

**UNIVERSITY OF PRETORIA**  
**FACULTY OF LAW**  
**CENTRE FOR HUMAN RIGHTS**

**A CRITICAL ANALYSIS OF THE LEGAL FRAMEWORK FOR THE  
PROTECTION AND ENFORCEMENT OF GEOGRAPHICAL  
INDICATIONS RIGHTS IN MALAWI**

A research paper submitted in partial fulfilment of the requirements for the LLM Degree in  
International Trade and Investment Law in Africa, University of Pretoria, South Africa

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**31 MAY 2012**

## Dedication

This paper is dedicated with admiration to my mother **Euphrasia Jane Chidothe Chisama** who tirelessly told me as a primary school teacher ‘I have clapped hands for many successful students who are not my children. Now I want to clap hands for you’. For my late father **Evans Joseph Chisama**, may God rest his soul in eternal peace.

## Acknowledgments

‘The Lord is my shepherd; I shall not want. He maketh me to lie down in green pastures; he leadeth me beside the still waters. He restoreth my soul: He leadeth me in the paths of righteousness for his name’s sake. Yea, though I walk through the valley of the shadow of death, I will fear no evil: for thou art with me ; ...Surely goodness and mercy shall follow me all the days of my life : and I will dwell in the house of the Lord forever. (Bible: king James Version. Psalm 23)

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## Declaration

I, **PETER CHISAMA**, declare that this Dissertation which is hereby submitted for the award of Legum Magister (LL.M) in Trade and Investment Law in Africa at International Development Law Unit is my original work. It has not been previously submitted for the award of a degree at this or any other tertiary institution. Where works of other people are used, references have been provided.

Signed

.....

**Peter Chisama**

**31 May 2012**

**Pretoria,  
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## Abbreviations and Acronyms

ARIPO	African Regional Industry Property Organisation
AQSIQ	Department of Administration of Quality Supervision, Inspection and Quarantine
CMO	Common Agricultural Markets Organisation
CTMR	Community Trademark Regulation
DCs	Developing Countries
EC	European Commission
ECJ	European Court of Justice
ECR	European Court Reports
EU	European Union
FTA	Free Trade Area
FSR	Fleet Street Reports
GI	Geographical Indication
GIs	Geographical Indications
IGOs	Indications of Geographical Origin
LDCs	Least Developing Countries
MFN	Most Favoured Nation
MOA	Ministry of Agriculture
OIHM	Office of Harmonization in the Internal Market
PDO	Protected Designation of Origin
PGI	Protected Geographical Indications
RTA	Regional Trade Area
SIAC	State Administration for Industry and Commerce
TRIPS	Trade-Related Aspects of Intellectual Property Rights Agreement 1994
TSG	Agricultural Products & Foodstuffs for Traditional Specialities Guaranteed
UNCTAD	United Nations Conference on Trade and Development
USPTO	United States Patent & Trademark Office
WTO	World Trade Organization

## Directory of cases

*Carl Kuhne and others v Jutrokonserverfabrik* Case C269/99 [2001] ECRI-9517(ECJ)

*Hamilton-Browne Shoe Co. v Wolf Bros. & Co* 240 US 251, 60Led629, 36 S Ct 269(1916)

*Zhejiang Province Food Co. v Shanghai Tai Kang Food*, Shanghai No.2 Intermediate  
People's Ct. October 31 2005 (also known as the Jinhua Ham case)

## **List of Treaties and Legislative Instruments**

### **Convention and Treaties**

Madrid Agreement concerning the International Registration of Marks, 1891

The Lisbon Agreement for the protection of Appellations of Origin and their International Registration, 1958

The Paris Convention for the protection of Industrial Property, 1883

Trade Related Aspects of Intellectual Property Rights Agreement (WTO), 1994

### **Legislation**

Council Regulation (European Union ) 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, OJ L 93, 31/03/2006, as amended by Council Regulation 1791/2006 of 20 November 2006

The Malawian Trademark Act of 1 April 1958, Chapter 49:01 of the Laws of Malawi

Trademark Law of United States of America (Lanham Act) of July 5, 1946

Trademark Law of the People's Republic of China of August 23, 1982; as amended on October 27, 2001)

Provisions for the Protection of Products of Geographical Indications in China of July 15, 2005

Community Trade Mark Regulation (Council Regulation (EC) No 40/94 on the Community Trademark of 20th December 1993

The Regulations on Protection of Products of Geographical Indications (AQSIQ) of China of 15 July 2005

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## **Abstract**

The Agreement on Trade –Related Aspects of Intellectual Property Rights has almost universal application due to the large number of signatories from the World Trade Organization member states. 149 countries signed the TRIPS by 1994. Therefore, the TRIPS Agreement has also become a valuable tool for the protection of special intellectual property rights under the term geographical indications.

