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The Comparison of the EU and U.S. Legislation on Protection of Geographical Indications

Diploma Thesis

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Brno 2018

Affidavit

I hereby solemnly declare that this diploma thesis on **The Comparison of the EU and U.S. Legislation on Protection of Geographical Indications** is a result of my independent work. All the sources of information I used to write this work were quoted in the footnotes and are cited in the list of used bibliography.

In Brno, 27 June 2018,

.....
Jan Dohnal

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Abstrakt

Diplomová práce se věnuje srovnání legislativy Evropské unie a Spojených států amerických na ochranu zeměpisných označení. Evropská unie vyvinula velmi sofistikovaný sui generis systém na ochranu těchto označení. Spojené státy americké naopak chrání zeměpisná označení v rámci dobře zavedeného systému ochranných známek, jako certifikační a kolektivní známky. Oba systémy tudíž užívají odlišný právní rámec. Tyto rozdíly způsobují překážky ve sporech z doménových jmen a jednání o mezinárodní spolupráci. Cílem této práce je porovnat výhody obou systémů a zjistit, zdali je udržování těchto kontrastních systémů opodstatněné.

Klíčová slova

chráněné zeměpisné označení, chráněné označení původu, ochranná známka, certifikační známka, kolektivní známka, doménové jméno, právo duševního vlastnictví

Abstract

The thesis is devoted to the comparison of the EU and U.S. legislation on protection of geographical indications (GIs). The European Union developed a very sophisticated sui generis system on the protection of GIs. Contrarily, the United States of America protects GIs under the well-established trademark system, as certification and collective marks. Therefore, both systems use the different legal framework. These dissimilarities cause obstacles in domain name disputes and international cooperation negotiations. The thesis aims to compare the advantages of both systems and discover whether maintaining of these contrast systems is justified.

Key words

Protected Designation of Origin, Protected Geographical Indication, Trademark, Certification Mark, Collective Mark, Domain Name, Intellectual Property Law

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List of Terms and Abbreviations

AO	- Appellation of Origin
AOC	- Appellation d'Origine Contrôlée
CJEU	- Court of Justice of the European Union
DNS	- Domain Name System
EU	- European Union
EUIPO	- European Union Intellectual Property Office
GI	- Geographical Indication
ICANN	- Internet Corporation for Assigned Names and Numbers
IGO	- Indication of Geographical Origin
IP	- Intellectual Property
PDO	- Protected Designation of Origin
PGI	- Protected Geographical Indication
TTAB	- Trademark Trial and Appeal Board of the United States Patent and Trademark Office
TTIP	- Transatlantic Trade and Investment Partnership
TRIPS	- Agreement on Trade-Related Aspects of Intellectual Property Rights
UDRP	- Uniform Domain-Name Dispute-Resolution Policy
U.S.	- United States of America
USPTO	- United States Patent and Trademark Office
WIPO	- World Intellectual Property Organization
WTO	- World Trade Organization

Introduction

This Master's Thesis aims to analyse and compare the legislation on protection of geographical indications in the European Union and the United States of America.

I have a long-lasting interest in the global protection of intellectual property rights. Therefore, I carefully studied its most familiar and well-recognized categories – copyright, patent and trademark protection. Then, the new and evolving category of geographical indications started to interest me. From one side, they are very similar to trademarks, because they are also rights to designation. From the other side, dominant differences prevailed, and geographical indications became a separate category of intellectual property because their function is beyond the scope of trademarks.

Thus, the European Union developed very sophisticated sui generis system on the protection of geographical indications which is based on four most important regulations. On the other hand, the United States decided to cover their protection under the already well-established trademark system, by certification and collective marks. Simply stated, I am fascinated, that these two globally dominant market players have completely different legislation and scope of protection on the institute of geographical indication. As a result of this finding, I determined my Master's Thesis to the comparison of these legislations.

Personally, I was multiple times exposed to the incorrect use of geographical indications. People are not sufficiently aware that Champagne or Parma Ham could not originate and be produced in the Czech Republic. Geographical indications are unfortunately affected by the worldwide omnipresent ambiguity of terms as a result of different national development around the countries in the past. It also helped to cause consumer confusion. From my point of view, the public awareness of this category of intellectual property is very low.

I chose this topic in order to enrich my knowledge and spread the word about the important institute of geographical indication as a separate category of intellectual property. I had the chance to study detailed analysis of the institute in the United States and the European Union. I believe that the comparison of both legislations and its outcomes could be the real contribution to the field of law and legal science. Additionally, the institute of the EU certification mark as a new trademark tool with wide EU effect is examined. My thesis also analyses the topic of geographical indications as a questionable standing for the Uniform Domain-Name Dispute-Resolution Policy.

The European Parliament debated lately on the topic of potential protection of non-agriculture products by the European Union system on the protection of geographical indications (e.g. clay pottery or leather for the shoe production). The potential expansion of geographical indications beyond the agriculture products is not covered by this thesis.

The following questions will be elaborated by the thesis. Could these two systems (the sui generis protection system in the European Union and the United States trademark system) work well together in the future? Does it cause any cooperation problems? Is the sui generis system unjustified result of strong European protectionism? Does the United States benefit from the actual Uniform Domain-Name Dispute-Resolution Policy concerning geographical indications?

The first chapter defines the term of geographical indication and its characteristics. It provides the definition of geographical indication given by the international treaties and the Court of Justice of the European Union. Consequently, historical evolution is briefly introduced. The chapter highlights the importance of the institute, reasons of protection and supports it with obtained statistical data. The ambiguity of terms is mentioned and explained for the purpose of the thesis.

The second chapter enumerates and briefly analyse the relevant and crucial international treaties which are devoted to geographical indications. The most significant is the Agreement on Trade-Related Aspects of Intellectual Property Rights dated 1994, which firstly used the verbatim "geographical indication". By virtue of

numerous signatories, all the members of the World Trade Organization, the Agreement carries significant influence. It provides the minimum standard of protection of geographical indications. Thus, the thorough description of its provisions is included.

The third chapter deals with the sui generis system on the protection of geographical indications in the European Union. It also clarifies its close and complicated relation to trademarks. It is complemented by the recent case law of the Court of Justice of the European Union. Under the contemporary reform of European trademark law, the certification trademark was harmonised at the European Union level. This chapter expounds an attitude of certification mark to the geographical indication.

The fourth chapter takes a closer look at the legal protection of geographical indications in the United States of America. It describes the local well-established trademark system, namely certification mark, collective mark and appellation of origin of wine.

The fifth chapter pursues the comparison of the contradictory legal frameworks itself. The elaborated analysis of both systems is summarised. It discloses the advantages and disadvantages of either systems and develops the arguments why the systems could collaborate or why they present keystone obstacle for future cooperation. By using the synthesis, it concludes with the partial conclusions.

The sixth chapter connects geographical indications and generic top-level domain names “.com” and “.net”. Consequently, it analyses the domain name disputes policy while taking into account the above described different legal frameworks. The emphasis is on the Uniform Domain-Name Dispute-Resolution Policy which is administered by Internet Corporation for Assigned Names and Numbers. Geographical indications are treated differently under the trademark system and sui generis system while being the object of the Uniform Domain-Name Dispute-Resolution Policy. The negative position of geographical indications is proved by the recent case law of the WIPO Arbitration and Mediation Centre.

The seventh chapter explains the role of the geographical indication in the international cooperation negotiations between the European Union and the United States. The negotiation on the Transatlantic Trade and Investment Partnership clearly shows that geographical indications present very sensitive political issue. Debates on the topic involve economic, transnational trade and agricultural aspects.

For the purposes of the Master's Thesis, I used the following methods: analysis, comparison and synthesis.

1 Characteristic of the Term, its Definition and Ambiguity

The institute of geographical indication (hereinafter referred to as “GI”) is a new category of intellectual property rights. Major categories of intellectual property rights are patents, copyrights, trademarks, industrial designs, integrated circuits and GIs. These rights have never been more economically and politically important or controversial than today. They are indispensable in all areas of human development. GIs are frequently debated in connection with topics like food security, public health, heritage, transnational trade or traditional knowledge.¹

1.1 Characteristic of Geographical Indication

GIs have a long history. The connection between the particular region and specific attributes was well-known in Egypt’s Old Kingdom and the Ancient Greek city-states.² It is associated with the expression of quality and specificity. GI declares the association between the unique qualities of goods and the geographical place of their production as a vehicle for trade. The institute was established to take advantage of the commercial attractiveness of these local reputations. Therefore, merchants can designate the place of origin of their products. Already in the past, products from particular regions were more saleable than comparable products from other regions, because of their superior quality. Particular climate and geology given by the natural geographic advantages (e.g. Roquefort cheese, Seville oranges), food processing techniques (e.g. Frankfurter sausages) or indigenous manufacturing skills (e.g. Bohemian crystal ware) could be the reasons of potential superior

¹ RANGNEKAR, Dwijen. *The Socio-Economics of Geographical Indications*. [online]. UNCTAD-ICTSD. 2004. [quoted on 04. 05. 2018]. Available at: <https://www.iprsonline.org/resources/docs/Rangnekar%20-%20Socio%20Economics%20of%20GIs%20-%20Blue%208.pdf>, p. 5.

² MANTROV, Vadim. *EU law on indications of geographical origin: theory and practice*. Cham: Springer, 2014, p. 32.

quality. GIs are legally protected instruments for creating value through the exclusivity for the producer of the products in question.³

They predominantly describe food and drinks which are made to a high standard, therefore attracting premium prices. They also reflect the hand-crafted rather than manufactured mass consumption products and cultural variety typical for the era before the globalisation.⁴

The idea of communicating origin to consumers and other producers by words or signs goes far back in time. From the moment of the inclusion in the Agreement on Trade-related Aspects of Intellectual Property Rights, they are part of international trade law. Copyright, patent and trademark, other major substantive rights, included in this Agreement, are well known and strongly supported as a subject matter of intellectual property theory. On the other side, the position of GIs presents a politically sensitive topic on economic competition, agricultural policy, protection for farmers, culture and tradition. Further, GIs highlighted the split between the “*New World*” and the “*Old World*” (as will be elaborated below).⁵

Concerning the categorisation of GIs, they could be classified as rights to the designation, the same category as trademarks. Individual trademark or service mark protects the concrete producer in relation to his product. Therefore, only the owner or the licensed user can use the trademark in commerce. The producer is protected from unauthorised use or imitation of his mark. Trademark also helps consumers by simplification of their market orientation between the products. The consumer is able to connect the product with a concrete producer in consequence of a trademark. Thus, both parties are protected and benefit from trademark protection.

³ BLAKENEY, Michael. *The protection of geographical indications: law and practice*. Cheltenham: Edward Elgar. 2014. Elgar intellectual property law and practice, p. 3-5.

⁴ PHILLIPS, Jeremy. *Trade mark law: a practical anatomy*. Oxford: Oxford University Press. 2003, p. 603

⁵ RAUSTIALA, Kal, MUNZER, Stephen R. *The Global Struggle over Geographic Indications*. [online]. European Journal of International Law. Volume 18. Issue 2. 2007. [quoted on 08. 05. 2018]. Available at: <https://doi.org/10.1093/ejil/chm016>, p. 337-340.

Both, GIs and trademarks, bring rights to prevent unauthorised producers from using the identical or confusingly similar signs.⁶

Nevertheless, the principle of protection of geographical indications is slightly different from other intellectual property rights. Intellectual property rights, in general, are based on the exclusive rights of the sole holder – patents or trademarks. The conception of GIs is different. Every producer, who follows the prescribed rules and whose production is located in the particular place, can use the GI. Conversely, no producer fulfilling the requirements related can be denied using it. The function of GI is substantially different from the trademark. The producer of products with superior quality wants to highlight that they were produced at a different place, but the products could be the same or similar. This producer is not the exclusive right holder, therefore not the owner of the GI.⁷

I believe that the protection of GIs goes beyond the trademark protection. Trademarks do not cover the location, the key geographical element for some products. Collective trademarks constitute an exception to the rule. According to the 74(2) of the Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark, “*signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute EU collective marks*”.⁸ It was enabled throughout the derogation from Article 7(1)(c) which covers absolute grounds for refusal of trademark registration, due to the fact it states “*trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the*

⁶ TÝČ, Vladimír a Radim CHARVÁT. *Zeměpisná označení v mezinárodních smlouvách a v právu Evropské unie*. Praha: Leges, 2016. Teoretik, p. 15.

⁷ KELBLOVÁ, Hana. *Zeměpisná označení výrobků a jejich právní ochrana*. Praha: Wolters Kluwer ČR, 2016, 1. vyd., p. 1.

⁸ Art. 74(2) of Regulation (EU) of the European Parliament and of the Council No 2017/1001 of 14 June on the European Union trade mark. In: *EUR-Lex* [legal information system]. The Publications Office of the European Union [quoted on 09. 05. 2018]. Available at: <http://data.europa.eu/eli/reg/2017/1001/oj>

service, or other characteristics of the goods or service" shall not be registered.⁹ Interestingly, the Czech trademark statute does not include this exemption provision in its Art. 35 which covers the collective trademark.¹⁰

Trademarks present the individuality of the producers but not the specific relation to the concrete region of origin. As a result, GIs have emerged as a distinct category of subject matter within International Intellectual Property law. On these grounds, some countries worldwide decided to cover this institute separately from the trademarks in their local legislation.

I consider two legal definitions as utmost valuable. First one was given by the Article 2 of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration from 1958. It defined "*appellation of origin*" to mean: "*the geographical name of a country, region, or locality, which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors*".¹¹ The second definition, the most quoted one, was given by the Article 22 of the Agreement on Trade-Related Aspects of Intellectual Property Rights dated 1994. It defines geographical indications as: "*indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or another characteristic of the good is essentially attributable to its geographical origin*".¹²

The Court of Justice of the European Union (hereinafter referred to as "CJEU") also elaborated on the objective of GIs in well-known case *Consortio del Prosciutto*

⁹ Ibid. Art. 7(1)(c)

¹⁰ § 35 zákona č. 441/1991 Sb., zákon o ochranných známkách, ve znění pozdějších předpisů. In: *ASPI* [právní informační systém]. Wolters Kluwer ČR [quoted on 25. 05. 2018].

¹¹ Art. 2 of Lisbon Agreement for the Protection of Appellations of Origin and their International Registration. In: *WIPO-Lex* [online]. WIPO [quoted on 25. 05. 2018]. Available at: http://www.wipo.int/lisbon/en/legal_texts/lisbon_agreement.html

¹² Art. 22 of Agreement on Trade-Related Aspects of Intellectual Property Rights. In: *WTO-Legal-Texts* [online]. WTO [quoted on 25. 05. 2018]. Available at: https://www.wto.org/english/docs_e/legal_e/27-trips_01_e.htm

di Parma v. Asda Stores in the following way: “Designations of origin fall within the scope of industrial and commercial property rights. The applicable rules protect those entitled to use them against improper use of those designations by third parties seeking to profit from the reputation which they have acquired. They are intended to guarantee that the product bearing them comes from a specified geographical area and displays certain particular characteristics. They may enjoy a high reputation amongst consumers and constitute for producers who fulfil the conditions for using them an essential means of attracting custom. The reputation of designations of origin depends on their image in the minds of consumers. That image in turn depends essentially on particular characteristics and more generally on the quality of the product.”¹³

The most common example is wine production. The first references to wine types named by geographic locations are already recorded in the Bible. At that time, there was no legal protection. With the growing popularity of wine types, counterfeits from other territories appeared with different quality and taste. This confusion motivated the emergence of protection for wines whose tradition and reputation are closely linked to a particular area and therefore very important.¹⁴

Taking into account historical developments, I believe that the initial motivation to protect GIs came from Europe. The first reference to the protection of wine concerned Italian Chianti from 1716. A well-known example could also be Portuguese Port Wine which production started in 1756. Port Wine was exported to England from the 16th century, where it became very popular. Wines from many other European regions were mistakenly substituted as Port Wine (Região Demarcada do Douro). Therefore, a company was set up to control Ports’ production process from grape harvesting to export. In 1919, France started to protect GIs through its legal

¹³ Judgment of the Court of 20 May 2003. *Consorzio del Prosciutto di Parma and Salumificio S. Rita SpA v Asda Stores Ltd and Hygrade Foods Ltd.* C-108/01. Case-law of the Court of Justice [online]. Court of Justice of the European Union [quoted on 10. 05. 2018].

