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THE GLOBAL STRUGGLE BETWEEN EUROPE AND UNITED STATES OVER GEOGRAPHICAL INDICATIONS IN ASIA. THE KOREAN COMPROMISE.

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Alla mia famiglia

"En este mundo traidor
no hay ni verdad ni mentira.
Todo es segundo el color
del cristal con que se mira".

"In questo mondo traditore
non c'è verità né menzogna.
Tutto dipende dal colore del vetro
attraverso cui si guarda".

Duque de Rivas

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ABSTRACT

Si dicono "Geografiche" quelle indicazioni che identificano un prodotto come originario del territorio di un paese, una regione o una località, quando una determinata qualità, la notorietà o altre caratteristiche del prodotto siano essenzialmente attribuibili alla sua origine geografica. Trattasi di un diritto di proprietà intellettuale annoverato come tale da vari accordi internazionali e caratterizzato, a differenza di tutti gli altri, da una intrinseca natura collettiva, da un imprescindibile legame con una determinata area geografica e da una innata componente culturale che comprende tutto quel patrimonio di tradizioni sviluppate nel tempo per produrre quello specifico prodotto.

Tuttavia, la natura e il tipo di protezione da accordare alle Indicazioni Geografiche (IG) sono tutt'altro che pacifici a livello internazionale ed hanno dato luogo ad uno dei più accesi dibattiti tra i Paesi Membri dell'Organizzazione Mondiale del Commercio fin dalla sua costituzione. Lo stesso inserimento delle Indicazioni Geografiche nell'accordo TRIPs come specifico diritto di proprietà intellettuale accanto ai brevetti, ai marchi e al diritto d'autore, è stato l'esito di un compromesso tra l'Unione Europea, che spingeva per il loro riconoscimento e per una forte protezione internazionale, e gli Stati Uniti, che invece fermamente si opponevano a tali richieste. Il risultato è stato un accordo multilaterale che ha lasciato molte questioni irrisolte ed ha legittimato una certa flessibilità nella scelta del sistema di protezione ritenuto più adatto, consentendo così a che le IG venissero protette mediante meccanismi molto diversi da Paese a Paese.

Alla base di tale scontro tra il "vecchio" e il "nuovo" continente si evidenziano origini storiche diverse e interessi economici contrapposti. L'Unione Europea enfatizza la nozione di *terroir* e protegge le IG come diritto di proprietà intellettuale a sé stante, mentre gli Stati Uniti, riflettendo una concezione economica utilitaristica basata sulla proprietà esclusiva e individuale, vedono le IG come una sotto-categoria dei marchi.

In assenza di uno standard internazionale univoco e pienamente satisfattivo degli interessi delle parti e in considerazione del blocco del negoziato di Doha sui temi dell'agricoltura, gli Stati Uniti e l'Unione Europea hanno fatto ricorso a soluzioni di carattere bilaterale per imporre il rispettivo sistema di protezione delle IG in Paesi terzi, specialmente in Asia. Il *leitmotiv* della politica estera europea è quello di innalzare il livello di protezione oltre gli standard TRIPs, mentre gli Stati Uniti si muovono per impedire che ciò avvenga. La prima parte dell'indagine di questo elaborato è proprio volta a far luce sul tipo e sull'intensità della protezione di cui le IG beneficiano nei più recenti accordi di libero scambio che l'Unione Europea e gli Stati Uniti hanno concluso con la Corea del Sud e con altri Paesi del Sud-Est Asiatico.

In questo clima di scontro, problemi ulteriori sorgono quando la parte contraente degli accordi stipulati rispettivamente dagli Stati Uniti e dall'Unione Europea è la stessa. Quando ciò accade, come nel caso della Corea del Sud e del Vietnam, una domanda sorge spontanea: in che modo il Paese terzo riesce a rispettare ed implementare contemporaneamente le disposizioni conflittuali in tema di IG contenute nei suddetti accordi? Con l'intenzione di trovare una risposta a tale quesito, la parte finale dell'elaborato esamina il sistema di protezione delle IG adottato in Corea, unico Paese che ad oggi ha già attuato entrambi gli accordi, per capire se e come la Repubblica Coreana sia riuscita a far fronte a tali contrasti nella sua legislazione nazionale. Lo studio della normativa Coreana vuole essere illustrativo delle difficoltà poste dall'avere in vigore due accordi bilaterali che regolamentano in modo diverso un medesimo diritto di proprietà intellettuale. Tali accordi infatti, come verrà dimostrato, rischiano di minare la coerenza del diritto interno del Paese terzo.

INTRODUCTION

Do consumers need to know that the feta they are purchasing is really from Greece or that the basmati they are tasting effectively originates in India? As this paper will show, this question is at the core of one of the fiercest ongoing debates in the World Trade Organisation. It concerns the nature and the scope of the protection of Geographical Indications.

Geographical Indications are a particular form of intellectual property right characterised by an intrinsic connection with a specific place, are collective in nature and have an inherent cultural component which includes traditional knowledge, skills, processes and ingredients used to produce a product. This connection between trade and culture makes GIs different from all the other traditional IPRs and makes this debate distinct from the typical debate concerning IPRs.

Chapter I begins by briefly exploring the concept of Geographical Indications, its role in the global market and the importance of its international protection. The TRIPs Agreement establishes GIs as a category of IPRs alongside patents, copyrights and trademarks. The inclusion of GIs within TRIPs was a key demand of the EU and was resisted by the US. The way in which GIs were included within TRIPs was the result of a compromise between the EU and the US and, as such, the Agreement neither specified the preferred legal means for the protection of GIs nor even identified the possible options, leaving Member States considerable room to choose. As a result TRIPs failed to implement a globally accepted substantive law with respect to the protection of GIs, *de facto* allowing inconsistent and even discriminatory treatment between WTO Members.

Different historical backgrounds and divergent economic interests between the "old world" and the "new world" stand out as the main causes of the different positions. The "old world" - Europe and its supporters - emphasises the notion of *terroir* and pushes for protecting GIs as an independent and unique form of IPR. The "new world" - i.e. the US and its supporters - on the other hand consider GIs as a

sub-set of trademarks emphasising an utilitarian economy theory based on individual, exclusive ownership. It is the anthesis of collectivity and *terroir*.

Chapter II aims at mapping the legal options available for the protection of GIs by studying the different GI protection systems adopted in the EU and in the US. The EU *sui generis* regime gives GIs a TRIPs-plus level of protection, whereas the US trademark regime downgrades GIs to a sub-set of TMs. The divergence is such that the best the parties could achieve during the various post-Uruguay Round discussions was to agree to disagree.

In the absence of a generally accepted and satisfactory standard, the EU and the US moved from the stalemate of the multilateral talks - i.e. the WTO - to the new field of the plurilateral and bilateral trade agreements as a means to try and impose their concept of GIs across the world and, in particular, in Asia. The EU is aggressively pushing for enhancing the level of GI protection to TRIPs plus, whereas the US is trying to prevent this from happening. Chapter III aims at shedding some light on the protection GIs enjoy under the most recent FTAs the EU and the US have concluded in the Asia-Pacific Region (Singapore, Vietnam) and in South Korea with particular attention paid to the level of protection granted to GIs and to the relationship between GIs and TMs.

In this puzzling context, additional problems arise when the US and the EU conclude trade deals with the same third country. When this happens - e.g. in the case of Korea - the question is whether and how the third country can successfully respect and apply the conflicting GI provisions contained in both the US and the EU FTAs. Chapter IV explores the Korean GI system so as to examine how Korea has effectively dealt with the different approaches 'imposed' on it with regard to GIs under the EU-Korea FTA on the one side, and the US-Korea FTA on the other side. The case study of Korea is designed to be an illustrative example of the difficulties created by these recently concluded free trade agreements to the domestic law of the third country. Countries that, as a matter of fact, still occupy weak bargaining positions *vis-à-vis* their more powerful trading partners - i.e. the US and the EU.

CHAPTER I

HISTORICAL BACKGROUND AND LEGAL FRAMEWORK

CONTENTS: 1. The concept of Geographical Indications. - 2. The importance of GIs in the global market. - 3. Protection of GIs in International Law. - 3.1 The importance of GIs' protection. - 3.2 WIPO treaties and the traditional WIPO terminology. - 3.3 The Paris Convention for the Protection of Industrial Property. - 3.4 The Madrid Agreement for the Repression of False and Deceptive Indications of Source on Goods. - 3.5 The Lisbon Agreement for the Protection of Appellation of Origin and their International Registration. - 3.6 The TRIPs Agreement. - 4. Different forms of GI protection. - 5. The key differences between Trademarks and GIs.

1. The concept of Geographical Indications

In order to fully understand the term "Geographical Indications" it is necessary to identify its core: the concept of *terroir*[1]. The French world *terroir*[2], as defined by François Casabianca[3], refers to: "a limited geographical area where a human community has constructed over the course of history collective production knowledge based on a system of interaction between a physical and biological environment and a set of human factors where the socio-technical itineraries involved reveal originality, confer typicality and endanger a reputation for a product originating in the *terroir*"[4]. Therefore *terroir* identifies a place whose natural factors, such as soil and climate, together with human factors, such as the current and

[1] D. GANGJEE, *Relocating the law of Geographical Indications,* University Press, Cambridge, 2012.

[2] An expression born in the context of the French wine industry.

[3] Member of the French National Institute for Agricultural Research.

[4] F. CASABIANCA - B. SYLVANDER - Y. NOEL - C. BÉRANGER - J.B. COULON - F.RONCIN, *Terroir et typicité: deux concepts clés des Appellations d'Origine Controlée, essai de definitions scientifiques et opéeationnelles,* Communication at the International Simposium "Territoires et enjeux du développement régional", Lyon, 9-11 March 2005. See also E. BARHAM – B. SYLVANDER, *Labels of Origin for Food: Local Development, Global Recognition*, Cabi, Wallingford, 2011, p. 96.

historical geographic distribution of the human know-how or *savoir faire*, impart distinctive qualities to products[5].

Considering this basic concept it is undeniable that a Geographical Indication (hereafter referred to as GI) is an indication (most commonly a place name) that signals a link not only between a product and its specific place of origin but also with its unique production methods and its outstanding qualities developed precisely thanks to that characteristic geographical environment[6] or, better said, *terroir*. For this reason GIs are commonly considered a unique expression of local rural and cultural traditions and they have come to be valued and protected in many countries throughout the world[7]. Some famous examples range from Champagne, Scotch whisky, Port wine to Feta cheese, Darjeeling tea and Basmati rice.

In light of this it is possible to see in the concept of geographical indications an ancient form of intellectual asset. In fact GIs have traditionally been recognised as independent intellectual property rights: Article 1 paragraph 2 of the Paris Convention for the Protection of Industrial Property of 1883[8] refers to "indication of source" and "appellation of origin" as objects of industrial property and paragraph 3 of the same Article specifies that the term "industrial property" is not limited to "industry and commerce", but applies also to "agricultural and extractive industries and to all manufactured or natural products".

Nevertheless the protection of GIs is not without controversy. As some distinguished authors mentioned: "geographical indications stand at the intersection

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[5] E. BARHAM, *Translating Terroir: the global challange of french AOC labeling*, in *Journal of Rural Studies*, Vol. 19, 2003, pp. 127-138, Pergamon, available at: http://www.uky.edu/~tmute2/geography_methods/readingPDFs/barnam_terroir.pdf (last viewed on September 6, 2015).

[6] GERMANÒ A., *Le indicazioni in etichetta (e la loro natura) e i segni degli alimenti,* in *Rivista di diritto agrario*, Anno XCI - Fasc. 2, Aprile-Giugno 2012, p. 239. In this regard see also the definition of *milieu géographique*, in D. SARTI, *Le indicazioni d'origine geografica:storia, questioni terminologiche e proposte interpretative*, in *Studi in memoria di Paola A.E. Frassi*, Milano, 2010, p. 619.

[7] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin,* Geneva, International Trade Centre, 2009, p. 5, available at: http://www.intracen.org/Guide-to-Geographical-Indications-Linking-Products-and-their-Origins/ (last viewed September 6, 2015).

[8] Paris Convention for the Protection of Industrial Property, adopted in 1883, as amended on September 28, 1979.

of three increasingly central and hotly debated issues in international law: trade, intellectual property rights and agricultural policy"[9].

In fact, the nature, the scope and the level of the protection of GIs varies significantly from country to country and the lack of harmonisation has its roots in profound differences among states in terms of their history and culture[10]. Because of this diverse approach, there is no fully accepted terminology in this area[11]. Several categories of signs, such as indication of source (IS), appellation of origin (AO), protected designation of origin (PDO) and protected geographical indication (PGI) are conventionally understood to fit within the broad heading of GIs as a category of IPR and as a common denominator capable of embracing all the above concepts[12]. In this hodgepodge of terms the difficulty in finding a universally accepted definition of GIs can be fully understood[13].

The first international treaty that properly mentions and defines the term "geographical indications" is the WTO[14] TRIPs Agreement[15] concluded as part of the Uruguay Round trade negotiation in 1994. However, this treaty, in its struggle to find a generally accepted definition among countries that do not share common views[16], instead of giving to GI a broad and comprehensive framing, confers to that term a more specific meaning[17], incapable to include all the categories of signs mentioned

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[9] K. RAUSTIALA - S.R. MUNZER, *The Global Struggle over Geographic Indications,* in *The European Journal of International Law*, Vol. 18, Issue 2, 2007, p. 338.

[10] E. BARHAM – B. SYLVANDER, *Labels of Origin for Food: Local Development, Global* Recognition, Wallingford, UK, CABI, 2011, p. 1.

[11] D. GANGJEE, *Relocating the law of Geographical Indications*, *op. cit.*, p. 2.

[12] D. GANGJEE, *Relocating the law of Geographical Indications*, *op. cit.*, p. 3.

[13] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin,*, *op. cit*., p. 1.

[14] The World Trade Organisation was established at Marrakesh in April 1994.

[15] Agreement on Trade Related Aspects of Intellectual Property Rights (also known as TRIPs Agreement), adopted in 1994.

[16] S. GOLDBERG, *Who will raise the white flag? The Battle between the United States and the European Union over the protection of Geographical Indications,* U.Pa. J. Int'l Econ. L., 2001, p. 109-110. See also D. GANGJEE, *Relocating the law of Geographical Indications*, *op. cit.*, p. 1. See also C. FIELD, *Negotiating for the United States*, pp. 147-148, available at: https://www.wto.org/english/res_e/booksp_e/trips_agree_e/chapter_8_e.pdf. For a general overview of the US and the EU conflicting agendas over the agricultural sector during the Uruguay Round see G. PERONI, *Il commercio internazionale dei prodotti agricoli nell'accordo WTO e nella giurisprudenza del Dispute Settlement Body,* Giuffrè Editore, Milano, 2005, pp. 97 ss..

[17] B. O'CONNOR *The law of geographical indications,* Cameron May, London, 2004 p. 23.

above, such as, Indication of Source, Appellation of Origin and Protected Designation of Origin. Nevertheless the TRIPs Agreement remains the only international treaty that provides for an official definition of GIs. Article 22 paragraph 1 contains the following description: "geographical indications are, for the purpose of this agreement, 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"[18]. As a consequence, since the adoption of the TRIPs Agreement, the term "Geographical Indication" in the international context is to be understood according to the definition of the Agreement and no longer as comprising both indications of source and appellation of origin[19].

That said, however, in this paper, the term will be used mostly in its general sense, as including IS and AO, unless differently specified[20].

2. The importance of GIs in the global market

Since the role of GIs is to confirm a link between a product and a specific geographic area together with unique production methods, characteristics or qualities that are known to exist in that area, they are perceived to offer a wide range of benefits both to producers and to consumers[21].

Starting from the producer's perspective, it is important to remember that GIs are intellectual property rights, meaning that the efforts of a community of producers to build a reputation related to a product is understood to have a commercial value

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[18] TRIPs Agreement, Article 22 paragraph 1.

[19] WIPO, Symposium on the international protection of Geographical Indications in the worldwide context, held in Eger, Hungary, on October 24-25, 1997, organised by the World Intellectual Property Organisation in cooperation with the Hungarian Patent Office, WIPO Publication No. 760(E), 1999, p. 13.

[20] See below paragraph 3.2.

[21] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin*, *op. cit.*, p. 7. See also T. JOSLING, *The war on Terroir: Geographical Indications as a Transatlantic Trade Conflict,* paper presented at the Presidential Address to the AES Annual Meeting in Paris, March 30, 2006.

that should be protected against usurpation[22]. Said that, "the specific objective of protecting GIs is securing a fair return for farmers and producers for the qualities and characteristics of a given product or of its mode of production"[23]. In this context producers consider GIs as an incentive for the maintenance and the creation of a high quality specialised market and as an opportunity to obtain a premium price for their special products[24]. This is possible because GIs convey the unique characteristics that distinguish their products, characteristics that come from the *terroir* whose natural factors and traditional production methods may be impossible to duplicate in other regions. For this reason GIs can turn out to be an important competitive advantage[25], and, at the same time, a tool for the protection of local tradition, cultural heritage and traditional industries[26].

From the consumer's perspective, on the other hand, GIs offer detailed information and precise guarantees on product qualities, characteristics and production methods linked to geographical origin, "thereby enabling consumers to make more informed purchasing choices"[27]. This implies that GIs can actually play a leading role in reducing the asymmetry of information between producer and consumer and therefore they can improve market transparency providing a public benefit[28].

Additionally, GIs strategically support rural development, meaning that they are often assumed as the organising principle for further local or regional agricultural

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[22] E. BARHAM – B. SYLVANDER, *Labels of Origin for Food: Local Development, Global Recognition*, *op. cit.*.

[23] Regulation (EU) No 1152/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs, 2012 O.J. L 343/1, Recital (18).

[24] K. STAROSTINA, *Protected Geographical Indications: scope of protection vis-à-vis comparable products and criteria for defining comparable products*, Prof. A.K.Sanders – G. Schneider (supervised by), Maastricht University, 2013.

[25] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin*, *op. cit.*, p. 25.

[26] C. H. FARLEY, *Conflicts between U.S. law and international treaties concerning Geographical Indications* in *Whittier L. Rev.,* Vol. 22, No.73, 2000. See also F. ADDOR - A. GRAZIOLI, *Geographical Indications beyond wines and spirits. A roadmap for a better Protection for Geographical Indications in the WTO TRIPs Agreement*, in *Journal of World Intellectual Property*, 2002, pp. 865 ss., p. 874.

[27] Regulation (EU) No 1152/2012, Recital (18).

[28] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin, op. cit.*, p. 8. See also T. JOSLING, *The war on Terroir: Geographical Indications as a Transatlantic Trade Conflict*, *op. cit.*, p. 3.

initiatives[29]. In fact, the entitlement to use a GI lies with regional producers, and therefore the added value generated by the GI fall naturally to all such producers bringing value to the region as a whole. Finally, thanks to the premium price they generate, GIs can actively contribute to local employment creation[30].

Anyhow a word of caution is needed, as a distinguished scholar has noted[31], the benefits of GIs can only be seen when the linkage between *terroir* and GI-denominated products is very strong, whenever this linkage is loosen, GI protection no longer promotes local development neither offer accurate information to consumers about the products.

3. Protection of GIs in International Law

3.1 The importance of GIs' protection

GIs reflect a reputation linked to a specific geographical area. This reputation can be considered as a collective asset, and if not adequately protected, it might be used without restriction and even misrepresented by dishonest commercial operators[32] and its value would be lost[33]. The use of GIs by unauthorised parties[34] is detrimental both to consumers and to legitimate producers. In fact, on the one hand, such use deceives consumers leading them to believe that they are buying a genuine product with specific qualities and characteristics whereas they get an imitation product which is something other than the product they sought to purchase. On the

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[29] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin, op. cit.*, p. 8.

[30] WIPO, *Geographical Indications: An Introduction*, WIPO Publication No. 952(E), 2004, p. 17, available at: http://www.wipo.int/portal/en/ (last viewed on September 9, 2015).

[31] I. CALBOLI, *Geographical Indications of Origin at the Crossroads of Local Development, Consumer Protection, and Marketing Strategies*, in *ICC - International Review of Intellectual Property*, 46:760-780, 2015, p. 762, Max Planck Institute for Innovation and Competition, October 12, 2015.

[32] L.P. LUKOSE, *Rationale and Prospects of the Protection of Geographical Indication: An Inquiry,* in *Journal of Intellectual Property Rights,* Vol. 12*,* March 2007, pp. 212-223.

[33] WIPO, *Geographical Indications: An Introduction, op. cit.*, p. 23.

[34] For example the use of the term "Darjeeling" for tea which was not grown in the Darjeeling's region, see WIPO, *What is a Geographical Indication?*, WIPO Publication No. L450GI/E, available at: http://www.wipo.int/edocs/pubdocs/en/geographical/450/wipo_pub_l450gi.pdf (last viewed on September 9, 2015).

other hand, producers suffer damage because the established reputation of their products is affected and thereby their valuable business is in jeopardy[35].

A system of protection is exactly what enables the legitimate users of the indication to prevent such violations, allowing them to take actions against others who use it without permission in connection with lower-quality products and benefit from its reputation free of charge (so called "free-riders")[36]. A GI protection system is also important to lower the risk of GI "genericization"[37]. A GI becomes a generic term and therefore a term freely usable by anybody, when, in the mind of consumers, it has lost its function of identifying a link between a product and its geographic origin and it is used as a common name to designate a particular class of goods. It is clear, indeed, that by the common widespread use of a GI in the market, its exclusive rights are diminished or even lost[38], if the GI is not registered and consistently defended. Therefore, for a GI to be successful, the enforcement of an effective legal protection is a need.

However, having in place a national legal system for the protection of GIs is not itself enough to guarantee the success of this IPR. As one author has affirmed: "national protection had weaknesses as products were often imitated outside the country of origin"[39]. From this remark it clearly appears that international cooperation is required to ensure GIs' protection not only at home but also abroad where the most of the infringements take place[40]. For this reason, since 1883, GIs

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[35] L.P. LUKOSE, *Rationale and Prospects of the Protection of Geographical Indication: An Inquiry,* in *Journal of Intellectual Property Rights, Vol. 12,* March 2007, pp 212-223. See also WIPO, *Geographical Indications: An Introduction,* op. cit., p. 23.

[36] WIPO, *Geographical Indications: An Introduction*, *op. cit.*, p. 23.

[37] WIPO, *Geographical Indications: An Introduction*, *op. cit*., p. 23.

[38] L.P. LUKOSE, *Rationale and Prospects of the Protection of Geographical Indication: An Inquiry*, *op. cit.*, p. 214.

[39] B. O'CONNOR, *The law of geographical indications*, *op. cit.*, p. 27.

[40] B. O'CONNOR, *The law of geographical indications*, *op. cit.*, p. 27. See also F. ADDOR - A. GRAZIOLI, *Geographical Indications beyond wines and spirits. A roadmap for a better Protection for Geographical Indications in the WTO TRIPs Agreement*, in *Journal of World Intellectual Property*, 2002, pp. 865 ss., p. 875.

have been the object of several international treaties, all administered by the World Intellectual Property Organization (WIPO)[41].

3.2 WIPO treaties and the traditional WIPO terminology

Three treaties administered by WIPO provide for the protection of indications of geographical origin before the adoption of the TRIPs Agreement: the Paris Convention for the Protection of Industrial Property (1883), the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods (1891) and the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (1958). Those treaties do not use the term "geographical indication" which has only been introduced in 1994 with the TRIPs Agreement. Instead, they use the term "indication of source" and the term "appellation of origin".

Therefore, before going into a detailed description of these international treaties it is important to briefly clarify the terminology used therein.

The term "indication of source" is used both in the Paris Convention[42] and in the Madrid Agreement but no definition of the term is provided in those treaties. Nevertheless, it is possible to infer from Article 1 paragraph 1 of the Madrid Agreement[43] that an indication of source is an "indication referring to a country or to a place situated therein as being the country or place of origin of a product"[44]. Thus an indication of source is a sign that provides information about the geographical

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[41] The origin of WIPO dates back to 1883 and 1886 when the Paris Convention for the Protection of Industrial Property and the Berne Convention for the Protection of Literary and Artistic Works provided for the establishment of an "International Bureau". The two bureaus were united in 1893 to form the United International Bureaux for the Protection of Intellectual Property - best known by its French acronym BIRPI - and, in 1970, were replaced by the World Intellectual Property Organization, by virtue of the WIPO Convention. For the detailed history see http://www.wipo.int/about-wipo/en/history.html.

[42] Paris Convention, Article 1 paragraph 2 and Article 10.

[43] Article 1 paragraph 1 of the Madrid Agreement reads as follow: "all goods bearing a false or deceptive indication by which one of the countries to which this Agreement applies, or a place situated therein, is directly or indirectly indicated as being the country or place of origin shall be seized on importation into any of the said country". Text available at: http://www.wipo.int/wipolex/en/details.jsp?id=12602.

[44] L. BAEUMER, *Protection of Geographical Indication under WIPO treaties and questions concerning the relationship between those treaties and the TRIPs Agreement*, paper presented at the Symposium on the Protection of Geographical Indications in the Worldwide Context, held in Eger, Hungary, on October 24-25, 1997, WIPO Publication No. 760(E), Geneva, 1999 p. 12.

origin of a product but does not imply any special quality or characteristic of the product[45].

The term "appellation of origin", on the other hand, while it is only mentioned in the Paris Convention[46], is the focus of the Lisbon Agreement. Lisbon Article 2 paragraph 1, contains the following definition: "in this Agreement, 'appellation of origin' means the geographical denomination of a country, region, or locality, which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and humans factors"[47]. According to this definition, appellation of origin can be seen as a special kind of indication of source since the product designated by the AO must have quality and characteristics exclusively or essentially due to its geographical origin[48]. In addition, Lisbon Article 2 paragraph 2, clarifying the meaning of "country of origin", stresses the important role of a product's reputation to be recognised as an AO: "the country of origin is the country whose name, or in which is situated the region or locality whose name, constitutes the appellation of origin which has given the product its reputation".

Comparing the definition of AO with that of GI contained in TRIPs Article 22 paragraph 1, this latter definition apparently seems to be based on Article 2 of the Lisbon Agreement, however there are some important differences between AOs and GIs that need to be highlighted. First of all, the TRIPs defines GIs as "indication which identify a good…", whereas the Lisbon Agreement defines AOs as "the geographical denomination of a country, region or locality, which serves to designate a product…". Thus, under the TRIPs, indications other than geographical names could be used as GIs. Secondly, the Lisbon Agreement requires that the quality or the characteristics of the product be due exclusively or essentially to the geographical environment, including natural and humans factors; while the TRIPs requires that the

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[45] WIPO, *Geographical Indications: An Introduction, op. cit.*, p. 26.

[46] Paris Convention, Article 1 paragraph 2.

[47] Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, 1883, as amended on September 28, 1979.

[48] K. STAROSTINA, *Protected Geographical Indications: scope of protection vis-à-vis comparable products and criteria for defining comparable products*, *op. cit.*, p. 7.

quality, reputation or other characteristics - i.e., in the singular - of the good be essentially attributable to its geographical origin. Hence, goods that have only a certain reputation linked to their place of origin but not a specific quality, are not covered under the definition of AO in the Lisbon Agreement[49].

To conclude, as regards the relationship between these definitions (IS, AO and GI), it can be said that, after the adoption of the TRIPs Agreement, the broadest term is an IS, which includes GI and AO. The term GI is broader than the term AO, meaning that all AOs are also GIs but not all GIs are necessarily able to satisfy the requirements of AO[50].

That being clarified, the following paragraphs describe in more details the different international treaties at issue.

3.3 The Paris Convention for the Protection of Industrial Property

The first international multilateral treaty to include provisions concerning indications of geographical origin is the Paris Convention for the Protection of Industrial Property of 1883[51] (hereinafter the "Paris Convention"). This Treaty is also the first international agreement covering the IP field in general and it is extremely important for the introduction, in this context, of the national treatment principle[52]. According to Article 2 paragraph 1: "nationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals; all without prejudice to the rights specially provided for by this Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights…". This clause,

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[49] K. STAROSTINA, *Protected Geographical Indications: scope of protection vis-à-vis comparable products and criteria for defining comparable products*, *op. cit.*, p. 8. See also G. CONTALDI, *Il conflitto tra Stati Uniti e Unione Europea sulla protezione delle indicazioni* geografiche, in Ubertazzi B. - Espada E.M., *Le indicazioni geografiche di qualità degli alimenti*, Giuffrè Editore, Milano, 2009, p. 27.

[50] K. STAROSTINA, *Protected Geographical Indications: scope of protection vis-à-vis comparable products and criteria for defining comparable products*, *op. cit.*, p. 8.

[51] The Paris Convention currently counts 176 Member States.

[52] B. O'CONNOR, *The law of geographical indications*, *op. cit.*, p. 28.

as a reflection of the more general non-discrimination principle, is one of the pillars of international IP law.

As regards GIs[53], Article 1 paragraph 2 of the Convention, recognises indications of source and appellations of origin as the subject matter of industrial property. However, as illustrated in the previous paragraph, the Convention does not directly define either of these terms, neither clarifies their means of protection[54]. Generally speaking, it prohibits the use of false indications of source on goods mainly through border measures to prevent the movement of the goods in question[55]. Articles 9 and 10 combined provide that in cases of direct or indirect use of false indication of the source or of the identity of the producer, manufacturer, or merchant, on goods, these unlawfully labelled products are to be seized on importation, where the seizure is part of a country's legal code, or, ultimately, to be subject to the actions and remedies available under the national law of the country of importation[56].

According to the Convention, the use of an indication of source on a good such that it could mislead the public as to the truth geographical origin or as to the truth characteristics of the good in question could be considered an act of unfair competition[57]. In this respect, Articles 10*bis* and 10*ter* require signatory states to assure to nationals of the other members states effective protection and appropriate legal remedies against unfair competition[58].

To conclude this brief overview over the Paris Convention it should be noted that, although Articles 9, 10, 10*bis*, and 10*ter*, only refer to IS and do not explicitly

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[53] The term GIs in this context is to be understood as a general and comprehensive term.

[54] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin, op. cit.*, p. 44.

[55] D. GANGJEE, *Protecting Geographical Indications as Collective Trademarks: the Prospects and Pitfalls,* in *IIP (Institute of Intellectual Property) Bulletin,* Tokyo, 2006

[56] WIPO, *Geographical Indications: An Introduction, op. cit.*, p. 26.

[57] Article 10*bis* paragraph 2 of the Paris Convention states as follow: "any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition". See L. BAEUMER, *Protection of Geographical Indication under WIPO treaties and questions concerning the relationship between those treaties and the TRIPs Agreement, op. cit.*, p. 16.

[58] WIPO, *Geographical Indications: An Introduction, op. cit.*, p. 26.

include AO as an object of their provisions, these Articles implicitly apply to both AO and IS, since, as a matter of fact, an AO is by definition an IS[59].

3.4 The Madrid Agreement for the Repression of False and Deceptive Indications of Source on Goods

Since the Paris Convention of 1883 provided limited protection for GIs, many countries, with the aim of improving the international level of protection, established a special union in 1891 under the Madrid Agreement for the Repression of False and Deceptive Indications of Source on Goods[60] (hereafter referred to as Madrid Agreement). However, contrary to expectations, the Madrid Agreement[61], which currently counts only 36 signatories, did not add much to the provisions of the Paris Convention[62]. In fact, it only extended the protection provided for "false" indications of source under the Paris Convention, to "deceptive" indications of source as well[63].

Deceptive indications are those which, although literally correct, may be misleading as to the real origin of the good[64]. For example when there are two identical place names in two different countries, but only one place is renowned for the production of a characteristic good, if the name is used on goods from the other homonymous place, the indication of source would be considered deceptive as the

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[59] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin*, *op. cit.*, p. 44.

[60] K. STAROSTINA, *Protected Geographical Indications: scope of protection vis-à-vis comparable products and criteria for defining comparable products, op. cit.*, p. 11.

[61] Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods adopted in 1891, as revised at Lisbon on October 31, 1958.

[62] L. BAEUMER, *Protection of Geographical Indication under WIPO treaties and questions concerning the relationship between those treaties and the TRIPs Agreement*, *op. cit.*, p. 17.

[63] WIPO, *Geographical Indications: An Introduction, op. cit.*, p. 26. See also L. BAEUMER, *Protection of Geographical Indication under WIPO treaties and questions concerning the relationship between those treaties and the TRIPs Agreement*, *op. cit.*, p. 17. See also K. STAROSTINA, *Protected Geographical Indications: scope of protection vis-à-vis comparable products and criteria for defining comparable products, op. cit.*, p. 11.

[64] WIPO, *Geographical Indications: An Introduction, op. cit.*, p. 26. See also L. BAEUMER, *Protection of Geographical Indication under WIPO treaties and questions concerning the relationship between those treaties and the TRIPs Agreement*, *op. cit.*, p. 17. See also B. O'CONNOR, *The law of geographical indications, op. cit.*, p. 31.

consumer would probably be led to believe that the good originates from that other place[65].

3.5 The Lisbon Agreement for the Protection of Appellation of Origin and their International Registration

After many years of negotiation[66], in 1958, the Lisbon Agreement for the Protection of Appellation of Origin and their International Registration was established. It entered into force in 1966, it was revised in 1967, amended in 1979 and most recently in 2015. The Lisbon Agreement was the first international treaty defining the notions "appellation of origin" and "country of origin". In addition, it took the level of protection of indications of source far beyond that provided for by the two previous agreements[67] and it introduced a mechanism for the international registration of appellations of origin[68].

An appellation of origin is defined in Article 2 paragraph 1 as "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 geographic environment, including natural and humans factors"[69] and, according to Article 2 paragraph 2, the country of origin is "the country in which is situated the region or locality whose name, constitutes the appellation of origin which has given the product its reputation".

The main principle of the Lisbon Agreement, expressed in Article 1 paragraph 2, is that the countries to which this Agreement apply undertake to protect AOs that are protected 'as such' in the country of origin and registered in the international register administered by WIPO[70]. Therefore it simplifies the protection of AOs

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[65] WIPO, *Geographical Indications: An Introduction, op. cit.*, pp. 26-27.

[66] K. STAROSTINA, *Protected Geographical Indications: scope of protection vis-à-vis comparable products and criteria for defining comparable products, op. cit.*, p. 12.

[67] B. O'CONNOR, *The law of geographical indications, op. cit.*, p. 37.

[68] K. STAROSTINA, *Protected Geographical Indications: scope of protection vis-à-vis comparable products and criteria for defining comparable products, op. cit.*, p. 12.

[69] See above paragraph 3.2.

[70] B. O'CONNOR, *The law of geographical indications, op. cit.*, p. 37.

internationally offering a mean of protection for an AO originating in one Member State in the territories of all other Members through a single international registration. As an aside, however, after the Revision of the Agreement in 2015, this system has been extended also to GIs recognised and protected in their country of origin[71]. Another extremely important provision of this Agreement that has to be mentioned and that is strictly connected to the establishment of the international register is the one expressed in Article 6 which states that a registered appellation cannot be deemed to have become generic as long as it is protected as an AO in its country of origin.

The scope of protection provided for by the Lisbon Agreement for internationally registered AOs is broader in comparison to the previous agreements[72]. According to Article 3 "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 or accompanied by terms such as 'kind', 'type', 'make', 'imitation', or the like". Thus the Agreement strengthens the level of protection especially by doing away, for the prohibition of the use of a registered indication, with requirement that the use be misleading and confusing.

Nevertheless the Lisbon Agreement failed to reach broad support from the international community[73]. In fact, it currently counts only 28 members[74] and many large economies are not parties, among them: the US, Canada, the majority of EU countries, Japan, South Korea. One reason for the limited uptake of the agreement is that accession to the Agreement was confined, prior to the recent amendments in May 2015, to those countries that protect AOs "as such", meaning that countries protecting AOs under trademark, unfair competition or consumer protection laws were excluded[75].

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[71] WIPO, *Geographical Indications: An Introduction, op. cit.*, p. 37.

[72] K. STAROSTINA, *Protected Geographical Indications: scope of protection vis-à-vis comparable products and criteria for defining comparable products, op. cit.*, p. 12.

[73] B. O'CONNOR, *The law of geographical indications, op. cit.*, p. 39.

[74] *Status* as of July 15, 2015, information available at: http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/lisbon.pdf.

[75] B. O'CONNOR, *The law of geographical indications, op. cit.*, p. 39.

A major review of the Lisbon Agreement was adopted with the Geneva Act[76] at the end of the Diplomatic Conference, held at the World Intellectual Property Organisation in Geneva, Switzerland, from May 11th to May 21st 2015[77]. The Conference was convened with the aim of adopting a new Act of the Lisbon Agreement that would render the Lisbon system more attractive for states while preserving its principles[78]. The Geneva Act is characterised by three fundamental improvements: first, it extends its scope to cover not only AOs but also GIs. This is reflected in the name of the Lisbon Agreement, which has been until now "Lisbon Agreement for the Protection of Appellation of Origin and their International Registration" and will now be "Lisbon Agreement on Appellations of Origin and Geographical Indications"; second, it contains a number of procedural provisions aimed at allowing countries following the trademark approach to participate in the new system[79]; third, it gives the possibility for international organisations to become full member (e.g. the EU)[80].

3.6 The TRIPs Agreement

The WTO's Agreement on Trade-Related Aspects of Intellectual Property (TRIPs) is, at present, the most comprehensive multilateral treaty in the development

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[76] Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indidications, as adopted on May 20, 2015, WIPO Lex No. TRT/LISBON/009.

[77] European Commission, *WIPO Conference agrees revisions to Lisbon Agreement on Geographical Indications,* May 22, 2015, available at: http://ec.europa.eu/agriculture/newsroom/206_en.htm.

[78] WIPO, *Diplomatic Conference for the Adoption of a new Act of the Lisbon Agreement - The Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications,* available at: http://www.wipo.int/meetings/diplomatic_conferences/2015/en/.

[79] e.g. the Geneva Act allows interested parties to request the refusal of the effect of an international registration and to request the payment of individual fees and it provides for express safeguards with respect to prior trademark rights, personal names used in business and rights based on plant variety or animal breed denomination.

[80] European Commission, *WIPO Conference agrees revisions to Lisbon Agreement on Geographical Indications*, *op. cit.*. See also F. CURCHOD, *The Revision of the Lisbon System*, paper presented at the Worldwide Symposium on Geographical Indications, held in Budapest from October 20 to October 22, 2015, WIPO/GEO/BUS/15/0, available at: http://www.wipo.int/meetings/en/details.jsp?meeting_id=36422.

of intellectual property law[81]. The Agreement, which binds all WTO Members[82], provides for a *minimum* standard of protection to all the major IPR including GIs. In this sense it represents a significant step toward the universal recognition of GIs as an IPR[83]. It constitutes Annex 1C of the Marrakesh Agreement Establishing the World Trade Organisation which was concluded on April 15, 1994 at Marrakesh and entered into force on January 1, 1995.

Articles from 1 to 8 of the TRIPs set out the basic rules concerning international protection of IPRs in general. Article 1.1 allows Members to implement in their law more extensive protection than is required by the Agreement, thus confirming that the TRIPs only provides for a *minimum* standard. Articles 3 and 4 include the fundamental rules on national and most-favoured-nation treatment of foreign nationals, which are common to all categories of IPR. The national treatment clause forbids discrimination between the nationals of one Member and the nationals of the others while the most-favoured-nation clause forbids discrimination between the nationals of other Members[84].

GIs are addressed in Section 3, Articles 22, 23, and 24 of the Agreement.

Article 22 paragraph 1 defines GIs as "indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation, or other characteristics of the good is essentially attributable to its geographical origin"[85]. Therefore, for an indication to be considered a GI three conditions must be met: the indication must necessarily identify a good and can be a non-geographical name; the good must necessarily posses a "given quality", or a "reputation" or "other characteristics", that is

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[81] B. O'CONNOR, *The law of geographical indications, op. cit.*, p. 50.

[82] The TRIPs Agreement counts 162 Member States, information available at: http://www.wipo.int/wipolex/en/other_treaties/parties.jsp?treaty_id=231&group_id=22.

[83] D.V. EUGUI – C. SPENNEMANN, *The treatment of geographical indications in recent regional and bilateral free trade agreements*, in M.P. Pugatch (ed.), *The Intellectual Property Debate*, Edward Elgar, Cheltenham, UK, 2006, p. 305.

[84] For an overview of the TRIPs Agreement see WTO, *Overview: the TRIPs Agreement*, at: https://www.wto.int/english/tratop_e/trips_e/intel2_e.htm.

[85] See above paragraph 3.2 for a comparison between the definition of GIs and the one of AOs provided by the Lisbon Agreement.

essentially linked to the designated geographical area[86]; the designated geographical area must be identified by the indication[87]. Academic commentators on TRIPs tends to agree that services are excluded from the scope of Section 3 since the definition only refers to "goods"[88].

Although there is only one definition of GIs, the TRIPs Agreement provides for two different levels of protection: a basic protection under Article 22 granted to any GI, and an additional or absolute protection under Article 23 granted exclusively to GIs related to wines and spirits[89].

The general and basic protection outlined in Article 22, which is applicable to all GIs except those for wines and spirits, obliges WTO' Members to "provide the legal means for interested parties to prevent (a) the use of any misleading means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good; (b) any use which constitutes an act of unfair competition within the meaning of Article 10*bis* of the Paris Convention (1967)"[90]. However, since the "legal means" are not specified, Members are free to determine the appropriate implementation mechanism. This explains the lack of a uniform approach in this field[91]. The next paragraph obliges WTO's Members to refuse or invalidate the registration of trademarks that contain or consist of a geographical indication, where they may

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[86] The essential link required by the TRIPs in Article 22 sometimes is referred to as the "essentially attributable test". It is also important to remind that, according to Article 22, the requirements of quality, reputation or other characteristics of the good have to be read alternatively and not jointly. See D. GANGJEE, *Relocating the law of Geographical Indications*, *op. cit.*, p. 186.

[87] I. KIREEVA - B. O'CONNOR, *Geographical Indications and the TRIPs Agreement: What Protection is Provided to Geographical Indications in the WTO Members?,* in *Journal of World Intellectual Property,* Vol. 13, No. 2, 2010, pp. 275-303.

[88] D.V. EUGUI – C. SPENNEMANN, *The treatment of geographical indications in recent regional and bilateral free trade* agreements, *op. cit.*, p. 310.

[89] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin*, *op. cit.*, pp. 41-42. See also CONTALDI G., *Il conflitto tra Stati Uniti e Unione Europea sulla protezione delle indicazioni geografiche*, *op. cit.*, p. 28.

[90] TRIPs Agreement, Article 22 paragraph 2 letter (a) and (b).

[91] I. KIREEVA - B. O'CONNOR, *Geographical Indications and the TRIPs Agreement: What Protection is Provided to Geographical Indications in the WTO Members?, op. cit.*, p. 276.

mislead the public as to the origin of the goods[92]. It is then specified that protection under Article 22 is applicable not only to false geographical indications but also to deceptive geographical indications, i.e. those indications that, although literally truth as to the place of origin of the good, falsely represents to the public that the good originates in a different country[93].

Thus, according to letter (a) of Article 22, the legitimate user of the GI has the burden to prove that a third party, by designating or presenting a good, misleads the consumers bringing them to believe that the third party's good originates in the same place as of the protected GI[94]. Alternately, as of letter (b) of the same Article, the owner of the protected GI has to prove that the use of an indication by a third party constitutes an act of unfair competition within the meaning of article 10*bis* of the Paris Convention[95]. However, reading Article 22 letter (b) combined with Article 10*bis* it is possible to argue that the TRIPs Agreement extends the protection available under Article 22 letter (a), which covers cases of consumer confusion as to the origin of the indicated good, to cases where the public is aware of the true origin but is misled as to the nature, manufacturing process or characteristics[96], namely cases that are understood to dilute the reputation of the products against the ethics of honest commercial activity[97].

By contrast, the protection granted to wine and spirit GIs under Article 23 is significantly higher and it is often referred to as "additional" or "absolute"

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[92] TRIPs Agreement, Article 22 paragraph 3.

[93] TRIPs Agreement, Article 22 paragraph 4: "the protection under paragraph 1, 2 and 3 shall be applicable against a geographical indication which, although literally true as to the territory, region or locality, in which the good originate, falsely represents to the public that the good originate in another country". For a better description of "deceptive indication" see above paragraph 3.3.

[94] D.V. EUGUI – C. SPENNEMANN, *The treatment of geographical indications in recent regional and bilateral free trade agreements, op. cit.*, p. 310.

[95] D.V. EUGUI – C. SPENNEMANN, *The treatment of geographical indications in recent regional and bilateral free trade agreements, op. cit.*, p. 311.

[96] D.V. EUGUI – C. SPENNEMANN, *The treatment of geographical indications in recent regional and bilateral free trade agreements, op. cit.*, p. 311.

[97] e.g. in the case of "California Chablis" consumers are aware of the non-French origin of the drink, but might nevertheless associate with that product certain characteristics typical of the famous French "Chablis". See D. RANGNEKAR, *Geographical indications – a review of proposals at the TRIPS Council: extending Article 23 to products other than wines and spirits,* UNCTAD-ICTSD Project on IPRs and Sustainable Development, Issue Paper No.4, Geneva, 2003, p. 14.

protection[98]. According to this provision third parties may not use a protected GI to designate their products even where the consumer is not misled as to the true origin of these products[99]. Indeed, Article 23 paragraph 1 prohibits the use of GIs for wines and spirits "even where the true origin of the good is indicated or the geographical indication is used in translation or accompanied by expression such as 'kind', 'type', 'style', 'imitation' or the like"[100]. Thus, as opposed to the basic protection under Article 22, these GIs are protected without requiring that either unfair competition or deception be demonstrated[101]. It is enough, for the legitimate user, to prove that the product using the GI in question does not come from the indicated area[102]. Moreover, paralleling the provision in Article 22, WTO's Members shall refuse or invalidate the registration of a trademark for wines or spirits that contains or consists of a geographical indication identifying wines or spirits, but in this case, irrespective of its misleading nature[103].

That said, in order to conclude the analysis of Article 23, it is important to recall that paragraph 3 states the principle of co-existence in the case of homonymous GIs provided that misleading uses are minimised through a practical differentiation mechanism determined by each Member State[104] and paragraph 4 obliges Members to undertake negotiations for the establishment of a multilateral system of

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98 D. GANGJEE, *Relocating the law of Geographical Indications*, *op. cit.*, p. 187.

99 D.V. EUGUI – C. SPENNEMANN, *The treatment of geographical indications in recent regional and bilateral free trade agreements, op. cit.*, p. 311.

100 The language of this article is familiar, it is the same used in Article 3 of the Lisbon Agreement. The only difference is that the protection is here referred to specific GIs, namely wine and spirit GIs, whereas in the Lisbon Agreement it was referred to all AOs irrespective of the type of product concerned.

101 D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin*, *op. cit.*, p. 42.

102 i.e., according to TRIPs provisions, "Parmesan cheese made in the US" is not considered a violation of the Parmigiano Reggiano GI, since the true origin of the product is indicated and therefore the public is not misled, while "Cognac made in the US" is a violation of the Cognac GI, even if the true origin of the product is indicated. See D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin*, *op. cit.*, p. 42.

103 TRIPs Agreement, Article 23 paragraph 2.

104 TRIPs Agreement, Article 23 paragraph 3. See D. GANGJEE, *Relocating the law of Geographical Indications*, *op. cit.*, p. 187.

notification and registration of wine and spirit GIs[105] in order to facilitate their protection[106].

The justification for such differentiated treatment between wines and spirits and all the other products concerning GIs remains unclear[107]: in fact none of the other IPRs in the TRIPs Agreement is regulated differently as to the category of products concerned[108]. Some Member States argue that this discrimination is not reasonable and therefore not acceptable and they wish to extend the higher level of protection of Article 23 to all products[109].

In any event, GI protection under Article 22 and 23 is subject to a number of important exceptions outlined in Article 24 that grandfather certain uses of GIs and trademarks normally prohibited[110]. Reading from paragraph 4 to paragraph 9 of Article 24, three main categories of exceptions can be identified: the first is related to continued and similar use of GIs for wines and spirits, the second concerns prior good faith trademark rights and the third is linked to generic designations[111].

The first exception established by Article 24 paragraph 4 only applies to GIs for wines and spirits and refers to cases where producers of one Member (country A) use a GI similar to a GI protected in another Member (country B). Provided that the GI has been used continuously and for the same or related goods or services, at least

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[105] Although spirits are not mentioned in the text of the Agreement, they were subsequently included in the negotiations for the register, precisely at the time of the Ministerial Conference of Singapore of 1996. See WTO - Council for TRIPs, 1996/7/8 Annual Reports, IP/C/8, November 6, 1996.

[106] D. RANGNEKAR, *Geographical indications – a review of proposals at the TRIPS Council: extending Article 23 to products other than wines and spirits*, *op. cit.*, p. 23.

[107] D. GANGJEE, *Relocating the law of Geographical Indications*, *op. cit.*, p. 188.

[108] E.O. CÀCERES, *Perspectives for Geographical Indications,* paper presented at the International Symposium on Geographical Indications, jointly organised by the World Intellectual property Organization (WIPO) and the State Administration for Industry and Commerce (SAIC) of the People's Republic of China, Beijing, June 26-28, 2007, WIPO/GEO/BEI/07/13.

[109] Namely, the EU is the major proponent of expanding the protection scope of Article 23 to all products, while the US and its coalition are the main opponents wishing to maintain the current differentiated treatment. See D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin*, *op. cit.*, p. 42. See also G. COSCIA, *I rapporti fra i sistemi internazionali e comunitari sulla protezione delle indicazioni di qualità,* in B. Ubertazzi - E. M. Espada (eds.), *Le indicazioni di qualità degli alimenti,* Giuffrè Editore, Milano, 2009, p. 54.

[110] D.V. EUGUI – C. SPENNEMANN, *The treatment of geographical indications in recent regional and bilateral free trade agreements, op. cit.*, p. 311.

[111] K. STAROSTINA, *Protected Geographical Indications: scope of protection vis-à-vis comparable products and criteria for defining comparable products, op. cit.*, p. 14.

since 15 April 1984, or that the GI has been used in good faith prior to 15 April 1994, country A is not required to prevent continued and similar use of the GI[112].

Secondly, paragraph 5 constitutes an exception both to Article 22.3 and Article 23.2. According to this provision the registration, the application for registration, or the acquisition through use of a trademark identical or similar to a GI, when in good faith, may be admitted if such rights are acquired before the entry into force of the TRIPs in the relevant country, or before the protection of the GI in the country of origin. Thus, if these conditions are met, the co-existence between the trademark in question and the GI does not prevent the protection of such trademark[113].

The third exception in paragraph 6 takes into account the fact that a certain indication while protected in one country, might be considered as the common name for the designated good or service in another country[114] and therefore not protected.

Finally, according to paragraph 8 and 9, the provisions of this Section shall not prejudice "the right of any person to use, in the course of trade, that person's name… except where such name is used in such a manner as to mislead the public" and shall not oblige "to protect geographical indications which are not cease to be protected in their country of origin, or which have fallen into disuse in that country"[115].

To complete this general review of the TRIPs Agreement, it is important to briefly mention the post-Uruguay round proposals on GIs. Such proposals found their roots in the same Section 3 of the TRIPs that, in Article 23 paragraph 4 and Article 24 paragraph 1, laid the foundation for further negotiations with regard to the establishment of a multilateral register for wines and spirits and to the increase of the level of protection under Article 23[116]. Hence, the subsequent discussions in the international community focused mainly on these two proposals: the creation of the

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[112] D.V. EUGUI – C. SPENNEMANN, *The treatment of geographical indications in recent regional and bilateral free trade agreements, op. cit.*, p. 311.

[113] K. STAROSTINA, *Protected Geographical Indications: scope of protection vis-à-vis comparable products and criteria for defining comparable products, op. cit.*, p. 15.

[114] D.V. EUGUI – C. SPENNEMANN, *The treatment of geographical indications in recent regional and bilateral free trade agreements, op. cit.*, p. 312.

[115] TRIPs Agreement, Article 23 paragraph 8 and 9.

[116] UNCTAD-ICTSD, *Resource Book on TRIPS and Development: An authoritative and practical guide to the TRIPS Agreement,* Capacity Building Project on IPRs, 30 November 2004, Cambridge University Press, New York, 2005, p. 315.

above-mentioned multilateral register and the extension of the higher level of protection of Article 23 beyond wines and spirits[117]. These proposals were presented by selected Member States at the TRIPs Council during the Doha round of WTO negotiations in 2001. However, due to the strong opposition expressed by some other countries to such proposals, at the end of the Doha round WTO Members could only agree to disagree[118]. The main supporters of the reviews were: the EU; Switzerland; Jamaica; Thailand; India and some African countries. While the main opponents were: the US; Canada; Australia; New Zealand; the Philippines and Taiwan[119]. Unfortunately, such disagreement was not only a thing of the past, discussions over these issues are still at the core of one of the fiercest ongoing debate in the international community and an agreement is far to be reached.

An overview of the current regime for the protection of GIs in the TRIPs Agreement and of the proposals for change now under negotiations is essential for an understanding of the main theme of this thesis, namely the *phaenomenon* of conflicting FTAs originating from the different groups of countries in this debate and most importantly the EU and the US.

4. Different forms of GI protection

The TRIPs Agreement obliges Members to implement its provisions on GIs in their national law but it does not specify the means through which WTO Members should achieve this result. For this reason there is no uniform approach[120].

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[117] WTO, *Geographical Indications in general*, at: https://www.wto.org/english/tratop_e/trips_e/gi_background_e.htm#wines_spirits. See also F. ADDOR - A. GRAZIOLI, *Geographical Indications beyond wines and spirits. A roadmap for a better Protection for Geographical Indications in the WTO TRIPs Agreement*, *op. cit.*, p. 883.

[118] WTO-Doha Ministerial Declaration of 20 November 2001, WT/MIN(01)/DEC/1, available at: https://www.wto.org/english/thewto_e/minist_e/min01_e/mindecl_e.htm.