GIs have current relevance in the world market to consumers who are healthy and quality conscious. The legal protection of GIs is due to their economic value to many countries where the producers are in rural areas. This is because most GIs are based on traditional methods of production which have earned goodwill. The TRIPS came in to prevent free riding of such rights by producers who do not conform to the standards and rules of production.

The TRIPS Agreement requires member states to harmonise their legal systems to provide legal means of protecting GIs to the standard stipulated therein. Malawi joined the WTO on 31 May 1995 which means that the obligation above mentioned is applicable from then on. Therefore, this study is an investigation of whether Malawi has complied with the obligations in article 1.1 of the TRIPS especially in so far as geographical indications rights are concerned.

## Chapter One

### INTRODUCTION

#### 1.1 Background

Malawi is a country in Southern East Africa and is one of the Least Developing Countries. It has a population of 13 million people over an area of 118, 480 square kilometres.<sup>1</sup> It is estimated that more than 11 million people live in rural area and over 60% of the population live below the poverty line.<sup>2</sup> Economically, agriculture contributes to 45% of the Gross Domestic Production and 90% of export earnings. On the other hand, Manufacturing, mining and tourism contribute 11.5%, 1.6% and 1.8% respectively.<sup>3</sup> The closest regional grouping for Malawi is the Southern Africa Development Community (SADC) which also includes the following countries: Angola, Botswana, Democratic Republic of Congo, Lesotho, Madagascar, Mauritius, Mozambique, Namibia, South Africa, Swaziland, United Republic of Tanzania, Zambia and Zimbabwe.<sup>4</sup>

Malawi is a member of World Trade Organisation and a party to the Agreement on Trade Related Aspects of Intellectual Property since 31<sup>st</sup> May 1995.<sup>5</sup> Malawi is also a party to several international treaties, conventions and bodies that deal with various types of intellectual property rights such as World Intellectual Property Organization (WIPO) Convention, Berne Convention and Paris Convention.<sup>6</sup>

Internationally, the current multilateral guiding standards subscribed by all the members of the WTO in intellectual property are the provisions of the TRIPS.<sup>7</sup> Geographical Indications

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<sup>1</sup>World Intellectual Property Organisation (WIPO) 'Malawi's intellectual property profile' (April 2009) <http://www.wipo.int/ldcs/en/country/pdf/mw.pdf>(accessed 4 November 2011).

<sup>2</sup>J Chigaru 'Malawi and the multilateral trading system: The impact of WTO Agreement, negotiations and implementation' (ITC/UNCTAD/WTO) (UNCTAD/DITC/TNCD/2005/18) 2006 1 <http://www.unctad.org/en/docs/ditctnkd200518.en.pdf> (accessed 28 October 2011).

<sup>3</sup> M Carbone 'Malawi country report' *The Courier, the Magazine of ACP- EU Development Cooperation* 201 (November – December 2003) 44-60 [http://ec.europa.eu/development/icenter/repository/201\\_ACP\\_EU\\_en.pdf](http://ec.europa.eu/development/icenter/repository/201_ACP_EU_en.pdf) (accessed 4 November 2011)

<sup>4</sup>World Trade Organization 'The WTO and Preferential Trade Agreements: From co-existence to coherence' World Trade Report (2011)242.

<sup>5</sup>World Trade Organization 'Understanding WTO' (2011) 112.

<sup>6</sup>A Neba 'Intellectual property rights system: Snapshots from the Southern African Development Community (SADC)' (10 June 2011) 13 <http://www.sarima.co.za/conference%202011/10%20June%20-%202009h00%20-%20Neba.pdf> (accessed 28 October 2011)

<sup>7</sup>D Vivas-Eugui & C Spennemann 'The treatment of Geographical Indications in recent WTO discussion and in Regional and Bilateral Agreements' International Centre of Trade and Sustainable Development (ICTSD)

(GIs) are some of the specific intellectual property rights under the TRIPS. Geographical Indications are signs or names used on goods that have a specific geographic origin and possess qualities or a reputation due to that place of origin. Most commonly, geographical indications consist of the name of the place of origin of goods.<sup>8</sup>

