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A Look at the Geneva Act of the Lisbon Agreement: A Missed Opportunity?

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1 INTRODUCTION

In May 2015, a number of World Intellectual Property Organization (WIPO) member states adopted a new Act of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration 1985 (Lisbon Agreement).[1] A question that surfaced both during the negotiations and since the signing ceremony is whether this new Act will be palatable to countries using a common-law trademark approach for the protection of geographical indications (GIs) instead of the mostly European approach of using a *sui generis* (non-trademark) system.[2] This question applies, for example, to several

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[1] Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration, October 31, 1958, *as revised*, July 14, 1967, 923 U.N.T.S. 205 [hereinafter Lisbon Agreement], www.wipo.int/treaties/en/text.jsp?file_id=285856/; World Intellectual Prop. Org. [WIPO], Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications and Regulations under the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications, WIPO Document LI/DC/19 (May 20, 2015), [hereinafter Geneva Act], www.wipo.int/meetings/en/details.jsp?meeting_id=35202.

[2] For example, "Champagne" is a GI protected under a *sui generis* regime in France and the rest of Europe. In France, this protection reflects a recognized link between the land (and know-how concerning its use) and a product – a concept known as *terroir*. *Terroir* has received various forms of legal protection dating back to at least the fifteenth century. *See* PAUL S. KINDSTEDT, CHEESE AND CULTURE 214 (2012). CHAMPAGNE is now protected under the system of *Appellations d'Origine Contrôlée* (AOC). *Id.* at 308. More recent regulations are contained in the Code de la Propriété Intellectuelle [C. PROP. INTELL.] [INTELLECTUAL PROPERTY CODE] art. L 721–1 to -10 (Fr.), www.legifrance.gouv.fr/affichCode.do?cidTexte=LEGITEXT000006069414; and the Law of the 30th of July 1935. Décret législatif du 30 juillet 1935 – Défense du Marché des Vins et Régime Économique de l'Alcool [Law of July 30, 1935, Defense of Wine Market and Economic Regime of Alcohol],

countries involved in the now likely defunct Trans-Pacific Partnership (TPP) Agreement but also in other regional trade arrangements including the draft Regional Comprehensive Economic Partnership (RCEP).[3]

GIs matter on several levels. They have deep roots in the *terroir*, a French word designed to encapsulate a blend of land, tradition, and human know-how.[4] In the Geneva Act context, this raises a question, namely whether this notion of *terroir* is commensurate with modern international trade rules, at least as trade is practiced outside of Europe (in say, RCEP countries).[5] *Terroir* matters to many producers and many countries, and not just in Europe. In parts of the "Old World," however, it is not an exaggeration to say that some countries link *terroir* to national identity.[6] Many so-called "New World" producers of wines, spirits, and agricultural products see things differently. While they also recognize the economic value of identifying the geographic origin for certain products – for example, in the United States (US), Florida orange juice, Idaho potatoes, Napa Valley wines, and Vidalia onions – they are concerned about possible restrictions on the use of terms they consider generic (meaning terms that, in their view, primarily describe a type of product, not its geographic origin).[7]

Several developing country producers have similar concerns about the protection of foreign terms—often belonging to producers in former colonial powers – that have become, or may become, generic in their country or region.

Journal Officel De La République Française [J.O.] [Official Gazette of France], July 31, 1935, p. 8314.

3 *See* Trans-Pacific Partnership, October 5, 2015, https://ustr.gov/sites/default/files/TPP-Final-Text-Intellectual-Property.pdf. The twelve countries party to the TPP are Australia, Brunei Darussalam, Canada, Chile, Japan, Malaysia, Mexico, New Zealand, Peru, Singapore, the United States, and Vietnam. *See* Office of the US Trade Representative, *What is the TPP*, https://ustr.gov/tpp/ (last visited February 9, 2016). As to the Regional Comprehensive Economic Partnership (RCEP), it is a proposed trade agreement (FTA) between the member states of the Association of Southeast Asian Nations (ASEAN) (Brunei, Cambodia, Indonesia, Laos, Malaysia, Myanmar, the Philippines, Singapore, Thailand, Vietnam), on the one hand, and Australia, China, India, Japan, New Zealand and South Korea, on the other hand. The United States is not party to the RCEP discussions (as of February 2017).

4 *See* Justin Hughes, *Champagne, Feta, and Bourbon: The Spirited Debate about Geographical Indications*, 58 Hastings L. J. 299, 300–02, 306–08, 352 (2006).

5 *See supra* note 3.

6 *See* Kolleen M. Guy, When Champagne Became French: Wine and the Making of a National Identity 2 (2007) ("Much like the nation, champagne and its *terroir* are believed to possess eternal, natural qualities. The wine can be seen as an objective manifestation of the French 'soul,' the guardian of supreme spiritual values."); Emily C. Creditt, *Terroir vs. Trademarks: The Debate over Geographical Indications and Expansions to the TRIPS Agreement*, 11 Vand. J. Ent. & Tech. L. 425, 427 (2009).

7 *See* J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition §§ 19:92.50 (2nd edn. 1999).

Their situation is not uniform, however. Those who live in countries rich in traditional knowledge (many of which are developing countries), for instance, see the expansion of GI protection as a way to repair historical wrongs and, more broadly, as a way to de-Westernize intellectual property rules, which some consider systematically discriminatory because they favor Western methods of marketing and production and Western goods.[8] Several developing nations consider GIs as a way of protecting and globally marketing their rural and traditional products at a higher price, which they assert would lead to "development from within," that is, "an alternative development strategy that prioritizes local autonomy and broad, community-wide development goals."[9]

GIs affect prices, though not for every product and not in a uniform way. There are examples that illustrate the capture of additional rents due to the (consumers') perception of higher quality associated with certain geographical origins. For some products, this ties into – and may sometimes be confused with – "fair trade" labels and certification processes concerning the sourcing of an increasingly wide range of products, many of which come from the developing world (e.g., coffee, tea, cocoa, etc.).[10] Recent research also suggests that GI protection impacts food consumption patterns and can lead to shifts in agricultural models.[11]

GIs tend to focus production on a nation's comparative advantage in making a product whose origin infuses it with a higher market

[8] "Western" is used here not as a geographical reference but as a reference to the most industrialized nations. Peter Yu has suggested that the discriminatory use of GIs may lead developing countries to be more self-interested in higher levels of intellectual property protection. *See* Peter K. Yu, *TRIPS* and Its Achilles' Heel,' 18 J. INTELL. PROP. L. 479, 523–24 (2011).

[9] *See* Sarah Bowen, *Development from Within? The Potential for Geographical Indications in the Global South*, 13 J. WORLD INTELL. PROP. 231, 232 (2010) (noting that "diverse stakeholders" find GIs a useful tool for rural development). *See generally* Daniel Gervais, *Traditional Innovation and the Ongoing Debate on the Protection of Geographical Indications*, in INDIGENOUS PEOPLES' INNOVATION 121, 121–47 (Peter Drahos & Susy Frankel eds., 2012) (suggesting that developing countries may be attracted to GI protection of indigenous products because of GI's potential ability to promote respect, prevent misappropriation and misuse of traditional cultural expressions, empower communities, and encourage community innovation and creativity).

[10] For a review of fair trade labeling standards, see, for example, *Our Standards*, FAIRTRADE INT'L, www.fairtrade.net/our-standards.html (last visited February 8, 2016).