¹⁴ *Zeměpisná označení a jejich ochrana*. Ministerstvo průmyslu a obchodu ČR. [online]. 1. vyd. 2011, [quoted on 12. 05. 2018]. Available at: <https://www.mpo.cz/assets/dokumenty/45738/51600/587664/priloha001.pdf>

system. The country responded to one of the rising phenomena - the migration. Immigrants, who left Europe to settle in North America or Australia, took with them all the know-how of wine and cheese production and other food or beverages. They started to produce them in their new homeland and gave them names with geographical names related to their original homes in Europe. Therefore, global migration has a dominant role in terminological and conceptual ambiguity covering the protection of GIs. I observe that the oldest roots of GIs protection are in European countries with a long history such as France, Italy and Spain, so-called the “*Old World*”.¹⁵

Detailed statistics support the importance of the GI institute. The worldwide sales value of GI products registered in the EU was estimated at €54.3 billion in 2010 at a wholesale stage in the region of production. It increased by 12 % between the years 2005 and 2010. GIs represented 5.7 % of the total food and drink sector in the EU, while wines accounted for 56 % of total sales, agricultural products and foodstuffs for 29 % and spirit drinks for 15 %.¹⁶

Over the past years, the global economy has grown in importance in protecting GIs. The risk of abuse is also increasing. Right holders call for the stronger legal protection of GIs, both nationally and internationally.¹⁷

¹⁵ *Zeměpisná označení a jejich ochrana*. Ministerstvo průmyslu a obchodu ČR. [online]. 1. vyd. 2011. [quoted on 12. 05. 2018]. Available at: <https://www.mpo.cz/assets/dokumenty/45738/51600/587664/priloha001.pdf>, p. 4.

¹⁶ European Commission. *Value of production of agricultural products and foodstuffs, wines, aromatized wines and spirits protected by a geographic indication (GI)*. [online]. European Commission. October 2012. [quoted on 12. 05. 2018]. Available at: http://ec.europa.eu/agriculture/external-studies/2012/value-gi/final-report_en.pdf

¹⁷ *Zeměpisná označení a jejich ochrana*. Ministerstvo průmyslu a obchodu ČR. [online]. 1. vyd. 2011. [quoted on 12. 05. 2018]. Available at: <https://www.mpo.cz/assets/dokumenty/45738/51600/587664/priloha001>

1.2 Ambiguity of Terms

Taking into account long and rich history of GIs, the ambiguity of terms is still omnipresent. A wide study made by the World Trade Organization (hereinafter referred to as “WTO”) identified twenty-three distinct definitions used in domestic legislations worldwide. The protection of GIs has evolved under diverse ways of national laws. There is no generally accepted terminology in this area. As an example, I would like to mention a limited number of major terminological rivals used worldwide: Indication of Source, Appellation of Origin (hereinafter referred to as “AO”), Appellation d’Origine Contrôlée (hereinafter referred to as “AOC”), EU’s Protected Designation of Origin (hereinafter referred to as “PDO”) and Protected Geographical Indication (hereinafter referred to as “PGI”). The World Intellectual Property Organization (hereinafter referred to as “WIPO”) attempts at establishing the Geographical Indication. The WTO Secretariat adopted the neutral terminology of Indications of Geographical Origin (hereinafter referred to as “IGO”) as a common denominator.¹⁸

This Master’s Thesis will operate with the term “geographical indication” in a broad sense. It must be clarified at the beginning of the paperwork since this term could also be used in a narrower sense as one subcategory of indications of geographical origin. From the second perspective, we recognise geographical indications and appellations of origin as two different types of protection.

A widely cited author and acclaimed academic, Dev Gangjee, mentioned in his publication that “*the law in this area is a mess*”.¹⁹ According to his opinion, the terminological diversity in this area may be attributable to the various policies to be served by GIs, such as agricultural marketing, rural development, the preservation of traditional knowledge and cultural heritage.²⁰

Countries also decided to protect GIs from different conceptual perspective. There are three main systems of protection of GIs worldwide. Firstly, the *sui generis*

¹⁸ GANGJEE, Dev. *Relocating the Law of Geographical Indications*. Cambridge University Press, p. 3-4.

¹⁹ Ibid. p. 1.

²⁰ Ibid., p. 2-18.

system based on the principle of registration (111 states, including all the 28 Member States of the EU). Secondly, the system of collective and certification trademarks (US, Australia, Canada, Japan, some states in Africa and few Arabic states). Thirdly, the protection of GIs by different national laws. It is a debatable problem, whether one or the other system provides better protection for GIs. There is no worldwide consensus on this issue.²¹

1.3 Reasons for Protection

Due to increasingly competitive and transnational trading environment, products need to be distinguished from one another in order to inform the consumers about their quality or origin. Nowadays, products are sold in domestic and foreign markets. Trademarks have the key role of distinguishing the products on the relevant market from each other, securing economic revenue from exclusivity and individualising the producers. Nevertheless, trademark protection turned out not to be sufficient and satisfactory. Goods have to be further distinguishable.

GIs are very important commercial objects with an enormous marketing opportunity. Their monumental sales value was mentioned above. Further, it is proved, that products bearing GI are being sold for higher prices. They serve consumers as visual means, which help to correlate the product with a particular quality, characteristic or reputation given by the specific geographical origin. They could present, without sufficient legal protection, a dangerous opportunity for free riders. GIs instigate reputational and qualitative expectations in consumers. Hence, the po-

²¹ KELBLOVÁ, Hana. *Zeměpisná označení výrobků a jejich právní ochrana*. Praha: Wolters Kluwer ČR, 2016, 1. vyd., p. 5.

tential threat is very high and could cause consumer confusion by their misuse. Correspondingly, GIs constitute an important category of intellectual property rights, which shall be adequately protected.²²

²² GUYOT, Nicolas. *The value of geographical indications for businesses*. [online]. European IPR Helpdesk. September 2016. [quoted on 19. 06. 2018]. Available at: https://www.ipr-helpdesk.eu/sites/default/files/newsdocuments/Fact-Sheet-Geographical_Indications_2.pdf, p. 7.

2 International Treaties on GIs Protection

Intellectual property rights, which include GIs, are national or territorial in nature. Therefore, they do not ordinarily operate outside the national territory in which they are granted. It has been a long-term problem for right holders whose brands, patents and other types of IP are the subjects of transnational trade. A number of countries desired for protection in other jurisdictions, throughout the nineteenth century. At the beginning, the issue was solved by the bilateral treaties, whereby two nations agreed to allow nationals of the other country to claim the protection of their respective laws. Afterwards, some countries entered into multilateral agreements.²³

Various international treaties cover the institute of GI. There are four most significant international treaties, which are to be elaborated in this chapter. They represent the international legal protection framework for GIs. They are the following: Paris Convention for the Protection of Industrial Property, Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods, Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, and Agreement on Trade-Related Aspects of Intellectual Property Rights. The above-mentioned terminological ambiguity might also result from these international agreements, as it will be explained below.

2.1 Paris Convention for the Protection of Industrial Property, 1883

The Paris Convention for the Protection of Industrial Property from 1883 Rights (hereinafter referred to as "*Paris Convention*") is the first multilateral agreement regulating the basic principles and rules in the different areas of the industrial property. The Convention (1883), revised at Brussels (1900), at Washington (1911),

²³ BENTLY, Lionel a Brad SHERMAN. *Intellectual property law*. 4th ed. Oxford: Oxford University Press, 2014. p. 6.

at The Hague (1925), at London (1934), at Lisbon (1958) and at Stockholm (1967), and amended in 1979 (Paris Union) has 177 contracting parties up-to-date.²⁴

It included “*indications of source or appellations of origin*” as objects for protection by national industrial property laws in Art. 1(2): “*The protection of industrial property has as its object patents, utility models, industrial designs, trademarks, service marks, trade names, indications of source or appellations of origin, and the repression of unfair competition.*” Nevertheless, these terms are not defined and no specific mode of protection is required.²⁵

For the purpose of GI protection, the Art. 1(3) is convenient: “*Industrial property shall be understood in the broadest sense and shall apply not only to industry and commerce proper, but likewise to agricultural and extractive industries and to all manufactured or natural products, for example, wines, grain, tobacco leaf, fruit, cattle, minerals, mineral waters, beer, flowers, and flour.*” Hence, manufactured and natural products could be the objects of industrial property rights.²⁶

The Paris Convention therefore unambiguously consider GIs as a part of industrial property rights. It should be expressly mentioned because some scholars do not agree and do not consider it as a part of industrial property rights. These opposite theories are founded on differences of GIs from other rights. Professor Louis Lorvellec claims that GIs do not fulfil the prerogatives of ownership as trademarks, private law institutes. Their duration is not limited. They are not transferable. The only function of GIs he sees in the informative character of GIs.²⁷

²⁴ Paris Convention for the Protection of Industrial Property. In: *WIPO-Lex* [online]. WIPO [quoted on 19. 05. 2018]. Available at: <http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/paris.pdf>

²⁵ Art. 1(2) of Paris Convention for the Protection of Industrial Property. In: *WIPO-Lex* [online]. WIPO [quoted on 19. 05. 2018]. Available at: http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=287556

²⁶ Ibid. Art. 1(3)

²⁷ LORVELLEC, Louis. *Réponse à l'article du Professeur Jim Chen*. [online]. *Révue de droit rural*, 1/1997. [quoted on 20. 05. 2018]. Available at: <http://www.origin-food.org/pdf/meet0901/lorvellec.pdf>

The Convention remarks only a seizure upon the importation of goods bearing a false indication of the source as the only sanction in Art. 10(1). However, it only applies to the extent that such a measure has been adopted under national law. Article 10bis states that false or misleading indications of the source are prohibited by unfair competition rules.²⁸

2.2 Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods, 1891

The concept of indication of source is also used in the Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods in 1891 (hereinafter referred to as “*Madrid Agreement*”).

Madrid Agreement, revised at Washington (1911), The Hague (1925), London (1934) and Lisbon (1958), and supplemented by the Additional Act of Stockholm (1967) has only 36 signatory states in total.²⁹

It was created with a purpose to prohibit the display or offering for sale of any goods capable of deceptive indication of source, more effectively than the Paris Convention. Art. 1(1) expresses: “*All goods bearing a false or deceptive indication by which one of the countries to which this Agreement applies, or a place situated therein, is directly or indirectly indicated as being the country or place of origin shall be seized on importation into any of the said countries.*”³⁰ Thus, Madrid Agreement operates with a non-specific term “*country or place of origin*”, which is not further defined.

²⁸ BLAKENEY, Michael. *The protection of geographical indications: law and practice*. Cheltenham: Edward Elgar, 2014. Elgar intellectual property law and practice, p. 10-11

²⁹ Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods. In: *WIPO-Lex* [online]. WIPO [quoted on 19. 05. 2018]. Available at: http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_source.pdf

³⁰ Art. 1(1) of Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods. In: *WIPO-Lex* [online]. WIPO [quoted on 19. 05. 2018]. Available at: http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=286779

The Agreement does not protect the designation of origin itself, but it is more detailed within the seizure of goods bearing the false or deceptive indication upon importation. It shall take place at the instance of the customs authorities according to its Art. 2(1). Consequently, it is not very efficient concerning the protection of the products with special qualities linked to the place of their origin. It protects consumers and empowers customs authorities. The more significant Madrid Agreement Concerning the International Registration of Marks was also concluded in 1891.

2.3 Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, 1958

Lisbon Agreement for the Protection of Appellations of Origin and their International Registration from 1958 (hereinafter referred to as "*Lisbon Agreement*").

Lisbon Agreement, as revised at Stockholm (1967) and as amended in 1979, has only 28 contracting parties up-to-date.³¹ Different legal concepts existed from country to country in regard to this special category of such GIs (e.g. "*appellations of origin*"). Therefore, an international system of registration and protection of appellations of origin among members of the Lisbon Union was created. It endeavours to facilitate the registration procedure and provides one convenient database with registered appellations. It is administered by the WIPO. It did not manage to attract more than a few states, contrary to other WIPO system agreements. The United States is not a signatory to the Lisbon Agreement.

It operates and defines the term "*appellation of origin*" in its Art. 2(1) as: "*the geographical denomination of a country, region, or locality, which serves to designate*

³¹ Lisbon Agreement for the Protection of Appellations of Origin and their International Registration. In: *WIPO-Lex* [online]. WIPO [quoted on 19. 05. 2018]. Available at: http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=10

a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors.”³²

Firstly, to accede the Lisbon Agreement, countries were obliged to follow the condition to recognise and protect appellations of origin at the national level as the denomination of a geographical area (country, region or locality). The formalised process of recognition was required. Countries, which used trademark law, unfair competition or consumer protection, were unable to join the Agreement. Secondly, GIs which had become generic in the Member States were not accepted. The Member States are obligated to provide a means of defense against any misuse or imitation of an appellation of origin in their territory.^{33, 34}

Lisbon Agreement was revised by the Geneva Act in 2015. It presented some important changes. Nevertheless, the Geneva Act shall enter into force after the ratification by five states or international organisations.³⁵

This system is widely used by the following economically significant states: France (565 registrations), Italy (148 registrations), the Czech Republic (79 registrations) and Mexico (16 registrations).³⁶

³² Art. 2(1) of Lisbon Agreement for the Protection of Appellations of Origin and their International Registration. In: *WIPO-Lex* [online]. WIPO [quoted on 19. 05. 2018]. Available at: http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=10

³³ BLAKENEY, Michael. *The protection of geographical indications: law and practice*. Cheltenham: Edward Elgar, 2014. Elgar intellectual property law and practice, p. 14-17.

³⁴ Objectives and Main Features of the Lisbon Agreement. In: *WIPO-Lex* [online]. WIPO [quoted on 19. 05. 2018]. Available at: <http://www.wipo.int/lisbon/en/general>

³⁵ TÝČ, Vladimír a Radim CHARVÁT. *Zeměpisná označení v mezinárodních smlouvách a v právu Evropské unie*. Praha: Leges, 2016. Teoretik, p. 63-64.

³⁶ Lisbon Express Database. In: *WIPO-Lex* [online]. WIPO [quoted on 19. 05. 2018]. Available at: <http://www.wipo.int/ipdl/en/search/lisbon/search-struct.jsp>

2.4 Agreement on Trade-Related Aspects of Intellectual Property Rights, 1994

The most recent international agreement also covering the protection of GIs is the Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter referred to as “TRIPS”) dated 1994. It was created as a part of the Uruguay Round negotiations of the General Agreement on Tariffs and Trade (GATT). It came into effect in 1995. Currently, it presents the most comprehensive multilateral agreement on intellectual property. TRIPS is binding on all the WTO Member States. It has 164 members since 29 July 2016, including the European Union and the United States, and 23 observers.³⁷

TRIPS Agreement goes further than that of the Lisbon Agreement by including indications, which are not place names by definition. It is the first international agreement in which the term “*geographical indication*” appeared in the literal form, what I consider as a very important step in this complicated field.³⁸

Art. 22(1) of the TRIPS defines the GIs for the purposes of the Agreement as: “*indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin*”.³⁹

At the basic level of protection, its Member States are obliged to provide the legal means for interested parties to prevent: (1) the use of a GI on goods where that use misleadingly suggest that the goods come from somewhere else than their true place of origin and (2) any act of unfair competition. These rules are based on the

³⁷ Members and Observers. In: *WTO* [online]. WTO [quoted on 25. 05. 2018]. Available at: https://www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm

³⁸ GERVAIS, Daniel J. *The TRIPS agreement: drafting history and analysis*. 2nd ed. London: Sweet & Maxwell, 2003. p. 184-200.