Geographical Indications have caused much debate in WTO and further negotiations are to continue until the mist around them is settled in the Doha Round.<sup>9</sup> Historically, GIs have been more elaborate in continental Europe. This meant that their reception into the WTO system brought new obligations to reform legal and institutional frameworks on many member states including, United States of America.<sup>10</sup> Malawi and many other countries have not been spared from this wind of change. Malawi, however, as a Least Developed Country (LDC) has been allowed under the WTO to delay the full implementation of the TRIPS until 2016.<sup>11</sup> Despite the obligation to align the legal framework with the TRIPS, Malawi has not yet reformed the same. Efforts are under way to develop a policy on intellectual property as per document containing all policies on a long term development plan in Malawi for the vision 2020.<sup>12</sup> The vision 2020 also encompasses short terms plans called the ‘Malawi Growth Development Strategy (2006-2011).

Historically, according to a United Nations Report on Malawi on the trade systems, Malawi intended to revise and implement its intellectual property legislation to meet its commitments under the TRIPS Agreement by 2006.<sup>13</sup> The report also revealed that by then Malawi would have made little progress in this direction. This was the situation because Malawi needs technical assistance from WIPO to create an effective enforcement mechanism, since the main problem in achieving full compliance with TRIPS is the absence of such a regime.<sup>14</sup> Furthermore, the report specifically mentioned the area of geographical indications as one of

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(October 2006) 2-3, <http://ictsd.org/downloads/2009/01/gis20dv2020cs20rev2020sa20dialogue-pdf.pdf> (accessed 1 November 2011).

<sup>8</sup>World Intellectual Property Organization ‘What is intellectual property? WIPO Publication Number 450(E) 15.

<sup>9</sup> ML Blackeney& T Coulet ‘The protection of Geographical Indications (GIs) : Generating empirical evidence at country and product level to support African ACP country engagement in the Doha Round Negotiations’ Mid-Term Progress Report,Ref: 9 ACP RPR 140-011-10 (11March 2011) <http://acp-mts-programme.org/assets/docs/069/119/9c75f45-4b5d177.pdf> (accessed on 1 November 2011). This paper discusses the issues that have not resolved by the TRIPS which are carried over to the Doha Round.

<sup>10</sup>Vivas-Eugui&Spennemann (n 7 above) 3.

<sup>11</sup>Neba (n 6 above) 30.

<sup>12</sup> Author Unknown ‘Malawi’s vision 2020 and Malawi Growth and Development Strategy (MGDS)(2006-2011) 17 [www.sadc.int/index.php/download\\_file/view/77/270/](http://www.sadc.int/index.php/download_file/view/77/270/)(accessed 4 December 2011)

<sup>13</sup>Chigaru(n 2 above) 37.

<sup>14</sup>Chigaru (n 2 above) 37.

the areas that lacks appropriate legislative cover. The report also noted that despite the extension of time for LDCs like Malawi to meet their obligations under TRIPS, progress was still impeded by the complexity and novelty of the field.<sup>15</sup>

This gives an impression that in some jurisdictions there are no starting points in the existing IP legislation to anchor some of the obligations that have come out of the TRIPS. Therefore, by prima facie inferences, LDCs, like Malawi may be required to provide complete new legislation or legal frameworks on specific issues such as Geographical Indications because the existing laws may not be effectively amended or revised.

In addition, the afore said report stated that Malawi intended to comply with TRIPS obligations by the end of 2005, but the absence of expertise on matters relating to intellectual property rights prevented the Government from revising the obsolete legislation. The Registrar General's Department which is responsible for the administration of intellectual property under the Ministry of Justice in Malawi lacked legal expertise on the subject and that none of the specialised organisations such as WTO and WIPO had offered the needed legal technical assistance and training.<sup>16</sup>

As a matter of emphasis, the situation is still as it was by end of 2005. There is no legal framework covering for the new obligations from TRIPS as well as the protection of GIs apart from the 1958 Trade Marks Act.<sup>17</sup> Therefore, changes in the IP law in Malawi may be necessary.

Some of the international debates on the protection of GIs which Malawi has to consider when changing its legislation as listed by Vivas-Eugui and Spennemann are, for example:(i) the implementation of TRIPS agreement obligations on legal frameworks; (ii) the extension of protection under Article 23 of TRIPS to other products than wines and spirits;( iii)the prevention of use and invalidation of trademarks containing or consisting of a GI; (iv)conformity of Regional Trade Agreements (RTA) and Bilateral Free Trade Agreements (FTA) to TRIPS.<sup>18</sup>

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<sup>15</sup>Chigaru (n 2 above) 37.

<sup>16</sup>Chigaru (n 2 above) 37.

