

Looking Beyond the Known Story: How the Prehistory of Protection of Geographical Indications in the Americas Provides an Alternate Approach

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1 INTRODUCTION

The current divide within the international community over the appropriate level of protection for geographical indications (GIs) is epitomized by the conflict between the European Union (EU) and the United States (US) in the context of the Transatlantic Trade and Investment Partnership Agreement (TTIP).¹ While GIs receive extensive protections that go beyond international treaty standards within the EU, the US (along with other “New World” countries) has repeatedly opposed strengthening the existing international GI protections.

The US’s resistance to strong protection of GIs has become a popularized account. The history of the US’s interest in GI protection, however, is more complex. Since 1929, the US has been bound by a little-known international convention that ensures strong protection of GIs: the General Inter-American Convention for Trade Mark and Commercial Protection (Inter-American Convention).² The Inter-American Convention is a regional agreement that was instituted by the US with several countries in the Americas. At the time in which the Convention went into force, the provisions on GIs in the Inter-American Convention were the most developed and strongest protections

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¹ Lina Montén, *Geographical Indications of Origin: Should They Be Protected and Why? An Analysis of the Issue from the U.S. and EU Perspectives*, 22 SANTA CLARA HIGH TECH. L.J. 315, 315 (2005) (noting how the members of the World Trade Organization who ultimately enact the laws proposed by the treaties are split between the EU and the “Old World” in favor of enhanced protection of GIs and the US and the “New World” in favor of limited protection, if any).

² General Inter-American Convention for Trade-mark and Commercial Protection, February 20, 1929, 46 Stat. 2907, 124 L.N.T.S. 357 (hereinafter Inter-American Convention) (being referred to as both the Inter-American Convention and the Pan American Convention).

available in any international agreement. And remarkably, these provisions were developed by the US.

This history of the protection of GIs in the US remains enigmatic. Few scholars and lawyers are aware of the Inter-American Convention, let alone its chapter on GI protection. Why was such a chapter included, and why were similar provisions not included in the 1946 Trademark Act or subsequent international agreements? The treatment of GIs both in this convention and in the US Trademark Act is largely the result of the work of Edward Rogers and Stephen Ladas, two of the leading practitioners of US trademark law in the twentieth century. These two men had as sophisticated an understanding of US common law and international obligations as anyone at that time. The resulting texts of the Inter-American Convention and the Trademark Act – both of which they were instrumental in drafting – were no accident.

As the Inter-American Convention is still in force, it indicates the minimum standards for the protection of GIs in the US, at least with respect to beneficiaries of the Convention. It is also arguably a self-executing treaty in the US. Understanding this agreement therefore offers more than historical insight; it may offer an alternate approach to the protection of GIs. The Inter-American Convention also offers lessons for developing GI protection standards in other regions, such as Asia. One reason for the Convention's inconspicuousness is that it was primarily intended to be used by US business in Latin America; it was not designed for the equal benefit of all member states. In addition, it was negotiated without the benefit of any experience protecting GIs on the part of the Latin American trading partners. Perhaps, it is not surprising then that the largely theoretical origins of the protections have resulted in the absence of a robust practice of applying them.

While the focus of this book is to consider GIs in Asia, this chapter will examine a particular historical moment in the legal protection of GIs that will expose a different view of the American approach to the protection of GIs. The reason to introduce this history is to offer policy makers in this region alternative approaches to GI protection beyond the current models advanced by the EU and the US. The short story is that the EU favors strengthening the current protections of GIs – it is said to be one of their greatest assets³ – while

³ Catherine Saez, *WIPO Design Treaty Fate Left to Assembly, Despite Shift on Technical Assistance*, INTELL. PROP. WATCH (March 21, 2013), www.ip-watch.org/2014/03/21/wipo-design-treaty-fate-left-to-assembly-despite-shift-on-technical-assistance/ (citing to a letter written by EU Parliament President Martin Schulz to members of the Internet Corporation for Assigned Names and Numbers (ICANN) expressing concern over the misuse of European GIs as domain names).

the US disfavors the development of additional protection for GIs beyond those offered by trademark law. The Inter-American Convention certainly complicates this story and provides a possible alternate approach.

2 THE 1929 GENERAL INTER-AMERICAN CONVENTION ON TRADE MARKS AND COMMERCIAL PROTECTION

The US experience with the international protection of GIs began with the 1929 Inter-American Convention on Trademarks and Unfair Competition. This relatively unknown Convention is still in force in all of the ten member states that were original parties to the Convention.⁴ The Convention came out of the Pan-American movement, in which the US asserted its dominance in the region over British and European rivals in the postcolonial era. The Convention was an instance of the US effort to replace militarism with institutionalism. The US recognized that Latin America had much to offer in terms of a supply of raw materials and a potential market for US finished products. As a result, there was then an ambitious effort to unite the Americas through innovations such as the creation of a railway system, a customs union, and a common currency.⁵ A harmonized intellectual

⁴ The 1929 Convention included nineteen signatory countries. STEPHEN P. LADAS, *THE INTERNATIONAL PROTECTION OF TRADE MARKS BY THE AMERICAN REPUBLICS* 11 (1929) (stating the signatories to the Convention were Bolivia, Brazil, Chile, Colombia, Costa Rica, Cuba, the Dominican Republic, Ecuador, Guatemala, Haiti, Honduras, Mexico, Nicaragua, Panama, Paraguay, Peru, the United States, Uruguay, and Venezuela). The Convention entered into force on April 2, 1930, and became effective in the United States, by Presidential proclamation, on February 27, 1931. Ten states ultimately ratified the Convention: Colombia, Cuba, Guatemala, Haiti, Honduras, Nicaragua, Panama, Paraguay, Peru, and the United States. The Convention remains in force today in every one of the original member states. See *Contracting Parties/Signatories: General Inter-American Convention for Trade-Mark and Commercial Protection*, WIPO www.wipo.int/wipolex/en/other_treaties/parties.jsp?treaty_id=353&group_id=21 (last visited April 10, 2015).

⁵ PAN AMERICAN UNION, *FIFTH INTERNATIONAL CONFERENCE OF AMERICAN STATES, SPECIAL HANDBOOK FOR THE USE OF THE DELEGATES* 6 (1922) ("The first International Conference was held at the city of Washington from October 2, 1889, to April 19, 1890. Invitation to this Conference was authorized by an act of the Congress of the United States, promulgated May 24, 1888, directing the President of the United States to invite the Republics of Mexico, Central and South America, Haiti, the Dominican Republic, and Empire of Brazil to meet in conference with United States. The same act sets forth the topics which the Conference was called upon to consider, which were as follows:

1. To preserve the peace and promote the prosperity of the American states.
2. Formation of an American customs union.
3. Establishment of regular and frequent communication between the American States.
4. Establishment of a uniform system of customs regulations.

property law was just one of the many attempts to create a regional market. The 1929 treaty was the last of six treaties concluded by the Pan-American Union that addressed trademarks.⁶

The text, which was evidently prepared by the US delegation,⁷ included, and still includes, some startlingly innovative provisions. Among these⁸ is an entire chapter, Chapter V, devoted to “the Repression of False Indications of Origin or Source.”⁹ The legal concept captured by the phrase “indications of origin or source” is not the equivalent of “geographical indication.” Although the concept is not defined in the Inter-American Convention, indications of source generally do not demand a link to the geographical area, nor do they demand a reputation of the area for the goods.¹⁰ Therefore, this chapter can be understood to address the use of geographic terms generally.¹¹ As a result, it actually offers protection to a broader category of geographical terms than the protection offered to GIs under the Agreement on Trade-Related Aspects to Intellectual Property Rights (TRIPS

5. Adoption of a uniform system of weights and measures, and laws to protect patents, copyrights, and trademarks.

6. Adoption of a common silver coin.

7. Agreement upon the recommendation for adoption to their Governments of a definite plan of arbitration.

8. Consideration of other matters relating to the welfare of the several countries, which may be presented at the Conference.”).

