

11-22-2016

## Whither (Wither?) Geographical Indications? The Case Against Geographical Indications and For Appellations of Origin in an Era of Glocalization

Benjamin Robert Hopper

Follow this and additional works at: <https://scholarship.kentlaw.iit.edu/ckjip>



Part of the [Intellectual Property Law Commons](#), and the [International Law Commons](#)

---

### Recommended Citation

Benjamin R. Hopper, *Whither (Wither?) Geographical Indications? The Case Against Geographical Indications and For Appellations of Origin in an Era of Glocalization*, 16 Chi. -Kent J. Intell. Prop. 210 (2016).

Available at: <https://scholarship.kentlaw.iit.edu/ckjip/vol16/iss1/9>

This Article is brought to you for free and open access by Scholarly Commons @ IIT Chicago-Kent College of Law. It has been accepted for inclusion in Chicago-Kent Journal of Intellectual Property by an authorized editor of Scholarly Commons @ IIT Chicago-Kent College of Law. For more information, please contact [jwenger@kentlaw.iit.edu](mailto:jwenger@kentlaw.iit.edu), [ebarney@kentlaw.iit.edu](mailto:ebarney@kentlaw.iit.edu).

WHITHER (WITHER?) GEOGRAPHICAL INDICATIONS? THE CASE  
AGAINST GEOGRAPHICAL INDICATIONS AND FOR  
APPELLATIONS OF ORIGIN IN AN ERA OF GLOCALIZATION

BENJAMIN ROBERT HOPPER<sup>1</sup>

ABSTRACT

*One of the most hotly contested legal debates in international intellectual property law today concerns geographical indications (GIs) and appellations of origin (AOOs), referred to herein using the umbrella term “indication of origin” (IO). Central to the debate are two different systems for IOs—the sui generis system of AOOs and the like promoted by IO advocates like the EU (generally civil law jurisdictions) and the system promoted by IO skeptics like the US (generally common law jurisdictions) under which GIs are subsumed within a pre-existing trademark system. These divergent IO systems are manifestations of deepening fragmentation in the international IO order, which has led to a deadlock in international IO law. Although key international agreements dealing with IOs have sought to “bridge the gap” between the two systems by permitting signatories to protect IOs under either system, this article finds that there is an inherent, irreconcilable tension between the two systems, making the gap unbridgeable. The article concludes that it is in the interests of all that a sui generis and limited system of AOO protection be adopted within an international, harmonized framework. By contrast, trademark-based GIs ought to be allowed to wither on the vine.*

1. LL.M. (Harvard University); J.D. and B.A. Arts (Hons.) (University of Melbourne). Admitted to the Supreme Court of Victoria and High Court of Australia. Email: benrhopper@gmail.com. I would like to thank Professor Ruth Okediji and Diana Liebenau for their encouragement and comments, Bryan Helwig for his guidance as article editor, and the staff at the *Chicago-Kent Journal of Intellectual Property* for their professionalism and support. I am responsible for any mistakes in this article.

## TABLE OF CONTENTS

PART I: INTRODUCTION.....	212
I.A: The GI vs. AOO debate.....	212
I.B: Structure of article and outline of arguments.....	213
I.C: Definitional matters.....	214
GIs and AOOs – clarifying the distinction .....	214
Trademarks .....	216
PART II: INTERNATIONAL IO AGREEMENTS – A STORY OF FRAGMENTATION .....	216
II.A: Early agreements .....	216
II.B: Lisbon Agreement and Geneva Act .....	217
II.C: TRIPS and the WTO .....	220
II.D: TPP .....	222
PART III: THE ECONOMIC GEOGRAPHY OF IOS – FURTHER FRAGMENTATION .....	223
III.A: Political economy of IOS .....	223
III.B: Potential economic value of IOS .....	224
III.C: Approaches to protecting IOS .....	225
III.D: The nation-state and IOS.....	228
PART IV: DOCTRINAL AND CONCEPTUAL TENSIONS .....	229
IV.A: Doctrinal and conceptual tensions .....	229
IV.B: Doctrinal and conceptual tension between IOS and trademarks.....	229
IV.C: Tension between GIs and AOOs .....	231
PART V: ELICITING THE THEORETICAL JUSTIFICATION FOR IOS .....	232
V.A: The functions and justifications of trademarks .....	232
V.B: The functions and justifications of IOS .....	235
PART VI: CONCLUSION – AOOs FOR ALL.....	238

## PART I: INTRODUCTION

*I.A: The GI vs. AOO debate*

One of the most hotly contested legal debates in international intellectual property law today concerns geographical indications (**GIs**) and appellations of origin (**AOOs**),<sup>2</sup> referred to herein using the umbrella term “indication of origin” (**IO**). A review of international agreements concerning IOs, and the different mechanisms by which countries seek to provide for their protection, reveals fragmentation. The source of this fragmentation may be located in the ever-widening disjuncture between the nation and state in “nation-state” and global struggles between emigrants and “stay-at-homes” over narratives of national identity. The debate over IOs is thus a manifestation of glocalization—the simultaneous pressures exerted by local and global tendencies.

Central to the debate are two different systems for IOs—the *sui generis* system of AOOs and the like promoted by IO advocates like the European Union (the **EU**) (generally civil law jurisdictions) and the system promoted by IO skeptics like the United States (the **US**) (generally common law jurisdictions) under which IOs are subsumed within a pre-existing trademark system. Although key international agreements dealing with IOs have sought to “bridge the gap” between the two systems by permitting signatories to protect IOs under either system, this article finds that there is an inherent, irreconcilable tension between the two systems, making the gap unbridgeable. The article concludes that it is in the interests of all that a *sui generis* and limited system of AOO protection tethered closely to the land be adopted within an international, harmonized framework. Indeed, this is the only practical normative basis on which AOOs can and should be based without doing undue harm to pre-existing trademark and common language rights. Further, it may well break the deadlock in negotiations between IO proponents and opponents.

2. Cf. Kal. Raustiala & Stephen R. Munzer, *The Global Struggle over Geographic Indications*, 18 EUR. J. INT'L. L. 337 (2007); Burkhardt Goebel & Manuela Groeschl, *The Long Road to Resolving Conflicts between Trademarks and Geographical Indications*, 104 TRADEMARK REP 829, at 830 (2014); and Anselm Kamperman Sanders, *Geographical Indications of Origin: When GIs Become Commodities, All Gloves Come Off*, 46 IIC - INT. REV. INTELLECT. PROP. COMPET. L. 755, at 755 (2015).

*I.B: Structure of article and outline of arguments*

After clarifying some important definitional matters, I provide an overview of the current international agreements concerning IO protection in Part II.

Part III outlines the “economic geography” of IO protection, noting in particular the, if not diametrically opposed, then certainly fragmented and fragmenting positions adopted and pushed by different countries (this is my first argument that there is deepening fragmentation in the international IO order). It also notes the historical/cultural, economic, and political underpinnings to those positions (this is my second argument that the fragmentation is not merely philosophical/systemic, but erupts from the widening hyphen between nation and state in “nation-state”).

Part IV sets out my third argument that, upon proper scrutiny, the theoretical justifications for IOs and their closest cousin in the intellectual property family, trademarks, clash in a manner that is irreconcilable. In particular, the cognate key tenets of trademark law of distinctiveness and “genericide” cannot be reconciled with IO’s protection for place names and refusal to accept the consequences of “genericide”. “Genericide” refers to a trademark owner losing their exclusive rights because their trademark has become generic, i.e., becomes the commonly used sign for a good or service (e.g., “Kleenex”).

In Part V, I set out my fourth argument that the theoretical justifications for IOs are not solely to be found in traditional theories of intellectual property, but also in a cultural heritage theory grounded in the protection, maintenance and sharing of cultural heritage. Thus, irrespective of whether or not an IO becomes a common descriptive term or could be used in an arbitrary or fancy fashion that would not cause consumer confusion, it should be reserved for the current occupants of the particular place whose name forms the IO. This is subject to the proviso that the IO retain an intimate connection to its indicated land. After all, an IO is not alienable in the sense that a trademark is. For example, a trademark may pass hands from a producer in the US to a producer in the Philippines, as may production of the good to which the trademark is attached. However, an IO is (or should be, I contend) tethered to the land—like an easement, it should “run with the land”. “Tethered to the land” refers to the extent to which the IO evokes a particular geographical location.

This leads me to conclude in Part VI that the best path forward is for an international agreement to be signed (or a pre-existing agreement amended) requiring member countries to provide *sui generis* AOO protection for goods whose qualities are indeed “essentially [i.e.,

*necessarily, inextricably] attributable*”<sup>3</sup> to their geographical origin by requiring them to be, or to use, raw materials from that origin and, if made from raw materials, so made using local knowledge. By contrast, trademark-based GIs ought to be allowed to wither on the vine.