³⁹ Art. 22(1) of Trade-Related Aspects of Intellectual Property Rights. In: *WTO-Legal-Texts* [online]. WTO [quoted on 25. 05. 2018]. Available at: https://www.wto.org/english/docs_e/legal_e/27-trips_04b_e.htm#3

Art. 22(2).⁴⁰ Additional protection is given to wines and spirits according to the Art. 23. The producers of wines and spirits are threatened by the misleading use of terms such as “*Spanish champagne*” or “*South African sherry*”. Hence, TRIPS requires that: “*Each Member shall provide the legal means for interested parties to prevent use of a geographical indication identifying wines or spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like*”.^{41, 42}

⁴⁰ Ibid. Art. 22(2).

⁴¹ Ibid. Art. 23.

⁴² PHILLIPS, Jeremy. *Trade mark law: a practical anatomy*. Oxford: Oxford University Press, 2003, p. 606-608

3 Protection of GIs in the European Union

This chapter will present the system of GI legal protection in the territory of the European Union (hereinafter referred to as “EU”). It rests upon four important EU Regulations of the European Parliament and of the Council. The first subchapter is focused on the very new institute of the EU certification mark, which was brought under the recent EU trademark reform and is applicable from 1 October 2017. The EU certification mark as a tool with wide EU effect should not be interchanged with certification mark in the United States, which cover the GI protection there. The second subchapter examines the recent and relevant case law of the Court of Justice of the European Union. This close examination analyses the provisions of the particular EU Regulations mentioned below and the level of protection of GIs in the EU in general.

The EU is an integration of 28 Member States with a supranational character, with its own institutions and legal order.⁴³ To begin with the EU law, I consider it necessary to very briefly explain its particular role. The Member States’ courts must give direct effect to the treaties (binding agreements between EU member countries which set out EU objectives, rules for EU institutions, how decisions are made and the relationship between the EU and its members), regulations and certain directives (provisions could provide rights to individuals which public authorities must respect). Secondly, the indirect effect must be given to other EU provisions, including directives. Therefore, interpreting national law consistently with them.⁴⁴

45, 46

⁴³ The Czech Republic is a Member State of the European Union from 1 May 2004.

⁴⁴ PILA, Justine, TORREMANS, Paul. *European intellectual property law*. Oxford: Oxford University Press, 2016. p. 22.

⁴⁵ CHALMERS, Damian, DAVIES, Gareth, MONTI, Giorgio. *European Union law: cases and materials*. 2nd ed. Cambridge: Cambridge University Press, 2010. p. 2-46.

⁴⁶ TÝČ, Vladimír. *Základy práva Evropské unie pro ekonomy*. 7. přepracované a aktualizované vydání. Praha: Leges, 2017.

Initially, states brought protection of product designations, which linked them to special qualities given by the territory of production, into their national statutory regulations (e.g. France, Italy and Spain). It was found to be a restriction of free movement of goods, which is the fundamental freedom of the EU internal market. Nevertheless, the CJEU expressed that the restriction is justifiable under the protection of health and protection of consumers ensured by the Art. 36 of the Treaty on the Functioning of the European Union. The protection of GIs was developed as a part of the common agricultural policy of the EU which is based on the Art. 43 of the Treaty on the Functioning of the European Union. Consequently, the below described Regulations were adopted.^{47, 48}

In the EU, consumers are informed and also protected by highly developed and sophisticated system on protection of GIs. This system is being called *sui generis* system.^{49, 50} Therefore, the EU created its own unique and particular system on the protection of GIs.

The system in the EU has the following attributes: all the GIs are listed in the public registry and coexistence between GIs and prior trademarks. Public authorities take administrative action in order to enforce the protection. A registered name shall correspond to a specific product for which a product specification is laid down. It can only be amended by due administrative process. There is an administrative process verifying that geographical indication identifies goods as originating in a

⁴⁷ Art. 36, 43 of Treaty on the Functioning of the European Union of 13 December 2007. In: *EUR-Lex* [legal information system]. The Publications Office of the European Union [quoted on 25. 05. 2018]. Available at: <https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:12012E/TXT&from=CS>

⁴⁸ TÝČ, Vladimír a Radim CHARVÁT. *Zeměpisná označení v mezinárodních smlouvách a v právu Evropské unie*. Praha: Leges, 2016. Teoretik, p. 83-84.

⁴⁹ Merriam Webster dictionary. *Legal definition: sui generis*. [online]. © Merriam-Webster. [quoted on 25. 05. 2018]. Available at: <https://www.merriam-webster.com/dictionary/sui%20generis>

⁵⁰ The legal definition of the term "*sui generis*" provided by the Merriam Webster dictionary is "*as constituting a class alone or unique or particular to itself*".

territory, region or locality, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.⁵¹

The sui generis system in the EU is based on four most important regulations: (1) Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs⁵², (2) Regulation (EC) No 110/2008 of the European Parliament and of the Council of 15 January 2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks⁵³ (*covering the protection of spirits*), (3) Regulation (EU) No 1308/2013 of the European Parliament and of the Council of 17 December 2013 establishing a common organisation of the markets in agricultural products⁵⁴ (*covering the protection of wines*) and (4) Regulation (EU) No 251/2014 of the European Parliament and of the Council of 26 February 2014 on the definition, description, presentation, labelling and the protection of geographical indications of aromatised wine products⁵⁵ (*covering the protection of aromatised wines*).

⁵¹ European Commission. *The European Commission Paper on Geographical Indications (GIs) in the EU - U.S. Transatlantic Trade and Investment Partnership*. [online]. European Commission. March 2016. [quoted on: 22. 05. 2018]. Available at: http://trade.ec.europa.eu/doclib/docs/2016/march/tradoc_154384.Paper%20Geographical%20Indications%20FINAL.pdf

⁵² Regulation (EU) of the European Parliament and of the Council No 1151/2012 of 21 November 2012 on quality schemes for agricultural products and foodstuffs. In: *EUR-Lex* [legal information system]. The Publications Office of the European Union [quoted on 25. 05. 2018]. Available at: <http://data.europa.eu/eli/reg/2012/1151/oj>

⁵³ Regulation (EC) of the European Parliament and of the Council No 110/2008 of 15 January 2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks. In: *EUR-Lex* [legal information system]. The Publications Office of the European Union [quoted on 25. 05. 2018]. Available at: [http://data.europa.eu/eli/reg/2008/110\(1\)/oj](http://data.europa.eu/eli/reg/2008/110(1)/oj)

⁵⁴ Regulation (EU) of the European Parliament and of the Council No 1308/2013 of 17 December 2013 establishing a common organisation of the markets in agricultural products. In: *EUR-Lex* [legal information system]. The Publications Office of the European Union [quoted on 25. 05. 2018]. Available at: <http://data.europa.eu/eli/reg/2013/1308/oj>

⁵⁵ Regulation (EU) of the European Parliament and of the Council No 251/2014 of 26 February 2014 on the definition, description, presentation, labelling and the protection of geographical

After the analysis of the above-mentioned Regulation No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs, it is clear, that producers can protect and register their agricultural products and food in three different ways in the EU. The first type is the *Protected Designation of Origin* ("PDO"), which could be used for food produced, processed and prepared in a certain geographical location and characterised by the qualitative characteristics typical of the site. Another option is the *Protected Geographical Indication* ("PGI") where the geographic link is no longer so strong, that is, at least one of the stages of production, processing or preparation must take place in a given geographical location. The last option is the *Traditional Specialties Guaranteed* ("TSG"), which has to be produced by using traditional raw materials or traditional practices and has multi-year sales in the European market.

GIs are currently experiencing an intensive growth, not only in the EU. It is supported by the statistical data provided by the European Commission. I recorded the highest number of registered GIs in Italy (923), the second is France (752), then Spain (358), Greece (270) and Portugal (208). Another interesting layout is the number of registered GIs within the each sector. Most of them fall into wine (1752), then food (1281), spirits (336) and aromatised wines (5). It means there was almost 3 500 GIs recognised under the four EU Regulations.⁵⁶

The classification of the number of registered GIs by type of product was the following: wines (52%); fruit, vegetables and cereals (11%); spirits (10%); cheeses (7%); meat products (5%) and fatty oils (4%).⁵⁷

The ratio of the registered PDOs and PGIs for wines within the Member States of the European Union is the following. In Italy, 474 wines were registered as PDOs

indications of aromatised wine products. In: *EUR-Lex* [legal information system]. The Publications Office of the European Union [quoted on 25. 05. 2018]. Available at: <http://data.europa.eu/eli/reg/2014/251/oj>

⁵⁶ DG Agriculture and Rural Development. European Commission Data provided upon personal email request. March 2016.

⁵⁷ Ibid.

and 129 wines as PGIs. In France, 376 wines as PDOs, 75 as PGIs; and 33 wines in Greece as PDOs and 116 as PGIs.^{58, 59}

PDOs are certainly not a negligible economic item. On the contrary, they are a landmark marketing tool that effectively increases the value of products. Consumers are assured of a guaranteed quality due to the distinctive character of the designation of origin clearly identifying the original product. The significance is also evident for cultural heritage, traditional methods of production and variety of production. A study by the European Commission showed that products protected by the PDOs were sold on average 2.23 times more. However, it does not mean that the producers earn 2.23 times higher profits, due to the fact that external expenses are not involved (e.g. registration costs).⁶⁰

3.1 EU Certification Mark

Certification mark was lately for the first time introduced as unitary EU trademark. It happened as a part of the EU trademark law reform represented by the Regulation No. 2017/1001 on the European Union trade mark.⁶¹ For the purposes of the Master's Thesis, the comparison of the EU and U.S. legislation on protection of GIs, I consider it necessary to involve and examine this new EU trademark tool, taking into account that GI protection in the United States is based on the certification marks (besides collective marks and appellations of origin of wine, as it will be analysed in detail in the fifth chapter).

⁵⁸ Ibid.

⁵⁹ The latest published statistics by the Agriculture and Rural Development Department were in 2013.

⁶⁰ European Commission. *Value of production of agricultural products and foodstuffs, wines, aromatized wines and spirits protected by a geographic indication (GI)*. [online]. European Commission. October 2012. [quoted on 12. 05. 2018]. Available at: http://ec.europa.eu/agriculture/external-studies/2012/value-gi/final-report_en.pdf, p. 4.

⁶¹ Regulation (EU) of the European Parliament and of the Council No 2017/1001 of 14 June on the European Union trade mark. In: *EUR-Lex* [legal information system]. The Publications Office of the European Union [quoted on 25. 5. 2018]. Available at: <http://data.europa.eu/eli/reg/2017/1001/oj>

The certification marks are known to many national legislations worldwide (e.g. China, France, New Zealand or Norway). Historically, certification marks already appeared in the EU legislation. The Directive 2008/95/EC of 22 October 2008 to approximate the laws of the Member States relating to trade marks mentioned them in its few articles.⁶² Most importantly, Art. 15(2) noted: “*By way of derogation from Article 3(1)(c), Member States may provide that signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute collective, guarantee or certification marks*”. Correspondingly, it allowed the Member States to cover the institute of certification mark in their national laws.

Nowadays, the EU certification marks are grounded in the Art. 83 – 93 of the Regulation No. 2017/1001. As a result, these marks could be registered, transferred and expired with EU effect. In comparison with other types of marks (ordinary or collective marks), they are essentially different.

In order to provide a quality comparison, the EU trademark (the ordinary one) shall be defined. Art. 4 of the Regulation No. 2017/1001 states that: “*An EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of (a) distinguishing the goods or services of one undertaking from those of other undertakings; and (b) being represented on the Register of European Union trade marks (‘the Register’), in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.*”⁶³ Thus, the core function of the

⁶² Art. 1, 4, 10, 15 of Directive of the European Parliament and of the Council No 2008/95/EC of 22 October 2008 to approximate the laws of the Member States relating to trade marks. In: *EUR-Lex* [legal information system]. The Publications Office of the European Union [quoted on 25. 5. 2018]. Available at: <http://data.europa.eu/eli/dir/2008/95/oj>

⁶³ Art. 4 of Regulation (EU) of the European Parliament and of the Council No 2017/1001 of 14 June on the European Union trade mark. In: *EUR-Lex* [legal information system]. The Publications Office of the European Union [quoted on 25. 5. 2018]. Available at: <http://data.europa.eu/eli/reg/2017/1001/oj>

trademark is to indicate the source of goods and services. But the certification mark aims to indicate the quality and other characteristics.

Art. 83(1) provides substantial conditions for certification mark in the following way: “*it is capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics, with the exception of geographical origin, from goods and services which are not so certified.*”⁶⁴ Further, the application must include the reference to a “*certification mark*”. The European Union Intellectual Property Office (hereinafter referred to as “*EUIPO*”), which serves as the Register of European Union trademarks, must be informed, that the applicant wants to register the certification mark.⁶⁵

All the rules that apply to ordinary EU trademark, also apply to EU certification marks, unless provided otherwise due to the Art. 83(3) of the Regulation.⁶⁶ Consequently, grounds for the refusal for the EU ordinary mark must be taken into account. Moreover, Art. 85 extends the relative and absolute grounds for refusal of registration with particular grounds for refusal.⁶⁷ For the purposes of the Master’s Thesis, especially important is the condition, that the mark cannot certify geographical origin. Thus, Art. 85 in conjunction with Art. 83(1) of the Regulation implies the prohibition from certifying geographical origin. It means that a sign whose purpose is to solely certify that the good originates from a specific region cannot be registered as an EU certification mark.⁶⁸

⁶⁴ Ibid. Art. 83(1).

⁶⁵ REPAS, Martina, KERESTES Tomaz. *The certification mark as a new EU-wide industrial property right*. International Review of Intellectual Property and Competition Law, 2018, p. 3.

⁶⁶ Art. 83(3) of Regulation (EU) of the European Parliament and of the Council No 2017/1001 of 14 June on the European Union trade mark. In: *EUR-Lex* [legal information system]. The Publications Office of the European Union [quoted on 25. 5. 2018]. Available at: <http://data.europa.eu/eli/reg/2017/1001/oj>

⁶⁷ Ibid. Art. 85.

⁶⁸ REPAS, Martina, KERESTES Tomaz. *The certification mark as a new EU-wide industrial property right*. International Review of Intellectual Property and Competition Law, 2018, p. 7.

I consider this GI exclusion condition as a very logical consequence of highly developed sui generis system on the protection of GIs. It also prevents the potential conflicts and consequences of products registered in either systems.

A compelling difference from the ordinary trademark is based on Art. 83(2) of the Regulation, which conditions the requirements for the certification mark owner. Hence, its owner could be: “*any natural or legal person, including institutions, authorities and bodies governed by public law, may apply for EU certification marks provided that such person does not carry on a business involving the supply of goods or services of the kind certified*”.⁶⁹ It represents a crucial limitation – the owner may not supply identical goods or services to the market. The failure to be in compliance with this rule could serve as a ground for mark invalidation grounded by Art. 92.⁷⁰ Therefore, one of the keystone characteristics of the EU certification mark is derived from Art. 83(2), the owner of the mark is not allowed to use it.⁷¹

If the owner of the ordinary EU trademark, which could be actually also used to designate goods and services with special characteristics, wants to authorise somebody else to use it, it must be done by the license agreement. Therefore, the same goal, under special circumstances, could be theoretically reached by EU ordinary mark. On the other hand, within the certification mark, it is not necessary to licence every licensee. Even though, it is necessary to grant authorisation to each user who wants to use the certification mark. A relevant difference lays in the licence (ordinary trademark) and the authorisation process (certification mark). The owner of the ordinary trademark can decide to whom will provide the licence. Furthermore, a licence is a contract, whose terms and conditions may remain confidential.

⁶⁹ Art. 83(2) of Regulation (EU) of the European Parliament and of the Council No 2017/1001 of 14 June on the European Union trade mark. In: *EUR-Lex* [legal information system]. The Publications Office of the European Union [quoted on 25. 5. 2018]. Available at: <http://data.europa.eu/eli/reg/2017/1001/oj>

⁷⁰ *Ibid.* Art. 92.

