are the author’s own.

44. *See id.*

45. *See id.* at 814.

The TRIPS Agreement does not refer to appellations of origin. Instead, it was the first multilateral text dealing with “geographical indications.”⁴⁶ Article 22.1 of the TRIPS Agreement resembles Article 2 of the 1958 Lisbon Agreement, yet it also differs at least facially from Lisbon on a number of points:

- a) Appellations of origin under the Lisbon Agreement are geographical *names* of a country, region, or locality, while geographical indications under TRIPS are *any* indication pointing to a given country, region or locality, but not necessarily limited to the name of a country, region or locality—what matters is the indication that the good originates in the territory of a member or a part thereof;
- b) Appellations of origin under Lisbon designate a product, while a geographical indication under TRIPS identifies a good, the term traditionally used in the GATT/WTO context to differentiate goods from services (that is, the definition does not include services);⁴⁷
- c) Finally, appellations of origin speak of a geographical environment, including natural and human factors,⁴⁸ while TRIPS uses a more general concept of “geographical origin.”

However, the negotiating history of the Lisbon Agreement⁴⁹ shows that the agreement was understood to provide considerable flexibility to member states. The Lisbon drafters would have recognized the TRIPS definition as similar, if not identical to the concept they were trying to define. For example, a possible difference between the two instruments is that the Lisbon definition (Art. 2(1)) mentions only the quality and⁵⁰ characteristics of a product, while TRIPS also mentions its reputation. This is correct of course. However, the definitions are functionally identical when one considers that the Lisbon Agreement defines

46. North American Free Trade Agreement, Art.1721 (U.S.-Can.-Mex., Dec. 17, 1992, 32 I.L.M. 605 (1993), available at http://www.nafta-sec-alena.org/DefaultSite/index_e.aspx?DetailID=78 (last visited Feb. 27, 2009) (also containing a definition of “geographical indications”).

47. Apparently, no difference in meaning (between “product” and “good”) was intended, especially in light of the fact that in both the French and Spanish versions the same words, namely “produit” and “producto” respectively, were used.

48. For examples of how far this could be applied, see Florent Gevers, *Geographical Names and Signs Used as Trade Marks*, 8 EUR. INTEL. PROP. REV. 285, 287 (1990); see also Luigi Sordelli, *The Future Possibilities of International Protection for Geographical Indications*, 30 INDUS. PROP. 154 (1991).

49. See ACTES, *supra* note 43, at 813.

50. It should be noted that the official signed text of the Lisbon Agreement is the French text and it uses “ou”, not “et”, that is “or” not “and”, and in that respect is similar to TRIPS. A key WIPO publication does the same (i.e., uses the disjunctive form), even in English. See G. H. C. BODENHAUSEN, *GUIDE TO THE APPLICATION OF THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY* 23 (1968).

“country of origin” as “the country whose name, or the country in which is situated the region or locality whose name, constitutes the appellation of origin which has given the product its *reputation*.”⁵¹ There remains what amounts mostly to a sequencing difference: Lisbon focuses on quality and characteristics, and seems to assume that a reputational advantage will follow, while TRIPS apposes the three notions. The negotiating history also supports a broad interpretation of the term “name,” which would apply to any denomination.

One could also interpret the reference to reputation in Lisbon as requiring reputation “next to” quality or characteristics. This view is supported by Article 2(2) but also by the use of the term “recognized” in Article 1(2). The meaning of this term as it features in Article 1(2) is explained in the Report of the Fourth Commission of the Lisbon Conference⁵² as follows: “Article I was approved with the addition of the word ‘recognized’ before the words ‘protected as such’[. . .]. This change was considered necessary to harmonize this provision with the principle according to which an appellation always protects a product having a certain degree of notoriety.”⁵³

In sum, geographical indications as defined in the TRIPS Agreement may cover a somewhat broader scope than appellations of origin as defined in the Lisbon Agreement, because they include the “reputation” parameter found in the relevant European Union Regulation⁵⁴ as a separate element, whereas in Lisbon, reputation is assumed to derive from the quality or characteristics and is mentioned in the definition of “country of origin” instead of the definition of appellation itself.⁵⁵ Yet when one looks at functional differences, there are very few indeed.

51. Lisbon Agreement, *supra* note 40, art. 2(2).

52. See ACTES, *supra* note 43, at 859.

53. *Id.*

54. Council Regulation 2081/92, Protection of Geographical Indications and Designations of Origin for Agricultural Products and Foodstuffs, 1992 O.J. (L 208) 1 (EEC), available at <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=CELEX:31992R2081:EN:HTML> (last visited Mar. 25, 2009).

