

CARIFORUM Legal Framework for Geographical Indications & Trade Marks

“Trademarks and geographical indications: synergies, conflicts & case law analysis”

CARIFORUM Intellectual Property and Innovation (carIPI) & Caribbean Court of Justice (CCJ) Law Academy Webinar

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CARIFORUM Nations (i.e. Caribbean Forum of African, Caribbean & Pacific States)

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CARIFORUM-EU



Treaties in Common for All CARIFORUM States Covering Geographical Indications (GIs) & Trade Marks (TMs)

- EU-CARIFORUM Economic Partnership Agreement (“EPA”- EU)
 - See Articles 144 (TMs) & 145 (GIs)
- Agreement on Trade-related Aspects of Intellectual Property Rights (“TRIPS Agreement”- WTO)
 - See Part II Section 3 (GIs) &
- Paris Convention for the Protection of Industrial Property (“Paris Convention”- WIPO)

Trade Mark Definition



A sign capable of distinguishing the goods or services of one proprietor from those of other proprietors.



Collective Mark: A type of trade mark used, in commerce, by the members of a collective group or organization, including a mark which indicates membership in a union, an association, or other organization.



Certification Mark: A type of trade mark used to show consumers that particular goods and/or services bearing the mark, or their providers, have met certain standards.





Other Important Trade Mark Treaties (WIPO- administered)

Nice Agreement Concerning
the International
Classification of Goods and
Services for the Purposes of
the Registration of Marks
("Nice Agreement")

Madrid Agreement
Concerning the
International
Registration of Marks +
the Madrid Protocol
("Madrid Protocol")

Singapore Treaty on
the Law of Trade
Marks ("Singapore
Treaty")

Vienna Agreement
Establishing an
International Classification
of the Figurative Elements
of Marks ("Vienna
Agreement")

Nairobi Treaty on
the Protection of
the Olympic Symbol
("Nairobi Treaty")

Trademark Law
Treaty ("TLT")

Contracting CARIFORUM States to WIPO TM Treaties

Country	Nice Agreement	Madrid Protocol	Vienna Agreement	Singapore Treaty	TLT
Antigua & Barbuda	YES	YES	NO	NO	NO
Bahamas	NO	NO	NO	NO	NO
Barbados	YES	NO	NO	NO	NO
Belize	NO (A)	NO	NO	NO	NO
Dominica	YES	NO	NO	NO	NO
Dominican Republic	NO (A)	NO	NO	YES	YES
Grenada	NO (A)	NO	NO	NO	NO
Guyana	NO (PA)	NO	NO	NO	NO
Haiti	NO (A)	NO	NO	YES	NO
Jamaica	YES	NO	YES	NO	NO
St. Kitts & Nevis	YES	NO	NO	NO	NO
St. Lucia	YES	NO	YES	NO	NO
St. Vincent & the Grenadines	NO (A)	NO	NO	NO	NO
Suriname	YES	NO	NO	NO	NO
Trinidad & Tobago	YES	YES	YES	YES	YES

(A)= Aligned with Nice Classification; (PA)= Partially Aligned with Nice Classification

Geographical Indication Definition

A geographical indication (GI) is a sign used on products that have a specific geographical origin and possess qualities or a reputation that are due to that origin. In order to function as a GI, a sign must identify a product as originating in a given place.

A geographical indication implies the presence of a special quality, reputation, or characteristic of the product essentially attributable to its place of origin.



Other Important GI Treaties

Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (and the follow-up Geneva Act of 2015) (“Lisbon Agreement”)

Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods (“Madrid Agreement re False/Deceptive Indications”)

Paris Convention for the Protection of Industrial Property (already discussed)

Protocol to the Madrid Agreement Concerning the International Registration of Marks (already discussed)

Contracting CARIFORUM States to GI Treaties

Country	Madrid Agreement re False/Deceptive Indications	Lisbon (+ Geneva 2015)
Antigua & Barbuda	NO	NO
Bahamas	NO	NO
Barbados	NO	NO
Belize	NO	NO
Dominica	NO	NO
Dominican Republic	NO	NO
Grenada	NO	NO
Guyana	NO	NO
Haiti	NO	NO
Jamaica	NO	NO
St. Kitts & Nevis	NO	NO
St. Lucia	NO	NO
St. Vincent & the Grenadines	NO	NO
Suriname	NO	NO
Trinidad & Tobago	NO	NO

