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Masayoshi Omachi
Japan Patent Office

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A TALE OF TWO APPROACHES: ANALYSIS OF RESPONSES TO EU'S FTA INITIATIVES ON GEOGRAPHICAL INDICATIONS (GIS)

MASAYOSHI OMACHI*

I. INTRODUCTION

European Union (“EU”) initiatives on geographical indications (“GIs”)¹ through bilateral trade agreements have been creating considerable impacts. The EU, consistently advocating strong protection of GIs in the world, including the extension of the higher-level protection as seen in the “additional protection” for wines and spirits under Article 23 of the TRIPS Agreement to GIs for other products,² clarified its position of placing an emphasis on free trade agreements (“FTAs”) to pursue its various objectives including those related to intellectual property, when it published a trade policy document in 2006.³ The EU-Korea FTA,⁴ which was signed in 2010 and commenced its provisional application in 2011, has been declared by the

* Director, 12th Board of Trial and Appeal, Trial and Appeal Department, Japan Patent Office. The views expressed in this article are the author's and are not meant to represent those of the Japan Patent Office or any other organization.

1. In this article, the term GI means “geographical indication” as defined in the Agreement on Trade-Related Aspects of Intellectual Property Rights, art. 22.1, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 308 [hereinafter “TRIPS Agreement”].

2. *See e.g.*, Special Session of the Council for Trade-Related Aspects of Intellectual Property Rights, *Geographical Indications: Communication from the European Communities*, WTO Doc. TN/IP/W/11 (June 14, 2005).

3. *See* DG TRADE, EUR. COMM'N, GLOBAL EUROPE: COMPETING IN THE WORLD 10–12 (2006). *See also infra* Part II. B.

4. Free Trade Agreement between the European Union and its Member States, of the one part, and the Republic of Korea, of the other part, EU-S. Kor., Oct. 6, 2010, 2011 O.J. (L 127) 6 [hereinafter “EU-Korea FTA”].

EU to be its first “new generation” FTA.⁵ The GI provisions of that FTA obligate South Korea to grant additional protection to GIs in the EU for agricultural products and foodstuffs, including such a term as “Φέτα” (Feta) for cheese, which is considered by the relevant industry of the U.S. to be a common (generic) name within the public domain, at least in the U.S.⁶ Thus, the GI provisions caused a sort of shockwave among New World countries like the U.S.⁷

Thereafter, international developments related to GIs in the context of FTAs can be seen in three domains: first, the completion of negotiations for subsequent EU FTAs such as the EU-Singapore FTA⁸ and the Comprehensive Economic and Trade Agreement (“CETA”) between Canada and the EU;⁹ second, the national implementation of the GI provisions of those FTAs; and third, the conclusion of the Trans-Pacific Partnership (“TPP”),¹⁰ containing GI-related provisions that can function as countermeasures against the EU’s FTA initiatives.¹¹ Both the EU-Singapore FTA and CETA have GI provisions extending higher-level protection to GIs in the EU for agricultural products and foodstuffs, but they are more sophisticated than those of the EU-Korea FTA in the sense that the

5. See DG TRADE, EUR. COMM’N, THE EU-KOREA FREE TRADE AGREEMENT IN PRACTICE 3 (2011) (calling the EU-Korea FTA “the first of a new generation of FTAs”).

6. See *infra* Part II. B.

7. See *id.* The magnitude of the impact can be seen in the request for clarification from the U.S. Government to the Korean Government concerning the FTA’s GI provisions through the letter of U.S. Trade Representative dated June 9, 2011, as explained in *infra* Part II. B, and also in the subsequent establishment in March 2012, of the Consortium for Common Food Names (“CCFN”), U.S.-based international non-profit alliance working to preserve the right to use generic food names.

8. Free Trade Agreement between the European Union and the Republic of Singapore, EU-Sing., Oct. 19, 2018, <http://trade.ec.europa.eu/doclib/press/index.cfm?id=961> (last visited Dec. 1, 2018) [hereinafter “EU-Singapore FTA”]. The FTA, initialed on September 20, 2013 (with the exception of the chapter on investment), has been separated from an investment protection agreement, which was previously a part of the proposed FTA, due to an issue regarding the competence of the EU to sign and conclude an FTA. Specifically, by 2015, a question arose, between the Commission and the European Parliament, of the one part, and the European Council and the Member States, of the other part, as to whether or not the EU had the requisite competence to sign and conclude alone an FTA. The question was examined by the Court of Justice of the European Union (“CJEU”) with respect to the proposed EU-Singapore FTA, to hold on May 16, 2017 that a majority of its provisions including those concerning intellectual property protection fall within the exclusive competence of the EU, while certain provisions related to non-direct investment between the EU and Singapore and to investor-state dispute settlement fall within a competence shared between the EU and its Member States. See Reports of Cases, Opinion 2/15 of the Court ¶ 305 (CJEU May 16, 2017), [http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:62015CV0002\(01\)&from=EN](http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:62015CV0002(01)&from=EN) (last visited Dec. 1, 2018). The FTA was finally signed on Oct. 19, 2018. See European Commission Press Release IP/18/6139, EU and Singapore forge closer economic and political ties (Oct. 19, 2018). See also 2018 O.J. (L 267) 1.

9. Comprehensive Economic and Trade Agreement (“CETA”) between Canada, of the one part, and the European Union and its Member States, of the other part, Can.-EU, Oct. 30, 2016, 2017 O.J. (L 11) 23.

10. Trans-Pacific Partnership, Feb. 4, 2016, Office of the U.S. Trade Rep. [hereinafter “TPP”].

11. See TPP, *supra* note 10, arts. 18.31, 18.32, 18.34, 18.36. See also *infra* Part III. E.

subsequent FTAs carefully strike a balance between GI beneficiaries and other stakeholders such as trademark proprietors and prior users.¹² This article covers those three domains, particularly focusing on the GI provisions of the EU-Singapore FTA and CETA and on their national implementation.

A significant point here is that the EU-Singapore FTA and CETA take different, indeed highly contrasting, approaches to striking the aforementioned balance: the approach taken in the EU-Singapore FTA can be called “rule-based” and that in CETA “solution-based.” Specifically: in the rule-based approach, while the final decision on whether or not to protect individual GIs is left to domestic procedures, the FTA provides for rules for those domestic procedures and identifies a list of individual GIs to be subject to such procedures; in the solution-based approach, FTA negotiations are conducted to find solutions for individual GIs right in the negotiations.¹³

This article looks into these two different approaches, not only by analyzing GI provisions of the two FTAs but also by digging into their national implementation in Singapore and Canada. I conclude that the former rule-based approach is conducive to solutions acceptable to varied stakeholders, if combined with mechanisms in national implementation designed to facilitate settlements among those stakeholders, as in the case of Singapore,¹⁴ while the latter solution-based approach, despite some commentators’ favorable views of the GI provisions in CETA,¹⁵ could have

12. See *infra* Part III.

13. See *infra* Part III. The two approaches identified here are relevant to concerns of the industry sector regarding the results of FTA negotiations on GIs. See Matthew Schewel, *U.S. Dairy Producers Slam CETA Deal’s Market Access, GI Provisions*, INSIDE U.S. TRADE (Oct. 25, 2013), <https://insidetrade.com/inside-us-trade/us-dairy-producers-slam-ceta-deals-market-access-gi-provisions> (describing the situation soon after the announcement of a political agreement on the key elements of CETA and before its text was made available to the public, as “U.S. industry sources said it is still unclear to them whether Canada has fully committed to protecting the list of 145 GIs, or merely committed to set up a domestic system where EU producers could try to register these GIs, though a final decision would rest with the Canadian government after receiving input from domestic and foreign producers.”).

14. See *infra* Part IV. A. 1–4.

15. See Susy Frankel, *Geographical Indications and Mega-Regional Trade Agreements and Negotiations*, in GEOGRAPHICAL INDICATIONS AT THE CROSSROADS OF TRADE, DEVELOPMENT, AND CULTURE: FOCUS ON ASIA-PACIFIC 147, 158 (Irene Calboli & Wee Loon Ng-Loy eds., 2017) (commenting that overall CETA is a well-developed compromise between the extremities of the GI debate, namely, insistence on the necessity of a *sui generis* GI system on the one hand and the view that only trademarks are appropriate and necessary, on the other). See also Irene Calboli, *Time to Say Local Cheese and Smile at Geographical Indications of Origin? – International Trade and Local Development in the United States*, 53 HOUS. L. REV. 373, 380 (2015) (remarking that the solution adopted in CETA certainly represents a win-win solution for Canada and the EU and that a similar solution could resolve the GI controversy in the Transatlantic Trade and Investment Partnership (“TTIP”)). See also Alessandra Moroni, *New Generation of Free Trade Agreements: Towards “International” European Geographical Indications*, 8 GEO. MASON J. INT’L COM. L. 286, 308 (2017) (mentioning, with respect to compromises in CETA GI provisions, that the EU and Canada have managed to reach a remarkable equilibrium despite needing to harmonize their otherwise opposing legal traditions).

problems, through “direct protection”¹⁶ of GIs in national implementation bypassing domestic procedures, as in the case of Canada, in terms of transparency and, importantly, compliance with the principle of most-favoured-nation (“MFN”) treatment stipulated in Article 4 of the TRIPS Agreement.¹⁷ This article thereby demonstrates the significance of scrutinizing FTA GI provisions from a national implementation perspective, not just focusing on the contents of the provisions themselves.

In Part II, I examine the overview of developments leading to the emergence of the EU’s first “new generation” FTA. In Part III, I analyze the GI provisions of the EU-Singapore FTA and CETA from four categories of legal perspectives, to elucidate the two contrasting approaches. Part III also considers the extent to which those approaches are in line with the GI provisions of the TPP. Part IV sheds light on the national implementation of the EU-Singapore FTA and CETA in Singapore and Canada, respectively, and discusses measures to facilitate settlement among stakeholders in Singapore’s legislation and risks observed in Canada’s that originate from direct protection of GIs. Covering the latest developments at the time of writing, Part IV also looks into Japan’s recent legislation on a *sui generis* GI protection system to accommodate the results of EU-Japan Economic Partnership Agreement (“EPA”) negotiations, to illuminate a questionable aspect of what may be called partial or modified direct protection, which has nature similar to the risks seen in Canada’s legislation. Finally, Part V draws conclusions.

II. THE EU’S THRUST FOR THE PROTECTION OF INDIVIDUAL GIS AND ISSUES INVOLVED

Part II reviews two aspects of international developments relevant to the EU’s shift from its traditional focus on efforts at multilateral fora such as the WTO to its significant emphasis on strengthening GI protection through FTAs, in particular, on securing higher protection of individual GIs listed in the annexes of FTAs.

16. In this article, the term “direct protection” means the protection, in a party to an FTA, of GIs specified in the FTA without applying procedures in the party generally required for, or entailed in, GI protection in that party. The existence or nonexistence of domestic legislation for the implementation of FTA GI provisions is not relevant.

17. *See infra* Part III. E, Part IV. B.

A. *Claw-back List and underlying Legal Issues*

The first aspect is the release of a list of the product names that the EU would like to “recuperate.” This Section looks into the list and underlying legal issues of significance.

In 2003, the EU published a list of 41 EU GIs for which the EU wanted protection outside the region, known as “the claw-back list.”¹⁸ Although the list was intended for the agriculture negotiations at the WTO, not for FTA talks, it clarified the EU’s demand for the protection of certain individual GIs in the rest of the world.

The press release of the European Commission stated that the list contained “well established European quality products whose names are being abused today” and would be negotiated in the agriculture negotiations within the Doha Development Agenda.¹⁹ It enumerated three main issues of the WTO negotiations on GIs: namely, “the claw-back of certain EU’s GIs whose names are usurped worldwide” in the agriculture negotiations, as well as the establishment of a multilateral register of GIs and the extension of the protection for wines and spirits to other products in the intellectual property negotiations.²⁰ The press release further explained that the names listed were included in the EU’s register of GIs and had been selected on the basis of the fact that, in many third countries, they were claimed to be generic terms and/or had been registered as trademarks by local producers.

The claw-back list contains 22 names of wines and spirits and 19 of agricultural products and foodstuffs.²¹ The latter includes “Feta,” “Parmigiano Reggiano,” and “Prosciutto di Parma,” all of which have faced disputes. I will focus on those three names and analyze relevant disputes, as they illustrate fundamental issues.

In relation to Prosciutto di Parma, there was a case in the U.S. involving a prior registered trademark owned by a local entity, highlighting the issue of GIs’ relationship with trademarks.²² The case involved three certification

18. See European Commission Press Release IP/03/1178, WTO talks: EU steps up bid for better protection of regional quality products (Aug. 28, 2003).

19. *Id.*

20. *Id.*

21. *Id.* The 19 names of agricultural products and foodstuffs in the claw-back list, annexed to the press release, are as follows: Asiago (Italy), Azafrán de la Mancha (Spain), Comté (France), Feta (Greece), Fontina (Italy), Gorgonzola (Italy), Grana Padano (Italy), Jijona y Turrón de Alicante (Spain), Manchego (Spain), Mortadella Bologna (Italy), Mozzarella di Bufala Campana (Italy), Parmigiano Reggiano (Italy), Pecorino Romano (Italy), Prosciutto di Parma (Italy), Prosciutto di San Daniele (Italy), Prosciutto Toscano (Italy), Queijo São Jorge (Portugal), Reblochon (France), and Roquefort (France).

22. See *Consorzio del Prosciutto di Parma v. Parma Sausage Products, Inc.*, 23 U.S.P.Q.2d 1894 (T.T.A.B. June 17, 1992). See also DEV GANGJEE, *RELOCATING THE LAW OF GEOGRAPHICAL INDICATIONS* 259 (2012).

marks, including “PARMA,” filed in the U.S. in 1984 by the Consorzio del Prosciutto di Parma (“Consorzio”), the association of the producers of prosciutto di Parma.²³ Those certification marks were denied registration due to the existing “PARMA BRAND” trademark registered in 1969 by an U.S. company established by an Italian immigrant.²⁴ Given the situation, the Consorzio filed a petition for the cancellation of the prior trademark.²⁵ The Trademark Trial and Appeal Board, however, dismissed the petition on the ground that the prior trademark was not proven to be geographically deceptive as of the date the registration was issued in 1969.²⁶ According to the Board, the Consorzio failed to prove that, in 1969 or earlier, consumers in the U.S. had recognized “Parma” as a geographic place, or that they had made an association between meat products and Parma, Italy.²⁷ Another case occurred in Canada as well in which a prior registered trademark of a local entity hindered registration of a trademark filed by the Consorzio.²⁸⁻²⁹

The most controversial name would be Feta, the original Greek indication of which is “Φέτα.”³⁰ The controversy concerns the question of whether the name is generic, i.e., a common name for the kind of cheese.³¹ This question has caused significant disputes, even within the EU.³² The term “feta” for cheese is derived from the Italian word “fetta,” meaning “slice,” which entered the Greek language in the 17th century.³³ Having finalized rules in Greece governing the production of “Feta” cheese, the Greek government applied for registration of the name as a protected designations of origin (“PDO”) in 1994 under the EC Regulation No

23. See *Consorzio del Prosciutto di Parma*, 23 U.S.P.Q.2d at 1895. The three trademarks of the Consorzio, namely, PARMA, PARMA HAM, and PROSCIUTTO DI PARMA, are registered as PARMA, 2,014,627; PARMA HAM, 2,014,628; and PROSCIUTTO DI PARMA, 2,014,629.

24. See *id.* at 1895–97.

25. See *id.*

26. See *id.* at 1894, 1900.

27. See *id.* at 1900.

28. See *Consorzio del Prosciutto di Parma v. Maple Leaf Meats, Inc.*, [2001] 2 F.C. 536 (Can.). See also GANGJEE, *supra* note 22, at 260.

29. A note is made from the perspective of the TRIPS Agreement. The prior trademarks in both cases were filed and registered before the date of application of the GI provisions of the TRIPS Agreement in both the U.S. and Canada (namely, January 1, 1996, one year after the entry into force of the Agreement, January 1, 1995). In cases like these, provided that the trademark has been applied for or registered in good faith, measures adopted to implement the GI provisions (provisions in Section 3 of Part II) of the TRIPS Agreement shall not prejudice eligibility for or the validity of the registration of the trademark, or the right to use the trademark, on the basis that such a trademark is identical with, or similar to, a GI. See TRIPS Agreement, *supra* note 1, art. 24.5. What is stipulated in the provision can be called a grandfather clause.