⁶ Six conventions were ratified between 1889 and 1929. All of these conventions are still in force, but more recent conventions supersede previous one for those parties who sign both. Since Brazil and the US both ratified the 1923 convention, but only the US ratified the 1929 Convention, the 1923 Convention remains in force as between the US and Brazil.

⁷ Just prior to the conference, Stephen Ladas published an influential book titled *The International Protection of Trade Marks by the American Republics* in an effort to “facilitate the work of the conference of trade mark experts and specialists of the American countries, meeting at Washington, February 11, 1929.” LADAS, *supra* note 4, at v. In this book, Ladas offered his own draft of the treaty. In a footnote in another book he published later, Ladas referred to “preparatory work” done by US trademark experts – including him – that seems to have been the basis of his draft text. STEPHEN P. LADAS, PATENTS, TRADEMARKS AND RELATED RIGHTS: NATIONAL AND INTERNATIONAL PROTECTION 1754 n.40 (1975) [hereinafter LADAS, PATENTS, TRADEMARKS AND RELATED RIGHTS].

⁸ See generally Christine Haight Farley, *The Pan-American Trademark Convention of 1929: A Bold Vision of Extraterritorial Meets Current Realities*, in TRADEMARK PROTECTION AND TERRITORIALITY: CHALLENGES IN THE GLOBAL ECONOMY (Irene Calboli & Edward Lee eds., 2014) (discussing novel priority provisions of the Convention).

⁹ Inter-American Convention, *supra* note 2, ch. V.

¹⁰ Paris Convention for the Protection of Industrial Property, March 20, 1883, as revised July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305 [hereinafter Paris Convention].

¹¹ *Id.*

Agreement).¹² Ultimately, the Inter-American Convention's protections are sweepingly broad.

For instance, Article 23 prohibits as "fraudulent and illegal" "any indication of geographical origin or source which does not actually correspond to the place in which the article, product or merchandise was fabricated, manufactured, produced or harvested."¹³ This language would seem to indicate that any false use of a geographical source is prohibited whether or not it is misleading.¹⁴ Thus, Article 23 of the Inter-American Convention mirrors the strict standard of Article 23 of the TRIPS Agreement, but, significantly, it is not limited to wines and spirits.¹⁵ In addition, the Inter-American Convention limits the use of generic terms.¹⁶ Article 27 indicates that the exception for generic terms does not include "regional indication of origins of industrial or agricultural products, the quality and reputation of which, to the consuming public, depends on the production of origin."¹⁷ This article also indicates that "industrial" products are protected along with "agricultural products."

Moreover, the chapter on geographical names in the Inter-American Convention not only prohibits the false use of geographical terms; it also limits the acquisition of trademark rights over geographical terms. Article 25 flatly states that "geographical names are not susceptible to individual appropriation."¹⁸ Depending on the interpretation given to "geographical names," this restriction may prohibit any geographical term from being protected as a trademark in any of the member states.

In addition to a chapter on geographical names, another chapter of the Inter-American Convention, Chapter IV, is devoted to unfair competition and, in turn, applies to unfair competition-related uses of geographical

¹² Agreement on Trade-Related Aspects of Intellectual Property Rights arts. 22–24, April 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299 [hereinafter TRIPS].

¹³ Inter-American Convention, *supra* note 2, art. 23.

¹⁴ See LADAS, PATENTS, TRADEMARKS AND RELATED RIGHTS, *supra* note 7, at 1581 (explaining that the only two requirements are that the term is understood as a geographic place and that the goods are not from that place); see also Amy P. Cotton, *123 Years at the Negotiating Table and Still No Dessert? The Case in Support of TRIPS Geographical Indication Protections*, 82 CHI.-KENT L. REV. 1295, 1300–01 (2007) (discussing the requirement of deception in GI protection under the Madrid and Lisbon Agreements).

¹⁵ Compare Inter-American Convention, *supra* note 2, art. 23, with TRIPS, *supra* note 12, art. 23.

¹⁶ Interestingly, the original draft had limitations on the use of generic terms within Article 23. Somewhere along the way the qualification was removed and now only appears in Article 27.

¹⁷ Inter-American Convention, *supra* note 2, art. 27. ¹⁸ *Id.* at art. 25.

names.¹⁹ In particular, two of the five acts of unfair competition delineated in this chapter explicitly address the use of geographical terms.²⁰ In notable contrast to the chapter on geographical terms, this chapter of the Inter-American Convention unmistakably addresses the *deceptive* use of geographical terms. Under this chapter, the use of a geographical term in a deceptive manner constitutes a prohibited act of unfair competition.²¹ The fact that this chapter requires deception suggests that unfair competition protection is different from the protections in the chapter on geographical terms. This is further reason not to read in an implied deception requirement in the chapter on geographical terms. To do so would mean that the provisions in the unfair competition chapter are duplicative.

¹⁹ See Inter-American Convention, *supra* note 2, ch. IV, which provides:

Article 20. Every act or deed contrary to commercial good faith or to the normal and honorable development of industrial or business activities shall be considered as unfair competition and, therefore, unjust and prohibited.

Article 21. The following are declared to be acts of unfair competition and unless otherwise effectively dealt with under the domestic laws of the Contracting States shall be repressed under the provisions of this Convention:

- (a) Acts calculated directly or indirectly to represent that the goods or business of a manufacturer, industrialist, merchant or agriculturist are the goods or business of another manufacturer, industrialist, merchant or agriculturist of any of the other Contracting States, whether such representation be made by the appropriation or simulation of trade marks, symbols, distinctive names, the imitation of labels, wrappers, containers, commercial names, or other means of identification;
- (b) The use of false descriptions of goods, by words, symbols or other means tending to deceive the public in the country where the acts occur, with respect to the nature, quality, or utility of the goods;
- (c) The use of false indications of geographical origin or source of goods, by words, symbols, or other means which tend in that respect to deceive the public in the country in which these acts occur;
- (d) To sell, or offer for sale to the public an article, product or merchandise of such form or appearance that even though it does not bear directly or indirectly an indication of origin or source, gives or produces, either by pictures, ornaments, or language employed in the text, the impression of being a product, article or commodity originating, manufactured or produced in one of the other Contracting States;
- (e) Any other act or deed contrary to good faith in industrial, commercial or agricultural matters which, because of its nature or purpose, may be considered analogous or similar to those above mentioned.