### *I.C: Definitional matters*

#### GIs and AOOs – clarifying the distinction

Due in no small part to the contest over the proper contents of GIs and AOOs, there is much confusion in the literature concerning their definitional boundaries, and delineating the distinction between the two can be elusive. For example, one commentator seeks to distinguish GIs from AOOs on the basis that “[w]hile geographical indications typically obtain their name from their geographical location. . . appellations of origin derive their special qualities from the geographical environment where the good is produced”.<sup>4</sup> The practical effect of the distinction between “geographical location” and “geographical environment” is not immediately apparent – the names of both are generally the same or, at least, the indications for both are geographical *names* (and it is only the *name* that a GI/AOO protects, not the underlying knowledge, technology, terrestrial features, etc.). Nonetheless, the distinction does seek to grasp at the root of the matter – the degree of intimacy between the name/indication and the *land*. As the World Intellectual Property Organization (**WIPO**) states, “[t]he basic difference between the two concepts is that the link with the place of origin must be stronger in the case of an appellation of origin.”<sup>5</sup>

Bernard O’Connor helpfully elucidates the concept of IOs as follows: in contrast to a trademark, “[a] geographical indication is linked. . .to something more than mere human creativity including topography, climate or other factors independent from human creativity. Therefore, the link between the product and its geographical origin cannot be broken and no delocalization of production is possible. . .whereas trademarks put emphasis on the producer of a product, a geographical indication

3. WORLD TRADE ORG., *AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS* (signed on April 15, 1994), at art. 22(1), <http://treaties.fco.gov.uk/docs/pdf/1996/TS0010.pdf> (last visited Dec. 3, 2016) (emphasis added).

4. Danielle Dudding, *The Lisbon Agreement: Why the United States Should Stop Fighting the Geneva Act*, 18 VAND. J. ENT. & TECH. L. 167, at 172 (2015).

5. WORLD INTEL. PROP. ORG., *Frequently Asked Questions: Geographical Indications*, [http://www.wipo.int/geo\\_indications/en/faq\\_geographicalindications.html](http://www.wipo.int/geo_indications/en/faq_geographicalindications.html) (last visited Dec. 3, 2016).

*underlines the geographical origin of a good and the characteristics that are derived therefrom.*<sup>6</sup>

Herein, unless otherwise indicated, I define GIs consistently with the Trade-Related Aspects of Intellectual Property agreement (TRIPS) as: “indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.”<sup>7</sup> However, I define an AOO consistently with the definition in the *Lisbon Agreement for the Protection of Appellations of Origin and their International Registration* (as amended on September 28, 1979) (**Lisbon Agreement**) as: “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 human factors.”<sup>8</sup> To further clarify the distinction between GIs and AOOs, I specify that (i) a GI may or may not be toponymic and may be registered under a trademark or a *sui generis* registration system; and (ii) an AOO is toponymic and is registered under a *sui generis* registration system.

An example of a GI is “feta”. The etymology of “feta” lies in “fetta”, being the Italian for “slice”, which, in turn, stems from the Latin “offa”, meaning “morsel” or “piece”.<sup>9</sup> Therefore, it is not a toponym, but derives from an everyday word. Nonetheless, it bears a historical association with a particular region (Greece) that produces white cheese using specific ingredients according to a particular process.<sup>10</sup> An example of an AOO is “Champagne”, which is a sparkling wine from the Champagne region of France using grapes grown in that region.<sup>11</sup>

The exceptions to using “GI” and “AOO” as defined above are: Part VI, wherein I argue for a more restrictive definition of AOO and, where I use “GI” or “AOO” in the context of a particular agreement, I

6. BERNARD O’CONNOR, *THE LAW OF GEOGRAPHICAL INDICATIONS*, at 113 (2004). Note: in this quote, “geographical indication” may be understood as equivalent in meaning to “IO” as used in this article.

7. WORLD TRADE ORG., *supra* note 3 (TRIPS), at art. 22(1).

8. Note: As will become apparent from the discussion below, in particular, Part VI wherein I set out my proposed definition of an AOO, I consider it doubtful that the geographical denomination of a country should form an AOO. Nonetheless, for the sake of clarity, I use this established definition of an AOO from the Lisbon Agreement as my starting point.

9. Douglas Harper, *fetta* (n.), ONLINE ETYMOLOGY DICTIONARY, [http://etymonline.com/index.php?term=fetta&allowed\\_in\\_frame=0](http://etymonline.com/index.php?term=fetta&allowed_in_frame=0) (last visited Dec. 3, 2016).

10. See Bernard O’Connor & Irina Kireeva, *What’s in a Name? The “Feta” Cheese Saga*, 9 INT. TRADE L. REGUL. 110, at 110, 116-17 (2003).

11. See Daniel J. Gervais, *Irreconcilable Differences? The Geneva Act of the Lisbon Agreement and the Common Law*, 53 HOUST. L. REV. 339, at 342 n.7 (2015).

intend for those acronyms to have the meanings they are given in that agreement. To avoid confusion, rather than using “GI” as “*an umbrella term whose overall purpose is to distinguish the identification of a product’s origin and its link with particular characteristics related to that origin*,”<sup>12</sup> I use the neologism “*indicium originis*” or “indication of origin” or “IO” to denote the “family” within which the “species” of GIs and AOOs fall.

### Trademarks

I define a trademark quite simply as a sign used in the course of trade to distinguish one person’s goods and/or services from that of another.<sup>13</sup>

## PART II: INTERNATIONAL IO AGREEMENTS – A STORY OF FRAGMENTATION

### II.A: Early agreements

The history of international *indicium originis* law reveals a pattern of increased protection for indications of origin, alongside increased confusion concerning the ontological nature of these indications.

The first mention of subject matter akin to *indicia originis* in a multilateral treaty was the watershed *Paris Convention on Industrial Property (Paris Convention)* (1883).<sup>14</sup> While the Paris Convention mentioned “*indication of source*” (“*indication de provenance*”), the term was left undefined, and only limited protection against false indications of source was provided for.<sup>15</sup> The Paris Convention’s protection against false indications of source has been expanded somewhat since 1883. Thus, the current incarnation of the Paris Convention (as amended in 1979) includes protection against “*direct or indirect use of a false indication of the source of the goods or the identity of the producer, manufacturer, or merchant*.”<sup>16</sup>

12. Daniele Giovannucci, Tim Josling, William Kerr, Bernard O’Connor & May T. Yeung, GUIDE TO GEOGRAPHICAL INDICATIONS: LINKING PRODUCTS AND THEIR ORIGINS, at xiii (2009).

13. Compare WORLD TRADE ORG., *supra* note 3 (TRIPS), at art. 15(1).

14. MICHAEL BLAKENEY, THE PROTECTION OF GEOGRAPHICAL INDICATIONS, at 10 (2014); Raustiala and Munzer, *supra* note 2, at 344.

15. WORLD INTELL. PROP. ORG., CONVENTION DE PARIS POUR LA PROTECTION DE LA PROPRIÉTÉ INDUSTRIELLE (DU 20 MARS 1883) [PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY (OF MARCH 20, 1883)], at art. 10, [http://www.wipo.int/wipolex/en/treaties/text.jsp?file\\_id=287780](http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=287780) (last visited Dec. 3, 2016).

16. WORLD INTELL. PROP. ORG., PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY (AS AMENDED ON SEPTEMBER 28, 1979), at arts. 9 and 10(1), [http://www.wipo.int/wipolex/en/treaties/text.jsp?file\\_id=287556](http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=287556) (last visited Dec. 3, 2016); Raustiala and Munzer, *supra* note 2, at 344; MICHAEL BLAKENEY, *supra* note 11, at 344.



Increased protection for indications of origin came in the form of the *Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods* (1891) (**Madrid Agreement**), under which parties agree to prohibit the importation of “[a]ll 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.”<sup>17</sup> Of note was art. 4 on genericide of indications of origin, which allowed the courts of member countries to determine what appellations, on account of their generic character, fall outside the agreement. “[R]egional appellations concerning the source of products of the vine” were, however, carved out from art. 4. In a harbinger of future IO disputes, this carve-out was apparently the reason why major trading nations (the US, Germany and Italy) did not accede to the Madrid Agreement.<sup>18</sup>

### *II.B: Lisbon Agreement and Geneva Act*

The Lisbon Agreement provides stronger protection for indications of origin than any other multilateral treaty.<sup>19</sup> The agreement obliges its members, who form the Lisbon Union,<sup>20</sup> to protect in their territories “the appellations of origin of products” of signatory countries, “recognized and protected as such in the country of origin” and registered at the International Bureau of WIPO.<sup>21</sup> Foreshadowing the heightened protection for wine and spirit IOs under TRIPS,<sup>22</sup> the Lisbon Agreement requires that protection 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.”<sup>23</sup>

No common law jurisdiction (apart from Israel) has acceded to the Lisbon Agreement, which only has 28 contracting parties.<sup>24</sup> The *Geneva*

17. WORLD INTELL. PROP. ORG., ARRANGEMENT DE MADRID CONCERNANT LA RÉPRESSION DES FAUSSES INDICATIONS DE PROVENANCE SUR LES MARCHANDISES (1891) [MADRID AGREEMENT FOR THE REPRESSION OF FALSE OR DECEPTIVE INDICATIONS OF SOURCE ON GOODS (1891)], at art. 1, [http://www.wipo.int/wipolex/en/treaties/text.jsp?file\\_id=281783](http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=281783) (last visited Dec. 3, 2016).