30. See *Joined Cases C-465/02 and C-466/02, F.G.R. v. Comm’n*, 2005 E.C.R. I-09115, ¶ 11–26.

31. See *id.* See also *infra* note 62.

32. See MICHAEL BLAKENEY, *THE PROTECTION OF GEOGRAPHICAL INDICATION: LAW AND PRACTICE* 92–95 (2014).

33. See *Joined Cases C-465/02 and C-466/02, F.G.R. v. Comm’n*, 2005 E.C.R. I-09115, ¶ 46.

2081/92,³⁴ ³⁵ the current version of which is Regulation (EU) No 1151/2012³⁶ (“EU Regulation”) applicable to GIs.³⁷ In 1996, the European Commission had the name registered for cheese as a PDO.³⁸ Subsequently in 1999, however, the European Court of Justice (“ECJ”) annulled the registration in relation to the question of whether “feta” was a generic name.³⁹ The Commission once again registered the name as a PDO, after reaching the conclusion that it was not generic.⁴⁰ Germany and Denmark applied before the ECJ for annulment of the registration, and the Commission contended (Joined Cases C-465/02 and C-466/02).⁴¹ The ECJ noted in its Grand Chamber ruling in 2005 that, although the production in the other countries than Greece had been relatively large and of substantial duration, the production of feta had remained concentrated in Greece.⁴² With regard to the consumers’ recognition as to whether the name was generic, the Court acknowledged that, while the majority of consumers in Greece considered that the name “feta” carried a geographical and not a generic connotation, in Denmark the majority of consumers believed that the name was generic.⁴³ Based on the evidence adduced to the Court, it found that, in Member States other than Greece, feta was commonly marketed with labels referring to Greek cultural traditions and civilization.⁴⁴ The Court considered it legitimate to infer therefrom that consumers in those Member States perceived feta as a cheese associated with Greece, even if in reality it had been produced in another Member State.⁴⁵ On the ground of those findings, the Court concluded that the name “feta” was not generic in nature.⁴⁶

34. Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs [hereinafter “EC Regulation”].

35. See Joined Cases C-465/02 and C-466/02, F.G.R. v. Comm’n, 2005 E.C.R. I-09115, ¶¶ 11, 52.

36. Regulation (EU) No 1151/12 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs, 2012 O.J. (L 343) 1, <http://eurlex.europa.eu/legal-content/en/TXT/?uri=CELEX%3A32012R1151> [hereinafter “EU Regulation”].

37. The subject matter protected under the EU Regulation includes protected designations of origin (“PDO”) and protected geographical indications (“PGI”), with the former having stricter requirements than the latter in terms of linkage between products and their geographical origins. In this article, no distinction is made between the two and both are referred to generally as GIs, unless specifically mentioned. See *id.*

38. See Joined Cases C-465/02 and C-466/02, F.G.R. v. Comm’n, 2005 E.C.R. I-09115, ¶ 12.

39. See *id.* at ¶¶ 13–15.

40. See *id.* at ¶¶ 17–22.

41. See *id.* at ¶¶ 23–25.

42. *Id.* at ¶ 83.

43. *Id.* at ¶ 86.

44. *Id.* at ¶ 87. See also *infra* Part IV. A. 3, explaining GI Act 2014 of Singapore, § 41(2).

45. See Joined Cases C-465/02 and C-466/02, F.G.R. v. Comm’n, 2005 E.C.R. I-09115, ¶ 87.

46. See *id.* at ¶¶ 87, 88, 100.

The name “Parmigiano Reggiano,” and “Parmesan” related thereto, illustrate a sensitive issue on a compound term (multi-component term), which is the question of whether a component of a GI or a possible translation thereof is generic or not. In its 2008 Grand Chamber judgment⁴⁷ the ECJ ruled that the “use of the word ‘Parmesan’ for cheese which does not comply with the specification for the PDO ‘Parmigiano Reggiano’ must be regarded for the purposes of the present proceedings as infringing the protection provided for that PDO under Article 13(1)(b) of Regulation No 2081/92.”⁴⁸ This was on the ground that the use of the name “Parmesan” must be regarded as an evocation of the PDO “Parmigiano Reggiano” in light of conceptual proximity between those two terms as well as phonetic and visual similarity, and that the name “Parmesan” had not been proven to have become generic. With respect to the evocation, Article 13(1)(b) of the EC Regulation No 2081/92 protected registered names against any misuse, imitation or evocation, as is the case also under the current EU Regulation No 1151/2012.⁴⁹ With regard to the assessment of the generic character of the term “Parmesan,” the Court pointed out the failure of Germany, the defendant, to present sufficient evidence to show that, and went on to state that, in Germany, certain producers of cheese called “Parmesan” marketed that product with labels referring to Italian cultural traditions and landscapes.⁵⁰ The Court considered it to be legitimate to infer from this that consumers in Germany perceived “Parmesan” cheese as a cheese associated with Italy, even if in reality it had been produced in another Member State.⁵¹ As for the question of whether or not the name “Parmesan” is a translation of the PDO “Parmigiano Reggiano,” although it was at issue in the present case, the Court did not make a judgment on that, as it regarded the use of the name “Parmesan” as an evocation of the PDO “Parmigiano Reggiano” and therefore considered that the question was of no relevance for the assessment of the present action.⁵²

As explained above, the three names in the claw-back list illustrate underlying legal issues: the name “Prosciutto di Parma” illustrates relationship between a GI and a prior conflicting trademark, “Feta” the question of whether a GI is generic or not in a certain territory, and “Parmigiano Reggiano” the issue of whether a GI-related term (a component

47. Case C-132/05, *Comm’n v. F.G.R.*, 2008 E.C.R. I-00957.

48. *See id.* at ¶ 57.

49. *See* EU Regulation, *supra* note 36, art. 13(1)(b).

50. *See* Case C-132/05, *Comm’n v. F.G.R.*, 2008 E.C.R. I-00957 at ¶¶ 54, 55.

51. *See id.* at ¶ 55.

52. *See id.* at ¶ 50.

of a compound GI or a possible translation of a GI) is within the public domain or not.

A note of the claw-back list clarifies the EU's intention that the protection proposed also covers "translations," such as "Parma ham" and "Parmesan/o," as well as transliterations in other alphabets.⁵³

People in the rest of the world potentially affected by the claw-back, if it leads to the ban on the use of the GIs in the EU for products not originating in the registered regions, include three kinds of parties. The first category is prior users, in particular, those who have been using GIs in the EU or their translations, or their components where GIs in question are compound terms, believing that they are generic in the countries of those prior users. The second is the holders of conflicting trademarks. The third is consumers who may no longer be able to select goods based on the marks they have been accustomed to. The disadvantages of those parties could be possibly brought about by the claw-back.

B. Creation of the "Global Europe" Strategy and the Conclusion of the EU-Korea FTA

The second aspect of the developments is the EU's increased emphasis on FTAs, in the context of which FTAs have been utilized for the protection of individual GIs including those in the claw-back list, amid prolonged contention at the multilateral forum.

In 2006, the European Commission published a trade policy document "Global Europe: Competing in the World." The document, on the one hand, emphasized the role of the WTO saying that the principal, substantive means of achieving the EU's goals remained through the system of multilateral negotiation, on the other hand, placed importance on FTAs. Specifically, it stated that many key issues, including investment, public procurement, competition, other regulatory issues and IPR enforcement, could be addressed through FTAs and that FTAs should include stronger provisions for IPR and competition.⁵⁴ It declared that the EU would make proposals for a "new generation" of carefully selected and prioritized FTAs.⁵⁵

The first of the new generation FTAs under the Global Europe strategy is said to be the aforementioned EU-Korea FTA,⁵⁶ which provides for the protection of individual GIs for agricultural products and foodstuffs listed in

53. European Commission Press Release, *supra* note 18, n.1.

54. See DG TRADE, EUR. COMM'N, *supra* note 3, at 10–11.

55. See *id.* at 15.

56. See DG TRADE, EUR. COMM'N, *supra* note 5, at 3.

its Annex 10-A comparable to the level of the additional protection stipulated in Article 23 of the TRIPS Agreement.⁵⁷ The prohibition of the use of a protected GI covers its transcription as well as translation.⁵⁸ The annex lists 60 GIs of the EU side and 63 of the Korean side for agricultural products and foodstuffs including all of the 19 GIs in the EU's claw-back list discussed in the previous Section A (although some names have certain differences in expression).

In the case of the EU-Korea FTA, no opportunity was provided for third parties to object to the protection of EU GIs listed in its annex, throughout the period after the conclusion of negotiations to initialing on October 15, 2009, signing on October 6, 2010, and the provisional application of the FTA on July 1, 2011. This is, on its face, at odds with the Korea's FTA with the U.S. ("KORUS FTA")⁵⁹ entering into force subsequently on March 15, 2012, which obligates a Party providing the means to apply for protection or petition for recognition of GIs, through a system of protection of trademarks or otherwise, to publish GI applications and petitions for opposition, and to provide procedures for opposing GIs that are the subject of applications or petitions as well as procedures to cancel a registration resulting from an application or a petition.⁶⁰ In Korea, on September 5, 2011 after the provisional application of the EU-Korea FTA, the Ministry of Foreign Affairs and Trade established rules of procedure on opposing GIs to be protected through trade agreements.⁶¹ Since the date of the establishment of the rule, it has provided the procedure for opposing GI protection based on FTAs, and it is to be applied to the later addition of GIs for protection under the EU-Korea FTA. As for the GIs listed in the annexes to the FTA from the beginning, however, they are not the subject of the opposition procedure provided for in the rule, as they had been agreed on before the establishment of the rule.

57. See EU-Korea FTA, *supra* note 4, arts. 10.21.1(b), 10.23.

58. See *id.*

59. Free Trade Agreement between the United States of America and the Republic of Korea, S. Kor.-U.S., June 30, 2007, Office of the U.S. Trade Rep. [hereinafter "KORUS FTA"].

60. See *id.* art. 18.2.14(e). Although the lack of opportunities for opposing GIs protected under the EU-Korea FTA appears to be inconsistent with the provision of the KORUS FTA obligating the Parties to provide procedures for opposing GIs that are the subject of applications or petitions, it is not necessarily the case for the following reasons: (i) the KORUS FTA was not in force on the date of provisional application of the EU-Korea FTA (July 1, 2011); and (ii) since agreeing to protect GIs under the FTA is not an ordinary domestic process, one could argue that those GIs were not the subject of applications or petitions.

61. Tongsanghyeopjeong-eul tonghae bohodoeneun jirijeok pyosuiui iuijegi jeolcha gyujeong [Rules of Procedure on Opposing Geographical Indications to be Protected through Trade Agreements], Ministry of Foreign Affairs and Trade Decree No. 190, Sept. 5, 2011 (S. Kor.), <http://law.go.kr/admRulInfoP.do?admRulSeq=2000000016993> (last visited Dec. 1, 2018).

The EU-Korea FTA does not have any specific provision on generic terms, and its Annex lists all the 19 names in the claw-back list for agricultural products and foodstuffs, including “Φέτα” (Feta), which is considered by the relevant industry of the U.S. to be a generic term.⁶²

Following those developments, the U.S. Trade Representative sent a letter to his Korean counterpart on June 9, 2011, prior to approval of the KORUS FTA by Congress, inquiring as to whether there were “additional updates or clarifications” with respect to the GI provisions of the EU-Korea FTA.⁶³ The letter states “our Congress, as well as U.S. industry, continues to raise questions and concerns regarding the provisions of your FTA with the European Union that pertain to geographical indications.”⁶⁴ In reply, the Korean side explained that the individual components (such as “parmigiano”) themselves of compound terms in the listed GIs, including their translation or transliteration, were not the objects of GI protection under the KORUS FTA.⁶⁵ In this relation, the reply illustrated the Korean government’s understanding that the terms (components of GIs) “camembert,” “mozzarella,” “emmental,” and “brie,” in either the English or Korean languages, were generic terms indicating types of cheeses in Korea, and that the use of these terms was therefore not restricted as a result of the FTA, and further mentioned that these terms were merely illustrative examples, not an exhaustive list of generic terms in Korea.⁶⁶ Additionally, the Government of Australia, sent a letter to the Government of Korea, on March 20, 2014, asking for clarification regarding the GI provisions of the EU-Korea FTA, in response to which a similar reply was sent four days later on March 24.⁶⁷

62. See EU-Korea FTA, Part A of Annex 10-A. See also letter sent under the joint signatures of 55 Senators of the U.S. Congress to Tom Vilsack, the Secretary of the U.S. Department of Agriculture, and Michael Froman, the U.S. Trade Representative (Mar. 11, 2014), http://www.commonfoodnames.com/wp-content/uploads/03112014_USDAUSTR_CheeseLetter2.pdf (last visited Dec. 1, 2018) (writing, in relation to CETA, “Common names for products such as ‘feta’ are clearly generic in Canada, as they are in many other countries.”). The letter is further explained in *infra* Part III. C.

63. Letter from Ron Kirk, U.S. Trade Representative, to Jong-Hoon Kim, Minister of Trade, Korea (June 9, 2011), <https://ustr.gov/sites/default/files/uploads/pdfs/PDFs/December%202012/060911%20Kirk-Kim%20Letter%20on%20GIs.PDF> (last visited Dec. 1, 2018).

64. *Id.*

65. Letter from Jong-Hoon Kim to Ron Kirk (June 20, 2011), <https://ustr.gov/sites/default/files/uploads/pdfs/PDFs/December%202012/062011%20Kim-Kirk%20Letter%20on%20GIs.pdf> (last visited Dec. 1, 2018).

66. *Id.* Those terms are components of compound-term GIs listed in Annex 10-A of the EU-Korea FTA. See EU-Korea FTA, *supra* note 4, Annex 10-A. The corresponding GIs are “Camembert de Normandie,” “Mozzarella di Bufala Campana,” “Emmental de Savoie,” and “Brie de Meaux.”

67. See letter from Taehee Woo, Assistant Minister for Trade, Ministry of Trade, Industry and Energy, Korea, to Jan Adams, Deputy Secretary, Department of Foreign Affairs and Trade, Australia

The developments above testify the magnitude of the EU-Korea FTA and also imply the desirability of provisions addressing better the interests of relevant stakeholders.

III. ANALYSIS OF THE GI PROVISIONS OF THE EU-SINGAPORE FTA AND CETA

Part III analyzes the GI provisions of the EU-Singapore FTA and CETA. An aspect common to both FTAs, as well as the aforementioned EU-Korea FTA, is that the parties other than the EU have FTAs with the U.S.

In view of discussion on underlying legal issues in Part II, comparative analysis is made in accordance with the following four perspectives: (i) level of protection of GIs for agricultural products and foodstuffs, including the question of extending GI protection to a translation; (ii) relationship between GIs and trademarks; (iii) handling of terms of generic nature and compound terms (multi-component terms), and (iv) existence of opposition opportunities and cancellation possibilities.

The EU and the U.S. have fundamentally different positions on the relationship between GIs and trademarks, specifically the relationship between GIs and prior trademarks. The U.S. promotes the “first in time, first in right” (“FITFIR”) principle, as seen in the provisions of the TPP,⁶⁸ to which the U.S. was a negotiating party. The FITFIR principle consists of the principle of priority, under which the sign that is protected first, whether it is a trademark or a GI, shall take precedence over any conflicting subsequent sign, and the principle of exclusivity, under which the former sign shall prevent the use of the latter.⁶⁹ The exclusivity aspect of the FITFIR principle allows the owner of a prior registered trademark to prevent all third parties not having the owner’s consent from using signs identical or similar to the trademark for identical or similar goods or services where such use would

(Mar. 24, 2014), <https://dfat.gov.au/trade/agreements/kafta/Documents/letter-on-geographical-indications-korea.pdf> (last visited Jan. 8, 2018). The exchange of letters between Australia and Korea, then on the EU-Korea FTA, is considered to be related to the signing of the eventual Australia-Korea FTA on April 8, 2014.

68. See TPP, *supra* note 10, art. 18.32.1 for the priority aspect of the FITFIR principle. The priority aspect, as stipulated in the provision, requires a party protecting or recognizing a GI through administrative procedures to provide procedures that allow interested persons to object to the protection or recognition of a GI on the grounds that, *inter alia*, the GI is likely to cause confusion with a prior trademark. See *infra* Part III. E. See also TPP, *supra* note 10, art. 18.20 for the exclusivity aspect of the FITFIR principle, providing for the exclusive right of the owner of a registered trademark to prevent third parties without the owner’s consent from using in the course of trade identical or similar signs, including subsequent GIs, for goods or services that are related to those goods or services in respect of which the owner’s trademark is registered, where such use would result in a likelihood of confusion.

69. See GANGJEE, *supra* note 22, at 257.

result in a likelihood of confusion.⁷⁰ Therefore, registration and use of a later GI with the consent of the owner of a prior trademark is not contrary to its exclusivity under the FITFIR principle. This point will be referred to later particularly in relation to the EU-Singapore FTA and the Singapore's GI legislation. In contrast to the U.S. position, the EU takes the position, under the aforementioned EU Regulation, that the existence of a prior trademark applied for in good faith earlier than a GI should not prevent the later GI from registration and both the trademark (with no grounds for its invalidity or revocation) and the GI should coexist unless, in the light of a trademark's reputation and renown and the length of time it has been used, registration of the GI would be liable to mislead the consumer as to the true identity of the product.⁷¹ The EU's rule allowing coexistence of a later GI with a prior trademark was scrutinized in terms of its compliance with Article 16.1 of the TRIPS Agreement in a WTO dispute settlement case DS 174/290,⁷² in which the complainants were the U.S. and Australia respectively and the respondent was the European Communities ("EC"). The Panel of the case, in its carefully-reasoned report adopted in 2005, decided that the EC Regulation No 2081/92 was inconsistent with Article 16.1 of the TRIPS Agreement with respect to the coexistence of GIs with prior trademarks but this was justified by Article 17 of the Agreement providing for exceptions to the exclusive right of trademarks.⁷³ While the WTO dispute settlement case sorted out legal issues and set an important precedent for the GI-trademark relationship, it cannot be said that a global consensus has been formed as to the extent, if any, to which the coexistence of a GI with a prior trademark

70. See TPP, *supra* note 10, art. 18.20; TRIPS Agreement, *supra* note 1, art. 16.1.

71. See EU Regulation, *supra* note 36, arts. 6(4), 14(2).

72. *European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs*. DS174 is for the dispute between the U.S. and the EC and DS290 between Australia and the EC. The complaint concerned the EC Regulation No 2081/92, the then effective predecessor of the EU Regulation No 1151/2012.