⁷¹ REPAS, Martina, KERESTES Tomaz. *The certification mark as a new EU-wide industrial property right*. International Review of Intellectual Property and Competition Law, 2018, p. 5.

Contrarily, the conditions to use the certification mark are public. In addition, the certification mark owner cannot refuse the authorisation if the person meets all the publicly disclosed requirements.⁷²

Practically, I was able to find 108 applications in the EUIPO database. Only six of them were successfully registered up-to-date (e.g. *Normpack* Reg. No. 017285578, *VERIFIED by SafeShops.be* Reg. No. 017384496). The rest of them is under the Office examination. It must be emphasized, that the institute of the EU certification mark is very new. The EU Regulation No. 2017/1001 is applicable from 1 October 2017.⁷³

Due to the fact, it was possible to register national certification mark in some EU Member States (e.g. France, Sweden), the harmonisation of the rules at the EU level is a considerable achievement towards future progress. Certification marks comprise a great tool for those who desire to guarantee the compliance of products with specific standards without being limited by membership in an entity group, as is the case of the EU collective mark.

As a result of the above-accomplished analysis, I observe that the EU certification mark represents a development of the EU trademark system, making it more attractive to applicants. Nevertheless, it differs from the certification mark in the United States, especially due to the explicit prohibition from certifying geographical origin.

⁷² REPAS, Martina, KERESTES Tomaz. *The certification mark as a new EU-wide industrial property right*. International Review of Intellectual Property and Competition Law, 2018, p. 10-11.

⁷³ The European Union Intellectual Property Office. *eSearch*. [online]. EUIPO 1995-2015. [quoted on 20. 06. 2018]. Available at: <https://bit.ly/2KumvZP>

3.2 Case Law of the Court of Justice of the European Union

The particularity of the EU sui generis system on GIs protection is well developed by the CJEU case law. I assume that CJEU protects the sui generis system and differentiate it from the trademark system. This determination is very useful for the purposes of the comparison of the GI institute in the EU and U.S.

3.2.1 C-393/16 - Comité Interprofessionnel du Vin de Champagne

Court of Justice recently decided in its case C-393/16 - Comité Interprofessionnel du Vin de Champagne of 20 December 2017 for a preliminary ruling between the Comité Interprofessionnel du Vin de Champagne (“CIVC”) and Aldi Süd Dienstleistungs-GmbH & Co. OHG concerning the use of the protected designation of origin (“PDO”) “*Champagne*” in the name of a frozen product. Aldi began to sell a frozen product under the name “*Champagner Sorbet*” at the end of 2012. It contained, among its ingredients, 12% champagne. The CIVC brought proceedings before the Landgericht München in order to obtain an injunction prohibiting Aldi from using that name on the frozen goods market.⁷⁴

It rested on Article 118m of Regulation No 1234/2007 and Article 103 of Regulation No 1308/2013. For the purposes of the Master’s Thesis, the following articles are relevant: Art. 103(2)(a)(ii) of Regulation No 1308/2013 which states: *A protected designation of origin shall be protected against any direct or indirect commercial use of that protected name in so far as such use exploits the reputation of a designation of origin or a geographical indication*” and 103(2)(c) which states: *“A protected designation of origin shall be protected against any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product, on the inner or outer packaging, advertising material or documents relating to the wine product concerned, as well as the packing of the product in a container liable to convey*

⁷⁴ Judgment of the Court (Second Chamber) of 20 December 2017. *Comité Interprofessionnel du Vin de Champagne v Aldi Süd Dienstleistungs-GmbH & Co.OHG. C-393/16*. Case-law of the Court of Justice [online]. Court of Justice of the European Union [quoted on 20. 06. 2018].

a false impression as to its origin". Art. 103(3) complements that PDOs cannot become generic in the EU.⁷⁵

The Court of Justice observed that the EU Regulations at issue serve as an implement of the common agricultural policy. Thus, consumers are protected as a reason of their secured expectation of the product, which originates from the specific geographic area. However, they also protect producers, who invested an effort to improve quality, against third parties trying to profit from the reputation of the genuine products unlawfully.⁷⁶

The Court of Justice stated that the above-mentioned provisions on a protected designation of origin, such as "*Champagne*" are applicable in this case when used as part of the name under which a foodstuff is sold, such as "*Champagner Sorbet*". Therefore, the conduct of Aldi and its product constituted exploitation of the reputation of a protected designation of origin "*Champagne*". The indication "*Champagner Sorbet*" was considered to be false and misleading.

I believe that this judgement of the Court of Justice represents the very powerful protection of GI in the EU under the sui generis system.

3.2.2 T-510/15 – Toscoro

The relation between trademarks and GIs is well remarked in the judgement of the Court of Justice T-510/15 - Mengozzi v EUIPO - Consorzio per la tutela dell'olio extravergine di oliva toscano (TOSCORO).

Mr Mengozzi filed an application for registration of an EU trademark with the European Union Intellectual Property Office (EUIPO). In 2003, the word sign

⁷⁵ Art. 103 Regulation No. 1308/2013 of the European Parliament and of the Council of 17 December 2013 establishing a common organisation of the markets in agricultural products. In: *EUR-Lex* [legal information system]. The Publications Office of the European Union [quoted on 20. 6. 2018]. Available at: <http://data.europa.eu/eli/reg/2013/1308/oj>

⁷⁶ Para. 38 of Judgment of the Court (Second Chamber) of 20 December 2017. *Comité Interprofessionnel du Vin de Champagne v Aldi Süd Dienstleistungs-GmbH & Co.OHG. C-393/16*. Case-law of the Court of Justice [online]. Court of Justice of the European Union [quoted on 20. 06. 2018].

TOSCORO was registered as an EU trademark under Reg. No. 002752509 for goods in International Classes 29 and 30 of the Nice Agreement of 15 June 1957⁷⁷. Consorzio per la tutela dell'olio extravergine di oliva Toscano IGP, filed an application for invalidation, concerned of all the goods covered by the contested mark, on December 2012. The application for declaration of invalidity was based on the PGI "*Toscano*" for the product "*olive oil*" registered in the European Union under the EU Regulation No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs.⁷⁸

The Court of Justice confirmed the findings of Board of Appeal of EUIPO that the signs at issue have the beginning of each sign identical, namely the element "*tosc*". It must be noted, in this regard, that in principle, a consumer usually pays more attention to the beginning of a sign than to its end⁷⁹. Furthermore, they are composed of seven letters and three syllables, have in common five letters with identical positioning, visually highly similar. Similarly, the signs at issue bore a strong phonetic similarity.

The Board of Appeal correctly applied Art. 13(1)(b) of Regulation No 2081/92, which says: "*registered names shall be protected against any misuse, imitation or evocation, even if the true origin of the product is indicated or if the protected name is translated or accompanied by an expression such as "style", "type", "method", "as produced in", "imitation" or similar*." Nowadays, it is regulated by Art. 13(1)(b) of Regulation No 1151/2012 which is directly applicable from 3 January 2013. The provision is slightly innovated in the following way: "*registered names shall be protected against any misuse, imitation or evocation, even if the true origin of the*

⁷⁷ *Nice Agreement*. In: *WIPO-Lex* [online]. WIPO [quoted on 20. 06. 2018]. Available at: <http://www.wipo.int/classifications/nice/en>

⁷⁸ Judgment of the General Court (Seventh Chamber) of 2 February 2017. *Roberto Mengozzi v European Union Intellectual Property Office*. T-510/15. Case-law of the Court of Justice [online]. Court of Justice of the European Union [quoted on 20. 06. 2018].

⁷⁹ Para. 64, 65 of Judgment of the General Court (Second Chamber) of 16 March 2005. *L'Oréal SA v European Union Intellectual Property Office*. T-112/03. Case-law of the Court of Justice [online]. Court of Justice of the European Union [quoted on 20. 06. 2018].

products or services is indicated or if the protected name is translated or accompanied by an expression such as 'style', 'type', 'method', 'as produced in', 'imitation' or similar, including when those products are used as an ingredient.”⁸⁰

Art. 13(1)(b) is applicable when the trademark contains a part of the protected designation. In the case of absence of any likelihood of confusion between the goods concerned, an evocation of a protected designation could occur due to the fact the origin of the products is not established in the mind of the public. Therefore, the reputation of PGI does not give an excessive advantage. Some common characteristics between the products are sufficient.^{81, 82}

Having regard to the visual and phonetic similarities between the signs at issue, the Board of Appeal concluded that the use of the sign “*TOSCORO*” amounted to an evocation of the PGI at issue for certain goods in Class 29 including edible vegetable oils and olive oil.⁸³

The Court of Justice added that the reputation of a PGI is not a condition for its protection.⁸⁴

It is necessary to highlight, that the objectives of the Regulation No. 1151/2012 consist, inter alia, in ensuring consumer protection.⁸⁵ Therefore, the

⁸⁰ Art. 13 of Regulation (EU) of the European Parliament and of the Council No 1151/2012 of 21 November 2012 on quality schemes for agricultural products and foodstuffs. In: *EUR-Lex* [legal information system]. The Publications Office of the European Union [quoted on 20. 6. 2018]. Available at: <http://data.europa.eu/eli/reg/2012/1151/oj>

⁸¹ Para. 33, 35, 45 of Judgment of the Court (Second Chamber) of 21 January 2016. *Viiniverla Oy v Sosiaali- ja terveystieteiden tutkimuskeskus - ja valvontavirasto*. C-75/15. Case-law of the Court of Justice [online]. Court of Justice of the European Union [quoted on 20. 06. 2018].

⁸² Par. 31 of Judgment of the General Court (Seventh Chamber) of 2 February 2017. *Roberto Mengozzi v European Union Intellectual Property Office*. T-510/15. Case-law of the Court of Justice [online]. Court of Justice of the European Union [quoted on 20. 06. 2018].

⁸³ Ibid. Para. 30.

⁸⁴ Ibid. Para. 48.

⁸⁵ Para. 31 of Judgment of the Court of 25 June 2002. *Criminal proceedings against Dante Bigi, third party: Consorzio del Formaggio Parmigiano Reggiano*. C-66/00. Case-law of the Court of Justice [online]. Court of Justice of the European Union [quoted on 20. 06. 2018].

Court of Justice presumes the expectation of the average consumer, who is reasonably well informed and reasonably observant and circumspect.⁸⁶ Furthermore, the average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details.⁸⁷ Eventually, the average consumer of the analysed case and the signs in question is the European Union consumer.^{88, 89}

To conclude, the thorough sui generis system on the protection of GIs protects them even against registered trademarks. Interestingly, the General Court of the European Union confirmed the assessment of the likelihood of confusion between a trademark and PGI, which is normally used to assess the likelihood of confusion between trademarks. The scrutinised case shows the strong protection of PGIs in the European Union. Signs imitating or evoking a protected PGI must not be registered.

3.2.3 C-44/17 - Scotch Whisky Association

Newly, on 7 June 2018, a suitable judgement was issued by the Court of Justice on the provisions of the Regulation No 110/2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks.

⁸⁶ Para. 24, 25 of Judgment of the Court (Second Chamber) of 21 January 2016. *Viiniverla Oy v Sosiaali- ja terveystieteiden tutkimuskeskus - ja valvontavirasto*. C-75/15. Case-law of the Court of Justice [online]. Court of Justice of the European Union [quoted on 20. 06. 2018].

⁸⁷ Para. 35 of Judgment of the Court (Third Chamber) of 12 June 2007. *Office for Harmonisation in the Internal Market v Shaker di L. Laudato & C. Sas*. C-334/05 P. Case-law of the Court of Justice [online]. Court of Justice of the European Union [quoted on 20. 06. 2018].

⁸⁸ Para. 32 of Judgment of the General Court (Seventh Chamber) of 2 February 2017. *Roberto Mengozzi v Europe-an Union Intellectual Property Office*. T-510/15. Case-law of the Court of Justice [online]. Court of Justice of the European Union [quoted on 20. 06. 2018].

⁸⁹ Para. 27 of Judgment of the Court (Second Chamber) of 21 January 2016. *Viiniverla Oy v Sosiaali- ja terveystieteiden tutkimuskeskus - ja valvontavirasto*. C-75/15. Case-law of the Court of Justice [online]. Court of Justice of the European Union [quoted on 20. 06. 2018].

This case⁹⁰ was a request for a preliminary ruling concerning the interpretation of Article 16(a) to (c) of Regulation (EC) No 110/2008 which states: *"registered geographical indications shall be protected against: (a) any direct or indirect commercial use in respect of products not covered by the registration in so far as those products are comparable to the spirit drink registered under that geographical indication or insofar as such use exploits the reputation of the registered geographical indication; (b) any misuse, imitation or evocation, even if the true origin of the product is indicated or the geographical indication is used in translation or accompanied by an expression such as 'like', 'type', 'style', 'made', 'flavour' or any other similar term; (c) any other false or misleading indication as to the provenance, origin, nature or essential qualities on the description, presentation or labelling of the product, liable to convey a false impression as to its origin"*⁹¹

Mr Klotz was selling a whisky under the designation "*Glen Buchenbach*", produced by the Waldhorn distillery in Berglen, Germany. The Scotch Whisky Association, whose objective is to protect the trade of Scottish whisky in Scotland and also abroad, accused Mr Klotz from infringement of their registered geographical indication in the meaning of Art. 16(a) to (c) of Regulation No 110/2008, which protects GIs of spirit drinks. The Scotch Whisky Association demanded him to discontinue selling the whisky designated as "*Glen Buchenbach*".

The Court of Justice noted that geographical indications must be interpreted in the light of the objective pursued by the registration of those indications, namely, to allow the identification of spirit drinks as originating from a specific territory, in situations where a given quality, reputation or other characteristic of those drinks

⁹⁰ Judgment of the Court (Fifth Chamber) of 7 June 2018. *Scotch Whisky Association v Michael Klotz*. C-44/17. Case-law of the Court of Justice [online]. Court of Justice of the European Union [quoted on 20. 06. 2018].

⁹¹ Art. 16 of Regulation (EC) of the European Parliament and of the Council No 110/2008 of 15 January 2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks. In: *EUR-Lex* [legal information system]. The Publications Office of the European Union [quoted on 20. 6. 2018]. Available at: [http://data.europa.eu/eli/reg/2008/110\(1\)/oj](http://data.europa.eu/eli/reg/2008/110(1)/oj)

are essentially attributable to that geographical origin.⁹² In addition, GIs seek not only the protection of consumers, but also the protection producers who endeavoured to guarantee the qualities expected of products.^{93, 94}

Concerning the interpretation of Art. 16(a), the Court of Justice draw a focus by its reasoning to that “*the disputed element must be used in a form that is either identical to that indication or phonetically and/or visually similar to it. Accordingly, it is not sufficient that that element is liable to evoke in the relevant public some kind of association with the indication concerned or the geographical area relating thereto*” in order to authorise indirect commercial use. The Court of Justice decided that Art. 16(b) must be interpreted that an evocation of a registered geographical indication in the absence of any phonetic and/or visual similarity between the disputed designation and the protected geographical indication and any partial incorporation of that indication in that designation, the conceptual proximity must be taken into account. On the other hand, for the purpose of Art. 16(2), the context surrounding the disputed element and the fact that the element is accompanied by an indication of the true origin of the product concerned must not be considered. Lastly, while establishing that there is a false or misleading indication, the context in which the disputed element is used is not relevant for the purpose of Art. 16(c).⁹⁵

⁹² Para. 37 of Judgment of the Court (Fifth Chamber) of 7 June 2018. *Scotch Whisky Association v Michael Klotz*. C-44/17. Case-law of the Court of Justice [online]. Court of Justice of the European Union [quoted on 20. 06. 2018]

⁹³ Para. 82 of Judgment of the Court (Second Chamber) of 14 September 2017. *European Union Intellectual Property Office v Instituto dos Vinhos do Douro e do Porto, IP*. C-56/16 P. Case-law of the Court of Justice [online]. Court of Justice of the European Union [quoted on 20. 06. 2018].