Countries with GI Legislation (i.e. Provisions specifically on Registration of GIs & Enforcement Options)

Country	Dedicated GI Legislation/Provisions In Force?
Antigua & Barbuda	YES
Bahamas	YES
Barbados	YES
Belize	NO
Dominica	YES
Dominican Republic	YES
Grenada	NO
Guyana	YES
Haiti	NO
Jamaica	YES
St. Kitts & Nevis	YES
St. Lucia	YES
St. Vincent & the Grenadines	YES
Suriname	NO
Trinidad & Tobago	YES



Aims of National GI Legislative Frameworks

- The general goals of national GI legislation in any CARIFORUM State is/will be to:
 - (1) provide a registration system for producers of goods to use a GI in relation to those goods; and
 - (2) allow for enforcement against unauthorized or deceptive use of a GI.
- In the case of GIs, a single criterion attributable to geographical origin is sufficient - whether it is a quality or other characteristic of the product - or even just its reputation.



Aims of National GI Legislative Frameworks (cont'd)

- Appellations of origin are a special kind of geographical indication (GI).
 - The link with the place of origin must be stronger than that accepted for a GI.
 - The quality or characteristics of a product protected as an appellation of origin must result exclusively or essentially from its geographical origin. (i.e. the raw materials should be sourced, and the processing of the product should be done, in the place of origin).

Regional Forerunners for GI Registrations



The Dominican Republic has registered several GIs including: “caca dominicano”, “Los Bejucos”, “Café de Valdesia” (2010)



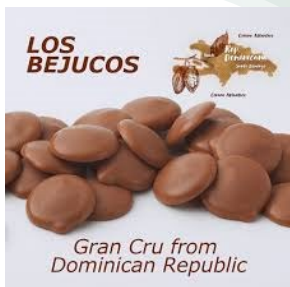
- Jamaica has registered “Jamaica Jerk” (September 30, 2015) , “Jamaica Rum” (December 1, 2016) {Jamaica Blue Mountain Coffee close to being or already registered}

- Cuba has registered the “Cuban Cigar”



- Trinidad & Tobago has registered “Trinidad Montserrat Hills Cocoa”

