

4 December 2008

**Initial questions concerning the proposal pertaining to the GI register for wines and spirits contained in TN/C/W/52**

The following is a compilation of questions and requests for clarification from various co-sponsors of the joint proposal, including Australia, Canada, Chile, Guatemala, Honduras, Japan, Korea, New Zealand, Nicaragua, South Africa, the Separate Customs Territory of Taiwan, Penghu, Kinmen and Matsu and the United States.

The co-sponsors of the Joint Proposal welcome the invitation extended at the meeting of 1 December 2008 of the Special Session for TRIPS Council, to submit questions relevant to the position of co-sponsors of TN/C/W/52 on the issue of the register for geographical indications for wines and spirits.

These questions refer exclusively to the portion of TN/C/W/52 that pertains to the mandate of the Special Session — the GI Register for wines and spirits. The other issues discussed in TN/C/W/52 remain clearly outside the mandate of the Special Session, and the Members posing these questions wish to make it clear that these questions are without prejudice to their positions regarding the status of the issues discussed in document TN/C/W/52 that are not within the mandate of the Special Session.

Further, the following questions are in no way exhaustive. We reserve our individual and collective rights to submit additional questions and comments, including in response to the answers provided by Members co-sponsoring TN/C/W/52.

For ease of reference, we have grouped the questions according to those specific paragraphs in TN/C/W/52 (paragraphs 1-3) that pertain to the mandate of the Special Session — the GI Register for wines and spirits. That said, we start with some general questions.

## General Questions

1. The need to integrate the "development dimension" into policy making on intellectual property protection has received increased recognition at the international level. How is the development dimension reflected in the wines and spirits GI register elements of TN/C/W/52?
2. How would the implementation process in the wines and spirits GI register elements of TN/C/W/52 impact WTO Members, particularly those developing countries who are not producers of wines or spirits?
3. TRIPS Article 1.1 grants Members the right to establish in their national systems their own criteria for determining eligibility for protection of geographical indications, within the parameters of Section 3, Part II of the Agreement. How do the co-sponsors of TN/C/W/52 reconcile their proposal with this right?
4. Why, in determining eligibility of geographical indications for inclusion in the system, are the exceptions provisions of Article 24 not relevant?
5. How are discrepancies regarding whether or not certain indications meet the definition of Article 22.1 addressed in the wines and spirits GI register elements of TN/C/W/52?
6. How do the EC's 'new ideas' and the register aspects of TN/C/W/52 relate? Does W/52 essentially replace the EC's 'new ideas' and its proposal on Geographical Indications of 14 June 2005 (WT/GC/W/547)?

## Paragraph 1 of TN/C/W/52

1. Members agree to establish a register open to geographical indications for wines and spirits protected by any of the WTO Members as per TRIPS. Following receipt of a notification of a geographical indication, the WTO Secretariat shall register the notified geographical indication on the register. The elements of the notification will be agreed.

7. We ask the co-sponsors of TN/C/W/52 to advise whether under the register they envision each Member would be responsible for the review or verification of notified terms *before* registration?

(a) If so, on what basis would this be done?

(b) And what information and supporting documentation would be included in the notification?

8. One of the co-sponsors of TN/C/W/52, the EC, has previously suggested that "other WTO Members... will not have to scrutinise notified GIs prior to their entry on the Register":

(a) what assurances will there be that a GI entered on the Register will, in fact, meet the definition of a GI, be it a wine or a spirit, and be protected in the country of origin?

(b) Can the co-sponsors confirm that the information and supporting documentation will be sufficient to meet the requirements of the domestic laws of all members?

9. The EC has also previously suggested that WTO Members would be able to notify a GI "as long as it is protected in the notifying Member":

(a) We ask the co-sponsors of TN/C/W/52 advise whether in their view it would it be open for Members to claim that a GI is protected "through tradition" or "by convention", for example, as used in common law systems?

(b) And if not, how would co-sponsors of TN/C/W/52 envision that these terms might be accounted for or protected?