18. BLAKENEY, *supra* note 14, at 12.

19. Dudding, *supra* note 4, at 182.

20. WORLD INTELL. PROP. ORG., LISBON AGREEMENT FOR THE PROTECTION OF APPELLATIONS OF ORIGIN AND THEIR INTERNATIONAL REGISTRATION (AS AMENDED ON SEPTEMBER 28, 1979), at art. 1(1), [http://www.wipo.int/wipolex/en/treaties/text.jsp?file\\_id=285838](http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=285838) (last visited Dec. 3, 2016).

21. *Id.* at art. 1(2).

22. WORLD TRADE ORG., *supra* note 3 (TRIPS), at art. 23.

23. WORLD INTELL. PROP. ORG., *supra* note 20 (Lisbon Agreement), at art. 3.

24. WORLD INTELL. PROP. ORG., *WIPO-Administered Treaties*, WIPO, [http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty\\_id=10](http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=10) (last visited Dec. 3, 2016). As

*Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications* (as adopted on May 20, 2015) (**Geneva Act**) emerged from a review of the Lisbon system with a view to making it more attractive to users and potential new members.<sup>25</sup> However, if the intent of the Geneva Act was to make the Lisbon system palatable to countries that protect indications of origin under a trademark system, rather than *sui generis* system of AOO protection, it appears that the intent has not been realized.<sup>26</sup>

At least two fundamental elements of a trademark-based system for indications of origin raise issues in terms of compatibility with the Geneva Act. These are, first, the “use” doctrine (a trademark owner only has rights over a sign for the goods/services in respect of which they use the sign, and may lose exclusive rights to the trademark in respect of some or all of those goods/services if they abandon it or acquiesce in another’s use for a sufficient length of time) and, second, the cognate doctrine of genericide.

Standing in marked tension with the use doctrine, art. 11 of the Geneva Act replaces the right against usurpation of the Lisbon Agreement with a “TRIPS Plus” three-limbed right that members are required to furnish, namely the right to prevent:

- (a) use of an AOO or GI (as defined in the Geneva Act at art. 2(1)(i) and art. 2(1)(ii), respectively):<sup>27</sup>
  - (i) in respect of goods of the same kind as those to which the AOO or GI applies; or

of December 3, 2016 the contracting parties to the Lisbon Agreement are: Algeria, Bosnia and Herzegovina, Bulgaria, Burkina Faso, Congo, Costa Rica, Cuba, Czech Republic, Democratic People’s Republic of Korea, France, Gabon, Georgia, Haiti, Hungary, Iran, Israel, Italy, Mexico, Montenegro, Nicaragua, Peru, Portugal, Republic of Moldova, Serbia, Slovakia, the former Yugoslav Republic of Macedonia, Togo, and Tunisia.

25. Int’l Trademark Ass’n, *New Act of the Lisbon Agreement Encompasses All Geographical Indications, Allows Accession by Regional Organizations*, 70 INTA BULL. 11 (June 15, 2015), [http://www.inta.org/INTABulletin/Pages/LisbonAgreement\\_7011.aspx](http://www.inta.org/INTABulletin/Pages/LisbonAgreement_7011.aspx) (last visited Dec. 3, 2016).

26. Cf. Gervais, *supra* note 11; Int’l Trademark Ass’n, *supra* note 25.

27. WORLD INTELL. PROP. ORG., GENEVA ACT OF THE LISBON AGREEMENT ON APPELLATIONS OF ORIGIN AND GEOGRAPHICAL INDICATIONS (adopted on May 20, 2015), at arts. 2(1)(i) and 2(1)(ii), [http://www.wipo.int/wipolex/en/treaties/text.jsp?file\\_id=370115](http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=370115) (last visited Dec. 3, 2016). The full text of these articles is: “*This Act applies in respect of:*

- (i) any denomination protected in the Contracting Party of Origin consisting of or containing the name of a geographical area, or another denomination known as referring to such area, which serves to designate a good as originating in that geographical area, where the quality or characteristics of the good are due exclusively or essentially to the geographical environment, including natural and human factors, and which has given the good its reputation; [AOO] as well as
- (ii) any indication protected in the Contracting Party of Origin consisting of or containing the name of a geographical area, or another indication known as referring to such area, which identifies a good as originating in that geographical area, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin. [GI]”.

- (ii) in respect of goods or services not of the same kind as those to which the AOO or GI applies, if such use would suggest a connection with the AOO or GI beneficiaries and be likely to damage their interests, or, “*where applicable*”, if the use would be “*likely to impair or dilute in an unfair manner, or take unfair advantage of*” the GI’s reputation,

in both cases, even if the AOO or GI is used in translated form or is accompanied by terms such as “style”, “kind”, “type”, “make”, “imitation”, “method”, “as produced in”, “like”, “similar”; and

- (b) “*any other practice liable to mislead consumers as to the true origin, provenance or nature of the goods.*”

The Geneva Act has thereby secured the indication of origin protection that the pro-IO countries have been unable to agree through the TRIPS council at the World Trade Organization (**WTO**) (see discussion in Part II.C below). As Daniel Gervais writes, “*the Geneva Act is a de facto expansion by (and for) the Lisbon Members of GI protection to goods other than wines and spirits—a measure sought by many WTO Members, especially in the developing world.*”<sup>28</sup>

It is not possible to reconcile art. 12 of the Geneva Act with the doctrine of genericide in trademark law. This doctrine is premised on the belief that, once a trademark has become generic, it is part of the commons, free for all to use like any dictionary word. However, art. 12 prevents a party from considering a registered AOO or GI as having become generic as long as it remains protected in the country of origin. As Gervais has explained,<sup>29</sup> this is an extraordinary manifestation of *lex originis* in international intellectual property law, where a key governing principle is that of territoriality (i.e., substantive rights are national in nature).<sup>30</sup>

In addition to expanding the *level* of protection enjoyed by *indicia originis*, the Geneva Act has expanded the *protected subject matter* by expanding the *definition* of “AOO”. This is part of the act’s attempt to “bridge the gap” between GIs and AOOs.<sup>31</sup> Under the new definition, an AOO, just like a GI, does not necessarily need to incorporate a toponym, but could be a “*denomination known as referring to [the relevant] area.*”<sup>32</sup>

28. Gervais, *supra* note 11, at 349.

29. *Id.* at 352–54.

30. Graeme B. Dinwoodie, *The Architecture of The International Intellectual Property System*, 77 CHI-KENT L. REV. 993, at 996-99 (2002).

31. *See*, generally, Gervais, *supra* note 11, at 340; Int’l Trademark Ass’n, *supra* note 25; Dudding, *supra* note 4, at 178.

32. WORLD INTELL. PROP. ORG., *supra* note 27 (Geneva Act), *see* art. 1(vi) read together with art. 2(1)(i) (emphasis added).

The only significant difference between AOOs and GIs under the Geneva Act thus appears to be:

- (a) a good designated by an AOO must have a quality or characteristics resulting from the geographical environment, including natural and human factors, in which that good originates, and which has given the good its reputation; whereas,
- (b) a good designated by a GI must have a quality, reputation or other characteristic resulting from its geographical origin.<sup>33</sup>

This conflation of the definitions for two already confusingly overlapping concepts is retrograde. Not only does it introduce semantic confusion, but also it further “untethers” *indicia originis* from the land. As I argue in Part V, this is contrary to the theoretical justifications for this subject matter. Thus, while introducing the language of GIs may have the benefit of including terminology with which the New World postcolonial countries are familiar, this is very much an improvement of *form* and not one of *substance*. I therefore disagree with Gervais that this “*dual approach*” is an improvement;<sup>34</sup> rather, it is markedly disadvantageous.

It follows from the analysis above that the Geneva Act has sought to bring within the Lisbon system’s orbit trademark-based IO protection, apparently to encourage common law jurisdictions to join. However, in so doing, the Geneva Act has had the effect of broadening and strengthening the level of protection given to both AOOs and trademark-based GIs under the Lisbon system. This is because, although an AOO enjoyed more expansive rights under the Lisbon Agreement than a GI traditionally receives in trademark-based systems, as explained in Part I.C above, a GI is a broader concept than an AOO (e.g., while a GI *may* include a toponym, that was a *necessary* element of an AOO under the Lisbon Agreement). Thus, if the aim was to attract “New World” countries already chary of strengthening protection for *indicia originis*, strengthening the protection that *indicia originis* receive under the Lisbon system would appear to be an odd way of going about achieving that aim.

### II.C: TRIPS and the WTO

The debate between the Old World European countries seeking strong indication of origin protection and New World postcolonial countries seeking to temper the strength of such protection is manifest in TRIPs.