[11] *See* Elizabeth Barham, *Translating Terroir: The Global Challenge of French AOC Labeling*, 19 J. RURAL STUD. 127, 127 (2003) (arguing that expanded AOC systems create "new forms of local–global connections"). "As part of its initiative on 'Quality Linked to Geographical Origin,' the Food and Agriculture Organization (FAO) of the United Nations sponsored case studies on GIs and developing countries, culminating in regional seminars in Morocco and Chile in 2007 and a conference in Rome in 2008." Bowen, *supra* note 9, at 232.

value.[12] As such, GIs may have a deep environmental significance and form an increasingly relevant part of agricultural and food policy.[13] It is not surprising, therefore, that the debate surrounding the protection of GIs has captured the attention of a number of consumer groups, many of which insist on proper labeling of products, notably to indicate their origin. Their insistence stems not only from a desire to buy more locally produced products and to reduce the carbon footprint of their consumption patterns but also from the "quality assurance" factor[14] associated with a number of GIs.[15]

How does this translate into the Lisbon Agreement context? As of this writing (March 2017), no common-law jurisdiction is party to the Lisbon Agreement.[16] There are a number of reasons that explain this lack of enthusiasm. As this chapter elaborates in the following pages, many common-law jurisdictions use trademarks, collective marks, and certification marks to protect geographic symbols and names. This has a number of both normative and administrative implications, including use requirements, possible loss or diminution of right due to acquiescence and abandonment or genericness, and the payment of maintenance fees, to mention just the main effects. These characteristics define the gap that needs to be bridged between the Lisbon system and the common law. This chapter's purpose is to explore whether the Geneva Act succeeded in building this bridge.

12 Cerkia Bramley, Estelle Biénabe, & Johann Kirsten, *The Economics of Geographical Indications: Towards a Conceptual Framework for Geographical Indication Research in Developing Countries*, *in* The Economics of Intellectual Property 109, 121 (2009), www.wipo.int/edocs/pubdocs/en/economics/1012/wipo_pub_1012.pdf.

13 *See* William van Caenegem, *Registered GIs: Intellectual Property, Agricultural Policy and International Trade*, 26 Eur. Intell. Prop. Rev. 170, 172–73 (2004) (stating that the momentum behind the EU appeals for greater GI protection "comes from Mediterranean EU states, Italy, Portugal, Spain, and above all France, where traditional, specialised, small scale, non-commoditised agricultural practices remain relatively commonplace, with a fair degree of rural processing").

14 *See* Alberto Francisco Ribeiro de Almeida, *Key Differences between Trade Marks and Geographical Indications*, 30 Eur. Intell. Prop. Rev. 406, 410 (2008) (listing positive public effects of GIs).

15 *See* David Goodman, *Rural Europe Redux? Reflections on Alternative Agro-Food Networks and Paradigm Change*, 44 Sociologia Ruralis 3, 9–10 (2004).

16 As of October 2015, the list of parties to the Lisbon Agreement is as follows: Algeria, Bosnia and Herzegovina, Bulgaria, Burkina Faso, Congo, Costa Rica, Cuba, Czech Republic, Democratic People's Republic of Korea, France, Gabon, Georgia, Haiti, Hungary, Iran, Israel, Italy, Mexico, Montenegro, Nicaragua, Peru, Portugal, Republic of Moldova, Serbia, Slovakia, the former Yugoslav Republic of Macedonia, Togo, and Tunisia. *See Contracting Parties-Lisbon Agreement*, World Intell. Prop. Org., www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=10 (last visited January 11, 2016).

To do so, the chapter proceeds as follows. The first part briefly describes the functioning of the Lisbon system, and the second part compares the Lisbon system with the common-law system of protection for geographic identifiers as marks.

2 GEOGRAPHICAL INDICATIONS UNDER THE LISBON AGREEMENT

2.1 *Terminological Issues*

Article 1 of the 1958 Lisbon Agreement requires member states to protect appellations of origin "as such."[17] The Geneva Act of the Lisbon Agreement on Appellation of Origin and Geographical Indications 2015 (Geneva Act)[18] is more flexible on this front. In addition to its reference to the 1958 notion of "appellations of origin," the Geneva Act also refers to "geographical indications," bringing it in line with the language used in the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement).[19]

The Geneva Act applies to

> any indication protected in the Contracting Party of Origin consisting of or containing the name of a geographical area, or another indication known as referring to such area, which identifies a good as originating in that geographical area, *where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin*.[20]

The TRIPS Agreement defines geographical indications 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 attributable to its geographical origin*.[21]

17 Lisbon Agreement, *supra* note 1, art. 1(2); *see* Hughes, *supra* note 4, at 312–13, 312 n.79.
18 Geneva Act, *supra* note 1, art. 2(1)(ii).
19 Agreement on Trade-Related Aspects of Intellectual Property Rights, 1993, art 22.1, April 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299 [hereinafter TRIPS Agreement]. TRIPS uses and defines only the term geographical indications. It refers neither to Lisbon, nor to the notion of appellation of origin.
20 Geneva Act, *supra* note 1, art 2(1)(ii) (emphasis added).
21 TRIPS Agreement, *supra* note 19 art 22.1 (emphasis added). For a full analysis of the distinction between TRIPS and the original 1958 definitions, see Daniel J. Gervais, *Reinventing Lisbon: The Case for a Protocol to the Lisbon Agreement (Geographical Indications)*, 11 CHI. J. INT'L L. 67, 83–87 (2010).

Incorporating the language contained in the TRIPS Agreement, and thus common to all WTO members in the Geneva Act, is an improvement. While the Geneva Act obligates members to protect both registered appellations of origin and geographical indications on their territory, it also dropped the "as such" language and further provides that each "Contracting Party shall be free to choose the type of legislation under which it establishes the protection stipulated in this Act."[22] Dropping the "as such" language may have solved the terminological quandary that countries not using the notion of "appellation of origin" in their legal system may have had with the 1958 text.

2.2 Level of Protection Issues

The 1958 Lisbon Agreement obligates countries to provide protection of geographical indications against "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,' 'type,' 'make,' 'imitation,' or the like."[23] "Usurpation" is not a term commonly used in international intellectual property laws and treaties.[24] The *travaux*[25] define usurpation as the "illicit adoption" of an appellation and provide "counterfeiting" as a possible synonym.[26] The *travaux* also make clear that it is up to each country to decide the remedies that should be available.[27] It is difficult to reconcile this language with the TRIPS Agreement because that Agreement provides for two different levels of protection of geographical indications.

22 Geneva Act, *supra* note 1, arts. 9, 10(1).

23 Lisbon Agreement, *supra* note 1, art. 3 (emphasis added).

24 The term is also used in the Bangui Agreement Relating to the Creation of an African Intellectual Property Organization, Constituting a Revision of the Agreement Relating to the Creation of an African and Malagasy Office of Industrial Property, art. 47, March 2, 1977, World Intell. Prop. Org., www.wipo.int/wipolex/en/other_treaties/text.jsp?file_id=181150#P3099_400022 (last visited November 20, 2015).

25 *Travaux* are the "[m]aterials used in preparing the ultimate form of an agreement or statute, and esp. of an international treaty; the draft or legislative history of a treaty." *Travaux préparatoires*, Black's Law Dictionary (10th edn. 2014).