55. In addition, systems concerning appellations of origin usually presuppose the existence of a registration system. See WTO, Queen Mary Intellectual Property Research Institute, *Relationship Between Intellectual Property Rights (TRIPS) and Food Security*, at 28, <http://www.ppl.nl/bibliographies/wto/files/6962.pdf> (last visited Feb. 27, 2009) (citing WIPO, *The Need for a New Treaty and its Possible Contents*, WIPO Doc., GEO/CE/1/2, at n.41 (Apr. 9, 1990)). See also WIPO, Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, 9th Sess., *The Definition of Geographical Indications*, WIPO Doc. SCT/9/4 (Oct. 1, 2002). It is also relevant to note that this European Regulation was negotiated at about the same time as TRIPS.

B. Protection of Geographical Indications in TRIPS

TRIPS provides for two types of protection of geographical indications, as this term is understood in the Agreement. Art. 22.2 obliges WTO Members to provide “legal means” for interested parties to prevent (a) the use of any means (not limited to a name)⁵⁶ in the designation or presentation of a good that could mislead the public into believing that the good in question originated in a geographical area other than the true place of origin, or (b) any use which constitutes an act of unfair competition within the meaning of Art. 10*bis* of the Paris Convention. This provision does not create a full exclusive right and allows WTO Members to implement the provision in a variety of ways.⁵⁷ Under Article 22.2(a), one must show that the *public might be misled*, a level of protection that resembles trademark protection.⁵⁸ In fact, protection may be provided as a collective or certification mark. The provision may also be implemented through a specific registration system and provide a higher level of protection. When a specific (*sui generis*) registration system is provided, it usually requires evidence that the product possesses a certain quality, reputation or characteristic due to its origin. This is not generally required under the trademark system,⁵⁹ but nor is determination of quality by the national authority (and then, how the standard would be applied) a required step either in TRIPS or the Lisbon Agreement.

Under TRIPS Article 23.1, a higher level (sometimes somewhat abusively referred to as “absolute” as in Lisbon)⁶⁰ of protection for *wines and spirits* was agreed upon. Using a geographical indication identifying *wines or spirits* for wines and spirits not originating in the place indicated by the indication is prohibited, even where the true origin of the wines and spirits concerned is indicated, and/or a translation is used, and/or the indication is accompanied by expressions such as “kind,” “type,” “style,” “imitation” or the like. There is no need here to show that the public might be misled or that the use constitutes an act of unfair competition. The last part of the Article resembles Article 3 of the Lisbon Agreement (which applies to all types of products, however): “Protection shall be ensured against any usurpation or imitation, even if the true origin of the product is indicated or if the appellation is used in translated form

56. It would seem that the reference to “any means in the designation or presentation”, combined with the open-ended mention of “indication which identify a good” (regardless of the means) covers also indirect indications.

57. Civil judicial procedures must be available to the right holder. See TRIPS Agreement, *supra* note 5, art. 42.

58. *Id.* art. 22(2).

59. See Alberto Francisco Ribeiro de Almeida, *Key Differences Between Trade Marks and Geographical Indications*, 30 EUR. INT. PROP. REV. 406, 408 (2008).

60. See J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 29.28 (3d ed. 1996).

or accompanied by terms such as ‘kind,’ ‘type,’ ‘make,’ ‘imitation,’ or the like.”⁶¹ The scope of additional protection is limited to the use of geographical indication for other wines or spirits.

C. *Geographical Indications and Traditional Knowledge*

While natural resources are shared quite unevenly among nations, every country has at least one undeniable resource: its geography. A nation is, among other things, a defined geographical area. Thus, the protection of geographical indications is potentially of interest to all nations. In fact, because many traditional goods with a specific geographical origin come from developing countries, the protection of geographical indications has normative heft in countries that are “TK-rich.”

Additionally, ensuring that goods that are identified as having a *specific origin and that have higher value because of that origin* may allow producers in all nations, including developing ones, to increase prices and protect markets. The normative (reducing distortions in the current intellectual property system) thus meets the pragmatic.

Against this backdrop, the political expediency that led to the adoption of a higher level of protection in TRIPS only for wines and spirits is perceived as discriminatory by many countries. Wines and spirits not sold as varietals or based on the name of the producer but rather on the geographical origin of the wine (Bordeaux, Champagne) or spirit (Cognac) is generally considered Western European, phenomenon—although a number of “New World” vineyards are increasingly gaining recognition. This explains why debates in the Doha Round⁶² have had a dual focus: the establishment of the register foreseen in TRIPS Art. 23.4, and though this is not expressly stated in TRIPS, the extension to products other than wines and spirits of the higher level of protection.