Article 22. The Contracting States which may not yet have enacted legislation repressing the acts of unfair competition mentioned in this chapter, shall apply to such acts the penalties contained in their legislation on trade marks or in any other statutes, and shall grant relief by way of injunction against the continuance of said acts at the request of any party injured; those causing such injury shall also be answerable in damages to the injured party.

²⁰ *Id.* ²¹ *Id.*

2.1 Creating New Standards

The above-mentioned provisions do not seem to reflect any then existing international legal standards to which the US was obligated.²² Moreover, there is no evidence that any Latin American states had corresponding protections at that time.²³ The GI protection standards in the Inter-American Convention also do not appear to reflect a contemporary understanding of then existing US statutory or common law.

Consider, for example, the case of “Tabasco.” Tabasco is a state in Mexico, where a particular chili pepper is grown and known as “Tabasco” pepper.²⁴ “TABASCO,” however, is also a trademark registered in the US since 1927 for a certain chili sauce.²⁵ “Tabasco” brand sauce is made from the type of pepper that is known as “Tabasco” pepper in Mexico, although not from peppers grown in Mexico. Interestingly, the TABASCO trademark was the object of several US federal court cases in the two decades preceding the ratification of the Inter-American Convention. In *Gaidry v. McIlhenny Co.*,²⁶ decided in 1918, the court recognized McIlhenny as the exclusive holder of the right to sell pepper sauce with the mark “Tabasco.” In particular, the court found that, despite the geographic descriptiveness of the word Tabasco, it had acquired a secondary meaning to the public as a source identifier for McIlhenny’s chili sauce. Likewise, in *McIlhenny Co. v. Ed. Bulliard*, decided in 1920, the Tabasco trademark was upheld as signifying the brand and not the place.²⁷ The court stated as fact that since 1868 McIlhenny had been making a sauce from peppers he grew from the seeds of peppers from the State of Tabasco, Mexico. The court stated that “McIlhenny gave his sauce the *distinctive* name ‘Tabasco Pepper Sauce.’”²⁸

It is intriguing then that the press release published by the US delegation announcing the US ratification of the Inter-American Convention stated

²² In 1929, the US was a party to the Paris Convention, which addressed both indications of source and unfair competition, but neither provision corresponded to the standards set out in the Inter-American Convention. See *supra* notes 10–21 and accompanying text.

²³ See *infra* notes 24–29 and accompanying text.

²⁴ *Tabasco*, ENCYCLOPÆDIA BRITANNICA, <https://global.britannica.com/place/Tabasco-state-Mexico> (last visited June 30, 2016).

²⁵ TABASCO, Registration No. 223310 (U.S.).

²⁶ *McIlhenny Co. v. Gaidry*, 253 F. 613 (5th Cir. 1918).

²⁷ *McIlhenny Co. v. Ed. Bulliard*, 10 TRADEMARK REP. 213, 215 (W.D. La. 1920) (“At this time these peppers were grown in the State of Tabasco, Mexico and elsewhere in Mexico, and were known as Mexican or Chili peppers – not as Tabasco peppers.”).

²⁸ *Id.* (emphasis added). Interestingly, the first brand name he used was “Petite Anse Sauce,” “Petite Anse” being the French name for the island on which he lived. Hence both names had a geographical significance, which was likely common for merchants at that time.

that Chapter V was derived from US principles. Notably, the document stated that

Chapter V extends through Latin American common law principles of honest trading which have been enforced in the United States for forty years under the elastic jurisdiction of our equity courts. It has always been the law in this country that the application of geographical terms to merchandise not originating in the geographical district indicated, is unfair and unlawful. This chapter extends that salutary doctrine throughout Latin America.²⁹

Whether the Inter-American Convention drafters truly understood themselves to be codifying existing principles or creating new legal standards probably will never be known.

The timing of the Inter-American Convention is noteworthy. Ratified in 1929, the Inter-American Convention was one of the earliest international conventions to address geographical terms along with the Paris Convention³⁰ and the Madrid Agreement.³¹ The Inter-American Convention also preceded the 1958 Lisbon Agreement by almost three decades, and it was adopted earlier than most of the domestic legislation that was enacted in the European countries.³² The Convention then was significant as a very early recognition of the protection of geographical terms in an international agreement.

²⁹ Press Release, U.S. Delegation to the Inter-American Convention, The Advantages Accruing to American Citizens from the General Convention for Trademark and Commercial Protection 2 (February 11, 1929).

³⁰ Paris Convention, *supra* note 10, as revised at The Hague, November 6, 1925, 47 Stat. 1789, T.S. No. 834.

³¹ According to the Madrid Agreement for the Repression of False and Deceptive Indications of Source on Goods, April 14, 1891, 828 U.N.T.S. 163 [hereinafter Madrid Agreement], all goods bearing a false or deceptive indication of source, by which one of the Contracting States, or a place situated therein, is directly or indirectly indicated as being the country or place of origin, must be seized on importation, or such importation must be prohibited, or other actions and sanctions must be applied in connection with such importation.

³² It was not until 1935 – six years after the Inter-American Convention – that the Institut National des Appellations d'Origine (INAO) was created, the same year that French law established a special category of AOC for wine and spirits. Champagne was not granted an AOC until the following year. Décret 47-1331 du 16 Juillet 1947 Fixant La Composition du Comité National des Appellations D'origine [Law 47-1331 of July 16, 1947, Determining the Composition of the National Committee of Origin], JOURNAL OFFICIEL DE LA RÉPUBLIQUE FRANÇAISE [J.O.] [OFFICIAL GAZETTE OF FRANCE], July 19, 1947, p. 6948. Judicial decisions produced uncertainty, so the French government created an official body to both establish and protect appellations of origin. This new regime recognized the importance of both origin *and* quality. DEV GANGJEE, RELOCATING THE LAW OF GEOGRAPHICAL INDICATIONS 109 (2012).

2.2 Understanding the Objective

Yet, what was the objective of including these provisions on the protection of geographical terms in the Inter-American Convention? Were the US drafters seeking to extend US legal principles across the Americas, or were they on a mission to create new rights?

As mentioned above, the individuals most responsible for the Convention's text were two of the most revered figures in US trademark law: Edward Rogers and Stephen Ladas. Perhaps, only the authors of trademark treatises had as sophisticated understanding of US trademark law as these practitioners. Rogers, who is best known as the drafter of the US Trademark Act,³³ litigated many of the Supreme Court and other trademark and unfair competition cases that the treatise authors studied.³⁴ Ladas, the named partner in Ladas & Parry LLP and the author of an important trademark treatise himself,³⁵ later represented the US at the 1958 revisions to the Paris Convention. As well as being fully informed of the existing state of US common law with regard to the protection of geographical terms, Rogers and Ladas were also well aware of international developments in trademark law.³⁶ Likewise, both experts had followed and written extensively on the delineation of specific acts of unfair competition in comparative jurisprudence during the first decades of the twentieth century.³⁷ The Inter-American Convention came along at an opportune time for these experts to articulate what they deduced was a developing set of principles, as well as to refine and further that agenda.

Still, as part of the history of the Inter-American Convention, there are hints that there was also a sense of developing conflict over protection standards for geographical terms. Later in his career, Ladas pointedly referred to the GI

³³ See Edward S. Rogers, *The Lanham Act and the Social Function of Trademarks*, 14 LAW & CONTEMP. PROBS. 173, 180 (1949) (recounting how he drafted what was introduced by Congressman Lanham in 1938 as the original bill based on ABA committee meetings).