26 Union Internationale pour la Protection de la Propriété Industrielle, Actes de la Conférence Réunie à Lisbonne du 6 au 31 Octobre 1958, at 815 (1863) [hereinafter *Actes*]. The *Actes* (including mostly the *travaux préparatoires*) of the Lisbon Conference were published in French only. Translations are the Author's own.

27 *Id.* at 818; *see also* Lisbon Agreement, *supra* note 1 art. 8 (stating that a "competent Authority" of each member state or an "interested party" in each member state may take legal action under the agreement).

Under Article 22.2(a) of the TRIPS Agreement, which may apply to products of any kind (thus to agricultural and nonagricultural products), a potential right-holder must provide the means for interested parties to prevent the use of designations that might mislead the public, a level of protection that resembles trademark protection. A higher level of protection for *wines and spirits* was agreed upon in the TRIPS Agreement. Article 23 of the TRIPS Agreement prohibits use of a GI on wine or spirits originating outside the region specified by the GI.[28] The prohibition stands even if the true origin of the wine or spirits is indicated, a translation is used, or the indication is "accompanied by expressions such as 'kind,' 'type,' 'style,' 'imitation' or the like."[29] There is almost what looks like a presumption that the public might be misled – or that the competing use constitutes an act of unfair competition – when dealing with GIs on wines and spirits. This higher level of protection for wines and spirits is closer to the standard of the 1958 Lisbon Agreement, and probably even more so now because the Geneva Act replaced the right against "usurpation" with a three-legged right.

Article 11 of the Geneva Act provides a right that combines elements of Articles 16.3 (protection of well-known marks) and 22.2 (protection of geographical indications) of the TRIPS Agreement. Specifically, member countries must provide legal means to prevent any unauthorized use of the GI in three situations: (1) goods of the same kind as those to which the GI applies (including use in translated form or accompanied by terms such as "style," "kind," "type," "make," "imitation," "method," "as produced in," "like," "similar," or the like); (2) goods or services not of the same kind, if use would suggest a connection expanded to include, "where applicable," a right against uses liable "to impair or dilute in an unfair manner, or take unfair advantage of, that reputation" of the GI; and (3) "any other practice liable to mislead consumers as to the true origin, provenance or nature of the goods," including use amounting to imitation of the protected appellation or indication.[30]

This is a "TRIPS plus" outcome both because the higher level of protection in the TRIPS Agreement (without the need to show deception or confusion) is limited to wines and spirits[31] and because the TRIPS Agreement does not provide protection against "imitation." The Geneva Act is a de facto expansion by (and for) Lisbon members of GI protection to products other than wines and spirits – a measure sought by a number of WTO members, especially in the developing world. The Lisbon standard does not require confusion. This

[28] TRIPS Agreement, *supra* note 19, art. 23.1. [29] *Id.* [30] Geneva Act, *supra* note 1, art. 11.
[31] TRIPS Agreement, *supra* note 19, art. 23.

level of protection, unlike trademark law, requires no evaluation of the local consumer even (or especially) in a market where a GI protected under Lisbon may be neither known (by a significant proportion of the relevant public) nor used.

Finally, under the Lisbon system, one could argue that registration creates a worldwide public notice of the claim leading, normatively and/or doctrinally, to a presumption of confusion of sorts, requiring a ban on the use of the GI even with words such as "like" or "style." The TRIPS Agreement provision on a possible notification and registration system does not go that far in that it does not specify the legal effect of registration in the system, the establishment of which must still be negotiated.

2.3 *Registration-Related Issues*

The 1958 Lisbon Agreement established a multilateral registry for appellations of origin.[32] The Geneva Act made several improvements to the administrative operation of the register and generally modernized the system of registration of both geographical indications and appellations of origin. Without offering an exhaustive list of such improvements, the Geneva Act made the role of national offices much clearer. Applicants may be required to pay per-country fees and fees to use the protected indication, but not maintenance fees to the member country in which they seek protection.[33]

The Geneva Act also introduced a clearer system to refuse new GIs (and then withdraw refusals in whole or in part) and a new system allowing interested parties to "request the Competent Authority to notify a refusal in respect of the international registration."[34] In contrast, the text of the 1958 Lisbon Agreement did not mention grounds for refusal of a GI submitted by another Contracting Party and had no detailed provision on withdrawals.[35]

[32] Lisbon Agreement, *supra* note 1, art. 5.

[33] The issue of maintenance fees was the topic of heated debate during the conference. Maintenance fees had been mentioned in square brackets in early versions of the draft Geneva Act but did not make it into the final version. *Compare* Geneva Act, *supra* note 1, arts. 7–8, WIPO Document LI/DC/3 (November 14, 2014) (providing in Article 7 an "Alternate A" and an "Alternate B" for a "maintenance fee," and stating in Article 8 that nonpayment of a maintenance fee will result in the cancellation of a registration).

[34] *See* Geneva Act, *supra* note 1, arts. 15–16; *see also id.* rule 9 (explaining how Contracting Parties are to notify the International Bureau of the refusal); *id.* rule 10 (explaining what the International Bureau does not consider as a valid refusal); *id.* rule 11 (stating the procedure for withdrawal of refusal).

[35] *Compare* Geneva Act, *supra* note 1, rules 9–10 (specifying the required contents of a valid refusal), *with* Lisbon Agreement, *supra* note 1, art. 5 (requiring only that the basis of the refusal be included).

Under the 1958 Lisbon Agreement, a court or other competent authority in the country where protection is claimed could invalidate an appellation.[36] The Geneva Act more or less maintains this system but includes much clearer rules and a specific process.[37]

The topic of fees was a major issue during the Diplomatic Conference. Under the system based upon the 1958 Lisbon Agreement, applicants had to pay a *single fee once* to WIPO and their application would be deemed valid (subject to refusal by individual members) for essentially forever in all Lisbon member states where it was not initially refused or later invalidated.[38] This fee (which was 500 Swiss francs or approximately US $525, but doubled as of January 1, 2016) is paid to, and retained by, WIPO. There is no country designation and no "per-country" fee, unlike, say, the Madrid system for trademarks, the Hague system for designs, or the Patent Cooperation Treaty (PCT).[39] No renewal fee is ever required.[40] This is administratively different from the situation with several other IP rights, and also arguably incompatible with the current practice of common-law jurisdictions that protect GIs as trademarks. Trademarks can be considered abandoned and canceled for nonuse, and a registration, renewal, or maintenance fee is typically payable.[41] Under the Geneva Act, country designation was introduced and per-country fees are now possible for the initial registration and for use of the indication, but not maintenance fees.[42] This is likely to become a major bone

[36] *See* Lisbon Agreement, *supra* note 1, art. 5 (stating that once an appellation is registered with the International Bureau, an authority in any of the countries party to the Agreement may invalidate an appellation in their own country within one year of notice of the registration).

[37] *See* Geneva Act, *supra* note 1, arts. 15–16 (using similar wording as the Lisbon Agreement that an authority may invalidate an appellation registered with the International Bureau); *id.* rules 9–10 (detailing the requirements for a notification of refusing, including the process of how the International Bureau will handle irregular notifications of refusals that do not contain all the required information).

[38] Lisbon Agreement, *supra* note 1, arts. 5, 7.

