




# **Geographical Indications and Trademarks: What the EPA and TRIPS Say**

**TRADEMARKS AND GEOGRAPHICAL INDICATIONS: SYNERGIES, CONFLICTS &  
CASE LAW ANALYSIS**

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**MS TIRA GREENE**

A bunch of ripe, yellow and red bananas is shown against a textured, light-colored background. The bananas are arranged in a cluster, with some showing signs of ripening and slight bruising. The overall image has a soft, slightly faded appearance, serving as a background for the text.

# CARIFORUM-EU Economic Partnership Agreement

❑ Trade Marks – Article 144

❑ Geographical Indications – Article 145

# The WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement)

- ❑ First multilateral agreement to treat IPRs as a global trade issue
- ❑ Trademarks – Section 2 (Articles 15-21)
- ❑ Geographical Indications – Section 3 (Articles 22- 24)

# TRIPS Agreement – Trademarks

Basic Rule established in Article 15 –

- ❑ Any sign, or any combination of signs, capable of distinguishing the goods and services of one undertaking from those of other undertakings, must be eligible for registration as a trademark, provided that it is visually perceptible.
- ❑ Such signs, (words, including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs) must be eligible for registration as trademarks.

# CARIFORUM-EU EPA

## Trademarks: Article 144

- A. Registration procedure
- B. Well-known trade marks
- C. Internet use
- D. Trade mark licenses
- E. International Agreements
- F. Exceptions to the rights conferred by a trade mark



# CARIFORUM-EU EPA

## Article 144 (C) – Internet Use

- ❑ Need for clear legal framework for trade mark owners desirous of using their trade marks on the Internet
- ❑ Participate in the development of electronic commerce

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## Article 144 (D) – Trademark licenses

- ❑ Pursues application of joint recommendations concerning trade mark licenses adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of WIPO at the Thirty-Fifth Series of Meetings of the Assemblies of the Member States of WIPO, 25 September to 3 October 2000.
- ❑ Simplification and harmonization

# CARIFORUM-EU EPA

## Article 145 (F) – Internet Use

- Acknowledgment and acceptance for the need for a clear legal framework for owners of GIs desirous of using their geographical indications on the Internet and to participate in the development of electronic commerce



# Internet Use: Ecommerce law

UNCITRAL Texts: Today implemented in all CARIFORUM countries except Guyana and Cuba via Electronic Transactions Acts

The ETAs are Omnibus laws

# Internet Use

The ETAs are Omnibus laws that allow for:

- Public Sector: Electronic Filings & Approvals
- Private sector: Certificates, Contracts, Corporate documents
- WIPO System for Intellectual Property
- Stock Exchange Online Trading
- Electronic Court
- Electronic Signatures & E-Payments

# Internet Use

## Hindrances to Ecommerce and Digital Government

Public Sector:

Still “part electronic part paper”

Many registries still not fully online

Electronic Signatures & E-Payments – are not accepted in many

E-Apostilles not in place

# Internet Use

## E-Apostilles:

With respect to e-apostilles, The Hague Conference on Private International Law confirmed that no specific legislation is required for Member Countries to implement the e-APP, other than the functional equivalence already contained in the ETA.

# Internet Use

## E-Apostilles :

The requirements are contained in the Background note on the e-APP. It was directed that paragraphs 8 and 13, summarise the two components of the e-APP. The provisions contained therein state:

*“ 8. An e-Apostille is an Article 3(1) Certificate issued in electronic form. It is signed by electronic signature with a digital certificate. e-Apostilles may be issued on electronic documents or on paper documents that have been scanned into electronic form...”*

*13. An e-Register is an Article 7(1) register maintained in a publicly accessible, electronic form. This allows any interested person to verify their Apostille online. While many Contracting Parties maintain an electronic register, the publicly accessible element is what determines its classification as an e-Register.”*