³⁴ See generally Stephen P. Ladas, *Latin American Economic Integration and Industrial Property*, 62 TRADEMARK REP. 1 (1972).

³⁵ See LADAS, PATENTS, TRADEMARKS AND RELATED RIGHTS, *supra* note 7.

³⁶ Ladas reflected in 1930 that few countries regulated place names in their domestic legislation and that domestic and international standards were occurring simultaneously. STEPHEN LADAS, *THE INTERNATIONAL PROTECTION OF INDUSTRIAL PROPERTY* 658–59 (Cambridge Press 1930).

³⁷ Rogers, for instance, drafted a “Uniform Code dealing with Unfair Competition,” which was an effort not only to distil the rules from US common law, but also to incorporate international developments into enumerated acts of unfair competition. See Edward S. Rogers, *Business Good-Will and Trade-Marks Nationally and Internationally Considered*, 34 TRADEMARK REP. 281 (1939).

chapter in the Inter-American Convention as an “amelioration” of the Madrid Agreement,³⁸ which was revised in 1925, just four years prior to the Inter-American Convention. Perhaps, Ladas had in mind Article 4 of the Madrid Agreement, which prescribed protection for products of the vine according to the country of origin.³⁹ Yet the Inter-American Convention did not privilege wines and spirits, or even agricultural products.⁴⁰

3 LESSONS TO BE DRAWN FROM THE INTER-AMERICAN CONVENTION

Many lessons can be drawn from illuminating this little-known chapter on international GI protection in the Inter-American Convention. Many of these lessons are cautionary, but the primary lesson is that the US GI tradition is a bit more complicated than many have thought.

In particular, the Inter-American Convention represents an alternative approach, and one generated by the US. Moreover, the Inter-American Convention represented an early example of a regional approach to IP protection. Interestingly, this early twentieth-century attempt at regionalism in the Americas, much like recent regional agreements, was motivated in part by a strategy of forum shifting. More specifically, the Inter-American Convention was an attempt by the US to create a regional alternative to the Paris Convention, which at that time was dominated by European countries with few Latin American signatories.⁴¹

Also in common with more recent examples, we see in the Inter-American Convention one country imposing its interests on the other, weaker states and trading partners. In this respect, the Inter-American Convention appeared to be primarily intended to benefit US firms conducting business in Latin America. In contrast, almost nothing in the Convention would have benefited Latin American firms at the time. Ladas admitted as much when he noted that Latin American “countries rarely register any trademarks in US, and the problem of protection of their trademarks is hardly existing.”⁴² Thus, the objective of the Inter-American Convention was to protect US businesses; it was never even anticipated that it would be used by another signatory as

³⁸ LADAS, PATENTS, TRADEMARKS AND RELATED RIGHTS, *supra* note 7, at 1754.

³⁹ Madrid Agreement, *supra* note 31, art. 4.

⁴⁰ See *supra* notes 10–21 and accompanying text.

⁴¹ Ladas, *supra* note 4, at 11. In addition to addressing the meager participation of Latin American states in the Paris Union, it appears that the drafters of the Inter-American Convention were interested in dealing with the perceived issues in the region with greater focus.

⁴² Ladas, *supra* note 4, at 32.

a beneficiary of the provisions of the Convention in a US court. So not only was the Inter-American Convention an example of an imbalance of expertise in negotiating positions, but it was also problematic as a regional agreement where, other than desiring trade relations, the signatories did not have much else in common.

Ultimately, as a result of the dominant interests and negotiating position of the US, the Inter-American Convention was drafted without the benefit of any experience protecting GIs on the part of the Latin American signatories. In other words, rather than developing out of a tradition of protecting GIs steeped in practice, the Inter-American Convention's provisions had more of a theoretical origin. The lack of correspondence of the protections to a practice may in part explain why the Inter-American Convention fell into disuse in many of the member states and has been largely forgotten. Certain of the provisions, however, have continued to be used and taken advantage of by US trademark owners in Latin America.

Still, as obvious as it may sound, countries should endeavor not to forget a convention that obligates them. Moreover, just as efforts to engage in regional trade partnerships have continued since 1929, so too have developments in the international protection of GIs. In fact, the US has since signed six separate free trade agreements (FTAs) with countries that are members of the Inter-American Convention in the intervening years.⁴³ Perversely, the Inter-American Convention was not explicitly referred to in any of these agreements even as these FTAs incorporated by reference other international agreements.⁴⁴ In addition, the standards of protection for GIs in these more recent agreements are not consistent with the standards in the Inter-American Convention described above. These FTAs did not commence from the foundation set by the Inter-American Convention, but rather began from a blank slate as if there had been no agreement in place already. In this respect, it would have been useful to take account of the rights that have already been agreed to before moving forward with different standards.

⁴³ See United States-Colombia Trade Promotion Agreement, U.S.-Colom., November 22, 2006 (2012), <https://ustr.gov/trade-agreements/free-trade-agreements/colombia-fta/final-text>; United States-Panama Trade Promotion Agreement, U.S.-Pan., June 28, 2007, <https://ustr.gov/trade-agreements/free-trade-agreements/panama-tpa/final-text> (entered into force October 31, 2012); Central America Free Trade Agreement (2006) (Guatemala, Honduras, Nicaragua) Dominican Republic-Central America-United States Free Trade Agreement (CAFTA-DR), U.S.-Cent. Am.-Dom. Repub., May 28, 2004, 43 I.L.M. 514; Peru Trade Promotion Agreement, April 12, 2006, Temp. State Dep't No. 09-54, KAV 8674.

⁴⁴ See *supra* note 43.

In light of this, as I have suggested elsewhere, there is a real possibility that the Inter-American Convention is today a sleeping treaty.⁴⁵ Were private parties to take notice of the Convention and make greater use of it as a basis for bringing individual claims in US courts, the US may be compelled to consider its obligations under it.

Notably, not only do countries not have the option to forget their obligations under treaties, but in this case there is a strong basis for resurrecting it in a US court. In 1940, the US Supreme Court pronounced the Inter-American Convention a self-executing treaty, and as such, the law of the land without the need for implementing legislation.⁴⁶ In fact, the Inter-American Convention was drafted in such a manner as to anticipate its provisions being used directly as operable law. For instance, under Article 28, the final article in the chapter on GIs, parties are authorized to make a claim and seek a remedy under existing domestic trademark laws in the event that no local law exists implementing the Convention's protections.⁴⁷

Although there is some case law rejecting the assertion of rights under the Convention,⁴⁸ the Trademark Trial and Appeal Board (TTAB), a body within the United States Patent and Trademark Office (USPTO), has ruled in a few cases, beginning in the year 2000, that the Convention is a self-executing treaty. First in *British-American Tobacco v. Philip Morris*,⁴⁹ the TTAB concluded that the Inter-American Convention has the same force of law as the Trademark Act, is independent of the Trademark Act, and it grants the USPTO jurisdiction to cancel registrations when it is alleged that there is

⁴⁵ See Christine Haight Farley, *The Pan-American Trademark Convention of 1929: A Bold Vision of Extraterritorial Meets Current Realities*, in TRADEMARK PROTECTION AND TERRITORIALITY: CHALLENGES IN THE GLOBAL ECONOMY (Irene Calboli & Edward Lee eds., 2014); Christine Haight Farley, *The Protection of Geographical Indications in the Inter-American Convention on Trademarks*, 6 WIPO J. 68 (2014).