33. *Id. see* arts. 1(vi), 1(vii), read together with art. 2(1). See the full text of arts. 2(1)(i) and 2(1)(ii) at *supra* note 27.

34. Gervais, *supra* note 11, at 347–48.

Early in the Uruguay Round TRIPS negotiations, the EU sought strong protection for indications of origin, including that all GIs be protected against any usurpation, imitation or evocation, even where accompanied by expressions such as “kind”, “type”, “style”, “imitation” or the like, and requiring refusal or invalidation of any application or registration for a trademark containing “*a geographical or other indication denominating or suggesting a country, region or locality with respect to goods not having this origin.*”<sup>35</sup>

By contrast, the US draft text granted very sparse protection to GIs and under a trademark-based, rather than more stringent *sui generis*, system. It simply obliged parties to protect GIs that certify regional origin by providing for their registration as certification or collective marks, and also to protect non-generic appellations for wine.<sup>36</sup>

As is often the case with major negotiations, things that fall into the “too hard” basket are left to be dealt with at a later time. The Uruguay Round negotiations resulted in WTO members being required to protect indications of origin, but having discretion as to the system of protection and only having to protect a subset of such indications, denoting wines and spirits, against imitation even where the true origin is indicated or where accompanied by expressions such as “kind”, “type”, “style”, “imitation” or the like.<sup>37</sup> Article 24 of TRIPS obliges members to enter into negotiations aimed at increasing the level of protection of GIs under art. 23 (Additional Protection for Geographical Indications for Wines and Spirits).

Since the signing of TRIPS, a deeply divided debate has taken place within the TRIPS Council between IO advocates seeking to extend the higher level of protection afforded IOs for wines and spirits and those who oppose the extension. Proponents include the EU, Guinea, India, Jamaica, Kenya, Madagascar, Mauritius, Morocco, Pakistan, Romania, Sri Lanka, Switzerland, Thailand, Tunisia and Turkey, who wish to use the higher level of protection to improve marketing of their products. Opponents include Argentina, Australia, Canada, Chile, Colombia, the Dominican Republic, Ecuador, El Salvador, Guatemala, Honduras, New Zealand, Panama, Paraguay, the Philippines, Chinese Taipei and the US, who stress

35. European Communities, *Draft Agreement on Trade Related Aspects of Intellectual Property Rights*, at arts. 19 to 21 (March 29, 1990), [http://www.tripsagreement.net/documents/GATTdocs/Draft\\_Agreement\\_on\\_Trade\\_Related\\_Aspects\\_of\\_IP\\_Rights\\_E\\_E.pdf](http://www.tripsagreement.net/documents/GATTdocs/Draft_Agreement_on_Trade_Related_Aspects_of_IP_Rights_E_E.pdf) (last visited Dec. 3, 2016).

36. United States, *Draft Agreement on the Trade-Related Aspects of Intellectual Property Rights*, at arts. 18 and 19 (May 11, 1990), [http://keionline.org/sites/default/files/mtn.gng\\_ng11.w.70\\_11may1990\\_us\\_draft\\_trips.pdf](http://keionline.org/sites/default/files/mtn.gng_ng11.w.70_11may1990_us_draft_trips.pdf) (last visited Dec. 3, 2016).

37. WORLD TRADE ORG., *supra* note 3 (TRIPS), at arts. 22 and 23.

the view that migrants should not be penalized for having taken names and methods of making products from their homeland and using them in good faith.<sup>38</sup>

The inability of IO advocates to seek increased protection for all IOs through the TRIPS Council process may at least in part explain the efforts to secure higher protection for IOs through the Geneva Act (described in Part II.B above). This process of securing protection outside of the broad multilateral framework of the WTO is evidence of fragmentation in the field of IOs. Gervais suggests that, notwithstanding the deep philosophical divide between IO advocates and opponents, the practical effect of exogenous pressures (namely, the benefit of access to European markets that New World countries may gain in return for concessions on IO protection) may lead to acceptance of the higher level of protection for IOs of the kind provided in the Geneva Act.<sup>39</sup> One way of testing this view, as well as my argument of increased fragmentation, is by considering how the recently concluded Trans-Pacific Partnership (**TPP**) deals with IOs.

#### II.D: TPP

The TPP (signed on February 4, 2016) is a multilateral trade agreement between 12 Pacific Rim countries that has the overall effect of requiring signatories to increase intellectual property protection. Five of its signatories are against higher IO protection (Australia, Canada, Chile, New Zealand, and the US) and two are members of the Lisbon Agreement (Mexico, Peru).

The TPP defines a GI in substantively the same terms as TRIPS.<sup>40</sup> Key relevant features of the TPP are:

- (a) it allows parties to protect GIs through trademark, *sui generis* or other legal means (art. 18.30);
- (b) it requires any administrative procedures to be transparent and without imposition of overly burdensome formalities (art. 18.31);
- (c) it requires parties to allow interested persons to oppose/cancel the GI on the grounds that, in the territory of the party (not of the origin of the GI good) the GI is:

38. WORLD TRADE ORG., *TRIPS: Geographical Indications - Background and the current situation* (2016), [https://www.wto.org/english/tratop\\_e/trips\\_e/gi\\_background\\_e.htm#protection](https://www.wto.org/english/tratop_e/trips_e/gi_background_e.htm#protection) (last visited Dec. 3, 2016); see also Justin Hughes, *Champagne, Feta, and Bourbon-the Spirited Debate About Geographical Indications*, 58 HASTINGS L.J. 299, at 320-31 (2006); and Gervais, *supra* note 11.

39. Gervais, *supra* note 11, at 340, 346, 368-71.

40. TRANS-PACIFIC PARTNERSHIP AGREEMENT (signed on February 4, 2016), at art. 18.1 <https://ustr.gov/sites/default/files/TPP-Final-Text-Intellectual-Property.pdf> (last visited Dec. 3, 2016).

- (i) likely to cause confusion with a trademark that is the subject of a pre-existing good faith pending application or registration;
  - (ii) likely to cause confusion with a pre-existing trademark; or
  - (iii) a term customary in common language as the common name for the relevant good (art. 18.32.1);
- (d) if a party protects or recognizes a GI pursuant to another international agreement, it must, among other things, provide that the above grounds of opposition/cancellation be available in respect of that GI (art. 18.36.1), unless the GI was specifically identified in, and recognized/protected pursuant to, an international agreement concluded before the TPP (art. 18.36.6); and
- (e) the above requirements in general do not apply to GIs for wine and spirits (see, e.g., art. 18.32, fn. 21; art. 18.36.4, but see also art. 18.32.1(c), fn. 21, being a carve-out for customary names of a grape variety existing in the territory of a party).<sup>41</sup>

It is apparent from the above analysis that, while the EU and other IO proponents have sought elevated protection for indications of origin via the Geneva Act, the US and other IO opponents have sought to reinforce the principles of a trademark-based system under the TPP. This system is founded on the doctrines of capacity to distinguish (and avoid consumer confusion), first-in-time priority to a trademark and genericide. While negotiations within the broad multilateral framework of the TRIPS Council have stalled, pro- and anti-IO forces have pursued their interests in other plurilateral and regional fora, leading to a marked fragmentation in international IO law. This would tend to undermine Gervais's postulation that "trade bricks" could form the stuff of a bridge between the pro- and anti-IO camps.<sup>42</sup> The overview of the "economic geography" of IOs in Part III provides further evidence of fragmentation.

### PART III: THE ECONOMIC GEOGRAPHY OF IOS – FURTHER FRAGMENTATION

#### *III.A: Political economy of IOS*

As Kal Raustiala and Stephen Munzer have persuasively argued, the increasingly persistent efforts to cement *indicia originis* in international

41. *Id.*

42. Gervais, *supra* note 11, at 340, 346, 368-71.

law may be attributed to: (i) falling trade barriers that have lowered the prices of IO protected goods and engendered a global market for previously local, discrete markets; (ii) goods similar to IO protected goods existing in many states due to prior waves of immigration, which brought skills and tastes to new locations, and these goods now competing with their “original” forebears on global markets; and (iii) rising wealth and falling food prices increasing the share of household income available for niche food products, often marketed under IOs.<sup>43</sup> IOs therefore exemplify the process of “glocalization”, or “*the simultaneity—the co-presence—of both universalizing and particularizing tendencies.*”<sup>44</sup> For IOs, protection of the *local* product is important to expanding *global* markets for that product.<sup>45</sup> In other words, global markets value IO products because of their local characteristics, quality or reputation owing to their geographical provenance, i.e., their authenticity.