<sup>17</sup>Malawi Trade Marks Act of 1958 Cap 49:01 of the Laws of Malawi WIPO Website <http://www.wipo.int/wipolex/en/details.jsp?id=9334> (accessed 1 November 2011).

<sup>18</sup>Vivas-Eugui&Spennemann (n 7 above) 5-7.

When negotiations were first made on the protection of GIs in WTO, European Union, Japan and Switzerland supported the USA to lobby for more protection.<sup>19</sup> However, the European Union and USA differed on the approach. Therefore, there are two schools of thought in so far as regulation and protection of GIs are concerned.<sup>20</sup> European Union advocates for a separate regime for protecting GIs since they have a long tradition of such framework. USA, Canada, Australia, New Zealand and others which historically have not had separate laws to protect GIs apart from the trademarks systems are opposed to EU's proposal to protect names of products based on their GIs status. USA and its allies disregard the validity of a sui generis protection because geographic names do not deserve protection under trademark law and are considered to be generic terms in the USA market rather than references to geographic locations that produce property rights.<sup>21</sup> This reality has made it difficult for the multilateral protection of GIs in so far as third countries are concerned.<sup>22</sup>

The concern of the developing countries and LDCs like Malawi in the protection of GIs is the extension of the Article 23 of TRIPS to other products than wines and spirits. The European Community protection of GIs only encompasses agricultural products. However, developing countries want to include other products such as crafts.<sup>23</sup>

## 1.2 Problem Statement

According to the WTO, Malawi as a member state has a legal obligation to reform her intellectual property regime by aligning it with the TRIPS. The main question to be dealt with in this study, therefore, is whether the current intellectual property framework in the Trademarks Act 1958<sup>24</sup> in Malawi provides protection to GIs in terms of Malawi's obligation under TRIPS.<sup>25</sup> The study will also investigate if GIs whether of domestic or foreign origin are protected by the current laws in Malawi taking into account the principles of non-discrimination in WTO systems. The other question is whether the current regime is useful in

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<sup>19</sup> JMC Martin 'The WTO TRIPS Agreement: The Battle between the old and the new world over the protection of Geographical Indications. (May 2004) 7(3) *The Journal of World Intellectual Property* 287

<sup>20</sup> Martin (n19 above) 287.

<sup>21</sup> Martin (n19 above) 288.

<sup>22</sup> N El Benni 'Geographical Indications: Discussions and negotiation about protection tools' Swiss National Centre Competence in Research working paper 2009/ 16 March 2009 30

[http://82.220.2.60/images/stories/publications/IP5/report\\_IP5\\_GI\\_protection\\_%202009.pdf](http://82.220.2.60/images/stories/publications/IP5/report_IP5_GI_protection_%202009.pdf): (accessed 1 November 2011).

<sup>23</sup> El Benni (n 22 above) 25.

<sup>24</sup> See WIPO Website <http://www.wipo.int/wipolex/en/details.jsp?id=9334>.

<sup>25</sup> WIPO (n 1 above). It must be noted that the information was documented in April 2009.

the enforcement of Malawian rights over Geographical Indications if they are violated in foreign countries.

The background has already shown the different regimes in the protection in GIs between EU and USA. Therefore, this study has to answer an ancillary question about the type of regime Malawi should use to protect the said rights. This means that Malawi should either follow the European Union in the sui generis protection of GIs or the USA group by protecting GIs as collective marks in the Trademark system. The answer then will be obtained by analysing the nature of existing laws in light of the legal and socio-economic status of Malawi.

### 1.3 Research Objectives

The overall objective of this research is to examine and provide reasonable recommendations which Malawi should consider when coming up with an appropriate GIs protection regime. This is irrespective of whether Malawi will opt for either amending the existing trademark law or coming up with a sui generis regime in the protection of GIs.

This research will not endeavour to propose a list of products which may be registered as GIs in Malawi, although the legal criteria for registering the same may be discussed. The rationale of limitation is based on the fact that to trace the availability of GIs in Malawi requires enormous quantitative research on products and production methods in all parts of Malawi. This process is incompatible with this qualitative and desk research.<sup>26</sup> In addition, the tracing exercise is a continuous process since people are still innovative and many more resources are being discovered in Malawi.