[39] *Schedule of Fees*, World Intell. Prop. Org., www.wipo.int/export/sites/www/hague/en/fees/pdf/sched.pdf (last visited February 8, 2016) (containing the fee schedule for the Hague System for Designs); *Individual Fees under the Madrid Protocol*, World Intell. Prop. Org., www.wipo.int/madrid/en/madridgazette/remarks/ind_taxes.html (last visited February 8, 2016); *PCT Fee Tables*, World Intell. Prop. Org., www.wipo.int/export/sites/www/pct/en/fees.pdf (last visited February 8, 2016); *Payment of Fees – Lisbon System*, World Intell. Prop. Org., www.wipo.int/about-wipo/en/finance/lisbon.html (last visited February 8, 2016).

[40] The Lisbon Agreement specifically provides for the absence of renewal. Lisbon Agreement, *supra* note 1, art. 7.

[41] In the United States, since 1989, the renewal term has been ten years. *See* McCarthy, *supra* note 7, §§ 19:142, 19–422. Also, under US law, cancelation is possible after three years of nonuse. *See* 15 U.S.C. § 1127 (2012) ("Nonuse for 3 consecutive years shall be prima facie evidence of abandonment").

[42] *See supra* note 33.

of contention within WIPO member states, due to the disagreements over the protection of GIs and the limited membership to the Lisbon Agreement, and the Geneva Act, among WIPO members.

2.4 *Genericness Issues*

The 1958 Lisbon Agreement was fairly flexible in several respects but not on genericide. Genericide is the loss of an appellation when it becomes generic, and is thus unable to function as an indication of geographic origin in a given market.[43] The language of the 1958 Lisbon Agreement prevents invalidation for genericness in the country where protection is claimed, unless the appellation has become generic *in its country of origin*.[44] This is a rare mandatory application of *lex originis* in international intellectual property.[45] A country *joining* the Lisbon system has one year to determine whether it will refuse to protect any previously registered appellations.[46] For appellations registered *after* a country has joined, there is a twelve-month period to make such a decision. After that period has lapsed, however, it becomes much more complicated to refuse protection. An issue might surface in common-law jurisdictions here, especially if the owner of a Lisbon GI does nothing while the GI is used (with his knowledge but without his consent) either by a competitor or generically by several users.

It is a well-established principle of international intellectual property that the law of the country of protection (*lex loci protectionis*) would typically govern issues of genericide. Thus, a court or other competent authority determines the validity of a copyright, trademark, or patent in its own jurisdiction. The Paris Convention for the Protection of Industrial Property (Paris Convention)[47] makes it clear that this does not directly affect the same trademark or a patent on the same invention in other

43 *See*, e.g., Deborah J. Kemp & Lynn M. Forsythe, *Trademarks and Geographical Indications: A Case of California Champagne*, 10 Chap. L. Rev. 257, 266 (2006); *see also* Daniel J. Gervais, *The Lisbon Agreement's Misunderstood Potential*, 1 World Intell. Prop. Org. J. 87, 96–97 (2010) (discussing how a country may refuse a registration if the name is generic in its country).

44 Lisbon Agreement, *supra* note 1, art. 6.

45 *Cf.* Graeme B. Dinwoodie, *Developing a Private International Intellectual Property Law: The Demise of Territoriality?* 51 Wm. & Mary L. Rev. 711, 731 (2009) (arguing that the United States applies *lex originis* in authorship copyright law by giving special weight to "the nationality of the authors and the place of first publication").

46 Lisbon Agreement, *supra* note 1, art. 14.

47 *See* Paris Convention for the Protection of Industrial Property, March 20, 1883, *as revised* July 14, 1967, 21 U.S.T. 1629, 828 U.N.T.S. 305 [hereinafter Paris Convention].

jurisdictions – a principle known as the independence of patents and trademarks.[48] In the case of infringement, the law of the country where protection is claimed (*lex loci delicti*) typically applies.[49] It would be strange indeed if a court could not find a patent or mark invalid unless it had been found invalid in the inventor's or trademark owner's country of origin. Yet that was, and still is, the system under the 1958 Lisbon Agreement.

Implementing this provision functionally requires a *sui generis* system because countries that protect GIs using trademarks assess genericness *in their territory* and not in the mark's country of origin. In previous scholarship, I have suggested that the Lisbon system should eliminate this obstacle to make it possible for countries protecting GIs under trademark systems to join. Unfortunately, the Geneva Act, while it uses language that differs from the 1958 Lisbon Agreement text, essentially maintains a version of the *lex originis* regime, especially in its Article 12, which reads: "Subject to the provisions of this Act, registered appellations of origin and registered geographical indications cannot be considered to have become generic in a Contracting Party."[50]

In sum, as already noted the Geneva Act, like the 1958 Lisbon Agreement, allows a Lisbon member to reject a GI within twelve months of registration if it is generic in their territory.[51] It will also allow its members to maintain coexistence of a GI and a trademark and protect prior trademark rights. However, if the GI gets protection under the Lisbon system and later becomes generic in a Lisbon Agreement member state, for example, because of inaction or even acquiescing by the holder of the GI, then it is far from clear under either the 1958 Lisbon Agreement or the Geneva Act how that Lisbon member could find this GI generic if the GI is not generic in its country of origin.[52] If that is so, then there is at least one irreconcilable difference between the Lisbon Agreement and the common law.

48 Paris Convention, *supra* note 47, arts. 4*bis*, 6 (proclaiming the independence of patents and marks).

49 *See id.* arts. 6*quinquies*(B), 10*ter*(2); Berne Convention for the Protection of Literary and Artistic Works art. 6*bis*, September 9, 1886, 1161 U.N.T.S. 3 (amended Sept. 28, 1979). *see also* Pamela E. Kraver & Robert E. Purcell, *Application of the Lanham Act to Extraterritorial Activities: Trend Toward Universality or Imperialism?* 77 J. Pat. & Trademark Off. Soc'y 115, 121–22 (1995) (discussing choice of law principles, including *lex loci delicti*).

50 Geneva Act, *supra* note 1, arts. 8(1), 12.

51 Lisbon Agreement, *supra* note 1, art. 5(3), (4); Geneva Act, *supra* note 1, art. 15(1).

52 Lisbon Agreement, *supra* note 1, art. 6; Geneva Act, *supra* note 1, art. 12.

2.5 *Conflicts with Prior Trademarks and Generic Terms*

The 1958 Lisbon Agreement allows its members to adopt or continue to use one of three approaches in managing conflicts between trademarks and GIs (however those are protected under national law): (1) a "first in time, first in right" approach; (2) a "coexistence approach" (that is, a GI and trademark with similar legal effect); or (3) a "GI superiority approach," under which the GI wins the conflict, except perhaps where the previous trademark is considered well known.[53]

"First in time, first in right" usually is understood to mean first *in the territory of the jurisdiction concerned*.[54] One could see a degree of irony in the case of GIs because GIs very often have been in use for decades or more before the registration of a trademark that would defeat the use of such GIs in a country other than the country of origin.[55] Yet, as a matter of trademark law, the analysis focuses on the domestic market and is largely a question of the domestic consumer's perception – although this perception may include