### *III.B: Potential economic value of IOs*

To put it crudely, IOs can now mean big bucks for rural regions in Europe (and other locations whose names have become so bound up with goods made there that inhabitants can trade off the name). By way of illustration, in France, the average price of IO protected cheeses (€10.42 per kg) is 30 percent higher than that of non-IO cheeses (€8.11 per kg).<sup>46</sup> Further, in France, over the period of 1997-2001, total revenue from IO products increased by 6.8 percent per annum, compared with corresponding per annum growth rates of 0.7 percent, 3.7 percent and 4.2 percent for the farming sector, food industry overall, and Gross National Product, respectively (see Figure 1).<sup>47</sup>

43. Raustiala and Munzer, *supra* note 2, at 347.

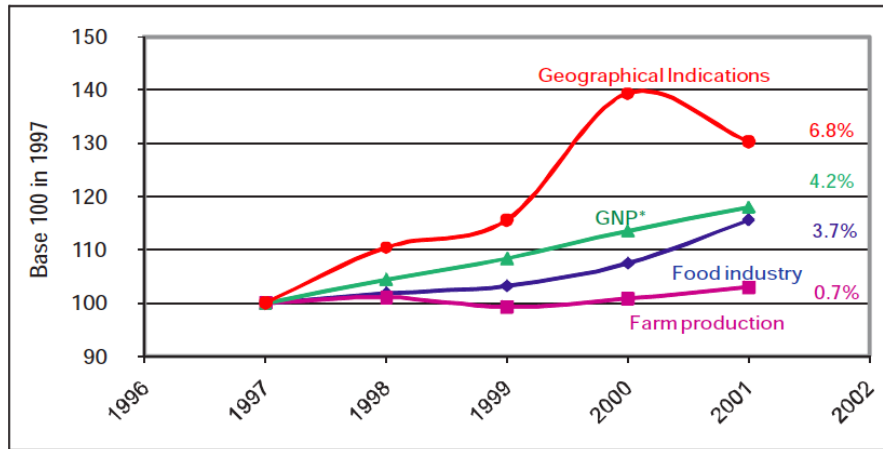
44. Roland Robertson, *Comments on the “Global Triad” and “Glocalization”* (1997), <http://www2.kokugakuin.ac.jp/ijcc/wp/global/15robertson.html> (last visited Dec. 3, 2016).

45. Giovannucci et al., *supra* note 12, at xvii.

46. *Id.* at 29.

47. *Id.* at 30. Figure 1 is a reproduction of Figure 2.4 in Giovannucci et al., *supra* note 12 at 30. It has been reproduced with permission from the International Trade Centre, Geneva, Switzerland. The full content of Giovannucci et al., *supra* note 12 is available at [www.intracen.org/publications](http://www.intracen.org/publications).





**FIGURE 1:** Selected economic growth rates, France, 1997-2001

The monetary value of IOs is not limited to France. In Vietnam, following the provision of IO protection for Phu Quoc Fish Sauce (Phu Quoc is an island in southwest Vietnam), its domestic price reportedly rose from approximately €0.50 to €1.50 per liter.<sup>48</sup> In China, my own research indicates that the average price for West Lake Longjing (a green tea from West Lake district, Zhejiang that has enjoyed IO protection since 2001)<sup>49</sup> at three randomly selected teashops in Beijing is 1,867RMB per 500g compared with 433RMB per 500g for Longjing from outside West Lake district.<sup>50</sup> It bears mentioning that all three above jurisdictions protect IOs under a *sui generis* system (with China using both *sui generis* and trademark systems). It would be interesting to compare whether or not there is a significant difference between the values of IOs protected under trademark-based systems as compared with *sui generis* systems, but that is beyond the scope of this article.

### *III.C: Approaches to protecting IOs*

As was shown in Part II, the social, cultural and economic pressures exerted by “glocalization” have not resulted in a harmonious approach to international IO agreements. Indeed, fragmentation in IO protection stems in no small part from inter-country systemic differences.

48. *Id.* at 28-29.

49. *Id.* at 29.

50. Benjamin Hopper, Fieldwork Notes for Masters Thesis at Harvard Law School, on file with author.

Countries can be divided into those, generally Old World/civil law, jurisdictions with a *sui generis* system under which unique and specific protection is provided for IOs (i.e., they are not “subsumed” within a pre-existing intellectual property regime) and those, generally New World/common law, jurisdictions that protect IOs under the pre-existing trademark regime, generally as certification trademarks<sup>51</sup> or collective trademarks.<sup>52</sup> *Sui generis* system countries tend to rely quite heavily on the concept of *terroir*: the idea that “*a particular land is a key input for a particular product.*”<sup>53</sup> By way of illustration, the European Commission drew on the concept of *terroir* in a 2005 IO food media campaign, describing “*le goût du terroir*” (i.e., “the taste of the *terroir*”) as “*a distinct, identifiable taste reminiscent of a place, region or locality . . . Foods and beverages that evoke the term terroir have signature qualities that link their taste to a specific soil with particular climate conditions. Only the land, climate and expertise of the local people can produce the product that lives up to its name.*”<sup>54</sup>

The key distinctions between a *sui generis* IO approach and a trademark approach are summarized in Table 1 below.<sup>55</sup>

Feature	Trademark approach	<i>Sui generis</i> approach
<b>Ownership</b>	Anyone. Typically individual entity or corporation, sometimes collective or government	Producers or government
<b>Alienability</b>	Yes	Linked to origin. Cannot be delocalized
<b>Rights to name</b>	First in time	Distinguishes legitimate rights to origin, irrespective of time of application
<b>Protection</b>	Private. Burden primarily on owner to enforce	Public. Burden primarily on government to enforce
<b>Use</b>	Necessary to maintenance	Collective, open to all producers who comply with rules

51. A certification mark is a mark registered by an entity that does not use the mark, but is authorized to certify that goods or services used in connection with the mark meet a certain standard, including having a particular place of origin, material and/or method of manufacture.

52. A collective mark is a mark used by members of an association to distinguish their goods or services from the goods or services of persons who are not members of the association.

53. Hughes, *supra* note 35, at 301.

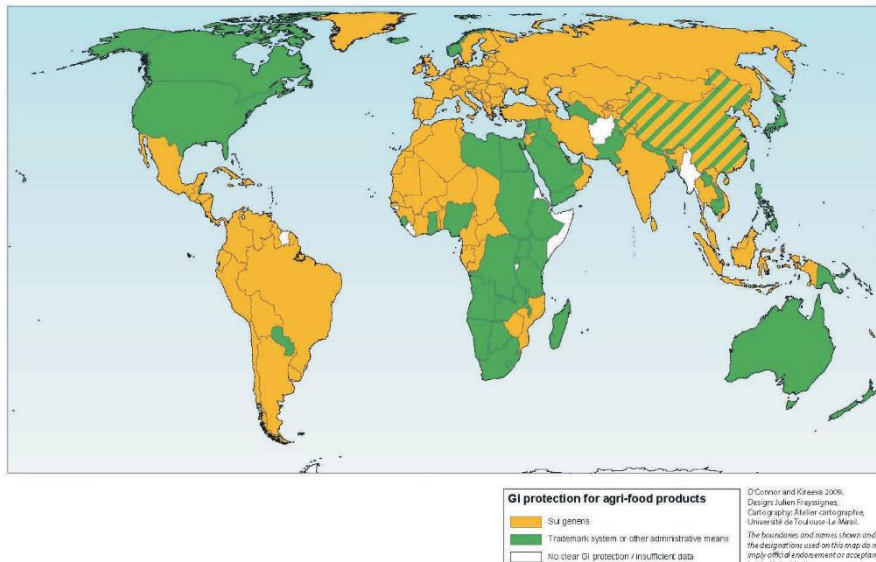
54. Cited in Raustiala and Munzer, *supra* note 2, at 344.

55. Adapted from Giovannucci et al., *supra* note 12, at 55.

Feature	Trademark approach	<i>Sui generis</i> approach
Quality	Not specified, except for some certification marks	Disclosed in standards or specifications obligatorily linked to origin
Name or sign	May be created and may or may not include geographic name	Must exist already and must link to <i>terroir</i>

**TABLE 1:** Trademark and *sui generis* approaches to IOs

Common law jurisdictions tend to prefer the trademark, private rights based approach to protecting IOs, while civil law jurisdictions tend to prefer the *sui generis* approach, under which IOs are inalienable community assets that cannot be decoupled from their origin.<sup>56</sup> This is illustrated by the map in Figure 2. The map shows that countries with a trademark approach to IOs tend to be common law jurisdictions and former colonies of the United Kingdom. One hundred and eleven countries use a *sui generis* system, while 56 countries use a trademark system.<sup>57</sup>



**FIGURE 2:** IO protection for agri-food products<sup>58</sup>

56. *Id.* at 55.

57. *Id.* at 124.

58. *Id.* at 50. Figure 2 is a reproduction of Figure 4.1 in Giovannucci et al., *supra* note 12, at 50. It has been reproduced with permission from the International Trade Centre, Geneva, Switzerland. The full content of Giovannucci et al., *supra* note 12 is available at [www.intracen.org/publications](http://www.intracen.org/publications).