[119] WTO, *Geographical Indications in general*, *op. cit.*. See also F. ADDOR - A. GRAZIOLI, *Geographical Indications beyond wines and spirits. A roadmap for a better Protection for Geographical Indications in the WTO TRIPs Agreement*, *op. cit.*, pp. 883-886.

[120] I. KIREEVA - B. O'CONNOR, *Geographical Indications and the TRIPs Agreement: What Protection is Provided to Geographical Indications in the WTO Members?, op. cit.*, p. 276. See also A.K. SANDERS, *Incentives for and Protection of Cultural Expression: Art, Trade and Geographical Indications*, in *The Journal of World Intellectual Property*, Vol. 13, Issue 2, pp. 81-93, March 2010, p. 83.

Some countries have in place a specific and unique, i.e. *sui generis* legislation for GI protection while others utilise an already existing legislation, e.g. trademark law, unfair competition and passing off laws or administrative scheme for protection[121].

These different approaches reflect a diversity of histories, cultures, values and traditions across countries[122]. For example, the common law approach of countries such as the US, Australia and Canada is more comfortable with the trademark regime as a way of protecting GIs, mainly using collective and certification marks. On the other hand the *sui generis* approach is preferred by other countries like the EU with its 28 Member States which perceive GIs more as a public asset that cannot be bought, transferred or controlled by a single individual[123].

This being said, the EU and US systems together are fairly representative of the variety of schemes utilised by most countries throughout the world for the protection of GIs and can therefore serve as useful examples[124]. For this reason in the following Chapter these two systems will be analysed in detail.

5. The key differences between Trademarks and GIs

GIs and Trademarks (hereinafter referred to as TMs) are source identifiers and, as distinctive signs, they are both used to distinguish goods in the market place. However the source they identify is different: TMs identify a good or service as originating from a particular enterprise while GIs identify a good as originating from a particular place with a specific quality, characteristic or reputation[125]. This basic

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[121] A.F. RIBEIRO DE ALMEIDA, *Key differences between trademarks and geographical indications,* Porto, 2008, p. 13, available at: http://citizenseminars.blogactiv.eu/files/2009/03/trade-marks-in-pdf.pdf.

[122] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their* origin*, op. cit.*, p. 49.

[123] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin, op. cit.*, pp. 54-55.

[124] G. BELLETTI - A. MARESCOTTI, *Approcci alternativi per la regolamentazione e la tutela dei nomi geografici: reputazione collettiva e interesse pubblico*, in *Agriregionieuropa*, Anno 4, No. 15, December 2008.

[125] WIPO, *Geographical Indications: An Introduction, op. cit.*, p. 13.

distinction implies that TMs and GIs are different concepts with different characteristics.

First of all a GI has a collective nature that is visible in the fact that GIs can be used by all producers, in the area of origin of the concerned product, that utilise a production method compliant with the one characterising the GI[126]. Therefore the registration of a GI confers rights to all legitimate producers. On the contrary a TM typically has an individual nature giving the owner the right to exclude all the others from using the sign registered as a TM.

Secondly, GIs are mostly geographical names or, exceptionally, traditional and historical non-geographical names if they are associated with a specific place[127]. Whereas TMs may consist of any arbitrary sign capable of being represented graphically, including letters, numerals and shapes of goods provided that such signs perform a distinctive function[128].

Thirdly, because of its link with the place of origin, a GI cannot be delocalised, meaning that it cannot be transferred or licensed to someone outside that place[129]. While a TM, because it is linked to a particular enterprise and not to a particular place, may be transferred to anyone anywhere in the world[130].

Another difference concerns the consequences of non-use. GIs are not subject to revocation for non-use and usually the renewal of the registration is not required. On the contrary, TMs may be revoked if not used for a continuous period of five years in the Member State where they are registered[131].

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[126] A.F. RIBEIRO DE ALMEIDA, *Key differences between trade marks and geographical indications, op. cit.*, p. 12. See also M. VITTORI, *The International Debate on Geographical Indications (GIs): The Point of View of the Global Coalition of GI Producers - oriGIn*, in *The Journal of World Intellectual Property*, Vol. 13 Issue 2, pp. 304-314, March 2010, p. 305.

[127] The most famous example is "Feta" which is not a place in Greece but is so closely connected to Greece as to identify a typical Greek product. See B. O'CONNOR, *Geographical indications and TRIPs: 10 Years Later A roadmap for EU GI holder to get protection in other WTO Members*, in *Geographical Indications Handbook,* 2004, available at http://trade.ec.europa.eu/doclib/docs/2007/june/tradoc_135088.pdf.

[128] A.F. RIBEIRO DE ALMEIDA, *Key differences between trade marks and geographical indications, op. cit.*, p. 7.

[129] WIPO, *Geographical Indications: An Introduction, op. cit.*, p. 13. See also A.F. RIBEIRO DE ALMEIDA, *Key differences between trade marks and geographical indications, op. cit.*, p. 8.

[130] WIPO, *Geographical Indications: An Introduction, op. cit.*, p. 13.

[131] A.F. RIBEIRO DE ALMEIDA, *Key differences between trade marks and geographical indications, op. cit.*, pp. 7-8.

Lastly, the type of protection provided is different. For GIs, considering their collective nature, the protection is also public, meaning that the Government, together with the private producers, is entitled by means of *ex officio* procedure to safeguard GIs. For TMs the protection is only private, thus the burden of proving an infringement is entirely on the owner[132].

However this general framework needs to be specified as, besides ordinary TMs, there are also collective and certification marks. In the interests of completeness, it is important to give a brief overview of the main differences between GIs and all these specific types of marks, taking into account that these differences are still being explored in legal literature[133].

Ordinary trademarks must be distinctive and not descriptive[134]. This means that signs composed exclusively by indications that serve to designate the geographical origin of a certain product, since inherently descriptive, cannot be registered as trademarks[135]. The reason of this impediment is to avoid monopoly in the use of a place name: the potentially limitless appropriation *via* trademark of an indication used to identify a locality by a single owner would unfairly prevent all the other operators to use that name without his prior consent[136]. The composition of an ordinary trademark by a geographical name may exceptionally take place if it has acquired distinctive character through use (i.e. secondary meaning). However it clearly appears that ordinary trademarks perform a completely different function when compared to GIs[137] and that they are contrary to the whole idea of GIs as

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[132] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their* origin*, op. cit.*, p. 55.

[133] B. O'CONNOR, *Geographical Indications in TTIP, The TransAtlantic Trade and Investment Partnership,* paper presented at the Parma Workshop, April 2015.

[134] P. AUTERI – G. FLORIDIA – V. MANGINI – G. OLIVERI – M. RICOLFI – P. SPADA, *Diritto industriale Proprietà intellettuale e Concorrenza,* Torino, Giappichelli, 2012, p. 86.

[135] Paris Convention, Article 6 quinquies letter b (ii). See also Council Regulation (EC) No. 207/2009 of 26 February 2009 on the Community trade mark, 2009 O.J. L 78/1, Article 7 letter (c). See also D. GANGJEE, *Protecting Geographical Indications as Collective Trademarks: The Prospects and Pitfalls*, *op. cit.*, p. 114.

[136] P. AUTERI – G. FLORIDIA – V. MANGINI – G. OLIVERI – M. RICOLFI – P. SPADA, *Diritto industriale Proprietà intellettuale e Concorrenza, op. cit.*, p. 86.

[137] A.F. RIBEIRO DE ALMEIDA, *Key differences between trade marks and geographical indications, op. cit.*, p. 9.

collective rights belonging to a number of producers sharing knowledge and skills and producing in the same area[138].

Collective marks, on the other hand, are owned by a collective body e.g. an association of producers, and serve the function to indicate that the person who uses the collective mark is a member of that community. Although members normally have to comply with a regulation of use set down by the association itself, this type of mark fulfils a membership function rather than a quality one. In fact, the mark is not necessarily open to any producer who complies with that regulation, but it may be limited to the current members of the association, thus increasing the distance from the characteristic collective and public nature of GIs[139].

Finally certification marks serve to designate that the products or services on which they are used have specific qualities, including, potentially, geographical origin. The owner of the certification mark undertakes to certify that the products or services on which the certification is used comply with the rules of production and the standards of quality by him established. However, unlike normal trademarks, the owner is not allowed to use the certification mark himself. The users may be any producer who respects the rules of production under the control of the owner. Therefore certification marks manly perform a guarantee function, which is not so far from the one performed by GIs[140]. Nevertheless, according to an opinion that can be shared[141], the juridical nature of the two remains different[142].

That said, differences between GIs and TMs exist and need to be taken into account when it comes to the regulation of these two IPRs. These differences also

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[138] I. KIREEVA - B. O'CONNOR, *Geographical Indications and the TRIPS Agreement: What Protection is Provided to Geographical Indications in the WTO Members?*, *op. cit.*, p. 288.

[139] A.F. RIBEIRO DE ALMEIDA, *Key differences between trade marks and geographical indications, op. cit.*, p. 10. See also B. O'CONNOR, *Geographical Indications: Some thoughts on the practice of the US Patent and Trademark Office and TRIPs,* World Trade Review, 13, pp.713-720, 2014, p. 714.

[140] A.F. RIBEIRO DE ALMEIDA, *Key differences between trade marks and geographical indications, op. cit.*, p. 10. See also B. O'CONNOR, *Geographical Indications: Some thoughts on the practice of the US Patent and Trademark Office and TRIPs, op. cit.*, p. 714.

[141] A.F. RIBEIRO DE ALMEIDA, *Key differences between trade marks and geographical indications, op. cit.*, p. 10.

[142] It is important to remind that the issue of the juridical nature of GIs is not without controversy, however, an analysis of this debate would go beyond the scope of this paper.

explain the autonomous regime provided for by some countries for the protection of GIs (i.e. the *sui generis* regime)[143].

[143] A.F. RIBEIRO DE ALMEIDA, *Key differences between trade marks and geographical indications, op. cit.*, p. 13.

CHAPTER II

THE DIFFERENT PROTECTION OF GEOGRAPHICAL INDICATIONS IN THE EUROPEAN UNION AND IN THE UNITED STATES

CONTENTS: 1. Protection of GIs in the European Union. - 1.1 *Sui Generis* Regime. - 1.1.1 EU Regulations on GIs: a brief history. - 1.1.2 Regulation No 1151/2012 on quality schemes for agricultural products and foodstuffs. - 1.1.3 Regulation No 1308/2013 establishing a common organisation in agricultural products and Regulation No 110/2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks. - 1.2 TRIPs-Plus level of protection. - 1.3 The EU approach reflected in the FTAs signed by the EU and third countries. - 2. Protection of GIs in the United States. - 2.1 Trademark Regime. - 2.1.1 Certification marks. - 2.1.2 Traditional trademarks and collective marks. - 2.1.3 Implications of the trademark approach and its impact on international trade: major problems for European producers in ensuring protection of their GIs through trademarks. - 2.1.4 Specific rules for GIs in the wine sector - 2.2 TRIPs-minus level of protection. - 2.3 The US approach reflected in the FTAs signed by the US and third countries.

1. Protection of GIs in the European Union

1.1 *Sui Generis* Regime

Historically the EU has played a leading role in the development, recognition and protection of GIs[144]. This specific attention to GIs is certainly deeply rooted in the long agricultural and manufacturer tradition that always characterised European countries, especially in the Mediterranean area[145]. The EU is still today a leading

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[144] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin*, *op. cit.*, p. 59.

[145] M. BLAKENEY, *Geographical Indications and TRIPS,* in *The Intellectual Property Debate: Perspectives from Law, Economics and Political Economy,* in M.P. PUGATCH (ed.), Edward Elgar, Cheltenham, UK, 2006, p. 300.

producer of wines[146] and spirits at the global level and the other food sectors are not less valuable[147]. The idea behind the EU system is that EU farmers must build on high quality reputation to sustain competitiveness and profitability[148].

This being said, in an attempt to provide an effective protection for GIs, EU legislation has set forth harmonised legal frameworks aimed at granting a highly advanced system of protection specifically designed for GIs that, for this reason, is called *sui generis*[149]. The *sui generis* approach considers GIs as belonging to a group of producers in the region and as a public asset that cannot be de-localised, transferred or controlled by any individual[150]. Thus, in the EU system, any operator producing an authentic product has the right to use the GI. Again, following this approach, GIs do not expire, do not need to be renewed and benefit from public enforcement within the EU, meaning that the State is likely to be involved in the protection process[151].

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[146] The EU accounts for 45% of wine-growing areas, 65% of production, 57% of global consumption and 70% of exports globally. See European Commission, Directorate-General for Agriculture and Rural Development, *WINE-Market Situation Evolution and Background*, July 2015, available at: http://ec.europa.eu/agriculture/wine/statistics/market-situation-2014-07_en.pdf (last viewed on October 1, 2015). Other statistics can be accessed at: http://ec.europa.eu/agriculture/wine/statistics/index_en.htm (last viewed on October 1, 2015). Data concerning registered European wine GIs are available at E-Bacchus: http://ec.europa.eu/agriculture/markets/wine/e-bacchus/index.cfm?event=statistics&language=EN (last viewed on October 1, 2015).

[147] Data concerning European spirit GIs are available at E-Spirit-Drinks: http://ec.europa.eu/agriculture/spirits/index.cfm?event=searchIndication (last viewed on October 1, 2015). Data concerning European agricultural products and foodstuffs' GIs are available at DOOR: http://ec.europa.eu/agriculture/quality/door/list.html (last viewed on October 1, 2015). At the end of April 2014, 336 names of spirits, 1577 names of wines and 1184 names of foodstuffs and agricultural products were registered at the EU level. See A. MATTHEWS, *What Outcome to Expect on Geographical Indications in the TTIP Free Trade Agreement Negotiations with the United States?*, Presentation to 145the EAAE Seminar " Intellectual Property Rights for Geographical Indications: What is at Stake in the TTIP?", Parma, 14-15 April 2015.

[148] See European Commission, Agricultural and rural development, Quality Policy, at: http://ec.europa.eu/agriculture/quality/index_en.htm.

[149] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin*, *op. cit.*, p. 56.

[150] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin*, *op. cit.*, p. 55.

[151] L. LOURDAIS, *Overview of the EU GIs system of protection and its benefits,* WIPO IPOPHL seminar, Manila, 28-29 February 2012.

European law, at present, is based on four systems for the protection of GIs, one for wines[152], one for spirits[153], one for aromatic wines[154] and one for agricultural products and other foodstuffs[155]. No specific GI system has yet been established at the EU level for non-agricultural products, however a discussion on whether this system should be implemented is currently underway[156]. That being said, the EU Regulations have replaced to a large degree the residual national systems of the European countries[157], so that Member States retain competence on GI issues only when EU law does not apply[158].

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[152] Regulation (EU) No 1308/2013 of 17 December 2013 establishing a common organisation of the markets in agricultural products and repealing Council Regulations (EEC) No 922/72, (EEC) No 234/79, (EC) No 1037/2001 and (EC) No 1234/2007, 2013 O.J. L 347/671.

[153] Regulation (EC) No 110/2008 of the European Parliament and of the Council of 15 January 2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirits drinks and repealing Council Regulation (EEC) NO 1576/89, 2008 O.J. L 39/16; Commission Implementing Regulation (EU) No 716/2013 of 25 July 2013 laying down rules for the application of Regulation (EC) No 110/2008 of the European Parliament and of the Council on the definition, description, presentation, labelling and protection of geographical indications of spirits drinks, 2013 O.J. L 201/21.

[154] Regulation (EU) No 251/2014 of the European Parliament and of the Council of 26 February 2014 on the definition, description, presentation, labelling and the protection of geographical indications of aromatised wine products and repealing Council Regulation (EEC) No 1601/91, 2014 O.J. L 84/14.

[155] Regulation (EU) No 1151/2012.

[156] OriGIn, *Study on geographical indications protection for non-agricultural products in the internal market,* Final Report, 18 February 2013, available at http://ec.europa.eu/internal_market/indprop/docs/geo-indications/130322_geo-indications-non-agri-study_en.pdf. See also European Commission, Green Paper, *Making the most out of Europe's traditional know-how: a possible extension of geographical indication protection of the European Union to non-agricultural products*, COM(2014) 469 final, 2014. See also European Parliament Resolution of 6 October 2015 on the possible extension of geographical indication protection of the European Union to non-agricultural products, 2015/2053(INI), 2015.

[157] As admitted by the ECJ in the *Budweiser II* case: "the Community system of protection laid down by Council Regulation (EC) No. 510/2006 on the protection of geographical indications and designation of origin for agricultural products and foodstuffs is exhaustive in nature". The same conclusion was reaffirmed in the *Bavaria* case: Bavaria NV v. Bayerischer Brauerbund eV, Case C-120/08, (2010) E.C.R. I-13393, paragraph 59. See V. MANTROV, *Protection Norms of Indications of Geographical Origin in the Applicable EU Regulations - Recent Changes and the Necessity of Further Unification*, in *IIC - International Review of Intellectual Property and Competition* Law, Vol. 43, No. 2, Max Planck Institute for Intellectual Property and Competition Law, Munich, Germany, 2012. See also, BRUGIONI L., *La tutela delle denominazioni di origine e delle indicazioni geografiche agroalimentari non registrate ai sensi del Regolamento (UE) 1151/2012. Una riflessione sul caso Salame Felino*, in *Rivista di diritto industriale*, Anno LXIV, 2015, p. 278.

[158] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG. *Guide to Geographical Indications: linking products and their origin*, *op. cit.*, p. 59. See also Regulation (EU) No 1151/2012, recital (24). In the case law, see Assica – Associazione Italiana produttori delle Carni e dei Salumi and Kraft Foods Italia SpA v. Associazione fra produttori per la tutela del "Salame Felino" et al., Case C-35/13, (2014) ECLI:EU:C:2014:306, paragraph 28; Budvar v. Ammersin, Case C-478/07, (2009) E.C.R. I-07721, paragraph 114; Schutzverband gegen Unwesen in der Wirtschaft eV v. Warsteiner Brauerei Haus Cramer GmbH & Co. KG., Case C-312/98, (2000) E.C.R. I-09187, paragraph 54.

In the following paragraphs, the EU Regulations concerning GIs will be analysed as to the scope, the level of protection and their relationship with the *minimum* standard provided for by the TRIPs Agreement.

1.1.1 *EU Regulations on GIs: a brief history*

The *sui generis* protection of GIs in the EU started with the adoption of several legal acts regulating product designations for wines in 1970[159]. This set of rules was then followed by the adoption of Council Regulation 1576/1989 laying down general rules on the definition, description and presentation of spirit drinks[160]. These acts, however, are no longer in force and, currently, these GIs are governed by Regulation No 1308/2013 for wines and by Regulation No 110/2008 for spirits.

With regard to agricultural products and other foodstuffs, only in 1992, after an intense pressure from the "agricultural" Member States[161], the EU adopted Regulation No 2081/1992 establishing for the first time a uniform GI system for foodstuffs. This Regulation introduced two categories of protected names: geographical indications and designations of origin, it gave users the exclusive privilege to use the registered geographical name and it required the state to prevent any direct or indirect commercial use of that name to comparable products[162]. This Regulation was first modified in March 2006, as a result of a ruling of the WTO

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[159] Council Regulation (EEC) 817/70 of 28 April 1970 laying down special provisions relating to quality wines in specified regions, 1970 O.J. L 99. See WIPO/GEO/SOF/09/4, *EU system for geographical indications for agricultural products and foodstuffs*, paper presented at the Worldwide Symposium on Geographical Indications, jointly organised by the World Intellectual Property Organization (WIPO) and the Patent Office of the Republic of Bulgaria, Sofia, June 10 to 12, 2009.

[160] Council Regulation (EEC) No 1576/89 of 29 May 1989 laying down general rules on the definition, description and presentation of spirit drinks, 1989 O.J. L 160. See OriGin, *Study on geographical indications protection for non-agricultural products in the internal market,* Final Report, 18 February 2013, available at http://ec.europa.eu/internal_market/indprop/docs/geo-indications/130322_geo-indications-non-agri-study_en.pdf.

[161] Namely: Italy, France, Greece, Spain and Portugal. See D. THUAL – F. LOSSY, *Q&A Manual European Legislation on Geographical Indications,* EU-China IPR2, February 2011, p. 66, available at http://ec.europa.eu/agriculture/events/2011/gi-africa-2011/q-a-manual_en.pdf.

[162] Council Regulation (EEC) No 2081/1992 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, 1992 O.J. L 208/1. See K. STAROSTINA, *Protected Geographical Indications: scope of protection vis-à-vis comparable products and criteria for defining comparable products, op. cit.*, p. 17.

Panel in 2005[163], and more recently in November 2012 with several important changes concerning the GI registration procedure and the opposition period. However it is worth mentioning that the scope of protection, including the relationship between TMs and GIs, has not changed since 1992.

1.1.2 *Regulation No 1151/2012 on quality schemes for agricultural products and foodstuffs*

Regulation No 1151/2012 on quality schemes for agricultural products and foodstuffs is designed to help producers of products linked to a geographical area by securing fair returns for the qualities of their products, by ensuring uniform protection of the names as IPRs in the territory of the Union and by providing clear information concerning the added value of their products to consumers[164].

This Regulation applies to: agricultural products intended for human consumption listed in Annex I to the TFUE (e.g. meat, fish, fruit, vegetables, etc.) and other agricultural products and foodstuffs referred to in Annex I of the Regulation (e.g. beer, bread, pastry, salt, hay, essential oils, cotton etc.). It does not apply to spirit drinks, aromatised wines or grapevine products as defined by Regulation (EC) No 1234/2007[165] that are covered by other, already mentioned, *sui generis* laws[166], the provisions of which are, however, substantially similar to those

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[163] WTO Panel Report, EC – Protection of Trademarks and Geographical Indications for agricultural products and other foodstuffs, WT/DS/174/R, 15 May 2005. In this case the US and Australia were complaining against Regulation (EC) No 2081/92. The WTO Panel Report of 15 March 2005 covered two main issues. First, the WTO examined some of the basic steps of the EC Regulation regarding the GI registration process in relation to third countries' GIs, ruling that the EU system was not compliant with the National Treatment rule contained in Article 3 of the TRIPs Agreement. Second, the WTO faced the significant issue of the relationship between TMs and GIs ruling that co-existence between a prior TM and a latter GI, as stated in the EC Regulation, was justified under Article 17 of the TRIPs Agreement. The opinion of the WTO Panel was so balanced that both the EC and the US did not appeal. However, the Panel Report itself was not completely satisfactory, leaving open many important questions, including a deeper understanding of the TRIPs concept of GIs. Anyhow, as a consequence, the EC enacted a new regulation (Council Regulation (EC) No 510/2006) in order to implement the recommendations of the Panel regarding registration and objection procedure. See M.A. ECHOLS, *Geographical Indications for Food Products: International Legal and Regulatory Perspectives,* Kluwer Law International, Netherlands, 2008, p. 203. See also https://www.wto.org/english/tratop_e/dispu_e/cases_e/ds174_e.htm and https://www.wto.org/english/tratop_e/dispu_e/cases_e/1pagesum_e/ds174sum_e.pdf.

[164] Regulation (EU) 1151/2012, Article 4.

[165] Regulation (EU) 1151/2012, Article 2.

[166] Namely Regulation No 1308/2013 for wines and Regulation No 110/2008 for spirit drinks.

of Regulation 1151/2012. Precisely in light of this similarity most of the description provided below can be generalised for analysis. Small differences remain.

The EU legislation on agricultural products and foodstuffs is based on two main categories of protected names: Protected Designations of Origin (PDO) and Protected Geographical Indications (PGI)[167]. For qualifying as PDOs or PGIs respectively the Regulation requires the registration of the name in a dedicated register[168] and the effectiveness of the said protection starts from the time of registration[169].

According to Article 5.1 a PDO is a name which identify agricultural products and foodstuffs originating in a specific place, region or exceptionally a country, whose quality or characteristics are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors and whose production steps take place all in the defined geographical area[170]. Thus in order to qualify for a PDO, there must be a very close and objective link between the territory and the specific characteristics of the product and all the steps from the production of the raw materials until the preparation of the final product must take place in the specified geographical area[171]. Nevertheless, cases where raw materials for the products concerned come from a larger or different geographical area can be exceptionally allowed if the production area of those raw materials is limited and if the production itself is a result of special conditions[172].

Whereas a PGI, as defined by Article 5.2, is a name which identifies agricultural products and foodstuffs originating in a specific place, region or country, whose given quality, reputation or other characteristics is essentially attributable to its geographical area and whose production steps take place only partially in the

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[167] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin*, *op. cit.*, p. 60.

[168] Regulation (EU) 1151/2012, Article 11.

[169] Regulation (EU) 1151/2012, Recital (24).

[170] Regulation (EU) 1151/2012, Article 5 paragraph 1.

[171] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin*, *op. cit.*, p. 61. See also T. JOSLING, *The war on Terroir: Geographical Indications as a Transatlantic Trade Conflict*, *op. cit.*, p. 8.

[172] Regulation (EU) 1151/2012, Article 5 paragraph 3.

specified geographical area[173]. This means that in order to qualify for a PGI a link between the territory and the specific characteristics of the product is essentially but not exclusively due to the origin and that only one of the stages of production, processing or preparation must take place in the defined geographical area[174]. It is immediately evident here the similarity between the PGI as defined in EU law and the GI as defined in Article 22 of the TRIPs Agreement[175].

Although there are two types of protected names, PDOs and PGIs, the level of protection provided for by the EU Regulation is the same. In fact, under Article 13 paragraph 1, all registered names are protected against: (a) any direct or indirect commercial use of a registered name in respect of non-originating products where those products are comparable to the product registered under the name[176] or where using the name exploits the reputation of the protected name, including when the product is used as an ingredient; (b) any misuse, imitation or evocation, even if the true origin of the product is indicated or if the protected name is used in translation or with expressions such as "style", "type, "method", "imitation" or the like, including when those products are used as an ingredient; (c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product that is used on the packaging, advertising material or documents related to the product in question, liable to convey a false impression as to its origin; (d) any other use capable to mislead the consumer as to the true origin of the product[177]. The consequence of these prohibition is that registered GIs are protected from becoming generic[178]. In fact, according to the same Article: "protected designations of origin

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[173] Regulation (EU) 1151/2012, Article 5 paragraph 2.

[174] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin*, *op. cit.*, p. 61. See also T. JOSLING, *The war on Terroir: Geographical Indications as a Transatlantic Trade Conflict*, *op.cit.*, p. 9.

[175] L. LOURDAIS, *Overview of the EU GIs system of protection and its benefits, op. cit.*.

[176] Here the scope of protection will mainly depend on the interpretation of "comparable products". See K. STAROSTINA, *Protected Geographical Indications: scope of protection vis-à-vis comparable products and criteria for defining comparable products, op. cit.*, p. 18.

[177] Regulation (EU) 1151/2012, Article 13 paragraph 1.

[178] K. W. WATSON, *Reign of Terroir: How to resist Europe's Efforts to Control Common Food Names as Geographical Indications*, Cato Institute, No. 787, February 16, 2016, p. 5, available at: http://object.cato.org/sites/cato.org/files/pubs/pdf/pa787.pdf

and protected geographical indications shall not become generic"[179]. This important provision has been carried out from the Lisbon Agreement[180].

The protection provided for by Article 13 covers both PDOs and PGIs and, as the ECJ noted, it refers to "various situation in which the marketing of a product is accompanied by an explicit or implicit reference to a geographic indication in circumstances liable to mislead the public as to the origin of the product or, at the very least, to set in the mind of the public an association of ideas regarding that origin, or to enable the trader to take unfair advantage of the reputation of the geographical indication concerned"[181]. As can be seen, the scope of protection is quite broad because confusion between the GI and the challenged name is not required for claiming the violation. In fact, PDOs and PGIs are protected against misuse, imitation, evocation[182], even if the true origin of the product is indicated, or if the protected name is translated or accompanied by expressions such as "style", "type", etc. This means that the protection would cover cases such as "taste like Feta" or "produced using the same methods as Asiago cheese" or "Gorgonzola made in the US" or "Parmesan[183]"[184]. This level of protection clearly resembles the one provided for by Article 23 of the TRIPs Agreement in relation to wine and spirit GIs.

Moreover, Article 13 paragraph 3 requires Member States to take appropriate administrative steps, besides the ordinary judicial remedies, in order to prevent or stop the unlawful use of the PDO and PGI produced or marketed within the Member State concerned. Thus GIs benefit from *ex officio* enforcement within the EU,

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[179] Regulation (EU) 1151/2012, Article 13 paragraph 1.

[180] T. WATTANAPRUTTIPAISAN, *Trademarks and Geographical Indications: Policy Issues and Options in Trade Negotiations and Implementation*, in *Asian Development Review*, Vol. 26, No. 1, 2009, p. 184.

[181] Bureau national interprofessionel du Cognac v. Gust. Ranin Oy, Joined Cases C-4/10 & C-27/10, (2011) E.C.R. I-06131, paragraph 46.

[182] The concept of evocation "covers a situation where the term used to designate a product incorporates part of a protected designation, so that when the consumer is confronted with the name of the product, the image triggered in his mind is that of the product whose designation is protected". Consorzio per la Tutela del Formaggio Gorgonzola v. Käserei Champignon Hofmeister GmbH&Co. KG and Eduard Bracharz GmbH, Case C-87/97, (1999) E.C.R. I-01301, paragraph 25.

[183] See Commission of the European Communities v. Federal Republic of Germany, Case C-132/05, (2008) E.C.R. I-00957, concerning the use of the name "parmesan".

[184] See in this context: H. MACQUEEN – C. WAELDE – G. LAURIE, *Contemporary Intellectual Property: Law and Policy,* Oxford University Press Inc., New York, 2008, p. 204.

meaning that each Member State shall establish a system by which public authorities are responsible for ensuring GI protection[185].

Another important issue in defining the scope of protection provided to GIs concerns their relationship with TMs. If a conflict between a TM and a GI arises, the EU system shifts the balance in favour of the GI, on the basis of its collective nature. According to Article 6.4 and Article 14 of the Regulation, a GI can be registered and can co-exist with a prior TM - i.e. a TM applied for, registered or used in good faith, prior to the GI - unless the TM in question is so well-known that the consumer would be mislead as to the true identity of the product[186], thus overruling the "first in time, first in right" principle, typical of the trademark system. On the contrary, a prior registered GI always prevents later TM registrations in relation to a product of the same type[187].

There are also specific provisions concerning generic terms and homonyms. Article 41 of the Regulation provides that in order to establish whether a term has become generic or not, all the relevant factors have to be taken into account, notably, the existing situation in the area where the product is consumed and the national or

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[185] D. THUAL – F. LOSSY, *Q&A Manual European Legislation on Geographical Indications, op. cit.*.

[186] See Regulation (EU) 1151/2012, Article 14 paragraph 2 and Article 6 paragraph 4. The ECJ expressed itself on the matter in Bavaria NV and Bavaria Italia S.r.l. v. Bayerischer Brauerbund, Case C-343/07, (2009) E.C.R. I-05491, holding that prior registered TMs may coexist with the subsequently registered GIs. See also E. TIBERTI, *Geographical Indications and Trademarks: space for coexistence as an equitable solution,* in *Rivista di Diritto Alimentare,* Anno VII, No. 3, 2013, p. 67.

[187] See Regulation (EU) 1151/2012, Article 14 paragraph 1. See Bavaria NV v. Bayerischer Brauerbund eV, Case C-120/08, (2010) E.C.R. I-13393, paragraph 36-37-38.

Union legal acts[188]. Generic names shall not be registered as PDOs or PGIs[189]. On the other hand, according to Article 6 of the Regulation, a name proposed for registration that is homonymous with a name already registered may exceptionally be entered in the register if there is sufficient distinction in practice between the two as to avoid consumer confusion.

That being said, the fact that the EU system puts particular emphasis on the link between the specific characteristics of a certain product and its geographical origin is reflected in the text of Article 7 of the Regulation[190] according to which applications for registration of GIs must contain the so called "product specifications", that include, among other elements, details establishing the link between the quality, other characteristics or the reputation and the geographical origin referred to in Article 5 paragraph 1 and 2[191] as well as a detailed description of the product with its raw materials and its main physical, chemical, microbiological or organoleptic

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[188] A detailed examination of genericity was made for the registration of the PDO "feta" from Greece. In particular see, Federal Republic of Germany and Kingdom of Denmark v. Commission of the European Communities, Joined Cases C-465/02 & C-466/02 25, (2005) E.C.R. I-09115, paragraph 21-87-88. In this case the Federal Republic of Germany and the Kingdom of Denmark applied for the annulment of the Commission Regulation (EC) No 1829/2002, which registered the name "feta" as a PDO, on the basis of its genericity. The Court dismissed the action on the basis of the following considerations: "according to the information sent by the Member States, those cheeses actually bearing the name 'Feta' on Community territory generally make explicit or implicit reference to Greek territory, culture or tradition, even when produced in Member States other than Greece, by adding text or drawings with a marked Greek connotation. The link between the name 'Feta' and Greece is thus deliberately suggested and sought as part of a sales strategy that capitalises on the reputation of the original product, and this creates a real risk of consumer confusion. Labels for 'Feta' cheese not originating in Greece but actually marketed in the Community under that name without making any direct or indirect allusion to Greece are in the minority and the quantities of cheese actually marketed in this way account for a very small proportion of the Community market." (Paragraph 21 of the Judgment). On these grounds the Court inferred that consumers in Member States other than the Hellenic Republic perceived feta as a cheese associated with the Hellenic Republic, even if in reality it was produced elsewhere and therefore the Court concluded that the name "feta" was not generic in nature.

[189] See Regulation (EU) 1151/2012, Article 6 paragraph 1. In this context it is of interest to mention the opinion of Advocate General Eleanor Sharpston with regard to generic terms: "...unless and until the Commission rejects an application specifically on that ground, it cannot be said that the name has been found to be generic within the meaning of the Regulation. Nor can be any basis for assuming that a geographical name is generic until it has been held not to be so". Therefore a designation cannot be presumed to be generic for as long as the Commission has not taken a decision on the application for registration of the designation, as the case may be, by rejecting it on the specific ground that designation has become generic. See Opinion of Advocate General Sharpston, Alberto Severi v. Regione Emilia Romagna, Case C-446/07, (2009) E.C.R. I-08041, paragraph 36-37.

[190] See B. O'CONNOR, *Geographical Indications: Some thoughts on the practice of the US Patent and Trademark Office and TRIPs, op. cit.*, p. 715.

[191] Regulation (EU) 1151/2012, Article 7 paragraph 1 letter (f).

characteristics[192]. The product's compliance with these specifications is then verified by a competent public authority or by a product certification body responsible for official controls designated by each Member State in accordance with Regulation (EC) No 882/2004[193]. The competent authorities, with adequate guarantees of objectivity, impartiality and specific knowledge, have the duty to ensure that the PDO or the PGI meet all the legal requirements for registration[194].

Coming now to procedural aspects, registration can be requested by groups who work with the products bearing the name to be registered[195] and only exceptionally by a single natural or legal person[196]. The registration proceeding starts with a national phase, where national authorities examine the application in order to check whether it is justified according to the conditions set out in the Regulation and where opposition to the application for registration can be filed. If the application has positively passed the national level, the competent national authorities take a favourable public decision and lodge an application dossier with the Commission[197]. At this point the Commission scrutinises the application one more time, and if the requirements are fulfilled, publishes the application on the Official Journal of the European Union (OJEU)[198]. Within three months from the date of publication, anyone having a legitimate interest established in Member States different from the one where the application originates or in third States may lodge a notice of opposition with the Commission[199]. Grounds of opposition include the fact that the name does not have the characteristics of a PDO or PGI, it has become generic or it

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[192] Regulation (EU) 1151/2012, Article 7 paragraph 1 letter (b).

[193] Regulation (EU) 1151/2012, Article 36 paragraph 1 and 3.

[194] Regulation (EU) 1151/2012, Article 36 paragraph 1 and 2.

[195] Regulation (EU) 1151/2012, Article 49 paragraph 1 part 1.

[196] Regulation (EU) 1151/2012, Article 49 paragraph 1 part 2 states as follow: "A single natural or legal person may be treated as a group where it is shown that both of the following conditions are fulfilled:
(a) the person concerned is the only producer willing to submit an application;
(b) with regard to protected designations of origin and protected geographical indications, the defined geographical area possesses characteristics which differ appreciably from those of neighbouring areas or the characteristics of the product are different from those produced in neighbouring areas".

[197] Regulation (EU) 1151/2012, Article 49.

[198] Regulation (EU) 1151/2012, Article 50.

[199] Regulation (EU) 1151/2012, Article 51.

would jeopardise the existence of an identical well-known trademark. However, if the Commission takes a favourable decision, the name is registered and entered into the European Register of Protected Geographical Indications and Designation of Origin (DOOR database) and the registration is published on the Official Journal of the EU[200]. Also non-EU GIs can be registered on the EU registry as long as they are recognised as GIs in the country of origin. In this case the applications have to be sent directly from the applicant to the Commission of the EU or *via* the appropriate competent authority of the third country[201].

In conclusion, the EU regime on the protection of GIs emphasis the concept of *terroir* pointing out the essential link between the location where the good is produced and its quality[202]. This results *ictu oculi* from the definition of PDO and PGI, from the product specifications required to submit an application for registration, and from the specific controls of compliance made by impartial and independent authorities.

1.1.3 *Regulation No 1308/2013 establishing a common organisation in agricultural products and Regulation No 110/2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks*

Wines are protected under Regulation (EU) 1308/2013 establishing a common organisation for markets for agricultural products[203] the provisions of which are, as said before, substantially similar to those of Regulation (EU) 1151/2012 for agricultural products and foodstuffs. In particular, important similarities concern the definitions of PDO and PGI, although the specificity of the wine sector is taken into account; the scope of protection, including the relationship with trademarks, generic terms and homonyms; the administrative enforcement of the protection; the registration procedure, including the application's requirements, and the

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[200] Regulation (EU) 1151/2012, Article 52.

[201] Regulation (EU) 1151/2012, Article 8 and 49.5. In this context see D. THUAL – F. LOSSY, *Q&A Manual European Legislation on Geographical Indications, op. cit.*, p. 27.

[202] See above Chapter I, paragraph 1.

[203] Regulation (EU) 1308/2013.

establishment of a publicly accessible electronic register of PDO and PGI[204]. Nevertheless an important difference between the two Regulations remains: while Regulation 1151/2012 supersedes national *sui generis* legislation[205], Regulation 1308/2013 bears the co-existence of national and EU protection systems provided that national requirements are compatible with Union law [206].

On the other hand, GIs for spirits are protected under Regulation (EC) 110/2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks[207] the provisions of which differ more consistently from the ones of Regulation 1151/2012. In fact, contrary to the European legislation on GIs for agricultural products and foodstuffs and for wines, the spirits Regulation does not differentiate between PDOs and PGIs, providing only a definition for Geographical Indications[208]. Also the registration procedure is significantly different from the one designed for wines and other agricultural products: although it is up to the Member State to send the request for registration to the European Commission, there is no provision with regard to a national phase, only the European registration procedure is taken into account. Finally, as for the wine sector, the co-existence of national and EU protection systems is allowed. However, the scope of protection, including the relationship with trademarks, generic terms and homonyms, the controls on the production process by competent impartial authorities, the establishment of a publicly accessible electronic register and the

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[204] See European Commission - DG-AGRI, *Foodstuffs, wine, and spirit GIs: a comparison of applicable legislation,* Doc.03, October 2014, available at http://ec.europa.eu/transparency/regexpert/index.cfm?do=groupDetail.groupDetailDoc&id=15842&no=3. See also DG-AGRI, background paper to the Green Paper on agricultural product quality, October 2008, p. 5, available at http://ec.europa.eu/agriculture/quality/policy/workingdocs/gi_en.pdf.

[205] Regulation (EU) 1151/2012, Recital (24).

[206] Regulation (EU) 1308/2013, Article 94 paragraph 2 letter (h).

[207] Regulation (EC) 110/2008.

[208] Regulation (EC) 110/2008, Article 15: "for the purpose of this Regulation a geographical indications shall be an indication which identifies a spirit drink as originating in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of that spirit drink is essentially attributable to its geographical origin".

administrative enforcement of the protection is almost the same as the one provided for by Regulation 1151/2012[209].

Of course, both for wines and spirits as it is for agricultural products and foodstuffs, the qualification of the name as PDO, PGI or GI and its effective protection depends on the positive registration of the said name in the dedicated register[210].

1.2 TRIPs-Plus level of protection

Given that TRIPs provisions can be implemented by any appropriate means by each WTO Member, the first question to be addressed after this analysis of the EU Regulations on the protection of GIs is whether the EU *sui generis* system is compliant with the TRIPs *minimum standard* provided for by Articles 22, 23 and 24 and, as the case may be, whether it goes beyond these provisions assuring a higher level of protection.

Starting from a comparison with the definition of GIs contained in Article 22 of the TRIPs[211], the first thing that stands out is that, whereas the TRIPs talks generally about "goods", the EU *sui generis* Regulations only refer to agricultural products, wines and spirits GIs. This EU sector-based approach, cutting out goods other than food products, like handicrafts, may hence appear not fully compliant with the TRIPs commitments. That said, as for the substance of the definition of GIs, in light of the language used in the EU Regulations for defining PDOs, PGIs and GIs and in light of the product specifications required to submit an application, the EU system seems to be perfectly respectful of the TRIPs requirement that an essential link between a given quality, other characteristic or at least a reputation of the product and its

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[209] See European Commission – DG Agriculture, *Foodstuffs, wine, and spirit GIs: a comparison of applicable legislation*, *op. cit.*. See also DG-AGRI, Green Paper working document on Geographical Indications, *op. cit.*, p. 5.

[210] See Regulation (EU) 1308/2013 and Regulation (EC) 110/2008.

[211] See above Chapter I, paragraph 3.6.

geographical origin be showed and proved (the so called "essentially attributable test")[212].

Also the *ex officio* enforcement provided for by the EU Regulations can be regarded as fully compliant with the TRIPs implementation system as described in Article 22.3[213].

On the other hand, the level of protection of GIs, as set up by the EU Regulations, not only respects the TRIPs *minimum standard* of Article 22 and 23 but goes further, providing a higher level of protection against wrongful uses[214]. In fact, while the TRIPs Agreement is based on two different levels of protection, a basic protection for agricultural products and an additional protection for wines and spirits[215], EU Regulation 1151/2012 *de facto* extends the additional protection provided for by Article 23 with regard to wines and spirits to agricultural products and other foodstuffs creating a unique and uniform standard of protection. Article 13 of Regulation 1151/2012 on agricultural products, reflecting the text of Article 23 of the TRIPs, prevents third parties from using a protected GI to designate their products even where the consumer is not misled as to the true origin of these products, i.e. even where the true origin of the good is indicated or the GI is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like[216]. For this reason the EU is said to have in place a "TRIPs-plus" level of protection.

The last issue to be considered concerns the relationship between TMs and GIs as established in the EU Regulations[217]. Is the principle of co-existence between a prior TM, as long as it has been applied for, registered or established by use in good

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[212] B. O'CONNOR, *Geographical Indications: Some thoughts on the practice of the US Patent and Trademark Office and TRIPs, op. cit.*, p. 715.

[213] TRIPs Agreement, Article 22 paragraph 3 states as follow: "A Member shall, *ex officio* if its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in that Member is of such nature as to mislead the public as to the true place of origin".

[214] L. LOURDAIS, *Overview of the EU GIs system of protection and its benefits, op. cit.*.

[215] See above Chapter I, paragraph 3.6.

[216] See above paragraph 1.1.2.

[217] See above paragraph 1.1.2, namely Regulation (EU) 1151/2012, Article 14 paragraph 2.

faith, and a later GI, compliant with the TRIPs Agreement? This question was raised before the WTO Panel by the United States and Australia in 2003[218]. The US alleged the lack of protection for trademarks on the basis that the principle of co-existence as stated in EC Regulation 2081/1992 would have undermined the exclusive right of the owner to prevent others to use the registered trademark as provided for by Article 16.1 of the TRIPs[219]. The decision of the Panel circulated on 15 March 2005 found that the exception to the trademark's owner rights under EC Regulation 2081/1992 was inconsistent with Article 16.1 but was justified as a permissible limited exception under TRIPs Article 17 as the use of a later GI, on the basis of the evidence presented to the Panel, was considered as fair use of descriptive terms[220]. According to many distinguished authors, it seems that the Panel accepted that the TRIPs provides for two different forms of intellectual property without any superiority of TMs over GIs, neither of GIs over TMs[221] and that the Panel endorsed the principle of co-existence between TMs and GIs as established under EU legislation[222]. As a result, the EU provisions can be regarded as compliant with the TRIPs obligations also in relation to this issue.

1.3 The EU approach reflected in the FTAs signed by the EU and third countries

The main objective of the EU trade policy concerning EU GIs is to obtain a satisfactory level of protection at international level, meaning a level of protection similar to that offered by the EU domestic system. Quite frequently EU GIs products

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[218] WTO Panel EC – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs, WT/DS/174/290, 15 May 2005.

[219] WTO Panel EC – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs, WT/DS/174/290, 15 May 2005.

[220] See WTO website, *Dispute Settlement: one-page case summaries,* at https://www.wto.org/english/tratop_e/dispu_e/cases_e/ds174_e.htm.

[221] B. O'CONNOR, *Geographical Indications in TTIP, The TransAtlantic Trade and Investment Partnership*, *op. cit.*.

[222] M.A. LOUCKS, *Trademarks and Geographical Indications: Conflict or Coexistance?,* Doctoral Thesis, M.A.Wilkinson (supervised by), The University of Western Ontario, Canada, September 2012, p. 80. See also D. GANGJEE, *Quibbling Sibling: Conflicts between Trademarks and Geographical Indications,* in *Chicago-Kent Law Review,* Vol. 82, Art. 6, 2007. See also E. TIBERTI, *Geographical Indications and Trademarks: space for coexistence as an equitable solution, op. cit.*, p. 70. For a different perspective see B. GOEBEL – M. GROESCHL, *The long road to resolving conflicts between Trademarks and Geographical Indications,* in *The Trademark Reporter,* Vol. 104, No. 4, 2014.

with high economic value suffer from usurpation or abuse of reputation in third markets (e.g. "Feta", "Gorgonzola", "Asiago", "Parma ham", "Champagne"). This is due to the fact that often the level of protection of GIs in other WTO countries is limited to TRIPs basic provisions, i.e. Article 22, which can be considered not to be sufficient to protect misuse, imitation and evocation of EU GIs at least for agricultural products and foodstuffs[223].

Precisely in order to reach this goal, the EU, within the WTO Doha Development Round (DDR) of 2001, had demanded that the protection of Article 23 of the TRIPs be extended from wines and spirits to agricultural products and that a multilateral system of notification and registration for wines and spirits be created. However the proposal had not made much progress due to the strong opposition of some countries, namely the US, Australia and Chile[224].

Since the EU considers that the TRIPs does not offer a satisfactory protection for EU GIs, the EU has sought to achieve its objectives through a variety of bilateral and multilateral international agreements[225]. The "TRIPs-plus" level of protection pursued by the EU in international negotiations means, in particular: the establishment of an open list of EU names to be protected directly and indefinitely in the third country (including controversial expression such as "Feta", "Prosciutto di Parma", "Champagne" and "Porto") from the entry into force of the agreement; the extension of the higher protection of Article 23 to products other than wines and spirits; the co-existence with prior trademarks if they were registered in good faith;

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223 DG-AGRI, working document on international protection of EU Geographical Indications: objectives, outcome and challenges, Ref. Ares(2012)669394–06/06/2012, Advisory Group International Aspect of Agriculture, Meeting of 25 June 2012, p. 8, available at http://ec.europa.eu/agriculture/consultations/advisory-groups/international/2012-06-25/agri-working-doc_en.pdf. See also E.O. CÀCERES, *Perspectives for Geographical Indications* in *International Symposium on Geographical Indications,* pp. 6-7.

224 B. O'CONNOR – L. RICHARDSON, *The Legal Protection of Geographical Indications in the EU's Bilateral Trade Agreements: moving beyond TRIPS,* in *Rivista di Diritto Alimentare,* Anno VI, No. 4, 2012, pp. 1-2.

225 B. O'CONNOR – L. RICHARDSON, *The Legal Protection of Geographical Indications in the EU's Bilateral Trade Agreements: moving beyond TRIPS, op. cit.*, p. 2. See also A. LUPONE, *Il dibattito sulle indicazioni geografiche nel sistema multilaterale degli scambi: dal Doha Round dell'organizzazione mondiale del commercio alla protezione TRIPs plus*, in *Le indicazioni di qualità degli alimenti*, B. Ubertazzi - E.M. Espada (eds.), Giuffrè Editore, Milano, 2009, p. 38.

the phasing out of prior generic EU names; the attempt to limit the extensive use of Article 24 TRIPs exceptions and the obtainment of an *ex officio* protection[226].

Before examining the state of play of EU bilateral agreements, it is important to remind that such a "TRIPs-plus" approach in international negotiations is authorised by Article 24.1 of the TRIPs which states that Members may enter into negotiations aimed at increasing the protection of individual GIs under Article 23 and that the exceptions provided in Article 24 shall not be used by a Member to refuse to conclude bilateral or multilateral agreements[227].

The first approach adopted by the EU to negotiate GI protection was based on specific "stand alone" agreements such as the "10 plus 10 project" with China[228] and bilateral "old generation" agreements on wines and spirits[229]. More recently, instead, the EU preferred to deal with the protection of GIs by inserting an IPR chapter in broader trade agreements such as Economic Partnership Agreements (EPAs)[230] and

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[226] DG-AGRI, working document on international protection of EU Geographical Indications: objectives, outcome and challenges*, op. cit.*, pp. 8-9. See also D.V. EUGUI – C. SPENNEMANN, *The Treatment of Geographical indications in recent Regional and Bilateral Free Trade Agreements,* in *The Intellectual Property Debate: Perspectives from Law, Economics and Political Economy*, *op.cit.*, pp. 312 ss.. See also M. HANDLER – B. MERCURIO, *Intellectual Property,* in *Bilateral and regional trade agreements: commentary and analysis*, S. Lester – B. Mercurio (eds.), New York , Cambridge University Press, 2015 (2nd edit.), p. 334.

[227] D.V. EUGUI – C. SPENNEMANN, *The Treatment of Geographical indications in recent Regional and Bilateral Free Trade Agreements, op. cit.*, p. 308.

[228] European Commission Press Release, *EU-China Geographical Indications - "10 plus 10" project is now complete*, IP/12/1297, Brussels, November 30, 2012.

[229] e.g. see the Agreement between the European Community and Australia on trade in wine (1994, renewed in 2008), 2009 O.J. L 28/13; the Agreement between the European Community and the United Mexican States on the mutual recognition and protection of designation for spirit drinks, 1997 O.J. L 152/16; the Agreement establishing an association between the European Community and its Member States, of the one part, and the Republic of Chile, of the other part, 2002 O.J. L 352; the Agreement between the European Community and the Republic of South Africa on trade in wine, 2002 O.J. L 28; the Agreement between the European Community and Canada on trade in wines and spirit drinks, 2004 O.J. L 35/3 and the Agreement between the European Community and the United States of America on trade in wine, 2996 O.J. L 87/2. The purpose of these "old generation" agreements was to provide for the mutual recognition of specific EU GIs as well as to phase out the use of specific wine and spirit terms of EU origin, which had acquired "generic" status in the partner countries. See B. O'CONNOR – L. RICHARDSON, *The Legal Protection of Geographical Indications in the EU's Bilateral Trade Agreements: moving beyond TRIPS, op. cit.*, p. 5.

[230] EPA negotiations have been concluded with African, Caribbean and Pacific Group countries (ACP, 2000). See the Partnership Agreement between the members of the African, Caribbean and Pacific Group of States of the one part, and the European Community and its Member States, of the other part, 2000 O.J. L 317/3. See B. O'CONNOR – L. RICHARDSON, *The Legal Protection of Geographical Indications in the EU's Bilateral Trade Agreements: moving beyond TRIPS, op. cit.*, p. 4.

Free Trade Agreements (FTAs)[231]. In particular, "new generation" FTAs, because of their comprehensive nature, constitute an occasion to go beyond the WTO rules by tackling issues that are not ready for multilateral discussion, serving in this way as a stepping stone for the next level of multilateral agreement[232]. The first of such WTO-plus FTA was signed with South Korea in October 2010 and entered into force in July 2011. Since it was the first of a long series of FTAs it was extremely important for the EU to reach the maximum of its negotiating objectives in the final text of the agreement. In fact the EU managed to obtain: the mutual recognition of over 226 GIs with the possibility of future addition from the lists provided, the extension of Article 23 TRIPs to agricultural products and foodstuffs, the co-existence of GIs and prior TMs and the administrative enforcement of the protection[233]. This FTA can hence be regarded as a very good and successful example of EU negotiations to expand the protection of GIs.

However, the negotiating context regarding GIs in an FTA may vary from one third country to another, depending on its historical tradition and sympathy for GIs, agricultural tradition or trademark tradition. Generally speaking, when the negotiating countries do not have a GI tradition, e.g. the US, Canada and Singapore,

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[231] e.g. see the Free Trade Agreement between the European Union and its Member States, of the one part , and the Republic of Korea, of the other part, 2011 O.J. L 127/6; the Trade Agreement between the European Union and its Member States, of the one part, and Colombia and Peru, of the other part, 2012 O.J. L 354/3; the Agreement establishing an Association between the European Union and its Member States, on the one hand, and Central America on the other, 2012 O.J. L 346/3. As FTAs concluded but not yet entered into force see: the Comprehensive Economic and Trade Agreement (CETA) between the European Union and Canada, 2014; the Free Trade Agreement between the European Union and the Republic of Singapore, 2014; the Free Trade Agreement between the European Union and Vietnam, 2015. See B. O'CONNOR – L. RICHARDSON, *The Legal Protection of Geographical Indications in the EU's Bilateral Trade Agreements: moving beyond TRIPS, op. cit.*, p. 7.