⁴⁶ *Bacardi v. Domenech*, 311 U.S. 150, 161 (1940).

⁴⁷ Inter-American Convention, *supra* note 2, art. 28 ("In the absence of any special remedies insuring the repression of false indications of geographical origin or source, remedies provided by the domestic sanitary laws, laws dealing with misbranding and the laws relating to trade marks or trade names, shall be applicable in the Contracting States.")

⁴⁸ In *Havana Club Holding v. Galleon*, the Second Circuit Court of Appeals wrestled with the question of the applicability of this treaty and held that it was not applicable because a party must assert rights under the Inter-American Convention "pursuant to § 44(b) of the Lanham Act." *Havana Club Holding v. Galleon*, 203 F.3d 116 (2d Cir. 2000). In other words, it must make a claim for relief under the Trademark Act. Thus, the Second Circuit did not consider it as providing an independent basis of jurisdiction. See also *Empresa Cubana Del Tabaco v. Culbro Corp.*, 399 F. 3d 462 (2d Cir. 2005).

⁴⁹ *British-American Tobacco Company Limited and Tabacalera Istmena, S.A. v. Philip Morris USA, Inc.*, 55 U.S.P.Q.2d 1585 (T.T.A.B. 2000).

a violation of the Convention.⁵⁰ Only one of these TTAB cases involved the false use of a geographical term, but this case happened to be brought under a different provision of the Convention.⁵¹ As a result, we do not have an application of the GI provisions of the Convention in a US tribunal.

As the international community moves forward with the development of GI protections, it may be that considering the strengths and weaknesses of the Inter-American Convention proves helpful. But at a minimum, the Convention certainly serves to complicate the story about the US's position on the protection of GIs, and demonstrates that the anti-GI narrative is of a more recent origin in the US.

4 UNITED STATES V. EUROPEAN UNION: TWO DIFFERENT VIEWS AND OBJECTIVES FOR THE PROTECTION OF GEOGRAPHICAL INDICATIONS

Despite the US's complex history regarding the protection of GIs,⁵² it appears that today's US approach on GIs is generally referred to as the anti-EU approach. As is well known, the US and the EU have very different views about how GIs should be protected and to what extent they should be protected, and are referred to as being on opposite sides of the debate.⁵³

The opposing views of the US and the EU on GIs were well documented in the negotiations leading to the adoption of the GI provisions in TRIPS, and later in the gridlock of the multilateral negotiations under the built-in TRIPS agenda and the Doha Development Agenda under the Doha Ministerial Declaration.⁵⁴ More recently, the US and the EU have been engaged in

⁵⁰ *Id.*

⁵¹ The case of *Cor Cimex S.A. v. DM Enterprises & Distributors*, No. 91178943, 2008 WL 5078739 (T.T.A.B. November 17, 2008), was simply brought as a trademark case in 2008. The Cuban brand was successful in preventing the registration of Cubita for this other party.

⁵² See Christine Haight Farley, *The Protection of Geographical Indications in the Inter-American Convention*, 6 W.I.P.O. J. 68, 69 (2014) (highlighting that the Inter-American Convention had some of the strongest GI protections in any international agreement even though the US has never been a strong supporter of GI protection).

⁵³ See Philippe Zylberg, *Geographical Indications v. Trademarks: The Lisbon Agreement: A Violation of Trips?*, 11 U. BALT. INTELL. PROP. L.J. 1, 1 (2003) (noting that the US and EU are the main contributors to the GI debate).

⁵⁴ World Trade Organization, Ministerial Declaration of November 14, 2001, WTO Doc. WT/MIN(01)/DEC/1, ¶ 18, 41 ILM 746 (2002) [hereinafter Doha Declaration]. For a detailed analysis of the Doha Declaration, see *TRIPS: Issues, Geographical Indications*, WORLD TRADE ORG., http://wto.org/english/tratop_e/trips_e/gi_e.htm (last visited November 20, 2015).

a contest to see whose vision of GI protection will prevail as part of the negotiations for bilateral and plurilateral FTAs with third countries, including with countries in Asia.⁵⁵ As several experts have noted, the two positions – from the US's and the EU's points of view – seem to be incompatible and thus a contest (and a race to lock in trading partners with the preferred view) has expectedly ensued.⁵⁶ At present, Asia is certainly a main battleground, especially in light of the recently concluded Trans-Pacific Partnership Agreement (TPP), and the many bilateral agreements that the US and EU have respectively concluded or are negotiating in Asia.⁵⁷ An example of this battle is Korea, who recently signed FTAs with both the US and EU and thus agreeing to incompatible protections for GIs.⁵⁸

In particular, the EU supports a strong protection of GIs to safeguard its economic interest in goods such as wine and cheese, which strategically rely on GIs to distinguish themselves from nonlocal competitors.⁵⁹ In the EU, GI protection is efficiently handled administratively by the EU Commission based on several EU Regulations.⁶⁰ As part of the registration process,

⁵⁵ For a detailed review of these agreements, see Susy Frankel, *Geographical Indications and Mega-Regional Trade Agreements and Negotiations*, and Anselm Kamperman Sanders, *Geographical Indications as Property: European Union Association Agreements and Investor-State Provisions*, in this Volume.

⁵⁶ See Bernard O'Connor, *The European Union & the United States: Conflicting Agendas on Geographical Indications – What's Happening in Asia?*, 9 GLOBAL TRADE & CUSTOMS J. 66, 66 (2014).

⁵⁷ See, e.g., Trans-Pacific Partnership, ch. 18, Intellectual Property, October 5, 2015, <https://ustr.gov/sites/default/files/TPP-Final-Text-Intellectual-Property.pdf> [hereinafter TPP, Intellectual Property Chapter]; United States-South Korea Free Trade Agreement, U.S.-S. Kor., June 30, 2007, <https://ustr.gov/trade-agreements/free-trade-agreements/korus-fta>; United States-Singapore Free Trade Agreement, U.S.-Sing., May 6, 2003, Temp. State Dep't No. 04-36, KAV 6376; United States-Oman Free Trade Agreement, U.S.-Oman, January 19, 2006, Temp. State Dep't No. 09-53, KAV 8673; EU-Vietnam Free Trade Agreement, EU-Viet., August 5, 2015, http://trade.ec.europa.eu/doclib/docs/2015/august/tradoc_153674.pdf; EU-Singapore Free Trade Agreement, EU-Sing., September 20, 2013, <http://ec.europa.eu/trade/policy/countries-and-regions/countries/singapore/>; EU-South Korea Free Trade Agreement, EU-S. Kor., September 16, 2010, 54 O.J. (L 127) 1, 46-47, <http://eur-lex.europa.eu/legal-content/en/ALL/?uri=OJ:L:2011:127:TOC>.

⁵⁸ See *supra* note 57.