[53] Lina Montén, *Geographical Indications of Origin: Should They Be Protected and Why? – An Analysis of the Issue from the US and EU Perspectives*, 22 Santa Clara Computer & High-Tech. L.J. 315, 328–30 (2006). For example, while the EU has a GI superiority approach in most cases, its regulations provide protection for prior, well-known marks. *See* Council Regulation No 510/2006 of March 20, 2006, on the Protection of Geographical Indications and Designations of Origin for Agricultural Products and Foodstuffs, art 3(4), 2006 O.J. (L 93) 12, 14–15 (EC). The European Union's Council Regulations provide that a "designation of origin or geographical indication shall not be registered where, in the light of a trademark'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." In sum, EU law provides that prior well-known trademarks prevail over GIs and allows coexistence of prior trademarks not considered to be well-known. *Id.*

[54] *See* Frederick W. Mostert, Famous and Well-Known Marks: An International Analysis 2–34 (2nd edn. 2004) (arguing that the principle of "first in time, first in right" should be applied to resolve for GI–trademark conflicts); *see also* Dev Gangjee, *Quibbling Siblings: Conflicts Between Trademarks and Geographical Indications*, 82 Chi.-Kent L. Rev. 1253, 1262 (2007) ("Given the similarity of function and therefore presumed epistemological backcloth for both trademarks and GIs, the principle of 'first in time, first in right' has been suggested as a means of resolving such conflicts."). A number of trade agreements have enshrined this principle. *See*, e.g., Free Trade Agreement, Austl.-U.S., art. 17.2(4), May 18, 2004, KAV 6422; *see also* Chase C. Rhee, Principles of International Trade (Import-Export): The First Step Toward Globalization 48 (5th edn. 2012) (regarding the US-Singapore Free Trade Agreement, which applies the principle of "first in time, first in right").

[55] *See Geographical Indication Protection in the United States*, US Patent and Trademark Office, www.uspto.gov/sites/default/files/web/offices/dcom/olia/globalip/pdf/gi_system.pdf (last visited February 8, 2016) ("The United States has provided protection to foreign and domestic GIs since at least 1946, decades prior to the implementation of the TRIPS Agreement (1995) when the term of art 'geographical indication' came into wide use."). I am grateful to Keri Johnston (of MARQUES) for this insight.

knowledge gained through advertising of a famous mark not in use or not yet widely used in the territory concerned.[56] The Geneva Act thus allows, but does not mandate, a country party to it to apply the "first in time, first in right" principle in resolving GI–trademark disputes.[57]

It is worth recalling the four main features that apply to WTO members under the TRIPS Agreement. First, a member of the World Trade Organization (WTO) must refuse or invalidate the registration of a trademark that contains or consists of a geographical indication if (1) the goods do not originate in the territory indicated; and (2) use of the indication in the trademark for such goods in the territory of the "member" concerned is *of such a nature as to mislead* the public as to the true place of origin.[58] Second, for GIs used in connection with wines and spirits, however, deception (misleading the public as to the true place of origin) does not need to be present.[59] Third, Article 24.5 of the TRIPS Agreement then allows a WTO member to protect those who were using or applied for registration of a trademark (or were "grandfathered") in the WTO member concerned either before the TRIPS Agreement became applicable in the WTO member concerned or before the indication in question was protected in its country of origin.[60] Fourth, Article 24.6 of the TRIPS Agreement provides that WTO members may decide not to protect a geographical indication used in connection with foreign goods or services[61] when the relevant indication "is identical with the term customary in common language as the common name for such goods or services in the territory of that Member."[62]

In *EC–Trademarks and Geographical Indications I*, a WTO dispute-settlement panel explained that the coexistence of a protected indication and a trademark can be considered, under certain circumstances a limited exception justifiable under Article 17 of the TRIPS

[56] This situation is reflected in TRIPS Article 16, which provides that in determining whether a trademark is well known for the purposes of applying Article 6*bis* of the Paris Convention (which only applies to identical or similar goods but which TRIPS extends to both dissimilar goods and services), WTO "Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark." TRIPS Agreement, *supra* note 19, art. 16; Paris Convention, *supra* note 47, art. 6*bis*.

[57] Geneva Act, *supra* note 1, art. 13(1).

[58] TRIPS Agreement, *supra* note 19, art. 22.3.

[59] *Id.* art. 23.2.

[60] *Id.* art. 24.5; *see also* World Intellectual Prop. Org. [WIPA], *Possible Solutions for Conflicts between Trademarks and Geographical Indications and for Conflicts between Homonymous Geographical Indications*, 11–12, WIPO Doc. SC/5/3 (June 8, 2000).

[61] TRIPS Agreement, *supra* note 11, art. 24.6.

[62] *Id.*

Agreement.[63] In other words, the coexistence of a protected indication and a nonfamous trademark is a permitted exception to *trademark rights*.[64] In sum, the TRIPS Agreement allows – but does not mandate – continued application of "first in time, first in right" by each WTO member.[65]

The Geneva Act is clearer on this point than the 1958 Lisbon Agreement in that it provides specific conflict rules, which mostly allow for prior trademark rights to be protected, and, like the text of the 1958 Lisbon Agreement, allows GIs to be rejected for genericness in a member country *at the time that country joins the system*. Because the genericide prohibition was maintained in the Geneva Act, it would make it difficult, however, to reconcile the new Act with "first in time, first in right" in the case of a GI that was used but becomes generic as a geographic term in a country, if the owner of the GI then tries to prevent its use, or the use of a similar term, by a third party as a trademark or even otherwise (e.g. a descriptive use). A country joining the Geneva Act may thus limit its option to use to its full extent the exception regime under the TRIPS Agreement as interpreted in the WTO dispute-settlement process.[66]

3 COMMON-LAW GEOGRAPHICAL INDICATIONS

3.1 *Geographical Indications and a Free Market Economy*

Attaching an intangible yet measurable (that is, a higher price due to the intellectual property rent) value to the identification of the geographic origin

63 Panel Report, *European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs: Complaint by the United States*, ¶ 7.688, WT/DS174/R (March 15, 2005); Panel Report, *European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs: Complaint by Australia*, ¶ 7.644–7.686, WT/DS290/R (March 15, 2005).

64 And thus allowed under Article 17 of TRIPS. *See* TRIPS Agreement, *supra* note 19, art. 17 ("Members may provide limited exceptions to the rights conferred by a trademark . . ."). The report of the dispute-settlement panel mentioned in the previous note concluded, "with respect to the coexistence of GIs with prior trademarks, the Regulation is inconsistent with Article 16.1 of the TRIPS Agreement but, on the basis of the evidence presented to the Panel, this is justified by Article 17 of the TRIPS Agreement." *Complaint by Australia*, *supra* note 64, ¶ 7.686; *Complaint by the US*, *supra* note 64,¶ 7.688. In countries that use certification marks and/or the torts of "unfair competition" and "passing off" in this context, such a conflict would be between two trademarks, not between a trademark and "something else," such as a GI.

65 Essentially, under TRIPS Article 24.5, a prior trademark continues to be registrable and its owner may continue to use the mark. This must be interpreted together with Article 16.1.