[232] European Commission, Communication from the Commission to the Council, the European Parliament, the European Economic and Social Committee and the Committee of the Region - Global Europe - Competing in the world - A contribution to the EU's Growth and Job Strategy, COM(2006) 567, Brussels, 4 October 2006, p. 10.

[233] B. O'CONNOR – L. RICHARDSON, *The Legal Protection of Geographical Indications in the EU's Bilateral Trade Agreements: moving beyond TRIPS, op. cit.*, p. 11.

the discussions are much more difficult and it is really challenging for the EU to reach a satisfactory agreement[234].

That said, what is happening today, placing another obstacle to the EU trade policy, is that these "no GI countries", such as the US, are negotiating, with the same countries with which the EU is negotiating, obligations on GIs which are often in conflict with what has been agreed in the EU trade agreements[235]. Thus third countries, negotiating and agreeing with both the US and the EU may find themselves with conflicting commitments.

This problem is the focus of Chapter III and IV of this thesis with particular attention being paid to the EU-South Korea FTA and its relationship with the US-South Korea FTA.

2. Protection of GIs in the United States

2.1 Trademark Regime

The US government does not currently recognise GIs as a separate form of intellectual property right but as a subset of TMs[236]. In fact, according to the view of the United States Patent and Trademark Office (hereinafter referred to as USPTO) GIs serve the same functions as TMs considering that they are source-identifier, guarantees of quality and valuable business interests[237]. The US views its trademark

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234 DG-AGRI, working document on international protection of EU Geographical Indications: objectives, outcome and challenges, *op. cit.*, p. 10. See e.g. the text of the Comprehensive Economic and Trade Agreement (CETA) between the European Union and Canada, concluded in 2014, available at: http://trade.ec.europa.eu/doclib/docs/2014/september/tradoc_152806.pdf. In this FTA the parties have agreed that: some EU GIs will be protected in Canada but such protection will not impact on the ability of Canadian producers to use specified, commonly employed terms such as "Valencia orange" or "Bavarian beer"; the cheese names "asiago", "feta", "fontina", "gorgonzola" will be protected as GIs, but existing and future Canadian producers will be able to continue to use such terms as generic product descriptors, if accompanied by qualifiers such as "type" or "style"; certain EU GIs, such as "Bud! jovické", will not be protected at all in Canada.

235 DG-AGRI, working document on international protection of EU Geographical Indications: objectives, outcome and challenges, *op. cit.*, p. 10.

236 R. MENDELSON – Z. WOOD, *Geographical Indications in the United States: Developing a Preliminary List of Qualifying Product Names*, OriGIn, 2013, p. 1.

237 USPTO, *Geographical Indication Protection in the United States,* available at http://www.uspto.gov/sites/default/files/web/offices/dcom/olia/globalip/pdf/gi_system.pdf, (last viewed October 25, 2015).

system, inclusive of traditional trademarks, certification and collective marks, as adequately meeting the requirements of TRIPs with respect to GIs[238]. Thus, the protection of GIs in the US is based on the same *criteria* and rules applicable to TMs under the Trademark Act of 1946[239]. As a consequence, first, the scope of protection of GIs, being the same provided to TMs, is not limited to agricultural products but it covers any type of good and service. Second, there is no US statutory definition of GIs nor is there a special register for those TMs eligible to qualify as GIs under the TRIPs definition, and therefore, in the absence of a single list of US and foreign GIs[240], they can only be found by reviewing each registered mark.

The origin of such a different approach can be rooted in the US history[241], legal tradition and dominant economic theory according to which GIs have always been regarded primarily as property rights, as tool to assist the competitiveness of firms and producers groups. Unlike Europe there is much less emphasis on rural development or traditional systems. Hence, the US supports GIs *via* a private system of rights that tends toward exclusive ownership and private management of the right[242].

The US considers that its approach brings a series of advantages. First, employing the existing and familiar TM regime would be a benefit in terms of costs as it allows the use of structures already in place with no need to use additional resources. Second, it would satisfy the TRIPs requirements without any need for further implementation since, in addition to fulfilling all the requirements of Section 3 of the TRIPs Agreement, the use of the national trademark system would meet the

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[238] USPTO, *Geographical Indication Protection in the United States, op. cit.*.

[239] B. O'CONNOR, *Geographical Indications in TTIP, the TransAtlantic Trade and Investment Partnership*, *op. cit.*.

[240] R. MENDELSON – Z. WOOD, *Geographical Indications in the United States: Developing a Preliminary List of Qualifying Product Names*, *op. cit.*, p. 1.

[241] Historically the US has been a country that experienced heavy European immigration. Consequently, sometimes, immigrant business owners of European extraction took pre-existing European place names, they were familiar with, to distinguish their products. To legitimate this *phaenomenon* the only possibility was to consider GIs as TMs, as private right freely transferable and not necessarily linked to a specific place. See CONTALDI G., *Il conflitto tra Stati Uniti e Unione Europea sulla protezione delle indicazioni geografiche*, *op. cit.*, p. 30.

[242] D. GIOVANNUCCI - T. JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin*, *op. cit.*, pp. 64-65.

obligations regarding national treatment and enforcement. Third, this system, being self-policing, would prevent governments from committing additional resources to ensure compliance as infringement issues would be raised by private stakeholders. Finally, the US claims that Article 7 *bis* of the Paris Convention requires that Paris Union Members provide protection for collective marks and that this obligation is incorporated in Article 2.1 of the TRIPs; thus protecting GIs through registration as collective marks would use a system that is already required to exist by international law[243].

The main method of GI protection in the US is the certification mark[244]. Other means of protection exist, namely collective and traditional trademarks, but they are less conducive to GIs than certification marks[245] since they can only be used provided that specific additional conditions are met. However, unlike in the EU system, in the US, unregistered geographic denomination may be protected through common law[246].

But contrary to the approach in relation to all goods, in the wine sector, origin is recognised through a *sui generis* system of appellations of origin, administered by the Alcohol and Tobacco Tax and Trade Bureau (TTB), which is part of the US Treasury Department[247].

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[243] USPTO, *Geographical Indication Protection in the United States*, *op. cit.*, p. 2. See also WTO-Council for TRIPs, Communication from the United States, *Registration of Geographical Indications under Trademark Regimes as Collective or Certification Marks*, IP/C/W/134, March 11, 1999. See also B. O'CONNOR, *Geographical Indications in TTIP, the TransAtlantic Trade and Investment Partnership*, *op. cit.*.

[244] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG *Guide to Geographical Indications: linking products and their* origin*, op. cit.*, p. 66.

[245] E. BARHAM, *American Origin Products (AOPs): Protecting a Legacy*, OriGIn, Geneva, 2010, p. 26.

[246] A famous example is the GI "Cognac", analysed in Institute National Des Appellations v. Brown-Forman Corp., 47 USPQ, 2d, 1875, 1884, (TTAB 1998). The Board stated that "Cognac" is a valid common law regional certification mark, rather than a generic term, since purchasers in the US primarily understand the "Cognac" designation to refer to brandy originating in the Cognac region of France.

[247] E. BARHAM, *American Origin Products (AOPs): Protecting a Legacy*, *op. cit.*, p. 26. See also R. MENDELSON – Z. WOOD, *Geographical Indications in the United States: Developing a Preliminary List of Qualifying Product Names*, *op. cit.*, p. 2.

2.1.1 *Certification marks*

The central method of GI protection in the US, as already mentioned above, is the certification mark. A certification mark, according to the US federal law on trademarks[248] (also known as the Lanham Act), is a mark "used by a person other than its owner…to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organisation"[249]. Section 2(e)(2) of the same Act provides that geographic names or signs – which otherwise would be considered primarily geographically descriptive and therefore un-registrable as trademarks or collective marks in the US without showing acquired distinctiveness (also known as "secondary meaning"[250]) – can be registered as certification marks[251]. In other words, a certification mark composed by a geographical term that functions to certify that a product originates in the specific geographical region identified by the term do not require "acquired distinctiveness" or prior commercialisation as a source identifier to be registered[252]. This is not the case for traditional trademarks and collective marks.

Thus, the Lanham Act differentiates certification marks from trademarks mainly by two characteristics[253]. Firstly, certification marks can only be used by entities other than the owner of the mark, with the authorisation of the owner itself, provided that the products and services on which the mark is used meet the requirements and specifications as established by the owner and which might include, among others, a

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[248] 15 U.S.C. §.

[249] 15 U.S.C., § 1127.

[250] The primary meaning being the place of origin and the secondary meaning being the particular product or service.

[251] 15 U.S.C., § 1052(e)(2).

[252] E. BARHAM, *American Origin Products (AOPs): Protecting a Legacy*, *op. cit.*, p. 24. See also T.M.E.P. § 1306-05(a). See also Cmty of Roquefort v. William Faehndric, Inc. 303 F.2d 494, 497, 133 USPQ 633, 635 (2nd Cir. 1962) according to which: "a geographical name does not require a secondary meaning in order to qualify for registration as a certification mark".

[253] USPTO, *Geographical Indication Protection in the United States*, *op. cit.*, p. 3.

place of origin and/or a method of production[254]. It is the owner's duty to control the correct use of the mark on the certified goods or services under penalty of cancellation[255]. Secondly, certification marks, unlike traditional trademarks, do not indicate commercial source by distinguishing the goods or services of one undertaking from those of another, but they essentially convey to consumers that the goods or services of the authorised users have been examined and inspected by the owner. Thus the purpose of a certification mark is basically to inform purchasers that the certified goods possess certain qualifications or standards[256]. In fact any entity that meets the certifying conditions is entitled to use the certification mark[257].

Additionally, in the experience of the US, the owner and therefore the authority that exercises control over the use of the geographical term as a certification mark is usually a governmental body or a body operating with governmental authorisation rather than a private individual. In fact a public entity is in a best position to preserve the freedom of all persons in the region to use the term without discrimination[258].

That said, certification marks themselves do not necessarily meet the essential factors for recognition as GIs. For a certification mark to serve as a GI, the established standards must include not only a delimitated place of origin but also explicit specifications of the particular product[259]. Therefore, in the absence of a special register for those certification marks eligible to qualify as GIs under the TRIPs definition, GIs can only be found by reviewing each registered certification mark.

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254 D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin*, *op. cit.*, p. 66. See also T. MCCARTHY, *Trademarks and Unfair Competition,* § 19:91, 4th ed., West, U.S.A., 2009, in Westlaw database.

255 L. ALTMAN – M. POLLACK, *Callman on Unfair Competition, Trademarks and Monopolies,* § 17A: 15, 4th ed.,Thomson/West, U.S.A., 2007, in Westlaw database.

256 USPTO, *Geographical Indication Protection in the United States*, *op. cit.*, p. 3. See also T. MCCARTHY, *Trademarks and Unfair Competition*, *op. cit.*.

257 D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin*, *op. cit.*, p. 66.

258 USPTO, *Geographical Indication Protection in the United States*, *op. cit.*, p. 3. See also R. MENDELSON – Z. WOOD, *Geographical Indications in the United States: Developing a Preliminary List of Qualifying Product Names*, *op. cit.*, p. 3.

259 D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin*, *op. cit.*, p. 66.

However, in light of the rules and peculiarities of the certification mark, this form of protection seems to be the one that most resembles the European GI system. Nevertheless differences remain. First, the owner of the mark, unlike in the PGI and PDO system, can change the attributes required at any time. Second, beside the peculiarities pointed out, certification marks work mostly by the same rules as trademarks and therefore, unlike GIs, these marks are transferable and licensable, they can expire and be invalidated for non-use and for non-renewal and, as for the level of protection and for the enforcement, certification marks provide the owner of the mark the exclusive right to prevent the use of the mark by unauthorised parties that do not meet certification standards by means of private actions through judicial system[260].

2.1.2 *Traditional trademarks and collective marks*

As noted above, other choices for GI protection exist, namely traditional trademarks and collective marks. However they are less suitable to GIs than certification marks[261].

In fact, the purpose of traditional trademarks is to indicate a single commercial source and this function is barely applicable to geographically distinctive products which usually have a variety of producers. In fact, trademarks that include geographically descriptive terms may only be registered on the Principal Register if they have acquired distinctive character through "secondary meaning", so if consumers have come to associate the mark with a particular producer[262]. In this case the trademark registrant would have the exclusive right to use the term[263].

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[260] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin*, *op. cit.*, p. 83 ss.

[261] E. BARHAM, *American Origin Products (AOPs): Protecting a Legacy*, *op. cit.*, p. 26.

[262] 15 U.S.C. 1052(e)(2) prohibits the registration on the Principal Register of marks that are primarily geographically descriptive of goods or services.

[263] E. BARHAM, *American Origin Products (AOPs): Protecting a Legacy*, *op. cit.*, pp. 26-27.

Also collective marks with a geographical term may only be registered if they have developed "secondary meaning"[264]. However, unlike traditional trademarks, a collective mark belongs to public or private groups (e.g. trade associations or agricultural cooperatives) and its use requires membership in the group owning the mark[265]. The purpose of this mark is to distinguish the products of members from the ones of non-members, thus indicating commercial origin in a group rather than in a single individual[266]. However, collective marks have some elements that could resemble the *sui generis* approach: in fact, they are collectively owned and members should comply with a certain level of quality or other standards established by the association. Nevertheless there are some important differences: compliance control is carried out only internally by the group itself and not externally by certifying bodies as it happens for certification marks[267] and the association may discretionary deny membership to producers of identical qualified goods in the same geographical area.

Thus traditional trademarks and collective marks do not seem to be the best tool to protect GIs: first, because they may show a linkage with a geographical region only upon acquired distinctiveness, second, because this link is not definitively tied to the specific place since the mark can be transferred or licensed at anytime to anybody[268], third, because, once registered as a TM, a GI is no longer available for use by others producing identical goods in the same geographic area without prior consent of the owner of the mark[269].

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[264] B. O'CONNOR, *Geographical Indications in TTIP, the TransAtlantic Trade and Investment Partnership*, *op. cit.*. See also USPTO, *Geographical Indication Protection in the United States*, *op. cit.*, p. 5.

[265] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin*, *op. cit.*, p. 67.

[266] USPTO, *Geographical Indication Protection in the United States*, *op. cit.*, p. 5.

[267] I. KIREEVA - B. O'CONNOR, *Geographical Indications and the TRIPs Agreement: What Protection is Provided to Geographical Indications in the WTO Members?, op cit.*, p. 288.

[268] D. GIOVANNUCCI - T.JOSLING - W. KERR - B. O'CONNOR – M. T. YEUNG, *Guide to Geographical Indications: linking products and their origin*, *op. cit.*, pp. 83 ss.

[269] I. KIREEVA - B. O'CONNOR, *Geographical Indications and the TRIPs Agreement: What Protection is Provided to Geographical Indications in the WTO Members?, op. cit.*, p. 288.

2.1.3 *Implications of the trademark approach and its impact on international trade: major problems for European producers in ensuring protection of their GIs through trademarks*

The use of the trademark system for the protection of GIs implies the application to GIs of the main trademarks rules: the "first in time, first in right" principle; the cancellation of the registration for non-use or for non-renewal, the protection limited to confusingly similar marks, the self-policing enforcement and a different regime for genericity.

The strict application of the "first in time, first in right" principle, makes it extremely difficult for legitimate beneficiaries to secure protection for their GIs in the US. In fact, if a name identical or similar to a GI is registered as a trademark before the legitimate beneficiary by a third party with no genuine link with the geographical area at issue, the legitimate beneficiary cannot register his GI in the US. He can only request the cancellation of the trademark as geographically misleading or buy the trademark in question[270], however these options may be extremely expensive. By contrast, the EU Regulations on GIs are more flexible providing for the possibility of co-existence between later GIs and previous TMs registered in good faith[271] and this reflects the EU efforts to take into account the nature of GIs which usually have been in place for centuries before their official registration[272].

Another obstacle that European producers may encounter is the registration cost. In fact, small GI groups may not be able to cover the costs of registering a trademark in the US and the additional costs for its maintenance and renewal. These costs are not required in the EU *sui generis* system[273].

Moreover, the legal protection of trademarks, including collective and certification marks, is limited to confusingly similar signs. This means that the

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[270] e.g. the "Consorzio del Prosciutto di Parma" bought the trademark "Parma ham" from a local company at the beginning of the '90s.

[271] See Regulation (EU) 1151/2012, Article 14 paragraph 2.

[272] OriGIn, *Analysis of the Relevant US Legislation for the Protection of GIs & Recommendations for Compromise Solutions on GIs in the TTIP Negotiations*, Ministero dello Sviluppo Economico, October 6, 2015.

[273] OriGIn, *Analysis of the Relevant US Legislation for the Protection of GIs & Recommendations for Compromise Solutions on GIs in the TTIP Negotiations*, *op. cit.*.

protection is based on the risk of misleading the public and thus the burden of proof of the infringement might be hard and expensive involving consumers surveys and attorney fees. Furthermore, according to the "fair use" doctrine, the US legislation does not allow the owner of a trademark to prohibit third parties from using descriptive indications of geographical origin, provided that such use is made in accordance with honest practices in industrial and commercial matters. Therefore, unlike in the EU, domestic and foreign GIs in the US do not enjoy absolute protection[274].

With regard to the enforcement, since no administrative protection is provided for trademarks in the US, it is crucial for GI groups to monitor continually the market against potential infringing uses of the GI or against the subsequent registration request of a potential conflicting trademark. This level of control requires again a significant investment of money. However, if the monitoring activity is not well carried out, the trademarks used to protect a GI are exposed to dilution or to become generic in the US. In the event that the control reveals potentially infringing activity or confusingly similar registration, the TM's owner should take action against the violator, filing, for instance, an opposition proceeding to prevent the registration of a confusingly similar sign or commencing a litigation to seek the cancellation of an already registered sign. Nevertheless an opposition proceeding before the Trademark Trial and Appeal Board as well as an enforcement action before the US Courts can be extremely expensive and not affordable for small GI groups[275].

Finally, unlike the EU *sui generis* system[276], in the US one, obtaining the protection of a GI through trademark does not prevent that indication from becoming generic in the territory of that state and that is why it is so important for GI groups to constantly monitor the market and prevent infringements[277].

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[274] OriGIn, *Analysis of the Relevant US Legislation for the Protection of GIs & Recommendations for Compromise Solutions on GIs in the TTIP Negotiations*, *op. cit.*.

[275] OriGIn, *Analysis of the Relevant US Legislation for the Protection of GIs & Recommendations for Compromise Solutions on GIs in the TTIP Negotiations*, *op. cit.*.

[276] See Regulation (EU) 1151/2012, Article 13 paragraph 2.

[277] OriGIn, *Analysis of the Relevant US Legislation for the Protection of GIs & Recommendations for Compromise Solutions on GIs in the TTIP Negotiations*, *op. cit.*.

2.1.4 *Specific rules for GIs in the wine sector*

In the wine sector a *sui generis* system is available for appellations identifying American products. It includes American Viticultural Areas (hereinafter referred to as AVAs) as well as political appellations, which are the names of the country, states and counties. This system is administered by the TTB which is part of the US Treasury Department[278].

An AVA is defined as "a delimited grape growing region distinguishable by geographical features, the boundaries of which have been recognized and defined"[279] by the TTB. In order to use an AVA on a wine label at least 85 percentage of the wine must be derived from grapes grown within the boundaries of the named AVA[280]. Moreover, the petition to register an AVA must include, among other elements, evidence that certain characteristics of the specified boundary are different from the adjacent areas and that these features affect viticulture as to make it distinctive. Such evidence usually includes geographical features, geology and climate[281]. Thus this focus on viti-culturally distinctive features, that resembles the French concept of "terroir", certainly matches the threshold for a characteristic that is essentially attributable to its geographical origin and that therefore is common to all wines made from grapes originate within the AVA[282].

The US also allows the use of appellations of origin based on political boundaries[283]. In order to use this type of appellation on a wine label not less than 75 percentage of the grapes must have been grown in the indicated area. However, due to the lower percentage required in this case, a common viti-cultural characteristic is hardly imparted to all wines from the same political appellation and therefore the

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[278] E. BARHAM, *American Origin Products (AOPs): Protecting a Legacy*, *op. cit.*, p. 28.

[279] CFR, Title 27, § 4.25(e)(1).

[280] CFR, Title 27, § 4.25(e)(3).

[281] See R. MENDELSON – Z. WOOD, *Geographical Indications in the United States: Developing a Preliminary List of Qualifying Product Names*, *op. cit.*, p. 2.

[282] See R. MENDELSON – Z. WOOD, *Geographical Indications in the United States: Developing a Preliminary List of Qualifying Product Names*, *op cit.*, p. 2.

[283] CFR, Title 27, § 4.25(a)(1).

factor of reputation is usually the best way to qualify these indications of provenance as GIs[284].

The TTB has also an important role in determining whether a geographic term has become generic or semi-generic. While a generic wine name is a name that has lost its original geographical significance becoming a designation for a certain class or type of wine sold in the US, a semi-generic wine name, on the one hand retains its original geographic meaning, on the other hand, indicates a type of wine[285]. Thus semi-generic names are generic as to the product characteristics but not as to the origin[286]. This means that they may be used to designate wines from the original area but they may also be used to indicate wines from a different geographical place as long as it is disclosed to consumers that the wine in question is not from the original source (e.g. "California Champagne")[287]. By contrast, in order to assure foreign producers that their place names, which has not been found to be generic or semi-generic, will not fall in the future into this *status*, the TTB established a category of non-generic names that may be used only to designate wines of the origin indicated by such name[288].

The purpose of this brief paragraph was to underline the different approach taken by the US for wine appellations of origin compared to the one provided for all the other GIs and to point out its similarities with the EU *sui generis* system.

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[284] See R. MENDELSON – Z. WOOD, *Geographical Indications in the United States: Developing a Preliminary List of Qualifying Product Names*, *op cit.*, p. 3.

[285] E. BARHAM, *American Origin Products (AOPs): Protecting a Legacy*, *op cit.*, p. 31. See also Department of the Treasury, Alcohol and Tobacco Tax and Trade Bureau (TTB), *Impact of the US/EU Wine Agreement on Certificates of Label Approval for Wine Labels with a Semi-Generic Name or Retsina,* Industry Circular, No. 2006-1, 10 March 2006, available at: http://www.ttb.gov/industry_circulars/archives/2006/06-01.html.

[286] There are 16 authorised semi-generic names under the TTB, namely: Angelica, Burgundy, Claret, Chablis, Champagne, Chianti, Malaga, Marsala, Madeira, Moselle, Port, Rhine Wine, Sauterne, Haut Sauterne, Sherry and Tokyo. See Department of the Treasury, Alcohol and Tobacco Tax and Trade Bureau (TTB), *Impact of the US/EU Wine Agreement on Certificates of Label Approval for Wine Labels with a Semi-Generic Name or Retsina*, *op cit.*.

[287] E. BARHAM, *American Origin Products (AOPs): Protecting a Legacy*, *op. cit.*, p. 31. See also Department of the Treasury, Alcohol and Tobacco Tax and Trade Bureau (TTB), *Impact of the US/EU Wine Agreement on Certificates of Label Approval for Wine Labels with a Semi-Generic Name or Retsina*, *op cit.*.

[288] CFR, Title 27, § 4.24(c)(1). See also E. BARHAM, *American Origin Products (AOPs): Protecting a Legacy*, *op. cit.*, p. 32.

2.2 TRIPs-minus level of protection

As mentioned above, the USPTO considers its trademark approach for the protection of GIs fully compliant with the TRIPs Agreement and emphasis its benefits[289]. However this view is not always shared.

According to some distinguished authors, questions can be raised as to whether the US system for the protection of GIs is compliant with the TRIPs standards[290]. In particular with the definition of GIs as set out in Article 22 and with the level of protection provided for by Article 22 and 23.

The comparison is based on the TRIPs definition on the one side, and the geographic certification mark system of GI protection on the other side, as the one that better reflects the features of a GI. This being clarified, even though the purpose of a certification mark is to verify the compliance with certain pre-defined standards, doubts may raise as to whether that certification is compliant with the TRIPs requirement to show an essential causal link between a quality, a characteristic or a reputation and the defined geographical area (i.e. "the essentially attributable test"). In fact, the guidelines for Trade Mark Examiners in the US provide that: "a geographic certification mark is a word, name, symbol, device, or some combination of these elements, which certifies that goods or services originate in a particular geographic region"[291]. The guide also states that: "when reviewing an application for a geographic certification mark, the examining attorney must consider the specimen of records and any other available evidence to determine whether the relevant consumers understand the designation to refer only to goods or services produced in the particular region identified by the term and not those produced elsewhere"[292]. It seems that, in order for a geographic certification mark to be registered, the only

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[289] See above paragraph 2.1.

[290] B. O'CONNOR, *Geographical Indications: Some thoughts on the practice of the US Patent and Trademark Office and TRIPs, op. cit.*. See also C. H. FARLEY *Conflicts between U.S. law and international treaties concerning Geographical Indications*, *op. cit.*, p. 73.

[291] USPTO, Draft of the "Geographic Certification Marks" examination guide, Paper 13, July 2013, p. 1, available at http://www.uspto.gov/sites/default/files/trademarks/notices/GeoCertExamGuide_-_26_JUNE_2013_-_External_Distribution.doc, (last viewed on November 2, 2015). See also 15 U.S.C. § 1127, *Trademark Manual of Examination Procedure* (TMEP), §§1306, 01-1306 01(b), 1306, 05, April 2013.

[292] Draft of the "Geographic Certification Marks" examination guide, Paper 13, USPTO, *op. cit.*, p. 5.

examination made by the USPTO regards the scrutiny that a certain product is associated, in the consumer's mind, with the delimited geographic area and, if needed, that the product conform to certain additional standards. However there is nothing to show that these product characteristics are essentially due to the place of origin as required by Article 22 of the TRIPs[293].

As for the level of protection, Article 22.2 of the TRIPs requires Members to provide the legal means for interested parties to prevent the use of a geographical indication that indicates or suggests, misleading the public, that the good originates from a place other than its true place of origin. This standard seems to be covered by 15 U.S.C. § 1125(a) that prohibits to use in commerce "false designation of origin" that are likely to cause confusion, or to cause mistakes, or to deceive as to the origin of the goods. However, also on this issue, the US system's compliance with TRIPs is not without controversy. One author calls attention to Article 24.4 of the TRIPs that exceptionally allows Members to use a "false" geographical indication when such continuous use was made in good faith preceding April 1994 or irrespective of good faith when such use started before April 1984. The Lanham Act, instead, apparently excuses the use of a "false" geographical indication simply on the basis that the mark acquired distinctiveness before 1993 regardless of the good or bad faith use[294]. Other arguments have been raised to challenge the US system's compliance with the

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[293] The absence of the need to show a link between the geographic origin and the product is made clear by the text of the certification mark statement itself, the following example is given in the Examination Guide: "the certification mark, as used by unauthorised persons, certifies the regional origin of potatoes grown in the State of Idaho and certifies that those potatoes conform to grade, size, weight, colour, shape, cleanliness, variety, internal defect, external defect, maturity and residual level standards promulgated by the certifier". See U.S. Registration No. 4221403 (Principal Register, Oct, 9, 2012). See in this context B. O'CONNOR, *Geographical Indications: Some thoughts on the practice of the US Patent and Trademark Office and TRIPs, op. cit.*, p. 720 and B. O'CONNOR, *Geographical Indications in TTIP, The TransAtlantic Trade and Investment Partnership*, *op. cit.*.

[294] 15 U.S.C. § 1052(f). See in this context C. H. FARLEY *Conflicts between U.S. law and international treaties concerning Geographical Indications*, *op. cit.*, p. 81.

TRIPs, like the failure of the Lanham Act to provide the legal means to *all* interested parties[295], however these opinions are even more contested and debated.

Turning now to the level of protection provided for by Article 23 of the TRIPs in relation to wines and spirits, the US Congress, in order to make the US trademark law compliant with the TRIPs standard, immediately after the adoption of the TRIPs Agreement, amended the Lanham Act to prohibit the registration by the USPTO of a "geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after the date on which the WTO Agreement…enters into force with respect to the US"[296]. This amendment brings the US system into compliance with Article 23.2 of TRIPs that requires the registration of a trademark for wines or spirits, which contains or consists of a GI identifying wines or spirits, to be refused or invalidated, *ex officio* or at the request of an interested party. However, Article 23.1 goes further prohibiting the use of a GI for wines or spirits not originating in the named place "even when the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as 'kind', 'type', 'style', 'imitation' or the like". The US argues that the Lanham Act complies also with this provision insofar as it prohibits the use of a "false designation of origin"[297]. But, as far as this provision requires a showing that the designation is misleading or misrepresentative or that consumers rely on it, it does not seem to fully comply with the absolute protection required by Article 23.1 of TRIPs[298].

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[295] In C. H. FARLEY *Conflicts between U.S. law and international treaties concerning Geographical Indications*, *op cit.*, p. 83, it is argued that US trademark law only grants standing to persons who believes they are likely to be damaged and not to all "interested parties". Although there is no definition of "interested parties" in the TRIPs, according to Farley, an "interested party" should be understood more generally as a competitor or as one who produces the goods in question in the same indicated place. While the strict US approach limits the legal standing to those who have been potentially injured and that have been able to demonstrate a casual link between such harm and the defendant's actions. The standard of "persons likely to be damaged" has been judicially defined as "the potential for a commercial or competitive injury" in the US. See e.g. Berni v. Intl. Gourmet Restaurants of Am., Inc., 838 F.2d 642, 648 (2nd Cir. 1988).

[296] 15 U.S.C. § 1052(a).

[297] 15 U.S.C. § 1125(a)(1).

[298] E. BARHAM, *American Origin Products (AOPs): Protecting a Legacy*, *op. cit.*, p. 30.

Although the above considerations reflect only the opinions of few authors, what clearly appears is that the US is not a major proponent of the protection of GIs[299] and this is also evident from the US non-accession to the Madrid and the Lisbon Agreements. In fact, in the US, unlike in Europe, traditional and local industries had never played a leading role and this historical difference may help explain the approach taken by the US in relation to the protection of GIs as compared to its approach towards all the other IPRs. However the inability of the US to benefit to the same extent as European countries because of its apparent lack of traditional industries does not fully explain the US resistance to the protection of GIs[300]. According to an opinion that can be shared, the difference is of a more fundamental nature. Since the beginning, in Europe, GIs were used to protect certain local industries and their reputation, for this reason the system was based on the right to prevent uses of the term that would result in diminishing the local reputation, encouraging in this way those industries to maintain high standards of quality in order to benefit from such a scheme. Whereas the US trademark law has always been primarily concerned with the protection of consumers from the misleading use of

[299] C. H. FARLEY *Conflicts between U.S. law and international treaties concerning Geographical Indications*, *op. cit.*, p. 74. See also R.M. KUNSTADT & G. BUHLER, *'Bud' Battle Illustrates Peril of Geographic Marks*, 20 Natl. L. J. C3, No. 4, May 18, 1998, according to which: "in the Unites States the protection of geographical indications traditionally played a minor role". See also T. MCCHARTY & V.C. DEVITT, *Protection of Geographical Denominations: Domestic and International*, 69 Trademark Rep. 199, HeinOnline, 1979.

[300] C. H. FARLEY *Conflicts between U.S. law and international treaties concerning Geographical Indications*, *op. cit.*, p. 75.

terms in branding. In fact, in the US, the right to use a term is usually related to the meaning resulting from its use in commerce[301].

It is not surprisingly thus, that in the US, the absolute protection as mandated by the Lisbon Agreement and by Article 23 of the TRIPs, which disregards, for the prohibition of the use of a registered indication, the misleading and confusing requirement, barely finds room. However this hesitant approach may result in granting to GIs a level of protection that is lower than the one required by the TRIPs and that, for this reason, could be said "TRIPs-minus".

2.3 The US approach reflected in the FTAs signed by the US and third countries

As already seen with regard to the EU external trade policy over GIs, the US also attempts to export its particular model of GI protection in its Preferential Trade Agreements (PTAs). In particular, the US is encouraging other countries to adopt a "minimalist, trademark oriented model of legal regulation of GIs" distinct from the *sui generis* EU scheme and to prioritise TMs over GIs in the event of any conflict between them[302].

The US' preference for protecting GIs through the trademark system at the international level is self-evident and it is well illustrated by the US proposal presented to the TRIPs Negotiating Group in 1990 which provided: "Contracting

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[301] C. H. FARLEY *Conflicts between U.S. law and international treaties concerning Geographical Indications*, *op. cit.*, pp. 74 ss. According to Farley, an illustrative example of this essentially different approach, is the famous "Budweiser" case. In the US, the term "Budweiser" is recognised as a property right because it has been used in such a way as to have a particular meaning of source-identifier for American consumers. However the term was not free of meaning when the American company Anheuser Busch adopted it as a trademark. In fact, the term "Budweiser" means "of Budweis" and "Budweis" is a small town in Bohemia where the "Budweiser" beer had been brewed for centuries. So the term at issue could have been seen as a protectable GI on the basis of its association with beer production and therefore as unsuitable to beer produced elsewhere. Instead, since American consumers did not see any association with that geographical place at the time of its introduction, the term "Budweiser" was allowed to be used as a brand of a US brewery. It is evident thus that the US system is mainly focused on the protection of consumers from confusingly similar uses. By contrast, the same case seen from the perspective of a country more concerned on the protection of traditional industries would have been differently solved: the analysis would not have been limited to consumers but rather it would have taken into account the harm suffered by the Czech brewery because of the freely appropriation of its geographical name by outside competitors. In case law see: Anheuser-Busch Inc. v. Budweiser Malt Products Corporation, 295 F 306, (C.A.2 1923); Anheuser-Busch, Inc. v. Du Bois Brewing Co., 73 F. Supp. 338, (D.C.Pa. 1947); Anheuser-Busch Brewing Assn. v. Fred Miller Brewing Co., 87 F. 864, (C.C. Wis. 1898).

[302] M. HANDLER – B. MERCURIO, *Intellectual Property*, *op. cit.*, p. 344.

Parties shall protect Geographical Indications that certify regional origin by providing for their registration as certification or collective trademarks"[303].

This being clarified, the main objectives of the US external action concerning GIs can be generalised for analysis and include: the partial extension of the TRIPs definition of GIs as to comprehend part of the definition of trademarks[304]; the retention of the scope of protection for goods other than wines and spirits to the "confusingly similar" standard[305]; the predominance of pre-existing trademarks over later GIs[306]; the emphasis added on the exceptions under Article 24 of the TRIPs[307] and the inclusion of certain procedural safeguards such as cancellation and opposition proceedings to address concerns regarding protection of generic terms[308].

Nevertheless every PTA presents some differences and peculiarities depending on the counterpart and thus its GI chapter varies accordingly in size and content[309]. For instance, over time, GI provisions have evolved from an independent GI

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[303] D.V. EUGUI – C. SPENNEMANN, *The treatment of geographical indications in recent regional and bilateral free trade agreements, op. cit.*, p. 325.

[304] e.g. in Article 17.4.1 of the United States - Chile Free Trade Agreement, 2004 (final text available at: https://ustr.gov/trade-agreements/free-trade-agreements/chile-fta/final-text) and in Article 15.3.3 of the United States - Morocco Free Trade Agreement, 2004 (final text available at: https://ustr.gov/trade-agreements/free-trade-agreements/morocco-fta/final-text) a new sentence has been added to the TRIPs definition of GIs indicating that "any sign or combination of signs in any form whatsoever shall be eligible for protection or recognition as a geographical indication". This sentence clearly resembles the definition of trademarks posing the legal basis for a GI to be protected through trademarks.

[305] See e.g. Article 18.2.15(a) of the Free Trade Agreement between the United States of America and the Republic of Korea (KORUS), 2012 (final text available at: https://ustr.gov/trade-agreements/free-trade-agreements/korus-fta/final-text) and Article 17.2.7 of the Chile - United States Free Trade Agreement, 2004.

[306] See e.g. Article 17.4.10 of the Chile - United States Free Trade Agreement, 2004, Article 15.3.2 of the United States - Morocco Free Trade Agreement, 2004, Article 16.2.2 of the United States-Singapore Free Trade Agreement, 2004, (final text available at: https://ustr.gov/trade-agreements/free-trade-agreements/singapore-fta/final-text) and Article 18.2.15 of the KORUS.

[307] In the US FTAs the exceptions provided for by Article 24 of the TRIPs are either explicitly included or are covered by the non-derogation clause. In particular, since in the US Agreements GIs are treated as another form of trademarks, the exception clause under Article 24.5 is mainly emphasised.

[308] See e.g. Article 18.2(8)(14)(15) of the KORUS (2012). For a detailed analysis in relation to the above mentioned objectives see D.V. EUGUI – C. SPENNEMANN, *The treatment of geographical indications in recent regional and bilateral free trade agreements, op. cit.*, p. 320 ss. See also C. FIELD, *Negotiating for the United States*, *op. cit.*, p. 148. See also B. O'CONNOR, *The European Union and the United States: Conflicting Agendas on Geographical Indications – What's happening in Asia?*, in *Global Trade and Customs Journal,* Vol. 9, Issue 2, Kluwer Law International BV, Netherlands, 2014.

[309] D.V. EUGUI – C. SPENNEMANN, *The treatment of geographical indications in recent regional and bilateral free trade agreements, op. cit.*, p. 325.

chapter[310] towards their inclusion in the TM chapter[311]. However, a detailed analysis of all these bilateral or regional agreements would be beyond the scope of this thesis. In fact, the deep study over the US-South Korea FTA (hereinafter referred to as KORUS) and the brief reference to the Trans Pacific Partnership Agreement (hereinafter referred to as TPP) contained in Chapter III can be considered appropriate enough to illustrate in a complete and comprehensive manner the US international action concerning GIs.

Generally speaking, it is evident how divergent the approaches of the US and the EU to GIs are in the bilateral context. The main debated issues concern: the additional protection extended to goods other than wines and spirits as against the minimalistic approach; the principle of priority as against the principle of co-existence in the relationship between GIs and TMs; the problem of generic terms[312].

This last matter, in particular, involves important economic interests for many corporations based in the States, and thus animates the dispute between the US and the EU constituting one of the major obstacles to the negotiations of the forthcoming Trans-Atlantic Trade and Investment Partnership (TTIP)[313]. In fact, the EU's efforts to claim exclusive use of some terms (e.g. feta, asiago, fontina, gorgonzola) in its FTAs, dramatically affect the US dairy industry that commonly uses these names on

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[310] e.g. the North America Free Trade Agreement (NAFTA), 1993, (final text available at https://ustr.gov/trade-agreements/free-trade-agreements/australian-fta) includes an independent GI section very close to the existing TRIPs standards.

[311] e.g. the United States-Australia Free Trade Agreement, 2005, (final text available at: https://ustr.gov/trade-agreements/free-trade-agreements/australian-fta/final-text) includes only one single section for both TMs and GIs under the title: "trademarks, including geographical indications".

[312] For reference, see USTR, *2015 Special 301 Report*, April 2015, p. 26; K. RAUSTIALA - S.R. MUNZER, *The Global Struggle over Geographic Indications*, *op. cit.*, pp. 350-351; B. O'CONNOR, *The European Union and the United States: Conflicting Agendas on Geographical Indications – What's happening in Asia*, *op. cit.*.

[313] See *GI supporters express puzzlement at U.S. dairy position* in *The Hagstrom Report*, Vol. 4, No. 217, 2014, available at http://www.hagstromreport.com/2014news_files/2014_1117_gi-supporters-puzzled-u-s-dairy-position.html. See also *European Union wants to force the U.S. to rename products like Parmesan cheese that are made in America*, published on MailOnline.com, 12 March 2014, available at: http://www.dailymail.co.uk/news/article-2578517/Europe-wants-Parmesan-seeks-change.html. See also P. BELLA, *European Union declares cheese war on America*, 14 March 2014, available at: http://www.chicagonow.com/cooking-cop/2014/03/european-union-declares-cheese-war-on-america/. See also J. SANBURN, *Europe's War on American Cheese*, published on Time.com, 12 March 2014, available at: http://time.com/22011/europes-war-on-american-cheese/.

products for sale around the world[314]. As a result of the EU trade policy the US would be prevented from importing such named products in those third countries that have signed a bilateral agreement with the EU. The remarks made by the Vice President of Trade Policy at US Dairy Export Council and National Milk Producers Federation clearly embrace the American concerns over the European action: "the EU's approach to restricting common food names through the use of GI registrations abuses a good concept in order to impose trade barriers against competitors…In forcing its trading partners to adopt the same trade-restrictive GIs in recent FTAs, the EU has turned FTAs, which are supposed to expand trade, into tools for discriminating against third countries to gain unfair market shares"[315]. Thus, in response, the US is trying to use its own FTAs to contain the effects of the European's push to globalise its "restrictions" on the use of place names[316].

The consequence of such an international setting is that the battle over GIs is being transferred in other countries as the EU and the US both use trade agreements to influence the protection of GIs in foreign markets[317]. Therefore, these third countries, finding themselves in the middle of a global struggle, will have to decide which obligations to respect and, if necessary, which to infringe.

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[314] In fact, it is commonly acknowledged that US producers took pre-existing European place names for their products - a frequent *phenomenon* in countries that experienced heavy European immigration. "Immigrant business owners of European extraction were familiar with geographical names from their home countries that were associated with quality products. They used those names to promote their own products, riding on the coat tails of the original product's reputation (or, depending on one's point of view, using them allusively, to indicate general product qualities)". In the US such place names have been treated as generic names for certain type of products. See E. BARHAM, *Translating Terroir Revisited: The Global Challenge of French AOC Labeling*, in *Research Handbook on Intellectual Property and Geographical Indications*, D. GANGJEE (ed.), Edward Elgar, Cheltenham, UK, forthcoming 2016, p. 57.

[315] Testimony by Shawna Morris, Vice President of Trade Policy, U.S. Dairy Export Council & National Milk Producers Federation to the United Stated Senate Committee on Finance, Subcommittee on International Trade, Customs and Global Competitiveness, *The U.S. – Korea Free Trade Agreement: Lessons Learned Two Years Later*, 29 July 2014, available at: http://www.finance.senate.gov/imo/media/doc/Testimony%20to%20Senate%20Trade%20Subcommittee%20on%20Korus_July%2029%2014_FINAL.pdf.

[316] K.W. WATSON, *U.S: Trying (and Failing) to Contain the Spread of European Geographical Indications*, Cato at Liberty, 27 February 2015, available at: http://www.cato.org/blog/us-trying-failing-contain-spread-european-gis.

[317] K.W. WATSON, *U.S: Trying (and Failing) to Contain the Spread of European Geographical Indications*, *op. cit.*.

CHAPTER III

CONFLICTING OBLIGATIONS ARISING OUT OF EU AND US FTAs IN ASIA

CONTENTS: 1. International Framework. - 1.1 The proliferation of FTAs negotiated by the US and the EU: causes and objectives. - 1.2 The important role of the South Korean bilateral agreements. - 1.3 Other FTAs recently concluded in the Asia Pacific Region: TPP, EU-Singapore and EU-Vietnam. - 2. Comparison between KOREU and KORUS with regard to GIs. - 2.1 KOREU. - 2.1.1 The definition of GIs and their registration procedure. - 2.1.2 The level of protection and enforcement. - 2.1.3 The relationship with TMs. - 2.1.4 Generic terms. - 2.1.5 Other exceptions. - 2.2 KORUS. - 2.2.1 The definition of GIs and their recognition procedure. - 2.2.2 The level of protection and enforcement. - 2.2.3 The relationship with prior TMs. - 2.2.4 Generic terms. - 2.2.5 Other exceptions. - 2.3 Implications of the different provisions: their theoretical incompatibility. - 2.3.1 The structure, scope and definition of GIs. - 2.3.2 The registration and the enforcement. - 2.3.3 The level of protection. - 2.3.4 The relationship with TMs. - 2.3.5 Generic terms. - 3. New hurdles on the horizon: the recent TPP, EUSFTA and EVFTA. - 3.1 ASEAN countries and their approach to GIs. - 3.2 The US and ASEAN countries. - 3.2.1 US-Singapore FTA. - 3.2.2 The Trans-Pacific Partnership. - 3.3 The EU and ASEAN countries. - 3.3.1 The EU-Singapore FTA. - 3.3.2 The EU-Vietnam FTA. - 3.3 A reiteration of conflicting provisions.

1. International Framework

The previous Chapter showed that the different approaches taken by the US and the EU in relation to GIs are very much reflected in the new generation of FTAs. *De facto,* the inclusion of an extensive IPRs chapter in these preferential trade agreements is rapidly changing the scope and the content of international obligations on IPRs under the TRIPs[318]. However, before examining some recently concluded

[318] D.V. EUGUI - C. SPENNEMANN, *The Treatment of Geographical Indications in Recent Regional and Bilateral Free Trade Agreements*, in *The Intellectual Property Debate: Perspectives from Law, Economics and Political Economy*, M.P. Pugatch (ed.), Edward Elgar, Cheltenham, UK, 2006, p. 335.

FTAs the question of why there has been an increase in PTAs with comprehensive IP chapters and of why they are mainly concentrated in Asia should be addressed.

1.1 The proliferation of FTAs negotiated by the US and the EU: causes and objectives

Nearly twenty one years ago the most comprehensive multilateral intellectual property agreement was concluded. However, while at first this agreement was seen as a major step forward, developed and industrialised countries soon began to see the need for further regulation so as to complete the TRIPs. They advocated for higher standards of intellectual property protection and when it became clear that the 2001 Doha round of WTO negotiations was unlikely to succeed, they decided to push their agendas thorough bilateral free trade and partnership agreements[319]. In particular, for entities such as the EU and the US the attempts to increase the level of IP protection have become a dominant priority in international trade policy[320].

Overall, EU and US objectives pursued through these bilateral and regional initiatives are very similar[321]: securing foreign markets, providing export opportunities for domestic companies on a WTO-plus basis and increasing their competitiveness in the global economy by removing trade barriers[322]. In this context, a strong level of IPR protection and enforcement is considered necessary. Without sufficient protection, the value of new market access would be seriously undermined,

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[319] S.K. SELL, *TRIPS was never enough: vertical forum shifting, FTAs, ACTA, and TPP*, in *J. Intell. Prop. L.,* Vol. 18:447, June 23, 2011, p. 448. See also C. ANTONS - R. HILTY, *Introduction: IP and the Asia-Pacific 'Spaghetti Bowl' of Free Trade Agreements*, in *Intellectual Property and Free Trade Agreements in the Asia-Pacific Region*, C. Antons - R. Hilty (eds.), Springer, 2015, p. 3.

[320] H.G.R. KHAN, *Time for a Paradigm Shift? Exploring Maximum Standards in International Intellectual Property Protection*, in *Trade Law and Development*, Vol. 1:56, 2009, p. 60.

[321] M. GARCIA, *Competitive Fears: The EU, US and Free Trade Agreements in East Asia*, EU External Affairs Review, July 2012, p. 70.

[322] W.H. COOPER, *Free Trade Agreements: Impact on U.S. Trade and Implications for U.S. Trade Policy*, CRS (Congressional Research Service) Report, February 26, 2014, p. 3, available at: www.crs.gov. See also European Commission, External Trade, *Global Europe: Competing in the World*, 2006, available at: http://trade.ec.europa.eu/doclib/docs/2006/october/tradoc_130376.pdf. See also S. MARAGKIDOU, *Competing Regionalism between the EU and the US: a race for regulatory influence?*, p. 4, available at: http://ecpr.eu/filestore/paperproposal/c98d9b5a-b13c-456b-b3d9-e22f066a0478.pdf.

given the obvious negative impact of IPR violations in terms of fiscal revenues, foreign investment, transfer of technology and know-how[323].

In 2004, the EU Commission, in its "Strategy for the Enforcement of Intellectual Property Rights in Third Countries" emphasised the direct connection between IPRs enforcement on a TRIPs-plus level and the successful development of the economy[324]. Again, in its 2006 "Global Europe" communication, the EU expressly said that FTAs are to be used as tools for setting international IP standards beyond the WTO framework as part of EU's IP enforcement strategy and, in order to achieve this result, FTAs should be deeply comprehensive in scope and provide for liberalisation of all trade[325]. Since the launch of its new external trade policy in 2006, the EU has become, together with the US, the largest trading block in the world and the largest regulatory power in many sectors using the incentive of market access as a bargaining chip to promote its values, rules and geo-economic interests in third countries[326]. When looking at GI protection specifically, the shift to comprehensive-designed FTAs also provided the opportunity to ensure protection of EU GIs in countries which would have no interest in entering specialised GI agreements[327] due to a lack of economic value attributed to their own GIs[328]. The Director-General for Agriculture and Rural Development pointed out that "a satisfactory GI Chapter is a

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[323] European Commission, Directorate General for Trade, *Strategy for the Enforcement of Intellectual Property Rights in Third Countries*, 2005, p. 16, available at: http://trade.ec.europa.eu/doclib/docs/2005/april/tradoc_122636.pdf. See also E.V. RODRIGUEZ, *The European Union Free Trade Agreements: Implications for Developing Countries*, Working Paper, Real Instituto Elcano, 2009, p. 5, available at: www.realinstitutoelcano.org.

[324] European Commission, Directorate General for Trade, *Strategy for the Enforcement of Intellectual Property Rights in Third Countries*, *op. cit.*.

[325] European Commission, External Trade, *Global Europe: Competing in the World*, op. cit. pp. 8-14. See also T. ENGELHARDT, *Geographical Indications Under Recent EU Trade Agreements*, in *IIC - International Review on Intellectual Property Law*, 2015, Vol. 46, pp. 781 - 818, p. 782.

[326] S. MARAGKIDOU, *Competing Regionalism between the EU and the US: a race for regulatory influence?*, *op.cit.*, p. 9.

[327] For many years the EU concluded bilateral agreements focused only on wines and spirits GIs. See e.g. Agreement between the European Community and Australia on trade in wine, 1994 O.J. L 86/3; the Agreement between the European Community and the United Mexican States on the mutual recognition and protection of designations for spirits drinks, 1997 O.J. L 152/16; and the Agreement between the European Community and the United States of America on trade in wine, 2006 O.J. L 87/2.

[328] T. ENGELHARDT, *Geographical Indications Under Recent EU Trade Agreements*, *op. cit.*, p. 782.

'must have' for the EU" and specified that "the EU objective is to add value compared to TRIPs basic provisions"[329].

Also for the US, the negotiation of stronger IP rights has become a core element of its trade policy, especially given the US's aggressive strategy to enlarge its sphere of trade influence worldwide[330]. In the late 90', when the US external trade action started focusing on big emerging markets that could offer consistent growth opportunities for US exporters and investors, FTAs were considered the best tool to enforce a particular economic liberalisation model[331] and to spread their preferred system of economic governance on others[332]. In particular, pushed by the recently developed "competitive liberalisation doctrine"[333], spread out during the W. Bush administration, the number of FTAs under negotiation increased considerably. President Obama has continued this trend[334]. In all these recent US FTAs, the TRIPs-plus standard, viewed as an essential pre-condition for fostering foreign investment, has been taken as a central part of the negotiations.

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[329] The EU main goals, as already mentioned in the previous Chapter, consists in: establishing a list of EU names to be protected directly and indefinitely in the other country; extending the protection granted by Article 23 TRIPs to products other than wines and spirits; allowing co-existence of GIs with prior TMs if they were registered in good faith; phasing out prior users of names originating in the EU; Obtaining administrative protection; avoiding any reliance on mere individual applications for the protection in the other country; ensuring an immediate right of use to any producer compliant with the applicable specifications; ensuring ongoing co-operation through the establishment of a designated mechanism. See DG-AGRI *working document on international protection of EU geographical indications: objectives, outcome and challenges,* Ref. Ares(2012)669394–06/06/2012, Advisory Group International Aspects of Agriculture (2012) Meeting of 25 June 2012.

[330] R.E. LUTZ, *Linking Trade, Intellectual Property and Investment in the Globalizing Economy: The Interrelated Roles of FTAs, IP and the United States*, in *Intellectual Property and Free Trade Agreements in the Asia-Pacific Region*, C. Antons - R. Hilty (eds.), Springer, 2015, p. 163-164. See also USTR, *2013 Special 301 Report*, pp. 11-12, available at: https://ustr.gov/sites/default/files/05012013%202013%20Special%20301%20Report.pdf.

[331] M. GARCIA, *Competitive Fears: The EU, US and Free Trade Agreements in East Asia*, *op. cit.*, p. 62.

[332] M. GARCIA, *Competitive Fears: The EU, US and Free Trade Agreements in East Asia*, *op. cit.*, p. 71.

[333] F. Bergsten developed the concept of competitive liberalisation in his analysis of negotiating incentives in the Asia Pacific context in 1996. Since then, the *phaenomenon* has taken place in all regions and has been adopted by the US Trade Representative R. Zoellick as the core strategy of US trade policy.

[334] S. MARAGKIDOU, *Competing Regionalism between the EU and the US: a race for regulatory influence?*, *op. cit.*, pp. 12-13. See also W.H. COOPER, *Free Trade Agreements: Impact on U.S. Trade and Implications for U.S. Trade Policy*, CRS (Congressional Research Service) Report, February 26, 2014, available at: www.crs.gov. See also S. HOADLEY, *U.S. Free Trade Agreements in East Asia: Politics, Economics, and Security Policy in the Bush Administration*, in *Journal of current Southeast Asian affairs*, 26 (2007), 1, p. 57, available at: http://www.ssoar.info/ssoar/handle/document/33672.

This being said, while the main purposes of the EU and the US trade policy concerning IPRs might be, generally speaking, the same, i.e. going beyond WTO standards[335], the approach with regard to GIs is completely different. Unlike for all the other IPRs, the US does not push for a TRIPs-plus level of protection and enforcement in relation to GIs but tries to limit them to a subset of trademarks. In light of this difference, the massive proliferation of preferential trade agreements is a vehicle for competition between the EU and the US, the two "regulators of the world", to shape the rules of global trade in relation to GIs[336]. Timing and who succeeds in closing a deal with a third party first will have an impact on the possibility of *manoeuvre* of the other party[337]. Today, as will be seen below, this race is mainly taking place in Asia where most of the fast-growing economies are located[338].