⁵⁹ Zylberg, *supra* note 53 (noting that the US and EU are the main contributors to the GI debate).

⁶⁰ See Regulation 1151/2012, of the European Parliament and of the Council of November 21, 2012, on Quality Schemes for Agricultural Products and Foodstuff, 2012 O.J. (L 343) 1 [hereinafter EU Agricultural Products and Foodstuff Regulation]; Council Regulation 479/2008 of April 29, 2008 on the Common Organization of the Market in Wine, Amending Regulations 1493/1999, 1782/2003, 1290/2005, 3/2008 and Repealing Regulations (EEC) 2392/86 and 1493/1999, 2008 O.J. (L 148) 1 [hereinafter EU Wine Regulation]; Regulation 110/2008,

applicants need to identify both the internal and the external entities that will enforce quality control for the GI products.

A crucial component of the EU GI protection is that GIs are categorically protected from becoming generic terms (even in the case that consumers may refer to the product generically in practice),⁶¹ which means that GIs cannot fall into the public domain and be used as generic terms.⁶² In this way, EU law aims at preserving the advantages that historic regional industries have against competitors who may claim (as they do in the US) that a term has become generic. For instance, if Tabasco were a GI in the EU, the protection received under EU law would ensure that the name continued to signify a place and not a type of product. I refer to this objective of EU law as a type of protection against the dilution of registered GIs because it seeks to maintain the significance and reputation of GIs in the same way that trademark dilution protection seeks to maintain the significance and reputation of a famous mark against free riders who attempt to take advantage by creating an association with the mark.

These strong protections are partially balanced in EU law by restricting GI protection to a circumscribed subject area. Under current EU law at least, GI protection only applies to foodstuffs, wines, and spirits.⁶³ Thus, manufactured products and services are excluded from protection, even though the EU is currently considering extending GI protection to nonagricultural products.⁶⁴

The more recent position of the US with respect to GI protection is seemingly incompatible with the EU approach. In principle, the US appears to be against the enhancement of GI protection. Like the EU, the US position

of the European Parliament and of the Council of January 15, 2008, on the Definition, Description, Presentation, Labeling and the Protection of Geographical Indications of Spirits Drinks and Repealing Council Regulation (EEC) 1576/89, 2008 O.J. (L 39) 16 [hereinafter EU Spirits Regulation].

⁶¹ In Italy, for example, many consumers use the word “parmigiano” to refer to the grated cheese used on their pastas, yet only the producers associated with the Consorzio del Parmigiano Reggiano can use the term “Parmigiano” on their products. Case C-132/05, *Comm’n v. Federal Republic of Germany (Parmesan)*, 2008 E.C.R. I-957.

⁶² Zylberg, *supra* note 53, at 3 (2003) (noting that the US and EU are the main contributors to the GI debate).

⁶³ See *supra* note 62.

⁶⁴ On September 22, 2015, the European Parliament also considered the issue in a plenary session following the opinions of several of its committees, and called “on the Commission to propose without delay a legislative proposal with the aim of establishing a single European system of protection of geographical indications for non-agricultural products.” Comm. on Legal Affairs, Report on the Possible Extension of Geographical Indication Protection of the European Union to Non-Agricultural Products, EUR. PARL. DOC. A8-0259, at 6/26 ¶ 3 (2015).

corresponds to economic realities, namely its interest in protecting its large food producers, who frequently use European names based on the claim that these names are generic terms.⁶⁵

The fundamental difference, however, can be reduced to the legal approach taken by both the EU and the US. Notably, while the EU favors a *sui generis* approach based on the administrative requirement of GI registration, the US strenuously advocates addressing GI protection through trademark law exclusively.⁶⁶ As a result, the source of GI protection in the US is not a registration system per se (even though GIs are protected primarily as registered trademarks), but a market understanding.⁶⁷ Moreover, in order for US trademark law to protect a geographical name/GI as an ordinary trademark, the name must have acquired secondary meaning.⁶⁸ Like other trademarks, a distinctive sign can also lose its source-identifying significance over time through generic use. Furthermore, US trademark law does not protect geographical terms against dilution; instead, it is incumbent on the producers from that region to maintain the meaning.⁶⁹ Still, it should be noted that many GIs are protected in the US as certification and collective marks,⁷⁰ and that the conditions to be satisfied in order to obtain this protection – which is granted to a collectivity of producers and not to individual undertakings – resemble, to a considerable extent, the process to be followed in order to obtain a GI registration under a *sui generis* system.

Relatedly, US trademark law leaves enforcement to interested parties. For example, although the term “ROQUEFORT” is registered with the USPTO as a certification mark for cheese produced in the Roquefort region in France,⁷¹ if a producer of cheese not from that region were to use this designation on its products in the US market, it would be incumbent on the

⁶⁵ U.S. Dairy Industry Drives Home Concerns on Geographical Indications and Common Food Name Issues During TTIP Stakeholders Forum, CONSORTIUM FOR COMMON FOOD NAMES (February 4, 2015), www.commonfoodnames.com/u-s-dairy-industry-drives-home-concerns-on-geographical-indications-and-common-food-name-issues-during-ttip-stakeholders-forum/ (last visited July 12, 2016) (relating the dairy industry opposition to EU pressure for protection of geographical indications).

⁶⁶ See, e.g., United States-Australia Free Trade Agreement, U.S.-Austl., art. 17.2.1, May 18, 2004, Temp. State Dep’t No. 05–074, KAV 7141 (“Each Party shall provide that marks shall include marks in respect of goods and services, collective marks, and certification marks. Each Party shall also provide that geographical indications are eligible for protection as marks.”).

⁶⁷ Zylberg, *supra* note 53, at 6, 15. ⁶⁸ *Id.* at 15.

⁶⁹ See generally Trademark Dilution Revision Act of 2006, Pub. L. No. 109–312, § 2, 120 Stat. 1730 (to be codified at 15 U.S.C. § 1125(c)(2)(A)).

⁷⁰ See, e.g., GROWN IN IDAHO, Registration No. 2,914,307 (U.S.).

⁷¹ See ROQUEFORT, Registration No. 571,798 (U.S.).

registrant to bring a private lawsuit in a federal court.⁷² Finally, as US trademark law loosely follows consumer understanding of signs, it is possible for geographical terms to be protected for any type of product whether agricultural or manufactured. In addition, it is possible to achieve protection in the US based on use without first obtaining a registration. For instance, common-law certification marks such as “COGNAC” have been recognized by US courts.⁷³

In sum, the EU and the US advocate for considerably diverging approaches to GI protection with the key features of these systems corresponding to different objectives. The EU system seeks to achieve a form of dilution protection through an administrative system. In contrast, the US system seeks to achieve a form of unfair competition protection limited by the contours of trademark law.⁷⁴

5 AN ALTERNATE APPROACH

Presented with these two diverging approaches, Asian countries, such as Korea, find themselves in the unenviable position of navigating between the EU and the US in deciding their national systems of GI protection. In this respect, the model embodied in the Inter-American Convention, with its provisions on GIs and unfair competition principles described above, could represent a distinct alternate approach.