66 State practice subsequent to the adoption of a treaty is one of the relevant factors in that treaty's interpretation. Vienna Convention on the Law of Treaties art. 31(3)(b). May 23, 1969, 1155 U.N.T.S. 331 (entered into force January 27, 1980).

of a product seems to postulate the existence of a correlative, measurable difference in *actual quality*, that is, an objectively quantifiable difference between products of different origin but similar composition – say, a wine produced from Pinot Noir grapes in Napa Valley, New Zealand, or Bourgogne (Burgundy).[67] One could posit that this measurable difference – assuming that one *can* measure it – lies in natural factors such as soil and climate. This now brings us to the *terroir*. Indeed, a system of protection for denominations of geographic origin emphasizes the cluster of factors traditionally amalgamated under the term *terroir*: tradition, know-how, and a link between product and land.[68] *Terroir* is used as a marketing tool to extract additional rents.

A consumer who does not share the history and culture of the French, Italian, or Spanish *terroir* may not easily identify with the conventions and practices that were used to define the quality of a product (say, a red wine) at its point of origin. That same consumer *can* nonetheless attribute a higher value or quality to a product for a different set of reasons. Even if the higher price resulting from the linkage between a product and its origin is arguably or even demonstrably irrational – say, because no measurable objective quality differentiates the product and its non-GI equivalent – that is not a fatal argument against GI protection: trademarks also sometimes perform an "irrational" yet well-accepted function in guiding consumer behavior.[69] Put differently, and more concretely, using a consumer's belief that *brie* cheese will be not just different but *better* because it was produced in Meaux[70] (France), as opposed to in an unknown location in some industrial plant or even in a known cheese producing location (such as the US state

67 *See* David Bird, Understanding Wine Technology: The Science of Wine Explained 1–16 (2005).

68 *See* Irene Calboli, *Of Markets, Culture and Terroir: The Unique Economic and Culture-Related Benefits of Geographical Indications of Origin*, *in* International Intellectual Property 433, 434 (Daniel J. Gervais ed., 2015) (describing *terroir* as a "deep traditional connection to the land – where the products are grown, processed, or manufactured").

69 *See* McCarthy, *supra* note 7, § 2:38 (discussing the criticism that trademarks create irrational consumer preferences).

70 "Meaux" is the name of a town near Paris, France. Brie de Meaux is a protected indication, but "Brie" is not. BRIE DE MEAUX is Lisbon entry no. 686 and was registered on October 5, 1983. *See (686) Brie de Meaux*, World Intell. Prop. Org., www.wipo.int/ipdl/en/lisbon/key.jsp?KEY=686 (last visited February 9, 2016). Wisconsin also produces "brie" cheese. *See Brie*, Wis. Cheese, www.eatwisconsincheese.com/wisconsin-cheese/article?cid=9 (last visited February 9, 2016) ("Wisconsin has become an important source of Brie for American consumers").

of Wisconsin), is not incompatible with the principles of a "free" market economy.[71]

3.2 Geographical Indications as Marks

Geographical indications, like trademarks, depend on reputation and associated goodwill.[72] To paraphrase Professor Dev Gangjee, they share the same epistemological backcloth.[73] Reputation is an element mentioned in both the Lisbon Agreement and the TRIPS Agreement.[74] "Normal" trademarks, collective marks, and certification marks can be used as symbols of or ways to suggest geographic origin.

A feature of common law–based trademark law is the so-called "first in time, first in right" approach, according to which the first user in a given territory will have senior rights. Using the US system as an exemplar of such an approach, a geographic designation of origin must not clash with a preexisting trademark if it is to be protected under a trademark system.[75] Similarly, a geographic term that is generic in the US cannot acquire trademark status.[76] A term that is merely descriptive can be protected as a mark once it acquires secondary meaning.[77]

In the case of a geographic *certification mark*, there is a *collective goodwill* linked to a region or locality. This notion of collective goodwill emerged in the United Kingdom in the so-called "Drinks" cases.[78] Collective goodwill is goodwill shared by a group of producers. Any producer part of the group may file a claim in civil courts to protect the goodwill – without having to show control over or agreement of the collective.

71 Unless the perception is based on deceptive marketing practices, but that is typically handled under a different area of law.

72 *See* McCarthy, *supra* note 7, § 2:38, at 2–76. 73 *See* Gangjee, *supra* note 54, at 1262.

74 Lisbon Agreement, *supra* note 1, art. 2(2); TRIPS Agreement, *supra* note 19, art. 22.1.

75 *See* McCarthy, *supra* note 7, § 16:1. 76 *See id.* § 14:18.

77 *See id.* § 11:25. The rule is a bit more complicated, but the details are not necessary for our purposes.

78 Bollinger v. Costa Brava Wine Co. Ltd. [1961] RPC 116 (Ch.) (Eng.); Vine Prods. Ltd. v. Mackenzie & Co Ltd. [1969] RPC 1 (Ch.) at 4 (Eng.) (citing Bollinger v. Costa Brava Wine Co. Ltd. [1960] RPC 16 (Ch.) (Eng.)). These cases have a progeny in the UK. John Walker & Sons Ltd. v. Henry Ost & Co Ltd. [1970] RPC 151 (Ch.) (Eng.); HP Bulmer Ltd. v. Bollinger S.A. [1978] RPC 79 (C.A.) (Eng.); Erven Warnink Besloten Vennootschap v. J Townend & Sons (Hull) Ltd. [1979] AC 731 (HL) (Eng.). The same happened in other common-law jurisdictions. Canada: Institut National des Appellations d'Origine des Vins et Eaux-de-Vie v. Andre Wines Ltd. (1990) 30 C.P.R. 3d 279 (Can. Ont. C.A.); Dairy Bureau of Canada v. Annable Foods Ltd. (1993) 46 C.P.R. 3d 289, 309 (Can. B.C. Sup. Ct.); New Zealand: Comite Interprofessionel du Vin de Champagne v. Wineworths Group, Ltd. [1991] 2 NZLR 432 (HC).

US courts have also recognized that goodwill can be shared but they have generally taken a less liberal approach on the right of action by individual users. They have given the holder of a certification mark more control over its use and enforcement. For example, in *State of Idaho Potato Comm'n* v. *G & T Terminal Packaging, Inc.*, the Ninth Circuit found that selling genuine Idaho potatoes using the name IDAHO constituted counterfeiting of the certification mark IDAHO for potatoes because the mark owner had not had the opportunity to exercise quality control.[79] The owner of the mark "acts as the representative of the mark users."[80] Hence, as a matter of trademark law, the owner of a certification mark – not the State – controls the certification standards. Examples of US geographic certification marks include FAMOUS IDAHO POTATOES, FAMOUS POTATOES GROWN IN IDAHO, GROWN IN IDAHO IDAHO POTATOES, and PREMIUM PACKED IDAHO POTATOES for (unsurprisingly) Idaho potatoes; PARMIGIANO-REGGIANO, ROQUEFORT, STILTON, and REAL CALIFORNIA for cheese; PARMA for ham; DARJEELING for tea; WASHINGTON for apples; and THE FLORIDA SUNSHINE TREE for citrus.[81]

Certification marks have also been used in a more typical "Lisbon" context: booze. The three US "Cognac" cases serve as milestones on the road to GI protection via trademark law. The first case dates back to 1944.[82] The case involved applications for the trademarks COLOGNAC and CALOGNAC for brandy. Oppositions to those applications were filed by a "genuine" (French) Cognac maker.[83] The oppositions were not made on the basis of preexisting registrations for other marks (such as COGNAC). Instead they were made under the terms of the statute in force at the time, which allowed certain parties (this would emerge in the case, as we shall see) to oppose the use of

79 State of Idaho Potato Comm'n v. G & T Terminal Packaging, Inc., 425 F.3d 708, 721–22 (9th Cir. 2005).

80 McCarthy, *supra* note 7, §19:92.50, at 19–305.

81 FAMOUS IDAHO POTATOES FAMOUS POTATOES GROWN IN IDAHO, Registration No. 2,403,069; PARMIGIANO-REGGIANO, Registration No. 1,896,683; ROQUEFORT, Registration No. 571,798; STILTON, Registration No. 1,959,589; REAL CALIFORNIA CHEESE, Registration No. 1,285,675; PARMA HAM, Registration No. 2,014,628; DARJEELING, Registration No. 1,632,726; WASHINGTON, Registration No 1,528,514; THE FLORIDA SUNSHINE TREE, Registration No. 932,033. The vast majority of certification marks in the United States are not for geographic origin. This majority includes marks registered by unions and various standardization bodies, such as Underwriters' Laboratories. *See* Jeffrey Belson, Special Report: Certification Marks 26–28 (2002).