1.2 The important role of the South Korean bilateral agreements

Within the trade development policy discussed above, the US, in 2006, started negotiating the US-South Korea FTA (hereinafter referred to as KORUS) which entered into force on March 15, 2012[339]. South Korea had to accept the US's "gold standard" of a WTO-plus FTA which incorporated a highly advanced and

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[335] For a study over the differences between the EU and US preferential trade agreements see H. HORN - P.C. MAVROIDIS - A. SAPIR, *Beyond WTO? An Anatomy of EU and US preferential trade agreements*, Bruegel Blueprint Series, Brussels, 2009. See also M.J. GARCIA, *Same aims, different approaches? Recent EU and US free trade agreements in Asia*, The UACES Blog, January 9, 2014, available at: http://uacesoneurope.ideasoneurope.eu/2014/01/09/same-aims-different-approaches-recent-eu-and-us-free-trade-agreements-in-asia/.

[336] S. MARAGKIDOU, *Competing Regionalism between the EU and the US: a race for regulatory influence?*, *op. cit.*, pp. 14-15.

[337] M. GARCIA, *Squaring the Circle? Approaches to Intellectual Property Rights and the TTIP*, UACES Conference, Cork, Ireland, 1-3 September 2014, pp. 6-7, available at: http://www.uaces.org/documents/papers/1401/garcia.pdf.

[338] The US has concluded FTAs with Singapore (entered into force in 2004), South Korea (entered into force in 2012) and through the TPP (concluded in 2015 but not yet entered into force) with Japan, Malaysia, Vietnam, Brunei, Singapore and New Zealand. Data available at: https://ustr.gov/trade-agreements/free-trade-agreements. The EU has concluded FTAs with South Korea (entered into force in 2011), Singapore (concluded but not yet entered into force), Vietnam (concluded in 2015 but not yet entered into force) and is negotiating with Japan, Malaysia, Thailand and India. Data available at: http://trade.ec.europa.eu/doclib/docs/2006/december/tradoc_118238.pdf.

[339] A general description of the KORUS' negotiations is available at: https://ustr.gov/trade-agreements/free-trade-agreements/korus-fta.

comprehensive IPR chapter.[340] This agreement for the US was particularly relevant. Firstly, it was the US's most commercially significant FTA in almost two decades, South Korea being the US's sixth trade partner[341]. Secondly, it was the first agreement to be concluded and ratified with a North Asian partner, becoming a model for trade agreements for the rest of the Asia-Pacific region[342]. And lastly, it was an important deal to consolidate the military collaboration between the two nations[343].

The agreement between the EU and South Korea (hereinafter referred to as KOREU) was no less significant: South Korea is the eighth exporting destination of the EU. The negotiations began in 2007 and the FTA provisionally entered into force in July 2011. For the EU it was the first of a new generation of deeply comprehensive and detailed FTAs and it was the first trade deal with an Asian country[344].

KORUS and KOREU also represented a shift in the trade policy of South Korea. Korea traditionally supported multilateralism as it is a signatory to most international agreements, except in this context, the Lisbon Agreement for the Protection of Appellation of Origin and their International Registration. Until 2004, Korea was one of the very last countries having no FTAs at all[345]. However, as a result of the 1997 financial crisis and of the WTO negotiations' failure, when regionalism emerged as the real asset of the global trade system, also Korea began to engage in preferential

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[340] M. GARCIA, *Competitive Fears: The EU, US and Free Trade Agreements in East Asia*, *op. cit.*, p. 62.

[341] See USTR, *New Opportunities for U.S. Exporters Under the U.S.-Korea Trade Agreement*, available at: https://ustr.gov/trade-agreements/free-trade-agreements/korus-fta. See also M. GARCIA, *Competitive Fears: The EU, US and Free Trade Agreements in East Asia*, *op. cit.*, p. 62.

[342] In fact, the recently concluded Trans Pacific Partnership Agreement reproduces the KORUS' general framework.

[343] The security and military aspects of the US presence in East Asia and especially in South Korea have played an important role in the US trade policy. See M. GARCIA, *Competitive Fears: The EU, US and Free Trade Agreements in East Asia*, *op. cit.*, p. 61.

[344] See European Commission, Trade, *The EU-Korea Free Trade Agreement in practice,* European Union Publication Office, Luxembourg, 2011.

[345] A. POLLET-FORT, *The EU-Korea FTA and Its Implications for the Future EU-Singapore FTA*, EU Centre in Singapore, Background Brief No. 4, June 2011, p. 12.

trade deals[346]. Thus, since the establishment of the new Korean trade strategy in 2003, officials in Seoul have actively engaged in FTA negotiations with over fifty countries and so far, FTAs with Chile, Singapore, ASEAN, India, Peru, the EU and the US have entered into force[347]. Not surprisingly, KORUS and KOREU have been the most relevant for the Korean market. The US is the fourth-largest importing and the third-largest exporting partner while the EU is the third-largest importing and the second-largest exporting partner for Korea[348].

The importance of KORUS and KOREU, however, is not only limited to economic issues. In fact, these two FTAs are the most comprehensive and advanced trade deals in force up to now in the Asian Region and have constituted a model for subsequent preferential agreements (concluded but not yet ratified) such as the TPP, the EU-Singapore FTA, the EU-Vietnam FTA and the forthcoming TTIP[349].

The Korea-EU FTA is organised into fifteen chapters with several annexes and appendixes, three protocols and four understandings. It covers all areas of economic activity between the Parties and it establishes rules and procedures in trade in goods and services including IPRs, competition policy, government procurement, labour rights, environmental protection and sustainable development[350]. It eliminates duties for industrial and agricultural products in a step-by-step approach[351] and it addresses non-tariff barriers to trade with a specific focus on the automotive and electronic

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[346] For more informations on the South Korean external action see I. CHEONG - J. CHO, *Republic of Korea*, in *Asia's Free Trade Agreements: How is Business Responding?*, M. Kawai - G. Wignaraja (eds.), Asian Development Bank and the ADB Institute, Edward Elgar, Cheltenham, 2011, pp. 130 ss. See also A. POLLET-FORT, *The EU-Korea FTA and Its Implications for the Future EU-SIngapore FTA*, *op. cit.*, p. 12.

[347] Ministry of Foreign Affairs, Republic of Korea, *FTA Status of* ROK, at: http://www.mofa.go.kr/ENG/policy/fta/status/overview/index.jsp?menu=m_20_80_10 (last viewed on January 6, 2016).

[348] Y. SONG, *KORUS FTA vs. Korea-EU FTA: Why the Differences?*, in *Korea Economic Institute (KEI)*, Vol. 6, No. 5, May 2011, p. 1.

[349] See in this context: A. POLLET-FORT, *The EU-Korea FTA and Its Implications for the Future EU-SIngapore FTA*, *op. cit.*, p. 22. See also USTR, *New Opportunities for U.S. exporters under the E.S.-Korea Trade Agreement*, at: https://ustr.gov/trade-agreements/free-trade-agreements/korus-fta.

[350] A. POLLET-FORT, *The EU-Korea FTA and Its Implications for the Future EU-Singapore FTA*, *op. cit.*, p. 14. See also European Commission, South Korea, at: http://ec.europa.eu/trade/policy/countries-and-regions/countries/south-korea/.

[351] As of July 2016 import duties will be eliminated on almost all goods. See European Commission, *EU-South Korea Free Trade Agreement: A Quick Reading Guide*, October 2010, p. 1, available at: http://trade.ec.europa.eu/doclib/docs/2009/october/tradoc_145203.pdf.

sector[352]. Similarly, the Korea-US FTA comprises twenty-four chapters which go from the elimination of tariff and non-tariff barriers to the regulation of competition, IPRs, labour and environment protection[353]. Here, like in KOREU, the provisions on IPRs are very detailed and comprehensive and reflect the same TRIPs-plus ambitions[354].

1.3 Other FTAs recently concluded in the Asia-Pacific Region: TPP, EU-Singapore and EU-Vietnam

After several years of negotiations, on October 4, 2015, a new plurilateral preferential trade agreement, named the Trans-Pacific Partnership (TPP) Agreement, has been concluded by the US with eleven countries, among which, in Asia: Singapore, Vietnam, Malaysia, Brunei and Japan[355]. This new FTA is considered a landmark for next-generation agreements. It eliminates and reduces tariff and non-tariff barriers across substantially the full *spectrum* of trade in goods and services, it addresses new trade challenges (as the development of the digital economy and the role of state-owned enterprises in the global market) and it constitutes a platform for regional integration especially in the Asia-Pacific Region[356].

The EU, on the other hand, in March 2010, launched negotiations for a comprehensive FTA with Singapore and, on 17 October 2014, the Parties announced the conclusion of the Agreement[357]. This FTA is the EU's second ambitious trade deal with a key Asian trading partner after South Korea and the first with a Southeast Asian country. Singapore is an important trade partner for the EU for several

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[352] European Commission, *EU-South Korea Free Trade Agreement: A Quick Reading Guide*, *op. cit.*, p. 3.

[353] USTR, *New Opportunities for U.S. exporters under the E.S.-Korea Trade Agreement*, at: https://ustr.gov/trade-agreements/free-trade-agreements/korus-fta.

[354] C. ANTONS - R.M. HILTY (eds.), *Intellectual Property and Free Trade Agreements in the Asia-Pacific Region*, Springer, 2015.

[355] See below paragraph 3.2.2.

[356] USTR, *Summary of the Trans-Pacific Partnership Agreement*, Press Release, October 2015, available at: https://ustr.gov/about-us/policy-offices/press-office/press-releases/2015/october/summary-trans-pacific-partnership.

[357] European Commission, Singapore, at: http://ec.europa.eu/trade/policy/countries-and-regions/countries/singapore/

reasons[358]. First, it is by far the EU's largest commercial partner in the region and one of the major destination for European investments in Asia[359]. Second, Singapore is a gateway to the Southeast Asian market and the location of regional headquarters of over 10.000 EU companies[360]. Third, Singapore's experience in concluding ambitious agreements with developed countries like the US and Japan indicates that the EU could reasonably expect to achieve a highly advanced trade deal[361]. On the other side, for Singapore, a deal with its third largest trading partner (after Malaysia and China) is naturally vital. With the FTA's entrance into force, Singaporean firms will be given access to millions of consumers in 28 EU Member States[362].

The EU also launched negotiations with Vietnam in June 2012 for an EU-Vietnam FTA. Vietnam has experienced a strong economic and social transformation over the past twenty years alongside a substantial integration into the global market. Thus, as a fast developing and growing economy, Vietnam holds great potential for EU firms. The Partnership and Cooperation Agreement between the EU and Vietnam[363], signed in June 2012, can be considered as a stepping stone for the intensification of the relations between the two Parties which ended up with the conclusion of a comprehensive and exhaustive FTA on December 2, 2015[364].

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[358] A. POLLET-FORT, *The EU-Korea FTA and Its Implications for the Future EU-Singapore FTA*, *op. cit.*, p. 25

[359] European Commission, Singapore, at: http://ec.europa.eu/trade/policy/countries-and-regions/countries/singapore/.

[360] A. POLLET-FORT, *The EU-Korea FTA and Its Implications for the Future EU-Singapore FTA*, *op. cit.*, p. 25.

[361] European Commission, Directorate-General for Trade, *The economic impact of the EU-Singapore Free Trade Agreement*, European Commission, Special Report, September 2013, p. 11, available at: http://trade.ec.europa.eu/doclib/docs/2013/september/tradoc_151724.pdf. See also A. POLLET-FORT, *The EU-Korea FTA and Its Implications for the Future EU-Singapore FTA*, *op. cit.*, p. 25.

[362] European Commission, Directorate-General for Trade, *The economic impact of the EU-Singapore Free Trade Agreement*, European Commission, Special Report, September 2013, *op. cit.*, p. 2.

[363] Framework Agreement on Comprehensive Partnership and Cooperation between the European Union and its Member States, of the one part, and the Socialist Republic of Vietnam, of the other part, available at: http://eur-lex.europa.eu/resource.html?uri=cellar:e9d99d61-6897-11e3-a7e4-01aa75ed71a1.0011.05/DOC_1&format=PDF.

[364] European Commission, Vietnam, at: http://ec.europa.eu/trade/policy/countries-and-regions/countries/vietnam/.

The content of those recently concluded FTAs[365] will be analysed in the last part of this Chapter, however it should be noted that all have been modelled following, respectively, the KOREU and the KORUS examples and that all these countries are Members of the WTO TRIPs Agreement.

2. Comparison between KOREU and KORUS with regard to GIs

2.1 KOREU

On 1 July 2011, the EU-Korea FTA provisionally entered into force[366], bringing to an end a process promoted five years earlier by the Commission's Communication on "Global Europe in a Competing World" which required the EU to renew its engagement in Asia. As already mentioned, the Agreement is unprecedented both in

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[365] Those Agreements have been concluded but not yet ratified and for this reason their analysis will be less detailed if compared to the one of KOREU and KORUS.

[366] See Article 3 of the Council Decision of 16 September 2010 on the signing, on behalf of the European Union, and provisional application of the Free Trade Agreement between the European Union and its Member States, of the one part, and the Republic of Korea, of the other part, 2011 O.J. L 127, Volume 52, 14 May 2011. See also the Notice concerning the provisional application of the Free Trade Agreement between the European Union and its Member States, of the one part, and the Republic of Korea, of the other part, 2011 O.J. L 168, Volume 54, 28 June 2011, which states as follow: "The Free Trade Agreement between the European Union and its Member States, of the one part, and the Republic of Korea, of the other part, signed in Brussels on 6 October 2010, will be provisionally applied, by virtue of Article 3(3) of the Council Decision on the signing and provisional application of the Agreement, as of 1 July 2011". See also Article 15.10.5 of the KOREU which provides for its provisional application, pending the completion of the procedures for its conclusion.
However, although the FTA has been provisionally applied since 1 July 2011, some parts of the Agreement that fall within the exclusive competence of the Member States have not been provisionally applied, e.g. provisions relating to the criminal enforcement of IPRs.
This being clarified, on 14 September 2015 the ratification procedures were concluded in all 28 national parliaments and KOREU formally entered into force on 13 December 2015. See the Notice concerning the entry into force of the Free Trade Agreement between the European Union and its Member States, of the one part, and the Republic of Korea, of the other part, 2015 O.J. L 307, Volume 58, 25 November 2015.
On the Korean side, the Korean Government submitted the KOREU FTA to the Korean Assembly in October 2010, and after delays in the ratification process due to political opposition, the FTA was officially ratified by the National Assembly on May 4, 2011. See A. POLLET-FORT, *The EU-Korea FTA and Its Implications for the Future EU-Singapore FTA*, *op. cit.*, p. 13. See also J.J. NA - T.H. LEE, *National Assembly ratifies Korea-EU FTA*. The Korea Times, May 4, 2011. See also Ministry of Foreign Affairs, Republic of Korea, *FTA Status ROK*, at: http://www.mofa.go.kr/ENG/policy/fta/status/effect/eu/index.jsp?menu=m_20_80_10&tabmenu=t_2&.

its scope and in the speed at which trade barriers are to be removed becoming the most ambitious trade agreement ever negotiated by the EU[367].

With regard to Geographical Indications, the KOREU provides for detailed and inclusive provisions which reflect the EU's advocacy of a specialised system for their registration and protection, aimed at preventing their misuse in the respective markets[368]. The important role of GIs is stressed by recital (7) of the Council Decision of 16 September 2010 on the signing, on behalf of the European Union, and provisional application of the Free Trade Agreement between the European Union and its Member States, of the one part, and the Republic of Korea, of the other part, which provides: "it is appropriate to set out the relevant procedures for the protection of geographical indications which are given protection pursuant to the Agreement"[369]. Hence, a full section of the Chapter 10 of the FTA is devoted to the mutual recognition and protection of the GIs of both Parties, including, for the first time, also agricultural products and foodstuffs GIs[370]. This confirms the idea of GIs as independent intellectual property rights[371].

KOREU will be analysed under five headings: a) the definition of GIs and their registration procedure; b) the level of protection and enforcement; c) the relationship with trademarks; d) the problem of generic terms; e) other exceptions.

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[367] European Commission, Trade, *The EU-Korea Free Trade Agreement in practice, op. cit.*. See also SQ Interview, EU Ambassador Tomas Kozlowski on the Korea-EU FTA and the Economic Outlook, SERI Quarterly, October 2012, available at: http://eeas.europa.eu/delegations/south_korea/press_corner/events/index_en.htm.

[368] European Commission, Trade, *The EU-Korea Free Trade Agreement in practice, op. cit.*, p. 15. See also T. WATTANAPRUTTIPAISAN, *Trademarks and Geographical Indications: Policy Issues and Options in Trade Negotiations and Implementations*, in *Asian Development Review*, Vol. 26, No. 1, pp. 166-205, 2009, pp. 167-168.

[369] Council Decision of 16 September 2010 on the signing, on behalf of the European Union, and provisional application of the Free Trade Agreement between the European Union and its Member States, of the one part, and the Republic of Korea, of the other part, 2011 O.J. L 127, Volume 52, 14 May 2011.

[370] D. Kim, *Geographical Indications Surfacing as Obstacle to Korea-EU FTA Talks*, The Korea Times, July 29, 2007, available at: http://www.koreatimes.co.kr/www/news/biz/2015/08/127_7382.html (last viewed on November 23, 2015). See also Trevisan&Cuonzo, *Free Trade Agreement EU-South Korea: for the first time in a Bilateral Agreement between the EU and a Third Country, the EU provides for the Protection of European GIs for Agricultural Products and Foodstuffs*, November 25, 2009, available at: http://www.trevisancuonzo.com/pubblicazioni-e-legal-update/legal-update/index.html?page=20.

[371] KOREU, Article 10.2.

Before going into this accurate analysis, it is of interest to mention the Article of the FTA which clarifies the relationship between this bilateral agreement and the TRIPs Agreements in order to understand to what extent the FTA can add something to or derogate from an international agreement. Article 10.2 provides as follow: "the Parties shall ensure an adequate and effective implementation of the international treaties dealing with intellectual property to which they are party including the Agreement on Trade Related Aspects of Intellectual Property Rights, contained in Annex 1C to the WTO Agreement...The provisions of this Chapter shall complement and specify the rights and obligations between the Parties under the TRIPs Agreement".

2.1.1 *The definition of GIs and their registration procedure*

The text of the Agreement does not formally include a definition of GIs as such. However Article 10.18 paragraph 6(b) while describing the elements required for the registration and control of GIs, makes reference to the definition of GIs as contained in Article 22 of the TRIPs[372]. In addition, footnote 51 clarifies what falls under the term "Geographical Indications", as used in the Agreement, by expressly referring to the EU and the Korean legislation. Namely, for what concerns the EU system, the term covers: geographical indications and designations of origin as defined by Regulation (EC) 510/2006, currently replaced by Regulation (EU)1151/2012, quality wines produced in a specified region and table wines with geographical indication as defined by Regulation (EC) 110/2008 and by Regulation (EC) 1234/2007, recently replaced by Regulation (EU) 1308/2013. For Korea, the term refers to geographical indications as defined by the Agricultural Products Quality Control Acts and the Liquor Tax Act. Under Korean law the definition of GIs seems to stand in the middle between a PDO and a PGI as referred to in Article 5 Paragraph 1 and 2 of the EU Regulation 1151/2012: "the term 'geographical indication' means, where the

[372] KOREU, Article 10.18 paragraph 6 states as follow: "the European Union and Korea agree that the elements for the registration and control of geographical indications referred to in paragraph 1 and 2 are the following...(b) an administrative process verifying that geographical indications identify a good as originating in a territory, region, or locality of either Party, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin".

reputation, quality *and* other distinctive features of agricultural and fishery products or processed agricultural and fishery products...result from the geographical characteristics of a specific region, an indication describing that the relevant agricultural and fishery products or processed agricultural and fishery products have been produced, made *or* processed in the specific region"[373].

Overall, if on one side it may be concluded that the term "geographical indication", in the context of this Agreement, is fully compliant with the "essentially attributable test" as required by the TRIPs definition of Article 22, on the other side, a word of caution is needed: the laws only protect GIs in relation to food products. Handicrafts seem to be excluded from the scope of protection as established under the FTA. This flaw might be regarded as a violation of the TRIPs requirement to ensure protection to all "goods"[374].

While producers must normally register their GIs before the relevant national authorities to obtain a protection in a third country, the main advantage of the FTA signed between the EU and South Korea relies on the mutual recognition of hundreds of GIs. Indeed, KOREU includes an extensive list of GIs originating in one of the Parties that are required to receive automatic protection as GIs in the other. The GIs in question are listed in Annex 10-A (agricultural products and foodstuffs) and 10-B (wines, aromatised wines and spirits) of KOREU, and have been recognised without any need to go through the standard national procedure[375]. With the entry into force of the FTA these particular GIs have been immediately and inherently protected in

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[373] Agricultural and Fishery Products Quality Control Act, as amended by Act No. 10885, July 21, 2011, available at: http://elaw.klri.re.kr/kor_service/lawView.do?hseq=25355&lang=ENG, Article 2(8).

[374] This consideration has already been done in relation to the EU system. See above Chapter II, paragraph 1.2.

[375] KOREU, Article 10.18 paragraph 3 states as follow: "Having examined a summary of the specifications of the agricultural products and foodstuffs corresponding to the geographical indications of Korea listed in Annex 10-A, which have been registered by Korea under the legislation referred to in paragraph 1, the European Union undertakes to protect the geographical indications of Korea listed in Annex 10-A according to the level of protection laid down in this Chapter". Respectively, Paragraph 4 says: "Having examined a summary of the specifications of the agricultural products and foodstuffs corresponding to the geographical indications of the European Union listed in Annex 10-A, which have been registered by the European Union under the legislation referred to in paragraph 2, Korea undertakes to protect the geographical indications of the European Union listed in Annex 10-A according to the level of protection laid down in this Chapter".

both territories[376]. In total the GIs listed in the Annexes are 64 for Korea and 162 for the EU. Of course, given the numbers, the list does not include all the GIs protected in the EU but only those GI's names that according to the EU are more likely to be usurped on a specific market and/or for which there is evidence of an economic interest[377]. Among them: Bud!jovické pivo, Bayerisches Bier, Feta, Prosciutto di Parma, Asiago, Fontina, Gorgonzola, Grana Padano, Parmigiano Reggiano, Pecorino Romano, Chianti, Marsala, Madeira, Porto, Grappa, Korean Red Ginseng, Jeju Green Tea[378]. Instead, the number of Korean GIs seems to include all the GIs registered in South Korea as of October 2009, when the Agreement between the EU and South Korea was initialled[379]. It is also important to note that the GIs in the EU cover mostly wines and spirits, while the Republic of Korea is not a wine country producer, and agricultural products and foodstuffs different from those produced in South Korea, where there are a number of local specialities, such as green tea or red ginseng, which are not among the GIs protected in the EU. Thus, the GIs benefiting from the FTA complement each other and have limited chance of competing in the same markets.

The FTA also makes sure that the GI lists are flexible and may be amended if needed. Article 10.24 and 10.25(3)(b) of the FTA permit the addition of new GIs to the list and Article 10.24 and 10.25(3)(b) provide for the possibility to remove GIs if they cease to be protected in their country of origin. The Parties explicitly establish a "Working Group on Geographical Indications" that is responsible for such changes. Thus, new GIs may continue to be added for protection to the list, even after the

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[376] Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea,* Ministero dello Sviluppo Economico, Italia in Corea, Italian Trade Commission, Seoul, April 2010, p. 78.

[377] K. TROJANOVÀ, *Intellectual Property Rights in Preferential Trade Agreements: The Comparison of KORUS FTA and EU-South Korea FTA*, E-Leader, Milan, 2014, p. 7.

[378] KOREU, Annex 10-A and Annex 10-B.

[379] The number of registered GIs *per* year can be accessed at: http://www.naqs.go.kr/eng/contents/Agrifood/Agrifood/H_01.naqs (last viewed on January 16, 2016). As to the history of the Korea-EU FTA see: H. KIM, *Future Prospects of Korea-Latvia Trade Relations in the Framework of the Korea-EU FTA*, Korea Institute for International Economic Policy, October 18, 2011, available at: http://www.mfa.gov.lv/data/Prezentacijas/Korea_EU_FTA.pdf (last viewed on January 16, 2016).

FTA's entry into force[380]. This approach, according to an authoritative opinion, goes beyond the TRIPs *minimum* standard. The latter, in fact, does not oblige Members to accord automatic protection to a foreign GI but rather allows their authorities to maintain the discretion to previously examine if any of the exceptions under Article 24 of the TRIPs applies[381].

Coming to the registration and control procedures, parties conclude that their respective legislation meet all the following requirements: (a) a register listing the GIs protected in their respective territory; (b) an administrative process aimed at verifying that the GI fulfils the "essentially attributable test" as required by Article 22 of the TRIP; (c) a requirement that a registered name corresponds to a specific product for which a product specification is laid down that may be amended only through an administrative process; (d) control commitments in relation to the production process; (e) legal provisions ensuring that a registered name may be used by any operator marketing the agricultural product or foodstuff conforming to the product's specifications; (f) an objection procedure that safeguards the legitimate interests of prior users of the same or similar names[382]. From this wording it is clear the extent to which the KOREU embraces most of the main pillars of the EU system, namely: the need for an *ad hoc* registration and administrative control system; the necessity to guarantee a certain traceability of the GI product by laying down product

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[380] Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea*, *op. cit.*, p. 95.

[381] D.V. EUGUI - C. SPENNEMANN, *The Treatment of geographical indications in recent regional and bilateral Free Trade Agreements*, *op. cit.*, pp. 315-316. However, this reasoning can be questioned. Usually, the general approach to the creation of the GI lists is that, during the negotiations, the Parties exchange lists of GIs for which they wish to receive protection *via* the agreement. When there are solid basis for the successful completion of the negotiations of the entire FTA, the Parties may initiate objection proceedings in their own jurisdiction. Some FTAs make this a requirement (see in this regard Article 208 of the Trade Agreement between the European Union and its Member States, of the one part, and Colombia and Peru, of the other part, 2012 O.J. L 354/3 and Article 245(1)(a) of the Agreement establishing an Association between the European Union and its Member States, on the one hand, and Central America on the other, 2012 O.J. L 346/3), however, KOREU only provides for an examination of the listed GIs to be carried out by the Parties, which may or may not include an objection phase. Nevertheless, objection proceedings did take place in the EU before the Agreement was initialled (see the European Commission, Notice - Geographical Indications from the Republic of Korea, 2008/C 141/15, 2008 O.J. C 141/33, June 6, 2008). This may lead to the conclusion that those listed GIs have been granted automatic protection under the FTA only because they have been approved by the Authorities of the respective Parties preceding the entrance into force of the Agreement. See T. ENGELHARDT, *Geographical Indications Under Recent EU Trade Agreements*, *op. cit.*, pp. 794-795.

[382] KOREU, Article 10.18 paragraph 6.

specifications to be respected; the assurance that a protected GI may be use by any operator marketing agricultural products, foodstuffs, wines, aromatised wines or spirits conforming to the corresponding specifications[383].

A few more words on the objection procedure prescribed by Article 10.18 paragraph 6 letter (f). This requirement refers only to the country of origin of the GIs but not to the other Party where recognition and protection *via* the Agreement is sought. This is inferred by the systematic context of the paragraph. The standards required by paragraph 6 for a GI protection system are relevant only in relation to paragraph 1 and 2 of the same Article, where both Parties agree that the system of the respective contracting Party complies with the standards prescribed. This seems to confirm that the objection procedure required only refers to the registration of domestic GIs and not to the registration of those GIs that are automatically protected *via* the FTA. Under the language of the Agreement, the protection of such listed GIs seems to be justified even in the absence of an individual objection proceeding, i.e. even if there are pre-existing rights that may be affected by such protection[384].

2.1.2 *The level of protection and enforcement*

Article 10.21 paragraph 1 of the Agreement provides that "geographical indications referred to in Article 10.18 and 10.19 shall be protected against: (a) the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good; (b) the use of a geographical indication identifying a good for a like good[385] not originating in the place indicated by the geographical indication in question, even where the true origin of the good is indicated or the geographical

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[383] For a review of the main principles of the EU system see above Chapter II section 1.

[384] However, in practice, the EU has carried out opposition procedures before KOREU was signed. See the European Commission, Notice - Geographical Indications from the Republic of Korea, 2008/ C 141/15, 2008 O.J. C 141/33, June 6, 2008. See also T. ENGELHARDT, *Geographical Indications Under Recent EU Trade Agreements*, *op. cit.*, p. 798.

[385] The term "like good" has to be interpreted according to Article 23.1 of the TRIPs Agreement in relation to the use of a GI identifying wines for wines not originating in the place indicated by the GI. See KOREU, Article 10.21, footnote 56.

indication is used in translation or transcription or accompanied by expressions such as 'kind', 'type', 'style', 'imitation' or the like; and (c) any other use which constitutes an act of unfair competition within the meaning of Article 10 bis of the Paris Convention". Among the three types of actions mentioned above, the ones described by letter (a) and letter (c), proscribing the use of a GI in a manner that would mislead the public as to the true place of origin, resemble the level of protection granted by Article 22 of the TRIPs to all GIs. On the contrary, the misconduct illustrated by letter (b), preventing the use of a GI regardless of any misleading test, clearly reflects the type of protection provided for by Article 23 of the TRIPs in relation to GIs identifying wines or spirits. In other words, KOREU extends the additional Article 23 protection to agricultural products and other foodstuffs thus reproducing the TRIPs-plus EU approach[386].

However, one crucial aspect to be clarified is the introductory sentence that limits its scope exclusively to "geographical indications referred to in Article 10.18 and 10.19". The wording is obscure. It is unclear if the provision refers to GIs as defined by footnote 51[387] - i.e. GIs protected under the respective legal regimes listed in that footnote - or if it is limited to those GIs listed in the Annexes 10-A and 10-B[388]. Considering the nature of the FTA and its main goal, i.e. the mutual protection of a certain number of GIs without incurring the costs and delays of the national procedures, it seems that the obligations under this Article is limited to those GIs listed in the Annexes. Otherwise, what would have been the scope to add a list of specific names to the Agreement if its provisions had referred to all the GIs protected in both countries? This conclusion appears to be the one endorsed by the European

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[386] Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea*, *op. cit.*, p. 94. However, this level of protection does not reflect entirely the one established under EU law. In fact, if compared to the one provided for by Article 13 of the EU Regulation 1151/2012, Article 10.21 of the KOREU does not include the "evocation" among the forbidden uses.

[387] In support of this opinion see: T. ENGELHARDT, *Geographical Indications Under Recent EU Trade Agreements*, *op. cit.*, p. 799.

[388] In support of this opinion see O. MANDEL, *The Recognition and Protection of key EU geographical indications in South Korea following the adoption of the EU - South Korea Free Trade Agreement*, April 22, 2011, available at: http://www.mandel-office.com/the-recognition-and-protection-of-key-eu-geographical-indications-in-south-korea-following-the-adoption-of-the-eu-south-korea-free-trade-agreement/.

Commission and by the Korean Government during the negotiation of the Agreement. In fact, when officials in Seoul modified their national legal system as to comply with the new FTA, they extended the level of protection only to those GIs already included in the FTA[389] and to those GIs that will be added to the Annexes in accordance to the procedure set out in Article 10.24[390].

As for what concerns the enforcement, Article 10.22 of the FTA requires the Parties to ensure protection to all GIs both on their own initiative through appropriate authorities and at the request of an interested party. Hence, implementing one of the main goals of the EU. The FTA also provides for an obligation to implement broader measures directed against acts infringing GIs[391]. Namely, acts that mislead consumers as to the true geographical origin and acts of unfair competition in relation to the GI in question. By contrast, the Parties refrained from introducing strict obligations on criminal sanctions for GI infringements. Article 10.55 only expresses the Parties' intention to "consider adopting measures to establish the criminal liability for counterfeiting geographical indications"[392].

2.1.3 *The relationship with TMs*

Under KOREU, a TM, which has been applied for, registered or established by use in the territory of a party before the date of the application for the protection of the GI, can continue to be used, provided that no grounds for the TM's invalidity or revocation exist in the legislation of the Party concerned[393]. Whereas if a TM that corresponds to any of the prohibited actions under Article 10.21 is applied for on like goods after the date of application for the protection or recognition of the GI in the

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[389] See Article 3-2 of the Unfair Competition Prevention and Trade Secret Protection Act, as amended by Act No. 11963, July 30, 2013, available at: http://elaw.klri.re.kr/kor_service/lawView.do?hseq=29192&lang=ENG. See below Chapter IV paragraph 2.

[390] KOREU, Article 10.24 states as follow: "the European Union and Korea agree to add geographical indications to be protected to the Annexes 10-A and 10-B in accordance with the procedure set out in Article 10.25". KOREU, Article 10.25 allows the addition of new GIs through the modification of Annexes 10-A and 10-B by the Working Group on Geographical Indications.

[391] KOREU, Article 10.67 paragraph 1, footnote 76(c)(iv).

[392] T. ENGELHARDT, *Geographical Indications Under Recent EU Trade Agreements*, *op. cit.*, p. 802.

[393] KOREU, Article 10.21 paragraph 5.

territory concerned, the registration of the trademark has to be refused or invalidated[394]. One more time these provisions unquestionable reflect the EU approach in the text of the FTA. In particular, Article 10.21 paragraph 5 expressly allows for the co-existence of GIs with prior TMs[395] and this clearly mirrors Article 14 paragraph 2 of the Regulation (EU) 1151/2012. In fact, shifting the balance in favour of the GI when a conflict between a TM and a GI arises, suggests that KOREU endorses the European view of GIs as completely independent IPRs and as public assets with a collective nature.

However, again, it is essential to underline that the above mentioned provisions only apply to those GIs already listed or that will be listed in the Annexes 10-A and 10-B of the Agreement[396]. This is inferred by paragraph 2 of Article 10.23 which clarifies what is meant for "date of application for protection": for registered GIs already included in the FTA, the date of application for protection shall be the date of entry into force of the FTA, i.e. July 1, 2011[397]; whereas for registered GIs which are not currently on the list but could be added in the future on the basis of Article 10.24 of the Agreement, the date for protection shall be the date of a Party's receipt of a request by the other Party to protect or recognise a GI[398].

2.1.4 *Generic terms*

There is no provision in the KOREU dealing with genericity. In the absence of a specific rule, the question is whether there is room for the exception under Article 24 paragraph 6 of the TRIPs which allows Members to exclude terms customary in common language as common names for certain goods from the scope of protection of GIs or whether the absence of such provision is to be interpreted as an implicit phasing out of the TRIPs exception. In order to answer this question, following the

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394 KOREU, Article 10.23 paragraph 1.

395 T. ENGELHARDT, *Geographical Indications Under Recent EU Trade Agreements*, *op. cit.*, p. 802.

396 O. MANDEL, *The Recognition and Protection of key EU geographical indications in South Korea following the adoption of the EU - South Korea Free Trade Agreement*, *op. cit.*.

397 KOREU, Article 10.23 paragraph 2 letter (a).

398 KOREU, Article 10.23 paragraph 2 letter (b).

reasoning of a respected author[399], a distinction is needed. On the one side, with regard to the particular GIs enumerated in the list annexed to the Agreement it might be concluded that the exception provided for by Article 24 paragraph 6 has been implicitly eliminated. They are granted automatic protection without reference to any exception. Therefore, even if one of the GIs listed in the Annex of the Agreement had been used previously in a presumptive generic manner in South Korea (e.g. the terms: "feta", "champagne", "cognac", "scotch", bordeaux"[400]), the latter is obliged to phase out its use locally from the date of the entry into force of the FTA[401]. On the other hand, a different thinking might be more appropriate in relation to individual applications for the protection of GIs in the respective territory[402]. Here, in the absence of a specific provision in the FTA, for the principle of territoriality that governs IPRs, the national legal system applies. And according to both EU and South Korean law, generic terms shall not be registered[403]. It seems thus that for individually applied GIs the TRIPs exception has been implicitly adopted.

However, as already mentioned[404], this reasoning can be questioned. Underlining the fact that the list of GIs contained in the Annex have been agreed by both parties after an *ad hoc* examination of the concerned specifications[405], it can be gathered that

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[399] D.V. EUGUI - C. SPENNEMANN, *The Treatment of geographical indications in recent regional and bilateral Free Trade Agreements*, *op. cit.*.

[400] D. KIM, *Geographical Indications Surfacing as Obstacle to Korea-EU FTA Talks*, *op. cit.*.

[401] D.V. EUGUI - C. SPENNEMANN, *The Treatment of geographical indications in recent regional and bilateral Free Trade Agreements*, *op. cit.*, p. 316.

[402] According to Article 10.26 of the KOREU the provisions of this Sub-section are without prejudice to the right to seek recognition and protection of a geographical indication through individual applications under the relevant legislation of the European Union or Korea.

[403] For the EU legal framework see Article 6 paragraph 1 of the Regulation (EU) 1151/2012. For the Korean one see Article 32 paragraph 9(4) of the Agricultural and Fishery Products Quality Control Act, as amended by Act No. 10885, July 21, 2011, available at: http://elaw.klri.re.kr/kor_service/lawView.do?hseq=25355&lang=ENG.

[404] See above paragraph 2.1.1.

[405] KOREU, Article 10.18 paragraph 3 states as follow: "having examined a summary of the specifications of the agricultural products and foodstuffs corresponding to the geographical indications of Korea listed in Annex 10-A, which have been registered by Korea under the legislation referred to in paragraph 1, the European Union undertakes to protect the geographical indications of Korea listed in Annex 10-A according to the level of protection laid down in this Chapter". On the other side KOREU, Article 10.18 paragraph 4: "having examined a summary of the specifications of the agricultural products and foodstuffs corresponding to the geographical indications of the European Union listed in Annex 10-A, which have been registered by the European Union under the legislation referred to in paragraph 2, Korea undertakes to protect the geographical indications of the European Union listed in Annex 10-A according to the level of protection laid down in this Chapter".

these GIs have been included in the Annex and granted automatic protection only after a verification, made by each Party, that no exception applies. On this different perspective, the TRIPs provision concerning generic terms would be fully maintained and respected also with regard to those GIs listed in the FTA and consequently the widespread concept of "clawing back" names that were already generic in a country would be simply wrong. According to this thinking, the terms in question have been automatically protected only because they were not generic at the time of their inclusion in the Annex of the FTA.

This being said, another important issue remains uncertain: after a foreign GI has been registered can it become generic? The answer again, given the silence of the FTA, varies depending on the national legal system of the two countries. According to the EU law, GIs, once registered, cannot become generic[406]. Korean law on GIs instead does not have any specific provision in this regard, however it is enough to know that the supervening genericness is not mentioned among the grounds for cancellation of the GI[407]. It seems thus that once legitimately and correctly registered, a GI does not risk to become generic either in the EU or in South Korea.

2.1.5 *Other exceptions*

In relation to the other exceptions provided for by Article 24 TRIPs, the examined bilateral agreement do maintain the same TRIPs flexibility reproducing the text of Article 24 paragraph 8[408] and 9[409] and of Article 23 paragraph 3[410]. In fact, at least in relation to those GIs directly protected under the FTA, Article 10.21 paragraph 2 provides: "the Agreement shall in no way prejudice the right of any party to use, in the course of trade, that person's name or the name of that persons's predecessor in business, except where such name is used in such a manner as to

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[406] Regulation (EU) 1151/2012, Article 13 paragraph 2.

[407] Agricultural and Fishery Products Quality Control Act, Article 44.

[408] TRIPs, Article 24 paragraph 8, addresses the situation where a person's name used for business purposes is also a GI.

[409] TRIPs, Article 24 paragraph 9, provides that GIs lacking protection in their country of origin do not need to be protected under TRIPs.

[410] TRIPs, Article 23 paragraph 3, deals with the protection of homonymous GIs for wines.

mislead consumers". Again, under Article 10.21 paragraph 4 "nothing in this Agreement shall oblige the European Union or Korea to protect a geographical indication which is not or ceases to be protected in its country of origin or which has fallen into disuse in that country". Finally, with respect to the protection of homonymous GIs, Article 10.21 paragraph 3 of the FTA, reflecting Article 23 paragraph 3 of the TRIPs, states that protection shall be granted to each indication provided that it has been used in good faith and that has met the practical conditions of use under which the homonymous GIs are differentiated from each other. These conditions are established by the Working Group on Geographical Indications taking into account the need to ensure equitable treatment of the producers concerned and the need to avoid consumers' confusion. The evident similarity between these provisions and the ones in the TRIPs make the above mentioned exceptions almost undisputed in the bilateral context[411].

2.2 KORUS

After many years of negotiations, on March 15, 2012, the FTA between the US and the Republic of Korea finally entered into force[412]. For the US, this Agreement is one of the first FTAs that has been agreed with a country in an advance stage of development and that includes a satisfactory, strong and comprehensive IPR chapter[413].

With regard to GIs, KORUS reflects the US approach to GIs as a subset of TMs and the US interest to ensure that the protection granted to GIs in other countries does not undercut the US industries' market access or, more specifically, does not prevent access to foreign markets for US exporters whose products are identified by generic names, like "parmesan", "feta", or "gorgonzola" for cheeses. In fact, among

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[411] D.V. EUGUI - C. SPENNEMANN, *The Treatment of geographical indications in recent regional and bilateral Free Trade Agreements*, *op. cit.*, p. 312.

[412] USTR, *New Opportunities for U.S. Exporters under the U.S. - Korea Trade Agreement*, at: https://ustr.gov/trade-agreements/free-trade-agreements/korus-fta.

[413] ITAC, *The U.S. - Korea Free Trade Agreement (FTA): The Intellectual Property Provisions*, Report of the Industry Trade Advisory Committee on Intellectual Property Rights (ITAC - 15), April 27, 2007, p. 2.

the objectives of the US pursued through this Agreement there are: the attempts to ensure that the registration of a GI does not violate prior rights (e.g. trademark rights) and does not deprive interested parties of the ability to use common terms; the opposition to the efforts to extend the protection given to GIs for wines and spirits to other products; and the assurance that interested parties have the opportunity to oppose or to seek cancellation of any GI applied for or protected[414].

The US aversion to GIs has been put on paper in a Report to the Congress from 2008, which expressly asserts that the US and South Korea in their bilateral agreement should make IPRs commitments beyond the TRIPs standard with provisions that "would facilitate the registration and protection of trademarks and established limitations on the use of geographical indications"[415]. This means that the US proposal while expanding the scope of trademark protection restricts the operation of GIs as a field of protection distinguishable from TMs[416].

The US-Korea Agreement, like KOREU, will be examined under five headings: (a) the definition of GIs and their recognition procedure; (b) the level of protection and enforcement; (c) the relationship with prior TMs; (d) the problem of generic terms; (e) other exceptions.

Before entering into the heart of this analysis, it is of interest to understand the relationship between the bilateral agreement and the TRIPs Agreement. According to Article 18.1 paragraph 2 of the KORUS: "...the Parties affirm their existing rights and obligations with respect to each other under the TRIPS Agreement". This reference, as it will be seen below, is extremely important in order to understand the current commitments of both the US and South Korea in relation to GIs when there is a gap in the bilateral agreement.

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[414] United States Trade Representative, *2015 Special 301 Report*, Ambassador Michael B.G. Froman, April 2015, available at: https://ustr.gov/sites/default/files/2015-Special-301-Report-FINAL.pdf

[415] W. COOPER et al., *The Proposed U.S-South Korea Free Trade Agreement (KORUS FTA): Provisions and Implications*, Report for Congress, Congressional Research Service (CRS), January 22, 2008, p. 40.

[416] S. FLYNN - M. KAMINSKI - B. BAKER - J. KOO, *Public Interest Analysis of the US TPP Proposal for an IP Chapter*, Program on Information Justice and Intellectual Property, American University Washington College of Law, December 6, 2011, p. 8, available at: http://infojustice.org/wp-content/uploads/2011/12/TPP-Analysis-12062011.pdf.

2.2.1 *The definition of GIs and their recognition procedure*

There is no stand alone section for GIs in the text of KORUS. GIs are assimilated to TMs and therefore regulated by the same Article 18.2, the title of which provides: "Trademarks Including Geographical Indications".

Nevertheless, the above mentioned Article, in footnote 5, contains a definition of GIs: "for the purposes of this Chapter, geographical indications means indications that identify a good as originating in the territory of a Party, 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. Any sign (such as words, including geographical and personal names, as well as letters, numerals, figurative elements and colors, including single color) or combination of signs, in any form whatsoever, shall be eligible to be a geographical indication...". This definition, if on one side reflects the wording of Article 22 of the TRIPs, on the other side, adds something that *de facto* enlarges the concept of GIs as to include not only indications and names but also any sign or combination of signs, exemplified by a non-exhaustive list, which are the constitutive elements of the TMs' definition[417]. It does seem thus that the language used in the FTA contains elements which resemble more TMs than GIs and this results in sharp contrast not only with the idea of GIs in the EU where only a name in relation to a particular product can be protected as a GI[418], but also with the idea embraced by the TRIPs that specifically establishes two different IPRs[419].

With regard to the recognition procedure, Article 18.2 paragraph 14 of the KORUS enumerates a list of commitments that the US and the Republic of Korea have to respect regardless of the system of protection adopted for GIs (i.e. trademark system or otherwise). Three key words can be used to summarise the content of this

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[417] e.g. Article 15 of the TRIPs Agreement defines TMs as: "any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks." See in this context S. FLYNN - M. KAMINSKI - B. BAKER - J. KOO, *Public Interest Analysis of the US TPP Proposal for an IP Chapter*, *op. cit.*, p. 9.

[418] B. O'CONNOR, *The European Union and the United States: Conflicting Agendas on Geographical Indications - What's happening in Asia?*, *op. cit.*, p. 66.

[419] D.V. EUGUI - C. SPENNEMANN, *The Treatment of geographical indications in recent regional and bilateral Free Trade Agreements*, *op. cit.*, p. 327.

Article: transparency, publicity and opposition. Both Parties are required to set out clearly the procedures to file and to process applications and petitions, to make them readily available to the public, to ensure that applications and petitions for GIs are published for the purpose of initiating opposition procedures and to lay down unambiguous procedures to oppose or cancel a registration resulting from an application or a petition[420].

What is clear from the Article in question is that KORUS does not provide automatic protection for any GI, rather, it emphasis the important role of the opposition process and the possibility for any interested party to defend their rights before granting protection.

2.2.2 *The level of protection and enforcement*

Article 18.2 paragraph 2 requires the Parties to provide that GIs be eligible for protection as TMs. It seems thus that the level of protection granted to GIs in the KORUS, mirroring the one required for TMs, be limited to confusingly similar signs and be based on the risk of misleading the public[421]. However, in the absence of a specific provision for GIs and in light of the wording of Article 18.1 paragraph 2 which reaffirms the commitments of the Parties to the obligations of the TRIPs, it may be assumed that the level of protection of Article 22 of the TRIPs shall apply to each member state regardless of the silence of the bilateral agreement[422]. According to this interpretation, both Parties are required to prevent the use of designations that misleads the public as to the true place of origin of the good in question[423].

A similar reasoning can be made for wines and spirits GIs. Although no provision concerning their additional or absolute protection as required by Article 23

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[420] KORUS, Article 18.2 paragraph 14.

[421] KORUS, Article 18.2 paragraph 4, gives the owner of a TM the exclusive right to prevent all third parties from using confusingly similar signs for like goods or services. See above Chapter I paragraph 3.1.3.

[422] In this context see D.V. EUGUI - C. SPENNEMANN, *The Treatment of geographical indications in recent regional and bilateral Free Trade Agreements*, *op. cit.*, p. 328.

[423] TRIPs Agreement , Article 22 paragraph 2.

of the TRIPs has been inserted in the FTA, Article 23 must apply anyway to each Member State.

However, notwithstanding this, the US's or the South Korean's real compliance with the basic level of protection as provided for by the TRIPs Agreement and not mentioned by the bilateral agreement is a different matter and has to be verified by examining the national law of each party[424].

In relation to the enforcement procedure, even if KORUS does not say anything in this regard, it is clear that, in light of the inclusion of GIs in the trademark system, which does not benefit from any administrative procedure, their enforcement is entirely up to the owner of the trademark GI who has the duty to monitor continually the market against potential infringing uses or against the subsequent registration request of a potential conflicting trademark.

2.2.3 *The relationship with TMs*

Concerning the relationship between prior TMs and GIs, KORUS clearly shifts the balance in favour of TMs[425]. This is made clear by two provisions: Article 18.2 paragraph 15 and Article 18.2 paragraph 4. The first provision provides for the refusal, opposition or cancellation of GI protection or recognition if the designation of geographical origin is: (i) likely to cause confusion with a prior trademark that is the subject of a good faith pending application or registration in the Party's territory; (ii) likely to cause confusion with prior trademark acquired through use in good faith; (iii) likely to cause confusion with a prior well-known trademark. The second provision provides as follow: "Each Party shall provide that the owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs, *including geographical indications*, at least for goods or services that are identical or similar to those goods or services in respect of which the owner's trademark is registered,

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[424] For the US this examination has already been done in paragraph 3.1.3 and 3.2 of the previous Chapter and for South Korea it will be done in the next Chapter.

[425] B. O'CONNOR, *The European Union and the United States: Conflicting Agendas on Geographical Indications - What's happening in Asia?*, *op. cit.*, p. 67.

where such use would result in a likelihood of confusion. In the case of the use of an identical sign, including a geographical indication, for identical goods or services, a likelihood of confusion shall be presumed". This Article reflects the terms of Article 16 of TRIPs[426], however, adding an explicit reference to geographical indications it stresses the idea of superiority of TMs over GIs. In fact, these two Articles incorporate one of the core elements of the US Lanham Act: "the first in time first in right principle", also said "principle of priority". This principle, in theory, only governs the relationship between TMs themselves. However, since GIs can be protected as TMs both under US domestic law and KORUS, this basic rule applies without any distinction to the relationship between TMs and GIs. This means that a latter GI which is confusingly similar to a prior TM could never be protected under KORUS. This provision represents an instance of the US approach of making GI protection similar to that of TMs[427].

2.2.4 *Generic terms*

Surprisingly, in KORUS, unlike in the more recent TPP (Trans Pacific Partnership Agreement[428]), a provision over generic terms is missing. In the absence of any regulation, Article 24 paragraph 6 of the TRIPs applies. Therefore neither the US nor the Republic of Korea shall be obliged to apply its provisions in respect of a GI of the other Party in relation to goods or services for which the indication concerned is identical with the term customary in common language as the common name for such goods or services in the territory of that Party[429]. This solution is implicitly suggested by the KORUS' reference to the TRIPs and, if this view is shared, it can be concluded that the exception of genericness may always be claimed

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[426] TRIPs, Article 16 states as follow: "The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed".

[427] S. FLYNN - M. KAMINSKI - B. BAKER - J. KOO, *Public Interest Analysis of the US TPP Proposal for an IP Chapter*, *op. cit.*, p. 9.

[428] See below paragraph 3.2.2.

[429] TRIPs, Article 24 paragraph 6.

by any interested party as an opposing ground for GI registration. In fact, in this Agreement, unlike in the EU-Korea FTA, there is no list of GIs to be mutually recognised and granted automatic protection: national authorities maintain their discretion to evaluate, for each individual application, the existence of genericness. Rather, KORUS emphasis the important role of the opposition process and the possibility for any interested party to challenge every application[430].

2.2.5 *Other exceptions*

The other exceptions to GI protection provided for by Article 24 paragraph 8 and 9 and by Article 23 paragraph 3 of the TRIPs Agreement are not referred to in KORUS. Thus, nothing has been said with regard to the use of a person's name in trade or homonymous GIs and no reference has been made to the right of each Member to refrain from protecting GIs that are not, or cease to be, protected in their country of origin. Nevertheless, again, in light of the wording of Article 18.1 paragraph 2 of the KORUS which recalls the TRIPs Agreement, it can be inferred that these exceptions apply to both the US and South Korea notwithstanding the absence of provisions in the bilateral agreement.

2.3 Implications of the different provisions: their theoretical incompatibility

The analysis of both the EU-Korea and the US-Korea FTAs allows for a comparison between their different provisions and permits to study their implications.

However, before examining the main contrasts, it has to be stressed that some of the commitments are very similar and this happens either when the TRIPs rules are directly incorporated in the text of the Agreement or when these rules are implicitly referred to in order to fill a gap in the Agreement. Therefore the provisions of the two FTAs match when there is no derogation from the TRIPs standards and this is the case for the use of a person's name in trade, of homonymous GIs and for the

[430] KORUS, Article 18.2 paragraph 14.

possibility not to protect GIs that are not or cease to be protected in their country of origin[431].

Nevertheless, other than these limited instances, KORUS and KOREU are very far from each other on several important issues: the scope, structure and definition of GIs, the registration and the enforcement, the level of protection, the relationship with trademarks and the problem of genericity. As already mentioned in the previous Chapter this is the result of different economic interests[432]. The EU considers GIs as part of its cultural heritage as well as a tool to consolidate the reputation and market niche of certain agricultural products, thus as a tool to increase, in quantity and in quality, its level of exports. While the US considers the protection of GIs as a potential protectionist barrier[433].

2.3.1 *The structure, scope and definition of GIs*

The structure of the two Agreements in relation to GIs again reflects the different legal traditions of the EU and the US respectively. A EU system more based on the appellation of origin model which is strictly related to a public law concept and a US model that, using the trademark system, is based on a private law concept[434]. Therefore, while the KOREU has a specific sub-section for GIs, the KORUS incorporates them into trademarks.

With regard to the scope of protection, KOREU, reproducing the EU approach, is quite limited in coverage as it includes only GIs for agricultural products, wines, aromatised wines and spirits. KORUS, instead, mandating the use of the trademark system for the protection of GIs, extends its coverage not only to any good but also to services.

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[431] TRIPs, Article 24 paragraph 8 and 9 and Article 23 paragraph 3.

[432] J. LEE, *Korea's Intellectual Property Law Strategies in the Korea-China FTA Negotiations in Comparison with Other International FTAs*, Seoul National University, Master Thesis, 2014.