First, the Inter-American Convention offers an alternative to the strict public law–private law divide between the EU and the US as member states can meet their obligations to protect GIs through either method so long as they agree to the broadly stated standards.⁷⁵

⁷² UNITED STATES PATENT AND TRADEMARK OFFICE, GEOGRAPHICAL INDICATION PROTECTION IN THE UNITED STATES 4 (2016), www.uspto.gov/sites/default/files/web/offices/dcom/olia/globalip/pdf/gi_system.pdf (explaining that “with respect to protection of geographical indication certification marks, affected parties can oppose registration or seek to cancel registrations, all within the existing trademark regime in the United States”).

⁷³ *Institut National Des Appellations D’Origine v. Brown-Forman Corp.*, 47 U.S.P.Q.2d 1875 (T.T.A.B. 1998) (holding “COGNAC” to be a geographical indication for brandy from France).

⁷⁴ *But see* Irene Calboli, *Time to Say Local Cheese and Smile at Geographical Indications of Origin? International Trade and Local Development in the United States*, 53 Hous. L. Rev. 373 (2015) (pointing out that the US protects appellations for wines with a *sui generis* system, and that the controversy between the US in the EU is primarily driven by diverging business interests; thus, consensus can be found when these interests overlaps, such as in the case of wines).

⁷⁵ *See generally* Inter-American Convention, *supra* note 2.

Second, both the EU and US approaches seem to work best at the national level (the regional level in the EU, in which GI protection is based on EU law). The Inter-American Convention approach, however, works best at a regional level (not strongly integrated as in the EU). As noted above, the Inter-American Convention was precisely an attempt to extend developing norms of unfair competition protection at the regional level among countries in the Americas. At the time when the Inter-American Convention was negotiated, the protection of GIs under US trademark law was not so well developed (and the current trademark act had not yet been adopted), and, thus, the convention aimed at (also) filling this gap.

Third, a model based on the Inter-American Convention may be better suited to address the conflicts that could possibly arise with respect to generic terms within a region. In particular, the generic exception – that is, the right to use foreign GIs on the basis that they are generic in the jurisdictions in question – is limited in the Inter-American Convention. As countries within a specific region – in Asia as much as in the Americas – may be more likely to share generic language and have awareness of the geographical meaning and reputations of GI regions and GI products from neighboring countries, the Inter-American Convention could represent a viable model for Asian countries to adopt a system of GI protection, which would take into account GIs registered in other countries in the same region.⁷⁶ In other words, a dilution-like GI protection such as that is applied in the EU could be achieved in Asia by adopting a system similar to the Inter-American Convention.

Another possible and positive consequence of adopting a model of GI protection having its source in unfair competition law, as in the Inter-American Convention, is the breadth of subject matter that can be protected under this model. In particular, because unfair competition law seeks to protect the reputation of a good, this type of GI protection can be used to protect agricultural products as much as nonagricultural products. This is explicitly the case in the Inter-American Convention text. Such possibility is of particular relevance in Asian countries, as many of these countries are rich in

⁷⁶ In this respect it could be mentioned that the revised text of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration that was adopted following a Diplomatic Conference was convened in Geneva, Switzerland, in May 2015 includes the possibility to register the same GI in two different countries through an application for a “trans-border area.” See *Diplomatic Conference for the Adoption of a New Act of the Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration*, WORLD INTEL. PROP. ORG., www.wipo.int/meetings/en/details.jsp?meeting_id=35202 [hereinafter Geneva Act] (last visited July 28, 2016)

traditional handicrafts and several of them already provide for GI protection for nonagricultural products.⁷⁷

6 PROTECTION FOR GEOGRAPHICAL INDICATIONS IN ASIA

Considering GI protection in the Asian region allows us to open the discussion beyond GI protection from the perspective of the EU or the US. This discussion is important because the objectives in protecting GIs in other regions may not exactly mirror those of the EU and the US, as several of the chapters in this volume also demonstrate. In particular, the inflexibility of the models presented by the EU and US regimes limits regional experimentalism, and the Inter-American Convention may present a suitable alternative.

To date, several Asian countries have implemented or are considering primarily national systems of *sui generis* protection modeled after the EU regime. In addition, several countries in the region have negotiated or are negotiating FTAs with the EU or ad hoc agreements for GI protection. For instance, the EU and China have reached certain agreements where they reciprocate recognition of certain GIs (so far ten from China and ten from the EU) in the model of EU law. From the EU side, this includes “Grana Padano” cheese, “Prosciutto di Parma” ham, and “Stilton” blue-veined cheese – all these products are protected as *sui generis* GIs in China today.⁷⁸ In reciprocation, the EU has agreed to recognize GIs for Chinese products such as “Pinggu da Tau” peaches and “Dongshan Bai Lu Sun” asparagus. It is debatable whether this reciprocal agreement is of equal benefit for both parties. Christopher Heath’s chapter in this volume indicates, for example, that seventeen Asian GIs are registered in the EU, yet none of which will likely be familiar to Europeans (at least to date).⁷⁹

Of course, many Asian GIs are well known to consumers outside of Asia. For instance, “Basmati” rice and “Darjeeling” tea are two Indian GIs that are

⁷⁷ See various examples in this respect in Part III of this volume.

⁷⁸ *EU-China Geographical Indications – “10 plus 10” Project Is Now Completed*, EUR. COMM’N (November 30, 2012), http://europa.eu/rapid/press-release_IP-12-1297_en.htm (discussing the pilot program between the EU and China and listing the ten GIs to which both sides committed to register and protect); *Geographical Indications, E.U.-CHINA TRADE PROJECT (II)*, www.euctp.org/index.php/en/agriculture-food-safety/geographical-indications-gi.html (last visited November 20, 2015) (supporting GI registration in the EU and China).

⁷⁹ See Christopher Heath, *How Would Geographical Indications from Asia Fare in Europe?*, in this volume.

recognized around the world for agricultural products from India.⁸⁰ Yet, the recognition and the rights to be recognized to each of these GIs have been legally tested under the EU and US GI regimes with mixed results for the GIs. In short, these GIs have not fared as well as desired by their owners, showing the still existing problems for the protection of foreign GIs under the US and EU systems.

The legal saga of “Basmati” in the US is well known to GI experts. “Basmati” is an Indian GI for aromatic, long-grain rice that grows in the Punjab region in northern India and across the Pakistani border.⁸¹ India has repeatedly claimed that the distinctive characteristics of basmati rice are a byproduct of the Indian soil that is irrigated by the Himalayan Rivers.⁸² India is the largest exporter of basmati rice in the world. The word “basmati,” however, has been used generically in the US for decades referring to aromatic long grain rice without regard to where the rice is grown. This US generic use predated any legal protection for “Basmati” in India. In the late 1990s, a US company provoked the ire of the Indian government by not only using brand names such as “American Basmati” and registering the trademark “Texmati,”⁸³ but also attempting to patent its production of this rice.⁸⁴ Moreover, in the US, the term “Basmati” is also used in connection with goods other than rice. Several “Basmati” marks have been registered, such as “Basmati Bus,” which is a registered service mark for food truck services.⁸⁵ These registrations are generally not related to goods or services originating from India.