73. See Panel Report, *European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs*, ¶ 7.688, WTO Doc. WT/DS174/R (adopted Apr. 20, 2005). The Panel considered that the EC Regulation created a "limited exception" within the meaning of Article 17 of the TRIPS Agreement and that the exception took account of the "legitimate interests of the owner of the trademark and of third parties" within the meaning of Article 17, pointing out, *inter alia*, the following findings: (i) The Regulation only curtails the trademark owner's right to prevent the use of an indication registered as a GI on a good in accordance with its registration; the trademark owner retains the right to prevent the use of a name registered as a GI by any person in relation to any goods which originate in a different geographical area or which do not comply with the specifications. See *id.* ¶¶ 7.656, 7.657, 7.659; (ii) Relevant provisions of the Regulation including Article 14(3) can ensure that, in cases where the likelihood of confusion is "relatively high," the coexistence does not apply. See *id.* ¶ 7.658; and (iii) Under the Regulation, the legitimate interests of the trademark owner can be taken into account through the system of objection to GI registration. See *id.* ¶ 7.665. It is noted, therefore, that coexistence-allowing legislation without such mechanisms cannot be considered to have been given endorsement with respect to TRIPS compliance by the Panel decision.

should be allowed. This situation leaves room for FTAs to set rules dealing with the coexistence issue.

In relation to the above (iii), it is noted that, while the EU Regulation provides that generic terms⁷⁴ shall not be registered as PDOs or PGIs,⁷⁵ it also provides that PDOs and PGIs shall not become generic.⁷⁶ In contrast, the TPP stipulates the obligation of a Party to provide not only the opposition procedure but also the cancellation procedure on the ground that a GI is a generic term.⁷⁷

In discussions below, the expression “direct protection” means the protection, in a party to an FTA, of GIs specified in the FTA without applying procedures in the party generally required for, or entailed in, GI protection in that party, such as the process of receiving applications for registration and the opposition procedure based on domestic laws and regulations.⁷⁸ The direct protection feature can be seen in CETA as well as in the EU-Korea FTA.

A. *Issue 1: Level of Protection of GIs for Agricultural Products and Foodstuffs*

The level of protection of GIs for agricultural products and foodstuffs in the EU-Singapore FTA and CETA is at the level of additional protection provided for in Article 23 of the TRIPS Agreement,⁷⁹ as is the case with the EU-Korea FTA.

In this relation, it should be noted that some limitations to the enhanced level of protection not provided for in the EU-Korea FTA are incorporated into the EU-Singapore FTA and CETA in different ways as follows:

In the EU-Singapore FTA, apart from the fact that GI protection is granted only after the opposition procedure, it is stipulated as a general note that the matter of whether or not a GI is used in translation is assessed on a

74. See EU Regulation, *supra* note 36, art. 3(6) (defining “generic terms” as “the names of products which, although relating to the place, region or country where the product was originally produced or marketed, have become the common name of a product in the Union.”).

75. See *id.* art. 6(1). With regard to PDOs and PGIs, see *supra* note 37.

76. See *id.* art. 13(2).

77. See TPP, *supra* note 10, art. 18.32.1(c), 18.32.2.

78. See *supra* note 16.

79. See EU-Singapore FTA, *supra* note 8, arts. 10.19.3, 10.21.1; CETA, *supra* note 9, art. 20.19.2(a), 20.19.3, 20.19.6. Protection of a GI against its “evocation,” which is stipulated in art. 13(1)(b) of the EU Regulation and exceeds the level of protection through Article 23 of the TRIPS Agreement, is not provided for in the EU-Singapore FTA and CETA as well as in the EU-Korea FTA.

case-by-case basis.⁸⁰ In response to this, as discussed in detail in Part IV below, Singapore's newly enacted implementing law, namely, Geographical Indications Act 2014 ("GI Act 2014")⁸¹, provides that any person may request that a qualification, of the rights conferred in respect of a registered GI, be entered in the register in relation to any term which may be a possible translation of the GI.⁸² This could be a mechanism based on which the scope of protection for contentious GIs would be made clear through actions of stakeholders under the national legal system.

In contrast, CETA provides for exception to the enhanced level of protection vis-à-vis certain individual GIs, right in the agreement itself, utilizing grandfather clauses and a list of terms⁸³ exempted from protection, as will further be elaborated in Section C below.

In the EU-Singapore FTAs, the protection extends to like goods,⁸⁴ similar to that in the EU-Korea FTA. In the EU-Singapore FTA, it is further made clear in its footnote that the term "like good" means "a good that would fall within the same category of good in that Party's register as the good for which a [GI] has been registered."⁸⁵ The FTA also stipulates that the "systems for the registration and protection of [GIs]" to be established under the FTA are "for such categories of wines and spirits and agricultural products and foodstuffs as [each Party] deems appropriate."⁸⁶ Such selected categories of agricultural products and foodstuffs are specified in Singapore's GI Act of 2014.⁸⁷

In CETA, the scope of protection is specified in the FTA itself in a concrete manner. The protection of a GI listed in its annex extends to a product that falls within the "product class" specified for that GI in the annex.⁸⁸ In total, 22 product classes are listed including "fresh, frozen and processed meats," "dry-cured meats," "cheeses," and "beer." Each of the GIs listed in the annex has a product class.

80. See EU-Singapore FTA, *supra* note 8, art. 10.19.3, n.17. The footnote further mentions that the provision on the protection of a GI against the use of its translated term does not apply where evidence is provided that there is no link between the protected GI and the translated term.

81. Geographical Indications Act 2014 (Act No. 19/2014) (Sing.) [hereinafter "GI Act 2014"].

82. See *id.* § 46(1), (2), (5), (7).

83. See CETA, *supra* note 9, Annex 20-B.

84. See EU-Singapore FTA, *supra* note 8, arts. 10.19.3, 10.21.1.

85. *Id.* art.10.19.3, n.16.

86. *Id.* art. 10.17.1.

87. See GI Act 2014, *supra* note 81, § 4(6), Schedule (listing 12 categories of agricultural products and foodstuffs, as well as wines and spirits.)

88. CETA, *supra* note 9, art. 20.19.2(a), Annex 20-A. All the product classes are listed in its Annex 20-C.

CETA stipulates, unlike the EU-Singapore FTA, the obligation of a Party to protect a GI of the other Party against its use for a product that “does originate in the place of origin specified in Annex 20-A for that [GI] but was not produced or manufactured in accordance with the laws and regulations of the other Party that would apply if the product were for consumption in the other Party.”⁸⁹ The provision would require a Party to CETA to provide the legal means for interested persons to prevent the use of a GI of the other Party for a product, on the ground that the product was not produced or manufactured in accordance with applicable laws and regulations of the other Party, even if the laws and regulations do not necessarily pertain to GIs, in light of the absence of limitation in the CETA text with regard to the nature of such laws and regulations. This could produce an effect of substantially exporting possibly non-GI laws and regulations (e.g., in food hygiene) via the GI provision, in the sense that the CETA GI provision could force a Party to apply the other Party’s laws and regulations to a product imported from that other Party, vis-à-vis the permissibility to use a GI of the other Party for that product. In response to the provision in CETA, the Trade-marks Act of Canada was amended on September 21, 2017 to include a provision prohibiting the use of, in connection with a business, a protected GI in respect of an “agricultural product or food belonging to the same category that originates in the territory indicated by the protected [GI] if that agricultural product or food was not produced or manufactured in accordance with the law applicable to that territory.”⁹⁰

As for enforcement, both of the FTAs, like the EU-Korea FTA, provide for civil remedies including injunctions and damages and provisional measures with respect to intellectual property rights including those for GIs.⁹¹ Both of the EU-Singapore FTA and CETA have provisions on border measures with respect to suspect “counterfeit geographical indication goods,”⁹² a feature nonexistent in the EU-Korea FTA. CETA goes further in obligating its Parties to provide for enforcement by administrative action with regard to a food commodity. Specifically, CETA stipulates that each Party shall provide for enforcement by administrative action, to the extent provided for by its domestic law, to prohibit a person from manufacturing,

89. *Id.* art. 20.19.2(a)(ii).

90. Trade-marks Act, R.S.C. 1985, c. T-13, § 11.15(3)(a) (Can.). For further explanation of the Trade-marks act *see infra* Part IV. B .

91. *See* EU-Korea FTA, *supra* note 4, arts. 10.41.1, 10.44.1, 10.46.1, 10.48.1, 10.50.1; EU-Singapore FTA, *supra* note 8, arts. 10.38.1, 10.38.2, 10.39.1, 10.39.2, 10.42, 10.44.1; CETA, *supra* note 9, arts. 20.32.4, 20.35.1, 20.37.1, 20.39.1, 20.40.1.

92. *See* EU-Singapore FTA, *supra* note 8, arts. 10.48(a), 10.49.1, 10.49.2, 10.49.4; CETA, *supra* note 9, art. 20.43.1, 20.43.2, 20.43.4, 20.43.5.

preparing, packaging, labeling, selling or importing or advertising a food commodity in a manner that is false, misleading or deceptive or is likely to create an erroneous impression regarding its origin.⁹³ In this relation, CETA also stipulates that each Party will provide for administrative action in respect of complaints related to the labeling of products.⁹⁴

The numbers of GIs for agricultural products and foodstuffs listed in the annexes of the FTAs, when a term shown as an item in a list is counted as one GI, are as follows: while the EU-Korea FTA specifies 60 GIs in the EU and 63 in Korea, the EU-Singapore FTA names 84 GIs in the EU (before going through the national process including the objection procedure) and none for Singapore, and CETA designates 171 GIs in the EU and none for Canada. Each of those annexes contains all of the 19 names for agricultural products and foodstuffs in the EU's claw-back list, although those in the Annex 10-A of the EU-Singapore FTA are subject to the national process in Singapore and those in Annex 20-A of CETA are subject to certain limitations as mentioned. As the EU-Singapore FTA and CETA do not list GIs in Singapore and Canada, respectively, it seems evident that GI provisions of those FTAs for the protection of individual GIs have resulted solely from the request of the EU.

Both of the FTAs, like the EU-Korea FTA, provide for the possibility of amending the list of GIs upon agreement of the Parties, allowing them to add GIs, or remove GIs which have ceased to be protected or have fallen into disuse in their places of origin.⁹⁵

B. Issue 2: Relationship between GIs and Trademarks

With regard to the relationship between GIs and trademarks, neither the EU-Singapore FTA, CETA, or EU-Korea FTA have a provision obligating Parties to have a coexistence regime provided for in the EU Regulation described earlier in this Part, namely, a provision to protect, unless certain conditions are met, a later GI conflicting with a trademark which has been applied for or registered in good faith before the date of application for the protection of the GI. This is not surprising, as Singapore and Korea have also concluded FTAs with the U.S. having provisions on the basis of the FITFIR principle,⁹⁶ and Canada and Singapore are parties to the TPP stipulating that

93. See CETA, *supra* note 9, art. 20.19.4.

94. See *id.* art. 20.19.5.

95. See EU-Korea FTA, *supra* note 4, art. 10.24.1, 10.25.3; EU-Singapore FTA, *supra* note 8, art. 10.18; CETA, *supra* note 9, art. 20.22.1. With regard to the matter related to cancellation of GI protection at the request of third parties, see *infra* Part III. D.

96. See KORUS FTA, *supra* note 59, art. 18.2.4, 18.2.15 and United States-Singapore Free Trade Agreement, art. 16.2.2, Sing.-U.S., May 6, 2003, Office of the U.S. Trade Rep.

principle.⁹⁷ Providing for a rule in an FTA in conflict with the FITFIR principle would bring about inconsistency among FTAs concluded by a nation.

Apart from that, an issue to be addressed is the conflict between individual GIs and trademarks, namely, the conflict between a GI in a list of GIs whose protection is sought by the EU in a FTA negotiation and its prior conflicting trademark(s) in a negotiating partner. In such conflict, provided that the prior trademark has no ground for invalidation, such as the ground that the trademark is geographically deceptive, options for addressing the conflict include: (i) the rejection of request for the GI protection; (ii) GI protection against the will of the prior trademark owner; and (iii) GI protection with the trademark owner's consent after certain negotiation with that trademark owner. The mere pursuit of the option (i) would make it difficult to reach an agreement with the EU and the adoption of the option (ii) would run counter to the FITFIR principle. In light of this, it can be said that the option (iii) would be a solution to seek, provided that such a negotiation process is appropriate. Both the EU-Singapore FTA and CETA seem to be aiming at the option (iii), but with different methodologies.

In the EU-Singapore FTA, it is made clear that in the case of Singapore, a subsequent GI is capable of being registered with the consent of the prior existing trademark rights holder,⁹⁸ although there is no provision on the definition of prior conflicting trademark in the FTA itself. In this context, Singapore's GI Act 2014, the domestic implementing law, has detailed provisions aimed at the resolution of conflicts regarding individual GIs based on negotiations by relevant parties through the opposition procedure in Singapore. This point will be further explained in Part IV. A. 2.

In contrast, CETA shows the result of negotiations addressing the relationship of prior conflicting trademarks and subsequent GIs, instead of rules governing the relationship. With regard to CETA, the European Commission explains, "thanks to the agreement, some prominent EU GIs such as Prosciutto di Parma and Prosciutto di San Daniele will finally be authorised to use their name when sold in Canada, which was not the case for more than 20 years."⁹⁹ The Commission specifies five EU GIs including the above "Prosciutto di Parma" and states that those GIs "conflicting with prior Canadian trademarks will coexist with these existing trademarks."¹⁰⁰

97. See TPP, *supra* note 10, arts. 18.20, 18.32.1. See also *supra* note 68.

98. See EU-Singapore FTA, *supra* note 8, art. 10.21.2, n.19.

99. European Commission Memorandum MEMO/13/911, Facts and figures of the EU-Canada Free Trade deal (Oct. 18, 2013).

100. Eur. Comm'n, *CETA – Summary of the Final Negotiating Results* 15 (Feb. 2016), available at https://trade.ec.europa.eu/doclib/docs/2014/december/tradoc_152982.pdf (last visited Dec. 1, 2018). The

“It establishes for the first time in a ‘common law’ country like Canada a deviation from the principle ‘first in time first in right,’” the Commission further declares.¹⁰¹ It is unclear from the document, however, whether or not the coexistence arrangements were formulated, in the course of CETA negotiations, with the consent of the owners of relevant prior conflicting trademarks. If that is the case, we may be able to consider that the exclusivity of trademark rights under the FITFIR principle has been maintained and that there is no “deviation” from the principle. In a document of the Canadian side, Canada says that CETA “[o]ffer[s] protection for GIs without prejudicing the validity of existing Canadian trademarks.”¹⁰² There is also a report that the EU and Canada had resolved several long-lasting commercial disputes through the CETA negotiations and had agreed to allow five GIs for foodstuffs to coexist with preexisting trademarks in Canada.¹⁰³ It is inferred from the above that the CETA negotiations included some dispute settlement elements concerning individual GIs.

As far as future new additions to the CETA’s GI list (“Annex 20-A”) are concerned, CETA does have a provision setting a rule regarding the relationship between prior conflicting trademarks and subsequent GIs, but the rule has a questionable aspect. According to the provision, a GI identifying a product originating in a Party shall not be added to the Annex if it is identical to a trademark that has been registered in the other Party in respect of the same or similar products.¹⁰⁴ The same applies to a GI identical to a trademark in respect of which in the other Party rights have been acquired through use in good faith and an application has been filed in respect of the same or similar products.¹⁰⁵ The provision, however, does not guarantee Parties’ compliance with Article 16.1 of the TRIPS Agreement, as it does not prevent the addition to the Annex of a GI that is not identical but similar to a registered trademark, even without the owner’s consent, in respect of the same or similar products, where the use of such a GI would result in a likelihood of confusion.¹⁰⁶

five GIs specified as those allowed to coexist with prior trademarks are: apart from “Prosciutto di Parma,” “Canards à foie gras du Sud-Ouest: Périgord,” “Szegedi téliszalámi/Szegedi szalámi,” “Prosciutto di S. Daniele,” and “Prosciutto Toscano.” Those GIs appear in the Annex 20-A of CETA.

101. *Id.*

102. CANADA, TECHNICAL SUMMARY OF FINAL NEGOTIATED OUTCOMES: CANADA-EUROPEAN UNION COMPREHENSIVE ECONOMIC AND TRADE AGREEMENT 20 (2013), <http://www.international.gc.ca/trade-agreements-accords-commerciaux/assets/pdfs/ceta-aecg/ceta-technicalsummary.pdf> (last visited Dec. 1, 2018).

103. *See* Schewel, *supra* note 13.

104. *See* CETA, *supra* note 9, art. 20.22.3(a).