[433] D.V. EUGUI - C. SPENNEMANN, *The Treatment of geographical indications in recent regional and bilateral Free Trade Agreements*, *op. cit.*, p. 335.

[434] D.V. EUGUI - C. SPENNEMANN, *The Treatment of geographical indications in recent regional and bilateral Free Trade Agreements*, *op. cit.*, p. 335.

Again, the definition of GIs in the two FTAs is quite different. If on one side both the Agreements make reference to Article 22 of the TRIPs which utilise the term "indication" to identify a GI, the KORUS goes further in adding that, not only indications but also "any sign (such as words, including geographical and personal names, as well as letters, numerals, figurative elements and colours, including single colour) or combination of signs, in any form whatsoever, shall be eligible to be a geographical indication..."[435]. Thus it could happen that a sign which falls under the definition of GI as stated in the KORUS and that, accordingly, is registered as a GI in South Korea, cannot be recognised as such under the Korea-EU bilateral agreement.

2.3.2 *The registration and the enforcement*

As to the registration procedure, it is true that both Agreements deal with the issue of GI registration or recognition and that both require some commitments to be guaranteed by South Korean law. Nevertheless these obligations are not always the same. Where the general requirements of transparency and publicity in the application and opposition phase laid down in Article 18.2 paragraph 14 of the KORUS are of course embraced also by the EU bilateral agreement as basic principles of law, the commitments required by KOREU are more specific and depend on the system of GI protection adopted. The need for an *ad hoc* register listing GIs, the establishment of an administrative control system designed to safeguard the traceability of the product, the assurance that a GI can be used by any operator and the obligation to accompany the application with precise "product specifications"[436] are all commitments that the US system, based on trademark law, does not require.

Moreover, as already mentioned, a number of EU GIs with market potential are automatically recognised *via* the agreement itself without the need to go through

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[435] KORUS, Article 18.2, footnote 5. See in this context B. O'CONNOR, *The European Union and the United States: Conflicting Agendas on Geographical Indications - What's happening in Asia?*, *op. cit.*, p. 66.

[436] KOREU, Article 10.18 paragraph 6.

national procedures including oppositions[437] and this might result in sharp contrast with the obligation to always ensure the possibility to challenge an application as stated in KORUS[438].

Finally, the administrative enforcement required by KOREU[439], typical of a *sui generis* system of GI protection, does not find room in the trademark approach where the enforcement is based on the private initiative of the owner of the mark[440].

2.3.3 *The level of protection*

One of the most debated issue at the international level is precisely the type of protection granted to GIs. As already analysed in previous sections there is considerable difference. According to KOREU the level of protection should at least match that provided for by Article 23 of the TRIPs and be applicable to all those GIs mutually recognised through the agreement, including GIs for agricultural products and other foodstuffs[441], while under KORUS the protection should be limited to confusingly similar signs or at most to the basic level of protection as accorded by Article 22 of the TRIPs to products other than wines and spirits. In short, while the US requires proof that consumer be misled in order to protect a certain GI, the EU protects GIs as such, even in the absence of misleading practices, and even if the true origin is indicated, if it is used in translation or with expressions such "like", "type", "style"[442].

The real question is whether South Korea is able to combine these conflicting provisions so as to be compliant to both the Agreements. In fact, a label such as "feta

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[437] KOREU, Article 10.18 paragraph 3. See also OriGin, *Analysis of the relevant US legislation for the protection of GIs & Recommendations for Compromise Solutions on GIs in the TTIP Negotiations*, Ministero dello Sviluppo Economico, October 06, 2015, p. 31.

[438] KORUS, Article 18.2 paragraph 14.

[439] KOREU, Article 10.22.

[440] See above paragraph 2.2.2.

[441] OriGin, *Analysis of the relevant US legislation for the protection of GIs & Recommendations for Compromise Solutions on GIs in the TTIP Negotiations*, *op. cit.*, p. 31. See also Y.G YOON - T.H. JUNG, *Evaluation on the Geographical Protection of Korea According to Korea-EU FTA Settlement*, February 2010, p. 25.

[442] KOREU, Article 10.21 paragraph 1 letter (b).

made in the US" would be fully admissible under the KORUS while prohibited under the KOREU.

2.3.4 *The relationship with TMs*

Another difficult debate concerns the relationship between GIs and TMs previously registered in good faith. This conflict is solved, according to the KORUS, in light of the principle of priority[443], and according to the KOREU, in light of the principle of co-existence[444]. As Goebel and Groeschl noted, it is about a clash between two conflict resolution mechanisms and "the issue is which one should prevail: the trademark rules firmly built on priority, exclusivity, and territoriality or the *sui generis* rules built on the assumption that the 'common good' geographical indication is somehow superior to the private property right trademark and could therefore destroy its existence, or at least its exclusivity, irrespective of priority and territoriality"[445]. However, as long as the conflict stays within different jurisdictions it can be handled in some way, but when these two mechanisms are imposed in the same jurisdiction through FTAs then it comes the real problem. This is now the case for Korea. How is Korea going to manage this evident incompatibility? Can a GI be registered even if there is an identical or similar TM previously registered in good faith for similar goods?

De facto, a partial solution to this conflict has been given by the KOREU itself. The FTA recognises the need for co-existence only in relation to some GIs, namely those listed in the agreement or those that will be added to the lists according to the procedure established under Article 10.24 of the FTA, rather than establishing a basis for co-existence between TMs and GIs as a general principle. Co-existence seems to be limited to a list of specific names and therefore when this list is accepted and officially recognised by the other country the problem is solved, meaning that there is no need to change the entire system of GI protection to comply with this provision.

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[443] KORUS, Article 10.2 paragraph 4 and 15.

[444] KOREU, Article 10.21 paragraph 5.

[445] B. GOEBEL - M. GROESCHL, *The Long Road to Resolving Conflicts between Trademarks and Geographical Indications*, *op. cit.*, p. 834.

It is enough to give protection to the GIs annexed to KOREU notwithstanding the existence of an identical or similar already registered TM. Producers of EU GIs will be allowed to rely on their listed GIs to claim protection in South Korea and to introduce a judicial action without the need to register first the GIs in question before the relevant Korean authorities.

2.3.5 *Generic terms*

Article 24.6 of the TRIPs Agreement allows Member to grandfather the use of a GI which has been legally deemed to be generic in their territory. Both the Agreements, in principle, recognise this exception. However the EU, in Annex 10-A and Annex 10-B, listed a number of GIs to be granted automatic and absolute protection in South Korea thus taking away the opportunity for stakeholders with an interest in the Korean market to present arguments that the GIs at issue were in fact generic names. As a result of the entrance into force of the KOREU certain US dairy products normally sold around the world under names identical to the ones listed in the Annexes (such as "gorgonzola", "feta", "asiago" and "fontina"), on the basis that those names are considered generic in the US, have been prevented from being imported in South Korea. This, not surprisingly, caused furious protests from the US dairy industry[446]. The Consortium for Common Food Names (CCFN), representing mainly the dairy industry, has accused the EU of using its FTAs as a trade barrier and as a mean to claw back the use of common names of certain dairy products for the sole use of EU producers[447]. Illustrative of the US concerns over this issue is the exchange of letters between the USTR Ambassador, Mr. Kirk, and the Korean

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[446] K. TROJANOVÀ, *Intellectual Property Rights in Preferential Trade Agreements: The Comparison of KORUS FTA and EU-South Korea FTA*, *op. cit.*, p. 7. See also W.H. COOPER - R. JURENAS - M.D. PLATZER - M.E. MANYIN, *The EU-South Korea Free Trade Agreement and Its Implications for the United States*, Congressional Research Service (CRS), January 5, 2011.

[447] Testimony of Shawna Morris Vice President of Trade Policy U.S. Dairy Export Council & National Milk Producers Federation to the United States Committee on Finance Subcommittee on International Trade, Customs and Global Competitiveness, *The U.S.-Korea Free Trade Agreement: Lessons Learned Two Years Later*, July 29, 2014. See also B. O'CONNOR, *The European Union and the United States: Conflicting Agendas on Geographical Indications - What's happening in Asia?*, *op. cit.*, p. 68.

Minister of Trade, Mr. Kim, just before the entrance into force of the KOREU[448]. Mr. Kirk, expressing the US industry's worries, asked for clarifications on the GIs provisions in the FTA with the EU[449]. Mr. Kim, in his answer[450], tried to reassure the US Government that most of the GI terms set forth in Annex 10-A were compound terms, i.e. "Brie de Meaux", "Emmental de Savoie", "Grana Padano", "Mozzarella di Bufala Campana", "Parmigiano Reggiano", "Pecorino Romano" and "Provolone Valpadana", and therefore any restriction imposed on the use of these indications would pertain only to the protection of the compound terms in their entirety and not of the individual components which would be freely usable by anybody, i.e. "grana", "parmigiano", "provolone" or "romano"[451]. However, the complaint advanced by the Consortium for Common Food Names and the clarifications required by the US Trade Representatives seem to be based on an erroneous interpretation of the TRIPs exception. The fact that certain names are deemed generic in the US in no way implies that in South Korea these terms have to be considered generic as well since the entire concept of genericness is limited by the principle of territoriality. And this is clear from the wording of Article 24.6 of the TRIPs which provides that: "nothing in this Section shall require a Member to apply its provisions in respect of a geographical indication of any other Member with respect to goods or services for which 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". Therefore, in the absence of any judicial decision or public consultation

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[448] K. TROJANOVÀ, *Intellectual Property Rights in Preferential Trade Agreements: The Comparison of KORUS FTA and EU-South Korea FTA*, *op. cit.*, p. 7.

[449] Official Letter sent by Ambassador Ron Kirk to the Minister of Trade in the Republic of Korea Jong-hoon Kim on June 09, 2011, available at: https://ustr.gov/sites/default/files/uploads/pdfs/PDFs/December%202012/060911%20Kirk-Kim%20Letter%20on%20GIs.PDF. However it has to be stressed that these guidelines are not an authentic interpretation of the FTA and therefore they do not have any binding effect.

[450] Official Letter sent by the Minister of Trade in the Republic of Korea Jonh-hoon Kim to Ambassador Ron Kirk on June 20, 2011, available at: https://ustr.gov/sites/default/files/uploads/pdfs/PDFs/December%202012/062011%20Kim-Kirk%20Letter%20on%20GIs.pdf.

[451] In the Official Letter sent by the Minister of Trade in the Republic of Korea Jonh-hoon Kim to Ambassador Ron Kirk, the Korean Minister tries to reassure its American partners on the freely availability of the term "romano" instead of "pecorino". The term "romano" is only an adjective and thus freely usable by anybody. The concerns were related to the use of the individual term "pecorino" and the Korean Minister did not say anything in this respect. This mistake testifies the unfamiliarity of Koreans with respect to European GIs and the difficulties, for a non-EU national, to distinguish between a GI and its descriptive specification.

aimed at demonstrating the genericness of certain GIs in South Korea, the indications listed in the Annexes of the KOREU seems to be fully respectful of the exception under Article 24.6 of the TRIPs. Rather, it would be in breach of the TRIPs Agreement if a GI not generic in Korea would not be protected because it is considered generic in the US.

This being said, however, the inclusion of a list of names, which are deemed generic in the US, to be protected automatically in a third country, remains the most debated issue between the US and the EU at the international level[452] and it is of interest to see if and how South Korea actually implemented the Korea-EU FTA prohibiting these contentious indications from entering the Korean market.

3. New hurdles on the horizon: the recent TPP, EUSFTA and EUVFTA

3.1 ASEAN countries and their approach to GIs

Before analysing the current trade dialogue between the US, the UE and ASEAN countries it might be useful to briefly clarify what ASEAN is and which is the *status* of FTAs in that region.

On August 1967, leaders of five nations in the Asia-Pacific Region, namely Indonesia, Malaysia, Philippines, Singapore and Thailand, sat down together and signed a document, also known as the ASEAN Declaration. By virtue of that document, the Association of Southeast Asian Nations (hereinafter referred to as ASEAN) was born. The aims and purposes of the Association were about cooperation in economic, social, cultural, technical, educational fields and in the promotion of regional peace and stability endorsing the principles of the United Nations Charter[453]. Later in time, other five countries joined the Association: Brunei

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[452] See C. VIJU, *CETA and Geographical Indicators: Why a Sensitive Issue?*, Canada-Europe Transatlantic Dialogue: Seeking Transnational Solutions to 21st Century Problems, CETA policy Briefs Series, October 2013, available at: http://carleton.ca/ces/wp-content/uploads/CETD_CETA-policy-brief_GIs_Viju.pdf ((last viewed on January 2, 2016).

[453] Association of SouthEast Asian Nations, History, at: http://www.asean.org/asean/about-asean/history/ (last viewed on January 2, 2016).

Darussalam (1984), Vietnam (1995), Lao PDR (1997), Myanmar (1997) and Cambodia (1999), making up what is today the ten Member States of ASEAN[454].

By the early 90s, ASEAN founding members plus Brunei Darussalam decided to establish a Free Trade Area with the aim to eliminate tariff barriers among Southeast Asian countries, to integrate the ASEAN economies into a single production base and to create a regional market of 500 million people[455]. Thus, on 28 January 1992, the Agreement on the Common Effective Preferential Tariff (CEPT) Scheme for the ASEAN Free Trade Area (AFTA) was adopted and AFTA established[456]. Vietnam, Lao PDR, Myanmar and Cambodia became members of AFTA when they joined the ASEAN. The realisation of AFTA was not only an essential step towards regional economic integration in ASEAN but constituted also an important building block for economic cohesion in the larger Asia-Pacific region, bringing together the economies of Northeast Asia, Australia and New Zealand with those of Southeast Asia[457]. In fact, after the establishment of the WTO, ASEAN as a regional block, has entered into five Free Trade Agreements with dialogue partners[458]: the ASEAN and China Comprehensive Economic Cooperation Agreement (November 2004)[459], the ASEAN and Korea Comprehensive Economic Cooperation Agreement (December 2005)[460], the ASEAN and Japan Comprehensive Economic Partnership Agreement (April

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[454] Association of SouthEast Asian Nations, Overview, at: http://www.asean.org/asean/about-asean/overview/ (last viewed on January 2, 2016).

[455] ASEAN Secretariat, *Southeast Asia a Free Trade Area*, Jakarta, Indonesia, 2002, p. 1.

[456] Agreement on the Common Effective Preferential Tariff Scheme for the ASEAN Free Trade Area, Singapore, January 28, 1992, available at: https://web.archive.org/web/20090414223453/http://www.asean.org:80/12375.htm (last viewed on January 3, 2016).

[457] ASEAN Secretariat, *Southeast Asia a Free Trade Area*, *op. cit.*, p. 8.

[458] T. WATTANAPRUTTIPAISAN, *The Topology of ASEAN FTA, with special reference to IP-Related Provisions,* in, *Intellectual Property and Free Trade Agreements in the Asia-Pacific Region*, C. Antons - R.M. Hilty (eds.), Springer, 2015, p. 127. For more information on these FTAs see ASEAN Economic Community Portal, Free Trade Agreements with Dialogue Partners, at: https://web.archive.org/web/20120105091802/http://www.asean.org/22935.htm

[459] Agreement on Trade in Goods under the Framework Agreement on Comprehensive Economic Co-operation between the Association of Southeast Asian Nations and the People's Republic of China, Vientiane, November 29, 2004, available at: https://web.archive.org/web/20091212224131/http://www.asean.org/16646.htm (last viewed on January 3, 2016).

[460] Agreement on Trade in Goods and Agreement on Trade in Services, both under the Framework Agreement on Comprehensive Economic Cooperation Among the Governments of the Member Countries of the Association of Southeast Asian Nations and the Republic of Korea, Kuala Lampur, December 13, 2005, available at: https://web.archive.org/web/20080623121113/http://www.asean.org/18063.htm (last viewed on January 3, 2016).

2008)[461], the ASEAN-Australia-New Zealand FTA (February 2009)[462] and the ASEAN-India FTA (August 2009)[463]. The increase in FTAs was the ASEAN's strategic response to the changed environment in development and globalisation[464], characterised by an intensification of FTA activity in the EU and in the US and by a stalled WTO Doha Round trade talks.[465].

This being said, however, the initiative of ASEAN's single members in pursuing FTAs in their own capacity separate from their membership in ASEAN is not inconsistent with their obligations under AFTA. In particular, in the field of IP, the ASEAN Framework Agreement on Intellectual Property Cooperation has a provision which expressly preserves the right of any member state to enter into any future bilateral or multilateral agreement relating to the protection and enforcement of IP[466]. Thus, many ASEAN countries decided to broaden their market network entering also into stand alone negotiations with many developed countries. As a consequence, since the financial crisis of 1997/1998, Southeast Asia have become the most active region for the negotiation of preferential trade agreements[467]: by 2015, ASEAN countries had signed 103 PTAs and others were under negotiation[468].

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[461] Agreement on Comprehensive Economic Partnership among Japan and Member States of the Association of Southeast Asian Nations, April 14, 2008, available at: http://www.mofa.go.jp/policy/economy/fta/asean/agreement.pdf (last viewed on January 3, 2016).

[462] Agreement Establishing the ASEAN-Australia-New Zealand Free Trade Area, Cha-am, Thailand, February 27, 2009, available at: https://www.mfat.govt.nz/assets/_securedfiles/FTAs-agreements-in-force/AANZFTA-ASEAN/Agreement-Establishing-the-ASEAN-Australia-New-Zealand-Free-Trade-Area-1.pdf (last viewed on January 3, 2016).

[463] Agreement on Trade in Goods under the Framework Agreement on Comprehensive Economic Cooperation between the Republic of India and the Association of Southeast Asian Nations, Bangkok, August 13, 2009, available at: https://web.archive.org/web/20111216073535/http://www.asean.org/22677.pdf (last viewed on January 3, 2016).

[464] T. WATTANAPRUTTIPAISAN, *The Topology of ASEAN FTA, with special reference to IP-Related Provisions, op. cit.*, p. 110.

[465] M. KAWAI - G. WIGNARAJA, *Patterns of Free Trade in Asia*, East West Center, Honolulu, Hawaii, 2013, p. *xiv*.

[466] Article 6 of the ASEAN Framework Agreement on Intellectual Property Cooperation, Bangkok, Thailand, December 15, 1995, available at: http://www.wipo.int/wipolex/en/other_treaties/text.jsp?file_id=204026 (last viewed on January 4, 2016). See also W.L. NG-LOY, *IP and FTAs of Singapore: Ten Years On*, in *Intellectual Property and Free Trade Agreements in the Asia-Pacific Region*, C. Antons - R.M. Hilty (eds.), Springer, 2015, p. 340.

[467] J. RAVENHILL, *What Drives Regionalism in East Asia - And Why It Matters?*, in *Intellectual Property and Free Trade Agreements in the Asia-Pacific Region*, C. Antons - R.M. Hilty (eds.), Springer, 2015, p. 88.

[468] Source: Asian Development Bank, 2015, Table 6: *FTAs Status by Country/Economy*, available at: https://aric.adb.org/fta (last viewed on January 4, 2016).

According to an authoritative opinion, this explosion of free trade deals has been driven as much by diplomatic as by commercial considerations[469]. Revenhill talks about a "political domino effect" where government's primary concern is their potential exclusion from a new dimension of "regional economic diplomacy" and where the content of PTAs itself is a direct reflection of political over economical motivation[470]. With the governments giving priority to doing what is necessary to become participant in the new regime of PTAs, one consequence has been the privileging of form over content: it has become more important to have an agreement, even if inconsequential in terms of economic outcomes, than to not have one at all. Another consequence has been that the outcome of the negotiations, in most of the cases, had been influenced by the party with more bargaining power[471].

This is the general context where the recently concluded FTAs discussed below have to be inserted and understood.

With regard to systems for the protection of GIs in Asia, it must be stressed that GIs had not been treated as a separate category of IPRs in ASEAN Member States (hereinafter referred to as AMS) before they were inserted in TRIPs as a new class of intellectual property asset[472]. Notably none of the ASEAN countries has acceded to the Madrid Agreement of 1891 or to the Lisbon Agreement of 1958, which represented the most significant advance in GI recognition prior to TRIPs[473]. Thus, before 1994, ASEAN countries protected GIs under TM law or under unfair competition and consumer protection law. With the adoption of the WTO Agreement, new laws and implementing rules were subsequently introduced by many states so as

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469 J. RAVENHILL, *What drives Regionalism in East Asia - And Why It Matters*, *op. cit.*, p. 98.

470 J. RAVENHILL, *What drives Regionalism in East Asia - And Why It Matters*, *op. cit.*, p. 88. In this context, see also N. MUNAKATA, *Has politics caught up with markets? In search of East Asian economic regionalism*, in *Beyond Japan: the dynamics of East Asian regionalism*, P.J. Katzenstein, T. Shiraishi (eds.), Cornell University Press, Ithaca, 2006, pp. 130-157; and C.M. DENT, *New Free Trade Agreements in the Asia-Pacific*, Palgrave Macmillan, Basingstoke, 2006.

471 J. RAVENHILL, *What drives Regionalism in East Asia - And Why It Matters*, *op. cit.*, p. 99.

472 T. WATTANAPRUTTIPAISAN, *Trademarks and Geographical Indications: Policy Issues and Options in Trade Negotiations and Implementation*, in *Asian Development Review*, Vol. 26, No. 1, 2009, p. 170.

473 It must be noticed, however, that seven AMS, with the exception of Brunei Darussalam, Lao PDR and Myanmar, are signatories to the Paris Convention of 1883. See T. WATTANAPRUTTIPAISAN, *Trademarks and Geographical Indications: Policy Issues and Options in Trade Negotiations and Implementation*, *op. cit.*, p. 170.

to comply with TRIPs *minimum* requirements, although not in a uniform way. Indonesia, Malaysia, Thailand Vietnam and Lao PDR established a specific registration system for GIs. Singapore and Philippines amended their law as to protect GIs as a new class of IPRs but still using the existing TM system[474].

This being said, in all ASEAN countries, the scope of coverage of the GI system adopted includes non-food GIs, such as textiles and silks, which represent one of the strongest statements of ASEAN's rich, cultural heritage and natural environment[475]. Nevertheless, the number of registered GIs in the region is still very low and this may be due to the little precedent regarding GIs before TRIPs, to the limited institutional capabilities and resources for examination and registration and to the inadequate local awareness of GI application requirements and GI benefits[476]. *De facto*, those countries are at the early stages of fully developing and exercising their GI regime.

The paper will proceed analysing preferential agreements recently concluded by some of these countries with the EU, namely, the EU-Singapore and the EU-Vietnam FTA; and with the US, namely the US-Singapore FTA and the TPP, the Trans-Pacific Partnership Agreement.

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[474] T. WATTANAPRUTTIPAISAN, *Trademarks and Geographical Indications: Policy Issues and Options in Trade Negotiations and Implementation*, *op. cit.*, p. 170.

[475] See, e.g., for Indonesia: Article 2 paragraph 2 of "Government Regulation of the Republic of Indonesia, Number 51 Year 2007 Regarding Geographical Indication", available at: http://www.wipo.int/wipolex/en/text.jsp?file_id=226919; for Malaysia: Section 2 of "Geographical Indication Act 2000", available at: http://www.wipo.int/wipolex/en/text.jsp?file_id=128846; for Singapore: Section 2 of "Geographical Indication Act 1998", available at: http://www.wipo.int/wipolex/en/text.jsp?file_id=129655; for Thailand: Section 3 paragraph 3 of "Act on Protection of Geographical Indication B.E. 2546 (2003)", available at: http://www.wipo.int/edocs/lexdocs/laws/en/th/th023en.pdf . The "Law on Intellectual Property" of Vietnam, in its Section 6, and the "Law on Intellectual Property" of Lao PDR, do not specify boundaries of protected GIs. See T. WATTANAPRUTTIPAISAN, *Trademarks and Geographical Indications: Policy Issues and Options in Trade Negotiations and Implementation*, *op. cit.*, p. 180.

[476] T. WATTANAPRUTTIPAISAN, *Trademarks and Geographical Indications: Policy Issues and Options in Trade Negotiations and Implementation*, *op. cit.*, p. 181.

3.2 The US and ASEAN countries

The US has been a dialogue partner of ASEAN since 1977[477]. In 2002 the US President announced the Enterprise for ASEAN Initiative (EAI) with the aim of strengthening the already deep trade and investment relationship between the parties and, in further support to these objectives, in 2006, the Trade and Investment Framework Arrangement between the US and ASEAN was signed[478]. However, an ASEAN-US FTA is far from being launched and, up to today, it remains an open possibility only[479]. Given the difficulties to negotiate a preferential agreement with ten Asian countries as a block, the US satisfied its need to enter the Southeast Asian market by concluding free trade deals individually with Singapore, Brunei Darussalam, Malaysia and Vietnam[480].

3.2.1 *US-Singapore FTA*

The US-Singapore Free Trade Agreement[481] (hereinafter referred to as USSFTA) was signed in Washington DC on 6 May 2003 and entered into force on 1 January 2004[482]. It was the first comprehensive US FTA with an Asian country[483].

The deal contains a long chapter on IP which, among others, covers TMs and GIs[484]. Like in KORUS, Article 16.2 of USSFTA refers to GIs as a subset of TMs and requires each party to provide that TMs "shall include service marks, collective

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[477] ASEAN Secretariat's Information Paper, *Overview of ASEAN-U.S. Dialogue Relations*, January 4, 2016, available at: http://www.asean.org/storage/2016/01/4Jan/Overview-of-ASEAN-US-Dialogue-Relations-(4-Jan-2016).pdf (last viewed on January 5, 2016).

[478] T. WATTANAPRUTTIPAISAN, *The Topology of ASEAN FTA, with special reference to IP-Related Provisions, op. cit.*, p. 125. The text of the Trade and Investment Framework Arrangement between the United States of America and the Association of Southeast Asian Nations is available at: https://ustr.gov/sites/default/files/uploads/agreements/tifa/asset_upload_file932_9760.pdf (last viewed on January 5, 2016).

[479] T. WATTANAPRUTTIPAISAN, *The Topology of ASEAN FTA, with special reference to IP-Related Provisions, op. cit.*, p. 126.

[480] See below paragraph 3.2.1 and 3.2.2.

[481] The text of the United States-Singapore Free Trade Agreement is available at: https://ustr.gov/sites/default/files/uploads/agreements/fta/singapore/asset_upload_file708_4036.pdf.

[482] USTR, *Singapore FTA*, at: https://ustr.gov/trade-agreements/free-trade-agreements/singapore-fta.

[483] M. KAWAI - G. WIGNARAJA, *Asia's Free Trade Agreements: How is Business Responding?*, Asian Development Bank and the ADB Institute, Edward Elgar, Cheltenham, UK, 2011, p. 30.

[484] W.L. NG-LOY, *IP and FTAs of Singapore: Ten Years On*, *op. cit.*, p. 342.

marks and certification marks and may include geographical indications"[485]. Its definition resembles that of TMs: "a geographical indication shall be capable of constituting a trademark to the extent that the geographical indication consists of any sign, or combination of signs, capable of identifying a good as originating in the territory of a Party, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good or service is essentially attributable to its geographical origin"[486]. As for the relationship between TMs and GIs, the treaty clearly affirms the prevalence of TMs. The TM's owner has the exclusive right to prevent all third party not having the owner's consent from using identical or similar signs, *including GIs*, for related goods or services if such use would result in a likelihood of confusion[487]. This Article is interesting because it enlarges the benchmark to evaluate confusion from "identical or similar" goods to "related" goods. All these provisions clearly reflect the US approach to GIs.

The bilateral treaty under analysis, as of today, is the one governing the trade relationship between Singapore and the US. However, when the recently concluded Trans-Pacific Partnership, which includes Singapore and the US as contracting parties, will enter into force, this latter agreement will prevail over the earlier one in accordance to Article 30 of the Vienna Convention on the law of treaties which provides as follow: "when all the parties to the earlier treaty are parties also to the later treaty but the earlier treaty is not terminated or suspended in operation under article 59, the earlier treaty applies only to the extent that its provisions are compatible with those of the later treaty"[488]. Therefore the USSFTA provisions will be probably superseded in the near future.

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[485] USSFTA, Article 16.2 paragraph 1.

[486] USSFTA, Article 16.2 paragraph 1, footnote 16-6.

[487] USSFTA, Article 16.2 paragraph 2.

[488] Vienna Convention on the law of treaties, Vienna, May 23, 1969.

3.2.2 *The Trans-Pacific Partnership*

The Trans-Pacific Partnership Agreement (hereinafter referred to as TPP)[489] between twelve countries: the US, Australia, Canada, Japan, Brunei, Chile, Malaysia, Mexico, New Zealand, Peru, Singapore and Vietnam[490], seeks to expand the US approach to GIs in Asia. This Agreement, unlike all other US FTAs, contains detailed provisions in relation to GIs and its provisions seem to be specifically targeted against the EU policy on GIs in Asia[491]. On October 4, 2015 an agreement in principle has been reached and Ministers of the twelve countries announced the conclusion of the negotiations. More recently, on February 4, the Agreement has been signed by the TPP Ministers in Auckland, New Zealand[492]. The result is an ambitious, comprehensive and high-standard trade deal and an important platform for regional integration across the Asia-Pacific region[493].

Officials in Seoul have recently showed their interest in joining the Agreement. While, initially, they decided not to participate to the negotiations due to the fact that Korea already had in place bilateral free trade deals with ten of the twelve TPP founding members, lately, they have expressed concerns about being outside the

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[489] On October 4, 2015, Ministers of the twelve Trans-Pacific Partnership countries announced conclusion of their negotiations. See USTR, *Summary of the Trans-Pacific Partnership Agreement*, at: https://ustr.gov/about-us/policy-offices/press-office/press-releases/2015/october/summary-trans-pacific-partnership (last viewed on November 29, 2015).

[490] See USTR, *The Trans-Pacific Partnership*, at: https://ustr.gov/tpp/ (last viewed on November 29, 2015). In this context it is important to remind that Canada, Singapore and Vietnam have recently concluded an FTA with the EU. For more informations see: European Commission, Canada, at: http://ec.europa.eu/trade/policy/countries-and-regions/countries/canada/; European Commission, Singapore, at: http://ec.europa.eu/trade/policy/countries-and-regions/countries/singapore/; and European Commission, Vietnam, at: http://trade.ec.europa.eu/doclib/press/index.cfm?id=1358.

[491] B. O'CONNOR, *The European Union and the United States: Conflicting Agendas on Geographical Indications - What's happening in Asia?*, *op. cit.*, p. 67.

[492] USTR, *Trans-Pacific Partnership Ministers' Statement*, February 4, 2016, at: https://ustr.gov/about-us/policy-offices/press-office/press-releases/2016/February/TPP-Ministers-Statement. See also Global Affairs Canada, *Trans-Pacific Partnership*, at: http://www.international.gc.ca/trade-agreements-accords-commerciaux/agr-acc/tpp-ptp/index.aspx?lang=eng (last viewed on February 76, 2016).

[493] USTR, *Summary of the Trans-Pacific Partnership Agreement*, at: https://ustr.gov/about-us/policy-offices/press-office/press-releases/2015/october/summary-trans-pacific-partnership.

Agreement particularly as important competitors, like Japan, benefit from reduced trade barriers in many of the same export industries as a consequence of TPP[494].

The main purpose of TPP in relation to GIs is well stated in a recently published overview of the IP Chapter of the Agreement which expressly affirms that the FTA aims at keeping generic terms available for US producers: "the chapter helps address the potential for inappropriately 'overprotecting' geographical indications in ways that shut the U.S. agricultural and food producers, including by providing opportunities for due process and requiring guidelines on how TPP partners should determine whether a term is generic in its market, as well as safeguards for owners of pre-existing trademarks"[495].

Four provisions in the TPP mainly reflect the US approach: Article 18.32 "Grounds of Opposition and Cancellation", Article 18.33 "Guidelines for Determining Whether a Term is the Term Customary in the Common Language", Article 18.34 "Multi-Component Terms" and Article 18.36 "International Agreements"[496].

According to Article 18.32 paragraph 1, among the grounds of opposition and cancellation of a GI, beside the usual circumstance of the GI being confusingly similar to a pre-existing TM, letter (c) adds the case of the GI being a term customary in common language as the common name for the relevant good in the territory of the Party. Again, the same Article at paragraph 2 expressly affirms the possibility for a regularly registered and protected GI to be cancelled on the basis of a potential

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[494] K. JUN, *South Korea Reiterates Interest in Trans-Pacific Partnership*, in *The Wall Street Journal*, October 5, 2015, available at: http://www.wsj.com/articles/south-korea-reiterates-interest-in-trans-pacific-partnership-1444057143. See also J.J. LEE, *The Truth About South Korea's TPP Shift*: *A look at the reason behind Seoul's recent rethinking*, Centre for Strategic & International Studies, online version, October 21, 2015, available at: http://csis.org/publication/pacnet-70-seoul-rethinks-tpp (last viewed on January 8, 2015).

[495] Office of the United States Trade Representative, *Overview on Chapter 18: Intellectual Property*, November 5, 2015, available at: https://medium.com/the-trans-pacific-partnership/intellectual-property-3479efdc7adf#.jcqjgds85 (last viewed on January 8, 2015).

[496] The final text of the TPP has been officially published on November 5, 2015 on the USTR website. The content of the mentioned Articles is available at: https://medium.com/the-trans-pacific-partnership/intellectual-property-3479efdc7adf#.srrr9zc5s. (last viewed on January 8, 2015).

subsequent genericness[497]. In other worlds, under the TPP, a registered GI can become generic and be cancelled on that basis.

On the other hand, Article 18.33 gives some guidelines on how to determine whether a term is generic in the territory of a Party: "Party's authorities shall have the authority to take into account how consumers understand the term in the territory of that Party. Factors relevant to such consumer understanding may include: (a) whether the term is used to refer to the type of good in question, as indicated by competent sources such as dictionaries, newspapers and relevant websites; and (b) how the good referenced by the term is marketed and used in trade in the territory of that Party". Moreover, Party's authorities may also take into account how the term is used in relevant international standards[498]. This last addition, referring to international standards as a *criterion* for the evaluation of genericness, seems to open the possibility for an extra-territoriality effect of this exception: a GI term may be considered generic in one country (e.g. Japan) because it has been used, in relevant international standards recognised by the Parties, to refer to a type or class of goods. Examples of relevant international food standards might be the once established under the *Codex Alimentarius*, a code adopted in 1961 and jointly administered by the Food and Agriculture Organization of the United Nations (FAO) and by the World Health Organization (WHO)[499]. The *Codex* establishes a collection of standards and product descriptions for a variety of foods with the aim to ensure food security and consumer protection[500]. Among others it lists the standards required for

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[497] Stewart and Stewart, *The Trans-Pacific Partnership, A Side-by-Side Comparison with: The United States - Colombia Trade Promotion Agreement of 2012; The United States - Korea Free Trade Agreement of 2012; the United States - Peru Free trade Agreement of 2009*, Comparison, Vol. 3, TPP Chapter 18: Intellectual Property, 2015, p. 20.

[498] TPP, Article 18.33, footnote 24. See *The Trans-Pacific Partnership, A Side-by-Side Comparison with: The United States - Colombia Trade Promotion Agreement of 2012; The United States - Korea Free Trade Agreement of 2012; the United States - Peru Free trade Agreement of 2009*, *op. cit.*, p. 23.

[499] C. MACMAOLAIN, *EU Food Law: Protecting Consumer and Health in Common Market*, Hart Publishing, Portland, Oregon, 2007, p. 151. For more information see Food and Agriculture Organization of the United Nations (FAO), *Codex Alimentarius*, at: http://www.codexalimentarius.org/about-codex/codex-timeline/en/.
According to C. MACMAOLAIN the idea behind the *Codex Alimentarius* came from a system of food codes used in the Austro-Hungarian Empire between 1897 and 1911 known as the *Codex Alimentarius Austriacus.*

[500] C. MACMAOLAIN, *EU Food Law: Protecting Consumer and Health in Common Market*, *op. cit.*, p. 152.

a cheese to be qualified as "Brie", "Provolone", "Cheddar", "Camembert", "Emmental" or "Mozzarella"[501]. Thus implicitly affirming that those terms are considered as common food names by the international community[502].

Article 18.34 requires Parties not to prohibit a third party's use of any individual component of a multicomponent protected GI if that component is the term customary in the common language as the common name for the associated good[503]. This Article expressly says, taking away all room for a different interpretation, that a multicomponent term, e.g. "Brie de Meaux", is protected only in its entirety while the individual term "Brie" would be freely available.

Finally, Article 18.36 is specifically designed to prevent future international agreements from granting automatic protection to a pre-established list of GIs without giving the opportunity for interested parties to oppose those applications. Exempted from this provision are only GIs for wines and spirits[504] and those GIs listed in international agreements that: (a) have already been concluded or agreed in principle by that Party prior to the date of conclusion or agreement in principle of TPP[505]; (b) have been ratified by that Party prior to the date of ratification of TPP; (c)

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[501] Data available at: http://www.codexalimentarius.org/standards/list-standards/en/?no_cache=1.

[502] On the indicative value of the rules of the *Codex Alimentarius* see in the EU case law: Ministère public v. Gérard Deserbais, Case C-286/86, (1988) E.C.R. I-4907, paragraph 15; Guimont, Case C-448/98, (2000) E.C.R. I-10663, paragraph 32. However, questions may arise as to whether *Codex* standards can be taken as a an "enforceable" point of reference with regard to IPRs. In fact, it should be kept in mind that *Codex* standards can be adopted by non-consensual proceedings and therefore a certain name may be inserted in the list even without the approval of those CAC Member States where IPRs corresponding to these standards exist. According to an opinion that can be shared, non-unanimous approval of *Codex* standards, with no formal implementation in domestic law, cannot "overrule" basic principles of international IP and GI law, namely the principle of *pacta sunt servanda* (Vienna Convention on the Law of Treaties, Article 26) in relation to existing bilateral and multilateral treaties and the principle of territoriality of IPRs. See J. SIMON, *Geographical Indications (GIs), Trademarks and International Standards (e.g. Codex Alimentarius)*, in *Le Indicazioni di Qualità degli Alimenti*, B. Ubertazzi - E. M. Espada (eds.), Giuffrè Editore, Milano, 2009, p. 323.

[503] *The Trans-Pacific Partnership, A Side-by-Side Comparison with: The United States - Colombia Trade Promotion Agreement of 2012; The United States - Korea Free Trade Agreement of 2012; the United States - Peru Free trade Agreement of 2009*, *op. cit.,* p. 24.

[504] TPP, Article 18.36 paragraph 4.

[505] TPP, Article 18.36 paragraph 6, footnote 29, clarifies that "for the purpose of this Article, an agreement 'agreed in principle' means an agreement involving another government, government entity or international organization in respect of which a political understanding has been reached and the negotiated outcomes of the agreement have been publicly announced".

or have entered into force for that Party prior to the date of entry into force of TPP[506]. With regard to those GIs, Parties shall only provide an opportunity for interested persons to make comments but not to oppose their recognition.

This being clarified, Article 18.19 of TPP, reflecting Article 18.2 paragraph 2 of KORUS, requires each party to provide that GIs be capable of protection under its trademark system. As a consequence, the level of protection granted to GIs under TPP seems to be limited to confusingly similar signs[507]. Instead, unlike KORUS and USSFTA, the Agreement explicitly specifies that its provisions are without prejudice to Article 22 and 23 of the TRIPs[508]. Thus, expressly ensuring at least the *minimum* level of protection according to international standards.

TPP also reaffirms the principle of priority as the leading rule governing the relationship between TMs and GIs[509]. However, compared to Article 18.2 paragraph 4 of KORUS, this provision goes a little further, reproducing the text of USSFTA. While KORUS prohibits the use of GIs for identical or similar goods or services benefiting from a registered TM if such a use would result in a likelihood of confusion, the TPP replace the expression "identical or similar" with "related to", thus apparently enlarging the benchmark to evaluate the likelihood of confusion[510].

Lastly, in relation to the definition of GIs and their recognition procedure, TPP recalls the regime of KORUS. Thus, any sign or combination of signs shall be eligible for protection as a GI[511] and the steps required for its recognition find their

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[506] TPP, Article 18.36 paragraph 6. See also *The Trans-Pacific Partnership, A Side-by-Side Comparison with: The United States - Colombia Trade Promotion Agreement of 2012; The United States - Korea Free Trade Agreement of 2012; the United States - Peru Free trade Agreement of 2009*, *op. cit.*, pp. 24-26. See also A. DI MAMBRO, *Così il TPP affossa Dop e Igp: l'accordo USA-Pacifico tutela solo i marchi registrati*, ItaliaOggi, November 18, 2015.

[507] TPP, Article 18.20. See also *The Trans-Pacific Partnership, A Side-by-Side Comparison with: The United States - Colombia Trade Promotion Agreement of 2012; The United States - Korea Free Trade Agreement of 2012; the United States - Peru Free trade Agreement of 2009*, *op. cit.*, pp. 13-14.

[508] TPP, Article 18.20, footnote 12.

[509] TPP, Article 18.20 combined with Article 18.32 letter (a) and (b).

[510] B. O'CONNOR, *The European Union and the United States: Conflicting Agendas on Geographical Indications - What's happening in Asia?*, *op. cit.*, p. 67.

[511] TPP, Article 18.1 combined with Article 18.19, footnote 10. See *The Trans-Pacific Partnership, A Side-by-Side Comparison with: The United States - Colombia Trade Promotion Agreement of 2012; The United States - Korea Free Trade Agreement of 2012; the United States - Peru Free trade Agreement of 2009*, *op. cit.*, pp. 1-13.

roots in the need to ensure transparency and publicity and to always guarantee an opposition phase[512].

It is therefore evident that the possible participation of South Korea to the TPP Agreement could endanger even more the Korean's compliance with the EU FTA increasing the distance among the different provisions and putting new obstacles on the table[513].

3.3 The EU and ASEAN countries

The ASEAN-EU dialogue was formalised in 1977, when the 10th ASEAN Foreign Ministers Meeting agreed on ASEAN's formal cooperation with the European Economic Community (ECC), and institutionalised in 1980, with the signing of the ASEAN-ECC Cooperation Agreement. Since then, relations have rapidly grown and expanded to cover a wide range of areas including economics and trade[514]. In 2006 in "Global Europe"[515] a bloc-to-bloc FTA with ASEAN was a top priority[516]. Thus, in July 2007 negotiations for an ASEAN-EU FTA were launched, however, they progressed slowly and both sides agreed to pause the negotiations in March 2009[517]. In fact, ASEAN countries' needs and preferences were too diverse, in particular on issues like government procurement and intellectual property rights,

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[512] TPP, Article 18.31. See *The Trans-Pacific Partnership, A Side-by-Side Comparison with: The United States - Colombia Trade Promotion Agreement of 2012; The United States - Korea Free Trade Agreement of 2012; the United States - Peru Free trade Agreement of 2009*, *op. cit.*, p. 19.

[513] See in this context: A. DI MAMBRO, *Così il TPP affossa Dop e Igp: l'accordo USA-Pacifico tutela solo i marchi registrati*, *op. cit.*. This Article shows some interesting opinions on the TPP. "Si intravede nel Tpp una visione chiaramente americana dato che l'accordo protegge ad oltranza i marchi commerciali e ignora la natura legale delle Ig". Stefano Fanti, director of the Consorzio del Prosciutto di Parma. "Il rischio che le regole fatte nel trattato per il Pacifico condizionino i futuri accordi dell'Ue con gli Stati dell'area e non solo, è concreto". Paolo de Castro, member of the Europarliament.

[514] ASEAN Secretariat's Information Paper, *Overview of ASEAN-U.S. Dialogue Relations*, January 2015, available at: http://www.asean.org/?static_post=overview-of-asean-eu-dialogue-relations (last viewed on January 6, 2016).

[515] See above paragraph 1.1.

[516] M. GARCIA, *Competitive Fears: The EU, US and Free Trade Agreements in East Asia*, *op. cit.*, p. 68.

[517] T. WATTANAPRUTTIPAISAN, *The Topology of ASEAN FTA, with special reference to IP-Related Provisions, op. cit.*, p. 122.

and the EU ambitious and comprehensive approach further complicated matters[518]. Given the difficulties to pursue a regional FTA, in March 2010, the EU Trade Commissioner Karel De Gucht stated that the EU would seek bilateral negotiations with individual Asian countries as building blocks towards the ASEAN-FTA[519]. To this end, in the same year, the EU launched negotiations with Singapore, Vietnam and Malaysia, the most significant states in ASEAN[520].

3.3.1 *The EU-Singapore FTA*

The EU and Singapore officially concluded the negotiations for a comprehensive free trade agreement on 17 October 2014[521]. The FTA needs now to be formally approved by the European Commission and by the Council of Ministers and then ratified by the European Parliament and by the Singapore National Assembly[522]. However, two issues are delaying the ratification process both in the EU and in Singapore. Singapore has issued a Consultation Paper[523] to obtain views from local or foreign stakeholders as to whether any of the 196 proposed GIs listed in the Agreement are generic or registered as TMs or otherwise well known in

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[518] M. GARCIA, *Competitive Fears: The EU, US and Free Trade Agreements in East Asia*, *op. cit.*, p. 69. See also A. POLLET-FORT, *The EU-Korea FTA and Its Implications for the Future EU-Singapore FTA*, *op. cit.*, p. 22.

[519] ASEAN Secretariat's Information Paper, *Overview of ASEAN-U.S. Dialogue Relations*, *op. cit.*.

[520] M. GARCIA, *Competitive Fears: The EU, US and Free Trade Agreements in East Asia*, *op. cit.*, p. 69

[521] It should be notated that, on 17 October 2014, Singapore and the EU concluded the negotiations of the Investment Protection Chapter of the EU-Singapore FTA thus marking the successful conclusion of the negotiations of the entire EUSFTA. However, negotiations on trade in goods and services had been concluded already on 16 December 2012. Negotiations on the investment protection started later based on a new EU competence under the Lisbon Treaty. See Ministry of Trade and Industry, Singapore, *Singapore and the European Union concluded Investment discussions under EUSFTA*, press release, 17 October 2014, available at:https://www.mti.gov.sg/MTIInsights/SiteAssets/Pages/EUSFTA/17%20Oct%202014%20 and Ministry of Trade Industry, Singapore, *European Union-Singapore Free Trade Agreement moves one step closer to Ratification*, press release, 20 September 2013, available at: https://www.mti.gov.sg/MTIInsights/SiteAssets/Pages/EUSFTA/20%20Sep%202013%20.

[522] See European Commission, Singapore, at: http://ec.europa.eu/trade/policy/countries-and-regions/countries/singapore/ (last viewed on January 8, 2016).

[523] Ministry of Trade and Industry (MTI), Ministry of Law (MinLaw), Intellectual Property Office of Singapore (IPOS), *Geographical Indications Consultation Paper List of Terms in relation to 196 Products*, January 21, 2013, available at: https://www.ipos.gov.sg/Portals/0/Geographical%20Indications%20Consultation%20Paper.pdf .

Singapore[524]. On the EU side, instead, a dispute over the EU Commission competence to negotiate such a comprehensive FTA puts new obstacles on the table. To clarify the issue the EU Commission decided to request an opinion of the European Court of Justice (ECJ) on its competence to sign and ratify the trade agreement with Singapore[525]. The Commission lodged the application initiating proceedings with the ECJ on July 10, 2015[526] for an opinion aimed at specifying which provisions of the FTA, according to the Treaty on the Functioning of the European Union (TFEU)[527], fall within the exclusive or shared competence of the EU and which fall within the exclusive competence of the Member States thus requiring a national ratification procedure[528]. The decision to await the ECJ opinion will further delay the entrance into force of the Agreement[529].

This being said, the GI provisions contained in the EU-Singapore FTA, if compared to the ones adopted by the EU in KOREU, reveal a more flexible approach capable of taking into account the differences between the systems of GI protection in the two Parties[530]. Singapore, in fact, recalling the US regime, protects GIs as a subset of TMs and endorses the "first in time first in right" principle[531]. Only in 1998

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[524] See the Letter sent by the Singaporean Minister for Trade and Industry L.H. Kiang to the Trade Commissioner Mr. Karel De Gucht concerning Geographical Indications in the EU-Singapore Free Trade Agreement on 21 January 2013, available at: http://trade.ec.europa.eu/doclib/press/index.cfm?id=961. See also B. O'CONNOR, *The European Union and the United States: Conflicting Agendas on Geographical Indications - What's happening in Asia?*, *op. cit.*, p. 66. See also J. SOPINSKA, *EU-Singapore FTA: Battle over protected names still ahead*, October 20, 2014, available at: https://www.contexte.com/article/politique-exterieure-de-lue/eu-singapore-fta-battle-over-protected-names-still-ahead_36031.html (last viewed on January 8, 2016).

[525] European Commission, *Singapore: The Commission to Request a Court of Justice Opinion on the trade deal*, Press Release, IP/14/1235, Brussels, October 30 2014.

[526] European Commission, *Overview of FTA and Other Trade Negotiations*, updated December 2015, available at: http://trade.ec.europa.eu/doclib/docs/2006/december/tradoc_118238.pdf.

[527] Consolidated Version of the Treaty on the Functioning of the European Union, 2012 O.J. 2012/C 326/01, Article 3(1)(e) and Article 207(1). See P. EECKHOUT, *EU External Relations Law*, Oxford University Press, New York, 2nd ed., 2011, pp. 57-58.

[528] Request for an opinion submitted by the European Commission pursuant to Article 218(11) TFEU, 2015 O.J. Opinion 2/15, 2015/C 363/22, November 3, 2015.

[529] J. SHEPHERD, *EU-Singapore Free Trade Agreement concluded, but EU ratification may be delayed*, International Law Office, December 19, 2014, available at: http://www.internationallawoffice.com/Newsletters/International-Trade/European-Union/King-Spalding-LLP/EU-Singapore-Free-Trade-Agreement-concluded-but-EU-ratification-may-be-delayed.

[530] M. GARCIA, *Squaring the Circle? Approaches to Intellectual Property Rights and the TTIP*, *op. cit.*, p. 8.

[531] M. GARCIA, *Squaring the Circle? Approaches to Intellectual Property Rights and the TTIP*, *op. cit.*, p. 8.

the Singaporean Parliament adopted a specific GI Act based on the TRIPs requirements for the protection of wine and spirit GIs[532]. However, as a city-state with no domestic GIs to protect, there was little incentive for Singapore to accept a list of EU GIs to be granted automatic protection in the FTA discussions, least of all when this contrasted with the principle of priority in place in Singapore[533]. Nevertheless, the EU made clear to the Singaporean officials that they would not have signed any Agreement without including GIs. Therefore, considering the extensive economic benefits of a potential FTA with the EU, Singapore agreed, but given its different legal system, a different solution was found[534]. Unlike in KOREU, under EUSFTA, Singapore will not grant automatic protection to EU GIs but it will establish its own GI register with the specific aim to evaluate those applications for GI protection listed in Annex A of the Agreement. The Singaporean National Assembly already passed the Act for the creation of the *sui generis* system in April 2014, however its implementation has been delayed until the FTA will be officially ratified[535]. In the meanwhile, as already indicated, Singapore launched a Consultation Paper, the outcome of which is uncertain.

Some of the main potential difficulties in the recognition of such a list of names have been presented in an exchange of letters between the EU Trade Commissioner and the Singapore Minister for Trade and Industry where GIs such as "Feta" and "Parmigiano Reggiano" have been specifically targeted[536]. "Parties agree that in the case of 'Feta', feta from other origins can coexist in perpetuity with the EU 'Feta' GI, once registered" and "as regards 'Parmigiano Reggiano', the importance of this name to the EU was noted. Singapore agrees to urgently deepen its investigation into other possible uses in its market of this name and to inform the EU of the result as soon as

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[532] Geographical Indications Act 1998, available at: http://www.wipo.int/wipolex/en/text.jsp?file_id=129655.

[533] M. GARCIA, *Squaring the Circle? Approaches to Intellectual Property Rights and the TTIP*, *op. cit.*, p. 8.

[534] M. GARCIA, *Squaring the Circle? Approaches to Intellectual Property Rights and the TTIP*, *op. cit.*, p. 8.

[535] M. GARCIA, *Squaring the Circle? Approaches to Intellectual Property Rights and the TTIP*, *op. cit.*, p. 9.

[536] M. GARCIA, *Squaring the Circle? Approaches to Intellectual Property Rights and the TTIP*, *op. cit.*, p. 9.

possible and in any case before initialling of the Agreement...The EU states its expectation that 'Parmigiano Reggiano' will be registered as a geographical indication in Singapore with exclusive rights"[537]. Finally, in its last paragraph, the letter clarifies that the arrangements on GIs of the EU-Singapore FTA reflect the fact that the Singapore's legislation does not allow direct protection of GIs *via* the Agreement and underlines that this FTA "does not constitute a precedent"[538].

That being said, this paper will proceed analysing the main GI provisions contained in the EUSFTA. First of all, the IP Chapter starts recalling the commitments of the Parties under the TRIPs Agreement and the Paris Convention and affirms that its provisions are designed to complement those obligations[539].

Sub-Section C deals with GIs as a *sui generis* IPR and Article 11.16 limits its scope to the recognition and protection of GIs for wines, spirits, agricultural products and foodstuffs originating in the territories of the Parties and recognised as GIs in their country of origin[540]. GI, for the purposes of EUSFTA means: "indications which identify a good as originating in the territory of a Party, 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"[541]. Thus, perfectly reproducing the definition of GIs under TRIPs.

Given the trademark regime always employed by Singapore for the recognition of GIs, Article 11.17, which mandates the establishment of a *sui generis* system of protection, represents a significant success for the EU. Singapore, upon the entrance into force of the Agreement, must establish in its territory a system for the registration and protection of wines, spirits and foodstuffs GIs[542]. The system must

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[537] Letter sent by the Singaporean Minister for Trade and Industry L.H. Kiang to the Trade Commissioner Mr. Karel De Gucht concerning Geographical Indications in the EU-Singapore Free Trade Agreement on 21 January 2013, paragraph 7 and 8, *op. cit.*.