82 The date matters because, although the case is silent on that point, sympathy for France may have been a factor at that particular juncture in US history.

83 Otard, Inc. v. Italian Swiss Colony, 141 F.2d 706 (C.C.P.A. 1944).

descriptors as marks if those descriptors would confuse or mislead the consumer. Reversing both the Examiner of Trade-Mark Interferences – who had not recognized the opposer's right to oppose the applications – and the Commissioner of Trademarks, the Court of Customs and Patent Appeals confirmed the opposer's standing and agreed with the opposer.[84] The Court stated the following in a passage that has the unmistakable aroma of an "Old World" GI perspective:

> Cognac is a name applied to a type of brandy distilled from wines made from grapes grown in a limited territorial region of France, often referred to as the Cognac district, the boundaries of which are defined by French law . . . there is a certain quality in the soil of the region which gives to the grapes there grown a particular character or flavor, which enters into the brandy made from them, and that that quality of soil is not found elsewhere in France, nor, it is claimed, in any other part of the world. It is recognized as a superior brandy.[85]

The second case, four decades later, dealt with applications for two similar derivatives of Cognac, namely COLOGNAC and CALOGNAC.[86] The case evidently bears strong resemblance to the previous one, but here the opposer was not an individual producer of Cognac but rather an entity responsible under French law for defending the word Cognac.[87] Between the two cases, Congress had adopted the 1946 Trademark (Lanham) Act, which contained a specific provision for certification marks.[88] Indeed, one of the Board's first steps in this second case was to note that the statute defined certification marks and included marks used to denote a geographic origin.[89] The 1946 statute also contained the now familiar prohibition of the registration of a mark that, "when applied to the goods of the applicant, is primarily geographically descriptive or deceptively misdescriptive of them."[90] The Board's approach was consonant with trademark law principles, putting the focus squarely on consumer deception:

[84] *Id.* at 709–11. [85] *Id.* at 708.
[86] Bureau Nat'l Interprofessionnel du Cognac v. Int'l Better Drinks Corp., 6 U.S.P.Q.2d 1610, 1615 (T.T.A.B. 1988). The application was filed in 1984. *Id.* at 1610.
[87] *Id.* at 1610–11. [88] Trademark Act, 15 U.S.C. §§ 1052(d), (e), 1054 (1946).
[89] *Bureau Nat'l Interprofessionnel du Cognac*, 6 U.S.P.Q.2d at 1614. The terminology was new, but not the notion of a collectively owned mark. Section 62 of the Trade-Marks Act of 1905 referred to standardization marks. Trade Marks Act 1905, 9 Edw. 7 c. 15, § 62 (Eng.). The statute was amended in 1936 and again in 1938 to provide for registration of collective marks owned by foreign associations. *See* S. Rep. No. 1770 (1938). Some of these marks were used to denote a form of certification by the foreign association. *Id.*
[90] Trademark Act, *supra* note 88, § 1052(e)(2).

> [I]f a mark is the name of a place known generally to the public, purchasers who encounter goods bearing the mark would think that the goods originate in that place [i.e., purchasers would make a "goods-place association" . . .], [if] the goods do not come from the named place, and the deception is material to the purchasing decision, the mark is deceptive under Section 2 (a); if the deception is not material to the purchasing decision, the mark is primarily geographically deceptively misdescriptive under Section 2(e)(2) of the Act.[91]

In the third and final case, decided a decade later, the opposer, the French Institut National des Appellations d'Origine, was also a "GI defending entity" responsible for defending several protected wine and spirit appellations of origin in France.[92] The Board applied Section 2(d) of the Lanham Act, which deals with the likelihood of confusion with a preexisting mark, and decided that the test was the same as for other marks:

> There is nothing in the language of Section 2(d) which mandates or warrants application of one level of likelihood of confusion analysis . . . in cases where the plaintiff's mark is a trademark or service mark, but a different and more limited likelihood of confusion analysis in cases where the plaintiff's mark is a certification mark.[93]

In other words, a showing of deception was unnecessary. Certification marks should be treated for purposes of an infringement analysis in the same way as ordinary trademarks. While the opinion parallels the previous case, it is worth noting that the Board also recognized protection of the COGNAC mark under *labeling regulations*.[94]

Overall, the picture that emerges from the Cognac cases and others shows a willingness to recognize collective goodwill in the form of (common-law) certification marks.[95] The application of trademark law by US courts and other authorities suggests that common law can protect symbols of geographic origin

[91] *Bureau Nat'l Interprofessionnel du Cognac*, 6 U.S.P.Q.2d at 1615.

[92] Institut Nat'l des Appellations d'Origine v. Brown-Forman Corp., 47 U.S.P.Q.2d 1875, 1877 (T.T.A.B. 1998). Apparently, the applicant's concoction actually contained some French brandy. *Id.* at 1880.

[93] *Id.* at 1890.

[94] *Id.* at 1878, 1885–96. The regulation is 27 C.F.R. § 5.22(d)(2) (2014) (recognizing French governmental authority to designate and regulate Cognac grape brandy distilled in the Cognac region of France).

[95] This actually started with Pillsbury-Washburn Flour Mills Co v. Eagle, 86 F. 608 (7th Cir. 1898). For a fuller discussion of this topic (from which this part of the Article is derived), *see* Daniel Gervais, A *Cognac after Spanish Champagne? Geographical Indications as Certification Marks*, in INTELLECTUAL PROPERTY AT THE EDGE 130, 135–36 (Rochelle Cooper Dreyfuss & Jane C. Ginsburg eds., 2014).

used in trade beyond the US *sui generis* mechanism used for alcohol labels. Unfortunately, for the future of the Lisbon system, using trademark law to protect GIs implies the ability to remove a mark not used by its owner from the register. More generally, trademark law in common law jurisdictions implies (1) a requirement of use to register, (2) the payment of renewal or maintenance fees, and (3) a level of protection tied to the existence of a likelihood of confusion except for famous or well-known marks.[96] None of these are allowed, at least explicitly, under the Geneva Act even though they were raised on several occasions by delegations at the Diplomatic Conference. The Geneva Act does allow member countries to impose examination and use fees, however, as well as declarations of intention to use a GI.[97]

3.3 *The Future of the Lisbon System*

As of the date of the Diplomatic Conference that adopted the Geneva Act of the Lisbon Agreement in May 2015, the so-called Special Union (of Lisbon members) had twenty-eight member states.[98] Many of the members will likely join the Geneva Act, which is also open to intergovernmental organizations such as the European Union and Organisation Africaine de la Propriété Intellectuelle (OAPI).[99] Even if several OAPI members join Lisbon, how much they will use it (that is, how many GIs they will actually register) is unclear. Indeed, some OAPI members are already members of the "old" Agreement and have not used it much.[100] North African countries such as

96 On the protection of well-known marks, the TRIPS Agreement requires WTO members to take account "of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark." TRIPS Agreement, *supra* note 19, art. 16.2.