105. *See id.*

106. *See id.* Under the Trade-marks Act of Canada as amended by the CETA Implementation Act, grounds for objection to GI protection seem to be broader than the grounds stipulated in CETA regarding

C. Issue 3: Handling of Terms of Generic Nature and Compound Terms (Multi-component Terms)

Unlike the EU-Korea FTA with no specific provision concerning generic terms, the EU-Singapore FTA makes it clear that a Party (e.g., Singapore) is not required to protect a GI of the other Party (e.g., the EU) if it is identical with the term customary in common language as the common name for relevant goods or services in the territory of that Party (e.g., Singapore).¹⁰⁷ The same applies to any name contained in a GI of the other Party.¹⁰⁸ In this relation, under the Singapore's GI Act 2014, grounds for refusal of GI registration include the situation in which a GI is identical to the common name of any goods in Singapore, where registration of the GI is sought in relation to those goods.¹⁰⁹ Also under the Act, where a term contained in a GI is considered to be generic, third parties can request that a qualification of the rights conferred in respect of the GI upon its registration be entered in the register on that ground.¹¹⁰

CETA takes a different approach to the issue of generic terms, by reflecting individual adjustments into the agreement itself as a result of compromise reached in the CETA negotiations, as explained below.

The first aspect of the CETA's approach is seen in grandfathering arrangements regarding some of EU GIs. Four from the 19 names on the claw-back list, i.e., Asiago, Φέτα (Feta), Fontina, and Gorgonzola, as well as another name outside the claw-back list (Munster), are subject to a grandfather clause with the critical date based on the conclusion of negotiations, namely, October 18, 2013, the date of reaching a political agreement.¹¹¹ The grandfather clause provides that the protection of the five GIs shall not prevent the use in Canada of any of these GIs by any persons, including their successors and assignees, who made commercial use of those GIs with regard to products in the class of "cheeses" preceding that date.¹¹²

the GI-trademark relationship for preventing future new additions of GIs to the list in Annex 20-A of CETA. Namely, according to the Act, a statement of objection may be filed on the basis, *inter alia*, that a GI is confusing with: (i) a registered trademark; (ii) a trademark that was previously used in Canada and that has not been abandoned; or (iii) a trademark in respect of which an application for registration was previously filed in Canada and remains pending. *See* Trade-marks Act, R.S.C. 1985, c. T-13, § 11.13(2)(d) (Can.). As for GIs existing in Annex 20-A from the beginning, they are exempted, under the Trade-marks Act, from challenges by third parties. *See infra* Part IV. B. 1.

107. *See* EU-Singapore FTA, *supra* note 8, art. 10.22.5.

108. *See* EU-Singapore FTA, *supra* note 8, art. 10.22.6.

109. *See* GI Act 2014, *supra* note 81, § 41(1)(e).

110. *See id.* § 46(1), (2), (5), (7).

111. *See* CETA, *supra* note 9, art. 20.21.2. Besides, one name is subject to a grandfather clause with the premise of commercial use for at least five years preceding the date of October 18, 2013 and two names at least 10 years preceding that date. *See id.* art. 20.21.3, 4.

112. *See id.* art. 20.21.2.

Even where persons other than those prior users use the above five GIs, Canada is not required to provide the legal means for interested parties to prevent the use of those GIs when the use of such terms is accompanied by expressions such as “kind,” “type,” “style,” “imitation” or the like and is in combination with a legible and visible indication of the geographical origin of the product concerned.¹¹³ Those provisions in CETA, and those in an agreement between the EC and the U.S. in 2006 in the field of GIs for wines, have the common feature of applying a grandfather clause to the protection of GIs with some generic nature (“semi-generic names” in the context of the EC-U.S. agreement) with the critical date being the date of the conclusion of an agreement, albeit difference in legal effects.¹¹⁴

The second aspect of the CETA’s approach is seen in securing expressly the freedom of using certain terms specified in a list, which are considered to be generic in English or French, the official languages of Canada. Namely, CETA specifies in its Annex 20-B certain terms including “Parmesan” and “St. George Cheese” (corresponding to “Parmigiano Reggiano” and “Queijo São Jorge,” respectively, both of which appear in the claw-back list and are the subject of protection under CETA) and stipulates that the right of any person to use, or to register in Canada a trademark containing or consisting of, any of those terms is not prejudiced.^{115,116}

The U.S. dairy industry has responded sourly to the GI provisions of CETA. In particular, with regard to the names that the industry considers to be generic, such as “feta,” according to the industry, Canada should not provide any protection sought by the EU as they have become generic in the Canadian market, and therefore the grandfather clauses are not appropriate.¹¹⁷ A letter dated March 11, 2014, sent under the joint signatures of 55 Senators of the U.S. Congress to the Secretary of the U.S. Department of Agriculture and the U.S. Trade Representative stated “Canada agreed as part of its recently concluded FTA with the EU to impose new restrictions on the use of ‘feta’ and other common cheese names. Common names for products such as ‘feta’ are clearly generic in Canada, as they are in many

113. *See id.* art. 20.21.1.

114. *See* Agreement Between the United States of America and the European Community on Trade in Wine, U.S.-EC, art. 6, Mar. 10, 2006, T.I.A.S. No. 06-310.

115. This is not applicable in respect of any use that would mislead the public as to the geographical origin of the goods.

116. CETA, *supra* note 9, art. 20.21.11, Part A of Annex 20-B.

117. *See* Schewel, *supra* note 13.

other countries.”¹¹⁸ The letter expresses the industry’s concern that these restrictions would impair market access for U.S. dairy products.¹¹⁹

An additional remark on Feta is that, in the context of the EU-Singapore FTA negotiations, Parties have agreed that “feta” from other origins can coexist in perpetuity with the EU “Feta” GI, once registered, according to a letter on GIs related to the FTA.¹²⁰ It is understood that even in the EU-Singapore FTA negotiations compromise on an individual GI basis was sought, as far as the most controversial “Feta” is concerned.

D. Issue 4: Existence of Opposition Opportunities and Cancellation Possibilities

The EU-Singapore FTA makes it clear that GIs are protected under systems including an objection procedure as well as an administrative verification process, and also provides for the possibility of cancellation of entries on the domestic GI register.¹²¹ Specifically, the FTA provides that the systems for the registration and protection of GIs (for such categories of wines and spirits and agricultural products and foodstuffs as a Party deems appropriate) must contain the element of an objection procedure that allows the legitimate interests of third parties to be taken into account.¹²² Such systems are also required to provide legal means that permit the rectification and cancellation of entries on the domestic register that take into account the legitimate interests of third parties and the right holders of the registered GIs in question.¹²³ The FTA provides that, as soon as practicable after the procedures for protection of GIs in each Party have been concluded for all the names listed in Annex 10-A, the Parties shall meet to adopt a decision in the Trade Committee organized under the FTA regarding the listing in Annex 10-B of the names from Annex 10-A of each Party that have been and remain protected as GIs under the respective Party’s system.¹²⁴ It further

118. Letter from 55 Senators of the U.S. Congress to Tom Vilsack, Secretary of the U.S. Department of Agriculture, and Michael Froman, U.S. Trade Representative, *supra* note 62.

119. *See id.*

120. *See* Letter from Lim Hng Kiang, Minister for Trade and Industry, Singapore, to Karel De Gucht, European Commissioner for Trade (Jan. 21, 2013), http://trade.ec.europa.eu/doclib/docs/2013/september/tradoc_151779.pdf (last visited Dec. 1, 2018).

121. *See* EU-Singapore FTA, *supra* note 8, art. 10.17.1, 10.17.2. *See also* Susanna H.S. Leong, *European Union-Singapore Free Trade Agreement: A New Chapter for Geographical Indications in Singapore*, in Calboli & Ng-Loy, *supra* note 15, at 247 (remarking, with regard to the arrangement of domestic registration process envisaged under the EU-Singapore FTA, “[I]t is noteworthy that under the EU-Singapore FTA, Singapore did not accept to grant automatic recognition and protection to a limited list of key GIs from the EU.”).

122. *See* EU-Singapore FTA, *supra* note 8, art. 10.17.2(c).

123. *See* EU-Singapore FTA, *supra* note 8, art. 10.17.2(d).

124. *See* EU-Singapore FTA, *supra* note 8, art. 10.17.3.

stipulates that amendments to Annex 10-B shall be subject to the GIs having been and remaining protected as GIs under the respective Party's system.¹²⁵

In contrast, under CETA, direct protection is provided to GIs listed in its Annex 20-A without going through the domestic process including the opposition procedure.¹²⁶ This feature is represented in a provision in CETA: “[h]aving examined the geographical indications of the other Party, each Party shall protect them according to the level of protection set out in this Sub-section.”¹²⁷ In this relation, a document of the Canadian Government summarized the negotiated outcome of CETA, with regard to GIs, “Consultations were conducted with stakeholders, including meetings with individual trademark holders.”¹²⁸ This implies that the protection of individual GIs was decided with the process of consultations between the Government and stakeholders during CETA negotiations and that these consultations may have contributed to the adjustment between five GIs and existing trademarks in Canada referred to in the above Section B and to the solutions with grandfather clauses with respect to GIs with some generic nature referred to in the above Section C.

CETA does not provide for any cancellation of GIs listed in Annex 20-A except for those which have ceased to be protected or have fallen into disuse in their place of origin.¹²⁹ This is another point making a clear contrast with arrangements in the EU-Singapore FTA.

In relation to arrangements of the EU-Singapore FTA, which is highly contrasting with the direct protection arrangements as in CETA, the EU notes that the arrangements of the EU-Singapore FTA for GIs “reflect the fact that Singapore’s legislation does not permit direct protection” of GIs via the Agreement, and underlines that “this does not constitute a precedent,” according to the letter of the Singapore Government referred to above.¹³⁰ This testifies to the EU’s desire for direct protection of GIs, and implies that its negotiations with Singapore were tough for the EU.

125. See EU-Singapore FTA, *supra* note 8, art. 10.18.

126. See CETA, *supra* note 9, art. 20.19.1, 2. In relation to the direct protection, an article cited above reports a remark of an EU official that Canada would protect GIs on the list directly through the agreement, meaning there is no need for EU producers to register these GIs in a Canadian domestic system. See Schewel, *supra* note 13. The article further refers to the EU official’s remark that Canada had decided not to run an opposition procedure as such and that, according to the EU’s understanding, domestic producers had been involved in the examination of the EU list tabled by the EU in May 2011. *Id.*

127. CETA, *supra* note 9, art. 20.19.1.

128. CANADA, *supra* note 102, at 21.

129. See CETA, *supra* note 9, arts. 20.22.1, 20.19.7.

130. Letter from Lim to De Gucht, *supra* note 120.

E. Remarks in relation to the TPP

The TPP, signed on February 4, 2016, by 12 countries including Canada and Singapore, provides a useful comparative basis vis-à-vis the EU's "new generation" FTAs, as (i) the TPP is a plurilateral FTA concluded after the emergence of such EU's "new generation" FTAs and therefore was negotiated with the knowledge of the emergence; and (ii) the TPP involves, as signatories, not only the U.S. and Australia, both of which are "New World" countries and complained against the EC Regulation No 2081/92 in the WTO dispute settlement case DS 174/290, but also Mexico and Peru, both of which are the members of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration.¹³¹ Accordingly, TPP's GI provisions have an aspect of a response of the New World countries to EU's initiatives in its FTAs, and another aspect of being acceptable to the signatories of the EU's FTAs and those of the Lisbon Agreement.

Although entry on the U.S. into force of the TPP is not foreseen at the time of writing, in light of the above, this Section considers how GI protection under the EU-Singapore FTA and CETA is in line with the GI-related norms provided by the TPP.

As a significant feature of the TPP's GI provisions, the agreement obligates a Party with administrative procedures for GI protection to publish GI applications or petitions for opposition¹³², and to provide procedures that allow interested persons to object to GI protection and to seek GI cancellation at least on the grounds, in the territory of such a Party, of: likely confusion with a pre-existing trademark, in line with the FITFIR principle; and the generic nature of the GI.¹³³ Specifically, those grounds are that: (a)

131. Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, Oct. 31, 1958, as revised at Stockholm on July 14, 1967, and as amended on Sept. 28, 1979, 923 U.N.T.S. 205 [hereinafter "Lisbon Agreement"]. See also World Intellectual Property Organization ("WIPO"), *WIPO-Administered Treaties (Lisbon Agreement)*, https://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=10 (last visited Dec. 1, 2018) (listing Mexico and Peru as contracting parties (in force since 1966 and 2005, respectively)).

132. See TPP, *supra* note 10, art. 18.31(e).

133. See *id.* art. 18.32.1, 18.32.2. See also *supra* note 68. A Party is not required to apply the obligations regarding opposition and cancellation under art. 18.32 to GIs for wines and spirits. See TPP, *supra* note 10, art. 18.32, n.20 & art. 18.36.4. With regard to cancellation, art. 18.32.2 has its compromising second sentence, allowing a Party to apply the ground as of the time of filing the request for protection or recognition of a GI in the territory of the Party. Accordingly, a Party would be allowed to exclude, from grounds for cancelling a registered GI, a situation where the GI in question was not generic at the time of filing of the request for protection but has subsequently become generic in that Party. This is considered to be in view of article 6 of the Lisbon Agreement (stipulating that an appellation which has been granted protection in one of the Lisbon member countries pursuant to the international registration procedure cannot, in that country, be deemed to have become generic, as long as it is protected as an appellation of origin in the country of origin). See Lisbon Agreement, *supra* note 131, art. 6. What

the GI is likely to cause confusion with a trademark that is the subject of a pre-existing good faith pending application or registration in the territory of the Party; (b) the GI is likely to cause confusion with a pre-existing trademark, the rights to which have been acquired in accordance with the Party's law; and (c) the GI is a term customary in common language as the common name for the relevant good in the territory of the Party.¹³⁴ In relation to item (c), there is a view that the United States' potential gain in the TPP had the effect of standing in the way of the EU approach of clawing back generic names.¹³⁵ Further, the TPP does obligate such a Party to provide procedures to refuse, or not to afford, GI protection or recognition on those grounds (a) to (c).¹³⁶

From such obligations under the TPP, it is understood that opposition opportunities for interested persons underpin the actual functioning of substantive rules regarding the Issues 2 and 3 – the denial of GI protection based on a prior conflicting trademark and the generic nature of the GI. In relation to the Issue 1, too, the TPP addresses clarification, with third-party involvement, on the protection of any translation or transliteration of a GI – namely, if a Party provides the protection or recognition of a GI, through administrative procedures, to the translation or transliteration of that GI, the Party is obligated to make available procedures for opposition and cancellation with respect to that translation or transliteration, on the above grounds.¹³⁷

It is particularly noted that the TPP explicitly stipulates a Party's obligation to apply equivalent procedures and grounds for opposition to GIs to be protected pursuant to international agreements without going through domestic administrative procedures.¹³⁸ This differentiates the TPP from the KORUS FTA, which does not have such a provision.¹³⁹ Accordingly, it has been made clear in the TPP that direct protection of GIs by an FTA without

is stipulated in that article can essentially be found in article 12 of the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications, as adopted on May 20, 2015. *See* Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications, art. 12, May 20, 2015, WIPO, GENEVA ACT OF THE LISBON AGREEMENT ON APPELLATIONS OF ORIGIN AND GEOGRAPHICAL INDICATIONS AND REGULATIONS UNDER THE GENEVA ACT OF THE LISBON AGREEMENT OF MAY 20, 2015 16 (2015).

134. *See* TPP, *supra* note 10, art. 18.32.1. In relation to a common name mentioned in the item (c), the TPP provides for the ineligibility, for GI protection, of an individual component of a multi-component term protected as a GI in a Party, where the component is a common name in that Party. *See* TPP, *supra* note 10, art. 18.34.

135. *See* Frankel, *supra* note 15, at 154 (mentioning that arguably any list of required names for claw-back purposes in future agreements will be inconsistent with the TPP).

136. *See* TPP, *supra* note 10, art. 18.32.1.

137. *See* TPP, *supra* note 10, art. 18.32.5.

138. *See* TPP, *supra* note 10, art. 18.36.1.

139. *See supra* Part II. B.

the opposition procedure is impermissible, albeit some transitional arrangements exist, as mentioned below.

Direct protection without the opposition procedure provided for in CETA¹⁴⁰ would be inconsistent with the obligation under the TPP mentioned in the previous paragraph, although GIs originally identified in CETA and protected pursuant to that are considered to be exempted from that obligation through transitional arrangements, as CETA had been agreed in principle prior to the date of agreement in principle of the TPP.¹⁴¹ If GIs are subsequently added to CETA Annex 20-A through the amendment of the Annex,¹⁴² Canada would be required by the TPP (provided that it enters into force for Canada), as far as those “new” GIs are concerned, to apply prescribed procedures including the Internet posting of details regarding terms of GI protection, and the provision of an opportunity for interested persons to comment regarding the GI protection.¹⁴³

It is worth noting that, in the context of bilateral exchange of letters as the outcome of the TPP negotiations, the U.S. has exchanged letters with Canada on agricultural transparency, showing their commitment to meeting, if requested by either Party, to discuss the use or proposed use by either Party of any GI that may restrict the labeling and marketing in the territory of that Party of an agricultural good produced in the territory of the other Party.¹⁴⁴ This is considered to reflect the concern of the U.S. that restrictions resulting from Canada’s GI commitments under CETA may impair market access for U.S. dairy products, as explained earlier in Section C of this Part.

In contrast to CETA, in the case of the EU-Singapore FTA, no conflict between its GI provisions and TPP GI provisions is observed. With reference to discussions in this Part, features of the EU-Singapore FTA in line with TPP GI provisions include: in relation to Issue 1, case-by-case assessment of the question regarding GI protection against the use of a translated term; in relation to Issue 2, possibility of registering a subsequent GI only with the

140. *See supra* Part III. D.

