INTA comments on 'Measures on protecting products bearing foreign geographical indications’ in China

March 29, 2019

INTA would like to submit the following comments on the Chinese exposure draft on the ‘Measures on protecting products bearing foreign geographical indications’ ("the exposure draft"), dated February 28, 2019.

The International Trademark Association (INTA) is a global association of brand owners and professionals dedicated to supporting trademarks and related intellectual property (IP), including geographical indications, to foster consumer trust, economic growth, and innovation.

INTA’s members are more than 7200 organizations from 191 countries. INTA members collectively contribute almost US $12 trillion / €8.8 trillion / ¥73 trillion to global GDP annually. For comparison, the 2016 annual GDP of the top three markets was $11.2 trillion (China), $16.4 trillion (European Union) and $18.6 trillion (United States). The Association's member organizations represent some 31,000 trademark professionals and include brand owners from major corporations as well as small and medium-sized enterprises, law firms and non-profits. There are also government agency members as well as individual professor and student members. INTA has 236 members' organizations representing 1689 individual members in China as well as 1431 members' organizations representing 6637 individual members in the European Union.

INTA undertakes advocacy work throughout the world to advance trademarks and related rights, and offers educational programs and informational and legal resources of global interest. Headquartered in New York City, INTA also has offices in Brussels, Shanghai, Singapore, Santiago de Chile and Washington D.C. and representatives in Geneva and New Delhi.

Further information about our Association can be found at www.inta.org.

INTA respectfully submits the following comments on the exposure draft:

I. General Comments

While INTA supports the protection of geographical indications (GIs) as an intellectual property right (IPR), INTA firmly advocates that such protection must not prejudice other existing IP rights, including trademarks.

Harmonious coexistence of GIs and trademarks is possible as long as conflicts between these rights continue to be resolved pursuant to the well-established intellectual property (IP) principles of territoriality, exclusivity and priority. INTA has always advocated for the priority principle (First in Time, First in Right) to apply to conflicts between GIs and trademarks, as enshrined in INTA Board Resolution on ‘Protection of geographical indications and trademarks' meaning that a validly registered prior trademark should prevail against a later geographical indication and vice versa.

INTA also advocates for any GI registration system to include opposition and cancellation procedures, and be consistent with TRIPS and WTO dispute resolution decisions.
II. Specific comments on the provisions of the exposure draft

Translation and transcription (article 4). For the sake of legal certainty, INTA would like the scope of protection to apply only to transcriptions or translations specifically and individually identified at the time of the application.

Moreover, INTA requests that an opposition be provided for against a requested transcription or translation.

Generic terms (articles 4, 33 and 34). INTA would like additional clarity regarding the modalities and legal grounds according to which a GI can become generic in China. In particular, INTA would welcome such statement to be declared by an independent authority based on the analysis of specific and pre-established legal grounds and criteria.

Committee of expert in geographical indication for deliberation and ruling on the application for revocation (article 35). INTA would welcome the definition of the requirements and skills of the experts which will be part of the committee of expert as they are not provided in the current exposure draft. In particular, INTA would like to have experience included as a criterion to select experts, i.e. the experts should have a specified and proven experience in the GI sector.

GI made of a compound of words (not included in the exposure draft). INTA would like to ensure that the scope of protection for GIs made of compound words apply only to the geographical indication as a whole (the entirety of the compound of words) and not to the use of each individual words.

Protection against infringements of GIs (not included in the exposure draft). With regards control powers over the Chinese market be by the Chinese authorities in order to detect possible infringing cases, INTA advocates that such controls should be carried out with the involvement and cooperation of the owner or the representative of the foreign GI.