[538] Letter sent by the Singaporean Minister for Trade and Industry L.H. Kiang to the Trade Commissioner Mr. Karel De Gucht concerning Geographical Indications in the EU-Singapore Free Trade Agreement on 21 January 2013, paragraph 9, *op. cit.*.

[539] Free Trade Agreement between the European Union and the Republic of Singapore (EUSFTA), available at: http://trade.ec.europa.eu/doclib/press/index.cfm?id=961, Article 11.2 paragraph 1.

[540] EUSFTA, Article 11.16 paragraph 1 and 2.

[541] EUSFTA, Sub-Section C, footnote 14.

[542] EUSFTA, Article 11.17 paragraph 1.

have four specific elements: (a) a domestic register; (b) an administrative process verifying that a GI to be entered on the register matches its definition's requirements; (c) an objection procedure to safeguard the legitimate interest of third parties; (d) legal means that allow the rectification and cancellation of GIs entered on the register[543].

As already mentioned, this Agreement contains two Annexes which, unlike those in KOREU, do not list GIs that will be granted automatic protection upon the entrance into force of the FTA. Annex-A[544] provides GIs that are only applied to be protected in the Parties territories and Annex-B[545], which currently has no entries, will contain those GIs of Annex-A that will be officially protected after the completion of the procedures for their recognition in each Party and the adoption of the decision of the Trade Committee[546]. The Parties agree on the possibility to amend the list of GIs in Annex-B provided that these requirements are satisfied[547].

As to the level of protection granted to those GIs contained in Annex-B, Article 11.19 extends the enhanced protection for wines and spirits to all products registered GIs. However, it also makes a subtle and almost imperceptible distinction between the two groups of GIs. Under paragraphs 2 and 3 all GIs listed in the Annex shall be protected at a TRIPs-plus level, meaning that Parties shall prevent the use of any such GI identifying a good for like good not originating in the place indicated by the GI in question even where the true origin is indicated, the GI is used in translation or the GI is accompanied by expressions such as "kind", "type", "style", "imitation", or the like[548]. However, even if the wording used in the paragraphs concerned is the same, only paragraph 3, the one dealing with agricultural GIs, contains a footnote

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[543] EUSFTA, Article 11.17 paragraph 2.

[544] Annex 11-A, "List of name to be applied for protection as Geographical Indications in the territory of the Parties", available at: http://trade.ec.europa.eu/doclib/docs/2013/september/tradoc_151762.pdf.

[545] Annex 11-B, "Protected Geographical Indications", available at: http://trade.ec.europa.eu/doclib/docs/2013/september/tradoc_151763.pdf.

[546] EUSFTA, Article 11.17 paragraph 3. The Trade Committee is established under Article 17.1 of EUSFTA and it is composed by representatives of the Union and Singapore. Its main duties in relation to GIs are provided for by Article 11.23: "The Trade Committee...shall have the authority to (a) adopt a decision regarding the listing in Annex 11-B referred to in paragraph 3 of Article 11.17...(b) amend Annex 11-B in accordance with Article 11.18...".

[547] EUSFTA, Article 11.18.

[548] EUSFTA, Article 11.19 paragraph 2 and 3.

aimed at clarifying the concept of translation. In this specific case the term "translation" should be evaluated on a case-by-case basis taking into account that, where evidence is provided that there is no link between the protected GI and the translated term, the provision does not apply[549]. This specification, not included in the paragraph related to wines and spirits GIs, should lead to reflection. Maybe Singapore wanted to keep open the possibility of defending some brands or trade names used on food products extensively imported by Singapore from countries such the US, Canada and Australia that might be considered translations of protected GIs, e.g. "Budweiser"[550] and "Parmesan"[551].

Another important provision under EUSFTA is that which requires Parties to renew the GI registration and to maintain minimal commercial activity in relation to the GI product in that Party's market in order to benefit of the protection under Sub-Section C[552]. Thus, this Article, emphasising the importance of commercialising the good bearing the IPR in question, resembles some features of the TM approach. The same provision deals also with the problem of homonymous GIs, *de facto* reproducing Article 23 paragraph 3 of TRIPs[553].

The right to use the GI "is not limited to the applicant, provided that such use is in relation to the goods as identified by that geographical indication"[554]. This provision, if on one hand embraces the concept of GI as a collective and not as an exclusive right, on the other hand is far from ensuring every producer complying

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[549] EUSFTA, Article 11.19 paragraph 3, footnote 17.

[550] Cass. civ., Sez. I, 19 settembre 2013, n. 21472 in *CED Cassazione*, 2013. Here the term "Budweis" has been identified by the Italian Supreme Court as the German translation of the Czech term "Budejovice", which identifies a city in the Czech Republic famous for the production of the original Czech "Budweiser".

[551] Commission of the European Communities v. Federal Republic of Germany, Judgment of the Court of Justice (Grand Chamber), Case C-132/05, (2008) E.C.R. I-00957. Here the ECJ established that only cheeses bearing the PDO "Parmigiano Reggiano" could be sold under the name "Parmesan". See in this context G. SGARBANTI, *La cooperazione tra Stati UE (il caso Parmesan, il regolamento 2006/2004)*, in *Le indicazioni di qualità degli alimenti*, B. Ubertazzi - E.M. Espada (eds.), Giuffrè Editore, Milano, 2009, p. 57; R. BARATTA, in *Giustizia Civile*, 2008, No. 4: pagg I, 838-840; V. PAONE, in *Foro Italiano*, 2008, No. 5: col. IV, 266-267; C. HEATH, *Parmigiano Reggiano by Another Name - on the ECJ's Parmesan Decision*, in *IIC - International Review on Intellectual Property Law*, 2008, Vol. 9, pp. 883-1004, p. 962.

[552] EUSFTA, Article 11.19 paragraph 4.

[553] EUSFTA, Article 11.19 paragraph 5 and 6.

[554] EUSFTA, Article 11.20.

with the product specifications the right to use the GI in question, as provided for in KOREU and in the basic EU GI rules.

Coming now to the relationship between GIs and TMs, it is of great interest to see which solution the Parties have found, given that the Singaporean system was based on the "first in time first in right" principle. A TM, which contains or, consists of, a GI already listed in Annex-B and which is to be used on like goods not having the origin of the GI concerned, shall be refused or invalidated *ex officio* if that Party's law so permits, provided that the application for registration of the TM is submitted after the date of application for registration of the GI in that territory[555]. A different rule is adopted for well-known TMs. Here, irrespective of registration, Parties shall have no obligation to protect a GI where, in light of a well-known trademark its protection is liable to mislead consumer as to the true identity of the product[556]. As to the most contentious relationship between a prior TM and a later GI, paragraph 2 provides that: "...the Parties acknowledge that the existence of a prior conflicting trademark in a Party would not completely preclude the registration of a subsequent geographical indication for like goods in that Party"[557]. However footnote 19 adds that: "in the case of Singapore, a geographical indication which conflicts with a prior existing trademark is capable of being registered with the consent of the prior existing trademark holder. In the case of the Union, such consent is not a prerequisite to the registration of a geographical indication which conflicts with a prior existing trademark"[558]. These provisions are extremely ambiguous. Reading paragraph 2 alone, it seems that the Parties agreed on a sort of co-existence between the two IPRs, however, reading paragraph 2 combined with footnote 19, it appears that co-existence exists on paper only. In fact, requiring the TM holder's consent in order to register a subsequent identical or similar GI gives a veto to the TM holder. Who would ever give such consent? In practice the principle of priority has been reaffirmed. In any case, the subsequent registration of a GI shall in no way prejudice

[555] EUSFTA, Article 11.21 paragraph 1.

[556] EUSFTA, Article 11.21 paragraph 4.

[557] EUSFTA, Article 11.21 paragraph 2.

[558] EUSFTA, Article 11.21 paragraph 2, footnote 19.

the validity or the right to use a prior TM which was applied for, registered or acquired through use in good faith[559].

The last provisions to be analysed are all contained in Article 11.22. Paragraphs 5 and 6 concern generic terms. The first reproduces the TRIPs exception of Article 24 paragraph 6, whereas the latter considers the case of a a common name being contained in a compound GI, providing that nothing shall require a Party to apply its provisions to a name contained in a GI of the other Party in relation to goods for which the name in question is identical with the term customary in common language as the common name for such goods in that Party's territory. Finally, as to the use of person's name in trade and the case of a GI that ceases to be protected in its country of origin, Article 11.22 replicates the content of Article 24 paragraph 8 and 9 of the TRIPs[560].

Not surprisingly EUSFTA has had a significant impact on Singapore's domestic legislation. As a consequence, a new law called "the GI Bill" was passed on 14 April 2014[561]. This new Act aims at repealing the previous GI Act introducing key changes in order to give effect to the significantly TRIPs-plus obligations imposed by EUSFTA. Thus, under the GI Bill, a GI Registry will be established within the Intellectual Property Office of Singapore to allow for GIs to be registered. The registration procedure will be based on three-stages: application, examination and opposition. The GI will be registered for a period of ten years from the date of registration and may be renewed every ten years. As to the level of protection, registered agricultural products and foodstuffs GIs will benefit from the enhanced protection currently afforded to wines and spirits GIs[562]. The new Act seems thus to fully comply with all the commitments established by the Parties under the FTA. However its implementation will depend on the progress of EUSFTA. As such, the

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[559] EUSFTA, Article 11.21 paragraph 3.

[560] EUSFTA, Article 11.22 paragraph 10 and 11.

[561] C.N. LAM - J. LIM, *Singapore to Implement Registration of Geographical Indications*, May 20, 2014, available at: http://www.wongpartnership.com/index.php/files/download/1259/20052014_legiswatch-singapore-geographical-indications-2-2.pdf.

[562] European Commission, Directorate-General for Trade, *The economic impact of the EU-Singapore Free Trade Agreement*, European Commission, Special Report, September 2013, p. 42, available at: http://trade.ec.europa.eu/doclib/docs/2013/september/tradoc_151724.pdf.

provisions in the new law relating to the establishment of a GI Registry will come into force upon the ratification by the EU Parliament of the Agreement, while the implementation of the remaining provisions relating to the enhanced protection for registered GIs will come into effect only with its provisional application and its entry into force[563].

Singapore's implementation of EUFTA is watched closely as its deal with the EU is the first among ASEAN Member States and it serves as a reference point for the EU's negotiations with Vietnam and Malaysia, countries that already have a GI registration system in place[564].

3.3.2 *The EU-Vietnam FTA*

The Free Trade Agreement between Vietnam and the EU (hereinafter referred to as EUVFTA) was agreed in principle on 4 August 2015[565] and on 2 December 2015 the Parties announced the conclusion of the negotiations. The Commission will now present to the Council a proposal for the approval of the FTA which will have to be ratified by the European Parliament and by the Vietnamese Parliament[566]. This FTA, the negotiations for which started in October 2012, is the most ambitious and comprehensive Agreement that the EU has ever concluded with a developing country, the second in the ASEAN region after Singapore and a further stepping

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[563] L.K. KENG - C. WONG, *An Enhanced Regime for the Protection of Geographical Indications in Singapore*, July 2014, available at: http://www.lawgazette.com.sg/2014-07/1085.htm. See also Ministry of Law, Singapore, *Factsheet on the Geographical Indications Act*, April 14, 2014, available at: https://www.mlaw.gov.sg/content/dam/minlaw/corp/News/GI%20Bill%20factsheet.pdf. See also K. WONG - E. FONG, *Revamped Geographical Indications Regime in Singapore*, May 15, 2015, available at: http://www.ellacheong.asia/2015/page/2/. See also I. SAAD, *New GI Regulations to offer greater protection of consumers' interests*, Singapore Parliament web, April 14, 2014, available at: http://www.channelnewsasia.com/news/specialreports/parliament/news/new-gi-regulations-to/1071250.html.

[564] L.K. KENG - C. WONG, *An Enhanced Regime for the Protection of Geographical Indications in Singapore*, *op. cit.*.

[565] European Commission , *EU and Vietnam reach agreement on free trade deal*, Press Release, IP/15/5467, Brussels, 04 August 2015. See also European Commission, *Facts and Figures: Free Trade Agreement between EU and Vietnam*, MEMO/15/5468, Brussels, August 4, 2015. See also WTO Center, *Facts and Figures: Free Trade Agreement between EU and Vietnam*, August 4, 2015, available at: http://wtocenter.vn/content/facts-and-figures-free-trade-agreement-between-eu-and-vietnam-0 and *EU and Vietnam reach agreement on free trade deal*, August 4, 2015, available at: http://wtocenter.vn/content/eu-and-vietnam-reach-agreement-free-trade-deal.

[566] European Commission, Vietnam, at: http://ec.europa.eu/trade/policy/countries-and-regions/countries/vietnam/.

stone towards the EU's objective of a region to region EU-ASEAN FTA[567]. The text of EUVFTA was made available to the public by the European Commission on 1 February 2016[568].

In Article 2 of the IP Chapter[569] the Parties reaffirm their rights and obligations as established under the TRIPs Agreement and agree that the provisions contained therein are designed to complement and further specify those obligations[570]. Interestingly, EUVFTA, unlike all the other FTAs analysed above, expressly makes reference to the Most Favoured Nation principle in the IP section: "with regard to the protection of intellectual property, any advantage, favour, privilege or immunity granted by a Party to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of the other Party, subject to the exceptions provided for in Article 4 and 5 of the TRIPs Agreement"[571]. An analysis of this Article would be beyond the scope of this paper, but suffice it to say that this provision seems to suggest that IP obligations, unlike all the other provisions contained in an FTA, are not exempted from the application of the WTO's MFN principle. Therefore, the higher level of IPR protection resulting from an FTA should be automatically extended to all WTO Members including an enhanced GI level of protection[572].

Article 6 expressly refers to Geographical Indications, and Article 6.1 specifies the scope of application: the provisions only apply to GIs for wines, spirits, agricultural products and foodstuffs originating and protected in the territories of the Parties. Thus, as in all the other EU FTAs this Agreement limits its scope to

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[567] European Commission, *EU and Vietnam reach agreement on free trade deal*, MEMO15/3674, Brussels, August 4, 2015.

[568] European Commission, *EU-Vietnam Free Trade Agreement Now Available Online*, Press Release, IP/16/184, Brussels, 1 February 2016.

[569] Chapter 12 of the EU-Vietnam Free Trade Agreement (EUVFTA), available at: http://trade.ec.europa.eu/doclib/press/index.cfm?id=1437. The text of the FTA, as of January 2016, is only the document at the end of the negotiations conducted by the European Commission. It is is not binding under international law and it will only become so after the completion of the ratification process.

[570] EUVFTA, Chapter 12, Article 2.

[571] EUVFTA, Chapter 12, Article X.

[572] R. KAMPF, *Trips and FTAs: A World of Preferential or Detrimental Relations?*, in *Intellectual Property & Free Trade Agreements*, C. Heath - A.K. Sanders (eds.), Hart Publishing, Portland, OR, 2007, p. 118.

agricultural GIs. In this context, the Parties agree to maintain a specific system of registration and protection for GIs characterised by: a register listing GIs protected in the territory of that Party, an administrative process verifying that GIs to be entered or remained on the register respect the "essentially attributable test" as required by Article 22 of the TRIPs Agreement[573], an objection procedure and procedures for rectification and termination of the GIs entered on the register[574]. In particular, each Party shall provide the legal means for the invalidation of registered GIs[575]. This last provision goes beyond the terms of KOREU which only requires an opposition phase to be guaranteed. Instead, under EUVFTA, the Parties commit to ensuring that a registered GI may always be invalidated taking into account the legitimate interests of third parties and of the right holders of the GI in question[576].

That being said, the main advantage of EUVFTA relies on the mutual recognition of hundreds of GIs. Indeed, like in KOREU, the EU-Vietnam Agreement includes an extensive list of GIs originating in one of the Parties that are required to receive automatic protection as GIs in the other. The GIs in question are listed in Annex GI-I, Part A (European GIs) and in Annex GI-I, Part B (Vietnamese GIs), and have been recognised by the Parties without any need to go through the standard national procedure. Thus, under the terms of Article 6.3, having completed an objection procedure and having examined the GIs listed in Annex GI-I, the EU and Vietnam recognise that they are GIs within the meaning of Article 22 of the TRIPs Agreement and undertake to protect them according to the enhanced level of protection as laid down in Article 6.5. Interestingly, unlike in KOREU, EUVFTA

[573] The need to ensure an essential link between a given quality, reputation or other characteristic of the good and its geographical origin is completed by Article 6.9 which requires products bearing the GI to comply with the product specifications, including any amendments thereof, approved by the authorities of the Party where the product originates.

[574] EUVFTA, Chapter 12, Article 6.2.

[575] EUVFTA, Chapter 12, Article 6.2, footnote 8.

[576] EUVFTA, Chapter 12, Article 6.2 letter (d).

makes the objection proceeding an explicit requirement[577] probably as to avoid the hurdles posed by Article 18.36 of the TPP which prevent International Agreements from requiring the automatic protection of certain GIs without ensuring an objection procedure.

Part A of Annex GI-I contains 171 EU food and drink GIs among which: "Marsala", "Madeira", "Porto", "Chablis", "Champagne", "Bordeaux", "Tokaj", "Chianti", "Prosecco" "Bayerishes Bier", "Brie de Meaux", Camembert de Normandie", Emmental de Savoie", Roquefort", "Feta", "Fontina", "Gorgonzola", "Asiago", "Grana Padano", "Mozzarella di Bufala Campana", "Parmigiano Reggiano", "Pecorino Romano" and "Prosciutto di Parma" . While Part B contains 39 Vietnamese GIs, among which "Mòc Chàu" tea and "Buon Ma Thuòt" coffee. The FTA allows for the amendment of the lists of GIs by removing those GIs that ceased to be protected in their country of origin and by adding, after the completion of the objection and the examination procedure, new GIs[578]. The Parties explicitly establish a "Working Group on Intellectual Property Rights, including Geographical Indications" that is responsible for such changes[579]. However, unlike in KOREU, this Article contains a second paragraph that *de facto* denies all those GIs already protected in the EU and in Vietnam on the date of signing of the agreement to be

[577] In this regard a provisional list of Vietnamese GIs is contained in a public consultation notice enacted by the European Commission on August 21, 2014 aimed at inviting, any Member State or third country or any natural or legal person having a legitimate interest, to submit oppositions to the protection of such listed GIs, by lodging a specific statement. Opposition statement that shall be examined by the Commission only if it shows that the protection of the proposed name would: (a) conflict with the name of a plant variety or animal breed in a way that would mislead consumer as to the true origin of the product; (b) be homonymous with a name already protected in the EU; (c) be liable to mislead consumers as to the true identity of the product in light of the TM's reputation and the length of time it has been used; (d) jeopardise the existence of an identical name or of a TM or the existence of products that which have been legally on the market for at least five years; (e) be considered generic. See European Commission, Information Notice - Public Consultation, 2014, O.J. 2014/C 274/08, August 21, 2014.

[578] EUVFTA, Chapter 12, Article 6.4. See also Agra-Europe Press, document No. 08-16, February 3, 2016.

[579] EUVFTA, Chapter 12, Article 6.11 paragraph 3 letter (a).

added to the list, thus preventing thousands of EU registered GIs to enjoy direct recognition and enhanced protection in Vietnam[580].

Article 6.5 provides that listed GIs benefit from the absolute protection as provided for by Article 23 of the TRIPs Agreement. Each Party must provide the legal means for interested parties to prevent the use of a GI of the other Party listed in Annex GI-I for a product that does not originate in the country of origin specified or does originate in the country of origin specified but was not produced in accordance with the laws of the other Party even where the true origin of the product is indicated or the GI is used in translation or accompanied by expressions such as "kind", "type" or the like[581]. Instead, unlisted GIs, according to letter (b) and (c) of the same Article are granted TRIPs Article 22 level of protection and therefore are protected only against "the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin or nature of the good"; and, against "any other use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention". This provision emphasises the different treatment established under the FTA between listed and unlisted GIs. In this respect, doubts may arise as to whether this discrimination be reasonable and therefore legitimate or not. What makes listed GIs merit better protection? TRIPs provides for different level of protection only between wines and spirits GIs as opposed to agricultural GIs. Hence, it is not clear why, under EU FTAs, only some specific GIs should be protected at a higher level on the simple basis of the commercial interest they have in different

[580] EUVFTA, Chapter 12, Article 6.4 paragraph 2: "A geographical indication for wines, spirits, agricultural products or foodstuffs shall not in principle be added to {Annex GI - I}, if it is a name that on the date of signing of this Agreement is listed in the relevant register of the Parties with a status of 'Registered'". See also B. O'CONNOR, *Geographical Indications in CETA, the Comprehensive Economic and Trade Agreement between Canada and the EU*, November 2014, p. 8, available at: http://www.origin-gi.com/images/stories/PDFs/English/14.11.24_GIs_in_the_CETA_English_copy.pdf.

[581] EUVFTA, Chapter 12, Article 6.5 paragraph 1 letter (a).

export markets[582]. That being said, however, this provision gives credit to the interpretation endorsed in the previous section, according to which the enhanced protection provided for by Article 10.21 of KOREU referred only to those GIs listed in the FTA and not to all the GIs protected in the contracting Parties.

Unlike in KOREU, the level of protection granted to listed GIs according to the EU-Vietnam FTA is not without exceptions. Under Article 6.5a the protection of the GIs "Asiago", "Fontina", "Gorgonzola" and "Feta" shall not prevent the use in the territory of Vietnam of any of these indications by any person who made actual commercial use in good faith of those indications with regard to products in the class of "cheeses" prior to 1 January 2017[583]. A similar provision applies to the GI "Champagne". According to Article 6.5a paragraph 3, the use of such GI, its translation or transliteration by any person who made actual commercial use in good faith of this indication with regard to products in the class of "wines" shall not be prevented for at least ten years from the entry into force of this Agreement. As already pointed out in this Chapter, those specific GIs are among the most contested indications worldwide and their recognition stands at the core of the battle between the US and the EU. While they are strictly protected in the EU they are considered generic in the US. The compromise solution found in this Agreement reflects, to a large extent, the solution adopted in the Comprehensive Economic and Trade Agreement (CETA) concluded between the EU and Canada[584]. However, while for Canada the need to find a middle way with regard to such terms was quite comprehensible because of Canada's strong commercial relationship with the US, the

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[582] B. O'CONNOR - L. RICHARDSON, *The legal protection of Geographical Indications in the EU's Bilateral Trade Agreements: moving beyond TRIPS*, in *Rivista di Diritto Alimentare*, Anno VI, No. 4, October - December 2012, p. 17. See also European Commission, Green Paper on Agricultural Product Quality: product standards, farming requirements and quality schemes, COM (2008) 641, Brussels, 15 October 2008, p. 14.

[583] EUVFTA, Chapter 12, Article 6.5a paragraph 1 and 2.

[584] See e.g. the solution adopted in the EU-Canada Comprehensive Economic and Trade Agreement (CETA), text available at: http://trade.ec.europa.eu/doclib/docs/2014/september/tradoc_152806.pdf. Article 7.6 paragraph 1 states as follow: " Notwithstanding paragraphs 2 and 3 of Article 7.4, Canada shall not be required to provide the legal means for interested parties to prevent the use of the terms listed in Part A of Annex I and identified by one asterisk {note: 'Asiago', 'Feta', 'Fontina', 'Gorgonzola' and 'Munster'} when the use of such terms is accompanied by expressions such as 'kind', 'type', 'style', 'imitation' or the like and is in combination with a legible and visible indication of the geographical origin of the product concerned".

solution adopted by the Vietnamese Government can only be explained by the influence exercised by the US and Australia with the Trans-Pacific Partnership. Those names are not deemed as generic under the agreement but their protection, in comparison to that granted to all the other listed GIs, is lower. In addition, not only any person who made, in the past, commercial use of such indications in Vietnam, will be allowed to use these terms forever notwithstanding their protection as GIs, but also any person who will make commercial use of such indications in the next months until 1 January 2017 will have the same benefit.

This being said, once a GI is protected under the FTA, the legitimate use of such indication shall not be subject to any registration or further charges[585].

Another important provision is set out in Article 6.5a paragraph 4, which provides that: "any request made under Article 6 in connection with the use or registration of a trademark must be presented within five years after the adverse use of the protected indication has become generally known in that Party or after the date of registration of the trademark in that Party...". Thus a limitation period of five years is imposed by EUVFTA for lodging claims with regard to registered GIs.

As to the enforcement of GI protection, the Agreement requires the Parties to have in place an administrative *ad hoc* system in addition to the enforcement provided at the request of an interested party, as in KOREU[586].

Coming to the relationship between GIs and TMs, Article 6.7 endorses the principle of co-existence: "where a trademark has been applied for or registered in good faith, or where rights to a trademark have been acquired through use in good faith, in a Party[587]" before the date of entry into force of the FTA or before the date on which a GI is added to the list according to Article 6.4, "measures adopted to implement this Article 6 in that Party shall not prejudice eligibility for or validity of the trademark on the basis that the trademark is identical with, or similar to a geographical indication[588]". If on the one hand this Article might be regarded as a

[585] EUVFTA, Chapter 12, Article 6.6.

[586] EUVFTA, Chapter 12, Article 6.8.

[587] EUVFTA, Chapter 12, Article 6.7 paragraph 1.

[588] EUVFTA, Chapter 12, Article 6.7 paragraph 1.

victory of the EU, on the other hand it should be acknowledged that the co-existence thereby established only concerns listed GIs and it is not imposed as a general principle of law.

Finally, the Parties undertake to maintain contact, ensure transparency and exchange information with regard to GIs[589].

For a better understanding of the future implications of the bilateral treaty in question for the law of Vietnam, a brief overview of its domestic GI legislation may be useful. The Vietnamese Law on Intellectual Property[590] provides for a *sui generis* system of GI protection and for the establishment of a National Register for GIs[591]. This of course will simplify Vietnam's compliance with the GI commitments established under the EUVFTA. In Vietnam a GI is "a sign which identifies a product as originating from a specific region, locality, territory or country"[592]. On the basis of that definition, Vietnamese GIs may include signs, symbols and images[593]. A GI shall be protected only where the product bearing the GI has a reputation, quality, or characteristics mainly[594] attributable to the geographical conditions of the environment corresponding to such GI[595]. The relevant geographical conditions include natural (i.e. climatic, geological and ecological conditions) and human (i.e. skill of producers and traditional production methods) factors[596]. On the contrary, a GI shall not be protected where the name concerned has become generic in Vietnam

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[589] EUVFTA, Chapter 12, Article 6.10.

[590] Law No. 50/2005/QH11 of November 29, 2005 on Intellectual Property, as amended by Law No. 36/2009/QH12, available at: http://www.wipo.int/wipolex/en/details.jsp?id=12011.

[591] Law No. 50/2005/QH1, Article 98.

[592] Law No. 50/2005/QH1, Article 4 paragraph 22.

[593] National Office of Intellectual Property of Vietnam (NOIP), *Geographical Indications: Overview*, at: http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms_en.nsf/(agntDisplayContent)?OpenAgent&UNID=49BC1C4511A1FFCA4725767F00377FAD (last viewed on January 12, 2016).

[594] The term "mainly" is directly employed by Article 79 paragraph 2. This may be seen as a *minus* compared to TRIPs Article 22 where, instead, the word "essentially" implies a stricter link between the quality, reputation or other characteristics of the good and its geographical origin. However, a detailed study over the Vietnamese GI system and its compliance with the TRIPs Agreement would be out of the scope of this paper.

[595] Law No. 50/2005/QH11, Article 79 paragraph 2.

[596] Law No. 50/2005/QH11, Article 82.

or it is identical or similar to a protected TM when the use of such GI is likely to cause confusion as to the origin of the product[597].

As to the registration procedure, the documents required to file an application include those aimed at describing and proving the causal link between the GI quality, characteristics or reputation and the geographical conditions of the area[598]. This is similar to the EU product specifications requirement. In this respect, the Vietnamese law provides that the right to register a GI belongs to the State as the only owner of Vietnam's GIs[599]. The State may then allow producers, collective organisations or administrative local authorities to exercise this right, provided however that registrants shall not become owners of such GIs[600]. The provision is of great interest because it solves, at least in Vietnam, the highly debated issue of the nature and ownership of GI rights. Once the application has been properly filed to the National Office of Intellectual Property of Vietnam, the registration procedure follows three main phases: publicity, opposition and substantial examination[601]. If the GI in question is registered, the Vietnamese system prescribes a constant control on the use and management of the GI in question. An *iter* that is very akin to that provided for in EU law.

Finally, as to the level of protection granted to domestic GIs, the IP Law of Vietnam provides an absolute protection for wines and spirits GIs and a basic

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[597] Law No. 50/2005/QH11, Article 82.

[598] Law No. 50/2005/QH11, Article 106 paragraph 1(c) and paragraph 2(e).

[599] Law No. 50/2005/QH11, Article 88 and 121. In particular, Article 121 paragraph 4 provides as follow: "The owner of Vietnam's geographical indications is the State. The State shall grant the right to use geographical indications to organizations or individuals that turn out products bearing such geographical indications in relevant localities and put such products on the market. The State shall directly exercise the right to manage geographical indications or grant that right to organizations representing the interests of all organizations or individuals granted with the right to use geographical indications".

[600] Law No. 50/2005/QH11, Article 88.

[601] National Office of Intellectual Property of Vietnam (NOIP), *Procedures for Obtaining a Geographical Indication*, at: http://www.noip.gov.vn/web/noip/home/en?proxyUrl=/noip/cms_en.nsf/(agntDisplayContent)?OpenAgent&UNID=C982CD420D1471284725767F003844E9.

protection for all the other GIs[602], including GIs for non agricultural products[603], thus recalling the difference between Article 22 and 23 of the TRIPs Agreement.

As a consequence, if the EU-Vietnam FTA enters into force, the only substantial modification required to the Vietnamese GI system would be the extension of the absolute protection to products other then wines and spirits, at least with regard to those GIs that are granted automatic protection by reason of the FTA.

In the interest of completeness, it should be noted that, in order to comply with the TPP provisions, Vietnam will have to adopt, in addition to the *ad hoc* system already in place for the protection of GIs, a trademark regime based on collective and certification marks. In this respect it is extremely interesting to note that Vietnam strongly opposed the TPP system of GI protection during the negotiations of the TPP. Vietnam, in fact, is an underdeveloped agricultural country where most of GIs belong to poor countryside communities[604]. According to a Letter sent by the Vietnam Chamber of Commerce and Industry (VCCI) to the US Trade Representative: "protecting GI by trademark or trademark-similar mechanism shall absolutely give tools to bad guys to rob important properties that link to income, culture and life of many weak and limited awareness Vietnamese population who are living on agricultural production at household size...GI has been a specific IP right characterised by the fact that this kind of IP property does not belong to an individual person (natural or legal person) but the community as a whole, and that it is crucial not only to income but also to the communities' spiritual and social life. Protecting GIs under trademark or trademark-similar mechanisms (especially with their main principal of 'first to file') shall nullify this core character of GIs at the detriment of fragile community living on these GIs"[605]. This statement is an important indication

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602 Law No. 50/2005/QH11, Article 129.

603 M.V. DELPHINE, *The Protection of Geographical Indications in Vietnam: Opportunities and Challenges*, paper presented at the United Nations Conference on Trade and Development held in Phnom Penh, Cambodia, on 11-12 December 2014.

604 Vietnam Chamber of Commerce and Industry (VCCI), Letter sent by the President and Chairman of Vietnam Chamber of Commerce and Industry to Ambassador Ron Kirk, *Regarding Intellectual Properties Chapter in TPP*, Hanoi, August 31, 2012, p. 2, available at: http://wtocenter.vn/sites/wtocenter.vn/files/tpp/attachments/VCCI%20Letter%20-IP%20-%20En.PDF.

605 Vietnam Chamber of Commerce and Industry (VCCI), Letter sent by the President and Chairman of Vietnam Chamber of Commerce and Industry to Ambassador Ron Kirk, *Regarding Intellectual Properties Chapter in TPP*, *op. cit.*, p. 2.

that Vietnam considers that GIs are a specific form of IPR based on the concept of *terroir* and characterised by a strong cultural and social component[606]. In a different statement, the VCCI expressly said that the US approach to protect GIs as TMs is inconsistent with the Vietnamese tradition and hence that Vietnam could not make such concession to the US under the TPP[607]. Consequently, VCCI recommended the rejection of any proposal made by the TPP in this sense and the exclusion of GI provisions from the scope of the IP Chapter[608]. According to the opinion of the Vietnam Chamber, the community would be seriously affected by protecting GIs as TMs: (a) the "first in time first in right" principle would prevent the entire community to use a GI for its products only on the grounds that a similar or an identical TM has been previously registered; (b) the use of a TM system would allow the registration of geographical indications without a proper administrative control as to the product specifications, thus undermining the "essentially attributable test"; and (c) the registration of GIs as TMs would unfairly allow GIs to become private property of the registrant. The VCCI concluded its recommendation by saying that the TM approach seems to be designed to help individuals to "steal" GIs which are material and spiritual assets of the relevant community[609]. This is a strong declaration against the TPP approach to GIs and testifies the efforts the Vietnamese Government had to do to accept the TPP actual provisions over GIs.

It will now be interesting to see how Vietnam will implement the GI commitments established under the final text of the TPP and, at the same time, respect and maintain its own GI system. A system that, as a matter of fact, is perfectly compliant with that of the EU as envisaged under the EU-Vietnam FTA.

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[606] Recommendation of Vietnamese business community on negotiating strategies of IP Chapter in TPP, Hanoi, July 2012, p. 20, available at: http://wtocenter.vn/sites/wtocenter.vn/files/tpp/attachments/INTA-2012-2-TPP4-Khuyen%20nghi%20Chuong%20IP.pdf.

[607] Recommendation of Vietnamese business community on negotiating strategies of IP Chapter in TPP, Hanoi, July 2012, *op. cit.*, p. 20.

[608] Recommendation of Vietnamese business community on negotiating strategies of IP Chapter in TPP, Hanoi, July 2012, *op. cit.*, p. 21.

[609] Recommendation of Vietnamese business community on negotiating strategies of IP Chapter in TPP, Hanoi, July 2012, *op. cit.*, p. 21.

3.4 A reiteration of conflicting provisions

Following the analysis of the TPP and the US-Singapore FTA as opposed to the EU-Singapore and the EU-Vietnam FTAs it appears that the GI regimes outlined therein are quite different. Like in the KOREU and in the KORUS, the most contentious issues are: the automatic protection of a list of GIs, the level of protection, the relationship with TMs and the problem of generic terms. However, since these agreements have only been concluded but not yet ratified, let alone entered into force, it is not possible either to conduct a proper study on their provisions, or to examine their implications for the national law of each third country party to the deal. Nevertheless, some preliminary and interesting conclusions can be drawn.

Comparing the EU-Singapore FTA with the US-Singapore FTA and the TPP, certain features should be underlined. It is true that both the US Agreements require Singapore: to allow for the protection of GIs as collective or certification marks[610]; to grant, at the most, a TRIPs *minimum* level of protection to food GIs; to reaffirm the principle of priority of TMs over GIs[611]; and to ensure the free availability of common food names on the market[612]. However, the EU-Singapore FTA, although aimed at introducing a *sui generis* GI regime[613], has been construed in a way that, at least theoretically, allows the co-existence between the different FTAs. In fact, as long as the GIs listed in the EU-Singapore FTA are not automatically recognised and protected in Singapore but they are subject to the ordinary registration procedure that gives to local or foreign stakeholders the right to oppose the registration of the GIs on the basis of possible genericness or that it is identical/similar to a registered TM, the system does not contravene the provisions of USSFTA and TPP. However, EUSFTA requires listed GIs to be protected at a TRIP-plus level[614], an obligation that goes far beyond the US attempt to ensure the same protection for GIs as granted to

[610] USSFTA, Article 16.2 paragraph 1, and TPP, Article 18.19.

[611] USSFTA, Article 16.2 paragraph 2, and TPP, Article 18.20, and Article 18.32.

[612] TPP, Article 18.33.

[613] EUSFTA, Article 11.17.

[614] EUSFTA, Article 11.19.

TMs. In this regard, it will be interesting to see how the proposed Singapore Bill will address the different approaches.

Coming to the EU-Vietnam FTA and to the Trans-Pacific Partnership Agreement, firstly, it is not clear whether the provision of Article 18.36 of the TPP which prevent the EU from imposing a list of GIs to be directly protected in a contracting party which is also party to the Trans-Pacific Partnership, applies or not to the EU-Vietnam Agreement[615]. In fact, given the absence of official documents, especially with regard to the TPP, it is hard to say which one of the two Agreements has priority over the other. Probably the EU-Vietnam FTA has been agreed in principle before TPP, but the TPP has been signed first[616]. Hopefully this uncertainty will be clarified during the ratification process.

That being said, beside the usual differences between the EU and the US approach - i.e. a trademark *versus* a *sui generis* regime, a principle of priority *versus* a principle of co-existence and a different level of protection - it is quite evident that the TPP has exercised a certain influence over the provisions contained in the EU-Vietnam FTA. This latter Agreement, unlike KOREU, expressly requires an objection proceeding to be guaranteed before a GI is added to the list[617], it requires the Parties to always ensure the possibility to invalidate a registered GI[618], and, like CETA, it addresses specific contentious GIs by lowering their level of protection compared to all the other listed GIs[619]. This is probably due to the fact that TPP negotiations started almost two years before the negotiations with the EU were launched[620]. This compromise confirms, in a way, the "first come first served" rule.

As proof of this, it should be reminded that Vietnam protects GIs by means of *sui generis* regulations, and therefore, the less satisfactory protection of GIs under EUVFTA if compared to KOREU cannot be considered the result of a different legal

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[615] See above paragraph 3.2.2.

[616] See above paragraph 3.2.2 and paragraph 3.3.2

[617] EUVFTA, Chapter 12, Article 6.3.

[618] EUVFTA, Chapter 12, Article 6.2.

[619] EUVFTA, Chapter 12, Article 6.5a.

[620] Vietnam formally joined TPP discussions in 2010 while negotiations for an EU-Vietnam FTA were launched only in 2012.

tradition in Vietnam as it was the case of Singapore, but it can only be regarded as the effect of the TPP Agreement. As one author has pointed out, Vietnam will be the largest beneficiary of the TPP from an economic perspective: "according to the World Economic Forum, Vietnam is predicted to have the most significant change in GDP in 2025 (i.e., 28,2%) compared with other TPP economies"[621]. This last remark can help in understanding the importance of the TPP for the ASEAN country at issue. That said, however, one question remains open: will Vietnam be capable of implementing the different commitments in its own law?

One last remark can be made with regard to Article 6.5a of the recent EU-Vietnam FTA. From the wording of such provision, it appears that the global struggle over different systems for the protection of GIs - i.e. a trademark regime as opposed to a *sui generis* regime - is becoming more and more a battle over specific and individual names revealing the real economic interests that animate this clash[622]. "Feta", "Asiago", "Gorgonzola", "Fontina" and "Champagne" stand at the heart of this conflict. In the case of Vietnam, the US arrived first and succeeded in preventing the EU in properly protecting such names.

The Trans-Pacific Partnership in fact, once entered into force, will prevent the EU from signing FTAs of the scope of KOREU with TPP economies. In particular, the model that the EU will probably have to embrace with future partners in Asia, i.e. with Malaysia Brunei and Japan[623], will be similar to the one adopted in the EU-Singapore FTA, even if the countries in question already have in place a *sui generis* system of GI protection. A model that, as already said, does not properly satisfy the needs envisaged by the old continent[624].

In light of all this, this Chapter can conclude acknowledging that, overall, at the bilateral level, both the EU and the US have been able to achieve some modest

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[621] O. MASSMANN, *Overview on the Trans Pacific Partnership Agreement - Commitments above WTO Level - An Analysis*, January 26, 2016, available at: http://www.lexology.com/library/detail.aspx?g=d69941cf-2f7b-4ea2-a36e-a278d81e7174.

[622] See above Chapter II, paragraph 2.3.

[623] These countries are all contracting Parties of TPP. See above paragraph 3.2.2.

[624] Letter sent by the Singaporean Minister for Trade and Industry L.H. Kiang to the Trade Commissioner Mr. Karel De Gucht concerning Geographical Indications in the EU-Singapore Free Trade Agreement on 21 January 2013, paragraph 9, *op. cit.*.

successes in advancing their approach regarding the protection (or not) of GIs. Yet, at the end of the day, the "first come first served" rule remains the one governing the outcome of each negotiation.

CHAPTER IV

THE KOREAN COMPROMISE

CONTENTS: 1. Reasons for this study. - 2. Protection of GIs in the South Korean legislation. - 2.1 The definition of GIs under Korean law - 2.2 Two GI registration systems and registration authorities. - 2.2.1 The registration procedure under AFPQCA. - 2.2.2 The registration procedure under TMA. - 2.3 The level of protection. - 2.4 The relationship with TMs. - 2.5 Generic terms. - 2.6 A specific regime for wine and spirit GIs. - 3. A brief review of the GI commitments under KOREU and KORUS. - 4. Amendments to the South Korean legislation with the entry into force of KOREU and KORUS. - 5. Is South Korean national legislation capable of an interpretation compliant with the GI provisions in both the FTAs? - 5.1 The Korean GI system and the KOREU: a comparative analysis. - 5.2 The Korean GI system and the KORUS: a comparative analysis. - 5.3 Outcomes of the comparative analysis. - 6. Korea at the crossroad of economic interests and legal coherence.

1. Reasons for this study

Following the analysis of the EU and US free trade agreements concluded in the Asian Region, this Chapter aims at studying the Korean domestic GI system in order to understand how the KOREU and the KORUS have been implemented by the Korean Government and to what extent they have impacted on Korean national legislation in this regard. South Korea is the only Asian country where this *phenomenon* can be properly examined since both the FTAs have been ratified and entered into force. Whether Korea was able or not to comply with the conflicting commitments in both agreements is the focus of this Chapter.

2. Protection of GIs in the South Korean legislation

In Korea, there are two types of protection of GIs: passive and active[625]. Passive protection means preventing third parties from registering or using a name of a place they have no right to monopolise[626]. The major laws providing for passive protection include: the Trademark Act, the Unfair Competition Prevention and Trade Secret Protection Act and the Act on the Investigation of Unfair International Trade Practices and Remedy Against Injury to Industry[627]. Active protection means the formal recognition of GIs through their registration and enforcement. Seoul adopted this positive protection system in 1999 only with the Agricultural and Fishery Products Quality Control Act (AFPQCA) and added to it in 2005 with the incorporation of GI collective marks into the Trademark Act[628].

More specifically, Korea enacted AFPQCA, in 1999, to deal with the new protection obligations imposed by the TRIPs Agreement of 1994 and by the Korea-EU Framework Agreement on Trade and Cooperation signed in 1996[629]. The Republic of Korea, as a member of the WTO, had the duty to make its domestic regulations related to IPRs conform with the International Treaty by January 1, 2000[630] and as a contracting Party of the Framework Agreement, had the obligation to establish a system of GI registration[631]. However, in the lack of any provision

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625 C.K. JUNG, *A Study on the Protection of Geographical Indications*, Master Thesis, Korea University, 2013.

626 Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea,* Ministero dello Sviluppo Economico, Italia in Corea, Italian Trade Commission, Seoul, April 2010 pp. 1-2.

627 Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea, op. cit.*, p. 116.

628 Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea, op. cit.*, p. 2.

629 Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea, op. cit.*, p. 121. For an overview of the Framework Agreement for Trade and Cooperation see the Embassy of the Republic of Korea to the Kingdom of Belgium and the European Union, *Korea - EU Political Relations*, at: http://bel.mofa.go.kr/english/eu/bel/bilateral/eu/index.jsp.

630 Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea, op. cit.*, p. 4.

631 Article 25 of the Framework Agreement between the European Union and its Member States, on the one part, and the Republic of Korea, on the other part, signed in Luxembourg on 28 October 1996 and entered into force on 1 April 2001, 2001 O.J. L 90 Volume 44, available at: http://eeas.europa.eu/korea_south/docs/framework_agreement_final_en.pdf.

granting remedies against infringement of GIs, AFQCA turned out to be insufficient to protect GIs as IPRs, and, in this situation the Korean Intellectual Property Office decided to amend its Trademark Act as to allow GIs to be registered as collective marks[632]. Nevertheless, years later, with an amendment that took effect in December 2009, AFQCA introduced civil remedy procedures against unjust uses of GI rights clearly stating that GIs are independent IPRs with an exclusive right of use.

So, as of now, Korea has two different systems for the protection of GIs by registration: the GI registration system of the Ministry for Food, Agriculture, Forestry and Fisheries (MFAFF) and the GI collective mark registration system of the Korean Intellectual Property Office (KIPO)[633]. Therefore, South Korea is one of those countries, together with China, which provides for a dualism of protection of GIs in its national system allowing their registration as trademarks and at the same time having in place a *sui generis* system[634].

That being said, the fact that the protection of GIs has been incorporated into several domestic laws creates confusion and legal uncertainty[635]. This paper will try to clarify how GIs are regulated in the Republic of Korea through a concept by concept approach, bearing in mind, however, that the FTAs in question brought important changes with regard to the level of protection and the relationship between GIs and TMs.

2.1 The definitions of GIs under Korean law

In Korean law there are two different definitions of GIs, one is contained in the Agricultural and Fishery Product Quality Control Act and the other in the Trademark Act.

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632 Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea, op cit.*, p. 122.

633 Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea, op. cit.*, p. 4.

634 I. KIREEVA - B. O'CONNOR, *Geographical Indications and the TRIPS Agreement: What Protection is Provided to Geographical Indications in WTO Members?*, in *The Journal of World Intellectual Property*, Vol. 13, No. 2, 2010, pp. 289-299.

635 S.Y. YOOK, *A study on Geographical Indication under FTAs and Its Domestic Implementation*, Korea Legislation Research Institute, August 9, 2014.

Under the Agricultural and Fishery Product Quality Control Act (hereinafter referred to as AFPQCA), GIs have been defined as indications that describe agricultural and fishery products or processed agricultural and fishery products as produced, made or processed in a specific region, where the reputation, quality and other distinctive features of these products fundamentally result from the geographical characteristics of the specific region[636].

By contrast, under the Trademark Act (hereinafter referred to as TMA), GIs are indications which identify goods as being produced, manufactured or processed in a specific region where a given quality, reputation or any other characteristic is essentially attributable to their geographical origin[637].

Thus, while AFPQCA limits the scope of GIs to agricultural and fishery products and their processed derivates, TMA does not have any specific limitation on the type of goods that can be protected, therefore even non-agricultural industrial products are entitled to be registered as GI collective marks. Only the service industry, in line with the TRIPs definition is not subject to protection[638]. Moreover AFPQCA requires that a given quality, reputation, *and* other characteristic of the agricultural or fishery product be essentially attributable to its place of origin, whereas according to the TMA it is enough that only one of these requirements, alternatively, be essentially linked to the geographical origin of the good[639].

In summary, it may be concluded that the definition of GI under AFPQCA resembles, in a certain way, the definition of Appellations of Origin (AOs) under the Lisbon Agreement, while the definition of GI under TMA is closer to the EU definition of PGI. Therefore, all the indications that fall under the definition of AFPQCA are also entitled to be protected under TMA but not *viceversa*.

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[636] Agricultural and Fishery Products Quality Control Act, as amended by Act No. 10885, July 21, 2011, available at: http://elaw.klri.re.kr/kor_service/lawView.do?hseq=25355&lang=ENG, Article 2 paragraph 8.

[637] Trademark Act, as amended by Act No. 11962, July 30, 2013, available at: http://elaw.klri.re.kr/kor_service/lawView.do?hseq=30765&lang=ENG, Article 2 paragraph 3-2.

[638] Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea*, *op. cit.*, p. 15. See also B. KIM - C. HEATH, *Intellectual Property Law in Korea*, Kluwer Law International, New York, 2nd edition, September 24, 2015.

[639] Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea*, *op. cit.*, p. 123.

2.2 Two GI registration systems and registration authorities

The TMA and AFPQCA are different in many aspects: purpose of legislation, registration authorities, procedures, effects and post-management of registration and its invalidation or cancellation[640].

The objectives pursued by the GI registration system under AFPQCA are essentially three: to improve the quality of agricultural and fishery products having geographical characteristics, to foster regional specialty industries, and to protect consumers[641]. The idea of this Act is to consider GIs more as a "guarantee mark", i.e. a mean to ensure a quality competition. Whereas the main purpose of the Trademark Act is to contribute to the development of industry and to protect the interests of consumers by maintaining the business reputation of those persons using trademarks[642].

This being said, according to AFPQCA, GIs shall be registered with the Minister for Food, Agriculture, Forestry and Fisheries (hereinafter referred to as MFAFF)[643]. In particular, MFAFF must establish a Council on the Quality Control of Agricultural and Fishery Products under its jurisdiction to deliberate on matters concerning the quality control of those products and shall appoint a subcommittee to deliberate on the registration of GIs[644]. By contrast, under the TMA, GIs shall be registered as "geographical collective marks" with the Korean Intellectual Property Office (hereinafter referred to as KIPO)[645]. The registration procedures under the two laws are considerably different.

Before starting the analysis, it is of interest to look at the numbers of GIs respectively registered with MFAFF and with KIPO. Until 2004, before the

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640 Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea*, *op. cit.*, pp. 10-123.

641 Agricultural and Fishery Products Quality Control Act, Article 32 paragraph 1.

642 Trademark Act, Article 1.

643 Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea*, *op. cit.*, p. 5.

644 Agricultural and Fishery Products Quality Control Act, Article 3 paragraph 6.

645 Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea*, *op. cit.*, p. 6.

amendment of the Trademark Act, only 3 GIs were registered under AFPQCA[646]. This number reflected the poor knowledge about GIs among Korean producers. However, in the years later, something changed, and GIs started to be perceived as economic assets and as part of the cultural heritage[647]. Hence, since 2005 dozens of applications were filed with MFAFF and with KIPO. Today there are more than one hundred GIs registered both under MFAFF[648] and under KIPO[649].

2.2.1 *The registration procedure under AFPQCA*

AFPQCA establishes a *sui generis* system for the protection of GIs, while the TMA applies the ordinary scheme used for TMs to GIs. The registration procedure under AFPQCA is regulated by Article 32 according to which a GI may be registered only by a corporation of producers or processors of an agricultural or fishery product with geographical characteristics attributable to a specific region, provided that, if only one person produces or processes these products, such person may solely apply for registration thereof[650]. Legitimate applicants may file an application to MFAFF along with the annexed documents prescribed by the Ordinance of the Minister, which include, among others: a description of the characteristics of the product concerned; an evidence showing the reputation of the product; an explanation of the relationship between the product's characteristics and its geographical environment; and a plan for quality management of the product[651]. The documents required reveal how important is to prove a strict link between a given reputation, quality and other characteristic of the product and its origin, emphasising in this way the concept of *terroir*.

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[646] The first Korean GI was "Boseong Green Tea" and it was registered on 25 January 2002. National Agricultural Products Quality Management Service, *Geographical Indication System*, available at: http://www.naqs.go.kr/eng/contents/Agrifood/Agrifood/H_01.naqs.

[647] J. SUH - A. MACPHERSON, *The impact of geographical indication on the revitalisation of a regional economy: a case study of "Boseong" green tea*, in *Area*, Vol. 39, Issue 4, pp. 518-527, 2007.

[648] National Agricultural Products Quality Management Service, *Geographical Indication System*, available at: http://www.naqs.go.kr/eng/contents/Agrifood/Agrifood/H_01.naqs.

[649] Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea*, *op. cit.*, p. 51.

[650] Agricultural and Fishery Products Quality Control Act, Article 32 paragraph 2.

[651] Agricultural and Fishery Products Quality Control Act, Article 32 paragraph 3.

Once an application for registration has been filed, the GI registration subcommittee examines if grounds for the rejection of registration exist, hearing also the opinion of the KIPO to check whether the GI applied for conflicts with another individual's TM under the Trademark Act[652]. If the rejection is overcome, MFAFF publishes the application on the Official Gazette and within two months from that date any person may file a formal opposition with the Minister[653]. Where no formal opposition is filed or where, upon receipt of the opposition, the Minister determines that no justifiable grounds for the rejection exist, the GI is registered and MFAFF issues a certificate of registration to the persons entitled to use the GI in question[654]. Once the GI has been registered the protection is potentially perpetual with no need for renewal, unless otherwise cancelled or nullified by authorities[655]. Moreover, for the purpose of maintaining the quality of GI designated goods and protecting consumers, AFPQCA provides for the post-management of the registered GI[656]. In fact, according to Article 39 the Minister may instruct the relevant public officials to do the following acts: to examine whether product bearing the GI meet the *criteria* for registration, to inspect documents of the owner, occupant or manager of the GI designated products, to collect samples of the GI products for inspection or for testing by expert test institutions[657].

A registration under AFPQCA gives the applicant the right to use the GI on its products as well as to label them with a specific mark and the right to prevent third parties who have not secured a registration from using a similar or identical indication[658]. However, it is important to underline in this context that, according to

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[652] Agricultural and Fishery Products Quality Control Act, Article 32 paragraph 4.

[653] Agricultural and Fishery Products Quality Control Act, Article 32 paragraph 6.

[654] Agricultural and Fishery Products Quality Control Act, Article 32 paragraph 7 and 8.

[655] Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea*, *op. cit.*, p. 23.

[656] Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea*, *op. cit.*, p. 31. See Agricultural and Fishery Products Quality Control Act, Article 39.

[657] National Agricultural Products Quality Management Service, *Geographical Indication system*, available at: http://www.naqs.go.kr/eng/contents/Agrifood/Agrifood/H_01.naqs.

[658] Agricultural and Fishery Products Quality Control Act, Article 34 paragraph 1 and 3.

this Act, the right holder is not allowed to transfer its GI right to any third party[659]. The rationale behind this provision is the strong and unmovable linkage with the specific geographical area that characterise the GI.