Lastly, what is paramount in this research is the fact that Malawi has to fulfil its legal obligation in the WTO in the protection of GIs. According to Articles 3 and 4 of the TRIPS, this protection must be for both Malawi's own products and foreign products alike in so far as the principle of non-discrimination in WTO is concerned.<sup>27</sup>

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<sup>26</sup>PR Jena & U Grote 'Changing institutions to protect regional heritage : A case for Geographical Indications in the Indian agrifood sector' 11 <http://www.pegnet.ifw-kiel.de/activities/pradyot.pdf> (accessed 4 December 2011) The paper discusses GIs in India .However, on page 11 the authors explain that in order to know about the existing GIs in a country and their socio-economic implications takes a great deal of research and collection of data which is problematic in most developing countries. Such information is also scarce in the said countries. This is equally applicable to Malawi which is a Least Developing Country.

<sup>27</sup> World Trade Organization 'Legal texts: The results of the Uruguay Round of multilateral trade negotiations' (1999) 323.



## 1.4 Research Hypothesis

The underlying assumption of this research is that there is no clear cut legal framework to protect GIs in Malawi. However, the intention and efforts to institute the same are under way but not yet hatched. If Malawi were to have an effective regime for the protection of GIs, this would discharge her legal obligation in the WTO in so far as TRIPS is concerned. Nevertheless, if Malawi embarks on the review of GIs protection one wonders which model should be adopted. One wonders also about what should be included in such a law taking into account different non concluded debates on GIs.

It also an assumption of this study that may be, this investigation would lead to the awareness of these rights to the general public, thereby, stimulating collective innovations and uncovering some of the existing but unknown GIs.<sup>28</sup> Consequently, Malawi could follow the example of India where upon instituting a legal regime to register and protect GIs in 2003, there was an increase in registration. There were 61 registrations of GIs in India from 2003 to 2008.<sup>29</sup>

## 1.5 Scope of Study

It is acknowledged that the field of International Law under analysis is very wide and that debates have not been yet settled. Therefore, a narrow but elaborate scope is proposed to deal with the protection of GIs in Malawi. The question whether Malawi has a legal framework for the protection of GIs will be analysed in context of singled out models in the world. Therefore, more focus will be given to the existing Trademark Act in Malawi.<sup>30</sup>

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<sup>28</sup> GM Robbani 'Trade-Related Aspects of Intellectual Property Rights and Least Developed Countries' (July 2005) 8 (4) *The Journal of World Intellectual Property* 565-573. Robbani notes that a credible regime will not only encourage innovations for the society but will also persuade registration of many existing IPs which remain forgotten at present. This will ensure that proper utilization of scarce knowledge and stop misuse of IP.

<sup>29</sup> Jena & Grote (n 26 above) 13.

<sup>30</sup> Malawi Trademark Act of 1958 (n 17 above).

## 1.6 Significance of the Research

The main significance of the research is the legal and social contribution of knowledge to Malawi and the world of academia. The research is providing an analysis of the legal framework in an area which may not be a priority in terms of economic problems the country is facing. However, it is the argument of this study that this area is more important when it comes to maintaining good international relations and poverty reduction as per vision 2020 and Malawi Growth Development Strategy.<sup>31</sup>

The premise above stems from the fact that the South (i.e. developing countries) has enjoyed several exemptions in the implementation of the TRIPS Agreement that is to include geographical indications. However, this generosity will not continue because intellectual property rights violations and lack of legal harmony distort the world market by providing parallel goods or practices. Therefore, the international community will forcefully drag LDCs to implement the same soon or later. The LDCs will painfully introduce IPR laws and enforcement mechanism in their territories and will not tolerate the same violations by their neighbours due international pressure.<sup>32</sup>

This research will also contribute to the deepening of knowledge among the few existing comprehensive literature on GIs in Malawi. Therefore, this study may be used as the basis of future extensive research on the availability of GIs in Malawi and thereby contributing to the economy of the country.<sup>33</sup>

The TRIPS only protects Geographic Indications which are recognized in the country or region of origin.<sup>34</sup> This entails that protection can only be accorded to proposed GIs if such recognition and protection is offered in the regulatory framework of the country or region of origin. The main problem for many countries such as Malawi, which have no frameworks or have weak existing frameworks, are that if they have GIs, the same cannot be protected in the multilateral system. Therefore, this study will contribute the acknowledgement of GIs in Malawi by proposing for a sound legal framework for recognition.

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<sup>31</sup> Author Unknown 'Malawi's Vision 2020 and Malawi 'Growth and Development Strategy (2006-2011) (n 12 above) 17.

<sup>32</sup> Robbani (n 28 above) 572.

<sup>33</sup> This point has already been justified under in this paper under section 1.4. Research Hypothesis.

