

**NON-EXHAUSTIVE SUMMARY OF THE MAIN POINTS RAISED  
IN THE DISCUSSION ON THE CHAIR'S LIST OF QUESTIONS**

**TRIPS SPECIAL SESSION - 23 OCTOBER 2009**

*This short and non-exhaustive informal summary of the points made and issues raised at the 23 October meeting of the TRIPS Special Session should not be considered as an authoritative expression or interpretation of any Member's position but is compiled only as a practical tool to facilitate the work of the Special Session. No point should be attributed to any Member or to the WTO Secretariat.*

**Question 1**

**What legal obligations would be acceptable for the Register to facilitate the protection of geographical indications for wines and spirits, as mandated by Article 23.4 of the TRIPS Agreement?**

Main points made by delegations:

- The appropriate legal obligation would be for participating Members to consult the Register when making decisions regarding trademarks and GIs for wines and spirits. This would ensure that better information is available to decision makers in domestic systems and thereby facilitate the protection of GIs notified to the Register. It would provide real benefits to producers and consumers by creating a resource that does not currently exist, respect the mandate and be easy to implement.
- Consulting the Register would be done according to Members' domestic laws and regulations.
- Introducing a legal presumption as proposed in W52:
  - would not facilitate but increase the protection for GIs. However, by limiting itself to "facilitating", the mandate directs Members to find *procedural means* aimed at protecting GIs in their respective domestic systems, and not ways to increase *substantive* protection;
  - would change the carefully negotiated balance of rights and obligations in TRIPS by shifting the burden of proof, as it would force other Members' examiners to defer to the findings of an examiner in the notifying Member as to whether a GI meets the definition in its territory and then be forced to prove that the notified term was not a GI the other Members. The notifying Member is most likely to have enough evidence to prove its claim of valid GI protection, so why should it not take on that responsibility;
  - would violate the principle of territoriality.
- More exchange of technical information on how Members would implement an obligation to consult was necessary before any negotiating text could be advanced in this issue at the international level.
- The obligation should be:
  - to consult; and
  - to duly take into account the information on the Register;as had also been acknowledged in oral statements of some joint proposal supporters. W/52 complemented W/10 with respect to what "take into account" could mean, by indicating how this information should be taken into account.
- It was necessary to set up a minimum standard at the multilateral level (i.e. the WTO) applicable to all Members, to define and decide at the international level what would be the

- effects of the information on the Register. Explaining the national procedures again would not help, as they were already known.
- On the issue of an obligation to consult, without prejudice, some possibilities contained within the joint proposal could include:
    - an obligation to take the information on the Register into account in accordance with domestic systems;
    - an obligation to give appropriate weight to that information in accordance with domestic systems;
    - an obligation to consider that information as evidence of the facts stated therein (e.g. that the term is protected as a GI in the notifying member) in accordance with domestic systems. However, if this last suggestion were to be a possibility, corresponding consideration would have to be given to the issue of generic terms.
  - The legal obligation acceptable would be to take into account the information on the Register. The information contained in the Register would be one of the determinants of granting/refusing a TM.
  - Members could set up a system with minimum legal effects and leave the longer-term arrangement for review after the system has been in operation for a certain period of time, for example four years.

## Question 2

**When making decisions regarding the registration and protection of trademarks and geographical indications, what significance and weight should national authorities give to the information on the Register?**

### Main points made by delegations:

- W52 gives minimum guidelines as to how significance and weight could be accorded to the information on the Register:
  - On *genericness*, W52 proposes clarification that genericness has to be based on facts and be to be proven. This does not impinge in substance of the decision on genericness because the final decision will always be taken by the national authorities. Either the rule (to substantiate an assertion of genericness) already exists in national systems, then no problems exist and no change in the law is required. Or this is not the case, then there is a need for changes.
  - On *GI definition*, W52 stipulates that absent proof to the contrary, the Register shall be considered as *prima facie evidence* that the Registered GI meets the definition of GI laid down in Article 22.1 TRIPS. This means that national authorities shall take the Register, with all the information notified by the country of origin, as providing evidence that the name meets the GI definition "at first sight", while the final decision whether or not to afford GI protection to a term is left to national authorities.
- Such proposal is reasonable, notably given that national legislation and systems related to GIs are deemed to be TRIPS-compatible. If Members think the legislation of a Member does not comply with TRIPS, they have the possibility to challenge it – and some have already made use of this possibility.
- Complicated legal question that will depend on the specifics of a particular case and the mechanics of Members' different systems, and cannot be answered in a vacuum. More exchange of information regarding how Members would implement an obligation to consult the Register in their domestic systems is necessary, to see if there are some common elements that could sensibly be used to provide greater specificity or prescriptiveness to the obligation to consult the Register.
- Article 24.6 does not specify that genericness has to be "substantiated".