⁹⁴ Para. 38 of Judgment of the Court (Second Chamber) of 20 December 2017. *Comité Interprofessionnel du Vin de Champagne v Aldi Süd Dienstleistungs-GmbH & Co.OHG*. C-393/16. Case-law of the Court of Justice [online]. Court of Justice of the European Union [quoted on 20. 06. 2018]

⁹⁵ Judgment of the Court (Fifth Chamber) of 7 June 2018. *Scotch Whisky Association v Michael Klotz*. C-44/17. Case-law of the Court of Justice [online]. Court of Justice of the European Union [quoted on 20. 06. 2018].

The case proved that the spirits registered as GIs under the EU Regulation No 110/2008 are well protected against misleading products. It is not to be taken into account that the disputed element is complemented by an indication of the true origin.

I find this case outcome to be very interesting and powerful demonstration of the EU intentions to protect the genuine products with specific quality and attributes as a result of geographical origin at the highest possible level.

To conclude, I observe an adamant approach by the CJEU to protect GIs. Above presented, recent CJEU cases provided the examination of practical aspects of the most important EU Regulations and its provisions on the protection of GIs.

4 Protection of GIs in the United States

In the United States (hereinafter referred to as “U.S.”), GIs are considered to be a subset of trademarks. It is claimed that GIs serve the same functions as trademarks. They are valuable business assets, which identify the source and guarantee the quality. Therefore, the U.S. protects GIs through the trademark system – usually as certification and collective marks. According to the United States Patent and Trademark Office (hereinafter referred to as “USPTO”), the U.S. has provided protection to foreign and domestic GIs since at least 1946, even before the implementation of the TRIPS Agreement in 1995.⁹⁶

The U.S. does not give GIs neither a special legal status, nor registration system apart from trademark and unfair competition law. The concept of GIs as a separate form of intellectual property is historically unknown to U.S. jurisprudence. GIs are protected as geographic certification or collective marks, under trademark law or appellations of origin for wine. Very famous examples are Florida oranges, Idaho potatoes and Washington State apples.⁹⁷

4.1 Certification Marks

The U.S. Trademark Act ensures that geographic names or signs can be registered as certification marks even though they would be otherwise considered primarily as

⁹⁶ The United States Patent and Trademark Office. *Geographical Indication Protection in the United States*. [online]. © United States Patent and Trademark Office 1994 – 2018. [quoted on 15. 05. 2018]. Available at: https://www.uspto.gov/sites/default/files/web/offices/dcom/olia/globalip/pdf/gi_system.pdf, p. 2.

⁹⁷ HARVEY D. Peter. *Geographical Indications: The United States' Perspective*. [online]. The Trademark Reporter. The Law Journal of the International Trademark Association. October 2017. Available at: https://www.inta.org/TMR/Documents/Volume%20107/Issue%20No.%205/vol107_no5_a2Z_harvey.pdf

geographically descriptive and therefore unregistrable as trademarks or collective marks without a showing of acquired distinctiveness.⁹⁸

The Lanham Act, the U.S. federal trademark statute, defines a “*certification mark*” as: “*any word, name, symbol, or device, or any combination thereof--(1) used by a person other than its owner, or (2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this Act, to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person’s goods or services or that the work or labor on the goods or services was performed by members of a union or other organization*”.⁹⁹

Certification marks cannot be used by their owner on the identified goods and services. It used to be called as “*anti-use-by-owner rule*”. It is the key difference from ordinary trademarks. A trademark is a sign used to distinguish its goods and services from others. It gives its owner the right to exclude others from using that trademark. These marks are mostly owned by one entity and used by others who meet the standards to certify quality or region. There are types of certification marks to indicate: (1) quality, material, mode of manufacture, accuracy or other characteristics of the goods and services; (2) regional or other geographic origin marks and

⁹⁸ The United States Patent and Trademark Office. *Geographical Indication Protection in the United States*. [online]. © United States Patent and Trademark Office 1994 – 2018. [quoted on 15. 05. 2018]. Available at: https://www.uspto.gov/sites/default/files/web/offices/dcom/olia/globalip/pdf/gi_system.pdf, p. 2.

⁹⁹ 15 U.S.C. §1127 Lanham Act. [online]. In: *U.S. Government Publishing Office*. [quoted on 16. 05. 2018]. Available online: <https://www.gpo.gov/fdsys/pkg/USCODE-2011-title15/html/US-CODE-2011-title15-chap22-subchapIII-sec1127.htm>

(3) “*Union label*” certification marks attesting that the goods or services were provided by union labour or other organisation.^{100, 101}

The owner of the mark mostly provides an authorisation to use it to the producers. The role of the owner also consists of controlling the product characteristics required by the certification mark description.

To realise the importance of this protection, I want to show some concrete examples: *Roquefort cheese* (U.S. Reg. No. 571798) which has been manufactured solely from sheep’s milk and has been cured in the natural caves of the Community of Roquefort, Department of Aveyron in France. The second one is *Parma ham* (U.S. Reg. No. 2014627) processed and packaged in Parma, Italy. Famous *Darjeeling tea* (U.S. Reg. No. 1632726) which contains at least 60 % tea originating in the Darjeeling region of India. Lastly, *Grown in Idaho potatoes* (U.S. Reg. No. 2914307) is a very well-known example of certification mark certifying that those potatoes were grown in the State of Idaho and meet the requirements for size, colour, weight, shape and cleanliness.

4.2 Collective Marks

Another way of protection under the U.S. law is a collective mark which is defined as a trademark or service mark in the following way: “(1) *used by the members of a cooperative, an association or other collective group or organisation, or (2) which such cooperative, association or other collective group or organisation has a bona fide intention to use in commerce and applies to register on the Principal Register*

¹⁰⁰ HARVEY D. Peter. *Geographical Indications: The United States’ Perspective*. [online]. The Trade-mark Reporter. The Law Journal of the International Trademark Association. October 2017. Available at: https://www.inta.org/TMR/Documents/Volume%20107/Issue%20No.%205/vol107_no5_a2Z_harvey.pdf

¹⁰¹ The United States Patent and Trademark Office. *Geographical Indication Protection in the United States*. [online]. © United States Patent and Trademark Office 1994 – 2018. [quoted on 15. 05. 2018]. Available at: https://www.uspto.gov/sites/default/files/web/offices/dcom/olia/globalip/pdf/gi_system.pdf, p. 2

established by this Act, and includes marks indicating membership in a union, an association, or other organisation".¹⁰²

A collective entity owns a collective mark. On the other hand, the mark is used by the members of the collective. Agricultural cooperatives of sellers of wine or cheese producers are typical owners of collective marks. Collective entities mostly promote the goods and services of its members, instead of selling goods on its own.¹⁰³

Two types of collective marks could be distinguished: (1) collective trademarks or collective service marks and (2) collective membership marks. As it was explained in *Aloe Creme Labs, Inc. v. Am. Soc'y for Aesthetic Plastic Surgery, Inc.*¹⁰⁴, a collective trademark or collective service mark is a mark adopted by a "collective" (e.g. an association, union, cooperative, fraternal organization, or other organized collective group) for use only by its members, who in return use the mark to identify their goods or services and distinguish them from those of non-members. Classic examples of collective trademarks and service marks are: *Realtors* for "brokerage of real estate" (Reg. No. 515200), *Blue Shield* for "furnishing medical care on a pre-payment basis" (Reg. No. 557037) or *National Honor Society* for "stimulating and maintaining interest in good scholarship among students" (Reg. No. 568636). A collective membership mark is a mark adopted for the purpose of indicating membership in an organised collective group, such as a union, an association, or other organisation.

¹⁰² 15 U.S.C. §1127 Lanham Act. [online]. In: *U.S. Government Publishing Office*. [quoted on 16. 05. 2018]. Available online: <https://www.gpo.gov/fdsys/pkg/USCODE-2011-title15/html/USCODE-2011-title15-chap22-subchapIII-sec1127.htm>

¹⁰³ HARVEY D. Peter. *Geographical Indications: The United States' Perspective*. [online]. The Trademark Reporter. The Law Journal of the International Trademark Association. October 2017. Available at: https://www.inta.org/TMR/Documents/Volume%20107/Issue%20No.%205/vol107_no5_a2Z_harvey.pdf

¹⁰⁴ Judgement of the Trademark Trial and Appeal Board. *Aloe Creme Labs, Inc. v. Am. Soc'y for Aesthetic Plastic Surgery, Inc.* 192 U.S.P.Q. 170 (TTAB 1976). Case Law of the Trademark Trial and Appeal Board. [online]. Unites States Patent and Trademark Office. [quoted on 18. 06. 2018].

Neither the collective nor its members use the collective membership mark to identify and distinguish goods or services. A well-known collective membership marks are for example: *Hells Angels* (Reg. No. 1214476), *National Ski Patrol* (Reg. No. 1534867), *Hare Krishna Movement* (Reg. No. 1017633) and *Weight Watchers* (Reg. No. 847199).¹⁰⁵

I would like to mention two additional examples of the famous registered collective marks indicating the regional origin in Europe: *Frankfurter Apfelwein* (U.S. Reg. No. 1097779) for apple wine from the city of Frankfurt in Germany. The second one is *Deutsches Eck* (U.S. Reg. No. 1350923) for beer from the middle Rhine and lower Mosel areas of Germany.

4.3 Appellation of Origin of Wine

Wine has significant importance when covering the geographical indications, so it has a unique way of registration. Applicant must comply both, the requirements of the Lanham Act and regulations promulgated by the Treasury Department pursuant the Federal Alcohol Administration Act. The Treasury Department's Alcohol and Tabaco Tax and Trade Bureau ("*TTB*") permits winemakers to indicate that wine originates from a particular geographical area.¹⁰⁶

In practice, the regulations prevent false claims – labels that misleadingly suggest that wine originates from a well-known viticultural area. Viticultural areas need not be defined by states, countries or towns. They can have smaller boundaries, not similar to an administrative division. There are more than 130 viticultural areas in 27 states. It means that appellations of origin for U.S. wines vary really widely. They

¹⁰⁵ BAZERMAN, H. Steven, DRANGEL, M. Jason. *Guide to Registering Trademarks*. Wolters Kluwer, 1998. p. 3.9-3.11.

¹⁰⁶ HARVEY D. Peter. *Geographical Indications: The United States' Perspective*. [online]. The Trademark Reporter. The Law Journal of the International Trademark Association. October 2017. Available at: https://www.inta.org/TMR/Documents/Volume%20107/Issue%20No.%205/vol107_no5_a2Z_harvey.pdf

can include the entire United States, a single state, a county or a location established by a viticultural area.¹⁰⁷

This system helps to provide stricter protection for consumers in order to ensure the integrity of its wine industry.

Generic geographic designations are not protected in the U.S. They are incapable of identifying a specific business source (or a specifically defined collective producing source). Once a geographic designation is generic in the U.S., any producer is free to use the designation for its goods/services. Due to the popularization of the products in the English language, the designations “*parmesan*” and “*champagne*” are considered to be descriptive there. Practically, “*California Champagnes*” website displays the following text: “*Most California sparkling wines are made in the Méthode Champenoise style with many of the wineries calling their product “sparkling wine” and some even use the Champagne designation.*”¹⁰⁸ On the other side, “*Roquefort*” cheese is protected, because the term is not so popularized in the U.S., probably due to its language origin from French.¹⁰⁹

¹⁰⁷ Ibid.

¹⁰⁸ California Champagnes. *California Sparkling Wine & Champagne* [online]. ©2018 CALIFORNIA CHAMPAGNES. [quoted on 28. 06. 2018]. Available at: <http://www.californiachampagnes.com/>

¹⁰⁹ MAKRIS, Demetra. *Geographical Indicators: A Rising International Trademark Dispute between Europe's Finest and Corporate America*. [online]. Arizona Journal of International & Comparative Law. Vol. 34. No. 1. 2016. [quoted on 20. 06. 2018]. Available at: http://arizonajournal.org/wp-content/uploads/2017/04/06_MAKRIS_V3.pdf

5 Advantages and Disadvantages of the Systems

This chapter aims to cover the debatable issue of whether sui generis or trademark system presents better protection for GIs. The systems could be seen as well cooperating together or as incompatible constituting a keystone issue.

At the beginning, I assume it is important to state that both, the EU and U.S. recognise and promote respective GIs. As members of the WTO, they have agreed on the general definition of GI provided by Art. 22(1) of the TRIPS Agreement, which represents the most significant international definition of GI. TRIPS established the minimum standards on protection, which every Member State must respect. It is in Member States' discretion, how to implement it and provide the sufficient protection. According to Ganjee, it constituted an “*unstable compromise*”.¹¹⁰ As being analysed above, the EU and U.S. provide the protection in a fundamentally different way. Nevertheless, both approaches are sufficient and in compliance with the minimum standards given by the TRIPS Agreement. Prima facie, systems indicate contrasting and institutional foundations. Practically, they are not so isolated from each other, and they can create synergies.¹¹¹

On the one hand, using already existing trademark legislation might be tranquil and continuous. By simple expansion of the scope of protection afforded under trademark law, the U.S. was able to protect GIs instantly; no legislation process was needed. If disputes arise between GI (protected as certification or collective mark) and trademark, principles of trademark law will be applied. Consequently, a dispute settling system, giving anticipated and calculable outcomes, is ensured. On the other

¹¹⁰ GANGJEE, Dev. Relocating the Law of Geographical Indications. Cambridge University Press, p. 184.

¹¹¹ LE GOFFIC, Caroline, ZAPPALAGLIO, Andrea. *The Role Played by the US Government in the Protecting Geographical Indications*. World Development Vol. 68, pp. 35-44. 2017. © 2016 Published by Elsevier Ltd.

hand, there is the specifically tailored sui generis system in the EU, which appears to be stronger than the protection afforded by the trademark system.¹¹²

The U.S. trademark regime is already familiar to businesses, both foreign and domestic. Only the resources already invested in the trademark system for applications, registrations, oppositions, cancellations, adjudication, and enforcement are used. Thus, this system did not financially burden the taxpayers and government resources. Additionally, it also covers the GIs that are not merely place names, but signs such as words, slogans, designs, three-dimensional marks, colours or even sounds and scents.¹¹³

A detailed examination acknowledges that the U.S. provides sufficient protection for GIs, which complies with all the TRIPS requirements for their national treatment and enforcement. I find the U.S. trademark system very efficient. Private owners do not have to wait for their government to take action against infringement or address unauthorised use. The owner can decide whether and when to take action against potential infringement. In the EU, there is an officially published document of the authorities enforcing compliance with PDO-PGI-TSG obligations in respect of product placed on the market (Art. 38 of Reg. 1151/2012). However, the owners of registered GIs can protect their products against infringement as counterfeit, misleading advertising, passing off or even as a question of public health.¹¹⁴

¹¹² FLODGREN. Johan. *Geographical Indications and Trademarks: Synergies and Conflicts in the International Market*. [online]. Organization for an International Geographical Indications Network (oriGIIn). [quoted on 19. 06. 2018]. Available at: https://www.origin-gi.com/images/stories/PDFs/English/OriGIIn_publications/News/johan_flodgren_essay.pdf

¹¹³ The United States Patent and Trademark Office. *Geographical Indication Protection in the United States*. [online]. © United States Patent and Trademark Office 1994 – 2018. [quoted on 15. 05. 2018]. Available at: https://www.uspto.gov/sites/default/files/web/offices/dcom/olia/globalip/pdf/gi_system.pdf, p. 2.