61. Lisbon Agreement, *supra* note 40, art. 3.

62. See DRAFTING HISTORY, *supra* note 15, at 46. The Declaration that launched the Round mandated negotiators specifically to “complet[e] the work started in the Council for Trade-Related Aspects of Intellectual Property Rights (Council for TRIPS) on the implementation of Article 23.4,” namely to negotiate the establishment of a multilateral system of notification and registration of geographical indications for wines and spirits by the Fifth Session of the Ministerial Conference. We note that issues related to the extension of the protection of geographical indications provided for in Article 23 to products other than wines and spirits will be addressed in the Council for TRIPS pursuant to paragraph 12 of this declaration.

World Trade Organization, Ministerial Declaration of 14 November 2001, WT/MIN(01)/DEC/1, 41 I.L.M. 746 (2002). The coded reference to paragraph 12 is essentially an obligation to “try to do something and then report.”

My suggestion is that the Lisbon register could easily be used as the TRIPS multilateral register. It has the experience and ability to grow. The Lisbon system is eminently flexible. Lisbon members⁶³ do not have to adopt a *sui generis* registration system. Their only obligation is to establish a national office empowered to interface with the international registry (either the same one or a different one for each type of notification provided for under the Agreement). This may be the existing trademark office, for example.

To be able to use the international register, an appellation must be protected in the country of origin of the right-holder (whose status is also decided under the domestic law of each member). This necessarily implies that a legal mechanism be put in place in each member state. However, this mechanism may be a national law or regulation, a court decision, a decision by a specialized agency or board, a trademark-like (application/publication/opposition/registration) system, or indeed a *sui generis* system, as in many European countries.

The Lisbon Agreement does not curtail the implementation method to be used in each member state. In fact, just the opposite is true: the Regulations provide that an application must contain, *inter alia*, “the title and date of the legislative or administrative provisions, the judicial decisions or the date and number of the registration by virtue of which the appellation of origin is protected in the country of origin.”⁶⁴

D. The TRIPS/Lisbon Interface

It has been argued that the TRIPS Agreement superseded Lisbon and affirmed the “first in time, first in right principle.”⁶⁵ This is both true and false. It is true in terms of membership, and consequently, geographical and economic coverage. As of December 2008, the WTO had 153 Members and twenty-nine accessions in progress,⁶⁶ while only twenty-six States were Lisbon members.⁶⁷

63. Only 26 as of January 2009, though only 3 in Western Europe. See WIPO, Administered Treaties, *infra* note 66.

64. WIPO, REGULATIONS UNDER THE LISBON AGREEMENT FOR THE PROTECTION OF APPELLATIONS OF ORIGIN AND THEIR INTERNATIONAL REGISTRATION Rule 5(2)(a)(vi) (2002), available at http://www.wipo.int/export/sites/www/treaties/en/registration/lisbon/pdf/trtdocs_wo013.pdf (last visited Mar. 2, 2009) (emphasis added).

65. Clark W. Lackert, *Geographical Indications: What Does the WTO TRIPS Agreement Require?*, 109 TRADEMARK WORLD 22, 24 (Aug. 1998).

66. WTO, Understanding the WTO, Members and Observers, www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm (last visited Feb. 27, 2009); WTO, Accessions, http://www.wto.org/english/thewto_e/acc_e/acc_e.htm (last visited Feb. 27, 2009). Not all WTO members are States that would be able to accede to the Lisbon Agreement, however. Some (e.g., Hong Kong) are trade territories.

67. See generally WIPO, Administered Treaties, Contracting Parties, Lisbon Agreement, www.wipo.int/treaties/en/ShowResults.jsp?treaty_id=10 (last visited Feb. 26, 2009).

It is also true that TRIPS contains far more detailed rules concerning the interface between marks and indications. Where the statement is more questionable is whether the Lisbon system was “superseded.”

As noted above, TRIPS contains a “built-in agenda” which, in the area of geographical indications, provides that negotiations must be undertaken on both substantive and administrative issues. On the latter front, Article 23.4 provides that negotiations “shall be undertaken in the Council for TRIPS concerning the establishment of a multilateral system of notification and registration of geographical indications for wines eligible for protection in those Members participating in the system.”⁶⁸ On the former, Article 24.1 provides that WTO Members “agree to enter into negotiations aimed at increasing the protection of individual geographical indications under Article 23.”⁶⁹ If we transpose those obligations into a Lisbon context, the questions become, respectively, whether the Lisbon protection, which seems to accord with the higher level of protection contained in Article 23.1, should be extended to other products, and whether the Lisbon registration system could be the system foreseen under Article 23.4.