<sup>34</sup> Article 24.9 of the TRIPS Agreement.

## 1.7 Literature Review

The heart of a successful business in a liberalized market lies in competitive advantage. This is achieved by the level of retention of existing customers and the creation of new ones. Therefore, goodwill is important and the concept of Geographical Indications is linked thereto.<sup>35</sup>

Historically, a clear concept of GIs was developed in continental Europe and before 1980s most common law countries were not well conversant with the regime.<sup>36</sup> However, internationally, the evolution of GIs protection can be traced to the Paris Convention for the Protection of Industrial Property of 20<sup>th</sup> March 1883<sup>37</sup> and the Madrid Agreement on the Suppression of False and Misleading Indications on Provenance of 14<sup>th</sup> April 1891.<sup>38</sup>

However, the new impetus on GIs was blown in by the TRIPS because its implementation required administrative and legal framework reforms. One of the reasons for the new impetus was to protect intellectual property, Geographic Indications inclusive, so as to encourage research and development for innovation. It was revealed, that countries lose billions of dollars per year due to the non-existence or weak enforcement of IP laws, mainly in developing countries.<sup>39</sup>

The strengthening of IP laws has met much criticism that it offers benefits to the North (developed countries) at the expense of the South especially in the areas of food security and health programmes. The Developing Countries, Least Developing Countries and NGOs tried to derail the North's agenda on the protection of intellectual property by criticising the TRIPS regime.<sup>40</sup> However, they failed. This contributed to the delay in the establishment of creative regulatory framework to protect their IP in developing countries.<sup>41</sup>

The enforcement of the Geographical Indications rights under the TRIPS has been controversial world over having two schools of thought splitting between the European countries on one hand, and USA, Japan and Canada on the other hand respectively. The EU

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<sup>35</sup>P Ganguli & M VIRDC World Trade Centre Mumbai 'Geographical Indications, Its Evolving Contours' WTC Research Study Report January 2009 1 [http://www.iips.ac.in/main\\_book.pdf](http://www.iips.ac.in/main_book.pdf) (accessed 1 November 2011).

<sup>36</sup>Vivas-Eugui & Spennemann (n 7 above) 3.

<sup>37</sup>L Bently & B Sherman *Intellectual property law* (2009) 979.

<sup>38</sup>Bently & Sherman (n 37 above) 22.

<sup>39</sup>Robbani (n 28 above) 565.

<sup>40</sup>Robbani (n 28 above) 565.

<sup>41</sup>Robbani (n 28 above) 565.

countries prefer to protect the GIs under a sui generis system they have been using for many years, while the USA block prefers to offer this protection under the trademark system.<sup>42</sup> Therefore, proposals in Malawi may take one form or another since both ways have advantages and disadvantages.

The debate on recognition and protection of GIs which exist in more than one country is also an issue to consider in the framework. Sometimes, GIs exist across borders, for example, GIs may be shared by Malawi and other neighbouring countries.<sup>43</sup> Therefore, the proposed reforms in Malawi must deal with the issue with innovation.

## 1.8 Research Methodology

There is a lot of literature available on GIs and models of legal frameworks all over the world. Therefore, the study will make a comparative analysis of the said models in view of the existing legal framework in Malawi. However, not so much has been written about GIs in Malawi.

The experience in EU, USA and China is also very important to the proposed reforms in Malawi as matter of international compatibility. The importance of USA and EU as already discussed in the preceding paragraphs represent the two different existing models and opinions in dealing with GIs. The EU represents the sui generis regime, while USA represents the protection under the trademark systems.<sup>44</sup> Therefore, this research has to analyse both systems to see whether they are suitable for Malawi. The justification of studying the system in China is that the country has a long existing tradition and is now doing exceedingly well in trade.<sup>45</sup> By 2009 China was number one in rank in world trade exports and number two in terms of imports.<sup>46</sup> By 2009 Malawi's imports from China were at 5.9 % of total imports.<sup>47</sup> Therefore, the growing importance and the long history of China may be very important to this study.

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<sup>42</sup>Martin (n19 above) 287-326.

<sup>43</sup>SK Soam 'Analysis of perspective Geographic Indications of India' (September 2005) 8 (5) *The Journal of World Intellectual Property* 679 – 705.

<sup>44</sup>Martin (n 19 above) 287-288.

<sup>45</sup>V Arora & A Vamvakidis 'China's economic growth: International spillovers' Asia and Pacific Department and Strategy, Policy, and Review Department IMF Working Paper WP/10/165 (July 2010) 3-4.