141. *See* TPP, *supra* note 10, art. 18.36.6(a). In light of the definition of the phrase “agreed in principle,” TPP, art. 18.36.6(a), n.29, it is considered that the dates of agreement in principle for CETA and the TPP are October 18, 2013 and October 5, 2015, respectively. *See* European Commission Press Release IP/13/972, EU and Canada conclude negotiations on trade deal (Oct. 18, 2013) and USTR Press Release, Trans-Pacific Partnership Ministers’ Statement (Oct. 5, 2015).

142. *See* CETA, *supra* note 9, art. 20.22.1.

143. *See* TPP, *supra* note 10, art. 18.36.2.

144. *See* Letter from Michael B.G. Froman, U.S. Trade Representative, to Chrystia Freeland, Minister of International Trade, Canada, and reply thereto (Feb. 4, 2016), <https://ustr.gov/sites/default/files/TPP-Final-Text-US-CA-Letter-Exchange-on-Agricultural-Transparency.pdf> (last visited Dec. 1, 2018). The exchanged letters are subject to dispute settlement under Chapter 28 (“Dispute Settlement”) of the TPP, with the entry into force on the date of entry into force of the TPP as between the U.S. and Canada. *See id.*

consent of the prior existing trademark rights holder;¹⁴⁵ in relation to Issue 3, no obligation to protect a GI of the other Party (or a component therein) where it is identical with the generic term in the territory of the Party; and in relation to Issue 4, existence of the domestic process including the opposition procedure and the possibility of cancellation of entries on the domestic GI register.

IV. NOTABLE FEATURES AND IMPLICATIONS OF THE NATIONAL IMPLEMENTATION OF FTA'S GI PROVISIONS

Part IV discusses the national implementation of the EU-Singapore FTA and CETA in Singapore and Canada, respectively, to examine what shape the two approaches take in the domestic legal systems. Focuses are placed on: (i) with respect to Singapore, measures to facilitate a settlement among stakeholders in the envisaged *sui-generis* GI registration system; and (ii) as for Canada, non-existence of third-party opposition and cancellation request procedures in Canada as to the EU GIs listed in an annex to CETA, as a consequence of the direct protection nature of CETA's GI provisions, and a resultant potential problem in terms of the MFN treatment obligation under the TRIPS Agreement. The present Part also looks into Japan's recent legislation to accommodate the results of EU-Japan EPA negotiations, and further examines the MFN issue arising from partial or modified direct protection. Although domestic GI protection regimes protect GIs for wines and spirits, this article focuses on GIs for agricultural products and foodstuffs.

A. *Singapore's Implementation of the GI Provisions of the EU-Singapore FTA*

The EU-Singapore FTA negotiations began in March 2010 and concluded on December 16, 2012 (with the exception of the chapter on investment).¹⁴⁶ Notable developments thereafter include public consultation processes.

Specifically, the Singaporean Government conducted its first public consultation process from January 21 to March 21, 2013, regarding a list¹⁴⁷

145. See *infra* Part IV. A. 2 for explanation on an exception where the proprietor of a prior trademark fails to give notice to the Registrar of his/her opposition to the registration within the prescribed time. See also GI Act 2014, *supra* note 81, § 41(7).

146. See European Commission Press Release IP/12/1380, EU and Singapore agree on landmark trade deal (Dec. 16, 2012). See also Opinion 2/15, *supra* note 8, at ¶ 8.

147. See *supra* Part III. A for the explanation of Annex 10-A of the EU-Singapore FTA containing the corresponding list.

of 196 terms (including those for wines and spirits as well as for agricultural products and foodstuffs) presented by the EU in the FTA talks. In the consultation, the Government asked the public whether any term in the list was considered generic in Singapore or found within an existing registered or well-known trademark (where the proprietor had not given consent for any third party to use the trademark as a GI) in Singapore, and asked for relevant information.¹⁴⁸ According to the Government, the public consultation exercise saw good feedback from a range of different stakeholders and the feedback was taken into account in formulating the Singapore regime for the protection of GIs.¹⁴⁹

The informal consultation has a role as a precursor to the examination procedure including the opposition procedure under the new GI regime to be established in Singapore. Specifically, possible deviation between the results of the informal public consultation as assessed by the EU and Singapore in the form of “Potentially-Opposed Terms” and the outcome of the formal third-party opposition to the protection of GIs in the EU has a certain linkage with the provisional application of the EU-Singapore FTA, according to the letter of the Singaporean Government referred to in Part III. C above.¹⁵⁰ Simply put, if the Formally-Opposed Terms (terms from the EU GI list that encounter formal third-party opposition) are within, or comparable to, the “Potentially-Opposed Terms,” the FTA will be provisionally applied following the end of the period of publication for opposition, but otherwise the FTA will be provisionally applied after the GI Registrar has issued its decisions, at the end of the opposition proceedings, in respect of the opposition proceedings.¹⁵¹

Following the initialing of the EU-Singapore FTA and the publication of its text on September 20, 2013 (with the exception of the chapter on investment),¹⁵² the Singaporean Government conducted its second public consultation process from November 1 to 30 of the same year regarding the consultation draft of a Geographical Indications Bill to implement the FTA’s

148. Ministry of Trade and Industry (“MTI”), Ministry of Law (“MinLaw”), & Intellectual Property Office of Singapore (“IPOS”), *Geographical Indications Consultation Paper: List of Terms in Relation to 196 Products*, ¶9 (Jan. 21, 2013).

149. IPOS, *Public Consultation on Changes to be made to the Geographical Indications Act and Trade Marks Act to Enhance Singapore’s Regime for the Protection of Geographical Indications*, ¶1.5 (Nov. 1, 2013).

150. See Letter from Lim to De Gucht, *supra* note 120.

151. See *id.*

152. European Commission Press Release IP/13/849, EU and Singapore present text of comprehensive free trade agreement (Sept. 20, 2013). See also Opinion 2/15, *supra* note 8, at ¶ 8.

GI provisions and related draft amendments to the Singapore Trade Marks Act.¹⁵³

After those consultation processes, the Geographical Indications Bill was submitted to the Parliament of Singapore on March 5, passed by Parliament on April 14, and promulgated as “Geographical Indications Act 2014” (“GI Act 2014”) on May 23, 2014. Upon entry into force of the Act, its predecessor mentioned below will be repealed.

Singapore has implemented its obligations of GI protection under the TRIPS Agreement through the Geographical Indications Act.¹⁵⁴ The Act does not require GIs to be registered for protection, and enables interested parties to file civil actions to prevent third parties from using GIs in a manner which misleads the public as to the geographical origin of the goods concerned.¹⁵⁵ Besides, it is also possible to obtain protection for a GI as a collective or certification mark under the Trade Marks Act.¹⁵⁶

Under the new regime, a GI Registry will be established within the Intellectual Property Office of Singapore (“IPOS”) and it will accept applications for GI registration for certain categories of agricultural products and foodstuffs as well as for wines and spirits.¹⁵⁷ All applications for GI registration will undergo examination and publication for pre-grant opposition.¹⁵⁸ GIs successfully registered will enjoy protection at the level of the additional protection stipulated in Article 23 of the TRIPS Agreement, and this will apply to GIs for agricultural products and foodstuffs in relation to any goods of the same category of agricultural products and foodstuffs,¹⁵⁹ as well as to GIs for wines and spirits. Border measures are available with respect to registered GIs.¹⁶⁰

The entry into force of the provisions of the GI Act 2014 implementing the EU-Singapore FTA will take place in multiple stages, in tandem with the EU’s ratification processes of the FTA, with a view to allowing organizations with operations in Singapore some time to adjust their existing practices.¹⁶¹ As the first phase, provisions relating to the GI Registry and the registration of GIs will come into effect with the EU Parliament’s ratification of the

153. See IPOS, *supra* note 149.

154. Geographical Indications Act, Cap. 117B (Act No. 44/1998) (Sing.).

155. See *id.* § 3(1), (2)(a). In the case of wines or spirits, misleading use is not a prerequisite for civil actions. See *id.* § 3(2)(c), (d).

156. Trade Marks Act, Cap. 332 (Act No. 46/1998) (Sing.), §§ 60, 61, First Schedule (Collective Marks) § 3, Second Schedule (Certification Marks) § 3.

157. See GI Act 2014, *supra* note 81, § 40, Schedule.

158. See *id.* §§ 43, 45, 48.

159. See *id.* § 4(6).

160. See *id.* § 56.

161. See IPOS, *supra* note 149, at ¶ 1.6.

FTA.¹⁶² As the second and third phases, provisions for the additional GI protection and those for border enforcement measures will be brought into force upon the provisional application and within three years of the entry into force of the FTA, respectively.¹⁶³

In the following Subsections, the Singapore's GI protection regime under the GI Act 2014 is analyzed, with a particular focus on mechanisms for conflict resolution based on actions by interested parties.

1. Mechanism 1: Clarification on Translation (related to Issue 1)

In relation to the "case-by-case" assessment regarding GI protection against the use of a translated term as mentioned in the EU-Singapore FTA,¹⁶⁴ a noteworthy aspect of the GI Act 2014 is that it enables any person to request, after the date of the publication of an application for GI registration for opposition, that a qualification, of the rights conferred in respect of a registered GI, be entered in the register in relation to any term which may be a possible translation of the GI on the grounds that the term is actually not a translation of the GI.¹⁶⁵ Another ground for a request for a qualification is that one or more of the exceptions for GI protection referred to under Part III of the Act (e.g., the use of an indication in relation to any goods or services which is identical with the common name of the goods or services in Singapore (Section 11 (c))) applies to any name contained in the GI in question or any term which may be a possible translation of the GI.¹⁶⁶ Hence, it is considered that such a request for a qualification may be made on the grounds that any name contained in the GI in question or any possible translation of the GI is identical with the common name of the goods or services in Singapore. If the Registrar is satisfied that at least either of the grounds is made out, he/she causes a qualification of the rights to be entered in the register. In this case, the rights of an interested party in respect of the GI are restricted accordingly.¹⁶⁷

In the consultation paper published on November 1, 2013, before the enactment of the GI Act 2014, IPOS stated its aim with regard to the system allowing any person to request a qualification, in relation to the protection of the translations of registered GIs, as follows:

162. *See id.*

163. *See id.* *See also* GI Act 2014, *supra* note 81, §§ 1, 88(2), (3); EU-Singapore FTA, *supra* note 8, art. 10.49.4.

164. *See supra* Part III. A.

165. *See* GI Act 2014, *supra* note 81, § 46(1), (2).

166. *See id.*

167. *See id.* § 46(5), (7).

As translations of registered GIs will be protected on a case-by-case basis . . . , it may not be clear what translations of the GI will be protected at the point of the application of the registration of the GI. By allowing third parties to request for disclaimers¹⁶⁸ of protection, both the applicant and interested third party can achieve clarity on whether specific terms will or will not be available for use by third parties.¹⁶⁹

Further, according to the explanation in the consultation paper, IPOS envisioned that, similar to an opposition hearing, such a disclaimer request process might include hearings where both the requester and applicant for the registration of the GI could provide arguments and evidence for their case.¹⁷⁰

The system described here could contribute to the clarification of the scope of GI protection, taking account of the legitimate interests of third parties in an open procedure available to any person.

2. *Mechanism 2: Possibility of Registering a Subsequent GI with Trademark Owner's Consent (related to Issue 2)*

With regard to the GI-trademark relationship, the GI Act 2014 provides for the possibility of the registration of a subsequent GI with the consent of the right holder of a prior trademark, while applying the FITFIR principle to the relationship between GIs and trademarks. Furthermore, that possibility has a link with the opposition proceedings.

Specifically, the GI Act 2014 stipulates the principle of refusing the registration of a GI if there is a prior conflicting trademark,¹⁷¹ as well as refusing the registration of a subsequent trademark on account of a prior conflicting GI.¹⁷² Here, a prior conflicting trademark is either (A) or (B) below:

(A) A trademark that is identical with or similar to the GI in question with a likelihood of confusion on the part of the public, with the trademark being:

168. The GI Act 2014 does not use the word “disclaimers” but instead refers to the phrase “a qualification, of the rights conferred under this Act in respect of a registered geographical indication.” *Id.* § 46(1).

169. IPOS, *supra* note 149, at ¶ 4.15.

170. *See id.* at ¶ 4.14.

171. *See* GI Act 2014, *supra* note 81, § 41(4), (6).

172. *See id.* § 90(c).

(A-1) a registered trademark (or a trademark entitled to protection in Singapore under the Madrid Protocol) that was applied for registration in good faith or registered in good faith before the date of application for registration of the GI in Singapore (taking into account, where appropriate, the priorities claimed); or

(A-2) a trademark that has been used in good faith in Singapore in the course of trade before the date of application for registration of the GI in Singapore.

(B) A well-known trademark in Singapore, before the date of application for registration of the GI in Singapore, that is identical with or similar to the GI where the registration of the GI is liable to mislead consumers as to the true identity of the goods identified by that GI.¹⁷³

The GI Act 2014 further provides that the Registrar may, in his/her discretion, register any GI with a prior conflicting trademark described above, if the proprietor of the trademark consents to the registration or fails to give notice to the Registrar of his/her opposition to the registration within the prescribed time after the date of the publication of the GI application.¹⁷⁴ Such a provision leaving the registration of a GI with a conflicting trademark to the Registrar's discretion may appear to give the administrative body too much authority. It can be interpreted, however, as a rule aiming for settlement among concerned parties as much as possible, while abiding by the FITFIR principle, instead of deciding on the permissibility of coexistence (e.g., in FTA negotiations) without the initiatives of the parties concerned. Namely, the provision is considered to systematically urge the right holders of potentially conflicting prior trademarks to file opposition within the prescribed time after the publication of GI applications, thereby creating the environment in which efforts are made to settle conflicts between GI applicants and trademark right holders, including licensing negotiations, in a certain time frame.

With regard to the examination of GI applications by the Registrar, the GI Act 2014 provides that the Registrar may carry out a search, to such extent as he/she considers necessary, of earlier trademarks and earlier GIs.¹⁷⁵ In relation to such a search during the examination process, the GI consultation paper in November 2013 mentions that, where appropriate, the Registrar may approach proprietors of prior registered trademarks to ascertain if they would consent to the registration of a GI.¹⁷⁶ This is considered to be another

173. *See id.* § 41(4)–(6).

174. *See id.* § 41(7). *See also supra* Part III. B for relevant provisions of the EU-Singapore FTA.

175. *See* GI Act 2014, *supra* note 81, § 43(2).

176. *See* IPOS, *supra* note 149, at ¶ 4.11.

arrangement to facilitate, where appropriate, settlement among parties concerned.

It is understood from the above that Singapore has prepared a procedural framework which is intended to enable parties concerned (including trademark right holders) to pursue settlement among themselves on an individual basis, while abiding by the FITFIR principle.

3. *Mechanism 3: Clarification on Generic Nature of a GI or its Component (related to Issue 3)*

The GI Act 2014 stipulates that a GI identical to the common name of any goods in Singapore shall not be registered, where registration of the GI is sought in relation to those goods.¹⁷⁷ Corresponding to this is a provision, with respect to exceptions to GI protection, that the use of a GI in relation to any goods or services which is identical with the common name of the goods or services in Singapore constitutes an exception.¹⁷⁸

As already discussed in Subsection 1, one ground for a request for a qualification of the rights conferred in respect to a registered GI is that one or more of the exceptions for GI protection referred to under Part III of the Act, including the aforementioned one regarding the common name, applies to any name contained in the GI or any term which may be a possible translation of the GI.¹⁷⁹ This could contribute to clarification on the generic nature of a component, or a possible translation, of a GI.

Two additional points are noted on the GI Act 2014 with respect to generic terms. Firstly, the GI Act 2014 explicitly shows possible evidence for the non-generic nature of a term. Namely, it stipulates that:

any marketing material in Singapore which uses a [GI] shall be relevant evidence that the [GI] is not the common name of any goods in Singapore, if the marketing material suggests (for example, by using words or pictures) in a misleading manner that the goods to which the marketing material relate[s] originate in the geographical origin of the [GI], when those goods originate elsewhere.¹⁸⁰

The above provision is thought to correspond to the decision of the ECJ with respect to the “Feta” case detailed in Part II. A of this article.¹⁸¹

177. See GI Act 2014, *supra* note 81, §41(1)(e).

178. See *id.* § 11(c).

179. See *id.* § 46(1), (2).

180. *Id.* §41(2). See also letter from Lim to De Gucht, *supra* note 120, at ¶ 4.

181. As discussed in *supra* Part II. A, the ECJ found in the case that, in Member States other than Greece, feta was commonly marketed with labels referring to Greek cultural traditions and civilization.

Secondly, under the GI Act 2014, GI registration may be cancelled if the registered GI has subsequently become the common name in Singapore of the goods identified by that GI.¹⁸² This marks a contrast with the EU Regulation, which stipulates that “[p]rotected designations of origin and protected geographical indications shall not become generic,”¹⁸³ and with Canada’s legislation implementing CETA, which exempts GIs specified therein from cancellation challenges, as discussed in Section B below.