10. Noting that the register for wines and spirits GIs elements of TN/C/W/52 do not refer to the issue of the costs of registration, an issue that was considered in previous proposals submitted by some of the co-sponsors of TN/C/W/52 and that the IP offices of many individual WTO Members work on a cost-recovery basis, we ask the co-sponsors of TN/C/W/52 to now advise Members who they would envision having to pay the additional costs of registration of a term on the WTO register?

(a) Would the cosponsors of TN/C/W/52 please confirm that costs related to registration *in other* Members would continue to be borne by the applicant, if this was the policy of the IP office of that Member?

11. If Members are required to "take into account" the terms notified on the register, this will require additional administrative costs, under both proposals. There could be a significant number of names included in the register. National IP offices could be faced with a significantly increased workload.
  - (a) Are there any estimates of the additional workload that could be expected by national IP offices?
  - (b) In addition, there are technical matters to work out related to searchability, translations, trademarks, etc.
12. Members are aware of conflicting claims to particular geographic indications. In light of such claims, please explain how protection of a geographic indication for a wine or spirit in a Member would constitute anything more than information regarding the situation in the notifying Member.
13. Since the co-sponsors of TN/C/W/52 appear to be proposing that the WTO Secretariat do no more than compile information that it receives, how do the co-sponsors propose to deal with conflicting claims to a geographic indication for a wine and/or spirit?
14. A number of similar or identical geographic names occur in the territory of more than one WTO Member.
  - (a) How would the situation of conflicting claims to the same geographical term be dealt with?
    - (i) Would all notified terms appear on the registry, even if similar or identical?
    - (ii) Would this be up to the registering country? On what basis would they take a decision (e.g. first to file)?
15. How would the Register for wines and spirits GIs be kept up-to-date regarding GI owners, addresses of service, etc.?
16. If a GI were to become generic in the country of origin, fall into dis-use, or have protection removed, how would that GI be removed from the Register for wines and spirits GIs?
  - (a) Under what other circumstances would a geographical term be removed from the Register?
17. Would the Register include sub-appellations, variations, or multi-termed GIs for wines and spirits? How would the cosponsors of TN/C/W/52 propose that such GIs be taken into account in other WTO Members?
18. In the EC's remarks of 21st Nov, the EC mentioned that the notified GI must have been "checked in the notifying Member following a domestic legal process that is in principle compliant with TRIPS." What does the EC mean by "legal process?" If it only means the process of domestic registration or

the judicial process, what about those GIs which are qualified for article 22.1 of TRIPS but have not sought domestic registration or not been through the judicial process? Will those GIs be qualified for notifying to the Register?

19. In the EC's remarks of 21<sup>st</sup> Nov, the EC claimed that the wines and spirits GIs register in TN/C/W/52 means "no administrative costs." Do the cosponsors envisage other types of costs might occur for the authorities and/or private sector of Members after the system is implemented? In our view, since the wines and spirits GIs register in TN/C/W/52 has the effect of prima facie evidence and the authorities and/or interested parties need "proof to the contrary" to change that effect, the system implies a bigger burden of proof for them. Therefore isn't it more accurate to say that the wines and spirits GIs register in TN/C/W/52 would transfer the administrative costs to other type of costs that will be borne by the authorities and/or interested parties of other Members?

20. We are interested to know what the contents of the notifications are. In wines and spirits GIs register in TN/C/W/52 it says "Following receipt of a notification of a GI, the WTO Secretariat shall register the notified GI on the register," which means the Secretariat will put any notified information on the website. But since the notified information will have the effect of prima facie evidence in each WTO member, it is very important to know the precise content of notifications to evaluate this proposal. We do not share the view in the EC's remarks of 21<sup>st</sup> Nov that the contents of the notifications should be left for after modalities. Therefore, we would like to reiterate our call for the EC or the other co-sponsors of TN/C/W/52 to table a complete proposal on wine register.