<sup>46</sup>WTO 'World trade profiles 2010' (2010) 38.

<sup>47</sup>WTO 'World trade profiles 2010' (2010) 105.

The study was investigative and explorative in nature involving desk and library research by reading text books and journals. Internet research of online articles, journals and study reports was also employed. Although the proposed exploration shall be legalistic, the nature of the subject area is multidisciplinary.

The study will also borrow ideas from jurisprudence especially autopoietic and legal positivist theories. The autopoietic approach argues that the law must engulf the social changes, while legal positivism as propounded by John Austin suggests that:<sup>48</sup>

...the existence of law is one thing, its merits and demerits are another ...a law which actually exist, is law. Though we happen to dislike it...

The law in Malawi in so far as Geographical Indications are concerned has to change to conform to the new obligations brought in by the TRIPS. Whether the TRIPS obligation is against developing countries or favours the developing countries is not a concern at this juncture, since member states agreed. Therefore, based on John Austin theory, member states must comply with the TRIPS unless the changes are made therein in another round of multilateral discussions and negotiations. Malawi needs a clear position on the protection of Geographical indications despite the merits of debates to conform to its obligations under the TRIPS. Secondly, the law in Malawi as it is, may not provide for geographical indication rights which may be very important to the citizens. Nothing can be done now in so far as recognition and promotion of such rights is concerned until the law in Malawi is changed to engulf the afore said rights.<sup>49</sup>

In conclusion, this research is a qualitative study of the legal framework for the protection of GIs in Malawi.

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<sup>48</sup>S Guest, .et al 'Jurisprudence and legal theory' (September 2004) 52.[http://www.londoninternational.ac.uk/current\\_students/programme\\_resources/laws/subject\\_guides/jurisprudence/juris\\_chs1to4.pdf](http://www.londoninternational.ac.uk/current_students/programme_resources/laws/subject_guides/jurisprudence/juris_chs1to4.pdf) (accessed 28 October 2011)

<sup>49</sup>M ABoden 'Autopoiesis and life' (2000)1 *Cognitive Science Quarterly*, 141:<http://cognition.iig.uni-freiburg.de/cs/q/pdf-files/boden.pdf> (accessed 1 March 2012); See also A D'Amato 'International law as an Autopoiesis system' 15 November 2003,14:<http://anthonydamato.law.northwestern.edu/auto/PLANCK-1.pdf> (accessed 1 March 2012).The autopoietic approach argues that the law must engulf the social changes, otherwise it loses its relevance and like a living thing it may die of malnutrition.

## **1.9 Overview of Chapters**

Chapter one introduces the study by laying the background, the legal problem to be addressed, the objectives, significance of the study, how the study is to be conducted and outlines the presentation of the knowledge. The chapter connects geographical indications to Malawi.

Chapter two discusses models of legal frameworks regulating geographical indication in the world. This chapter will introduce substantive issues of GIs, the general definition of Geographical Indications, the pre-TRIPS international legal frameworks on GIs by discussing conventions and agreements. The chapter addresses the legal frameworks regulating GIs in European Union, the USA and China.

Chapter three covers the existing or current legal framework for the regulation geographical indications in Malawi. This chapter analyses the existing law and how it is currently protecting GIs in Malawi. The Trademark Act of 1958 in Malawi as provided in chapter 49:01 of the Laws of Malawi is the main focus of study.

Chapter four provides the overall recommendations and conclusion of the study .This chapter revisits the problem statement to see whether the same has been addressed by the investigation. The chapter also makes recommendations and proposes future areas of research before concluding.

## Chapter Two

# MODELS OF LEGAL FRAMEWORKS FOR THE PROTECTION OF GEOGRAPHICAL INDICATIONS

### 2.1 Introduction

This chapter will highlight the broad picture of geographical indications and how they operate internationally and nationally. This will be achieved by briefly looking at the definition of geographical indications and their evolution as intellectual property rights. Furthermore, the study will also focus on the current international regime on the said rights and specific national legislation from European Union, United States of America and China. The case-study countries will be looked prior to the study of the regulatory framework in Malawi, the subject matter of this research.

Geographical indications (GIs) are special type of intellectual property rights under a broad category of geographical designations<sup>50</sup> or rights protecting designation of source.<sup>51</sup> Furthermore, Jehoram calls them geographic denominations forms and the WTO Secretariat refer them to indications of geographical origin (IGOs).<sup>52</sup> The Agreement on Trade- Related Aspects of Intellectual Property Rights (TRIPS) emphasizes the importance of geographical indications as intellectual property rights. In many countries, geographical indications are regarded as a type of industrial property separate and distinct from trademarks. However, geographic indications most closely resemble trademarks<sup>53</sup> in some countries like Australia, Canada and USA.