¹¹⁴ European Commission. *Authorities and/or bodies enforcing compliance with PDO-PGI-TSG obligations in respect of product placed on the market (Art. 38 of Reg. 1151/2012)*. European Commission. May 2018. [quoted on 24. 06. 2018]. Available at: https://ec.europa.eu/agriculture/sites/agriculture/files/quality/schemes/compliance-authorities_en.pdf

Correspondingly, the system is self-monitoring due to the fact that competitors in the geographic area in question, or mark owners will undoubtedly claim infringement, or report failure to comply with certification standards. Therefore, supplementary government resources devoted for enforcement of compliance are not required. On the other hand, the above-described absence of enforcement by administrative action could constitute an obstacle for smaller producers or GI associations. Only the trademark owner is responsible for controlling of his trademark on the market and challenging abuses and oppose registrations.

Consequently, the sui generis system provides protection for GIs without any time limitation. Thus, the protection will remain valid with no need of renewal, unless the GI registration is cancelled. Unlike the trademarks, GIs do not confer individual rights, but rather collective rights. GI is mostly registered by an association or formation of producers from the specific locality. Individual producers are only using the registered GI under beforehand described conditions of production for the product. They are not the owners.¹¹⁵

Trademarks can become generic as a result of the term vulgarisation. Afterwards, the designation is not capable of the source-identifying function. In addition, it is not enforceable by US trademark law because it is not possible to register a generic term as a trademark. It happens when a consumer uses the mark as the name of the product. Then, its distinctiveness is lost. A very famous example is Kleenex. Consumers replaced word “*tissue*” with the trademark “*Kleenex*”. Instead of proper formulation: “*Do you have a Kleenex tissue?*”, the trademark is used in a generic way: “*Do you have a Kleenex?*”.¹¹⁶

¹¹⁵ GUYOT, Nicolas. *The value of geographical indications for businesses*. [online]. European IPR Helpdesk. September 2016. [quoted on 19. 06. 2018]. Available at: https://www.ipr-helpdesk.eu/sites/default/files/newsdocuments/Fact-Sheet-Geographical_Indications_2.pdf, p. 7.

¹¹⁶ MAKRIS, Demetra. *Geographical Indicators: A Rising International Trademark Dispute between Europe's Finest and Corporate America*. [online]. Arizona Journal of International & Comparative Law. Vol. 34. No. 1. 2016. [quoted on 20. 06. 2018]. Available at: http://arizonajournal.org/wp-content/uploads/2017/04/06_MAKRIS_V3.pdf

Trademarks are based on “*first in time, first in right*” principle, thus the trade mark applied for could be opposed by the proprietor of an earlier trade mark under the specific circumstances – an example of relative ground for trademark application refusal. In the US, a prior right holder has priority and exclusivity over any later users of the same or similar sign where consumers would likely be confused by the two uses. The rule is applicable to the same, similar, related, or in some cases unrelated goods and services. Thus, the trademark owner has the exclusive right to prevent the use of the mark by unauthorised parties. In addition, if the trademark is not used genuinely, fatal consequences could occur (e.g. revocation of the trademark). Furthermore, trademarks are private law instruments, tied up by time limits (e.g. renewals and payment of related fees).¹¹⁷

In contrast, the undeniable advantage of trademarks is an easier registration process. GIs require reputation and also rely on the past experience of consumers.¹¹⁸

The procedural aspects surrounding GIs in the EU and trademarks in the US are certainly different. In the EU, the application process of PDOs, PGIs and TSGs is grounded in Art. 49 of the Regulation (EU) No 1151/2012.¹¹⁹ Firstly, the registration must be processed by the designated national authority of the Member State or their group. In the case of successful registration at the national level, the registered name is adequately published by the Member State. Then, the application is processed by the European Commission. After the scrutiny, which should not exceed a period of six months, a name is published in the Official Journal of the European Union, if all the required conditions were met.¹²⁰ An opposition, which could be lodged within three months from the date of publication in the Official Journal of the European

¹¹⁷ DE TULLIO, Elio. *Trademark protection for quality products*. Presentation at the International Trademark Association Annual Meeting, Seattle, May 2017.

¹¹⁸ Ibid.

¹¹⁹ Art. 49 of the Regulation (EU) No 1151/2012 of 21 November 2012 on quality schemes for agricultural products and foodstuffs. In: EUR-Lex [legal information system]. The Publications Office of the European Union [quoted on 23. 06. 2018]. Available at: <http://data.europa.eu/eli/reg/2012/1151/oj>

¹²⁰ Ibid. Art. 50.

Union, and the cancellation procedure are both administered by the Commission.¹²¹ If no objection is made, a registered PDO/PGI/TSG enters the Database of Origin & Registration ("*DOOR*").^{122, 123, 124}

On the other hand, the procedure of registration certification and collective marks in the US is administered by the USPTO. Marks are published in the official journal of the USPTO, which is called the Official Gazette.¹²⁵ According to 37 C.F.R. § 2.101(b), any person who believes that would be damaged by the registration of a mark may file an opposition. It may be filed only in response to the publication of the mark during the application in the Official Gazette of the USPTO. An opposition is addressed to the Trademark Trial and Appeal Board (hereinafter referred to as "*TTAB*"). In addition, a petition for cancellation may be filed by any person who believes that he is or will be damaged by the registration of the mark. The losing party at the TTAB level may appeal the TTAB's decision to the Court of Appeals for the Federal Circuit, a court with jurisdiction, inter alia, over intellectual property matters.¹²⁶

¹²¹ Ibid. Art. 51, 54.

¹²² IDABC. *DOOR: Database of Origin and Registration*. [online]. European eGovernment Services. [quoted on 24. 06. 2018]. Available at: <http://ec.europa.eu/idabc/en/document/5360/5637.html>

¹²³ The DOOR database provides the following details about registered PDOs, PGIs, and TSGs: Denomination (in original language only), Type of product, Member State of origin, Product specification (original language only), Summary in all official languages, Dates of application and registration and Name and contact details of the responsible authority

¹²⁴ Note also "E-Bacchus" database which consists of the Register of designations of origin and geographical indications protected in the EU in accordance with Regulation (EU) No 1308/2013, lists non-EU countries' geographical indications and names of origin protected in the EU in accordance with bilateral agreements on trade in wine concluded between the EU and the non-EU countries' concerned; and lists the traditional terms protected in the EU in accordance with Regulation (EU) No 1308/2013. Available at: <http://ec.europa.eu/agriculture/markets/wine/e-bacchus/>

¹²⁵ The United States Patent and Trademark Office. *Official Gazette*. [online]. © United States Patent and Trademark Office 1994 – 2018. [quoted on 23. 06. 2018]. Available at: <https://www.uspto.gov/learning-and-resources/official-gazette>

¹²⁶ The United States Patent and Trademark Office. *Trademark Trial and Appeal Board Manual of Procedure*. [online]. © United States Patent and Trademark Office 1994 – 2018. [quoted on 23.

Due to the fact that harmonious coexistence of GIs and trademarks is possible, I believe that the double-layer protection via both of these IP instruments represents the most beneficial approach. This combined use could be prosperous for both parties, producers and also consumers. Firstly, producers prevail over any legal pitfalls given by the international uncertainty of the area. Secondly, consumers are adequately informed about the commercial source (as a consequence of the trademark) and geographical origin (as a consequence of the GI) of the products.

The most important outcome of the comparison lies in the fundamentally different institutional approach to the protection of GIs in the EU and U.S. The EU constructed the sui generis system on protection of agriculture and foodstuff products (PDOs, PGIs, TSGs), wines, aromatised wines and spirits. The U.S. relies on well-established and flexible trademark system which under the common law rules recognises also unregistered trademark rights.

For the purpose of the comparison, I would definitely highlight the aspect that GIs do not confer individual rights, but rather collective rights, opposingly to trademarks. This perspective is important for the comparison of enforcement of rights vested in the institutes of GIs and trademarks.

Procedural aspects of application, opposition and cancellation were compared. In the U.S., the procedure is administered by the USPTO and TTAB. In the EU, it is under the authority of the Commission.

I consider the threat of trademark genericide as a substantive disadvantage of the U.S. system on the protection of GIs. It also constitutes one of the biggest issues for international cooperation negotiations. As a result of the U.S. trademark approach, momentous number of GIs, protected in the EU, is not recognised in the U.S., due to the fact of being considered as descriptive designations (e.g. "*champagne*" or "*parmesan*").

The significant impact of the different approach on the protection of GIs already in the past could be seen in the Report of the Panel (WT/DS174/R) of 15 March 2005 regarding the Complaint by the United States against the European Communities on the Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs. The dispute started in 1999 when the U.S. requested consultations on the matter of lack of protection of trademarks and geographical indications. The dispute was decided by the WTO Dispute Settlement Body. The U.S. claimed that European Communities (EC) 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 (1) discrimination against foreign nationals and foreign products with respect to geographical indication protection, and (2) failure to protect foreign trademarks. The Panel of the WTO Dispute Settlement body decided that the GI Regulation at issue discriminated foreign nationals by requiring equivalent systems of protection in the foreign country. The European Communities implemented all the recommendations into the next GI regulation which entered into force on 31 March 2006.¹²⁷

To conclude the chapter, even though the protection of GIs is based on essentially different institutes in the EU and U.S., trademarks and GIs, they both have a common element – providing exclusivity for producers. The EU provides stronger protection for GIs. It is proved by the sophisticated and detailed sui generis system and institutes of PDO, PGI and TSG and relevant database DOOR. Therefore, I observe that the protection for GIs is assured in the EU and also U.S., at least in the compliance with the minimum standard determined by the TRIPS Agreements.

¹²⁷ Panel Report of WTO Dispute Settlement Body of 15 March 2005. European Communities - Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs. DS174. [online]. WTO Disputes. [quoted on 28. 06. 2018]. Available at: https://www.wto.org/english/tratop_e/dispu_e/cases_e/ds174_e.htm

6 GIs and their Relations to Other Signs

This chapter aims to examine the relation of GIs to other signs, namely domain names. GIs are widely used by the Domain Name System. The practical implications of the different legal framework of protection covering the scope of GIs in the EU and U.S. could be seen especially in relation to domain names and the Uniform Domain Name Dispute Resolution Policy (hereinafter referred to as “*UDRP*”). In addition, the chapter develops the topic of the relation of the EU GIs and EU trademarks.

6.1 Domain Names

The EU law does not provide any legal definition of the term “*domain name*”. Thus, for the purpose of the Master’s Thesis, the adequate definition could be derived from the literature: “*A domain name is an alphanumeric label corresponding to an Internet Protocol address (hereinafter referred to as “IP address”)*”.¹²⁸

Domain names are formed according to the rules of Domain Name System (hereinafter referred to as “*DNS*”). The explanation of the function of domain names could be simplified in the following way. The user of the Internet types the domain name instead of precise IP address, which consist of a string of numbers. Domain names are hierarchically organized in subordinate levels, which are divided by the dots. The first level set of domain names are the top-level domains (hereinafter referred to as “*TLDs*”), including the generic top-level domains (hereinafter referred to as “*gTLDs*”), such as the prominent domains (e.g. .com, .info, .net, .edu, and .org), and the country code top-level domains (hereinafter referred to as “*ccTLDs*”) (e.g. .eu, .cz, .fr, .us, .uk). However, domain names do not expose the user’s location. Hence, a ccTLD does not automatically disclose that its registrant is located in that

¹²⁸ HÖRNLE, Julia. *Cross-border internet dispute resolution*. Cambridge: Cambridge University Press, 2009. p. 22.

country. Therefore, if a dispute occurs, the counter-parties could be surprised by the unexpected location in another jurisdiction.^{129, 130}

The domain name space is managed by the Internet Corporation for Assigned Names and Numbers (hereinafter referred to as "ICANN") created in 1998. ICANN accredits the domain name registrars, through which domain names may be registered and reassigned. It also defines policies for how the "names and numbers" of the Internet should run.¹³¹

A domain name represents a sign. This sign could be in the conflict with other, registered signs, for example, trademarks or even geographical indications. A potential dispute arises when a person registers a domain name confusingly similar to the registered sign (e. g. trademark, PGI) which is owned by a different person. There are particular procedures for owners of the registered signs, how to defend them against the confusingly similar domain names. The appropriate procedure depends on the type of the gTLD.¹³²

6.2 The Uniform Domain Name Dispute Resolution Policy

The above-mentioned DNS was designed by non-lawyers who were concerned mostly with technical matters, not with potential legal conflicts in the era of commercial Internet use. Later on, the gap between domain names and real-world identifiers/intellectual property rights emerged. Already back in 1999, the WIPO pointed out the conflict: "*The DNS was designed for its own internal purposes: to ensure connectivity in a technically coherent manner and to do so in a way which was simple and easy for human users to understand and use. Over the same period as the DNS has demonstrated its outstanding success in achieving its design objectives,*

¹²⁹ Ibid. p. 22.

¹³⁰ LINDSAY, David. *International domain name law: ICANN and the UDRP*. Oxford: Hart publishing, 2007. p. 6-14.

¹³¹ Ibid. p. 40-67.

¹³² CHARVÁT, Radim. *Označení původu a zeměpisná označení versus konfliktní doménová jména*. Obchodní právo. Wolters Kluwer. April 2017, p. 123.

however, it has become a victim of its own success as the applications of the Internet have expanded into all spheres of activity and as enterprises and persons have begun to include their domain names in the standard identification apparatus that they use for the purposes of business and social communication.”^{133, 134}

Generally, the UDRP sets out the legal framework for the resolution of disputes between a domain name registrant and a third party. On 24 October 1999, the ICANN board approved the implementation of the UDRP, which are based on the proposals made in WIPO’s Final Report. A very well know term “*cybersquatting*” concerns this topic. Typically, it is abusive, bad faith registration of another’s trademark in a domain name. The UDRP provides protection against bad faith registration if all the three elements/conditions of bad faith registration are met. These elements are set out in paragraph 4(a) of the UDRP.¹³⁵ The first element means the complainant is required to establish that the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights. The second element requires the complainant to prove that the domain name holder has no rights or legitimate interest in the domain name. The third element depends upon the ability of the complainant to prove that the domain name has been registered and is being used in bad faith.¹³⁶

The UDRP Proceedings are conducted according to the procedural rules called Rules for Uniform Domain Name Dispute Resolution Policy (hereinafter referred to as “*Rules for UDRP*”). The UDRP and Rules for UDRP comprise the legal framework for alternative dispute resolution for gTLDs. These rules are

¹³³ WIPO. *The Management of Internet Names and Addresses: Intellectual Property Issues*. [online]. Report of the WIPO Internet Domain Name Process. April 1999. [quoted on 20. 06. 2018]. Available at: <http://www.wipo.int/amc/en/processes/process1/report/index.html>, para 46.

¹³⁴ LINDSAY, David. *International domain name law: ICANN and the UDRP*. Oxford: Hart publishing, 2007. p. 95-128.