Within these countries, there is a variety of mechanisms by which IO protection is provided, adding to the global fragmentation of the concept of IOs. These differences feed into differences of approach within the international IO order. While many countries agree there would be benefits to having a common international registration system, they differ on how such a system should be structured.<sup>59</sup>

### *III.D: The nation-state and IOs*

The fragmentation described above does not only flow from philosophical, systemic and economic factors. Borrowing from Arjun Appadurai's postcolonial analysis of disjuncture and difference in the global cultural economy,<sup>60</sup> the heated debate over IOs may be understood as stemming from the widening "hyphen" between nation and state in "nation-state"—<sup>61</sup>a hyphen being stretched ever further with the movement of peoples (i.e., nations) away from states in increasingly disparate directions. By way of illustration, the fame of "feta" spread with the large-scale emigration of Greeks. These emigrants made "feta" from cow's milk due to low supplies of traditional "feta" (made with sheep's and goat's milk). They continued to use the word "feta" due to its existing reputation.<sup>62</sup> Thus, the New World approach to IOs may be understood as part of an "ethnoscape" (the global, not necessarily contiguous, spaces inhabited by communities of persons who may share "imagined worlds")<sup>63</sup> of people who have migrated away from the IO territory but retained its culture, including names for particular goods from that territory. This represents the "nation" fighting against the "state", manifest in the Old World approach to IOs, whose states seek to maintain control over cultural products originating in their territories. The value of IOs to the consumer may be understood as a form of "production fetishism" —the fetish for authentic locally produced goods (often an illusion in a global economy marked by transnational production loci).<sup>64</sup> Thus, the disjuncture between nation and state is central to the global cultural flows of IOs.

59. *Id.* at 41.

60. Arjun Appadurai, *Disjuncture and Difference in the Global Cultural Economy*, 2 PUBLIC CULT., Vol. 2, No. 2, 11(1990).

61. *Id.* at 13-14.

62. O'Connor and Kireeva, *supra* note 10, at 117.

63. *Id.* at 7.

64. *Id.* at 16.

When understood in this light, the protracted and, thus far, fruitless negotiations concerning IOs at the TRIPS Council and the divergent approaches being taken by the likes of the EU and the US in various trade agreements, begin to make sense. Can a normative justification for a specific form of IO be found that might bridge the gap between migrant-receiving states (that favor a trademark approach) and migrant-sending states (that favor a *sui generis* approach)? I now turn to this fundamental and, I contend, hitherto unresolved question.

#### PART IV: DOCTRINAL AND CONCEPTUAL TENSIONS

##### *IV.A: Doctrinal and conceptual tensions*

It may be regarded as remarkable that IOs have sought to be protected as trademarks given what appear to be irreconcilable tensions between the conceptual and theoretical underpinnings for IOs and trademarks. In this part, I argue that, upon proper scrutiny, IOs and their closest cousin in the intellectual property family, trademarks, clash irreconcilably. In particular, the cognate key tenets of trademark doctrine of capacity to distinguish and “genericide” cannot be reconciled with IO’s protection for place names and refusal to accept the consequences of “genericide”.

##### *IV.B: Doctrinal and conceptual tension between IOs and trademarks*

It is a fundamental tenet of trademark law that, to be registrable, a trademark must be distinctive. This means that, on the grounds of public policy, one trader “ought not to be allowed to obtain by registration under the Trade Marks Act a monopoly in what other traders may legitimately desire to use.”<sup>65</sup> Words forming part of the common language should be free to all to use in the course of their business and no one person should be able to claim exclusive rights to dictionary words. Thus, the question of distinctiveness largely depends on “whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods.”<sup>66</sup>

It follows that “no person should be able to monopolise a place name, because the effect of registration would be to impose an unreasonable restraint upon other traders who may legitimately wish to use that name in

65. *Smith, Kline and French Laboratories Ltd v Sterling-Winthrop Group Ltd*, [1976] RPC 511, at 538–39.

66. *W & G Du Cros Ltd’s Application*, (1913) 30 RPC 660, at 672.

*relation to their own goods or services.*"<sup>67</sup> The only exception to this is where the use of a place name does not carry the signification of the place. This may arise in two circumstances: (i) the place name used in respect of the specified goods or services does not connote the place because it is an arbitrary/fanciful usage (e.g., AMAZON (a vast rainforest in South America) for an online store);<sup>68</sup> and (ii) the place name has *acquired* distinctiveness or secondary meaning, such that its use in respect of specified goods or services no longer denotes a geographical location, but rather, it denotes a particular trader and/or a particular quality or "brand" associated with a good or service (e.g., the word COLUMBIA (the name of, among other things, the largest river in the Pacific Northwest region of North America)<sup>69</sup> used in respect of sportswear has come to be associated, at least in the US, with the sportswear company originally named for the river near where the company was founded).<sup>70</sup>

The underlying reasoning has been explained as follows: "*if goods of the kind in question are produced at the particular place or in the area, or if it is reasonable to suppose that such goods in the future will be produced there, other traders have a legitimate interest in using the geographical name to identify their goods, and it is this interest which is not to be supplanted by permitting any one trader to effect trade mark registration.*"<sup>71</sup>

In stark contrast, the very purpose of an IO (be it a GI or an AOO) is to signify that the good in respect of which it is used comes from the indicated place. Thus, if an *indicium originis* functions as intended to signify a place where goods of the kind in question are produced, then it should absolutely *not* be registered as a trademark. The counter-position from a pro-IO enthusiast might be that, if a person wishes to produce goods of the kind in question at the place, then, provided certain stipulated criteria are complied with, that person may use the place name for their product. The rebuttal from the trademark perspective is threefold. First, the requirement that certain stipulated criteria be complied with infringes upon freedom of trade (i.e., freedom to manufacture as one wishes). Secondly, if the place name can be used in a manner that is distinctive (e.g., AMAZON

67. *Re Chancellor, Masters and Scholars of the University of Oxford T/A Oxford University Press v the Registrar of Trade Marks*, (1990) 24 FCR 1, at 24.

68. J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (Fourth Edition, 2016), at § 14:7.

69. WIKIPEDIA, *Columbia River*, [https://en.wikipedia.org/wiki/Columbia\\_River](https://en.wikipedia.org/wiki/Columbia_River) (last visited Dec. 3, 2016).

70. WIKIPEDIA, *Columbia Sportswear*, [https://en.wikipedia.org/wiki/Columbia\\_Sportswear](https://en.wikipedia.org/wiki/Columbia_Sportswear) (last visited Dec. 3, 2016).

71. *Re Chancellor*, *supra* note 67, at 41.

for an online store (inherent distinctiveness) or COLUMBIA for sportswear (acquired distinctiveness)), then it is unreasonable to restrain traders from using that name in good faith in that fashion. Thirdly, as explained further in Part IV.C below, if the place name has entered the common language as the name for the good, irrespective of where it is produced, no one person or association should have the monopoly over that term. The doctrinal tension between IOs and trademarks is irreconcilable.

#### *IV.C: Tension between GIs and AOOs*

As signalled above, a tension persists between a “pure” form of IOs, represented by the *sui generis* approach of AOOs, and a trademark form of IOs, represented by GIs. A GI is subject to a form of GI genericide (“geogenericide”) well captured by art. 18.32 of the TPP (discussed in Part II.D above), namely, becoming “*a term customary in common language as the common name for the relevant good.*” However, even if an AOO enters the vernacular as the common reference for the referent good, on a pure IO approach, the exclusive right to that AOO should remain with the producers in the AOO region.

For example, the word “feta” is commonly used to refer to salty, crumbly white cheese made from sheep’s and/or goat’s milk.<sup>72</sup> Some might argue that, although it has retained a cultural affiliation with Greece, the word has become so commonly used that it no longer signifies such cheese originating in Greece, but cheese with the qualities just described irrespective of the locus of production. An AOO purist would nonetheless insist that that cultural affiliation with place be retained, even if it becomes very distant. A trademark lawyer, however, would say the word has entered the common language and to grant monopoly rights to its use is anathema.<sup>73</sup>

Similarly, imagine that the word “Champagne” were to begin to signify something other than sparkling wine in the mind of the ordinary consumer. For example, through widespread colloquial usage it came to mean, “*to gather for a soirée.*” On a pure AOO approach, the consumer should be educated that the subsequent “slang” is inferior and subservient

72. See O’Connor and Kireeva, *supra* note 10, at 116-17.

73. Note: in 2005, the European Court of Justice confirmed the validity of the IO (specifically, the Protected Designation of Origin) for “feta”. See *Federal Republic of Germany and Kingdom of Denmark v. Commission of the European Communities*, E.C.R. (2005); *WORLD INTELL. PROP. ORG., DEFINING A NAME’S ORIGIN: THE CASE OF FETA*, <http://www.wipo.int/ipadvantage/en/details.jsp?id=5578> (last visited Dec. 3, 2016).

to the original place name designation for sparkling wine. On a trademark approach, this slang meaning should not be policed in any way.