The analysis of the AFPQCA *sui generis* registration system would be incomplete without mentioning the potential challenges to which a registered GI may be subject: cancellation and invalidation. According to Article 43, the invalidation of a protected GI may be claimed by any interested party or by the GI subcommittee in two cases: (i) where the GI was registered despite an existing rejection ground or (ii) where the registered GI ceases to be protected or is no longer used in the country of origin. This Article reproduces the exception provided for by Article 24 paragraph 9 of the TRIPs Agreement[660]. If the invalidation is then confirmed by a judicial decision, the right shall be deemed not to have existed in the first place[661]. Article 44, instead, establishes two conditions for the cancellation of a registered GI: (i) where the registrant does not allow admission into the organisation, e.g. through prohibition or setting forth difficult membership requirements or if a person not entitled to use the GI is admitted as a member of the organisation or (ii) where the registered organisation misuses the GI misleading consumers as to the quality and to the origin of the products. In this case, the GI right shall cease to exist immediately upon confirmation of the decision to cancel the GI in question[662].

A number of comments can be made in relation to these two Articles. First, unlike the EU system which provides only for the potential cancellation of a registered GI, South Korean law allows also for its invalidation *ex tunc*. Second, cancellation grounds are similar to those established for collective and certification marks[663] and this might rise the question as to whether South Korea understands GIs

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[659] Agricultural and Fishery Products Quality Control Act, Article 35.

[660] TRIPs, Article 24 paragraph 9: "There shall be no obligation under this Agreement to protect geographical indications which are not or cease to be protected in their country of origin, or which have fallen into disuse in that country".

[661] Agricultural and Fishery Products Quality Control Act, Article 43.

[662] Agricultural and Fishery Products Quality Control Act, Article 44.

[663] Trademark Act, Article 73 paragraph 11 and 13.

as a public asset potentially open to any producer of the area and not limited by any membership requirement or something else.

2.2.2 *The registration procedure under TMA*

In the Republic of Korea, GIs have been protected as collective marks under the Trademark Act[664] since July 1, 2005[665]. In particular, the amended Article 2 introduced the concept of "geographical collective mark" defining it as a "collective mark which is intended to be used directly by a corporation composed solely of the persons who carry on the business of producing, manufacturing or processing goods eligible for a geographical indication, or which is intended to be used by members under the supervision of such corporation"[666]. This new approach had the effect of waiving the general rule of TM law according to which a TM cannot be registered if consisting solely of a mark indicating in a common way the origin of a good or consisting solely of a conspicuous geographical name[667] unless it has acquired "secondary meaning"[668]. Under the newly inserted Article 6 paragraph 3, a term that is merely descriptive of the geographical origin of the good or that is a geographical indication, may always be registered as a geographical collective mark.

A GI collective mark may be registered only by a legal entity, comprised of producers or manufacturers or processors of goods eligible for the GI, which has the function of representing its members and the relevant geographic area (e.g.

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[664] Korea enacted the TMA in 1949. The Act had been drafted under the military administration of the United States of America and adopted the first-to-use system similar to US trademark law. However since the system caused uncertainty and confusion, the 1949 Act was completely amended in 1958 to adopt the first-to-file rule. The 1958 TMA preceded the current TMA and has been revised 37 times. See B. KIM - C. HEATH, *Intellectual Property Law in Korea*, *op. cit.*, Chapter 6, p. 1.

[665] Trademark Act as amended by Act No. 7290, December 31, 2004. Amendment available at: http://www.wipo.int/wipolex/en/text.jsp?file_id=128478.

[666] Trademark Act, Article 2 paragraph 3-4.

[667] Trademark Act, Article 6 paragraph 1(3)(4). In the case law see e.g. "Dallas" (Supreme Court, 24 November 1992, 95 Hu 735) and "Paris" (Supreme Court, 24 January 1984, 82 Hu 83). See B. KIM - C. HEATH, *Intellectual Property Law in Korea*, *op. cit.*, Chapter 6, p. 5.

[668] Trademark Act, Article 6 paragraph 2. In this regard the Supreme Court has recognised registrability of the marks "Excel" for car (Supreme Court, 22 December 1989, 89 Hu 438) and "New York" for bakery (Supreme Court, 22 May 1984, 81 Hu 70). In order to prove the secondary meaning, the applicant shall submit evidence showing the protracted use of the mark, the production volume or the sales volume of the goods bearing the mark (Application Rules of the Trademark Act, Section 34 [4]). See B. KIM - C. HEATH, *Intellectual Property Law in Korea*, *op. cit.*, Chapter 6, p. 5.

association or *consortium* of wine makers from a certain region)[669]. Any legal entity that intends to register a GI collective mark must submit to KIPO, in addition to all the other documents already required to register an ordinary TM and a collective mark, the articles of associations, a description of the intended use of the GI mark and evidence showing that the mark conforms to the definition of GI under Article 2 of TMA[670]. It is important to notice that, even here, unlike in the US system, there is the need to show an intrinsic connection between the geographical environment and the specific quality, reputation or other characteristic of the product. Additionally, where an application is filed in relation to items entitled for registration as GIs under AFPQCA, KIPO, before publishing the application concerned, must hear the opinion of the Minister for Food, Agriculture, Forestry and Fishery about whether it falls under the definition of GIs[671]. However, once the application has been published, the GI collective mark follows the same *iter* provided for normal TMs: within two months from the publication date, any interested party may raise an objection to KIPO against the registration of such mark[672] and if no opposition is filed the TM is registered. Its duration, unlike a GI under AFPQCA, is ten years from the date of registration which may be renewed every ten years[673]. The difference with AFPQCA is then stressed by the fact that no separate measure has been established to control the subsequent use and management of the GI collective mark as to constantly guarantee the compliance with those qualities and characteristics declared in the TM application. Problems are solved only through petitions filed by interested parties for the invalidation of the concerned mark[674].

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669 Trademark Act, Article 3-2. See also Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea*, *op. cit.*, p. 14.

670 Trademark Act, Article 9 paragraph 4. See also Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea*, *op. cit.*, p. 18. See also B. KIM - C. HEATH, *Intellectual Property Law in Korea*, *op. cit.*.

671 Trademark Act, Article 22-2 paragraph 3.

672 Trademark Act, Article 25 paragraph 1.

673 Trademark Act, Article 42 paragraph 1 and 2.

674 Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea*, *op. cit.*, p. 32.

A GI registered as a collective mark implies the same right as other TMs: the exclusive right to use the mark in question[675] preventing actual or potential infringements. However, while the right holder of a normal TM shall also have the exclusive right to license[676] and transfer[677] the registered TM for the designated goods, a different provision applies to collective marks, which, according to Article 54 and 55, shall be non-transferable and non-licensable[678]. This ruling seems to be in line with the concept of *terroir* typical of the GI.

A registered GI collective mark may be invalidated and cancelled. An invalidation action may be filed by any interested party or by KIPO: (i) where the TM was registered despite an existing rejection ground or (ii) where the GI registered as a collective mark ceases to be protected or is no longer used in the country of origin[679]. In this case, when the trial decision that TM be invalidated becomes final, that right shall be deemed not to have existed from the beginning[680]. On the other hand, a trial for cancellation may be requested by any interested party: (i) where the owner of the TM fails to use it for at least three years consecutively without justifiable grounds; (ii) where the owner of the GI mark prohibits any producer or manufacturer of the designated goods entitled for the GI from joining the organisation or allows any person disqualified for using the GI to enter the organisation; (iii) where the owner of the GI mark misleads consumers as to the quality and the origin of the goods[681]. It appears that, except for the cancellation ground based on non-use, all the other cases of invalidation and cancellation of the GI collective mark are basically identical to those established under AFPQCA. This seems to suggest that Korea has in a certain way, mixed up the concept of GIs as collective rights and of TMs as exclusive rights. However, this confusion, if on one

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[675] Trademark Act, Article 50.

[676] Trademark Act, Article 55 paragraph 1.

[677] Trademark Act, Article 54.

[678] Trademark Act, Article 54 paragraph 9 and 10 and Article 55 paragraph 2.

[679] Trademark Act, Article 71 paragraph 1(1)(6).

[680] Trademark Act, Article 71 paragraph 3.

[681] Trademark Act, Article 73 paragraph 10, 11 and 12.

hand has created a state of chaos and additional costs for market operators[682], on the other hand has led to a more extensive and thorough protection of GIs as TMs. In fact, it can be considered that the TM registration system, as construed by the Korean legislator in 2004, seems to respect quite exhaustively the main feature of the GI *strictu sensu*, i.e. the essential link between a quality, reputation or other characteristic of a product and its geographical origin[683].

2.3 The level of protection

The protection of GIs under Korean laws can be divided in two main categories: protection based on the registration of the GI either as a *sui generis* GI or as a TM and a protection given to all GIs irrespective of their registration[684]. The first type of protection is established exclusively by AFPQCA and by the TMA while the second is provided for by the Unfair Competition and Trade Secret Prevention Act[685] and by the Act on the Investigation of Unfair International Trade Practices and Remedy against Injury to Industry[686].

Under AFPQCA a registered GI shall be protected against any act of affixing or forging a label identical or similar to a registered GI label and any act of direct or indirect use of items identical or similar to the products bearing a registered GI for the commercial purpose of impairing the reputation of the GI[687]. Whereas under

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[682] Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea*, *op. cit.*, p. 125. See also C.K. JUNG, *A Study on the Protection of Geographical Indications*, *op. cit.*. See also S.Y. YOOK, *A study on Geographical Indication Under FTAs and Its Domestic Implementation*, Korea Legislation Research Institute, August 9, 2014.

[683] The extra requirement added by the TMA for the registration of a GI as a collective mark, i.e. the necessity to show an essential link between the quality, reputation or other characteristics of a good and its geographical origin, if on one hand brings Korea into compliance with Article 22 TRIPs definition and thus with the definition of GIs contained in footnote 5 of Article 18.2 of the KORUS, on the other hand, it causes serious problems when a US stakeholder seeks to register its GI collective mark in South Korea. South Korea in fact, may reject the US application on the grounds that, according to the Lanham Act, the essentially attributable test has not been proved.

[684] S.Y. YOOK, *A study on Geographical Indication Under FTAs and Its Domestic Implementation*, *op. cit.*.

[685] Unfair Competition Prevention and Trade Secret Protection Act, as amended by Act No. 11963, July 30, 2013, available at: http://elaw.klri.re.kr/kor_service/lawView.do?hseq=29192&lang=ENG

[686] Act on the Investigation of Unfair International Trade Practices and Remedy Against Injury to Industry, as amended by Act No. 10230, April 5, 2010, available at: http://elaw.klri.re.kr/kor_service/lawView.do?hseq=18599&lang=ENG

[687] Agricultural and Fishery Products Quality Control Act, Article 36 paragraph 2.

TMA a registered GI collective mark shall be protected against any act of forging, possessing or using a TM identical or similar to a registered GI collective mark of another person on goods identical or recognised as identical to the GI collective mark's designated goods and any act of keeping, for the purpose of transfer, goods identical to the designated goods on which a TM identical or recognised as identical or similar to another person's registered GI collective mark is used[688].

If these two provisions are compared with Article 22 of the TRIPs Agreement two remarks can be made. On the one hand, it may seem that AFPQCA and the TMA have *de facto* limited the protection of GIs to particular and specific cases focused on the imitation or on the use of an identical or similar label or TM rather than ensuring their protection against any means that indicates or suggests that the good in question originate in a geographical area other than its true place of origin. On the other hand, while Article 22 of the TRIPs requires that the public be misled as to the geographical origin of the good, both the Acts under analysis do not mention consumer confusion among the conditions needed to be shown.

The level of protection granted to all GIs irrespective of their registration is that established under unfair competition law. The main provision in this regard is Article 2 of the Unfair Competition and Trade Secret Protection Act which provides that: "the term 'acts of unfair competition' means...: (d) an act of causing confusion about the place of origin by making false marks of the place of origin on goods, or on trade documents or in communication by means of advertising of the goods or in a manner that makes the public aware of the marks; or by selling, distributing, importing or exporting goods bearing such marks; (e) an act of making a mark that would mislead the public into believing that goods are produced, manufactured, or processed at places, other than the actual places of production, manufacture, or processing, on goods, or on trade documents or in communications by means of advertisements of the goods that makes the public aware of the mark; or selling, distributing, importing or exporting such mark"[689]. Unlike the protection ensured under AFPQCA and TMA

[688] Trademark Act, Article 66 paragraph 2.

[689] Unfair Competition Prevention and Trade Secret Protection Act, Article 2 paragraph 1(d)(e).

this provision seems to perfectly reflect the content of Article 22 of the TRIPs Agreement thus making the Korean system compliant with the *minimum* standard of protection required. Before the implementation of the EU-Korea FTA, Article 2 of the Unfair Competition Act represented the highest protection that a GI in South Korea could have.

The last important provision in this regard is Article 4 of the Act on the Investigation of Unfair International Trade Practices and Remedy Against Injury to Industry which defines as "unfair international trade practices": the act of supplying or exporting goods which violate GIs as protected by Korean statutes or by treaties signed by the Republic of Korea, the act of exporting or importing goods whose marks of origin are false or misleading and the act of exporting or importing goods whose quality is falsely or exaggeratedly stated[690]. The purpose of this Article is to ensure the establishment of fair trade and the protection of domestic industries[691] by extending the level of protection of Article 2 of the Unfair Competition Act to international trade practices and by giving importance to those international treaties to which the Korea is party.

2.4 The relationship with TMs

The rules concerning the relationship between GIs and TMs can be found in AFPQCA and in the TMA respectively.

Article 32 paragraph 9 of AFPQCA provides that where the GI seeking protection is identical or similar to a third's party's trademark for which an application has already been filed or registered in accordance with the Trademark Act, the Minister for Food, Agriculture, Forestry and Fishery shall reject the GI application. This Article expressly establishes the principle of priority removing the possibility for a GI to be registered if an identical or similar TM has already been filed or registered.

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[690] Act on the Investigation of Unfair International Trade Practices and Remedy Against Injury to Industry, Article 4.

[691] Act on the Investigation of Unfair International Trade Practices and Remedy Against Injury to Industry, Article 1.

Under Article 7 paragraph 9-2 of TMA, the general rule, before the implementation of the KOREU, was to deny the registrability of a TM, identical or similar to another party's well known GI, only when it was meant to be used on goods *identical* to the ones using such GI[692]. The same rule applied when a TM, identical or similar to another persons's registered geographical collective mark, was meant to be used on goods *identical* with the designated goods[693]. Thus, until 2011, TMs identical or similar to a prior registered GI but used on *similar* goods were registrable. By contrast this was not allowed in case the TM in question was identical or similar to another prior TM. Therefore GIs and geographical collective marks were basically granted lower protection than other traditional TMs whose effects were extended also to *similar* goods.

Beside this specification, however, it is evident that, both under AFPQCA and TMA, the rule governing the relationship between GIs and TMs is always the "first in time first in right" principle.

2.5 Generic terms

AFPQCA contains two important provisions on generic terms. Article 32 paragraph 9(4) prevents a GI corresponding to a general term to be registered[694] and Article 43 provides for the invalidation *ab origine* of a GI registered notwithstanding the impediment of Article 32 paragraph 9(4). These Articles basically reproduce the exception established for generic names under Article 24 paragraph 6 of the TRIPs Agreement. However, as already discussed above[695], the case of a name becoming

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[692] Article 7 paragraph 9-2 of the former Trademark Act stated as follow: "trademarks which are identical with or similar to another person's geographical indication which is well known among consumers as indicating the goods of a specific region or locality and which are to be used on goods identical with the goods using such geographical indication". The Trademark Act before the Amendment of 2011 is available at: http://elaw.klri.re.kr/kor_service/lawView.do?hseq=18985&lang=ENG.

[693] Article 7 paragraph 7-2 of the former Trademark Act stated as follow: "Trademarks which are identical with or similar to another person's registered geographical collective mark, the registration of which was made by an earlier application, and which are to be used on goods identical with the designated goods".

[694] The same Article specifies that for "general term" is understood the name of an agricultural or fishery product which, although originally related to a specific place of production, has become a common noun as a consequence of its long use.

[695] See above Chapter III, paragraph 2.1.4.

generic only after its legitimate registration as a GI is not mentioned among the grounds for cancellation under Article 44 of AFPQCA leading to the conclusion that, according to Korean law, once regularly registered, a GI cannot become generic at a later stage.

The TMA prevents the registration of those trademarks that consist solely of marks indicating in a common way the ordinary name of a good[696]. However, unlike AFPQCA, it enumerates, among the grounds for the invalidation of the TM, the case of a trademark legitimately registered which looses its distinctive character becoming a generic name after the registration. This process of trademarks becoming generic and no longer being protectable is referred to as "genericide" and applies also to geographical collective mark. Thus, according to Korean law, while a *sui generis* registered GI cannot be invalidated on the basis of subsequent genericness, a GI registered as a TM is liable to be cancelled on that ground.

2.6 A specific regime for wine and spirit GIs

In order to incorporate, at least partially, the new obligations imposed by the TRIPs Agreement in relation to the protection of wine and spirit GIs, in 1997 the Trademark Act was revised so as to proscribe the registration of TMs containing or consisting of GIs for wines or spirits and used in connection with wines, spirits or other similar goods[697]. This provision clearly reflected the content of Article 23 paragraph 2 of the TRIPs Agreement[698].

However this clause was considered insufficient. In June 2000, the "Notice on Use of Trademarks in connection with Liquor"[699], which is a National Tax Service

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[696] Trademark Act, Article 6 paragraph 1 and Article 23 paragraph 1.

[697] Trademark Act, Article 7 paragraph 14. This Article was amended in 2004 as to allow the registration of wines or spirits GIs as geographical collective marks: "the foregoing shall not apply where any person entitled to use such geographical indications applies for geographical collective mark registration of the goods concerned as designated goods under Article 9 (4)".

[698] TRIPs Agreement, Article 23 paragraph 2 states as follow: "the registration of a trademark for wines which contains or consists of a geographical indication identifying wines or for spirits which contains or consists of a geographical indication identifying spirits shall be refused or invalidated, ex officio if a Member's legislation so permits or at the request of an interested party, with respect to such wines or spirits not having this origin".

[699] National Tax Service Notification No. 2000-33, available only in Korean at: http://www.law.go.kr/admRulLsInfoP.do?admRulSeq=2100000021689

Regulation subordinate to the Liquor Tax Act, was amended. The newly inserted Article 7 of the Notice "prevents the use of GIs identifying wines or spirits for wines or spirits not originating in the place indicated by the GI in question, even where the true origin of the goods is indicated or the GI is used in translation or accompanied by terms such as 'kind', 'type', 'style', 'imitation' or the like"[700], thus providing the basis to perform the obligation to give additional protection to wine and spirit GIs under Article 23 paragraph 1 of the TRIPs Agreement.

Therefore, the South Korean system, at least before 2011, provided for two different levels of protection: one basic level used in relation to GIs for agricultural, fishery products and other goods and an additional level with regards to wine and spirit GIs. This, while on the one hand was considered perfectly compliant with the distinction in the TRIPs Agreement, on the other hand caused some problems in the implementation of the Korea-EU FTA which required the extension of the additional protection to products other than wines and spirits[701].

3. A brief review of the GI commitments under KOREU and KORUS

In order to better understand how KOREU and KORUS have affected the South Korean system as described above, a brief review of the main obligations established under the two FTAs might be useful. The main targets of the EU in relation to GIs when entering into international negotiations are the followings: the establishment of an open list of EU names to be protected directly and indefinitely in the third country (including controversial expression such as "Feta", "Asiago", "Fontina" and "Gorgonzola") from the entry into force of the agreement; the extension of the higher protection of Article 23 to products other than wines and spirits; the co-existence with prior trademarks if they were registered in good faith; the phasing out of prior generic EU names; the attempt to limit the extensive use of Article 24 TRIPs

[700] National Tax Service Notification No. 2000-33, Article 7.

[701] KOREU, Article 10.21.

exceptions and the obtainment of an *ex officio* protection[702]. Unsurprisingly, as it was pointed out in the previous Chapter, all these ambitious objectives have been achieved in the KOREU. In particular, the Parties recognised that each has legislation in place for the registration and control of GIs that meet the *criteria* set out in the FTA[703]; they agreed to list a number of GIs annexed to the Agreement that are to be protected at a TRIPs-plus level[704]; they inserted a "grandfather" clause which allows continued use of TMs already in existence before the date of the application for protection or registration of a GI that is included in the annexes[705]; they agreed for an enforcement procedure at the initiative of the respective authorities in each Party or at the request of an interested party[706]; and finally they established a Working Group on GIs with the aim of adding new GIs to the annexes[707]. These achievements made the EU-Korea FTA one of the most successful example of the EU external action in relation to GIs within a preferential trade agreement.

This successful result from an EU perspective has probably been favoured by two main factors: first, by the fact that Korea already had in place a *sui generis* system of GI protection and second, by the fact that KOREU entered into force before KORUS. This priority was essential in order to avoid the detrimental effects of the GI provisions contained in the US agreement.

In fact, in the KORUS, the US' preference for protecting GIs through the trademark system is self-evident and implies: the partial extension of the definition of GIs as to comprehend part of the definition of trademarks[708], the retention of the

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[702] DG-AGRI, Working document on international protection of EU Geographical Indications: objectives, outcome and challenges, Advisory Group International Aspect of Agriculture, *op. cit.*, pp. 8-9. See also D.V. EUGUI – C. SPENNEMANN, *The Treatment of Geographical indications in recent Regional and Bilateral Free Trade Agreements,* in *The Intellectual Property Debate: Perspectives from Law, Economics and Political Economy,* M.P. Pugatch (ed.), Edward Elgar, Cheltenham UK – Northampton, MA, USA, 2006, p.312 ss. See also M. HANDLER – B. MERCURIO, *Intellectual Property,* in *Bilateral and regional trade agreements: commentary and analysis*, *op. cit.*, p. 334. See above Chapter 2, paragraph 1.3.

[703] KOREU, Article 10.18 paragraph 1 and 2.

[704] KOREU, Article 10.18 paragraph 3 and 4, Article 10.19 and Article 10.21.

[705] KOREU, Article 10.21 paragraph 5.

[706] KOREU, Article 10.22.

[707] KOREU, Article 10.24 and 10. 25.

[708] KORUS, Article 18.2 paragraph 2, footnote 5.

scope of protection for goods other than wines and spirits to the "confusingly similar" standard[709], the predominance of pre-existing trademarks over later GIs[710], the emphasis added on the exceptions under Article 24 of the TRIPs and the inclusion of certain procedural safeguards such as opposition and cancellation proceedings to address concerns regarding protection of prior rights[711]. More specifically, KORUS expressly required GIs to be protected as TMs, namely certification and collective marks[712], demanded procedures for opposing geographical indications that are subject of applications and petitions[713], and mandated the refusal and cancellation of those GIs that are likely to cause confusion with prior TMs[714].

KOREU and KORUS can hence be regarded as perfect examples of the EU and the US conflicting stance over GIs: the automatic recognition of certain GIs *versus* the requirement to always guarantee an opposition phase, the objective *versus* the subjective level of protection, and the co-existence *versus* the priority principle in the relationship between TMs and GIs[715]. So that begs two questions, first, how had the Korean dual system of protection, as described above, to be modified or integrated to be able to satisfy the provisions of the two FTAs? Second, will the Korean amended system be capable to comply with the conflicting commitments therein? In the paragraphs below, the paper aims at addressing these questions.

4. Amendments to the South Korean legislation with the entry into force of KOREU and KORUS

Having analysed the Korean GI legislation and having reviewed the main provisions of the two FTAs it is now possible to examine the principal amendments

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[709] This is implied by the assimilation of GIs to the TM system.

[710] KORUS, Article 18.2 paragraph 15 and Article 18.2 paragraph 4.

[711] KORUS, Article 18.2 paragraph 14.

[712] KORUS, Article 18.2 paragraph 2.

[713] KORUS, Article 18.2 paragraph 14 letter (e).

[714] KORUS, Article 18.2 paragraph 15.

[715] See above Chapter III paragraph 2.3.

that have affected Korea as a a consequence of the entry into force of the bilateral treaties in question.

The only addition that the Korean Government carried out in order to comply with the Korea-US FTA, was the insertion of the certification mark among the means available to register a GI as a TM[716]. Hence, with an amendment of December 2011[717], Seoul's officials introduced the concept of geographical certification mark defining it as "a certification mark with geographical indication used by person who carries on the business of certifying the quality, origin, mode of production or other characteristics of the goods in order to certify whether the goods of a person who carries on the business of producing or manufacturing or processing goods satisfy specified geographical characteristics"[718]. However, despite this modification, the collective mark still remains the best tool to protect GIs under the Korean TMA being the only mark exempted from the "secondary meaning rule" or "acquired distinctiveness rule" that is normally required to register a geographical descriptive term as a TM[719].

With regard to the Korea-EU FTA, the amendments that officials in Seoul had to introduce were greater. One of the biggest changes was the inclusion of an additional level of protection for GIs related to products other than wines or spirits. In fact, according to the common understanding of the treaty, the absolute protection provided for by Article 23 of the TRIPs Agreement was extended to all those GIs listed in the FTA[720]. For this purpose, by virtue of the Amendment of June 30, 2011[721] the Korean Government inserted a new Article in the Unfair Competition Prevention and Trade Secret Protection Act, namely Article 3-2, which provides as follow: "as to geographical indications protected under a free trade agreement which

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[716] KORUS, Article 18.2 paragraph 2 states as follow: "each party shall provide that trademarks shall include certification marks".

[717] Act No. 11113, December 2, 2011.

[718] Trademark Act, Article 2 paragraph 4-2. See B. KIM - C. HEATH, *Intellectual Property Law in Korea*, *op. cit.*, p. 4.

[719] Trademark Act, Article 6 paragraph 3. Note that the term "geographical certification mark" is not mentioned by this Article. See above paragraph 1.2.2.

[720] See above Chapter III paragraph 2.1.2.

[721] Act No. 10810, June 30, 2011.

is concluded bilaterally or mutually and takes effect between the Republic of Korea and a foreign country, or foreign countries...in addition to the act of unfair competition under subparagraphs 1 (d) and (e) of Article 2, any person who does not have a legitimate source of right shall not conduct any of the following acts with respect to the goods whose place of origin is not the one indicated in the geographic mark concerned (limited to goods that are identical to or recognised to be identical to the goods with the relevant geographic mark): using a geographic mark separately, in addition to the authentic place of origin; using a geographic mark which is translated or transliterated; using a geographic mark with the expression of 'kind', 'type', 'mode', 'counterfeit' or other expressions"[722]. However this rule does not apply if the prior use of the mark began before July 1, 2011 and the mark has become recognised by consumers[723].

This provision basically increases the level of protection in relation to all those GIs listed in an FTA where South Korea is party, regardless of the type of goods on which such GIs are used. However, while on the one hand this rule brings Korea into compliance with the requirements of the agreement with the EU, on the other hand, it generates discrimination between those foreign and national GIs listed in the FTA and those registered Korean or foreign GIs not listed in the FTA. Is this discrimination admissible under Korean law? The following section, among other matters, will also try to answer this question.

Another amendment that the Korean Government had to make in order to satisfy the commitments agreed upon in the KOREU pertained to the relationship between TMs and GIs. In fact, under Article 10.23 of the FTA, if a TM, that may infringe the scope of protection granted to a GI, is applied for on *similar* goods, its registration shall be refused or invalidated, provided that the TM application was submitted after the date of application for the protection or recognition of the GI in the territory concerned. By contrast, the Korean TMA only prevented a TM, identical or similar to another person's GI which was filed earlier for *identical* goods, to be refused or

[722] Unfair Competition Prevention and Trade Secret Protection Act, Article 3-2 paragraph 1.

[723] Unfair Competition Prevention and Trade Secret Protection Act, Article 3-2 paragraph 3.

invalidated. As such this provision was amended[724] to expand its scope as to include TM applications that are filed for goods *identical* or *recognised as identical* to the designated goods. Despite this modification, however, doubts remain on whether this change may really fulfil the concept of *similar* or *like* goods.

The last important change made by Korea as a consequence of the KOREU was the insertion of paragraph 16 and 17 in Article 7 of the Trademark Act[725]. Two categories of unregistrable TMs have been added: TMs which are identical or similar to another party's GI registered pursuant to Article 32 of AFPQCA and which are to be used for goods identical or recognised as identical to the goods using such GI and TMs which are identical or similar to another person's GI protected pursuant to an FTA. This addition basically protects GIs listed in preferential trade agreements against potential subsequent TM registrations even if those GIs have not been included in the national register under AFPQCA[726].

Now, having examined the Korean GI system in all its different forms and having pointed out what has changed to enable the entrance into force of the two FTAs, the next sections aim at summing up the outcome of this quite detailed analysis.

5. Is South Korean national legislation capable of an interpretation compliant with the provisions on GIs contained in both the FTAs?

5.1 The Korean GI system and the KOREU: comparative analysis

Starting from the Korea-EU FTA, this paper will proceed with an analysis section by section of the Korean legislation in comparison with the provisions of the bilateral agreement in question.

Article 10.18 paragraph 6 of KOREU requires Korea to have in place an *ad hoc* register listing GIs, an administrative process aimed at verifying that GIs respect the

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[724] Act No. 10810, June 30, 2011.

[725] Act No. 10810, June 30, 2011.

[726] B. KIM - C. HEATH, *Intellectual Property Law in Korea*, *op. cit.*, p. 9.

"essentially attributable test" with their product specifications and at continually monitoring the production process and, finally, an objection procedure to safeguard legitimate interests of prior users. In the same Article, at paragraph 1, the EU has been able to get Korea agreement on a *sui generis* system for the protection of GIs implemented by the Ministry of Agriculture, Forestry and Fisheries. In fact, AFPQCA mandates the establishment of a specific subcommittee constituted in the Council on Quality Control of Agricultural and Fishery products with the task to deliberate on the registration of GIs[727] and establishes an *ad hoc* registration and objection procedure[728], a specific register for GIs[729] and a post-management of registered GIs[730]. Thus the EU has been able to get agreement on a system that appears to replicate the EU's domestic system.

Article 10.20 of the bilateral agreement provides that GIs may be used by any operator marketing agricultural products, foodstuffs, wines, aromatised wines or spirits conforming to the corresponding specifications. In this regard, however, doubts may rise on whether the Korean system is compliant with this provision. In fact, reading Article 34 combined with Article 44 of AFPQCA it appears that the idea of exclusive ownership prevails also in relation to GIs. According to these Articles, the person entitled to use the GI in question seems to be the only registrant. However, if he prohibits persons who produce agricultural and fishery products eligible for such GI from becoming member of the organisation, the GI may be cancelled. The latter, based on the concept of membership may lead to the conclusion that the right to use the GI is not *per se* accessible to any producer compliant with the product specifications but may be limited by some membership requirements imposed by the registrant as it happens for certification or collective marks. Nevertheless if these requirements are unjustifiably strict the GI shall be cancelled. It is exactly this last provision that, if rigorously interpreted by the competent authority, may be seen as the key to bring the Korean system into compliance with the

[727] Agricultural and Fishery Product Quality Control Act, Article 3.

[728] Agricultural and Fishery Product Quality Control Act, Article 32.

[729] Agricultural and Fishery Product Quality Control Act, Article 33.

[730] Agricultural and Fishery Product Quality Control Act, Article 39.

commitments of the treaty: the possible cancellation, in fact, if well used, may be a way to guarantee the collective and public nature of the GI.

Article 10.21 of the FTA deals with the scope of protection and requires all GIs listed in the FTA to be protected at a TRIPs-plus level. This request has been fully satisfied by the Korean Government with the recent insertion of Article 3-2 of the Unfair Competition Prevention and Trade Secret Protection Act which ensures GIs protected under FTAs where the Republic of Korea is party a level of protection that resembles the one provided for by Article 23 of the TRIPs Agreement.

Another important provision of the KOREU is that protection of GIs under Article 10.21 is without prejudice of the continued use of prior TMs[731]. This is the famous principle of co-existence between prior TMs and GIs. Korean law does not provide anything in this regard, however, the fact that the list of GIs annexed to the Agreement has been automatically recognised with the entrance into force of the FTA notwithstanding the existence of prior or similar TMs may lead to the conclusion that also this ruling has been respected.

Article 10.23 of the treaty prevents Parties from registering a TM that corresponds to any of the situations referred to in Article 10.21.1 in relation to protected GIs for *like goods*. This provision has been partially included in Article 7 of the Korean Trademark Act according to which: "any trademark which is identical or similar to another person's geographical indication protected pursuant to free trade agreements that have been concluded between the Republic of Korea and foreign countries in a bilateral or multilateral manner and come into effect, or any trademark which consists of or contains such geographical indications and is to be used for goods identical or recognised as identical to the goods using such geographical indications"[732] shall not be registered. This being said, is the expression "recognised as identical" equivalent to the one of "like goods"? Probably not, also because for ordinary TMs the protection is expressly extended to *identical* and *similar* products. This may be seen as a partial infringement of the above mentioned treaty's

[731] KOREU, Article 10.21 paragraph 5.

[732] Trademark Act, Article 7 paragraph 17.

obligation. Beside this remark, however, the newly inserted paragraph 17 of Article 7 has been a great step forward for the automatic recognition of those GIs protected under FTAs in the Republic of Korea.

Finally, under Article 10.22 of the agreement, Parties shall enforce the protection of GIs on their own initiative by appropriate intervention of their authorities and at the request of any interested party. This commitment finds its transposition into Korean law through Article 43 of AFPQCA which enumerates, among the persons entitled to file a request for the invalidation or the cancellation of a certain GI, both any interested party and the subcommittee established in the Council on Quality Control on Agricultural and Fishery products.

5.2 The Korean GI system and the KORUS: comparative analysis

In relation to KORUS, the obligations related to GIs in this Agreement are less demanding than the one provided for by the Korea-EU FTA. However four provisions deserve attention and seems to be directly target agains the EU approach. Article 18.2 paragraph 2 requires Parties to provide that GIs be eligible for protection as TMs. Footnote 5 of the same Article contains a definition of GIs which includes the wording: “any sign or combination of signs, in any form whatsoever”. Article 18.2 paragraph 14 demands the guarantee of a procedure for opposing GIs subject of applications and Article 18.2 paragraph 15 mandates the refusal or the cancellation of the GI that is likely to cause confusion with a prior TM.

With regard to the first commitment, since 2005, the TMA provides for the protection of GIs as collective marks and, since 2011, also as certification marks. In this regard thus, the Korean system can be considered compliant with Article 18.2 of KORUS. In contrast, the definition of GIs as provided for by footnote 5 is a more contentious issue. The TMA defines GIs as mere “indications”[733] excluding “signs” or “combination of signs” from being eligible for registration as geographical collective or geographical certification marks. This may be due to the fact that GIs

[733] Trademark Act, Article 2 paragraph 3-2.

are viewed by Koreans as a separate form of IPR[734], different from traditional TMs, and for this reason even the Trademark Act provides for *ad hoc* paragraphs for the regulation of geographical collective and geographical certification marks separated from traditional trademarks, collective and certification marks. This being said it appears that the scope of protection under Korean law is limited if compared to that required by the FTA and this may be seen as an infringement of one of the treaty's obligation.

Also the opposition phase required by the bilateral agreement in question in relation to each GI application has been guaranteed by Korean law. The relevant provisions in this regard can be found in Article 32 paragraph 5 and 6 of AFPQCA[735] and in Article 25[736] of TMA. However, if on one hand this may satisfy the KORUS obligation, on the other hand, it may contrast with the automatic recognition of certain GIs under KOREU. In this respect, it should be noted that the direct protection of listed GIs has been possible, without infringing any international obligations, only because KOREU entered into force prior to KORUS[737].

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[734] H.J. JEON - J.H. LEE, *A study on the Problems of Geographical Indications and a Regional Development Plan in Korea*, Kyobo Book Center, June 10, 2010, pp. 141-163.

[735] According to Article 32: "(5) When the Minister for Food, Agriculture, Forestry and Fisheries determines to make an official announcement, he/she shall give public notice of the details of such determination through the Official Gazette and put them on the website, and make an application for registration of a geographical indication and documents annexed thereto available for public inspection for two months from the date of the official announcement. (6) Any person may file a formal objection with the Minister for Food, Agriculture, Forestry and Fisheries along with a document stating grounds for the formal objection and evidence within two months from the date of an official announcement made under paragraph (5)".

[736] According to Article 25 paragraph 1: "When any application is published, any person may raise an objection to the Commissioner of the Korean Intellectual Property Office against the registration of the relevant trademark on the grounds that the application falls under any subparagraph of Article 23 (1) or Article 48 (1) 2 and 4 within two months from the date on which such application is published".

[737] See below paragraph 5.3.

Finally, with regard to the principle of priority as established under Article 18.2 paragraph 15[738], its equivalent in the Korean system can be recognised in Article 32 paragraph 9(2) of AFPQCA according to which an application for the registration of a GI shall be rejected where the GI in question is identical or similar to a third party's TM for which an application has already been filed or registered or to a third person's TM widely known in the Republic of Korea. Thus, except for those GIs listed in the KOREU that have been automatically recognised and that are governed by the principle of co-existence with prior similar TMs, the general rule that regulates the relationship between TMs and GIs is the rule of priority in conformity with the US requests.

Last but not least, the level of protection granted to GIs under KORUS seems to be limited to confusingly similar signs. However, in light of the reference, made by the same Agreement, to the TRIPs obligations, the basic level of protection provided for by Article 22 of the TRIPs has to be considered as the *minimum* standard that both contracting Parties have to ensure to GIs. South Korea complies also with this requirement thanks to Article 2 of the Unfair Competition Prevention and Trade Secret Protection Act[739].

5.3 Outcomes of the comparative analysis

It seems that, overall, South Korea, with its dual system of protection, has implemented its GI law in a manner that is compliant with most of the obligations agreed under the free trade agreement with the EU and with the US. The only

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[738] According to Article 18.2 paragraph 15: "Each Party shall provide that each of the following shall be grounds for refusing protection or recognition of, and for opposition and cancellation of, a geographical indication:
(i) the geographical indication is likely to cause confusion with a trademark that is the subject of a good faith pending application or registration in the Party's territory and that has a priority date that predates the protection or recognition of the geographical indication in that territory;
(ii) the geographical indication is likely to cause confusion with a trademark, the rights to which have been acquired in the Party's territory through use in good faith, that has a priority date that predates the protection or recognition of the geographical indication in that territory; and
(iii) the geographical indication is likely to cause confusion with a trademark that has become well known in the Party's territory and that has a priority date that predates the protection or recognition of the geographical indication in that territory".

[739] Unfair Competition Prevention and Trade Secret Protection Act, Article 2 letter (d) and (e). See above paragraph 2.

important exception regards the definition of GIs, which, according to the Korea-US FTA includes "any sign or combination of signs" while under the Korean TMA is limited to "indications". However, with regard to the two main contentious issues in the Trans-Atlantic debate, namely the level of protection and the relationship between GIs and TMs, the Republic of Korea has been able to balance those different approaches in its domestic law and to enforce all the commitments established under KORUS and KOREU in this regard. This has been possible for two reasons.

First because the Korea-EU Agreement just required the extension of the level of protection and the imposition of the co-existence rule only to those GIs listed in the FTA and not to all GIs protected in the contracting Parties. The key provision in this context is Article 3-2 of the Unfair Competition Prevention and Trade Secret Protection Act which solves, in a clever way, the problem of the US and EU conflicting agendas over GIs. It grants absolute protection only to those GIs directly recognised through FTAs as required by KOREU[740] and at the same time it implicitly confirms that all the other agricultural and foodstuffs GIs shall be protected at a lower level, namely the one provided for by Article 22 of the TRIPs as desired by the US.

Second, because KOREU entered into force before KORUS and therefore the automatic recognition of some GIs without a mandatory public opposition phase was still possible. However problems may arise in the future when GIs are added to the annexes according to the procedure laid down in Article 10.25 of the KOREU. In fact, under the terms of the KOREU, new GIs may be included in the FTA upon a simple decision of the Working Group. As a consequence, the US may contend that Korea, by enlarging the list of GIs which benefit from automatic and direct protection in South Korea, infringes the obligation to always ensure an opposing or

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[740] Unfair Competition Prevention and Trade Secret Protection Act, Article 3-2, provides as follow: "as to geographical indications protected under a free trade agreement which is concluded bilaterally or mutually and takes effect between the Republic of Korea and a foreign country, or foreign countries...in addition to the act of unfair competition under subparagraphs 1 (d) and (e) of Article 2, any person who does not have a legitimate source of right shall not conduct any of the following acts with respect to the goods whose place of origin is not the one indicated in the geographic mark concerned (limited to goods that are identical to or recognised to be identical to the goods with the relevant geographic mark): using a geographic mark separately, in addition to the authentic place of origin; using a geographic mark which is translated or transliterated; using a geographic mark with the expression of 'kind', 'type', 'mode', 'counterfeit' or other expressions". See above paragraph 2.

cancellation proceedings in relation to each GI application. This conflict would be a direct consequence of the different approaches adopted by the EU and the US and imposed in the same jurisdiction.

That being said, although as to date Korea seems not to be in a position of incompatibility with regard to the majority of the international obligations assumed, the ratification of the KOREU and the KORUS affected the legal coherence of the Korean legislation.

As a matter of fact, the ratification of the treaties increased the state of chaos and sharpened the complexity of an already intricate system, where provisions over GIs are placed in several different regulations and where it is hard to retrieve and understand the relevant rule of conduct[741]. The complexities are in part due to the inadequate information provided by the Korean Government in this regard[742]. According to the TMA and to AFPQCA, any person who produces agricultural or fishery products the characteristics, the quality or the reputation of which is essentially attributable to its place of origin and who wants to obtain a GI registration in Korea, has two options: register such indication as a TM or as *sui generis* GI. Both the regimes give the registrant the following advantages: the exclusive right to use the GI, the right of priority against subsequent identical or similar TMs applications in relation to goods identical or recognised as identical and the right to prevent confusingly similar uses of such registered indication. TMA and AFPQCA require similar documents for the filing of a GI application and both demand the proof of the causal link between the characteristics of the good and its geographical origin. As to the level of protection, GI collective or certification marks and *sui generis* GIs, as well as unregistered indication of geographical origin, are all protected under the Unfair Competition Act which ensures TRIPs 22 level of protection. The only main difference concerns the duration of the rights, perpetual for *sui generis* GIs and limited for GI collective or certification marks and the administrative control to which only the *sui generis* GI is subject. This overlap between the two systems

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[741] S.Y. YOOK, *A study on Geographical Indication Under FTAs and its Domestic Implementation*, Korea Legislation Research Institute, August 9, 2014.

[742] C.K. JUNG, *A Study on the Protection of Geographical Indications*, *op. cit.*.

generates confusion as well as high costs for the maintenance of different procedures and bureaucracies[743]. For all these reasons, some distinguished authors have envisaged the need of a reform for the creation of a unique specific system[744]. In this respect, the entrance into force of the two FTAs have removed any chance of such a reorganisation. In fact, having in place a TM as well as a GI regime for the protection of GIs is necessary in order to comply with the different commitments established under the KOREU and the KORUS.

Beside the obstacles posed by the bilateral agreements in question to the reform of the system, their implementation have led to the establishment of a domestic system that may conflict with fundamental principles of the law. The rule of protecting GIs listed in FTAs at a higher level than all the other national registered GIs as a consequence of the EU-Korea FTA may violate the non-discrimination principle as stated in the Korean Constitution. In fact, comparing Article 3-2 of the Unfair Competition Prevention and Trade Secret Protection Act with Article 2 letter (d) and (e) of the same Act it is clear that GIs protected under FTAs benefit from a higher level of protection, namely from Article 23 TRIPs level of protection, than all the other national or foreign GIs not listed in the agreement. Neither the TMA nor AFPQCA grant to GIs such a high and comprehensive protection. Is this compliant with Korean law? There is as yet no case law on the issue. The Korean Constitution calls for the principle of equality among Korean citizens. Under Article 11: "(1) all citizens shall be equal before the law, and there shall be no discrimination in political, economic, social or cultural life on account of sex, religion or social status. (2) No privileged caste shall be recognized or ever established in any form"[745]. This fundamental principle of the law, according to the common understanding of the Korean Supreme Court, requires that similar situations shall not be treated differently

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[743] C.K. JUNG, *A Study on the Protection of Geographical Indications*, *op. cit.*.

[744] S.Y. YOOK, *A study on Geographical Indication Under FTAs and its Domestic Implementation*, *op. cit.*.

[745] The Constitution of the Republic of Korea, as amended on 29 October 1987, available at: http://www.wipo.int/edocs/lexdocs/laws/en/kr/kr061en.pdf.

unless differentiation is reasonably justified[746]. Thus, if foreign GIs or a certain number of national GIs - i.e. those Korean GIs registered before 2008 - enjoy better rights under Korean law, there might be room for alleging a violation of the equality principle. Hence, if a violation were contended by an unlisted GI holder based on such inequality, the Korean Supreme Court would have to consider, as a decisive factor, whether such inequality was the result of Government's arbitrariness or of Government's justifiable discretion in support of a legitimate position. The new Unfair Competition Act created two different types of rights, one for listed GIs and one for unlisted GIs and it is conceivable that this distinction was made on the belief that listed and unlisted GIs are not to be considered absolutely identical. This view would justify the different treatment. However, what would make those GIs dissimilar? The mere fact that some GIs have been inserted in a free trade agreement does not make them *per se* different from all the other GIs registered through national procedure. In GI law, unlike TM law, a separate category of "well-known GIs" does not exist and, in theory, all GIs should be treated equally. The only legitimate distinction, according to TRIPs, concerns wines and spirits GIs as opposed to agricultural products GIs. In support of this allegation it should be noted that, in the KOREU, Korea listed basically all its GIs registered at the time the negotiating talks were closed, and therefore the choice was not based on a supposed prevalence of certain Korean GIs over others. If all GIs were inserted in the agreement, why did Korea not change its internal law as to give every *sui generis* GI the same level of protection? According to the current regime, dozens of national GIs registered under AFPQCA after 2008 and foreign GIs registered *via* national procedure in Korea enjoy a lower protection. Following this argument, it is reasonable to say that no justification exists for such a different treatment and it is conceivable to believe that

[746] Y.H. KIM - H.C. JEONG, *Basic Classes of Constitution*, Willbes, Seoul, South Korea, February 13, 2015, pp. 346 ss. (Korean title: 정회철, 기본강의 헌법 *2015,*사법시험 및 변호사시험 대비, 저자 김유향, |윌비스). In the case law see: KCCR May 29, 2008, 2007Hun-Ma1105; KCCR February 3, 2005, 2001Hun-Ga9; KCCR August 30, 2007, 2004 Hun-Ma670; KCCR June 28, 2007, 2004 Hun-Ma 644.

the Government adopted this halfway solution as to undermine the least possible the US' commercial interests[747].

6. Korea at the crossroad of economic interests and legal coherence

A country's primary aim, when entering into FTA negotiations, is to obtain economic advantages, to reduce tariff and non-tariff barriers and to increase trade relationships with the negotiating partner[748]. However, all new generation FTAs concluded by the EU and the US, unlike precedent trade deals, go well beyond the elimination of tariffs and incorporate to varying degrees WTO provisions[749] including detailed obligations with regard to IPRs[750]. In this framework, if a contracting party wants to achieve the privileges and the economic advantages of a free trade area with the EU or the US, it also has to deal with the legal consequences of such an agreement for its national legislation. Agreements that always more often require the party to implement new IP regulations and new IP standards as to align its system to the level of protection desired by the EU and the US, the two "regulators of the world"[751]. However, problems arise when the commitments required by either the EU or the US are different. When this happens, the present study shows that the first agreement has an impact on the room for manoeuvre left to the parties in relation to the second[752]. In the case of Korea, the EU succeeded in closing its Agreement before the US. This allowed the EU to achieve the objectives without making compromises, in particular the EU obtained the mutual recognition of 164 GIs (among which, e.g., "Gorgonzola", "Fontina", "Asiago"). The US was not in a

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[747] In the absence of case law, this reasoning is the result of the personal understanding of the author on the matter.

[748] T. FERIDHANUSETYAWAN, *Preferential Trade Agreements in the Asia-Pacific Region*, International Monetary Fund, Working Paper WP/05/149, July 2005, p. 14.

[749] A. SEMERTZI, *The Preclusion of Direct Effect in the Recently Concluded EU Free Trade Agreements*, in *Common Market Law Review*, Vol. 51, pp. 1125-1158, Kluwer Law International, United Kingdom, 2014.

[750] H. HORN - P.C. MAVROIDIS - A. SAPIR, *Beyond the WTO? An Anatomy of EU and US Preferential Trade Agremeents*, *op. cit.*, p. 3.

[751] H. HORN - P.C. MAVROIDIS - A. SAPIR, *Beyond the WTO? An Anatomy of EU and US Preferential Trade Agremeents*, *op. cit.*, p. 3.

[752] M. GARCIA, *Squaring the Circle? Approaches to Intellectual Property Rights and the TTIP*, *op. cit.*, pp. 6-7.

position, on the basis of its later FTA, to prevent such automatic protection. This had the potential for negative consequences for US exports to Korea. In fact, American producers and suppliers, since the entrance into force of the Korea-EU FTA, have been prevented from selling, in Korea, products bearing names identical to those listed in the Agreement even if the true origin is indicated, or if they are accompanied with expressions such as "like", "style" or the like or if they are used in translation[753]. US stakeholders have also been blocked from registering such indications as TMs[754].

In this battle over conflicting interests Korea found itself in a difficult position. In order to benefit from the trade advantages arising out of the FTAs, Korea had to accept the EU hard stance over GIs and to modify its internal law in order to give European GIs the level of protection sought[755]. On the other side, US trade representatives disclosed their concerns over the GI system outlined by the EU-Korea FTA and investigated to what extent the KOREU would have affected the successful conclusion of KORUS[756]. Korean Ministers, in an exchange of letters, had to reassure the American partners that the KOREU would not have effectively undermined the US export market[757]. Officials in Seoul knew that the problem of GIs had to be treated with caution as it was a burning issue for both trade partners.

As a result, the current GI regime in South Korea seems to be the outcome of a compromise solution, of an attempt to please everyone. Both the KORUS and the

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[753] Among others, the names "feta", "fontina" and "gorgonzola" have been inserted in Annex 10-A of KOREU and therefore, since July 2011, identical or similar products coming from the US, Canada or Australia and sold as "feta made in the US" or "like gorgonzola" shall not be admitted in the Korean market. This is the rule. Nevertheless, identical products coming from countries other than Italy or Greece and sold under those names are still available for Korean consumers in many supermarkets. Probably, as long as Europe does not say anything in this regard, Korea is trying to delay the devastating consequences that the KOREU will have on the US, Canadian and Australian export market.

[754] Information on the refusal of US TMs' applications in relation to "gorgonzola", "fontina" and "asiago" can be accessed at: http://engportal.kipris.or.kr/engportal/search/total_search.do.

[755] Unfair Competition Prevention and Trade Secret Protection Act, Article 3-2.

[756] Official Letter sent by Ambassador Ron Kirk to the Minister of Trade in the Republic of Korea Jong-hoon Kim on June 09, 2011, available at: https://ustr.gov/sites/default/files/uploads/pdfs/PDFs/December%202012/060911%20Kirk-Kim%20Letter%20on%20GIs.PDF.

[757] Official Letter sent by the Minister of Trade in the Republic of Korea Jonh-hoon Kim to Ambassador Ron Kirk on June 20, 2011, available at: https://ustr.gov/sites/default/files/uploads/pdfs/PDFs/December%202012/062011%20Kim-Kirk%20Letter%20on%20GIs.pdf.

KOREU were too important for Korean exports to the EU and the US to be held up by GIs. In this respect, however, Korea's efforts to develop a GI system capable of complying with the different obligations required by the KOREU and the KORUS should be acknowledged and admired. What this Chapter wants to underline are the hurdles caused by the entrance into force of such comprehensive FTAs as a consequence of the divergent approaches adopted in relation to GIs in the EU and the US. In the absence of a common strategy, these bilateral agreements may jeopardise the coherence of a country's domestic system with respect to basic principles of the law.

CONCLUSION

The legal means for the protection of GIs varies from country to country due to the flexibility in the TRIPs itself. Both the US and the EU therefore adopted different systems for the protection of GIs that reflect their different economic interests and different legal traditions. The EU considers that GIs are a stand alone form of intellectual property requiring a specific *sui generis* law. The US on the other hand considers GIs a sub-set of trademarks. In addition to this fundamental difference, the EU seeks the extension of the absolute protection of TRIPs Article 23 to products other than wines and spirits and the co-existence between GIs and prior TMs while the US seeks to promote the "first in time first in right" principle, fundamental to a trademark regime.

Chapter III examines this difference in the context of the increasing number of Free Trade Agreements being concluded by the US and the EU. Each has detailed provisions on GIs reflecting the different starting points and approaches of the two sides. And both the EU and the US have sought to transfer their approaches into the law of the third countries with which they are negotiating. This is particularly so in relation to the East Asian Region, where most of the fast-growing economies are located. The analysis shows that the arm-wrestling match between the EU and the US with regard to GIs in Asia is basically governed by the "first come first served" rule: the country which concludes a deal first gets the best deal. Korea is the perfect example. South Korea, in its struggle to strike a balance between the two systems of GI protection imposed in the two FTAs it has signed with the EU and the US, changed its domestic law which, even if it managed to balance quite different obligations in the two FTAs, may have had to infringe its own constitutional obligations not to discriminate in the treatment of different local GIs.

Some conclusions can be made. The actual competition between the EU and the US to impose their concepts of GI across the world by means of bilateral and plurilateral preferential trade agreements with the same third country has two consequences: first, it is threatening the legal coherence of the national laws of their

trading partners, second it is clearly undermining the possibility to create a uniform system for the protection of all GIs throughout the world.

The protection of GIs should not be dependant on the patchwork of deals being concluded by the EU and the US. This is especially so given that Asian countries are still weak bargaining partners *vis-à-vis* their more powerful trading partners and are willing to accept whatever is required on GIs just to get the deal done. The fact that GIs are regulated and protected differently in each country may prevent equal market access undermining some of the main objectives of the TRIPs itself, i.e. to set up a uniform and fair international intellectual property law for all Member States in order to reduce distortion and impediments to international trade.