- The mandate in Article 23.4 should not be used to negotiate the scope of the definition of a GI as set out in Article 22 or to undermine the Article 24 exceptions or prior existing TM rights under Article 16.
- Mandate requires procedural ways aimed at GI protection in domestic systems. Accordingly, any "significance" or "weight" that a domestic authority affords to a term on the Register should be consistent with its domestic laws. To prescribe how a domestic authority should consider a term on the Register and what, if any, weight should be afforded to the term, presumes to dictate an outcome and therefore exceeds the mandate under Article 23.4.
- Discussion should focus on:
  - how national authorities use the information on the Register in their existing domestic system;
  - rather than how the WTO should require national authorities to use the information, i.e., what kind of substantive weight or significance we should give a registration. It is not the role of the Special Session to evaluate and restructure substantive examination practices of each WTO Member.
- Discussion should focus on developing a useful and meaningful mechanism to facilitate protection of GIs.
- The system proposed in the joint proposal would provide a useful reference that would facilitate the work of examiners by providing a central repository for relevant information, a resource that currently does not exist.
- Not acceptable that more evidentiary weight should be afforded to findings by authorities in a notifying Member than to the domestic authorities of the Member who is making decisions regarding protection and registration under its own national law.
- The significance and weight national authorities should give to information on the Register would depend, amongst other things:
  - on whether the consulting country is satisfied that the notified GI is in fact a GI;
  - on whether, for example, a trademark which is being applied for consists of a GI in that country. If the trademark consists of a GI in the country concerned, then little or no significance should be attached to the information on the Register. Where the trademark does not consist of a GI in the country concerned, then great significance and weight should be attached to the information on the Register, assuming that the notified GI is indeed a GI.

### Question 3

**Are there any options regarding participation, other than voluntary and mandatory participation? If so, what criteria could be envisaged?**

Main points made by delegations:

- Voluntary participation is the only logical and equitable mechanism to meet the mandate. Mandatory participation is not a credible option as plainly contrary to the mandate.
- "Multilateral" means "all Members" had to participate. There is no WTO "à la carte".
- No participation options available between mandatory and voluntary.
- It is not appropriate to establish criteria for participation, as the mandate clearly requires mandatory participation.
- The Register could be voluntary in the beginning and this status be reviewed after a couple of years of operation.
- Caution that any possible criteria for mandatory or voluntary participation could create the undesirable situation where some developing Members would be asked to participate on a mandatory basis, while other developing Members or even developed Members were free to participate on a voluntary basis.

#### Question 4

**What form could special and differential treatment take with regard to the Register?**

Main points made by delegations:

- Participation and special and differential treatment are closely interrelated, as voluntary participation provided simple and effective special and differential treatment. If participation in the system was voluntary, a Member would choose to participate if and when it felt it was in its interest to participate and it had the capacity to do so.
- It is unusual to have S&D provisions in the form of optional participation.
- If optional participation, would there be any S&D provisions for developing countries wishing to participate in the multilateral Register?
- Not clear how voluntary participation for all could be equated with S&D treatment. If a developing country had expectations of benefiting from facilitated protection of GI in the Register, but then a developed country opted out, how could this be called special and differential treatment?
- Mandatory participation could hold merit especially for small developing countries whose GIs were not yet well-known and were still being misappropriated, as it helps facilitating protection.
- No need for any specific S&D right now, but once the final form of the Register was clear S&D provisions would crystallize around other elements than just optional participation.
- S&D could take the form of longer implementation period for certain countries. Difficult to state precisely what form S&D would take at this stage, as not yet clear what disciplines will be agreed. No S&D may be required.
- While Article 23.4 language describes a voluntary Register, meaning that all Members, developing and developed, would be free to decide whether or not to participate, in view of the importance of greater certainty in trade negotiations, one could consider asking Members to indicate their interest to participate in the system as part of the negotiations. Large part of W52 sponsors have not pronounced themselves on their view on mandatory participation.

#### **Chair's question re "shared responsibility" for taking the information into account**

- Is there a chance to balance the legal responsibility for taking the Register information into account?
- While it is understandable that a consulting country does not want an imposition of a decision from the notifying country, it would nevertheless be interested to have all facts available in order to make proper informed decisions. The notifying country certainly has information and facts which presumably it can use to help to justify the position with respect to the notification:
  - Re. genericness, the consulting country would probably have better facts regarding the situation in its country.
  - Re. whether a notification meets the definition there may be reasonable elements of information on both sides.
- In the case of two Members that are clearly participating in the system (i.e. without prejudice to the question of participation), would there be any scope for sharing this responsibility so that the consulting country is still in the driving seat in terms of the decision-making, but it has facts from both sides that it can bring to bear on its decision making?