¹³⁵ Para. 4(a) of *Uniform Domain Name Dispute Resolution Policy*. [online]. © 2018 Internet Corporation for Assigned Names and Numbers [quoted on 20. 06. 2018] Available at: <https://www.icann.org/resources/pages/policy-2012-02-25-en>

¹³⁶ *Ibid.* p. 109-116.

incorporated in the contract between the domain name holder and registrar. The proceedings itself is conducted before one of the administrative-dispute-resolution service providers, which are officially listed by ICANN (e.g. WIPO Arbitration and Mediation Center, The Czech Arbitration Court Arbitration Center for Internet Disputes or Asian Domain Name Dispute Resolution Centre). The complaint under the UDRP could have the following decisions: denial, cancellation of the domain name, its transfer or other changes to the domain name registration.¹³⁷

Concerning the abusive registrations, the Final Report on the WIPO Internet Domain Name Process states in its paragraph 167, that it is defined only by reference to trademarks and service marks. Therefore, the registrations that violate trade names, geographical indications or personality rights would not be considered to fall within the definition of abusive registration for the purposes of the UDRP administrative procedure. This procedural set up is justified by the number of cases related to trademark and service mark abuse, which are the most common. As a result of not sufficiently harmonised legal protection of trade names, geographical indications and personality rights in the world, taking into account the international treaties on the protection of geographical indications and trade names, they are not considered.¹³⁸

Further, the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (*“WIPO Jurisprudential Overview 3.0”*) must be analysed for the purpose of this chapter. Its paragraph 1.6 explicitly notes that: *“Geographical terms used only in their ordinary geographical sense, except where registered as a trademark, would not as such provide standing to file a UDRP case”*. It additionally comments, that they could provide standing to file a UDRP case only if they are

¹³⁷ ICANN. *Uniform Domain Name Dispute Resolution Policy*. [online]. © 2018 Internet Corporation for Assigned Names and Numbers [quoted on 20. 06. 2018] Available at: <https://www.icann.org/resources/pages/policy-2012-02-25-en>

¹³⁸ WIPO. *The Management of Internet Names and Addresses: Intellectual Property Issues*. [online]. Report of the WIPO Internet Domain Name Process. April 1999. [quoted on 20. 06. 2018] Available at: <http://www.wipo.int/amc/en/processes/process1/report/index.html>, para 167.

registered as trademarks and not used solely in a geographically descriptive sense.¹³⁹

I believe it presents an enormous benefit for the United States, which protect GIs under the trademark system. Nevertheless, if a UDRP case complainant is able to prove the secondary meaning of the geographical term at issue, consumer recognition of the mark in relation to the complainant's goods or services, GI could provide standing for extraordinary cases. In essence, it would mean to prove unregistered trademark rights in that geographical term on the basis of secondary meaning, which is very complicated and time-consuming. Supplementary, it requires sufficient evidence.

This partial recognition of exceptional conditions, while GIs could provide standing for a UDRP case, is significant progress. The previous Panel, the second edition of the WIPO Panel Views on Selected UDRP Questions, ultimately refused the extension of protection on GIs under the UDRP.

6.2.1 Case No. D2017-0554 - “*gorgonzola.club*”

The practical consequences for owners of GIs are very unpleasant and troublesome. Recently, on 14 May 2017, a case No. D2017-0554 between Consorzio per la Tutela del Formaggio Gorgonzola of Novara versus William Wise of Brooklyn was decided by the WIPO Arbitration and Mediation Center.¹⁴⁰

The disputed domain name was “*gorgonzola.club*”, which was registered by William Wise with the registrar GoDaddy.com, LLC. The complainant of the case is Consorzio per la Tutela del Formaggio Gorgonzola of Novara, which owns the PDO “*Gorgonzola*” in the European Union from 12 June 1996 under the Reg. No. 1107. It

¹³⁹ WIPO. *Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition*. [online]. WIPO. 2017 [quoted on 20. 06. 2018]. Available at: <http://www.wipo.int/export/sites/www/amc/en/docs/overview3.pdf>, para 1.6.

¹⁴⁰ Administrative Panel Decision of WIPO Arbitration and Mediation Center of 14 May 2017. *D2017-0554. Domain Name Disputes*. [online]. WIPO. [quoted on 22. 06. 2018]. Available at: <http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2017-0554>

also has a figurative European Union Trade Mark registration under the Reg. No. 010595015. The panel noted that there is no evidence in the complaint that “*gorgonzola*” is a protected denomination of origin in the United States, the location of the respondent, and cheese described as “*gorgonzola*” is produced in the United States. Thus, the panel recognised the protection of the denomination of origin in the EU. However, it was not satisfied by the evidence submitted by the complainant that the word “*gorgonzola*” is anything other than a descriptive term for a particular type of cheese in the United States. According to the various articles annexed, the panel concluded that the term “*gorgonzola*” has descriptive meaning for particular type veined Italian blue cheese, made from unskimmed cow’s milk and produced in a particular manner, using the mould “*penicillium glaucum*”.¹⁴¹

The panel added that the complainant provided insufficient evidence to prove an unregistered trademark rights for “*Gorgonzola*” in the U.S. Without such a strong reputation of the term in the U.S., a domain name featuring the word “*gorgonzola*” does not have to mean taking unfair advantage necessarily. No evidence for illegitimate commercial purposes was observed. Bad faith registration was not proved in the case. Hence, the complaint was denied.¹⁴²

6.2.2 Case No. D2018-0168 - “*rioja.com*”

Nowadays, on 4 May 2018, the WIPO Arbitration and Mediation Center decided the case No. D2018-0168 between Regulatory Board of the Rioja Qualified Designation of Origin (“*D.O.CA*”) of Logroño and Kevin Daste of New Orleans under the UDRP. The disputed domain name was “*rioja.com*” registered with the registrar Sea Wasp, LLC. Regulatory Board of the Rioja Qualified Designation of Origin of Logroño is the complainant in the case.¹⁴³

¹⁴¹ Ibid.

¹⁴² Ibid.

¹⁴³ Administrative Panel Decision of WIPO Arbitration and Mediation Center of 4 May 2018. *D2018-0168. Domain Name Disputes*. [online]. WIPO. [quoted on 22. 06. 2018]. Available at: <http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2018-0168>

The disputed domain name was registered on 7 November 1996 by a person different from the actual registrant. Nevertheless, he should be treated as having acquired the disputed domain name as of the date of first registration. The complainant is the owner of the PDO “*Rioja*” and was established in 1991 as an official body with a purpose to promote and defence the PDO. Rioja is wine produced in the autonomous communities of La Rioja, the Basque Country, and Navarre. Three subareas are recognised by cause of different wine characteristic: Rioja Alta, Rioja Baja, and Rioja Alavesa. The complainant owns various trademarks, also the International Trade Mark No. 655291, registered on 10 June 1996 which contains the word “*Rioja*”. Interestingly, the domain name at issue invited potential buyers to make an offer or to request a price for the domain name. The Complainant submitted statistical sales evidence, claiming that Rioja wine has the worldwide prestige.¹⁴⁴

The panel commented that the complainant failed to demonstrate its role in such worldwide activities or the degree of recognition. Statistical information was insufficient to show unregistered trademark rights. In addition, it failed to demonstrate the distinctiveness of the term “*Rioja*” and establish unregistered trademark rights in the term “*Rioja*”. Respondent claimed he did not have knowledge of the term “*Rioja*” in relation to wine at the time of registration of the disputed domain name. The panel concluded that the complainant did not manage to prove that respondent registered the domain name at issue most likely with reference to the complainant’ trademarks rather than purely for its geographical meaning. Finally, the panel decided that the case never moved beyond a presumption, and bad faith registration was not proved. This complaint was denied.¹⁴⁵

The Rioja case showed that GIs are not sufficient standing for the UDRP case. Despite the fact that complainant failed to prove bad faith, the third element, the first element was recognised only as a result of the registered trademarks.

¹⁴⁴ Ibid.

¹⁴⁵ Ibid.

6.2.3 Case No. DCO2011-0026 - “*champagne.co*”

Lastly, I want to analyse the case No. DCO2011-0026 which involved a very well-known GI “*Champagne*”. The dispute occurred between Comité Interprofessionnel du vin de Champagne and Steven Vickers. The disputed domain name was “*champagne.co*” registered with the registrar Tuscows Inc.¹⁴⁶

The panel expressed that the complainant did not sufficiently show that the rights in the expression “*Champagne*” constitute an unregistered trademark right of the kind that would satisfy the procedural policy. The panel mentioned that a geographical indication per se does not distinguish the wine of one champagne producer from the wine of another. Thus, there is not any individual trade source to protect in the case. Even though, the panel recognised that “*Champagne*” may be among the world’s most famous geographical indications, that is not the kind of “*acquired distinctiveness*” which would of itself be enough to confer “*trademark or service mark*” status for the purposes of the first UDRP element. Unlike in the previous Rioja case, CIVC did not possess any registered trademarks. Therefore, the complainant failed to prove the first element under paragraph 4(a)(i) of the UDRP¹⁴⁷, and the complaint was denied.¹⁴⁸

Nowadays, there are 350 million registered domain names in total. In 2018, 17 300 domain names include “*Champagne*”, which includes exact reproductions (e.g. “*champagne.ru*”), translations (e.g. “*champagner.eu*” or “*champania.com*”), com-

¹⁴⁶ Administrative Panel Decision of WIPO Arbitration and Mediation Center of 21 June 2011. *DCO2011-0026. Domain Name Disputes*. [online]. WIPO. [quoted on 22. 06. 2018]. Available at: <http://www.wipo.int/amc/en/domains/search/text.jsp?case=DCO2011-0026>

¹⁴⁷ Para. 4(a)(i) of *Uniform Domain Name Dispute Resolution Policy*. [online]. © 2018 Internet Corporation for Assigned Names and Numbers [quoted on 20. 06. 2018] Available at: <https://www.icann.org/resources/pages/policy-2012-02-25-en>

¹⁴⁸ Administrative Panel Decision of WIPO Arbitration and Mediation Center of 21 June 2011. *DCO2011-0026. Domain Name Disputes*. [online]. WIPO. [quoted on 22. 06. 2018]. Available at: <http://www.wipo.int/amc/en/domains/search/text.jsp?case=DCO2011-0026>

mercial websites selling non-Champagne sparkling wines (e.g. “*meinchampagner.de*”) and websites named Champagne relating to non-Champagne activities. It is, unfortunately, an enormous potential for legal infringement.¹⁴⁹

I contemplate that the scope of UDRP procedure should be extended. Specifically, the condition of the first element, which requires a trademark or service mark as standing for the UDRP case, should be updated. The uncertain position of right holder would be improved. Already back in 2014, Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications of the WIPO expressed their concerns on the matter. The importance of GIs and high risk of infringements were highlighted. Regrettably, for GI owners, the UDRP remained unchanged.¹⁵⁰

6.3 Trademarks in the European Union

This subchapter aims to briefly explain the relation between GIs and trademarks in the EU.

Art. 7(1) of the EU Regulation 2017/1001 represents absolute grounds for refusal of trademark application and also a key provision explaining the relation between GIs and trademarks.¹⁵¹

The following shall not be registered: Art. 7(1)(b) states: “*trademarks which are devoid of any distinctive character*”, Art. 7(1)(c): “*trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the*

¹⁴⁹ GOEMAERE, Charles. *Protection of “Champagne” on the Internet*. Presentation at the International Trademark Association Annual Meeting. Seattle. May 2017.

¹⁵⁰ WIPO. *Proposal of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications*. [online]. WIPO. Thirty-First Session. May 2014. [quoted on 22. 06. 2018]. Available at: http://www.wipo.int/edocs/mdocs/sct/en/sct_31/sct_31_8_rev_4.pdf

¹⁵¹ Art. 7 of Regulation (EU) of the European Parliament and of the Council No 2017/1001 of 14 June on the European Union trade mark. In: *EUR-Lex* [legal information system]. The Publications Office of the European Union [quoted on 22. 06. 2018]. Available at: <http://data.europa.eu/eli/reg/2017/1001/oj>

goods or of rendering of the service, or other characteristics of the goods or service” and Art. 7(1)(j) “The following shall not be registered: trademarks which are excluded from registration, pursuant to Union legislation or national law or to international agreements to which the Union or the Member State concerned is party, providing for protection of designations of origin and geographical indications”¹⁵²

Therefore, GIs, which seek for the trademark protection, are mostly objected to being not distinctive enough, solely designating the quality or geographical origin.

Contrarily, the subchapter above mentioned in the particular case, that Consorzio per la Tutela del Formaggio Gorgonzola of Novara submitted an EU trademark as evidence in the domain name complaint under the UDRP. The trademark in question is a figurative trademark, which is represented by the letter “g”. The figurative mark does not contain the term “gorgonzola”. Otherwise, they do not have any other registered word trademark “gorgonzola”, because I believe such a trademark application would be rejected by the EUIPO on the grounds of Art. 7(1)(j).

As a practical example, I would mention a trademark application No. 015956485 for a word trademark “Mezcal 52”, which was rejected by the EUIPO on 7 March 2017. It contained a PDO, was descriptive and devoided of any distinctive character. It applied for protection in International Class 33 of the Nice Agreement¹⁵³ for Edible alcoholic beverages; Alcoholic cordials; Spirits; Spirits and liquors; Digesters [liqueurs and spirits]; Liqueurs; Distilled spirits; Distilled beverages; Aperitifs with a distilled alcoholic liquor base.¹⁵⁴

On 26 October 2017, the EUIPO also rejected an application for EU figurative mark, which displayed a part of the sun and contained words “TERRA TEQUILA”. It

¹⁵² Ibid. Art. 7(1)(b), 7(1)(c), 7(1)(j)

¹⁵³ Nice Agreement. In: *WIPO-Lex* [online]. WIPO [quoted on 22. 06. 2018]. Available at: <http://www.wipo.int/classifications/nice/en>

¹⁵⁴ EUTM file information. *Mezcal 52. Application number: 015956485*. [online]. © EUIPO 1995-2018 [quoted on 22. 06. 2018]. Available at: <https://euipo.europa.eu/eSearch/#details/trademarks/015956485>

was found that the trademark applied for contained a PGI “*Tequila*”. Hence, the application was rejected on the grounds of Art. 7(1)(j).¹⁵⁵ The same happened within the trademark application for the figurative mark “*IRISH Country Cream THE BENEDICTINE NUNS KYLEMORE ABBEY CONNEMARA IRELAND*”. The EUIPO found that the trademark applied for was evocative of the PGI “*Irish Cream*”. Applicant claimed that the scope of products is different from the products covered by the PGI. The EUIPO used the argumentation of the CJEU that evocation also occurs when the product in concern incorporates only a part of the protected designation. Evocation is objective. It could result even if the owner of the mark did not intend to evoke the protected name.^{156, 157, 158} Thus, pursuant to Art. 7(1)(j), the trademark application was rejected.¹⁵⁹

The certification and collective marks are exceptions as analysed above in the Master’s Thesis. Therefore, Consorzio del Prosciutto di Parma was able to register the EU collective mark “*PROSCIUTTO DI PARMA*” under the Reg. No. 001116458¹⁶⁰, even though there is a registered PDO “*Prosciutto di Parma*”. The Consorzio is the owner of both, registered PDO and EU collective mark. The Consorzio was created

¹⁵⁵ EUTM file information. *TERRA TEQUILA*. Application number: 017010992. [online]. © EUIPO 1995-2018 [quoted on 22. 06. 2018]. Available at: <https://euipo.europa.eu/eSearch/#details/trademarks/017010992>

¹⁵⁶ The same argument was already elaborated in the subchapter 4.2.1 C-393/16 - Comité Interprofessionnel du Vin de Champagne.

¹⁵⁷ Para. 25. Judgment of the Court (Fifth Chamber) of 4 March 1999. *Consorzio per la tutela del formaggio Gorgonzola v Käserei Champignon Hofmeister GmbH & Co. KG and Eduard Bracharz GmbH*. C-87/97. Case-law of the Court of Justice [online]. Court of Justice of the European Union [quoted on 22. 06. 2018].

¹⁵⁸ Para. 44. Judgment of the Court (Grand Chamber) of 26 February 2008. *Commission of the European Communities v Federal Republic of Germany*. C-132/05. Case-law of the Court of Justice [online]. Court of Justice of the European Union [quoted on 22. 06. 2018].