4. Mechanism 4: Opposition and Cancellation Procedures (related to Issue 4)

In response to the provisions of the EU-Singapore FTA discussed in Part III. D, the GI Act 2014 stipulates, “[a]ny person may, within the prescribed time after the date of the publication of the application, give notice to the Registrar of his opposition to the registration.”¹⁸⁴ The Act does not give details of the opposition proceedings, and only provides, “[t]he Minister may make rules to provide for opposition proceedings and for matters relating thereto.”¹⁸⁵ Nonetheless, the first public consultation paper in January 2013 mentions, “[a]s for a GI application that is opposed within the publication/pre-grant opposition period, if the relevant parties are not able to resolve their dispute amongst themselves within a certain period, an opposition hearing will be held, and registration of the GI will depend on the outcome of that opposition hearing.”¹⁸⁶ Inferred from this is that dispute settlement among relevant parties for themselves in a certain time frame is intended. A similar mechanism is seen in the European opposition system under the EU Regulation.¹⁸⁷

The GI Act 2014 also stipulates that the registration of a GI may be cancelled by the Court or the Registrar upon an application by any person other than the registrant on grounds including: that the GI was registered in breach of the provision on grounds for refusal of registration; and that, in

182. See GI Act 2014, *supra* note 81, § 52(1), (2)(e).

183. EU Regulation, *supra* note 36, art. 13(2).

184. GI Act 2014, *supra* note 81, § 45(2).

185. *Id.* § 45(4).

186. MTI, MinLaw, & IPOS, *supra* note 148, at ¶ 7.

187. See EU Regulation, *supra* note 36, art. 51(3) (providing that, within two months after the receipt of an admissible reasoned statement of opposition, the European Commission shall invite the opponent and the applicant to engage in appropriate consultations for a reasonable period not longer than three months (extendable by a maximum of three months at the request of the applicant)). According to the provision, the opponent and the applicant shall provide each other with the relevant information to assess whether the application for registration complies with the conditions of the EU Regulation. See *id.* If no agreement is reached, this information shall also be provided to the Commission. See *id.* See also BLAKENEY, *supra* note 32, at 154–56.

consequence of a lack of any activity by any interested party of goods identified by a registered GI, as mentioned in above Subsection 3, the GI has become the common name of those goods in Singapore.¹⁸⁸

As discussed, in Singapore's national implementation of its FTA with the EU, the existence of the pre-grant publication of GI applications and the opposition opportunities for any person bears significance in: (i) the clarification regarding whether a certain term is within the scope of protection of a GI as its translation;¹⁸⁹ (ii) the identification of any prior trademark conflicting with a GI; and (iii) the determination on whether a GI or its element is a generic term in Singapore. This contrasts with situations regarding the implementation of CETA GI provisions in Canada based on direct protection arrangements, as shown in Section B below.

B. Canada's Implementation of the GI Provisions of CETA

CETA was signed on October 30, 2016,¹⁹⁰ and on the following day, the Canadian Government introduced to the House of Commons Bill C-30 to implement CETA.¹⁹¹ The Bill was passed by the Senate on May 11, 2017, and received royal assent on May 16 of the same year¹⁹² ("CETA Implementation Act").

The CETA Implementation Act includes provisions to amend the Trade-marks Act¹⁹³ to comply with CETA's GI provisions in Canada. The amendment went into effect on September 21, 2017, the date of provisional application of CETA.¹⁹⁴ The Trade-marks Act as amended is hereinafter referred to as the "TM Act."

The TM Act provides that "[t]here shall be kept under the supervision of the Registrar a list of [GIs] and, in the case of [GIs] identifying an

188. See GI Act 2014, *supra* note 81, § 52(1), (2).

189. The clarification can be made through an aforementioned request that a qualification be entered in the register, in relation to any term which may be a possible translation of a GI being protected, on the ground that the term is actually not a translation of the GI. Such a request may be filed at any time after the publication of a GI application. See GI Act 2014, *supra* note 81, § 46(1).

190. European Commission Press Release IP/16/3581, EU-Canada summit: newly signed trade agreement sets high standards for global trade (Oct. 30, 2016).

191. House of Commons of Canada, Bill C-30, 42nd Parliament (2016) (Can.) (first reading).

192. An Act to implement the Comprehensive Economic and Trade Agreement between Canada and the European Union and its Member States and to provide for certain other measures, S.C. 2017, c. 6 (Can.) [hereinafter "CETA Implementation Act"].

193. An Act relating to trade-marks and unfair competition, R.S.C. 1985, c. T-13 (Can.) [hereinafter "TM Act"].

194. See Order Fixing September 21, 2017 as the Day on which the Act Comes into Force, other than Certain Provisions, Canada-European Union Comprehensive Economic and Trade Agreement Implementation Act, SI/2017-47 (Can.).

agricultural product or food, translations of those indications.”¹⁹⁵ The Act protects such a GI or translation from being adopted or used in connection with a business, as a trademark or otherwise, in respect of an agricultural product or food belonging to the same category as specified by the GI entry, where that agricultural product or food does not originate in the territory indicated by the protected GI.¹⁹⁶ The protection against use also covers the case where the agricultural product or food in question originates in the territory indicated by the protected GI but was not produced or manufactured in accordance with the law applicable to that territory.¹⁹⁷ The Act stipulates exceptions to the protection including those with respect to specific indications such as “Φέτα” (Feta) reflecting the grandfathering arrangements present in the CETA GI provisions.¹⁹⁸

The GI protection regime foreseen under the TM Act is considered to raise a serious question vis-à-vis Canada’s MFN obligation under Article 4 of the TRIPS Agreement, due to difference in treatment between GIs to be protected under CETA identifying products as originating in the EU and GIs identifying products as originating in other countries including WTO Members.¹⁹⁹ In this relation, it is noted that regional trade agreements (“RTAs”) like FTAs are not exempted from the MFN obligation under the TRIPS Agreement.²⁰⁰

This Section elaborates on the MFN question.

1. Opposition against Entry into List applicable to GIs in General

Under the TM Act, within two months after the publication of a GI or a translation of a GI (in the case of one identifying an agricultural product or food) for entry into the list of protected GIs or translations, any person

195. TM Act, *supra* note 193, § 11.12(1).

196. *See id.* § 11.15(1), (2).

197. *See id.* § 11.15(3). *See also supra* Part III. A.

198. *See id.* § 11.17(3)–(7). *See also supra* Part III. C.

199. *See infra* Part IV. B. 3. *See also* TRIPS Agreement, *supra* note 1. (The TRIPS Agreement contains a provision on the MFN obligation (art. 4) as well as one on the national treatment (“NT”) obligation (art. 3).)

200. *See* Roger Kampf, *TRIPS and FTAs: A World of Preferential or Detrimental Relations?*, in *INTELLECTUAL PROPERTY AND FREE TRADE AGREEMENTS* 87, 95 (Christopher Heath & Anselm Kamperman Sanders eds., 2007) (explaining, with regard to the MFN obligation under the TRIPS Agreement, that “every advantage, favour, privilege or immunity in regard to the protection of intellectual property, negotiated under a free trade agreement between two or more countries needs to be automatically extended to all nationals of WTO Members.”). *Cf.* Tim Engelhardt, *Geographical Indications Under Recent EU Trade Agreements*, 46 *INT’L REV. OF INTELL. PROP. AND COMPETITION L.* 781, 792 (2015) (mentioning that, while the MFN principle could not be violated if the GI listed in an annex to an FTA receives the same level of protection as other GIs, the situation might be different if such GIs in fact receive better protection than other GIs).

interested may file with the Registrar a statement of objection with respect to the GI or the translation, based on prescribed grounds.²⁰¹ Those grounds include: (i) that, at the time of publication, the GI or the translation is identical to a term customary in common language in Canada as the common name for the concerned product (agricultural product or food); and (ii) that, at the time of publication, the GI or the translation is confusing with a registered trademark, a trademark previously used in Canada and not abandoned, or a trademark in respect of which an application for registration was previously filed in Canada and remains pending.²⁰² In relation to the TPP, these grounds correspond with grounds for opposition stipulated in Article 18.32.1 (for GIs), Article 18.32.5 (for translations), and Article 18.36.1 (for GIs protected or recognized pursuant to an international agreement) of the TPP.

A noteworthy exception is stipulated in the CETA Implementation Act: namely, despite the provisions of the TM Act concerning opposition, the Registrar must enter the GIs in the EU to be protected under CETA, which are set out in Schedule 6 of the Implementation Act, on the list of protected GIs.²⁰³ Accordingly, no objection may be filed with respect to those GIs in the EU. In relation to the TPP, such nonexistence of the objection procedure is allowable by virtue of its transitional arrangements.²⁰⁴

2. *Request for Removal from List applicable to GIs in General*

The TM Act sets forth two procedural possibilities for removal of a GI or any translation of a GI from the list of protected GIs and translations: (i) by means of the publication of a statement by the Minister specifying that the GI or the translation is to be removed; and (ii) by means of an order made by the Federal Court for the removal of the GI or the translation.²⁰⁵ Although the former possibility was stipulated in the TM Act before amendment,²⁰⁶ the latter is a new procedure introduced by the amendment. As for the latter

201. See TM Act, *supra* note 193, § 11.13(1), (2), (2.1).

202. See *id.*

203. See CETA Implementation Act, *supra* note 192, § 115(1) (providing that the Registrar must enter the indications set out in Schedule 6 on the list as soon as feasible after the section comes into force). A similar provision can be found with respect to certain Korean GIs. See *id.* § 132(1). See also *infra* Part IV. B. 2 regarding those Korean GIs.

204. Art. 18.36.6(a) of the TPP is applicable to the CETA case, as a result of which the obligations regarding opposition stipulated in art. 18.36.1 need not to be observed. See TPP, *supra* note 10, art. 18.36.6(a). See also *supra* Part III. E.

205. See TM Act, *supra* note 193, § 11.12(4).

206. See *id.* § 11.12(4), amended by the CETA Implementation Act (Sept. 21, 2017). It is noted that removal of a translation is not stipulated in the subsection, as entry of a translation in the list is introduced as a result of the amendment.

route, subsection 11.21(1) of the TM Act provides that, on the application of any person interested, the Federal Court has exclusive jurisdiction to order the Registrar to remove a GI or a translation from the list based on prescribed grounds including: (i) that, on the day of the application for removal, the GI or the translation is identical to a term customary in common language in Canada as the common name for the product concerned; and (ii) that, at the time of publication, the GI or the translation is confusing with a registered trademark, a trademark previously used in Canada and not abandoned, or a trademark in respect of which an application for registration was previously filed in Canada and remains pending or has resulted in registration when the application for removal is made.²⁰⁷ In relation to the TPP, those grounds correspond with grounds for cancellation stipulated in Article 18.32.2 (for GIs) and Article 18.32.5 (for translations) of the TPP.

Again, the GIs in the EU to be protected under CETA are exempted from challenges: namely, provisions on GI removal from the Registrar's list by means of an order made by the Federal Court (Section 11.21) do not apply to a protected GI that is listed in Part A of Annex 20-A, as amended from time to time, of Chapter 20 of CETA.²⁰⁸ It is noted that Part A of Annex 20-A to CETA contains GIs identifying products as originating in the EU only (hereinafter referred to as "CETA GIs").²⁰⁹ The exemption means that not only GIs existing in CETA as signed but also GIs added later to Part A of CETA's Annex 20-A are exempted from removal through a Federal Court order. In addition, the TM Act provides that those CETA GIs are not subject to a provision on an exception for customary names allowing third parties to adopt, use, or register as a trademark or otherwise a protected GI that is identical to a term customary in common language in Canada as the common name for the product concerned.²¹⁰ This effectively prevents third parties from the defense that a protected GI has become a generic term. A similar exemption is granted to the GIs in South Korea included in the Canada-Korea Free Trade Agreement,²¹¹ which are specified in the TM Act,²¹² unlike open-ended CETA GIs. In relation to the TPP, the unavailability of cancellation procedures with respect to CETA GIs is considered to be allowable, as the TPP does not require a Party to provide cancellation procedures with respect

207. See TM Act, *supra* note 193, § 11.21(2), (3).

208. See TM Act, *supra* note 193, § 11.22.

209. See CETA, *supra* note 9, art. 20.18 (stipulating that "the indications listed in Part A of Annex 20-A are geographical indications which identify a product as originating in the territory of the European Union or a region or locality in that territory").

210. See TM Act, *supra* note 193, §§ 11.22, 11.18(2)(a).

211. Free Trade Agreement between Canada and the Republic of Korea, Can.-S. Kor., art. 16.10.1, Sept. 22, 2014, 2015 Can. T.S. No. 3.

212. See TM Act, *supra* note 193, § 11.23.

to GIs that are protected, not through administrative procedures, but pursuant to an international agreement.²¹³

3. *Analysis concerning Compliance with MFN Obligation*

It is considered that special treatment under the TM Act of the GIs protected by CETA that identify products as originating in the EU, in particular exemption for CETA GIs from removal challenges, raises a serious question about whether or not such treatment is at odds with Canada's MFN obligation under Article 4 of the TRIPS Agreement.

In view of the aforementioned case of DS 174/290, it would be appropriate, for the purpose of MFN analysis, to compare: (i) with respect to opposition, the effective equality of opportunities for the group of nationals of WTO Members other than Canada and EU Member States who wish to seek GI protection under the TM Act and the group of EU's nationals who wish to seek GI protection under the TM Act; and (ii) with respect to removal (cancellation), the effective equality of opportunities with regard to maintenance²¹⁴ of GI protection for the group of nationals of WTO Members other than Canada and EU Member States as well as Korea²¹⁵ who have their GIs²¹⁶ on the Registrar's list and the group of EU's nationals who have their GIs²¹⁷ on the Registrar's list.²¹⁸

213. See TPP, *supra* note 10, art. 18.36.

214. See TRIPS Agreement, *supra* note 1, art 3, n.3 ("For the purposes of Articles 3 and 4, 'protection' shall include matters affecting the availability, acquisition, scope, maintenance and enforcement of intellectual property rights as well as those matters affecting the use of intellectual property rights specifically addressed in this Agreement.")

215. Korea is excluded here in the comparison, in view of the fact that some Korean GIs enjoy exemption from the possibility of being removed from the Registrar's list after third parties' challenges. See TM Act, *supra* note 193, § 11.23. As a test for inconsistency with the MFN obligation under art. 4 of the TRIPS Agreement, it would be sufficient to demonstrate that, with regard to IP protection, there is "any advantage, favour, privilege or immunity" granted by Canada to the nationals of the EU but not accorded to the nationals of certain WTO Members. See TRIPS Agreement, *supra* note 1, art. 4.

216. These are the GIs the protection of which has been made available by the TM Act to the group of nationals of such WTO Members. It is not presumed here, although it would basically be the case, that those GIs refer to geographical areas in such WTO Members.

217. These are the GIs the protection of which has been made available by the TM Act to the group of EU's nationals. Such GIs would include CETA GIs and others.

218. See Panel Report, *supra* note 73, at ¶ 7.134 (with regard to the national treatment ("NT") obligations under the TRIPS Agreement, "the Panel will examine whether the difference in treatment affects the 'effective equality of opportunities' between the nationals of other Members and the European Communities' own nationals with regard to the 'protection' of intellectual property rights, to the detriment of nationals of other Members"), at ¶ 7.182 (comparing, for the purpose of analysis on the NT obligations under the TRIPS Agreement, the effective equality of opportunities for the group of nationals of other WTO Members who may wish to seek GI protection under the EC Regulation and the group of the EC's own nationals who may wish to seek GI protection under the EC Regulation). Cf. Appellate Body Report, *United States – Section 211 Omnibus Appropriations Act of 1998*, at ¶ 306, WTO Doc. WT/DS176/AB/R (adopted Feb. 1, 2002) (comparing, for the purpose of analysis on the MFN obligations under the TRIPS Agreement, trademark protection in the U.S. for each of two original owners of two

a. Opposition

Although there might be a room for considering the exemption applied to the GIs in the EU in Schedule 6 from the opposition process, to which GIs in other WTO members would be subject, to be *de facto* discrimination in favor of EU's nationals, it would be possible to regard the exemption as a difference in treatment that does not amount to such discrimination. According to the Canadian Government, consultations were conducted, during the CETA negotiation process, with stakeholders, including meetings with individual trademark holders.²¹⁹ In view of this, an argument could be made that possible oppositions had already been taken into account in the course of the consultation process, even though the consultation process would not be regarded as an equivalent to a formal opposition procedure, particularly from the viewpoint of opportunities for stakeholders outside Canada to participate in the consultation process.

The focus of the present analysis is now shifted to opportunities for interested parties to request for removal from the list of protected GIs.

b. Request for Removal from the List

Exemption for CETA GIs including those added to Part A of CETA's Annex 20-A in the future from removal challenges could be inconsistent with Canada's MFN treatment obligation under Article 4 of the TRIPS Agreement, as explained below.

Firstly, the TM Act discriminates among GIs on the Registrar's list, with respect to the maintenance of protection, between those located in WTO Members other than EU Member States as well as Korea, on the one hand, and CETA GIs on the other hand, all of which are located in EU Member States. Specifically, the TM Act would accord less favorable treatment to GIs on the Registrar's list other than CETA GIs and a few specified Korean GIs than to CETA GIs on the Registrar's list, in the sense that the former GIs have to keep facing the risk of being removed from the list of protected GIs after being challenged by interested parties while the latter GIs, namely CETA GIs, are free from such a risk.²²⁰ Furthermore, the challenges that the

U.S. trademarks, respectively, both of which are the same or substantially similar to signs in a Cuban trademark used in connection with a business or assets confiscated in Cuba, with those two original owners being a national of Cuba and a national of a country other than Cuba or the United States).