# Institutionalised Resistance

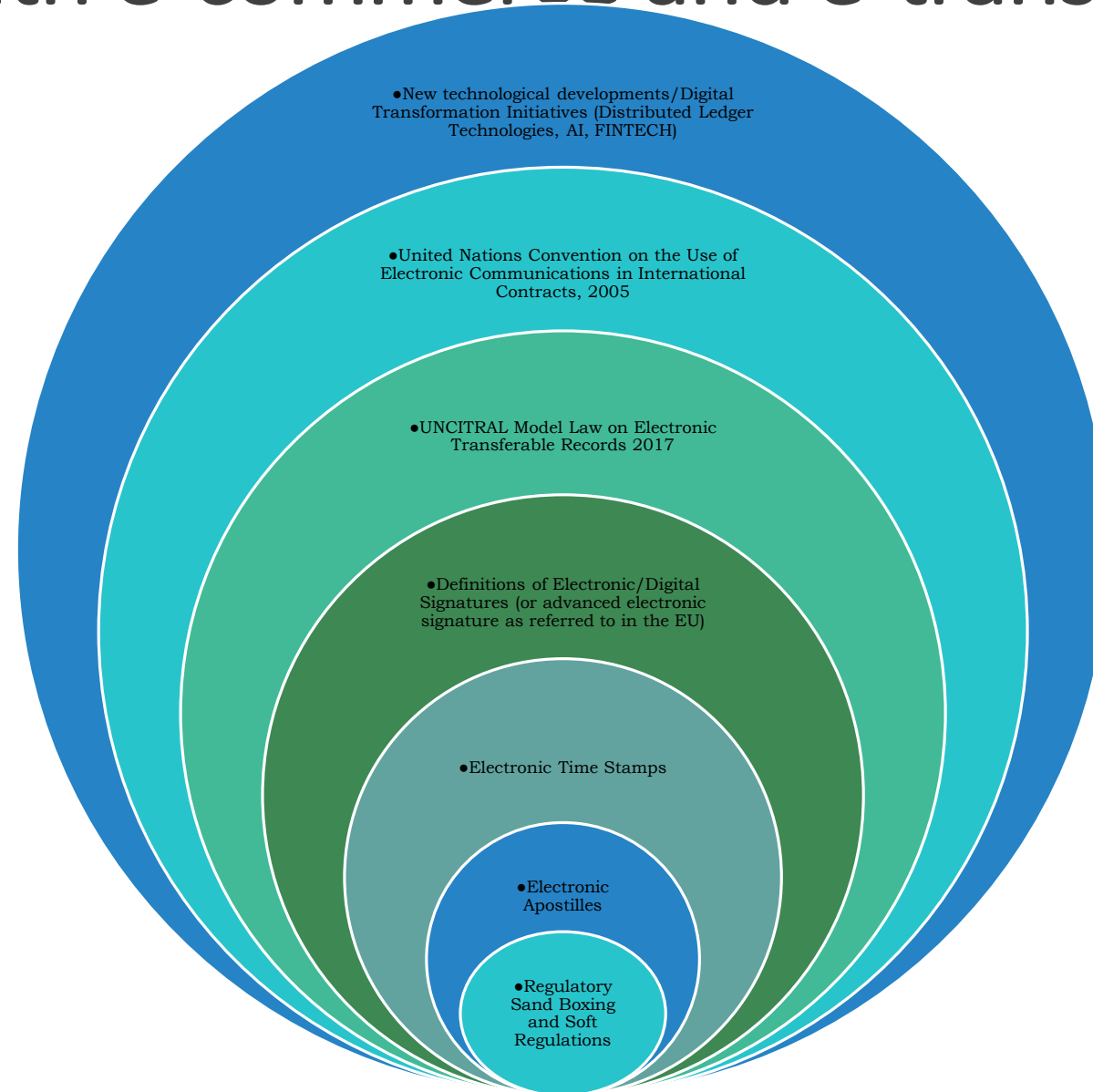
Infusing business processes with technology leads to a change in how people do things and what they do.

- Such changes in how business is conducted have met with considerable resistance or hesitation over the years from both senior officials and line officers.

Countries like Anguilla, Bermuda, BVI and the Cayman Islands have successfully implemented a number of digital government initiatives in a fairly smooth manner.

- These countries each have a small civil service with many young technocrats and officials and there is pressure to achieve more with less.
- The dependence on international business and investment means that the public and private sectors have had to adapt to the standards of the investors from developed countries.

# International Developments which impact and interplay with e-commerce and e-transactions



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## Article 144 (E) – International Agreements

- ❑ Pursues accession to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (1989) and the revised Trade mark Law Treaty (2006).



