A New World for Geographical Indications
The progressive extension of sui generis GI protection to contending territories

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Abstract – **While exploring the ongoing major shift in countries that have employed a sui generis system for the protection geographical indications (GIs) and those in opposition to the recognition of GIs as a specific category of intellectual property rights, this paper outlines the form and scope of protection offered in newly established regimes for GIs. The GIs now registered remain for the most part those on the lists of products to be protected through Free Trade Agreements. Within these GI registries relatively few foreign GIs (not listed in the Annexes of FTAs) have gone through or are still going through the established registration system to obtain protection. How these new sui generis systems will effectively be used in the future depends for a large part on the progressive development of public policies around GIs in the countries concerned. This can also be influenced by the respective domestic GI potential and developments in the international sphere.**

Keywords – Geographical indications; bilateral agreements; Canada; Japan; Singapore; South Africa.

Introduction

This research is placed against the backdrop of the differing policy objectives and strategies of the European Union (EU) and the United States (US) regarding GIs. Both have pushed for their interests in a contended race of free trade agreements (FTAs) over the last decade since negotiations within the World Trade Organization came to an impasse in 2008.

The model of FTAs concluded by the EU since then, as well as the progressive developments of legal approaches towards GIs, led to the establishment of *sui generis* GI systems, even in countries who had previously been opposed for years to such a concept. In this paper, we examine the ways and means of this major shift.

Method

Four countries: Canada (negotiations with the EU began in 2009, the final agreement was signed in 2016), Japan (negotiations began in 2013, agreement signed in 2017), Singapore (began 2010, agreement in 2017) and South Africa (began 2013, agreement in 2016), who concluded FTAs with the EU and their respective sui generis systems were selected and have been examined.

The research carried out is based on public documents such as available literature on the subject matter and legal texts. Further, in addition to discussions and exchanges with officials from the respective intellectual property offices, targeted questions were circulated to enable comparisons to be made. This included for example questions on the information provided by the government on GIs during public consultations and any responses submitted by relevant interest groups.

Likewise, the effective use and implications of the established GI registries were examined both for foreign and domestic GIs. This served to assess the registries' integration in national legal and institutional systems, as well as their sustainability and future prospects.

Results

While the Agreement on Trade-Related Aspects of Intellectual Property (TRIPS) did include geographical indications as an intellectual property right, the scope of protection of such a right was not specified, except to some extent in relation to wines and spirits. As such, it was left to the members of the World Trade Organization to determine the legal means implemented to provide protection. (O'Connor et al., 2017). In turn, the EU had previously sought to ensure an adequate level of protection for GIs through lists that were annexed to their FTAs. However, a change in policy and approach has become apparent in the extent to which the EU supports awareness-raising and capacity-building around GIs. Activities thereunder are being carried out among stakeholders in the private sector, as well as the general public at large.

It can also be found that certain associations of GI producers or those with GIs that hold strong potential have had a role to play to the evolution of the sui generis systems and the drafting of related laws and regulations. Likewise, it can be considered in how far the public is aware and consumer's demand has grown for the provision and supply of recognized GI products.

The domestic interest for recognizing and protecting GIs varies from one country to another, depending on the potential of local specialty products (both foodstuffs and handicrafts) and, to a lesser extent, to the development of a mature market for a detailed

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segmentation of quality products. If there were to be a scale in terms of domestic interest and drivers, the countries were studied could be ranked from Singapore: with almost no domestic products eligible for GI recognition, to Japan: with huge potential of traditional edible products locally rooted. For present purposes, handicrafts are not included as they are not covered by the current sui generis system, although the potential is very high as well. (Kimura et al., 2021) The potential and interest around GIs can be assessed through public consultations and debates, where they took place. For example, Singapore and South Africa held such consultations with responses from various stakeholders inter alia the national law society and associations of GI producers.

With regards to legal protection, prior to concluding its FTA with the EU, Canada provided GI protection under its trademark act. The same for applies in part to South Africa where several different pieces of legislation provide protection, notably the Trade Mark Act 1993, No. 194 whereby protection is provided in the form of certification and collective marks. In Japan this is achieved through a system of "regional brands", established through the revision of the Trade Mark Act, which led to the regional Collective Trade Mark System in 2006. In Singapore, GI obligations under TRIPs were met in the establishment of their GI Act whereas previously only certification and collective marks could be registered. Subsequently the Act was amended following the conclusion of the FTA with the EU in 2019 (Mirandah, G (2021).

In parallel, in all four countries preexisting acts or legal provisions existed that provided protection to wines and spirits GIs, as required by TRIPS. At the same time, this can also be linked to the stringent regulations around alcohol and related taxes. The separate legal provisions and their systems in turn are to seek coexistence with the establishment and implementation of the sui generis systems that provide GI protection for agricultural and possibly for non-agricultural products.

It follows that now these countries, like the EU itself, face or may soon face the challenge to find ways to merge and/ or harmonize these different legal systems. Extending registration and protection to non-agricultural GIs is likely to emerge soon as an additional question. In contrast, in other countries, a system has been established to cover all kinds of GIs from the beginning.

Depending on the FTA concluded, GI protection can be obtained automatically through the inclusion of the GI on the respective list in the Annex of an FTA. Alternatively, the GI will still be required to undergo the application and registration process of the respective national sui generis system to be taken up into the GI registry. The latter is the case for Singapore, where 143 EU GIs out of the 196 GIs included on the List annexed to the EU-Singapore Free Trade Agreement underwent the registration procedure and are subsequently in the GI registry. On the contrary, in South Africa, presently no foreign GIs could be registered in the newly established register, due to a lack in meeting the present legal requirements.

In the FTA between the EU and Singapore, there is a provision (Art 10.17, 2.) that provides that the system of protection of GIs shall include a domestic register. No such provision is apparent in Protocol 3 of the Economic Partnership Agreement between the EU and SA. Instead, a Special Committee on GIs was established with the purpose of monitoring the development of the EPA. The same applies to Japan and Canada, where both had to establish domestic legislation in order to satisfy their obligations according to the FTA.

The South African and Japanese registers could attribute their establishment more towards the internal drivers and activities that continue around capacity-building. While nonetheless, negotiating a FTA with the EU played a role in tipping political momentum towards overcoming contrary views within individual public institutions.

Analysis and conclusions

Upon the conclusion of FTAs with the EU, the sui generis GI systems remain predominantly modest, with few GI registrations (except for Japan). Or even nascent in some cases, in terms of the need for further harmonization of national laws and further GI registrations. This then, beyond the larger, more established GI associations and their producers who have attained national as well as international recognition in relation to their reputation and consumer demand.

The future of these modest and nascent sui generis GI systems may well be determined by the move by these countries to specifically address outstanding legal issues related to GIs, and/or steer legislation towards harmonization towards potential/ eventual accession to the to Geneva Act. In which case the process of entering foreign GIs into national registries through the respective individual procedures may no longer be decisive.

Nevertheless, even with the remaining challenges and obstacles that lie ahead, the GI sui generis systems in the four countries are taking root.

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