Rather than locking themselves in a mercantilistic battle over a limited number of specific GIs by means of overlapping and conflicting bilateral agreements with the same Asian partners, the EU and the US should take a step back from Asia and focus on achieving a coherent compromise that could provide the basis for a multilateral agreement, possibly in a revived Doha Round. The "first come first served" rule plays a pivotal role for the successful conclusion of these FTAs. However this race to conclude deals cannot mask the failure to address the underlying need to get the formal recognition of GIs as a separate form of IPRs. The small victories that the EU has achieved in ensuring some form of protection for some of Europe's most famous GIs in some of the agreements is not necessarily a reason to celebrate. The object of any international negotiation should rather be to set out a series of basic and commonly agreed principles to address the "essentially attributable test" required by TRIPs Article 22, the need for co-existence between GI and TM law and the problems surrounding a limited number of specific names considered both generic and specific by consumers in different markets.

The difficulties that the current bilateral rather than multilateral approach is creating should not be underestimated. In this respect, it seems appropriate to recall a statement made by the first WTO Director General, Mr. Ruggiero, on the occasion of the WTO symposium held in Geneva in April 2005: "it seems that preferential agreements are no more considered as an exception to the non-discrimination rule,

but as an instrument of normal competition with the multilateral system. If the Doha Rounds fails, the movement towards the consolidation and the creation of new vast preferential areas, sometimes covering a whole continent, will increase. This will not only change the trade geography, but also influence political relations. The risk is an international trade system with no more rules agreed by everyone, where the poor and the weak will have to fear 'a return to the law of the jungle'...Are we 'deglobalizing' the international trade system? The rigidities of the system will increase and the disputes between these vast regional preferential areas could become dangerous. This is, I believe, the most important challenge in today's international trading system".

Ruggiero was addressing the general *phaenomenon* of FTAs. But his concerns can easily describe the current situation for the harmonised protection of GIs. The fact of having in place different GI systems and the attempt to impose those conflicting systems on third countries through FTAs is undermining the main principles of the WTO, i.e. the most favoured nation and the non-discrimination principles. More efforts must be made by the US and the EU to reopen a constructive dialogue and to find a balanced solution at the multilateral level. The EU-US Trans-Atlantic Trade and Investment Partnership (TTIP) currently under negotiation should be seen as an opportunity to redefine how GIs should be protected around the world and not a mean to continue this battle of ideas.

BIBLIOGRAPHY

BOOKS & ARTICLES!

AGDOMAR M., *Removing the Greek from Feta and adding Korbel to Champagne: The Paradox of Geographical Indications in International Law*, in *Fordham Intellectual Property Media & Entertainment Law Journal*, 2007, Vol. 18, Issue 2, Article 6, pp. 541-608.

ALLAIRE G. - CASABIANCA F. - THÉVENOD-MOTTET E., *Geographical origin: A complex feature of agro-food products*, in E. Barham, B. Sylvander (eds.), *Labels of origin for food. Local development, global recognition*, CABI International, Cambridge, U.S.A., 2011.

ALLAIRE G. - SYLVANDER B., *Globalization and Geographical indications*, in Barham E., Sylvander B. (eds.), *Labels of origin for food. Local development, global recognition*, CABI International, Cambridge, U.S.A., 2011.

ALMEIDA A.F., *Key differences between trademarks and geographical indications,* Porto, 2008, available at: http://citizenseminars.blogactiv.eu/files/2009/03/trade-marks-in-pdf.pdf.

ALTMAN L. - POLLACK M., *Callman on Unfair Competition, Trademarks and Monopolies,* § 17A:15, 4th ed.,Thomson/West, U.S.A., 2007.

ANTONS C. - HILTY R.M. (eds.), *Intellectual Property and Free Trade Agreements in the Asia-Pacific Region*, Springer, Heidelberg, 2015.

ANTONS C. - HILTY R.M., *Introduction: IP and the Asia-Pacific 'Spaghetti Bowl' of Free Trade Agreements*, in *Intellectual Property and Free Trade Agreements in the Asia-Pacific Region*, C. Antons - R. Hilty (eds.), Springer, Heidelberg, 2015.

AUTERI P. - FLORIDIA G. - MANGINI V. - OLIVERI G. - RICOLFI M. – SPADA P., *Diritto industriale Proprietà intellettuale e Concorrenza,* Giappichelli, Torino, 2012.

BAEUMER L., *Protection of Geographical Indications under WIPO treaties and questions concerning the relationship between those treaties and the TRIPs Agreement,* paper presented at the Symposium on the Protection of Geographical Indications in the Worldwide Context, held in Eger, Hungary, on October 24-25, 1997, WIPO Publication No. 760(E), Geneva, 1999.

BARATTA R., in *Giustizia Civile*, 2008, No. 4: pagg I, 838-840.

BARHAM E., *Translating Terroir: the global challange of french AOC labeling*, in *Journal of Rural Studies*, Vol. 19, 2003.

BARHAM E. - SYLVANDER B., *Labels of Origin for Food: Local Development, Global Recognition*, CABI, Wallingford, UK, 2011.

BARHAM E., *American Origin Products (AOPs): Protecting a Legacy*, OriGIn, Geneva, 2010.

BARHAM E., *Translating Terroir Revisited: The Global Challenge of French AOC Labeling*, in *Research Handbook on Intellectual Property and Geographical Indications*, D. Gangjee (ed.), Edward Elgar, Cheltenham, UK, forthcoming 2016.

BARJOLLE D. - SYLVANDER B. - THÉVENOD-MOTTET E., *Public policies and geographical indications*, in E. Barham, B. Sylvander (eds.), *Labels of origin for food. Local development, global recognition*, CABI International, Cambridge, U.S.A., 2011.

BELLA P., *European Union declares cheese war on America*, 14 March 2014, available at: http://www.chicagonow.com/cooking-cop/2014/03/european-union-declares-cheese-war-on-america/.

BELLETTI G. - MARESCOTTI A., *Approcci alternativi per la regolamentazione e la tutela dei nomi geografici: reputazione collettiva e interesse pubblico*, in *Agriregionieuropa*, 2008, Anno 4, No. 15.

BLAKENEY M., *Geographical Indications and TRIPS,* in M.P. Pugatch (ed.), *The Intellectual Property Debate: Perspectives from Law, Economics and Political Economy*, Edward Elgar, Cheltenham, UK, 2006.

BRUGIONI L., *La tutela delle denominazioni di origine e delle indicazioni geografiche agroalimentari non registrate ai sensi del Regolamento (UE) 1151/2012. Una riflessione sul caso Salame Felino*, in *Rivista di diritto industriale*, 2015, Anno LXIV, pp. 269 ss.

CÀCERES E.O., *Perspectives for Geographical Indications,* paper presented at the International Symposium on Geographical Indications, jointly organised by the World Intellectual property Organization (WIPO) and the State Administration for Industry and Commerce (SAIC) of the People's Republic of China, Beijing, June 26-28, 2007, WIPO/GEO/BEI/07/13.

CASABIANCA F. - SYLVANDER B. - NOEL Y. - BÉRANGER C. - COULON J.B. - RONCIN F., *Terroir et typicité: deux concepts clés des Appellations d'Origine Controlée, essai de definitions scientifiques et opéeationnelles*, Communication at the International Simposium "Territoires et enjeux du développement régional", Lyon, 9-11 March 2005.

CALBOLI I., *Geographical Indications of Origin at the Crossroads of Local Development, Consumer Protection, and Marketing Strategies*, in *IIC* -

International Review of Intellectual Property, 2015, Vol. 46, pp. 760-780, 2015, Max Planck Institute for Innovation and Competition, Munich, Germany.

CERRATO S.A., *I controlli sulla qualità del cibo: forme, disciplina, meccanismi di enforcement*, in *Annali Italiani del Diritto d'Autore (AIDA)*, 2015, Anno XXIV, pp. 261-305.

CHEONG I. - CHO J., *Republic of Korea*, in M. Kawai - G. Wignaraja (eds.), *Asia's Free Trade Agreements: How is Business Responding?*, Asian Development Bank and the ADB Institute, Edward Elgar, Cheltenham, UK, 2011.

COOPER W.H., *Free Trade Agreements: Impact on U.S. Trade and Implications for U.S. Trade Policy*, Congressional Research Service (CRS) Report, February 26, 2014.

COOPER W.H. et al., *The Proposed U.S-South Korea Free Trade Agreement (KORUS FTA): Provisions and Implications*, Report for Congress, Congressional Research Service (CRS), January 22, 2008.

COOPER W.H. - JURENAS R. - PLATZER M.D. - MANYIN M.E., *The EU-South Korea Free Trade Agreement and Its Implications for the United States*, Congressional Research Service (CRS), January 5, 2011.

CONTALDI G., *Il conflitto tra Stati Uniti e Unione Europea sulla protezione delle indicazioni geografiche*, in B. Ubertazzi - E. M. Espada (eds.), *Le indicazioni geografiche di qualità degli alimenti*, Giuffrè Editore, Milano, 2009.

COSCIA G., *I rapporti fra i sistemi internazionali e comunitari sulla protezione delle indicazioni di qualità*, in B. Ubertazzi - E. M. Espada (eds.), *Le indicazioni di qualità degli alimenti*, Giuffrè Editore, Milano, 2009.

CURCHOD F., *The Revision of the Lisbon System*, paper presented at the Worldwide Symposium on Geographical Indications held in Budapest from October 20th to October 22nd 2015, WIPO/GEO/BUS/15/0.

DELPHINE M.V., *The Protection of Geographical Indications in Vietnam: Opportunities and Challenges*, paper presented at the United Nations Conference on Trade and Development held in Phnom Penh, Cambodia, on 11-12 December 2014.

DENT C.M., *New Free Trade Agreements in the Asia-Pacific*, Palgrave Macmillan, Basingstoke, 2006.

DI MAMBRO A., *Così il TPP affossa Dop e Igp: l'accordo USA-Pacifico tutela solo i marchi registrati*, ItaliaOggi, November 18, 2015.

ECHOLS M.A., *Geographical Indications for Food Products: International Legal and Regulatory Perspectives,* Kluwer Law International, Netherlands, 2008.

ENGELHARDT T., *Geographical Indications Under Recent EU Trade Agreements*, in *IIC - International Review on Intellectual Property Law*, 2015, Vol. 46, pp. 781-818, Max Planck Institute for Intellectual Property and Competition Law, Munich, Germany.

EUGUI D.V. - SPENNEMANN C., *The treatment of geographical indications in recent regional and bilateral free trade agreements* in M.P. Pugatch (ed.), *The Intellectual Property Debate*, Edward Elgar, Cheltenham, UK, 2006.

FARLEY C.H., *Conflicts between U.S. law and international treaties concerning Geographical Indications* in *Whittier L. Rev.*, 2000, Vol. 22, pp.73-90.

FERIDHANUSETYAWAN T., *Preferential Trade Agreements in the Asia-Pacific Region*, International Monetary Fund, Working Paper WP/05/149, July 2005.

FIELD C., *Negotiating for the United States*, available at: https://www.wto.org/english/res_e/booksp_e/trips_agree_e/chapter_8_e.pdf.

FLYNN S. - KAMINSKI M. - BAKER B. - KOO J., *Public Interest Analysis of the US TPP Proposal for an IP Chapter*, Program on Information Justice and Intellectual Property, American University Washington College of Law, December 6, 2011, available at: http://infojustice.org/wp-content/uploads/2011/12/TPP-Analysis-12062011.pdf.

GANGJEE D., *Relocating the law of Geographical Indications,* Cambridge University Press, Cambridge, 2012.

GANGJEE D., *Protecting Geographical Indications as Collective Trademarks: the Prospects and Pitfalls,* in *IIP - Institute of Intellectual Property Bulletin,* 2006, pp. 112-119.

GANGJEE D., *Quibbling Sibling: Conflicts between Trademarks and Geographical Indications,* in *Chicago-Kent Law* Review, 2007, Vol. 82, Art. 6, pp. 1253-1291.

GARCIA M., *Competitive Fears: The EU, US and Free Trade Agreements in East Asia*, EU External Affairs Review, July 2012.

GARCIA M., *Same aims, different approaches? Recent EU and US free trade agreements in Asia*, the UACES Blog, January 9, 2014, available at: http://uacesoneurope.ideasoneurope.eu/2014/01/09/same-aims-different-approaches-recent-eu-and-us-free-trade-agreements-in-asia/.

GARCIA M., *Squaring the Circle? Approaches to Intellectual Property Rights and the TTIP*, the UACES Conference, Cork, Ireland, 1-3 September 2014, available at: http://www.uaces.org/documents/papers/1401/garcia.pdf.

GERMANÒ A., *Le indicazioni in etichetta (e la loro natura) e i segni degli alimenti*, in *Rivista di diritto agrario*, Anno XCI - Fasc. 2, Aprile-Giugno 2012.

GIOVANNUCCI D. - JOSLING T. - KERR W. - O'CONNOR B. - YEUNG M.T., *Guide to Geographical Indications: linking products and their origin,* International Trade Centre, Geneva, 2009.

GOEBEL B. - GROESCHL M., *The long road to resolving conflicts between Trademarks and Geographical Indications,* in *The Trademark* Reporter, 2014, Vol. 104, No. 4.

GOLDBERG S., *Who will raise the white flag? The Battle between the United States and the European Union over the protection of Geographical Indications,* in *U.Pa. J. Int'l Econ. L.*, 2001, Vol. 22:1, pp. 107-151.

HANDLER M. - MERCURIO B., *Intellectual Property,* in S. Lester - B. Mercurio (eds.), *Bilateral and regional trade agreements: commentary and analysis*, Cambridge University Press, New York, 2015 (2nd edit.).

HEATH C., *Parmigiano Reggiano by Another Name - on the ECJ's Parmesan Decision,* in *IIC - International Review on Intellectual Property Law,* 2008, Vol. 9, pp. 883-1004, Max Planck Institute for Intellectual Property and Competition Law, Munich, Germany.

HOADLEY S., *U.S. Free Trade Agreements in East Asia: Politics, Economics, and Security Policy in the Bush Administration*, in *Journal of current Southeast Asian affairs*, 2007, Vol. 26:1, pp. 51-75.

HORN H. - MAVROIDIS P.C. - SAPIR A., *Beyond WTO? An Anatomy of EU and US preferential trade agreements*, Bruegel Blueprint Series, Brussels, 2009.

JEON H.J. - LEE J.H., *A study on the Problems of Geographical Indications and a Regional Development Plan in Korea*, Kyobo Book Center, June 10, 2010.

JOSLING T., *The war on Terroir: Geographical Indications as a Transatlantic Trade Conflict,* paper presented at the Presidential Address to the AES Annual Meeting in Paris, March 30, 2006.

JUN K., *South Korea Reiterates Interest in Trans-Pacific Partnership*, in *The Wall Street Journal*, October 5, 2015, available at: http://www.wsj.com/articles/south-korea-reiterates-interest-in-trans-pacific-partnership-1444057143.

JUNG C.K., *A Study on the Protection of Geographical Indications*, Master Thesis, Korea University, 2013.

KAMPF R., *Trips and FTAs: A World of Preferential or Detrimental Relations?*, in C. Heath - A.K. Sanders (eds.), *Intellectual Property & Free Trade Agreements*, Hart Publishing, Portland, OR, 2007.

KAWAI M. - WIGNARAJA G., *Patterns of Free Trade in Asia*, East West Centre, Honolulu, Hawaii, 2013.

KAWAI M. - WIGNARAJA G., *Asia's Free Trade Agreements: How is Business Responding?*, Asian Development Bank and the ADB Institute, Edward Elgar, Cheltenham, UK, 2011.

KENG L.K. - WONG C., *An Enhanced Regime for the Protection of Geographical Indications in Singapore*, July 2014, at: http://www.lawgazette.com.sg/2014-07/1085.htm.

KHAN H.G.R., *Time for a Paradigm Shift? Exploring Maximum Standards in International Intellectual Property Protection*, in *Trade Law and Development*, 2009, Vol. 1:56, pp. 56-102.

KIM B. - HEATH C., *Intellectual Property Law in Korea*, Kluwer Law International, New York, 2nd ed., September 24, 2015.

KIM D., *Geographical Indications Surfacing as Obstacle to Korea-EU FTA Talks*, The Korea Times, July 29, 2007, available at: http://www.koreatimes.co.kr/www/news/biz/2015/08/127_7382.html.

KIM H., *Future Prospects of Korea-Latvia Trade Relations in the Framework of the Korea-EU FTA*, Korea Institute for International Economic Policy, October 18, 2011.

KIM Y.K. - JEONG H.C., *Basic Classes of Constitution*, Willbes, Seoul, South Korea, February 13, 2015.

KIREEVA I. - O'CONNOR B., *Geographical Indications and the TRIPs Agreement: What Protection is Provided to Geographical Indications in the WTO Members?,* in *Journal of World Intellectual Property*, 2010, Vol. 13, No. 2.

KUNSTADT R.M. & BUHLER G., *'Bud' Battle Illustrates Peril of Geographic Marks*, in *The National Law Journal*, 1998, C3, No. 4.

LAM C.N. - LIM J., *Singapore to Implement Registration of Geographical Indications*, May 20, 2014, available at: http://www.wongpartnership.com/index.php/files/download/1259/20052014_legiswatch-singapore-geographical-indications-2-2.pdf.

LEE J., *Korea's Intellectual Property Law Strategies in the Korea-China FTA Negotiations in Comparison with Other International FTAs*, Seoul National University, Master Thesis, 2014.

LEE J.J., *The Truth About South Korea's TPP Shift*: *A look at the reason behind Seoul's recent rethinking*, Centre for Strategic & International Studies, online

version, October 21, 2015, available at: http://csis.org/publication/pacnet-70-seoul-rethinks-tpp.

LOUCKS M.A., *Trademarks and Geographical Indications: Conflict or Coexistance?,* Doctoral Thesis, M.A. Wilkinson (supervised by), The University of Western Ontario, Canada, September 2012.

LOURDAIS L., *Overview of the EU GIs system of protection and its benefits,* WIPO IPOPHL seminar, Manila, 28-29 February 2012.

LUKOSE L.P., *Rationale and Prospects of the Protection of Geographical Indication: An Inquiry,* in *Journal of Intellectual Property Rights*, 2007, Vol. 12, pp. 212-223.

LUPONE A., *Il dibattito sulle indicazioni geografiche nel sistema multilaterale degli scambi: dal Doha Round dell'organizzazione mondiale del commercio alla protezione TRIPs plus*, in B. Ubertazzi - E.M. Espada, *Le indicazioni di qualità degli alimenti*, Giuffrè Editore, Milano, 2009.

LUTZ R.E., *Linking Trade, Intellectual Property and Investment in the Globalizing Economy: The Interrelated Roles of FTAs, IP and the United States*, in C. Antons - R. Hilty (eds.), *Intellectual Property and Free Trade Agreements in the Asia-Pacific Region*, Springer, Heidelberg, 2015.

MACQUEEN H. - WAELDE C. - LAURIE G., *Contemporary Intellectual Property: Law and Policy,* Oxford University Press Inc., New York, 2008.

MACMAOLAIN C., *EU Food Law: Protecting Consumer and Health in Common Market*, Hart Publishing, Portland, OR, 2007.

MANDEL O., *The Recognition and Protection of key EU geographical indications in South Korea following the adoption of the EU - South Korea Free Trade Agreement*, April 22, 2011, available at: http://www.mandel-office.com/the-recognition-and-protection-of-key-eu-geographical-indications-in-south-korea-following-the-adoption-of-the-eu-south-korea-free-trade-agreement/.

MANTROV V., *Protection Norms of Indications of Geographical Origin in the Applicable EU Regulations - Recent Changes and the Necessity of Further Unification*, in *IIC - International Review of Intellectual Property and Competition Law*, 2012, Vol. 43, No. 2, Max Planck Institute for Intellectual Property and Competition Law, Munich, Germany.

MARAGKIDOU S., *Competing Regionalism between the EU and the US: a race for regulatory influence?*, available at: http://ecpr.eu/filestore/paperproposal/c98d9b5a-b13c-456b-b3d9-e22f066a0478.pdf.

MASSMANN O., *Overview on the Trans Pacific Partnership Agreement - Commitments above WTO Level - An Analysis*, January 26, 2016, available at:

http://www.lexology.com/library/detail.aspx?g=d69941cf-2f7b-4ea2-a36e-a278d81e7174.

MCCARTHY T., *Trademarks and Unfair Competition,* § 19:91, 4th ed., West, U.S.A., 2009.

MCCARTHY T. & DEVITT V.C., *Protection of Geographical Denominations: Domestic and International*, in *The Trademark Reporter*, 1979, Vol. 69, pp. 199 ss..

MENDELSON R. - WOOD Z., *Geographical Indications in the United States: Developing a Preliminary List of Qualifying Product Names*, OriGIn, 2013.

MUNAKATA N., *Has politics caught up with markets? In search of East Asian economic regionalism*, in P.J. Katzenstein, T. Shiraishi (eds.), *Beyond Japan: the dynamics of East Asian regionalism*, Cornell University Press, Ithaca, 2006.

NA J.J. - LEE T.H., *National Assembly ratifies Korea-EU FTA*. The Korea Times, May 4, 2011.

NG-LOY W.L., *IP and FTAs of Singapore: Ten Years On*, in C. Antons - R.M. Hilty (eds.), *Intellectual Property and Free Trade Agreements in the Asia-Pacific Region*, Springer, Heidelberg, 2015.

O'CONNOR B. *The law of geographical indications*, Cameron May, London, UK, 2004.

O'CONNOR B. et al., *Geographical indications and TRIPs: 10 Years Later A roadmap for EU GI holder to get protection in other WTO Members*, in *Geographical Indications Handbook*, Brussels: Insight Consulting, 2004.

O'CONNOR B., *Geographical Indications in TTIP, The TransAtlantic Trade and Investment Partnership,* paper presented at the Parma Workshop, April 2015, available at: http://www.nctm.it/wp-content/uploads/2015/04/GIs-in-TIPP.pdf.

O'CONNOR B., *Geographical Indications: Some thoughts on the practice of the US Patent and Trademark Office and TRIPs,* in *World Trade Review*, 2014, Vol. 13, Issue 4, pp.713-720.

O'CONNOR B. – RICHARDSON L., *The Legal Protection of Geographical Indications in the EU's Bilateral Trade Agreements: moving beyond TRIPS,* in *Rivista di Diritto Alimentare,* 2012, Anno VI, No. 4, pp. 1-29.

O'CONNOR B., *The European Union and the United States: Conflicting Agendas on Geographical Indications – What's happening in Asia?*, in *Global Trade and Customs Journal*, 2014, Vol. 9, Issue 2, pp. 66-69.

PAONE V., in *Foro Italiano*, 2008, No. 5: col. IV, 266-267.

PERONI G., *Il commercio internazionale dei prodotti agricoli nell'accordo WTO e nella giurisprudenza del Dispute Settlement Body*, Giuffrè Editore, Milano, 2005.

POLLET-FORT A., *The EU-Korea FTA and Its Implications for the Future EU-Singapore FTA*, EU Centre in Singapore, Background Brief No. 4, June 2011.

PUGATCH M.P., *The Intellectual Property Debate*, Edward Elgar, Cheltenham, UK, 2006.

RANGNEKAR D., *Geographical indications - a review of proposals at the TRIPS Council: extending Article 23 to products other than wines and spirits,* UNCTAD-ICTSD Project on IPRs and Sustainable Development, Issue Paper No.4, Geneva, 2003.

RAUSTIALA K. - MUNZER S.R., *The Global Struggle over Geographic Indications,* in *The European Journal of International Law*, 2007, Vol. 18, Issue 2, pp. 337-365.

RAVENHILL J., *What drives Regionalism in East Asia - And Why It Matters*, in C. Antons - R.M. Hilty (eds.), *Intellectual Property and Free Trade Agreements in the Asia-Pacific Region*, Springer, Heidelberg, 2015.

RODRIGUEZ E.V., *The European Union Free Trade Agreements: Implications for Developing Countries*, Working Paper, Real Instituto Elcano, 2009.

SAAD I., *New GI Regulations to offer greater protection of consumers' interests*, Singapore Parliament web, April 14, 2014, available at: http://www.channelnewsasia.com/news/specialreports/parliament/news/new-gi-regulations-to/1071250.html.

SANDERS A.K., *Incentives for and Protection of Cultural Expression: Art, Trade and Geographical Indications*, in *The Journal of World Intellectual Property*, 2010, Vol. 13, Issue 2, pp. 81-93.

SANBURN J., *Europe's War on American Cheese*, published on Time.com, 12 March 2014, available at: http://time.com/22011/europes-war-on-american-cheese/.

SARTI D., *Le indicazioni d'origine geografica: storia, questioni terminologiche e proposte interpretative*, in *Studi in memoria di Paola A.E. Frassi*, Milano, 2010.

SELL S.K., *TRIPS was never enough: vertical forum shifting, FTAs, ACTA, and TPP*, in *Journal of Intellectual Property Law*, 2011, Vol. 18, pp. 447-478.

SEMERTZI A., *The Preclusion of Direct Effect in the Recently Concluded EU Free Trade Agreements*, in *Common Market Law Review*, 2014, Vol. 51, pp. 1125-1158.

SGARBANTI G., *La cooperazione tra Stati UE (il caso Parmesan, il regolamento 2006/2004)*, in B. Ubertazzi - E.M. Espada, *Le indicazioni di qualità degli alimenti*, Giuffrè Editore, Milano, 2009.

SHEPHERD J., *EU-Singapore Free Trade Agreement concluded, but EU ratification may be delayed*, International Law Office, December 19, 2014, available at: http://www.internationallawoffice.com/Newsletters/International-Trade/European-Union/King-Spalding-LLP/EU-Singapore-Free-Trade-Agreement-concluded-but-EU-ratification-may-be-delayed.

SIMON J., *Geographical Indications (GIs), Trademarks and International Standards (e.g. Codex Alimentarius)*, in B. Ubertazzi - E. M. Espada (eds.), *Le indicazioni di qualità degli alimenti*, Giuffrè Editore, Milano, 2009.

SONG Y., *KORUS FTA vs. Korea-EU FTA: Why the Differences?*, in *Korea Economic Institute (KEI)*, 2011, Vol. 6, No. 5.

SOPINSKA J., *EU-Singapore FTA: Battle over protected names still ahead*, October 20, 2014, available at: https://www.contexte.com/article/politique-exterieure-de-lue/eu-singapore-fta-battle-over-protected-names-still-ahead_36031.html.

STAROSTINA K., *Protected Geographical Indications: scope of protection vis-à-vis comparable products and criteria for defining comparable products*, Master Thesis, Prof. A.K.Sanders – G. Schneider (supervised by), Maastricht University, 2013.

SUH J. - MACPHERSON A., *The impact of geographical indication on the revitalisation of a regional economy: a case study of "Boseong" green tea*, in *Area*, 2007, Vol. 39, Issue 4, pp. 518-527.

THUAL D. - LOSSY F., *Q&A Manual European Legislation on Geographical Indications,* EU-China IPR2, February 2011, available at http://ec.europa.eu/agriculture/events/2011/gi-africa-2011/q-a-manual_en.pdf.

TIBERTI E., *Geographical Indications and Trademarks: space for coexistence as an equitable solution,* in *Rivista di Diritto Alimentare*, 2013, Anno VII, No.3.

TRITTON G., *Tritton on Intellectual Property in Europe*, 4th edition, Sweet & Maxwell, London, UK, 2014.

TROJANOVÀ K., *Intellectual Property Rights in Preferential Trade Agreements: The Comparison of KORUS FTA and EU-South Korea FTA*, E-Leader, Milan, 2014.

UBERTAZZI B. - ESPADA E.M. (eds.), *Le indicazioni geografiche di qualità degli alimenti*, Giuffrè Editore, Milano, 2009.

WATSON K.W., *U.S: Trying (and Failing) to Contain the Spread of European Geographical Indications*, Cato Institute, February 27, 2015, available at: http://www.cato.org/blog/us-trying-failing-contain-spread-european-gis.

WATSON K.W., *Reign of Terroir: How to resist Europe's Efforts to Control Common Food Names as Geographical Indications*, Cato Institute, No. 787, February 16, 2016, available at: http://object.cato.org/sites/cato.org/files/pubs/pdf/pa787.pdf.

WATTANAPRUTTIPAISAN T., *Trademarks and Geographical Indications: Policy Issues and Options in Trade Negotiations and Implementation*, in *Asian Development Review*, 2009, Vol. 26, No. 1, pp. 166-205.

WATTANAPRUTTIPAISAN T., *The Topology of ASEAN FTA, with special reference to IP-Related Provisions,* in C. Antons - R.M. Hilty (eds.), *Intellectual Property and Free Trade Agreements in the Asia-Pacific Region*, Springer, Heidelberg, 2015.

WONG K. - FONG E., *Revamped Geographical Indications Regime in Singapore*, May 15, 2015, available at: http://www.ellacheong.asia/2015/page/2/.

YOON Y.G - JUNG T.H., *Evaluation on the Geographical Protection of Korea According to Korea-EU FTA Settlement*, February 2010.

YOOK S.Y., *A study on Geographical Indication under FTAs and Its Domestic Implementation*, Korea Legislation Research Institute, August 9, 2014.

VIJU C., *CETA and Geographical Indicators: Why a Sensitive Issue?*, Canada-Europe Transatlantic Dialogue: Seeking Transnational Solutions to 21st Century Problems, CETA policy Briefs Series, October 2013.

VITTORI M., *The International Debate on Geographical Indications (GIs): The Point of View of the Global Coalition of GI Producers - oriGIn*, in *The Journal of World Intellectual Property*, 2010, Vol. 13 Issue 2, pp. 304-314.

EU Materials: Reports, Press Releases, Green Papers and Others

DG-AGRI, background paper to the Green Paper on agricultural product quality, October 2008, p. 5, available at http://ec.europa.eu/agriculture/quality/policy/workingdocs/gi_en.pdf.

DG-AGRI, working document on international protection of EU geographical indications: objectives, outcome and challenges, Ref. Ares(2012)669394–06/06/2012, Advisory Group International Aspects of Agriculture (2012) Meeting of 25 June 2012.

European Commission – DG Agriculture, *Foodstuffs, wine, and spirit GIs: a comparison of applicable legislation,* Doc.03, October 2014, available at http://ec.europa.eu/transparency/regexpert/index.cfm?do=groupDetail.groupDetailDoc&id=15842&no=3.

European Commission, *Making the most out of Europe's traditional know-how: a possible extension of geographical indication protection of the European Union to non-agricultural products,* Green Paper, text with EEA relevance, Strasbourg, 2014, COM(2014) 469 final.

European Commission, Communication from the Commission to the Council, the European Parliament, the European Economic and Social Committee and the Committee of the Region - Global Europe - Competing in the world - A contribution to the EU's Growth and Job Strategy, COM(2006) 567, Brussels, 4 October 2006.

European Commission, Directorate General for Trade, *Strategy for the Enforcement of Intellectual Property Rights in Third Countries*, 2005.

European Commission, Green Paper on Agricultural Product Quality: product standards, farming requirements and quality schemes, COM (2008) 641, Brussels, 15 October 2008.

European Commission, Trade, *The EU-Korea Free Trade Agreement in practice,* European Union Publication Office, Luxembourg, 2011.

European Commission, *EU-South Korea Free Trade Agreement: A Quick Reading Guide*, October 2010.

European Commission, Directorate General for Trade, *The economic impact of the EU-Singapore Free Trade Agreement*, Special Report, September 2013, DOI 10.2781/66069.

European Commission, *Singapore: The Commission to Request a Court of Justice Opinion on the trade deal*, Press Release, IP/14/1235, Brussels, October 30 2014.

European Commission, *Overview of FTA and Other Trade Negotiations*, updated December 2015, available at: http://trade.ec.europa.eu/doclib/docs/2006/december/tradoc_118238.pdf.

European Commission, Directorate-General for Agriculture and Rural Development, *WINE-Market Situation Evolution and Background*, July 2015, available at: http://ec.europa.eu/agriculture/wine/statistics/market-situation-2014-07_en.pdf.

European Commission, *WIPO Conference agrees revisions to Lisbon Agreement on Geographical Indications,* May 22, 2015, available at: http://ec.europa.eu/agriculture/newsroom/206_en.htm.

European Commission, *EU-China Geographical Indications - "10 plus 10" project is now complete*, Press Release, IP/12/1297, Brussels, November 30, 2012.

European Commission , *EU and Vietnam reach agreement on free trade deal*, Press Release, IP/15/5467, Brussels, 04 August 2015.

European Commission, *EU and Vietnam reach agreement on free trade deal*, MEMO15/3674, Brussels, August 4, 2015.

European Commission, *Facts and Figures: Free Trade Agreement between EU and Vietnam*, Press Release, MEMO/15/5468, Brussels, August 4, 2015.

European Commission, *EU-Vietnam Free Trade Agreement Now Available Online*, Press Release, IP/16/184, Brussels, 1 February 2016.

Request for an opinion submitted by the European Commission pursuant to Article 218(11) TFEU, 2015 O.J. Opinion 2/15, 2015/C 363/22.

US Materials: Reports, Studies and Articles

TTB, *Impact of the US/EU Wine Agreement on Certificates of Label Approval for Wine Labels with a Semi-Generic Name or Retsina,* Industry Circular, No. 2006-1, 10 March 2006.

USPTO, *Geographical Indication Protection in the United States,* available at http://www.uspto.gov/sites/default/files/web/offices/dcom/olia/globalip/pdf/gi_system.pdf.

USPTO, Draft of the "Geographic Certification Marks" examination guide, Paper 13, July 2013, p. 1, at http://www.uspto.gov/sites/default/files/trademarks/notices/GeoCertExamGuide_-_26_JUNE_2013_-_External_Distribution.doc.

USTR, *2015 Special 301 Report*, 2015.

USTR, *2013 Special 301 Report*, 2013.

USTR, *Summary of the Trans-Pacific Partnership Agreement*, Press Release, October 2015, available at: https://ustr.gov/about-us/policy-offices/press-office/press-releases/2015/october/summary-trans-pacific-partnership.

USTR, *Overview on Chapter 18: Intellectual Property*, November 5, 2015, available at: https://medium.com/the-trans-pacific-partnership/intellectual-property-3479efdc7adf#.jcqjgds85.

USTR, *Trans-Pacific Partnership Ministers' Statement*, February 4, 2016, at: https://ustr.gov/about-us/policy-offices/press-office/press-releases/2016/February/TPP-Ministers-Statement.

WTO and WIPO Materials

WIPO Publication No. 760(E), 1999, *Symposium on the international protection of Geographical Indications in the worldwide context,* held in Eger, Hungary, on October 24-25, 1997, organised by the World Intellectual Property Organisation in cooperation with the Hungarian Patent Office.

WIPO Publication No. 952(E), *Geographical Indications: An Introduction,* 2004.

WIPO Publication No. L450GI/E, *What is a Geographical Indication?*.

WIPO, *EU system for geographical indications for agricultural products and foodstuffs*, paper presented at the Worldwide Symposium on Geographical Indications, jointly organised by the World Intellectual Property Organization and the Patent Office of the Republic of Bulgaria, WIPO/GEO/SOF/09/4, Sofia, June 10 to 12, 2009.

WIPO, *Diplomatic Conference for the Adoption of a new Act of the Lisbon Agreement - The Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications,* at: http://www.wipo.int/meetings/diplomatic_conferences/2015/en/.

WTO - Council for TRIPs, Communication from the United States, *Registration of Geographical Indications under Trademark Regimes as Collective or Certification Marks*, IP/C/W/134, March 11, 1999.

WTO - Council for TRIPs, 1996/7/8 Annual Reports, IP/C/8, November 6, 1996.

WTO - Doha Ministerial Declaration of 20 November 2001, WT/MIN(01)/DEC/1.

WTO Center, *Facts and Figures: Free Trade Agreement between EU and Vietnam*, August 4, 2015, available at: http://wtocenter.vn/content/facts-and-figures-free-trade-agreement-between-eu-and-vietnam-0.

WTO Center, *EU and Vietnam reach agreement on free trade deal*, August 4, 2015, available at: http://wtocenter.vn/content/eu-and-vietnam-reach-agreement-free-trade-deal.

Materials from Other Institutions

ASEAN Secretariat's Information Paper, *Overview of ASEAN-U.S. Dialogue Relations*, January 4, 2016.

ITAC, *The U.S. - Korea Free Trade Agreement (FTA): The Intellectual Property Provisions*, Report of the Industry Trade Advisory Committee on Intellectual Property Rights (ITAC - 15), April 27, 2007.

Italian Intellectual Property Rights DESK, Ufficio ICE di Seoul, *Protection of Geographical Indications in the Republic of Korea,* Ministero dello Sviluppo Economico, Italia in Corea, Italian Trade Commission, Seoul, April 2010.

Ministry of Law, Singapore, *Factsheet on the Geographical Indications Act*, April 14, 2014, available at: https://www.mlaw.gov.sg/content/dam/minlaw/corp/News/GI%20Bill%20factsheet.pdf.

Ministry of Trade and Industry (MTI), Ministry of Law (MinLaw), Intellectual Property Office of Singapore (IPOS), *Geographical Indications Consultation Paper List of Terms in relation to 196 Products*, January 21, 2013, available at: https://www.ipos.gov.sg/Portals/0/Geographical%20Indications%20Consultation%20Paper.pdf.

NAQS (National Agricultural Products Quality Management Service), *Geographical Indication System*, available at: http://www.naqs.go.kr/eng/contents/Agrifood/Agrifood/H_01.naqs.

NAQS (National Agricultural Products Quality Management Service), *Geographical Indication System*, available at: http://www.naqs.go.kr/eng/contents/Agrifood/Agrifood/H_01.naqs.

ORIGIN, *Study on geographical indications protection for non-agricultural products in the internal market,* Final Report, 18 February 2013.

ORIGIN, *Analysis of the relevant US legislation for the protection of GIs & Recommendations for Compromise Solutions on GIs in the TTIP Negotiations*, Ministero dello Sviluppo Economico, October 06, 2015.

UNCTAD-ICTSD, *Resource Book on TRIPS and Development: An authoritative and practical guide to the TRIPS Agreement,* Capacity Building Project on IPRs, 30 November 2004, Cambridge University Press, New York, 2005.

MISCELLANEOUS MATERIALS

European Union wants to force the U.S. to rename products like Parmesan cheese that are made in America, published on MailOnline.com, 12 March 2014, available at: http://www.dailymail.co.uk/news/article-2578517/Europe-wants-Parmesan-seeks-change.html.

GI supporters express puzzlement at U.S. dairy position in *The Hagstrom Report*, Vol. 4, No. 217, 2014, available at http://www.hagstromreport.com/2014news_files/2014_1117_gi-supporters-puzzled-u-s-dairy-position.html.

Global Affairs Canada, *Trans-Pacific Partnership*, available at: http://www.international.gc.ca/trade-agreements-accords-commerciaux/agr-acc/tpp-ptp/index.aspx?lang=eng.

Letter sent by the Singaporean Minister for Trade and Industry L.H. Kiang to the Trade Commissioner Mr. Karel De Gucht concerning Geographical Indications in the EU-Singapore Free Trade Agreement on 21 January 2013, available at: http://trade.ec.europa.eu/doclib/press/index.cfm?id=961.

Letter sent by the President and Chairman of Vietnam Chamber of Commerce and Industry to Ambassador Ron Kirk, *Regarding Intellectual Properties Chapter in TPP*, Hanoi, August 31, 2012, p. 2, available at: http://wtocenter.vn/sites/wtocenter.vn/files/tpp/attachments/VCCI%20Letter%20-IP%20-%20En.PDF

Official Letter sent by Ambassador Ron Kirk to the Minister of Trade in the Republic of Korea Jong-hoon Kim on June 09, 2011, available at: https://ustr.gov/sites/default/files/uploads/pdfs/PDFs/December%202012/060911%20Kirk-Kim%20Letter%20on%20GIs.PDF.

Official Letter sent by the Minister of Trade in the Republic of Korea Jonh-hoon Kim to Ambassador Ron Kirk on June 20, 2011, available at: https://ustr.gov/sites/default/files/uploads/pdfs/PDFs/December%202012/062011%20Kim-Kirk%20Letter%20on%20GIs.pdf.

Recommendation of Vietnamese business community on negotiating strategies of IP Chapter in TPP, Hanoi, July 2012, p. 20, available at: http://wtocenter.vn/sites/wtocenter.vn/files/tpp/attachments/INTA-2012-2-TPP4-Khuyen%20nghi%20Chuong%20IP.pdf

Stewart & Stewart, *The Trans-Pacific Partnership, A Side-by-Side Comparison with: The United States - Colombia Trade Promotion Agreement of 2012; The United States - Korea Free Trade Agreement of 2012; the United States - Peru Free trade Agreement of 2009*, Comparison, Vol.3, TPP Chapter 18: Intellectual Property, 2015.

SQ Interview, EU Ambassador Tomas Kozlowski on the Korea-EU FTA and the Economic Outlook, SERI Quarterly, October 2012, available at: http://eeas.europa.eu/delegations/south_korea/press_corner/events/index_en.htm.

Testimony by Shawna Morris, Vice President of Trade Policy, U.S. Dairy Export Council & National Milk Producers Federation to the United Stated Senate Committee on Finance, Subcommittee on International Trade, Customs and Global Competitiveness, *The U.S. – Korea Free Trade Agreement: Lessons Learned Two Years Later*, 29 July 2014, available at : http://www.finance.senate.gov/imo/media/doc/Testimony%20to%20Senate%20Trade%20Subcommittee%20on%20Korus_July%2029%2014_FINAL.pdf.

Trevisan & Cuonzo, *Free Trade Agreement EU-South Korea: for the first time in a Bilateral Agreement between the EU and a Third Country, the EU provides for the Protection of European GIs for Agricultural Products and Foodstuffs*, November 25, 2009, available at: http://www.trevisancuonzo.com/pubblicazioni-e-legal-update/legal-update/index.html?page=20.

European Union

Council Regulation (EEC) 817/70 of 28 April 1970 laying down special provisions relating to quality wines in specified regions, 1970 O.J. L 99.

Council Regulation (EEC) No 1576/89 of 29 May 1989 laying down general rules on the definition, description and presentation of spirit drinks, 1989 O.J. L 160.

Council Regulation (EEC) No 2081/1992 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, 1992 O.J. L 208/1.

Agreement between the European Community and the United Mexican States on the mutual recognition and protection of designation for spirit drinks, 1997 O.J. L 152/16.

Regulation (EC) No 110/2008 of the European Parliament and of the Council of 15 January 2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirits drinks and repealing Council Regulation (EEC) NO 1576/89, 2008 O.J. L 39/16.

European Commission, Notice - Geographical Indications from the Republic of Korea, 2008/C 141/15, 2008 O.J. C 141/33.

Council Regulation (EC) No. 207/2009 of 26 February 2009 on the Community trade mark, 2009 O.J. L 78/1.

Council Decision of 16 September 2010 on the signing, on behalf of the European Union, and provisional application of the Free Trade Agreement between the European Union and its Member States, of the one part, and the Republic of Korea, of the other part, 2011 O.J. L 127.

Notice concerning the provisional application of the Free Trade Agreement between the European Union and its Member States, of the one part, and the Republic of Korea, of the other part, 2011, O.J. L 168.

Consolidated Version of the Treaty on the Functioning of the European Union, 2012 O.J. 2012/C 326/01.

Regulation (EU) No 1152/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs, 2012 O.J. L. 343/1.

Commission Implementing Regulation (EU) No 716/2013 of 25 July 2013 laying down rules for the application of Regulation (EC) No 110/2008 of the

European Parliament and of the Council on the definition, description, presentation, labelling and protection of geographical indications of spirits drinks, 2013 O.J. L 201/21.

Regulation (EU) No 1308/2013 of 17 December 2013 establishing a common organisation of the markets in agricultural products and repealing Council Regulations (EEC) No 922/72, (EEC) No 234/79, (EC) No 1037/2001 and (EC) No 1234/2007, 2013 O.J. L 347/671.

Regulation (EU) No 251/2014 of the European Parliament and of the Council of 26 February 2014 on the definition, description, presentation, labelling and the protection of geographical indications of aromatised wine products and repealing Council Regulation (EEC) No 1601/91, 2014 O.J. L 84/14.

European Commission, Information Notice - Public Consultation, 2014 O.J. 2014/C 274/08, August 21, 2014.

European Parliament Resolution of 6 October 2015 on the possible extension of geographical indication protection of the European Union to non-agricultural products, 2015/2053(INI), 2015.

Notice concerning the entry into force of the Free Trade Agreement between the European Union and its Member States, of the one part, and the Republic of Korea, of the other part, 2015 O.J. L 307.

EU Preferential Trade Agreements

Partnership Agreement between the members of the African, Caribbean and Pacific Group of States of the one part, and the European Community and its Member States, of the other part, 2000 O.J. L 317/3.

Agreement establishing an association between the European Community and its Member States, of the one part, and the Republic of Chile, of the other part, 2002 O.J. L 352.

Agreement between the European Community and the Republic of South Africa on trade in wine, 2002 O.J. L 28.

Agreement between the European Community and Canada on trade in wines and spirit drinks, 2004 O.J. L 35/3.

Agreement between the European Community and the United States of America on trade in wine, 2006 O.J. L 87/2.

Agreement between the European Community and Australia on trade in wine (1994, renewed in 2008), 2009 O.J. L 28/13.

Free Trade Agreement between the European Union and its Member States, of the one part , and the Republic of Korea, of the other part, 2011 O.J. L 127/6.

Trade Agreement between the European Union and its Member States, of the one part, and Colombia and Peru, of the other part, 2012 O.J. L 354/3.

Agreement establishing an Association between the European Union and its Member States, on the one hand, and Central America on the other, 2012 O.J. L 346/3.

Comprehensive Economic and Trade Agreement between the European Union and Canada, 2014 (not yet ratified), available at: http://trade.ec.europa.eu/doclib/docs/2014/september/tradoc_152806.pdf.

Free Trade Agreement between the European Union and the Republic of Singapore, 2014 (not yet ratified), available at: http://trade.ec.europa.eu/doclib/press/index.cfm?id=961.

Free Trade Agreement between the European Union and Vietnam, 2015 (not yet ratified), available at: http://trade.ec.europa.eu/doclib/press/index.cfm?id=1437.

United States

Lanham (Trademark) Act 1946.

Lahnam (Trademark) Act 1946, § 1127, *Trademark Manual of Examination Procedure* (TMEP), §§1306, 01-1306 01(b), 1306, 05, April 2013.

Code of Federal Regulation, Title 27, §.

US Preferential Trade Agreements

North America Free Trade Agreement, 32 I.L.M. 289 and 605, 1993, available at: https://ustr.gov/trade-agreements/free-trade-agreements/australian-fta.

United States - Singapore Free Trade Agreement, with annexes and related exchange of letters, signed at Washington on May 6, 2003 and entered into force on January 1 2004, available at: https://ustr.gov/trade-agreements/free-trade-agreements/singapore-fta/final-text.

United States - Chile Free Trade Agreement, with annexes and related exchange of letters, signed at Miami on June 6, 2003 and entered into force on January 1, 2004, available at: https://ustr.gov/trade-agreements/free-trade-agreements/chile-fta/final-text).

United States - Australia Free Trade Agreement, with annexes and related exchange of letters, signed at Washington on May 18, 2004 and entered into force on 1 January, 2005, available at: https://ustr.gov/trade-agreements/free-trade-agreements/australian-fta/final-text.

United States - Morocco Free Trade Agreement, signed at Washington on June 15 2004 and entered into force on January 1, 2006, available at: https://ustr.gov/trade-agreements/free-trade-agreements/morocco-fta/final-text).

Free Trade Agreement between the United States of America and the Republic of Korea, entered into force on March, 15, 2012, available at: https://ustr.gov/trade-agreements/free-trade-agreements/korus-fta/final-text.

Trans-Pacific Partnership Agreement, signed in Auckland, New Zealand, on February 4, 2016 (not yet ratified), available at: https://ustr.gov/tpp/.

South Korea

Constitution of the Republic of Korea, as amended on 29 October 1987.

National Tax Service Notification No. 2000-33.

Act on the Investigation of Unfair International Trade Practices and Remedy Against Injury to Industry, as amended by Act No. 10230, April 5, 2010.

Liquor Tax Act, as amended by Act No. 11134, December 31, 2011.

Agricultural and Fishery Products Quality Control Act, as amended by Act No. 10885, July 21, 2011.

Trademark Act, as amended by Act No 11962, July 30, 2013.

Unfair Competition Prevention and Trade Secret Protection Act, as amended by Act No. 11963, July 30, 2013.

Indonesia, Malaysia, Singapore, Thailand, Vietnam, Lao PDR

Geographical Indication Act 1998, Singapore.

Geographical Indication Act 2000, Malaysia.

Act on Protection of Geographical Indication B.E. 2546 (2003), Thailand.

Government Regulation of the Republic of Indonesia, Number 51 Year 2007 Regarding Geographical Indication, Indonesia.

Law on Intellectual Property, Vietnam.

Law on Intellectual Property, Lao PDR.

ASEAN Preferential Trade Agreements

Agreement on the Common Effective Preferential Tariff Scheme for the ASEAN Free Trade Area, Singapore, January 28, 1992.

Agreement on Trade in Goods under the Framework Agreement on Comprehensive Economic Co-operation between the Association of Southeast Asian Nations and the People's Republic of China, Vientiane, November 29, 2004.

Agreement on Trade in Goods and Agreement on Trade in Services, both under the Framework Agreement on Comprehensive Economic Cooperation Among the Governments of the Member Countries of the Association of Southeast Asian Nations and the Republic of Korea, Kuala Lampur, December 13, 2005.

Agreement on Comprehensive Economic Partnership among Japan and Member States of the Association of Southeast Asian Nations, April 14, 2008.

Agreement Establishing the ASEAN-Australia-New Zealand Free Trade Area, Cha-am, Thailand, February 27, 2009.

Agreement on Trade in Goods under the Framework Agreement on Comprehensive Economic Cooperation between the Republic of India and the Association of Southeast Asian Nations, Bangkok, August 13, 2009.

Multilateral Agreements

Paris Convention for the Protection of Industrial Property adopted in 1883, as amended on September 28, 1979.

Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods adopted in 1891, as revised at Lisbon on October 31, 1958.

Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, adopted in 1958, as amended on September 28.

Vienna Convention on the law of treaties, adopted in 1969.

World Trade Organization, Agreement on Trade Related Aspects of Intellectual Property Rights, adopted in 1994.

Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications, as adopted on May 20, 2015.

CASE LAW

European Union

Ministère public v. Gérard Deserbais, Case C-286/86, (1988) E.C.R. I-4907.

Consorzio per la Tutela del Formaggio Gorgonzola v. Käserei Champignon Hofmeister GmbH&Co. KG and Eduard Bracharz GmbH, Case C-87/97, (1999) E.C.R. I-01301.

Guimont, Case C-448/98, (2000) E.C.R. I-10663.

Schutzverband gegen Unwesen in der Wirtschaft eV v. Warsteiner Brauerei Haus Cramer GmbH & Co. KG., Case C-312/98, (2000) E.C.R. I-09187.

Federal Republic of Germany and Kingdom of Denmark v. Commission of the European Communities, Joined Cases C-465/02 & C-466/02 25, (2005) E.C.R. I-09115.

Commission of the European Communities v. Federal Republic of Germany, Case C-132/05, (2008) E.C.R. I-00957.

Commission of the European Communities v. Federal Republic of Germany, Judgment of the Court of Justice (Grand Chamber), C-132/05, (2008) E.C.R. I-00957.

Budvar v. Ammersin, Case C-478/07, (2009) E.C.R. I-07721.

Bavaria NV and Bavaria Italia S.r.l. v. Bayerischer Brauerbund, Case C-343/07, (2009) E.C.R. I-05491.

Opinion of Advocate General Sharpston, Alberto Severi v. Regione Emilia Romagna, Case C-446/07, (2009) E.C.R. I-08041.

Bavaria NV v. Bayerischer Brauerbund eV, Case C-120/08, (2010) E.C.R. I-13393.

Bureau national interprofessionel du Cognac v. Gust. Ranin Oy, Joined Cases C-4/10 & C-27/10, (2011) E.C.R. I-06131.

Assica – Associazione Italiana produttori delle Carni e dei Salumi and Kraft Foods Italia SpA v. Associazione fra produttori per la tutela del “Salame Felino” et al., Case C-35/13, (2014) ECLI:EU:C:2014:306.

United States

Anheuser-Busch Brewing Assn. v. Fred Miller Brewing Co., 87 F. 864, (C.C. Wis. 1898).

Anheuser-Busch Inc. v. Budweiser Malt Products Corporation, 295 F 306, (C.A.2 1923).

Anheuser-Busch, Inc. v. Du Bois Brewing Co., 73 F. Supp. 338, (D.C.Pa. 1947).

Cmty of Roquefort v. William Faehndric, Inc. 303 F.2d 494, 497, 133 USPQ 633, 635 (2nd Circ. 1962).

Berni v. Intl. Gourmet Restaurants of Am., Inc., 838 F.2d 642, 648 (2nd Cir. 1988).

Institute National Des Appellations v. Brown-Forman Corp., 47 USPQ, 2d, 1875, 1884, (TTAB 1998).

South Korea

Supreme Court, 24 January 1984, 82 Hu 83.

Supreme Court, 22 May 1984, 81 Hu 70.

Supreme Court, 22 December 1989, 89 Hu 438.

Supreme Court, 24 November 1992, 95 Hu 735.

KCCR February 3, 2005, 2001 Hun-Ga9.

KCCR August 30, 2007, 2004 Hun-Ma670.

KCCR June 28, 2007, 2004 Hun-Ma 644.

KCCR May 29, 2008, 2007 Hun-Ma1105.

Italy

Cass. civ., Sez. I, 19 settembre 2013, n. 21472, in *CED Cassazione*, 2013.

World Trade Organization

WTO Panel Report: EC – Protection of Trademarks and Geographical Indications for agricultural products and other foodstuffs, WT/DS/174/R, 15 May 2005.

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