Furthermore, while the Indian government succeeded in invalidating the patents covering basmati rice, it could not prevent the US company from using the trademark “Texmati.” This episode angered the Indian public who believed that the use of the word “basmati” was pirating their indigenous product.⁸⁶ Indian nongovernmental organizations have insisted that the

⁸⁰ *But see* Michelle Agdomar, *Removing the Greek from Feta and Adding Korbel to Champagne: The Paradox of Geographical Indications in International Law*, 18 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 541, 582–84 (2008) (explaining the legal battle over the “Basmati” GI in the US).

⁸¹ Saritha Rai, *India-U.S. Fight on Basmati Rice is Mostly Settled*, N.Y. TIMES (August 25, 2001), www.nytimes.com/2001/08/25/business/india-us-fight-on-basmati-rice-is-mostly-settled.html.

⁸² *Id.*

⁸³ *See* TEXMATI, Registration No. 1,859,875 (U.S.); Utsav Mukherjee, A STUDY OF THE BASMATI CASE (INDIA-US BASMATI RICE DISPUTE): GEOGRAPHICAL INDICATION PERSPECTIVE (National Law University Jodhpur, 2008) http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1143209.

⁸⁴ U.S. Patent No. 5,663,484 (filed August 7, 1994); *see also* Rai, *supra* note 81.

⁸⁵ *See* U.S. Trademark Application Serial No. 8657496 (filed March 9, 2015).

⁸⁶ Rai, *supra* note 81.

US change its rice standards so that only rice grown in India and Pakistan can be branded with the word “basmati.”⁸⁷ This dispute may have prompted the Indian government to protect basmati rice as a GI for the regions where it is being grown in India. However, this attempt was met with spirited opposition both from a state within India that produces basmati rice but had been excluded from the “Basmati region,”⁸⁸ as well as the Basmati Growers Association of Pakistan, who protested that basmati rice is grown in both India and Pakistan.⁸⁹

Similarly, the name “Darjeeling” has been the subject of several abuses, and legal challenges both in the US and the EU. The “Darjeeling” GI protects tea that is cultivated and grown in the Darjeeling region of West Bengal in India.⁹⁰ The distinctive quality and flavor of Darjeeling tea has been globally recognized for over a century.⁹¹ The distinctiveness of Darjeeling tea is said to be due to two main factors: the tea’s geographic origin, and the process by which the tea is made.⁹² The tea is grown in tea gardens located 2,000 meters above sea level, and the environment at that particular elevation is said to add to the uniqueness of the tea.⁹³ In addition to these two factors, the Tea Board of India’s quality control mechanisms ensure that the product maintains its high quality and that the tea originates only from the GI region.⁹⁴

Hence, there have been several controversies around the use of the term “Darjeeling” for non-tea products outside India in recent years. For instance, the Tea Board of India disputed the use of “Darjeeling” as a mark by a French company for intimate lingerie.⁹⁵ In this case, the Tea Board ultimately succeeded in protecting the name under EU trademark law, as Darjeeling was first registered as a mark in the EU,⁹⁶ and only subsequently was registered

⁸⁷ Mukherjee, *supra* note 83.

⁸⁸ The State of Madhya Pradesh filed an opposition on the grounds that the application for “Basmati” as a GI had excluded thirteen territories of Madhya Pradesh (MP) where Basmati rice is grown.

⁸⁹ If the evidence of opposition were not filed within the prescribed time, the application would be deemed to be abandoned.

⁹⁰ S. C. Srivastava, *Protecting the Geographical Indication for Darjeeling Tea*, WORLD TRADE ORGANIZATION, www.wto.org/english/res_e/booksp_e/casestudies_e/case16_e.htm.

⁹¹ *Id.* ⁹² *Id.* ⁹³ *Id.*

⁹⁴ See the Chapter by Yogesh Pai & Tania Singla, “Vanity GIs”: India’s GI Legislation and the Missing Regulatory Framework, in this volume.

⁹⁵ *The Darjeeling Question: What’s Your Cup of Tea – a T-bag or a G-string?*, THE IPKAT (October 14, 2015), <http://ipkitten.blogspot.com/2015/10/the-darjeeling-question-whats-your-cup.html>.

⁹⁶ The Tea Board’s trademark is DARJEELING, Registration No. 004325718 (EU). The opposed marks were DARJEELING collection de lingerie, Trade Mark No. 009466228 (EU) and DARJEELING, Trade Mark No. 009466269 (EU).

as a *sui generis* GI.⁹⁷ Still, in another dispute in France, an insurance company used “Darjeeling” as a mark for its services.⁹⁸ In response, however, the French courts concluded that because Lipton marketed “Darjeeling” in French supermarkets, that the term did not have enough of a distinctive reputation to receive dilution protection under trademark law in France.⁹⁹

In the US, several “Darjeeling” trademarks have been registered for non-tea products, again by parties unrelated to the producers of Darjeeling tea in India. For instance, “THE DARJEELING BAGS” is registered for luggage products.¹⁰⁰ Additionally, “DARJEELING” is registered to a company that sells shirts, shorts, dresses, and ladies undergarments.¹⁰¹ These registrations are still in force and it does not seem that it would be possible to obtain their cancelation based on US trademark law.

Under an unfair competition approach, such as the one that is embodied in the Inter-American Convention, GI protection is justified not only to ensure that consumers are not deceived, but also to protect producers from the region referenced. For example, out of fairness to consumers and producers, countries interested in combating unfair competition would not want companies to use “Basmati” on rice that does not come from that region. But, this justification for protection does not apply in situations where non-rice products are marketed with “Basmati” marks because there is no threat to competition. Thus, while the mark “Texmati” would probably not withstand a legal challenge under a provision similar to the Inter-American Convention, the use of “Darjeeling” for non-similar goods or service would unlikely be prohibited.

7 CONCLUSION

As I have elaborated in this chapter, the US history with respect to GI protection is a little more complex than most assume. In particular, the US has not consistently shied away from GI protection nor has it always relied upon a trademark system to achieve GI protection. In 1929, in drafting and ratifying the Inter-American Convention, the US forged a different

⁹⁷ Commission Implementing Regulation No 1050/2011 of October 20, 2011, entering a name in the register of protected designations of origin and protected geographical indications (Darjeeling (PGI)), 2011 O.J. (L276) 5; DOOR, *Denomination Information*, EUR. COMM’N, <http://ec.europa.eu/agriculture/quality/door/registeredName.html?denominationId=1900>.

⁹⁸ See the chapter by Christopher Heath, *How would Geographical Indications from Asia fare in Europe?*, in this volume.

⁹⁹ *Id.* ¹⁰⁰ THE DARJEELING BAGS, Registration No. 4855286 (U.S.).

¹⁰¹ DARJEELING, Registration No. 2043112 (U.S.).

approach to GI protection to be applied in several countries in the Americas. The Inter-American Convention offered a broader, more comprehensive system of protection to GIs compared to the systems of protection achieved in any other treaty at that time. While the US may no longer officially follow this (still in force) approach today, and many in the US may barely have been aware of the Inter-American Convention, a similar system may be interesting for Asia, and for other regional blocks of countries coming into this discussion, as a model to consider. Ultimately, the Inter-American Convention offers the international community an alternate approach, or a middle path between the current US and EU models, with its unfair competition foundation. At a minimum, the Inter-American Convention offers a variant to the *sui generis* system today applied in the EU and the trademark approach of the US.