# CARIFORUM-EU EPA

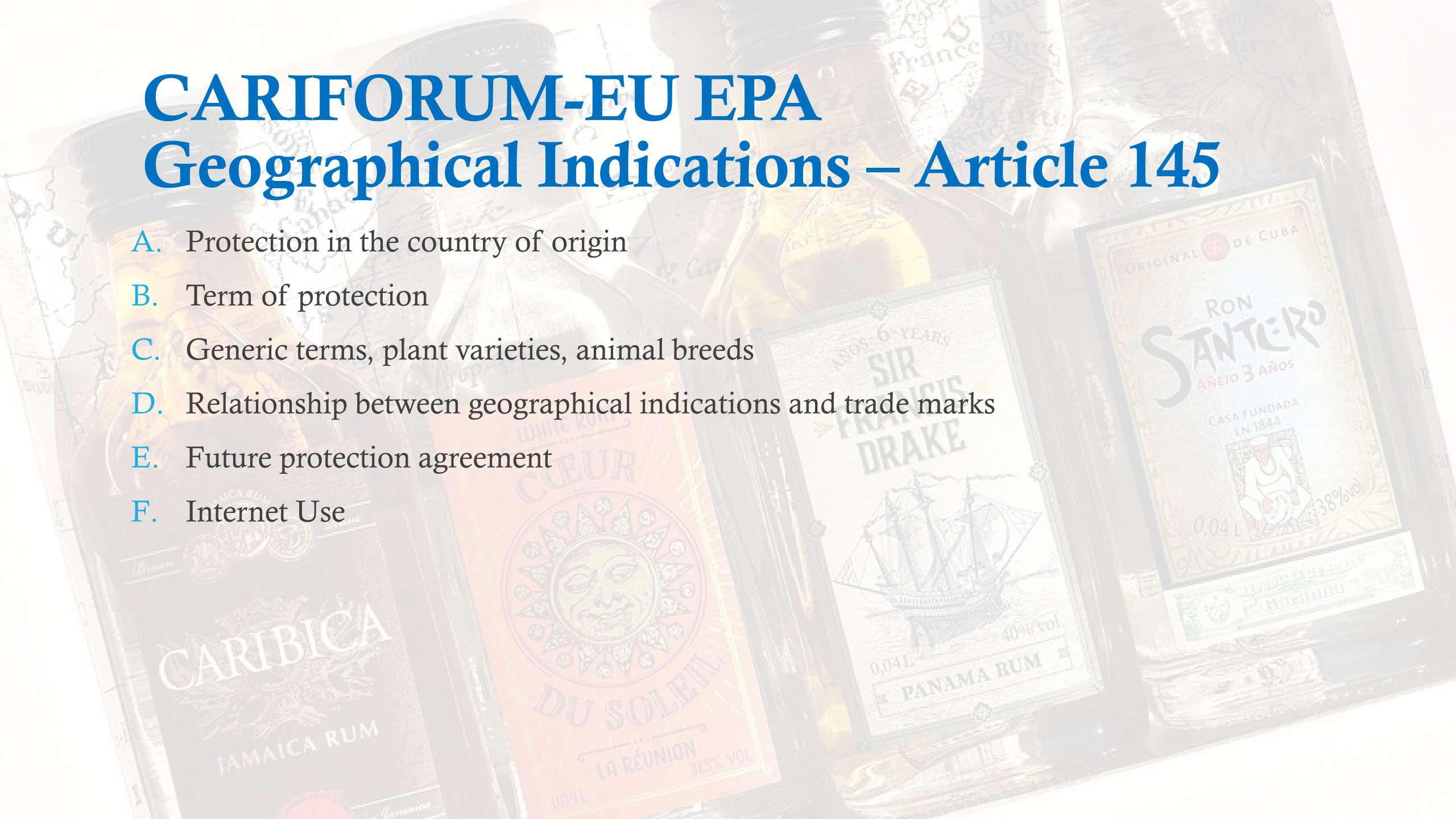
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## Article 144 (F) - Exceptions to the rights conferred by a trade mark

- ❑ Provide for the fair use of descriptive terms, including geographical indications, as a limited exception to the rights conferred by a trade mark
- ❑ Takes into account the legitimate interests of the owner of the trade mark and of third parties.

# CARIFORUM-EU EPA Geographical Indications – Article 145

- A. Protection in the country of origin
- B. Term of protection
- C. Generic terms, plant varieties, animal breeds
- D. Relationship between geographical indications and trade marks
- E. Future protection agreement
- F. Internet Use





## Article 145 (A) – Protection in the country of origin

- ❑ CARIFORUM and EU States have no requirement to protect in their territories GIs that are not protected in their country of origin.
- ❑ Establishment of a system of protection of GIs no later than 1 January 2014.
- ❑ Cooperation in respect of the development of GIs through the CARIFORUM-EC Trade and Development Committee

# CARIFORUM-EU EPA

## Article 145 (B) – Term of Protection

- ❑ Indefinite Protection granted in accordance with the legal system and practice of the EU Party or the relevant Signatory CARIFORUM State)
- ❑ Such protection shall ensure that the use of geographical indications of goods protected be exclusively reserved in the EC Party and the Signatory CARIFORUM States to goods originating in the geographical area concerned and that are produced in accordance with the relevant product specifications.

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Article 145 (C) – Generic terms, plant varieties, animal breeds

Article 145 (D) – Relationship between geographical indications and trade mark

Article 145 (E) – Future Protection Agreement