These distinct approaches to geo-genericide compound the doctrinal and conceptual irreconcilability between IOs and trademarks. The source of the tension, however, is not only to be found in doctrinal differences, but also in the theoretical and philosophical underpinnings of each. These are examined in the next part of this article.

#### PART V: ELICITING THE THEORETICAL JUSTIFICATION FOR IOS

While the closest cousin of IOs are trademarks, the normative justifications of the two forms of mark are distinct and do not admit of merger. In this part, after identifying the functions of trademarks and IOs, I argue that the theoretical justifications for IOs do not lie solely in traditional theories of intellectual property (welfare, labor, personhood, and cultural theory), but also, and more significantly, are grounded in the protection, maintenance and sharing of cultural heritage.

##### *V.A: The functions and justifications of trademarks*

In a highly illuminating article, Lee Burgunder identifies three key functions of trademarks:

- (a) to enable consumers to discriminate efficiently among similar products in the marketplace with minimal private and social costs (**Distinguishing Function**);
- (b) to preserve the goodwill of traders (and, hence, foster incentives for traders to offer quality goods and services) (**Goodwill Function**); and
- (c) to allow consumers to associate goods or services in the marketplace with certain forms of information expressed in advertising (**Advertising Function**).<sup>74</sup>

Burgunder stresses that these are “*the only legitimate functions of trademarks*.”<sup>75</sup> But perhaps his point may be better put as follows: if a mark is not serving one of these functions, or another socially valuable function, then exclusive use of the mark should neither be recognized nor enforced.

To the above functions of trademarks, I would add:

- (d) to encourage the development of signs that enrich culture through free participation in semiotic democracy, i.e., in “*the process of*

<sup>74</sup> Lee B. Burgunder, *An Economic Approach to Trademark Genericism*, 23 AM. BUS. L.J. 391, at 396 (1985).

<sup>75</sup> *Id.*



*making cultural meaning*<sup>76</sup> or “*the construction of [one’s] cultural environment*” (**Cultural Function**);<sup>77</sup>

- (e) to promote social harmony through a system of registration that enables all persons in a society to know which trademarks belong to whom and which may be safely used without infringing on another’s rights (which would disturb the Goodwill Function) or causing consumer confusion (which would disturb the Distinguishing Function) (**Social Harmony Function**).

A trademark will not serve a socially valuable function if that trademark *per se* constitutes a barrier to effective competition, in which case it should be cancelled.<sup>78</sup> This happens where a trademark becomes a common descriptive name (e.g., a dictionary or “Urban Dictionary”<sup>79</sup> term for something) and ceases to signify the trader or the trader’s “brand”. If this happens, maintenance of the registration for that trademark substantially reduces substitutability, not because of the association with a particular person (who has invested in goodwill and should therefore retain the benefit of that goodwill in the form of a trademark registration), but because it has become a common word that other traders may well desire to use in the course of trade without any improper motive. This may be because the mark has become the most convenient and efficient means of communicating information about those traders’ goods or services (e.g., it is much more convenient and efficient to say “feta” than to say “white, salty, crumbly cheese made from sheep and/or goat’s milk”). In short, if the trademark becomes a common descriptive term, it is not able to fulfill the above functions and loses its *raison d’être*

Traditional theories of intellectual property help to explicate a trademark system’s functions. These are: welfare theory (or utilitarianism), labor (or just desserts) theory, personhood (or personality) theory and cultural (or social planning) theory. Each theory is briefly explained in turn before applying them to the functions of trademarks identified above.

76. William W. Fisher III, *Theories of Intellectual Property*, in *NEW ESSAYS IN THE LEGAL AND POLITICAL THEORY OF PROPERTY* 168, at 193 (Stephen R. Munzer ed., 2001), <http://elplandehiram.org/documentos/cursos/ftpi/FisherIPTheories.pdf> (last visited Dec. 3, 2016).

77. WILLIAM W. FISHER III, *PROMISES TO KEEP: TECHNOLOGY, LAW, AND THE FUTURE OF ENTERTAINMENT*, at 241 (2004).

78. Burgunder, *supra* note 74, at 396.

79. Courts are increasingly relying on Urban Dictionary in decision-making. *See, e.g.*, Leslie Kaufman, *For the Word on the Street, Courts Call Up an Online Witness*, *THE NEW YORK TIMES*, May 20, 2013, [http://www.nytimes.com/2013/05/21/business/media/urban-dictionary-finds-a-place-in-the-courtroom.html?pagewanted=all&\\_r=2](http://www.nytimes.com/2013/05/21/business/media/urban-dictionary-finds-a-place-in-the-courtroom.html?pagewanted=all&_r=2) (last visited Dec. 3, 2016).

Welfare theory (the principal theory applied to intellectual property)<sup>80</sup> notes that intellectual property comprises “public goods”, which include signs like IOs. These public goods share the attributes of being (i) non-rivalrous (use of the good by one person does not prevent use of the good by other persons) and (ii) non-excludable (once the good has been made available to one person, it is difficult, if not impossible, to prevent others from gaining access to it). These attributes mean that, without some kind of government intervention to allow recoupment of the high costs of original production, such goods may not be produced in the first place. Welfare theory suggests that one means of dealing with this public goods problem is by granting government-backed exclusive rights (e.g., intellectual property rights) to those goods. This exclusivity is justified if, and to the extent that, its benefits to society outweigh its costs (i.e., Bentham’s “*greatest good for the greatest number*”).<sup>81</sup>

Labor theory postulates that a person should acquire property rights in a thing resulting from mixing their labor with un-owned things or things held in common.<sup>82</sup> This is subject to the proviso that, after acquiring the property rights, “*there is enough and as good left in common for others.*”<sup>83</sup> Under labor theory then, a person has a natural right to their artistic or scientific creations, subject to that right not breaching the proviso.<sup>84</sup>

Personhood theory, derived from Kantian and Hegelian thought,<sup>85</sup> postulates that creators of things are entitled to considerable continuing control over their creations, where injuries to those creations injures the creator’s self, or control over those creations is part of a general project of creating and maintaining an identity.<sup>86</sup>

Cultural theory postulates that intellectual property rights should be shaped so as to foster a just and attractive culture.<sup>87</sup> As William Fisher explains, “[t]his approach is similar to utilitarianism in its teleological orientation, but dissimilar in its willingness to deploy visions of a desirable

80. Peter S. Menell, INTELLECTUAL PROPERTY: GENERAL THEORIES 129, at 130 (Boudewijn Bouckaert & Gerrit De Geest eds., Encyclopedia of Law and Economics, Volume I. The History and Methodology of Law and Economics) (2000).

81. Fisher, *supra* note 76, at 169-70; 177-84; Menell, *supra* note 80, at 130-31.

82. Robert Nozick, ANARCHY, STATE, AND UTOPIA, at 174-182 (1999).

83. John Locke, TWO TREATISES, at section 27 (P Laslett ed., 1970).

84. Fisher, *supra* note 76, at 170-71.

85. *Id.* at 171; Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L. J. 287 (1988).

86. *See* Fisher, *supra* note 76; and Hughes, *supra* note 85.

87. For more comprehensive discussions of these theories, *see* the seminal Fisher, *supra* note 76; and (on labor and personhood theories) *see* Hughes, *supra* note 85.

*society richer than the conceptions of 'social welfare' deployed by utilitarians.*"<sup>88</sup>

Applying these theories to the functions of trademarks identified above then, one can say:

- (a) welfare theory supports the trademark's Distinguishing Function, as any losses associated with the exclusive rights to a particular, distinctive mark are outweighed by the benefit to society as a whole in reducing search costs and minimizing confusion;
- (b) labor theory seems most adapted to supporting the trademark's Goodwill Function – traders' investment in building the name of their goods or services ought to be rewarded with exclusive rights in order to incentivize ongoing consistent rendering of those goods or services. Personhood theory is also relevant, particularly where personal reputation is bound up in the goodwill attaching to a trademark;
- (c) welfare theory supports the trademark's Advertising Function because of that function's contribution to minimizing search costs;
- (d) labor and cultural theory support the trademark's Cultural Function because adding to the "cultural stock" (with new signs) ought to be rewarded and it also tends to foster a just and attractive culture; and
- (e) welfare and cultural theory support the trademark's Social Harmony Function because the order of formalities is necessary to the Distinguishing Function and is also necessary to avoid the semiotic confusion that would result in the absence of formalities, upsetting the Cultural Function.

#### *V.B: The functions and justifications of IOs*

The functions of IOs are similar to, but in significant respects distinct from, those of trademarks. More importantly for present purposes, the normative justifications for them do not reside solely in traditional theories of intellectual property.