Naturally, WTO Members could agree, as a first step, to have a worldwide registration system only for wines and spirits. In light of political developments concerning the importance of indications for products other than wines and spirits for dozens of developing countries, an issue deeply enmeshed in the Doha Round,⁷⁰ this does not seem a highly likely path.

Many non-Lisbon TRIPS Members say they oppose Lisbon because they do not want to accept the past (and perhaps not the future) appellations on the registry. The reality is, they do not have to. Lisbon allows its Members to reject any new registration *and* those already on the register when they join. Under Article 5(3) of the Agreement, any national office may declare that it “cannot ensure the protection of an appellation of origin whose registration has been notified to it . . . together with an indication of the grounds therefor.”⁷¹ The declaration of refusal must be made within one year of the receipt of WIPO’s notification and may not be made later.⁷² If such a declaration is made within the appropriate delay and with a proper justification (for example, the appellation is generic in the declaring country), WIPO then notifies the country of origin of the registration, which, in turn, notifies the right-holder (holder of the registration). The *only* remedy available at that juncture is for the right-holder to resort, in the declaring/refusing country, to the judicial and administrative remedies open to the nationals of that country. That is, national

68. See TRIPS Agreement, *supra* note 5, art. 23.4.

69. *Id.* art. 24.1.

70. See DRAFTING HISTORY, *supra* note 15, at 95–108.

71. Lisbon Agreement, *supra* note 40, art. 5(3).

72. *Id.* art. 5(4).

treatment. As already mentioned, there are no limits on the grounds that may be invoked in support of a declaration under Article 5(3).

Then Article 14(2)(c) provides that any country acceding to this Agreement may, within a period of one year, declare in regard to which appellations of origin, already registered at the International Bureau, it wishes to exercise the right provided for in Article 5(3).

Lisbon Members also have considerable flexibility in the grounds they may invoke and their decision is not subject to international review; only to review or other litigation before their national courts. WTO Members could thus join Lisbon and reject all appellations that clash with active trademarks. As there were only 887 appellations on the register as of December 19, 2008,⁷³ many of which are not used internationally, the amount of work involved would not be insurmountable. Rejections could be sent in even doubtful or marginal cases. The spirit of Lisbon is that a rejection may be considered as a way of entering into negotiations.

Administratively, little would be required from new members. There is no need for countries that would join Lisbon to establish a *sui generis* administrative system for GIs. Existing trademark offices could function as national Lisbon agencies. Naturally, rules would need to be developed to deal with the administrative submission process, but essentially a Lisbon registration could be sought by an applicant for any qualifying collective or certification mark corresponding to the notion and function of a geographical indication. Applicants submitting a trademark based on geographical designation could ask their national office to submit it as a Lisbon appellation. Each Member could decide to which extent it would examine those claims. Clearly, however, the process could function as a trademark system. Applications (to be registered under Lisbon) would be published as any pending mark application. Incoming Lisbon registrations would also be published and subject to opposition by prior trademark holders. If the opposition was litigated, the national office could notify a refusal, which it could then withdraw if the holder of the appellation won its case before national administrative and/or judicial authorities. Essentially, an unopposed Lisbon appellation would be protected as a certification or collective mark in those systems, thus preventing or restraining future trademark registration of the same mark. This would not be different from registration of other marks under the current system.

Politically, using Lisbon as the Article 23 Register would shift the ongoing Doha discussions from one based on fairly abstract principles to one on

73. See generally WIPO, Program and Budget Committee, 13th Sess., *Summary Program Performance Report for 2006–2007*, ¶ 176, WIPO Doc. WO/PBC/13/3(b), (Nov. 17, 2008), available at http://www.wipo.int/edocs/mdocs/govbody/en/wo_pbc_13/wo_pbc_13_3_b.pdf (last visited Mar. 2, 2009).

specific, individual indications, and also one allowing the Round to move forward.

The normative question left unanswered by this proposed solution is whether a higher degree of harmonization is desirable. Given the ideological differences between the “GIs as trademark countries” and those that see GI as a higher form of (*sui generis*) protection, a difference reconciled in part by TRIPS, and the fact that even if in the *sui generis* countries the superiority of geographical indications is not always affirmed, further harmonization fruits may not be ripe for harvesting and incorporation into a multilateral instrument, whether as an amendment to TRIPS or as an entirely new instrument.