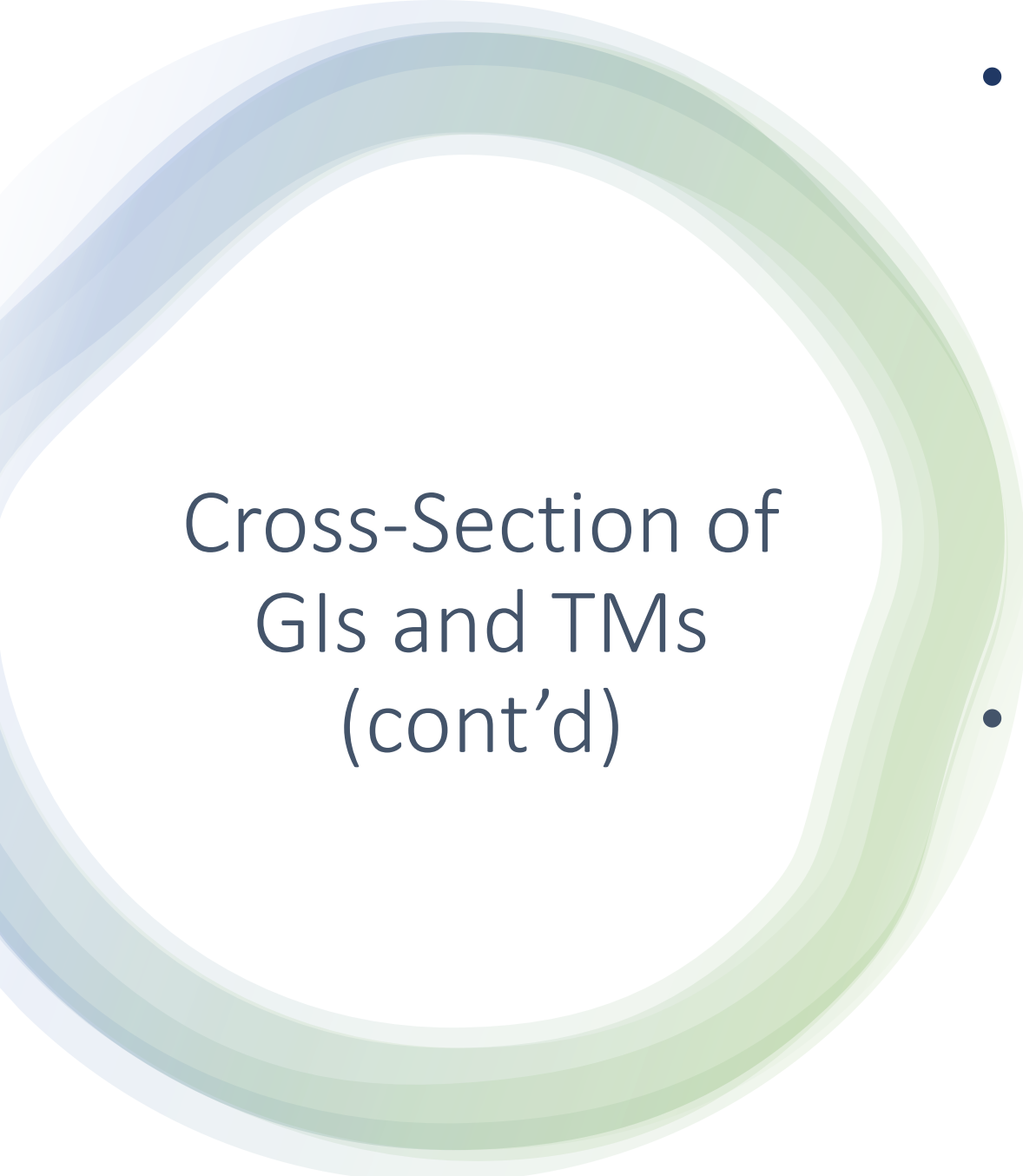
- Guyana – “Demerara Rum” also registered in the EU





Cross-Section of GIs and TMs

- Many trade mark legislations in the CARIFORUM states contain provisions which touch on the use of signs or words which indicate geographic origin of the goods/services being registered in association with a trade mark.
- Belize, for example, expressly prohibits registration of trade marks that exclusively consist of signs indicating (among other options) geographic origin.
 - This does not apply to collective marks and certification marks; however, the proprietor of these types of marks cannot prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).



Cross-Section of GIs and TMs (cont'd)

- CARICOM countries are obligated to strengthen regimes for the protection of intellectual property rights amongst other actions.
 - See Article 66- Revised Treaty of Chaguaramas Establishing CARICOM Inc. the CSME
 - See also Article 4.2(n) – Revised Treaty of Basseterre Establishing the OECS Economic Union
- Additionally, CARIFORUM & EU countries through the EPA are required to reject applications for trade marks, once that proposed trade mark includes characteristics identical with, similar to or containing a registered GI.
 - See Article 145 (D) of the EPA.



Distinctions between GIs and TMs That Influence All CARIFORUM States' Legal Frameworks

GIs	TMs
GIs identify a good as originating from a particular place.	A TM identifies a good or service as originating from a particular proprietor.
A GI may be used by any person in the area of origin, who produces the good according to specified standards.	Use of a TM is exclusive to its proprietor in the jurisdiction(s) of registration and may not be used by another without authorization.
Due to its intrinsic link with the place of origin, a GI cannot be assigned or licensed to someone outside of that place or not belonging to the group of authorized producers.	A trademark can be assigned or licensed to anyone, anywhere in the world, because it is obligated to be linked to a specific proprietor and not to a particular place.
The name used as a GI is usually predetermined by the name of the geographical area.	A trademark often consists of a fanciful or arbitrary sign (cannot be descriptive, generic etc).

THANK YOU FOR
YOUR ATTENTION!



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