- (a) IOs serve a Distinguishing Function, but do not distinguish a particular trader or "brand"; rather, they distinguish a particular product made in a *particular place*. The normative justification for this is not a welfare theory-based benefit of minimizing search costs; rather, it may be justified on the basis of recognition

88. Fisher, *supra* note 76, at 172.

of cultural heritage. Personhood theory lends support to this function, but only to the extent that the group's personality is bound up in the land delimited by the IO and not to the extent that the personality is bound up in transportable knowledge used to make IO goods;<sup>89</sup>

- (b) IOs serve a Goodwill Function, but seek to preserve the goodwill of the community of IO good producers and not that of individual traders. As with trademarks, the normative justification for this lies in labor theory. What is rewarded is not the ancestors' labor involved in originally creating the *terroir*-based product,<sup>90</sup> but rather the current inhabitants' *maintenance* of the tradition of making that product in a *particular place*, as well as their foregoing other potentially more lucrative opportunities that could be made of that *place* such as the development of large hotel, entertainment and/or residential complexes or the building of factories or offices;<sup>91</sup>
- (c) IOs serve an Advertising Function in the sense of acting as a mnemonic for information about the IO goods, but that information pertains to the good's connection to a *particular place* (i.e., information that the IO good has a particular quality owing to its terrestrial provenance);
- (d) IOs serve a Cultural Function of a sort—not in the sense of *adding* new cultural stock; but rather in the sense of *preserving* cultural heritage linked to a *particular place*; and
- (e) IOs serve a Social Harmony Function. However, this is not justified on the basis of a first-to-use or first-to-file priority principle like trademarks; rather, it is justified on the basis that giving inhabitants of a place the exclusive right to use a place name (or place-evoking name) for a locally produced good is the best means of securing social harmony.

The principal normative justifications for IOs then are to be found not solely in traditional theories of property,<sup>92</sup> but rather in a combination of: (i) a cultural heritage theory, under which the preservation of cultural heritage is valued; (ii) labor theory, under which the sacrifice made to use the land in the interests of preserving cultural heritage is valued and (iii)

89. Cf. Raustiala and Munzer, *supra* note 2, at 358–59.

90. Contra Raustiala and Munzer, *Id.* at 354–357.

91. Cf. Justin Hughes, *Traditional Knowledge, Cultural Expression, and the Siren's Call of Property*, 49 SAN DIEGO L. REV. 1, at 29 (2013).

92. Contra Raustiala and Munzer, *supra* note 2.

personhood theory, under which a group's connection to their land is valued. On this view, irrespective of whether or not an IO becomes a common descriptive term or could be used in an arbitrary or fancy fashion that would not cause consumer confusion, it should be reserved for the current occupants of the particular place whose name forms the IO, provided it retains an intimate connection to its indicated land. Otherwise, the IO could not function as the elicited cultural heritage and labor theory justifications require. Further, the personhood theory justification for IOs provides a basis for an anti-dilution right in respect of IOs, i.e., a right to prevent use of IOs even in translated form or accompanied by terms such as "kind," "type," "make," "imitation", or the like.<sup>93</sup> This is because such use by others may tend to do injury to the community's and its members' sense of connection to their land.

The key point is that, the stronger the tie between the IO and the land, the more the grant of an exclusive IO right can be justified on the above grounds without doing harm to others' trademarks and common language use rights. Conversely, the more untethered from the land the IO becomes (i.e., the weaker its capacity to evoke a particular geographical location), the less it is justified on the above grounds. It loses its *raison d'être* and is therefore less deserving of exclusive rights. In other words, to the extent that the IO is used in respect of *knowledge* that happens to come from a particular place, it should not be protected; it should only be protected to the extent it is used in respect of its connection with the land. This is consistent with Raustalia and Munzer's finding that "*the more human factors—which are moveable—matter, the weaker is the rationale for protecting a GI only in a specified region.*"<sup>94</sup>

If an IO is closely connected to a particular delimited geographic region, the argument that persons from outside that region should be prevented from using an IO signifying a product from that region's soil gains significant force. This is because it is not possible for others to produce the same product, even using the same transportable know-how, on different soil. After all, this link to the soil lies at the core of IOs' *raison d'être*.

The desideratum of an intimate relationship with the land being a *sine qua non* of IO protection is reinforced by the following key difference between IOs and all other intellectual property rights. Whereas the "commons" for IOs (i.e., places) is limited—there are only so many places

93. WORLD INTELL. PROP. ORG., *supra* note 20 (Lisbon Agreement), at art.3.

94. Raustalia and Munzer, *supra* note 2, at 353. Note: in this quote, "GI" may be understood as equivalent in meaning to "IO" as used in this article.

in the world (or in the galaxy should production of a good move to a “*terroir*” in outer space); the commons for ideas that could form the basis for other forms of intellectual property, including trademarks, is virtually unlimited. A “loose” regime for IO protection could well result in an over-proliferation of place names being unjustifiably reserved for exclusive use.

#### PART VI: CONCLUSION – AOOs FOR ALL

The reason IO proponents’ efforts to secure a global IO system have faltered is that they have demonstrably failed to link IOs to a consistent theoretical framework and have sought to expand IOs beyond the confines of what their theoretical justification allows. This expansion has led to IO laws, including the Geneva Act, that seek to cover subject matter not justified by IOs’ normative foundation. Consequently, these laws lack “internal morality” (in the sense used by Lon Fuller).<sup>95</sup> By the same token, the US’s (and others’) efforts to “accommodate” IOs within a trademark framework is a far from ideal approach, given the irreconcilable tensions between IOs and trademarks identified in Part IV above.

In an era marked by glocalization and disjuncture, from the above analysis it follows that a unitary, harmonious and *multilateral* AOO regime should be agreed to under which protection of the kind guaranteed in the Geneva Act (see Part II.B above) is given to the subject matter of AOOs, very strictly and narrowly defined by reference to their relationship to the land. The distinction between AOOs and GIs ought to be kept clear, with GIs simply being a term for a sign consisting of or containing a toponym (or other place reference) subject to the exact same regime as any other trademark, including the doctrines of distinctiveness and genericide. Under this approach, it would be impermissible, without the authority of the AOO-owner, to use or register under the trademark system a GI containing a registered AOO, unless the use of the AOO is incidental and would not connote any relationship with the goods protected by the AOO. This approach would serve to ensure that AOO and GI laws remain true to their normative justifications, as well as providing semantic and conceptual clarity (features sorely missing from the IO debate until now).

Having concluded that an AOO should receive the strong protection afforded under the Geneva Act, but be narrowly defined, I propose the following definition. An AOO must:

95. Lon L. Fuller, *Positivism and Fidelity to Law: A Reply to Professor Hart*, 71 HARV. L. REV. 630 (1958).

- (a) consist of or contain a place name, or be a name strongly connected with the referent place in the mind of the ordinary consumer in the jurisdiction wherein the place is located [in the lattermost case, the applicant would bear the burden of proving the strong connection, for example, by clear and convincing evidence that it evokes the place in the mind of the ordinary consumer]; and
- (b) designate goods that either (i) *per se* originate from a particular place, or (ii) are made from raw materials originating in a particular place and any processing of those raw materials occurs in that place using local knowledge.

My definition of an AOO is consistent with the Lisbon Agreement's definition: "*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 human factors.*" I do allow non-toponymic AOOs, but only where there is the requisite strong connection between the AOO and the referent place. Further, I add the requirement that the product consist of, or be made from, raw materials originating from the earth of the geographical environment encompassed by the geographical denomination and, if made from raw materials, be made using local knowledge. The "local materials" and "local knowledge" elements are necessary to ensure that only AOOs with an intimate connection to the indicated land are afforded protection.

The justifications for this approach are grounded primarily in traditional trademark theory, labor theory, personhood theory and cultural heritage theory (and cultural theory more generally). If the stringent definition for AOOs set out above is applied, then it will be true that others, even transporting/planting the same raw materials to the "second-comer" region, will not be able to reproduce goods with quite the same quality or characteristics as the goods produced in the AOO-protected region, with the result that (i) using the same name for goods from a different place could genuinely lead to consumer confusion and/or harm to the IO name (e.g., a consumer tastes a different-tasting good from the second-comer region and is deceived into thinking the taste of goods from the AOO region has changed), and (ii) using the same name would undermine the efforts and sacrifices that those in the AOO-protected region have made. These efforts should be rewarded, not only because of the efforts made by the AOO-region's producers (and opportunities forgone, e.g., to develop resort complexes or mining operations), but also because they lead to the

maintenance of cultural heritage from which we all can derive value and pleasure.

While the above proposal, owing to its narrow definition of protected subject matter (AOOs) provides less protection than under the Geneva Act (which may be understood as the type of protection the EU and its AOO-allies would like to see promulgated worldwide) and uses a *sui generis*, rather than trademark, system of the kind privileged in the TPP (which may be understood as the type of protection the US and its GI-allies are willing to see promulgated worldwide), I consider that it strikes a measured, as well as doctrinally, conceptually and theoretically justified balance between pro- and anti-IO jurisdictions. By allowing trademark-based GIs to wither on the vine, while ensuring protection for AOOs strongly rooted in a particular place in the manner commended by the above analysis, the fragmented and fractious disjunctures that mark the current era of glocalization may be stemmed, resulting in greater harmony and comity in international IO law.