219. See CANADA, *supra* note 102, at 21.

220. See TM Act, *supra* note 193, §§ 11.12(4), 11.21, 11.22. Although even the CETA GIs (or their translations) face the possibility of removal from the list by means of the publication of a statement by

former GIs have to face include those on account of the subsequently arising ground that the GIs in question have become generic after the commencement of GI protection, while the latter GIs do not have to face such possibilities, which amounts to a shield against becoming generic.²²¹ Thus, the differences in treatment are not only procedural but also substantive. The exemption from the risk would amount to “any advantage, favour, privilege or immunity” granted by Canada, with regard to intellectual property protection, to the CETA GIs on the Registrar’s list, all of which refer to geographical areas within the EU,²²² and accordingly to the beneficiaries of such CETA GIs.

Secondly, although the TM Act does not discriminate on its face between nationals, a “link” should be taken into account between the location of a geographical area to which a GI refers and certain persons, as discussed by the panel of DS 174/290.²²³ A link between such a location and certain persons can be seen in the TM Act as well. Specifically, the TM Act provides that no person shall use in connection with a business a protected GI (or a translation on the list) in respect of an agricultural product or food belonging to the same category as that for the GI, if the agricultural product or food does not originate in the territory indicated by the GI, or if the agricultural product or food originates in the territory but it was not produced or manufactured in accordance with the law applicable to that territory.²²⁴ This would effectively require that a person using a protected GI in connection with a business be a person connected with an agricultural product or food that originates in the territory indicated by the GI and that is produced or manufactured in accordance with the law applicable to that territory.²²⁵ In addition, the responsible authority, namely, the person, firm or other entity that is a party to GI proceedings under the TM Act, must be sufficiently connected with and knowledgeable about the agricultural product or food concerned.²²⁶

With the aforementioned difference in treatment under the TM Act depending on the location of the geographical area to which a GI refers,

the Minister, as explained, they are free from the risk of being removed from the list based on challenges by interested parties. *See id.*

221. *See id.* §§ 11.21(2)(b), 11.22. *See also supra* Part IV. B. 2. *Cf.* Lisbon Agreement, *supra* note 131, art. 6.

222. *See supra* note 209.

223. *See* Panel Report, *supra* note 73, at ¶¶ 7.186, 7.197–199.

224. *See* TM Act, *supra* note 193, § 11.15(2), (3).

225. *See id.* *See also* TM Act, *supra* note 193, § 2 for the definition of GI, which corresponds to that in the TRIPS Agreement, art. 22.1, and refers to “the territory of a WTO Member, or a region or locality of that territory.”

226. *See* TM Act, *supra* note 193, § 11.11(1).

working in favor of CETA GIs located in the EU, and the link under the TM Act between such a location and persons who are allowed to use a protected GI, the TM Act would work in favor of persons connected with agricultural products or foods that originate in the territories within the EU indicated by CETA GIs and that are produced or manufactured in accordance with the law applicable to those territories within the EU. In respect to the question to be considered, i.e., effective equality of opportunities with regard to maintenance of GI protection for the group of nationals of WTO Members other than Canada and EU Member States as well as Korea who have their GIs on the Registrar's list and the group of EU's nationals who have their GIs on the Registrar's list, the difference in treatment under the TM Act on the basis of the location of a GI would operate in practice to discriminate between the two groups, to the detriment of the former group.²²⁷

Accordingly, it could be considered that the TM Act would accord less favorable treatment to the nationals of WTO Members other than Canada and the EU as well as Korea than to the nationals of the EU for the purposes of Article 4 of the TRIPS Agreement. Furthermore, none of the exceptions in Articles 4 and 5 of the Agreement is relevant to the present consideration.

It is true that GIs in the EU that are not CETA GIs cannot enjoy the exemption, like GIs in any other WTO Members (except for a limited number of Korean GIs). Even so, attention should be paid to the fact that such a GI in the EU would have the possibility of being added to Part A of CETA's Annex 20-A and becoming entitled to the exemption,²²⁸ which is not the case with GIs located in other WTO Members.

The above analysis reveals that the exemption for CETA GIs from removal challenges by interested persons, including a shield against a challenge on the ground that a GI has subsequently become generic in Canada, raises a serious question as to Canada's fulfillment of its MFN obligation under Article 4 of the TRIPS Agreement.

c. Implications of Direct Protection on the MFN Issue

Exemption for CETA GIs from opposition procedures and removal challenges, which causes the MFN questions as discussed above, is considered to be a consequence of the direct protection of CETA GIs obliged

227. See Panel Report, *supra* note 73, ¶ 7.194 (stating that "the distinction made by the Regulation on the basis of the location of a GI will operate in practice to discriminate between the group of nationals of other Members who wish to obtain GI protection, and the group of the European Communities' own nationals who wish to obtain GI protection, to the detriment of the nationals of other Members").

228. See TM Act, *supra* note 193, § 11.22. See also CETA, *supra* note 9, art. 20.22.1. See also *supra* Part IV. B. 2.

by CETA's GI provisions. That direct protection, without the possibility of intervention of national procedure, can be seen in CETA's GI provisions obliging Parties to protect each of the GIs listed in Annex 20-A of CETA unless such a GI ceases to be protected in its place of origin or falls into disuse in that place.²²⁹

This makes a clear contrast with GI provisions of the EU-Singapore FTA, according to which Singapore is allowed to examine GIs listed in Annex 10-A of the FTA for registration and to make them subject to national objection and cancellation procedures.²³⁰ Indeed, the GI Act 2014 of Singapore provides that the Registrar shall examine whether an application for registration of a GI satisfies prescribed requirements²³¹ and stipulates grounds for refusal of registration, from which even the EU GIs listed in Annex 10-A of the FTA are not exempted.²³² Those grounds include the generic nature, in Singapore, of the GI in question,²³³ and the existence of a prior conflicting GI or trademark.²³⁴ Any person may, within the prescribed time after the date of the publication of the application, give notice to the Registrar of his/her opposition to the registration.²³⁵ After registration of a GI, it may be cancelled: by the Registrar upon an application by the registrant; or by the Court or the Registrar upon an application by any other person, on grounds including the grounds for refusal of registration.²³⁶ Grounds for the cancellation of the registration of a GI include its becoming generic subsequent to its registration; namely, that, in consequence of a lack of any activity by any interested party of goods identified by a registered GI, the GI has become the common name of those goods in Singapore.²³⁷

Direct protection of GIs based on a bilateral international agreement like an FTA, particularly when the agreement obligates its Parties to exempt those GIs from cancellation procedure, may result in advantageous treatment of those GIs over others, and could bring about the MFN question, considering links between the geographical areas of GIs and certain persons associated with such areas, as discussed above. In contrast, applying national procedure including cancellation procedure to all GIs without exception for

229. See CETA, *supra* note 9, art. 20.19.2, 20.19.7. Protection of certain GIs are subject to exceptions including grandfathering, but making GIs listed in Annex 20-A (including those certain GIs) subject to the national opposition or cancellation procedure is not foreseen under CETA.

230. See EU-Singapore FTA, *supra* note 8, art. 10.17.2, 10.17.3.

231. See GI Act 2014, *supra* note 81, § 43(1).

232. See *id.* § 41.

233. See *id.* § 41(1)(e).

234. See *id.* § 41(3)–(7).

235. See *id.* § 45(2).

236. See *id.* § 52(1), (2).

237. See *id.* § 52(2)(e).

those specified in an FTA, as seen in the Singapore case, would eliminate the risk of that MFN question.

C. Japan's Legislation for GI Protection in view of EU-Japan EPA Negotiations – A Partial Direct Protection Case

This Section gives thoughts to Japan's recent legislation, in view of EU-Japan EPA negotiations, to establish a *sui generis* GI protection system and further to add to it a GI "designation" procedure on the premise of an international agreement. The designation procedure may be called a partial or modified direct protection process, in the sense that it eliminates the need to file applications for GI registration in Japan and relaxes some requirements for GI protection while it allows the general public to submit to the national competent authority a written opinion on proposed protection of each GI. A close look at the system reveals that such arrangements also involve MFN questions as in the Canada's legislation – although in a vaguer manner.

The EU-Japan EPA negotiations, launched officially in March 2013, reached "an agreement in principle on the main elements" of the Agreement in July 2017.²³⁸ "Subsequent to the agreement in principle, the relevant governmental agencies of Japan published 210 GIs for opinion regarding their protection, of which 71 GIs were for agricultural products and foodstuffs²³⁹ and 139 for alcoholic beverages including wines and spirits.²⁴⁰ The European Commission claims that the Agreement provides for "direct protection of GIs" under the EPA and "removal of all associated charges or taxes for any user registration."²⁴¹

238. European Commission Press Release IP/17/1902, EU and Japan reach agreement in principle on Economic Partnership Agreement (July 6, 2017).

239. Ministry of Agriculture, Forestry and Fisheries, *Information on Publication for Designation*, (July 11, 2017), http://www.maff.go.jp/e/policies/intel/gi_act/designation.html (last visited Dec. 1, 2018). The 71 GIs do not include those for such alcoholic beverages as beers, as the Agricultural GI Act referred to below does not cover alcoholic beverages. See Agricultural GI Act, *infra* note 256, art. 2(1).

240. "Nichi EU EPA kōshō o tsūjita chiriteki hyōji no hogo" ni taisuru iken boshū ni tsuite [Invitation for public opinion concerning "Protection of geographical indications through Japan-EU EPA negotiations"], E-GOV (July 12, 2017), <http://search.e-gov.go.jp/servlet/Public?CLASSNAME=PCMMSTDETAIL&id=410290041&Mode=3> (last visited Dec. 1, 2018).

241. Eur. Comm'n, *EU-Japan EPA – The Agreement in Principle*, at 10 (July 6, 2017), http://trade.ec.europa.eu/doclib/docs/2017/july/tradoc_155693.doc.pdf (last visited Dec. 1, 2018).

The EPA negotiations were concluded in December 2017²⁴² and the negotiated text was signed on July 17, 2018.²⁴³ The EU-Japan EPA²⁴⁴ generally stipulates GI protection for agricultural products and foodstuffs at the level of additional protection provided for in Article 23 of the TRIPS Agreement,²⁴⁵ although the EPA does not stipulate the additional level of GI protection vis-à-vis subsequent trademarks.²⁴⁶ Exception to the protection includes the prior use exception, which, however, expires at the end of a seven-year transitional period from the date of protection.²⁴⁷ The pertinent annex to the EPA lists 72 GIs²⁴⁸ for agricultural products and foodstuffs in the EU.²⁴⁹ The annex clarifies that the protection of specified individual components of multi-component GIs, such as the component “camembert” of the GI “Camembert de Normandie,” is not sought.²⁵⁰

The following Subsections look into Japan’s relevant legislation.

1. GI Registration System

Developments regarding the Japanese national legal system related to GIs, in particular establishment of a new *sui generis* GI protection system is summarized in this Subsection.

Japan has provided TRIPS-level GI protection, since its implementation of the TRIPS Agreement, through its domestic laws and regulations, specifically the Unfair Competition Prevention Act²⁵¹ and the Trademark Act²⁵² and, for GIs for wines and spirits, the Indication Standards Concerning

242. European Commission Press Release IP/17/5142, EU and Japan finalize Economic Partnership Agreement (Dec. 8, 2017).

243. European Commission Press Release IP/18/4526, EU and Japan sign Economic Partnership Agreement (July 17, 2018).

244. Agreement between the European Union and Japan for an Economic Partnership, EU-Japan, July 17, 2018, <http://trade.ec.europa.eu/doclib/press/index.cfm?id=1684> (last visited Dec. 1, 2018) [hereinafter “EU-Japan EPA”].

245. *See id.* art. 14.25.1(a).

246. *See id.* art. 14.27.1 (stipulating that each Party shall refuse to register a subsequent trademark the use of which would be likely to mislead as to the quality of the good). *See also infra* Part IV. C. 1 regarding the relevant feature of the Japan’s GI protection system.

247. *See id.* art. 14.29.1.

248. Of the 72 EU GIs listed in Annex 14-B of the EU-Japan EPA, the GI “Prosciutto di Parma” has been registered individually in Japan. *See id.* Annex 14-B. *See also infra* Part IV. C. 3.

249. *See* EU-Japan EPA, *supra* note 244, Annex 14-B.

250. *See id.* With respect to certain individual GIs, the annex makes some further clarifications, including the note on the GI “Parmigiano Reggiano” that the EPA GI provisions shall in no way prejudice the right of any person to use or to register in Japan a trademark containing or consisting of the term “parmesan” in respect of hard cheeses, unless the use would mislead the public as to the geographical origin of the good in question.

251. Fusei kyōsō bōshihō [Unfair Competition Prevention Act], Law No. 47 of 1993 (Japan).

252. Shōhyōhō [Trademark Act], Law No. 127 of 1959 (Japan) [hereinafter “Trademark Act”].

Geographical Indications²⁵³ issued in accordance with Article 86-6(1) of the Act on Securing of Liquor Tax and on Liquor Business Associations²⁵⁴ as well as the Trademark Act.²⁵⁵ In view of its EPA negotiations with the EU, Japan established a *sui generis* system with administrative GI registration for the protection of GIs for agricultural, forestry and fishery products and foodstuffs by enacting the Act on Protection of the Names of Specific Agricultural, Forestry and Fishery Products and Foodstuffs²⁵⁶ (hereinafter referred to as “Agricultural GI Act”) promulgated on June 25, 2014, which went into force on June 1, 2015.²⁵⁷ According to the Agricultural GI Act, a group of producers that conducts production process management may receive registration on a product if prescribed requirements are met.²⁵⁸ A producer as a member of a registrant group may affix a GI on a product pertaining to the registration or its package, container, or invoice.²⁵⁹ The same applies to a person who has directly or indirectly received the product from such a producer.²⁶⁰ The Act prohibits other persons from affixing a registered GI or an indication similar thereto on products belonging to the classification to which the product pertaining to the registration belongs, or their packages, containers, or invoices, with some exceptions including those on prior trademarks and prior uses.²⁶¹ The prohibition does not require misleading the public as to the geographical origin of the product in question, and “similar” indications include, according to the Act’s implementing regulation, indications used in translation or accompanied by expressions such as “kind,” “type,” “style,” “imitation” or the like.²⁶² Thus, in this sense,

253. Shurui no chiriteki hyōji ni kansuru hyōji kijyun o sadameru ken [Notice on Establishing Indication Standards Concerning Geographical Indications for Liquor], National Tax Agency Notice No. 19 of 2015 (originally issued as Chiriteki hyōji ni kansuru hyōji kijyun o sadameru ken [Notice on Establishing Indication Standards Concerning Geographical Indications], National Tax Agency Notice No. 4 of 1994) (Japan).

254. Shuzei no hozon oyobi shuruigyō kumiai tō ni kansuru hōritsu [Act on Securing of Liquor Tax and on Liquor Business Associations], Law No. 7 of 1953 (Japan).

255. See Council for Trade-Related Aspects of Intellectual Property Rights, *Review of Legislation on Trademarks, Geographical Indications and Industrial Designs: Japan*, III, ¶¶ 6–12, WTO Doc. IP/Q2/JPN/1 (Aug. 13, 1997).

256. Tokutei nōrinsuisanbutsu tō no meishō no hogo ni kansuru hōritsu [Act on Protection of the Names of Specific Agricultural, Forestry and Fishery Products and Foodstuffs], Law No. 84 of 2014 (Japan) [hereinafter “Agricultural GI Act”].

257. See generally Sachiko Tanaka, *Analysis of a Newly Enacted Law in Japan on Geographical Indications (GIs) – Private Rights Protection or Regulatory Regime Creation?* –, 40 A.I.P.P.I. (Bimonthly Journal of AIPPI JAPAN) 71 (2015) (presenting the overall analysis of the Agricultural GI Act).

258. See Agricultural GI Act, *supra* note 256, art. 6.

259. See *id.* art. 3(1).

260. See *id.*

261. See *id.* art. 3(2).

262. Tokutei nōrinsuisanbutsu tō no meishō no hogo ni kansuru hōritsu sekō kisoku [Ordinance for Enforcement of the Act on Protection of the Names of Specific Agricultural, Forestry and Fishery

the GI protection can be considered to be an extension of the higher-level protection provided for in Article 23 of the TRIPS Agreement, although the Agricultural GI Act has an uncommon feature in relation to trademarks,²⁶³ and for that reason the higher-level protection is not full-fledged. After the product pertaining to a GI is registered for protection, a group of producers intending to conduct the production process management for the registered product may receive a registration of a change to add the information pertaining to the group.²⁶⁴

Regarding the opposition procedure available for the *sui generis* GI registration system, the Agricultural GI Act provides that any person may submit a written opinion concerning the application for registration within three months from the date of publication,²⁶⁵ although the Act does not make available procedures for opposition with respect to translations of GIs, as provided for in Article 18.32.5 of the TPP. As for the cancellation procedure, the Act stipulates that the Minister of Agriculture, Forestry and Fisheries may cancel all or part of a registration when, *inter alia*, the name of the registered product has become a generic term.²⁶⁶ The Act does not provide for any cancellation procedure on the request of interested parties, but the Ministry of Agriculture, Forestry and Fisheries (“MAFF”) explains that a complaint against registration may be raised in accordance with laws of general nature, specifically, the Administrative Complaint Review Act and the Administrative Case Litigation Act.²⁶⁷

Products and Foodstuffs], Ministry of Agriculture, Forestry and Fisheries Ordinance No. 58 of 2015, art. 2 (Japan).