97 Geneva Act, *supra* note 1 art. 7(4); WIPO Document LI/DC/19, *supra* note 1, rule 5(4)(b).

98 *See supra* notes 1, 16; *see also* World Intellectual Prop. Org. [WIPO], *Contracting Parties or Signatories of Treaties Administered by WIPO: Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration*, www.wipo.int/export/sites/www/treaties/en/documents/pdf/lisbon.pdf (last visited November 20, 2015). The term "Special Union" (that is, the group of parties to the Lisbon Agreement) is used in the Lisbon Agreement (1958), *supra* note 1, art. 1, and in the Geneva Act, *supra* note 1, art. 21.

99 Geneva Act, *supra* note 1, art. 22(2). The OAPI has seventeen members, most of which are French-speaking sub-Saharan African countries. *États Membres*, Organisation Africaine de la Propriété Intellectuelle, www.oapi.int/index.php/en/aipo/etats-membres (last visited February 9, 2016).

100 The following countries are members of both agreements: Burkina Faso, Congo, Gabon, and Togo. *See Contracting Parties or Signatories of Treaties Administered by WIPO – Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration*, *supra* note 98; *Etats Members*, *supra* note 99.

Morocco and Tunisia, together with Algeria, which is already party to the "old" (1958/1967) Act, may also join the Geneva Act membership. A few Latin American countries might do so as well, adding to the existing five members of the old Agreement (Costa Rica, Cuba, Mexico, Nicaragua, and Peru).[101] More importantly, European membership will likely broaden to include most or all EU members (including Germany, who is not currently a Lisbon member) and possibly Moldova and Russia, among others. This means a potential of approximately fifty to fifty-five member states. If the European Union were to join backed by all its member states, it would potentially have a majority vote in the Special Union (which it could exercise as a single vote on behalf of all twenty-eight EU members).[102]

The denouement of the Geneva Act story may be complicated, however. Despite the strength of the opposition manifested at the closing plenary by a number of common-law jurisdictions, the art of trade negotiations is such that anything is possible. Smaller common-law jurisdictions might find it harder to resist EU trade pressure to join Lisbon. Some of the nations that negotiated the moribund TPP recently introduced *sui generis* GI legislation that may make it easier for them to agree to join Lisbon, for example, as part of a trade deal with the European Union.[103] The list of bilateral EU trade agreements with a GI focus might soon include India.

Then, multinational companies, including those based in the common law world, that use terms they consider generic or descriptive on their products may find Lisbon members in the path of their trade transactions with other nations, including members of the Association of Southeast Asian Nations (ASEAN), where the cost of protecting foreign GIs (and implementation of the Geneva Act) could be low, and may bring substantial beneficiaries in trade dealings with the European Union.[104] Even so, a question that remains is what

[101] Haiti is also a member. *See Contracting Parties or Signatories of Treaties Administered by WIPO – Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration*, *supra* note 98.

[102] *See* Lisbon Agreement, *supra* note 1 art. 22(b)(4)(ii) (allowing any Contracting Party that is an intergovernmental organization to vote in place of its members).

[103] *See, e.g.*, Geographical Indications of Goods (Registration and Protection) Act, 1999, No. 48 Acts of Parliament, 1999 (India); Geographical Indications Act, 2000 (Act 602) (Malay.); Geographical Indicators Regulation, 2007, Gov. Reg. No. 51 (2007) (Indon.).

[104] According to an April 2015 press release announcing the restart of EU-ASEAN trade talks, "[t]he EU is ASEAN's second-largest trading partner with total trade amounting to $248 billion in 2014 and was Southeast Asia's largest source of foreign direct investment in 2014 with $29.1 billion, or 21.3% of foreign inflows to the region." *See EU and ASEAN to Jumpstart Trade Agreement Talks* EURACTIVE (April 27, 2015), www.euractiv.com/sections/trade-society/eu-and-asean-kick-start-free-trade-agreement-talks-314100 (last visited February 9, 2016).

the European Union will be prepared to concede to get ASEAN countries to adhere to the Geneva Act.

More importantly, normative countermeasures, such as definitions of prior rights or genericness standards incompatible with the Lisbon standard, may emerge. The TPP text was not easy to reconcile with Article 12 of the Geneva Act (providing for genericide only in the country of origin of the GI): it provides that a GI may become generic in each country that protects it, leading to its potential invalidation in such country.[105] The apparent TPP failure probably pushes this back to diplomatic *oubliettes*. More generally, adequate heed should be paid to the renewed emphasis on the role of certification marks to protect GIs which has surfaced in various fora.

4 CONCLUSION

The adoption of the Geneva Act of the Lisbon Agreement was a clear chance to update the Lisbon Agreement to reconcile the Lisbon system on two fronts: doctrinally, with the common law; and administratively, by allowing countries that protect GIs under trademark law (often as certification marks) to continue to do so as Lisbon members. That did not happen, however, at least not clearly. The absence of consensus – indeed, the deep divide – at the Diplomatic Conference and the stated[106] incompatibility of the Geneva Act with trademark-based GI systems are unlikely to prove productive in the short- to medium term for GI holders, authorized users

105 The TPP text available as of November 2015 is not easy to reconcile with Article 12 of the Geneva Act on genericide only in the country of origin of the GI, in that it provides that a GI may become generic in each country that protects it, leading to its potential invalidation in such country. Article 18.32.(3) provides "No Party shall preclude the possibility that the protection or recognition of a geographical indication may be cancelled, or otherwise cease, on the basis that the protected or recognised term has ceased meeting the conditions upon which the protection or recognition was originally granted in that Party." Trans-Pacific Partnership, *supra* note 3, 18.32(3).

106 Reference is made here to statements, notably by Australia, Japan, Korea, and the United States, during the closing plenary of the Diplomatic Conference that adopted the Geneva Act (May 20, 2015). The author attended the event and this is from personal knowledge as the Records of the conference had not yet been published as of this writing. However, archived webcasts of all official meetings are available. *Diplomatic Conference for the Adoption of a New Act of the Lisbon Agreement*, World Intell. Prop. Org., www.wipo.int/webcasting/en/index.jsp (last visited November 20, 2015) (select "LI/DC: Diplomatic Conference for the Adoption of a New Act of the Lisbon Agreement for the Protection of Appellations Of" in the Videos on Demand Search Bar, scroll to and select "LI/DC – Tues 19 – English Afternoon Main Committee I"; the US delegation makes its proposal between 1:29:50 and 1:33:10).

of GIs, users of generic denominations, or consumers. The bridge between the Lisbon system and the common law has not been built by the Geneva Act. Some useful foundations were laid, but much remains to be done. The bridge, if it is ever built, will not be the result of a normative encounter. It will be made of trade bricks.