¹⁵⁹ EUTM file information. *IRISH Country Cream THE BENEDICTINE NUNS KYLEMORE ABBEY CONNEMARA IRELAND*. Application number: 015424971. [online]. © EUIPO 1995-2018 [quoted on 22. 06. 2018]. Available at: <https://euipo.europa.eu/eSearch/#details/trademarks/015424971>

¹⁶⁰ EUTM file information. *PROSCIUTTO DI PARMA*. Application number: 001116458. [online]. © EUIPO 1995-2018 [quoted on 22. 06. 2018]. Available at: <https://euipo.europa.eu/eSearch/#details/trademarks/001116458>

in 1963 with the objectives of safeguarding the genuine product of Parma Ham, its tradition and the image. Interestingly, it is the official body in charge of safeguarding, protecting and promoting the PDO. Currently, it identifies 150 producers of Parma Ham.¹⁶¹

The fact of having registered trademark is very beneficial for example for the purpose of the UDRP process. Consorzio del Prosciutto di Parma owns the EU collective mark and therefore was able to reach the positive outcome of the UDRP process, the transfer of the domain name. Concretely, it was elaborated in the following cases: Case No. D2010-1561 which involved the domain names "*italyparma-ham.com*", "*parma-ham.biz*", "*parmahambuy.com*", "*parma-ham.info*", "*parmahamitaly.com*", "*parma-ham.net*", "*parma-ham.org*", "*prosciuttocrudodiparma.org*", "*prosciuttoparma.biz*", "*prosciuttoparma.info*"¹⁶² and Case No. D2010-0002 which concerned the following domain names "*lavorazioneprosciuttiparma.com*", "*prosciuttocrudoparma.com*", "*prosciuttodolceparma.com*", "*prosciuttoparma.net*", "*prosciuttoparma.org*", "*prosciuttoparmastagionato.com*", "*prosciuttoparmastagionatura.com*"¹⁶³. In the case of submission of registered PGO and no registered collective trademark, they would not be probably able to prove the acquired distinctiveness of the designation and individual trade source to protect. In this imaginary case, Consorzio would not fulfil the first obligatory element of the UDRP. Consequently, their complaints would be rejected.

¹⁶¹ CONSORTIUM. *The Consorzio del Prosciutto di Parma*. [online]. © 2018 C.C.I.A.A. DI PARMA NUM. ISCRIZ. REG. IMPRESE [quoted on 23. 06. 2018]. Available at: https://www.prosciuttodiparma.com/en_UK/consortium

¹⁶² Administrative Panel Decision of WIPO Arbitration and Mediation Center of 11 November 2010. *D2010-1561. Domain Name Disputes*. [online]. WIPO. [quoted on 23. 06. 2018]. Available at: <http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2010-1561>

¹⁶³ Administrative Panel Decision of WIPO Arbitration and Mediation Center of 22 February 2010. *D2010-0002. Domain Name Disputes*. [online]. WIPO. [quoted on 23. 06. 2018]. Available at: <http://www.wipo.int/amc/en/domains/decisions/text/2010/d2010-0002.html>

The chapter analysed the position of GIs in the UDRP. I observe, that the U.S. has a significantly beneficial position due to the trademark protection of GIs. According to the first element of the UDRP, trademarks and service marks could present standing for the UDRP case. GIs are not fully recognised as a standing for the UDRP, unless the acquired distinctiveness is proved.

Furthermore, the chapter examined the relation between GIs and ordinary trademarks in the EU. The trademark applications which feel the lack of distinctiveness, designate the quality or geographical origin are being refused by the EUIPO. Generally, registered GIs shall also be excluded from the ordinary word trademark registrations. Nevertheless, the concrete example of successful figurative trademark registration was mentioned. Additionally, practical examples of rejected trademark applications, which contained the registered GI or evoked the protected GI, were elaborated. Collective marks constitute an exception, which could be wisely used for double-layer protection (designation protected by GI and collective mark). I would personally recommend this double protection. Registered trademark could be useful for example for the purpose of the UDRP.

7 The Role of GIs in International Negotiations

This chapter aims to explain the particular role of geographical indications in the international trade negotiations between the European Union and the United States. Furthermore, the chapter discusses the importance of GIs as a minor category of intellectual property rights.

7.1 Transatlantic Trade and Investment Partnership

The Transatlantic Trade and Investment Partnership (hereinafter referred to as “TTIP”) is the official name for potentially the most significant bilateral trade agreement.

In July 2013, the European Union and the United States initiated debates on the topic of the TTIP, which aimed to liberalise mutual trade and investments. Further, it wants to increase the trade and increase the revenues. The European Commission obtained a mandate to negotiate in the name of the EU. It is claimed that import, export and investments could be easier and fairer. Markets of both parties should be more accessible in an easier way. The TTIP negotiations cover a monumental number of topics like customs duties, food safety, animal and plant health and regulations of particular industries as pharmaceuticals, pesticides, chemicals or information and communication technologies.^{164, 165}

The TTIP desires to create a comprehensive legal framework, which should be predictable and stable. The EU exported €3.3 billion worth of wine to the US and €5.3 billion in spirit drinks (including beer) in 2015. In relation to this important

¹⁶⁴ GRILLER, Stefan, OBWEXER, Walter, VRANES, Erich. *Mega-regional trade agreements: CETA, TTIP, and TiSA: new orientations for EU external economic relations*. Oxford: Oxford University Press, 2017. International economic law.

¹⁶⁵ European Commission. *The Transatlantic Trade and Investment Partnership (TTIP) Towards an EU-US trade deal*. 2015. [online] The Publications Office of the European Union [quoted on 20. 6. 2018]. Available at: <https://publications.europa.eu/s/hpSr>

category of the products, two bilateral agreements on wine and spirit drinks were created: (1) Agreement between the European Community and the United States of America on trade in wine of 8 March 2006; and (2) Agreement in the form of exchange of letters between the European Community and the United States on the mutual recognition of certain distilled spirits/spirit drinks of 25 March 1994.¹⁶⁶

GIs became an important and controversial issue of the negotiations across the Atlantic. In reality, GIs do not constitute only a complicated issue in the scope of intellectual property rights, as analysed above, but they also deal with political, cultural, socio-economic and environmental aspects.

The minimum level of international harmonisation of GIs produced significant conflicts between states regarding the legitimacy. As Sanders accurately noted, GIs are the only IP right, which always heated the international trade debates.¹⁶⁷

The dispute occurred already during the negotiations on international treaties covering the scope of GIs in the past. Consequently, the U.S., for example, did not endorse the Lisbon Agreement, which provides a high level of protection for internationally registered appellations of origin. Despite the growing economic value of GIs and many elaborated studies on the utility of GI products, the dispute over the different treatment of GIs could not be solved at the multilateral level. Thus, many states concluded bilateral trade agreements.¹⁶⁸

The different approach to the protection of GIs is being justified by the historical split between the “*Old World*” and “*New World*”. Generally, the typical division

¹⁶⁶ European Commission. *Agriculture and Geographical Indications (GIs) in TTIP: A guide to the EU's proposal*. [online]. European Commission. March 2016. [quoted on 25. 05. 2018]. Available at: http://trade.ec.europa.eu/doclib/docs/2016/march/tradoc_154372.pdf

¹⁶⁷ SANDERS, K. Anselm. *Geographical Indications of Origin: When GIs Become Commodities*, All Gloves Come off. 46 *International Review of Intellectual Property and Competition Law*. 2015. p. 755.

¹⁶⁸ MANCINI, C. Maria, ARFINI, Filippo, VENEZIANI, Mario, THÉVONOD-MOTTET, Erik. *Geographical Indications and Transatlantic Trade Negotiations: Different US and EU Perspectives*. [online]. *EuroChoices* 16(2). © 2016 Agricultural Economics Society and European Association of Agricultural Economists. [quoted on 23. 06. 2018]. Available at: <https://doi.org/10.1111/1746-692X.12131>, p. 35.

is usually made between the “*North World*” and “*South World*” for the purposes of various comparisons out of the scope of GIs. Hence, this split is extraordinary. The “*Old World*” represents the original place of many products with specific attributes and traditional manufacturing procedures. Nowadays, it is dominantly represented by the European Union, which obviously urges for strong protection of GIs. On the other side, there is the “*New World*” led by the United States, which effectively resists admitting the high-level protection of GIs mostly coming from the EU. As already stated above, the controversy is also connected to the past immigration. Europeans immigrated to the US, kept the traditional manufacturing procedures and continued performing it. Hence, they consider their production as the original. Nevertheless, the crucial link of the product and the original territory is missing.¹⁶⁹

It is important to delimit the legal framework of GIs in order to ensure fair behaviour in the market and especially not to mislead consumers. Some GIs protected in the EU are found as being generic names in the U.S. Under the political pressure from the EU, the U.S. is opposed to the possible revocation of that generic status. On the other hand, the EU requires the competent US authorities to act administratively against the misuse of GIs, as it is typical under the sui generis system. The EU asks for specific protection of selected food (the list could include GIs of both parties) directly through the agreement. In addition, the EU would appreciate ad hoc solutions for a limited number of cases (e.g. Fontina, Feta, Cheddar, Asiago). The US would prefer the EU to downgrade the level of GIs protection to similar prior trademark uses. In the case of accepting these terms, the worldwide recognition of EU GIs would be weakened.¹⁷⁰

¹⁶⁹ PAGER, Sean. “*I Get No Kick from [Sparkling Wine]” Do Copyists Have a Privilege to Make ‘Fair Use’ of ‘Semi-Generic’ Trademarks on Competing Goods?*.” [online]. Berkeley Law. 2006. [quoted on 23. 06. 2018]. Available at: <https://www.law.berkeley.edu/files/Pager.doc>

¹⁷⁰ MANCINI, C. Maria, ARFINI, Filippo, VENEZIANI, Mario, THÉVONOD-MOTTET, Erik. *Geographical Indications and Transatlantic Trade Negotiations: Different US and EU Perspectives*. [online]. EuroChoices 16(2). © 2016 Agricultural Economics Society and European Association of Agricultural Economists. [quoted on 23. 06. 2018]. Available at: <https://doi.org/10.1111/1746-692X.12131>, p. 35 – 36

The two-tier strategy was chosen in order to reach progress over the GIs negotiations. Firstly, the GIs should be perceived as IP rights rather than the agriculture policy tools. Secondly, recognition of coexistence between the two distinct forms of intellectual property and the coexistence of protected GI products and other non-protected names is the possible solution.¹⁷¹

The U.S.'s demand on private nature of GIs protection complicates the process of negotiations.

Even though GIs represent only one small part of the many TTIP chapter, it obtained worldwide attention due to the different legal frameworks and background contentions in the EU and U.S. Neither of the parties, of course, is inclined to change the already established practice. Therefore, GIs as a minor category of intellectual property rights managed to influence the international trade debates and negotiations.

Highly medialisised topic of the TTIP negotiations concerned cheese "*Feta*". It is registered PDO in the EU from October 2002. Greece requires it to be made from sheep's milk or from a mixture of sheep's and goat's milk. The U.S. claims that "*feta*" is a descriptive term. Hence, dairies make feta cheese from cow's milk in the U.S.^{172, 173}

¹⁷¹ O'CONNOR, Bernard. *The Legal Protection of GIs in TTIP: Is There an Alternative to the CETA Outcome?*. [online] European Association of Agricultural Economists. April 2015. [quoted on 24. 06. 2018]. Available online at: <http://purl.umn.edu/204144>

¹⁷² European Commission. *Denomination Information: Feta. EL/PDO/0017/0427* [online]. In: DOOR database. European Commission. [quoted on 27. 06. 2018]. Available at: <http://ec.europa.eu/agriculture/quality/door/registeredName.html?denominationId=876>

¹⁷³ AMADEO, Kimberly. *Transatlantic Trade and Investment Partnership (TTIP)*. [online]. ©The Balance. [quoted on 27. 06. 2018]. Available at: <https://www.thebalance.com/transatlantic-trade-and-investment-partnership-ttip-3305582>

In 2017, the President of the United States, Donald Trump, suspended TTIP negotiations. However, on 29 March 2018, the U.S. Department of Commerce Secretary Wilbur Ross said the administration would be willing to resume TTIP negotiations. Therefore, the future of the TTIP is uncertain.¹⁷⁴

The chapter, which covers the TTIP negotiations, well supports my persuasion of the importance of GIs. I consider it interesting, that a minor category of intellectual property and minor chapter of the TTIP heated the international negotiations up to such a level that it was also intensively discussed by the public. Positively, it increased the general awareness of the legal protection of GIs.

¹⁷⁴ *Ibid.*

Conclusion

The Master's Thesis compared two fundamentally different approaches on the protection of geographical indications as a peculiar category of intellectual property.

Initially, the Thesis enumerated the most important international treaties that assisted with the international scope of legal protection of geographical indications. It was found that the Paris Agreement firstly recognized indications of source and appellations of origin as a category of intellectual property. The Lisbon Agreement presents strong protection of appellations of origin, but it unfortunately did not engage an attention of high number of states (e.g. United States did not become a signatory). Thus, its global impact is not so significant. Nevertheless, it created the Lisbon Union system, which effectively facilitates the process of registration. TRIPS Agreement is the essential one on the protection of GIs. It firstly used the verbatim "*geographical indication*" in its provision. TRIPS had set the minimum standard of the protection of GIs. The Thesis ascertained that the EU and U.S. are in compliance with the minimum standard. As a matter of fact, they both provide higher level of protection than required by the TRIPS Agreement.

The Thesis discovered that the European Union protects geographical indications under the specific and sophisticated sui generis system, which is based on four most important regulations. On the other hand, the United States protects geographical indications as certification and collective marks, under the well-established and flexible trademark system; and as appellations of origin of wine.

According to the research, the Thesis can unconditionally argue, that the EU provides higher and detailed set protection to GIs than the U.S. The strength of the protection of GIs in the EU was proved by the elaborated case studies of the judgments of the Court of Justice of the European Union.

On the one side, it became clear that the U.S. considers the protection of the GIs in the EU as an unnecessary restriction of the market and limitation of liberal trade. Thus, the U.S. believes the sui generis system as unjustified result of strong

European protectionism. On the other side, the EU argues that GIs provide a strong added value to the products originating in the Member States. Therefore, the EU, as a representative of the “*Old World*”, where most of the GIs and traditional manufacturing procedures came from, claims that this high-level protection of GIs is necessary and well justified.

Further, the Thesis analysed the new institute of the EU certification mark which came into effect on 1 October 2017 under the recent EU trademark reform. Only six of the EU certification marks were successfully registered up-to-date. It is an interesting tool with a wide EU effect, which could attract new users.

The Thesis highlighted the importance of legal protection of GIs in general and mentioned the reasons for protection. Their economic value, according to the provided statistical data, is not negligible.

The relation between GIs and “*ordinary*” trademarks in the EU was clarified. The sui generis system should be protected. The Thesis presented couple of practical examples of the trademark applications which contained registered geographical indication or evoked registered geographical indication. All these trademark applications were rejected by the EUIPO.

I consider the chosen methods of work as sufficient. For the purpose of the comparison, the sui generis system in the EU and trademark system in the U.S. were analysed. The comparison itself has the following outcomes. The two systems could work together in the future. Nevertheless, the institutional differences cause some problems. The biggest issue is presented by the trademark genericide as described in the fifth chapter. As a result, the U.S. does not recognise some well-known European GIs (e.g. “*champagne*” or “*parmesan*”).

In addition, the protection of GIs under the trademark system is very beneficial for the UDRP, as the Thesis supported by the domain name disputes case law of the WIPO Arbitration and Mediation Centre. The currently set UDRP represents a significant advantage for the U.S. approach on the protection of GIs. The Thesis discussed and proposed changes to the current first element of the UDRP.

The Thesis explained the particular characteristics of collective marks in the EU. It developed the ideal scenario for right holders in the EU, which lies in the double-layer protection (by the geographical indication and collective mark).

Finally, the Thesis examined the role of GIs in the TTIP negotiations. It summarised the controversial aspects surrounding GIs and complexity of the issue. It elaborated an amicable solution for the negotiations over the GIs, even though the negotiations were suspended in 2017.

Personally, I would recommend creating a one global database of registered and recognised GIs. Taking into account all the aspects surrounding the GIs, it would be unimaginably complicated to reach this goal, and countries would have to make compromises during the negotiations of the conditions.

*“Champagne should be cold, dry and free.”*¹⁷⁵

“The question is: where shall it come from?”¹⁷⁶

¹⁷⁵ Quote traditionally ascribed Winston Churchill. In: FLODGREN. Johan. *Geographical Indications and Trademarks: Synergies and Conflicts in the International Market*. [online]. Organization for an International Geographical Indications Network (oriGIn). [quoted on 19. 06. 2018]. Available at: https://www.origin-gi.com/images/stories/PDFs/English/OriGIn_publications/News/johan_flodgren_essay.pdf

¹⁷⁶ Ibid.

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