263. Neither the Agricultural GI Act nor the Trademark Act specifically provides for the refusal or invalidation of the registration of a trademark, which contains or consists of a GI registered under the *sui generis* system with respect to goods not originating in the territory indicated, although a subsequent trademark may be refused or invalidated if it is *confusing* with an earlier GI in accordance with existing Article 4(16) etc. of the Trademark Act. In that sense, it can be said that the *sui generis* system does not provide the higher-level of GI protection vis-à-vis trademarks. The Trademark Act was amended, concurrently, with the establishment of the *sui generis* system, to include a provision for limiting the effects of trademark rights so that the scope of trademarks’ exclusive rights does not cover the legitimate use of registered GIs, so long as the use of such GIs is not for unfair competition purposes. *See* Trademark Act, *supra* note 252, art. 26(3). A side effect of this limitation on trademark rights is the possibility that the exclusive rights of a prior registered trademark may be eroded when a similar subsequent GI for a similar product happens to be registered due to possible difference in interpreting similarity of marks or products between practices under the Trademark Act and those under the Agricultural GI Act (despite the provision of the Agricultural GI Act to reject an application for registration of a GI conflicting with a registered trademark unless the trademark owner’s consent has been obtained. *See* Agricultural GI Act, *supra* note 256, art. 13(1)(iv)(b), 13(2)).

264. *See* Agricultural GI Act, *supra* note 256, art. 15(1).

265. *See id.* art. 9(1). A question remains whether the opportunity to submit a written opinion can be regarded as the opposition procedure in a strict sense, as the Act does not ensure a decision stating a reason.

266. *See id.* art. 22(1).

267. *See* Food Industry Affairs Bureau, MAFF, *Chiriteki Hyōji Hō ni tsuite – Tokutei Nōrinsuisanbutsu tō no Meishō no Hogo ni Kansuru Hōritsu [On Geographical Indication Act – Act on*

As for enforcement, the Minister of Agriculture, Forestry and Fisheries may order a violator to remove or erase the GI in question or an indication similar thereto,²⁶⁸ and any person who has further violated the order faces criminal penalties.²⁶⁹ No civil remedies are provided for in the Agricultural GI Act; however, damages might be awarded by courts in accordance with the Civil Code if a violator is found to have intentionally or negligently infringed the protected interest of a registrant.²⁷⁰

2. *GI Designation System*

Effective on December 26, 2016, the Act was amended to include provisions for Japan to protect the names of agricultural, forestry and fishery products and foodstuffs mutually with another state having an “equivalent system.”²⁷¹ Such a state is supposed to have concluded an international agreement with Japan on such mutual protection and to have a competent authority to take necessary measures when the Japanese Government or a registered group of producers asks for appropriate protection of a name of the Japanese side to be protected in accordance with the agreement.²⁷² Under the amended Agricultural GI Act, the Minister of Agriculture, Forestry and Fisheries may designate the products of the aforementioned state whose names are protected under its “equivalent system.”²⁷³ No details on equivalence can be found in the Act. This designation would allow a state with an equivalent system to have Japan protect GIs for that state through simplified procedures without a need for filing applications for GI registration.

3. *Analysis concerning Compliance with MFN Obligation*

Some differences exist, between the designation route and the ordinary route for registration, in terms of substantive requirements for protection and the effects of protection. In the designation route, requirements for protection are relaxed, in comparison with the ordinary registration route, so as not to include the requirements: (i) that the registrant be a group of producers that

Protection of the Names of Specific Agricultural, Forestry and Fishery Products and Foodstuffs] 9 (Dec. 15, 2017).

268. See Agricultural GI Act, *supra* note 256, art. 5. In this relation, any person who considers that violation exists may report that to the Minister of Agriculture, Forestry and Fisheries. See Agricultural GI Act, art. 35(1).

269. See Agricultural GI Act, *supra* note 256, art. 39.

270. See MINPŌ [CIV. C.] art. 709 (Japan).

271. See Agricultural GI Act, *supra* note 256, ch. IV.

272. See *id.* art. 23(1).

273. See *id.*

conducts prescribed production process management;²⁷⁴ and (ii) that the quality, reputation or other established characteristic of the product in question be essentially attributable to the specified place of production.²⁷⁵ Unlike the ordinary registration route, there is no provision in the designation route for altering a registration to add a group of producers intending to conduct the production process management for the registered product, based on a request of such a group, possibly, even against the will of the original registrant.²⁷⁶ Instead, a person who is entitled to affix a GI under the equivalent system may affix the GI on a product pertaining to the designation or its package, container, or invoice.²⁷⁷ With regard to the opposition and cancellation procedures, the amended Agricultural GI Act provides for similar procedures for the designation route as those for the ordinary registration route.²⁷⁸

Such differences may amount to favour (although vaguer in comparison with the case of Canada) to nationals of the nation taking advantage of the designation route. The Agricultural GI Act is based on the premise that the registrant must be a group of producers conducting prescribed production process management (namely, based on self-control by such a group),²⁷⁹ and that authorities may make a group report on its business or inspect its operation as necessary.²⁸⁰ This is not shared with the European system. Under the *sui generis* GI protection system in accordance with the EU Regulation, verification of compliance with the product specification before placing products on the market is supposed to be carried out for either: (i) GIs that designate products originating within the EU, by competent

274. Compare *id.* arts. 2(6), 6, 13(1)(ii) with respect to the ordinary route for registration (stipulating, respectively: that the term “production process management” as used in the Act means operations conducted by a group of producers including guidance, examination and other operations that are necessary to conform the production by the producers of the group to the specification concerned; that a group of producers that conducts production process management may receive GI registration; and that registration shall be refused when, *inter alia*, the method of production process management does not meet the standards provided for in a MAFF Ordinance), with *id.* art. 29 with respect to the designation route (stipulating criteria for designation where no requirement is mentioned regarding production process management).

275. Compare *id.* arts. 2(2)(ii), 13(1)(iii)(a) with respect to the ordinary route for registration (stipulating, in combination, that registration shall be refused when the requirement is not met that the quality, reputation or other established characteristic of the product concerned is essentially attributable to the specified place of production), with *id.* art. 29 with respect to the designation route (stipulating criteria for designation where no requirement is mentioned regarding characteristic of the product concerned).

276. See *id.* art. 15 with respect to the ordinary route for registration. There is no corresponding provision for the designation route.

277. See *id.* arts. 3(1), 30. A person who has directly or indirectly received the product from such an entitled person may also affix the GI to the product. *Id.*

278. See *id.* arts. 25, 32.

279. See *supra* note 274.

280. See Agricultural GI Act, *supra* note 256, art. 34(1).

authorities and/or control bodies as provided for in Regulation (EC) No 882/2004; or (ii) GIs that designate products originating in third countries, by public authorities designated by the third countries and/or product certification bodies.²⁸¹ If the designation route is utilized, groups in Europe would not have to meet Agricultural GI Act's requirement that the registrant be a group of producers that conducts prescribed production process management, and such groups would be free from a risk that a designation could be altered to add a group of producers intending to conduct the production process management for the designated product, based on a request of such a group.

The aforementioned possible favour is considered to raise a MFN question, probably in a less apparent manner than that in the case of Canada. This situation is brought about by the partial removal of requirements for, and the modification of effects of, GI protection for the designation route. Unlike the case of Canada, national procedures are applied, at least partially, to the envisaged mutual protection process. The national procedures to be applied include giving the public an opportunity to submit a written opinion concerning the proposed designation,²⁸² possibly in view of a relevant TPP provision.²⁸³ Still, the lesser requirements and risks for GIs for products originating in a certain country could lead to the MFN question. In addition, one may ask what the phrase "equivalent system" in the Agricultural GI Act exactly means.

Developments on the EU-Japan EPA indicate that the designation system is likely to be actually used for GI protection under the EPA. On July 11, 2017, MAFF published 71 EU product names intended to be designated under the amended Agricultural GI Act as a foreseen result of the EU-Japan EPA negotiations, allowing any person to submit a written opinion about the proposed designation within three months from the date of the publication.²⁸⁴ The published list includes all the 19 names on the EU's claw-back list for agricultural products and foodstuffs with the sole exception of separately

281. See EU Regulation, *supra* note 36, art. 37(1), (2). See also BLAKENEY, *supra* note 32, at 145–46.

282. See Agricultural GI Act, *supra* note 256, art. 25.

283. See TPP, *supra* note 10, art. 18.36.1.

284. See MAFF, *supra* note 239. See also Keiko Fujibayashi et al., *Public Comment Period Open for EU-Proposed Geographical Indications*, USDA FAS, GLOBAL AGRIC. INFO. NETWORK ("GAIN") REP. No. JA7098 (July 12, 2017), https://gain.fas.usda.gov/Recent%20GAIN%20Publications/Public%20Comment%20Period%20Open%20for%20EU-Proposed%20Geographical%20Indications_Tokyo_Japan_7-12-2017.pdf (last visited Dec. 1, 2018). See generally Agricultural GI Act, *supra* note 256, art. 25 (stipulating that, when publication for GI designation is made, any person may submit a written opinion about the designation within three months from the date of the publication).

protected “Prosciutto di Parma.”^{285, 286} For example, the list includes the following four names: Asiago, Φέτα (Feta), Fontina, and Gorgonzola. Subsequent to the written opinion submission period, on December 15, 2017, MAFF published a list of GIs to be designated on the date of the entry into force of the EU-Japan EPA, containing all the proposed names except the republished “Comté.”²⁸⁷ GI arrangements under the EPA, explained in a document published by MAFF on the same day, do not include grandfathering arrangements as in CETA, while confirmation is made that certain components of compound GIs, such as “camembert” and “mozzarella,” are generic and that the term “Parmesan” is outside the scope of protection of “Parmigiano Reggiano.”²⁸⁸ Indeed, the GI arrangements contain the settlements under which even prior use would have to be phased out in a seven-year transitional period from EPA’s entry into force and that the use of translation and transliteration of a protected GI for a specification-incompliant product would be prohibited.²⁸⁹ Accordingly, such a controversial term as “Feta” (let alone the original term “Φέτα”) would be protected, with the effect that even prior use by third parties would have to be terminated within the transitional period. With regard to prior use, steps will be taken for the amendment of the Agricultural GI Act to restrict the prior use exception to the seven-year period vis-à-vis protected GIs in general.²⁹⁰ No specific information was published on the occasion of the

285. See MAFF, *supra* note 239.

286. In respect of “Prosciutto di Parma,” an ordinary application for registration had been filed under the Agricultural GI Act and registration was granted on Sept. 15, 2017 (Registration number: 41; Registered names: “Prosciutto di Parma” and “Parma Ham”). See Daisuke Sasatani & Christopher Riker, *Prosciutto di Parma GI Registered in Japan*, USDA FAS, GAIN REP. NO. JA7118 (Sept. 21, 2017), https://gain.fas.usda.gov/Recent%20GAIN%20Publications/Prosciutto%20di%20Parma%20GI%20Registered%20in%20Japan_Tokyo_Japan_9-21-2017.pdf (last visited Dec. 1, 2018). Furthermore, the indication “PROSCIUTTO DI PARMA” had already been protected in Japan through its registration as a regional collective trademark (Registration number: 5073378; Date of registration: Aug. 31, 2007).

287. See MAFF, *Information on GIs subject to be designated* (Dec. 15, 2017), http://www.maff.go.jp/e/policies/intel/gi_act/designation2.html (last visited Dec. 1, 2018). “Comté” was republished on Oct. 27, 2017. See MAFF, *supra* note 239.

288. See Food Industry Affairs Bureau, MAFF, *Nichi EU EPA (GI Bun’ya) no Saishū Gōi no Gaiyō [Outline of the Final Agreement under the Japan-EU EPA (GI Area)]* (Dec. 15, 2017).

289. See *id.* See also EU-Japan EPA, *supra* note 244, art. 14.29.1 (stipulating a transitional period of a maximum of seven years for phasing out GI uses), art. 14.25.1(a) (stipulating the scope of GI protection). Note, in relation to prior use, that the existence of the prior use of the GIs Asiago, Fontina, and Gorgonzola was confirmed on Feb. 16, 2018. See *id.* Annex 14-B.

290. See MAFF, *supra* note 288. After finishing writing this article, a bill was passed by the National Diet of Japan to amend the Agricultural GI Act so as to include, *inter alia*, provisions to restrict the prior use exception to the seven-year period from the date of GI registration or designation, and was promulgated on Dec. 7, 2018 (Law No. 88 of 2018 (Japan)) so that the amendment will enter into force on the date when the EU-Japan EPA takes effect, which will be Feb. 1, 2019. See KANPŌ [Official gazette] Gōgai [Extra ed.] No. 270 1, 3-5 (Dec. 7, 2018). See also European Council Press Release 837/18, EU-Japan trade agreement will enter into force on 1 February 2019 (Dec. 21, 2018).

announcement, concerning which written opinions had been submitted and how they, if any, had been taken into consideration. Depending on the operation of the designation system, it could effectively amount to a direct protection system.

V. CONCLUSION

The EU's FTA initiatives on GIs unequivocally include efforts to extend the enhanced level of protection to selected GIs in the EU for agricultural products and foodstuffs, covering all of those GIs in the claw-back list. Accordingly, the initiatives provide the potential for conflicts with owners of prior trademarks and prior users of relevant names (GIs, elements thereof, or possible translations) considered as generic terms by those users. The issue is how a solution could be found to such conflicts.

In response to the EU's FTA initiatives, two contrasting approaches have emerged: one embodied in the GI provisions of the EU-Singapore FTA and the other in those of CETA. The former provides rules on which conflicts could be solved in domestic procedures, and the latter works out compromises over individual GIs in FTA negotiations so as to describe the results of the compromises in an FTA. Background situations behind those two approaches seem to be, respectively: that, as for Singapore, stakeholders are generally outside the country, who are producing agricultural products and foodstuffs bearing names that conflict with GIs in the EU and exporting them to Singapore; and that, in the case of Canada, a considerable number of stakeholders are inside the country, as implied by the fact that the compromises were reached through consultations during the CETA negotiations.²⁹¹ In this light, it may be said that the choices of the approaches by the two respective countries are grounded in their situations.

However, the present study has revealed that while Singapore's rule-based approach has been combined with sophisticated domestic mechanisms for conflict resolution based on actions by interested parties, Canada's solution-based approach has led to questionable aspects of its GI protection regime through the direct protection feature of CETA, with its exemption for CETA GIs from cancellation challenges raising the MFN question,²⁹² apart from the lack of the opposition procedure being at odds with the TPP

291. See *supra* Part III. B and C for the compromises under CETA with regard to prior conflicting trademarks in Canada and certain grandfathered indications. Such compromises include the coexistence of "Prosciutto di Parma" and a prior conflicting registered trademark of a Canadian entity (Maple Leaf Meats, Inc.). See also *supra* note 28 as to the conflict (*Consorzio del Prosciutto di Parma v. Maple Leaf Meats, Inc.*, [2001] 2 F.C. 536 (Can.)).

292. See *supra* Part IV. B. 3.

commitments (although allowable by transitional arrangements). In addition, with regard to Canada's approach, resolution of conflicts on individual GIs in FTA negotiations between governments could potentially be inconsistent with the allocation of rights to GIs as private rights.²⁹³ The present study further finds that even partial or modified direct protection envisaging a domestic system of allowing third parties to submit observations opposing GI protection while exempting GIs in certain countries, based on bilateral agreements, from the ordinary filing and examination procedures, as seen in the case of Japan, could result in relinquishing certain requirements for GI protection, and thus is not free from the MFN question, although it may be in a vaguer form.²⁹⁴

With regard to Singapore's approach, the domestic mechanisms conducive to GI conflict resolution among relevant parties include: (i) the existence of the systems of third-party opposition and cancellation; (ii) the establishment of the system allowing third parties to file requests for qualifications on possible translations and the elements of multi-component GIs; (iii) the principle of registering a subsequent GI basically only with the consent of the right holder of a prior conflicting trademark; (iv) the possibility of registering a subsequent GI, nevertheless, if no opposition is filed, effectively urging such trademark holders to oppose GI registration during the opposition period; and (v) consultations between parties before making a decision in the opposition procedure.²⁹⁵

The rule-based approach taken by Singapore is considered to be more consistent with international norms such as the MFN obligations under the TRIPS Agreement and TPP's GI provisions,²⁹⁶ and workable in conflict resolution with open participation of interested parties, particularly if combined with effective domestic mechanisms. GI provisions of the EU-Singapore FTA are a worthy precedent, at least for countries without much domestic production of agricultural products and foodstuffs bearing names that conflict with GIs in the EU, despite the EU's underlining, regarding the

293. See e.g., TRIPS Agreement, *supra* note 1, preamble (recognizing that intellectual property rights are private rights). CETA makes a contrast with the EU-Singapore FTA, which provides that each Party's GI protection system shall contain the elements of objection and cancellation procedures involving third parties. See EU-Singapore FTA, *supra* note 8, art. 10.17.2(c), (d).

294. See *supra* Part IV. C. 3.

295. See *supra* Part IV. A.

296. See *supra* Part III. E. It is noted that although the TPP is not a multilateral agreement and has not taken effect at the time of this writing, it is a concluded plurilateral agreement involving as signatories 12 nations including not only "New World" countries like Australia, Canada, and the U.S. but also Mexico and Peru, both of which are members of the Lisbon Agreement.

arrangements of the EU-Singapore FTA for GIs, that “this does not constitute a precedent.”²⁹⁷

297. Letter from Lim to De Gucht, *supra* note 120.