The idea that geographical indications may be owned by groups or collectives rather than individuals makes them more akin to other forms of intellectual property rights particularly certification and collective marks under trademark law.<sup>54</sup> In patents, the most distinguishing

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<sup>50</sup>Bently & Sherman (n 37 above) 976.

<sup>51</sup>LR Helfer & GW Austin *Human rights and intellectual property, mapping in the global interface*(2011) 18.

<sup>52</sup>HC Jehoram (ed) *Protection of Geographic Denominations of goods and services*, (1980) vol 3 VII. See the foreword. See also D Gangjee, *Relocating the law of Geographical Indications*(2012) 2-4.

<sup>53</sup>EW Ibele 'The Nature and Function of Geographical Indications in Law' (2009) 10 (1) *The Estey Centre Journal of International Law and Trade Policy* 39 [esteyjournal.com](http://esteyjournal.com) or [ageconsearch.umn.edu/bitstream/48791/2/ibele10-1.pdf](http://ageconsearch.umn.edu/bitstream/48791/2/ibele10-1.pdf)(accessed 18 January 2012).

<sup>54</sup>Bently & Sherman (n 37 above) 976.

feature of a product is the uniqueness of the author or the novelty of the patented invention, which is similar to the uniqueness of the link between a product and a place required in proving geographical designations.<sup>55</sup>

The various terms used to describe geographical designations exist due to the different phases of evolution which these rights have undergone. This has also caused epistemic, conceptual and institutional conflicting complexities in the area.<sup>56</sup> Therefore, prior understanding of the similarities and differences in terms is crucial to the analysis of any piece of legislation on geographical designations.

## 2.2 The broad concepts in legal frameworks for protecting geographical designations

The geographical designations are expressed by using different terminologies from different regimes each having distinctive characteristics.<sup>57</sup> The terms ‘indication of source’ or ‘indication of provenance’ or ‘indication of origin’ refer to geographical designations.<sup>58</sup> These terms were used in the Paris Convention and the Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods of 1891.<sup>59</sup> The purpose of an indication of source is to connect a product to a particular geographical location, thereby simply informing consumers that the product bearing the sign comes from a particular place, region, or country.<sup>60</sup> There is no requirement that there be any correlation between the characteristics or quality of a product and the place that the product originated from.<sup>61</sup>

Geographical designations are also described by the term geographical indication of origin (GI) in Article 22(1) of TRIPS.<sup>62</sup> This article defines geographical indications to include a place and a given quality, reputation or other characteristic of the good which must be essentially attributable to its geographical origin.<sup>63</sup>

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<sup>55</sup>Bently & Sherman (n 37 above) 976.

<sup>56</sup>HC Jehoram (n 52 above) VII. See the foreword. See also Gangjee (n 52 above) 2.

<sup>57</sup>H Mac Queen et al *Contemporary Intellectual property, Law and Policy* (2010) 735

<sup>58</sup>Bently & Sherman (n 37 above) 977.

<sup>59</sup>Bently & Sherman (n 37 above) 977.

<sup>60</sup>Bently & Sherman (n 37 above) 977.

<sup>61</sup>Bently & Sherman (n 37 above) 977.

<sup>62</sup>Bently & Sherman (n 37 above) 977.

<sup>63</sup>Art.22 of the TRIPS Agreement.



The term ‘appellation of origin’ refers to a specific type of geographical indication which serves to designate a product originating from a place, region or country ,the quality or characteristics of which are exclusively or essentially due to the geographical environment.<sup>64</sup>

The geographical environment includes natural and human factors thereto. The distinctive feature of an appellation of origin is that the product for which an appellation of origin is used must have quality and characteristics which are due exclusively or essentially to its geographic environment.<sup>65</sup>

In comparison, the term ‘indication of source’ is broader than both appellations of origin and geographical indications. This is because indication of source simply denotes that a product originates from a particular geographic location.<sup>66</sup> Geographical indications of origin and appellation of origin both require that the geographic location must give the product particular traits or characteristics.<sup>67</sup> However, geographical indications differ from appellations of origin by extending beyond the quality of the product to include ‘reputation or other characteristics of the good. Appellation of origin requires that the quality or characteristics of the product must be exclusively or essentially due to the geographical environment.<sup>68</sup>

Therefore, from the premises above, it is proven that geographical indications are more akin to trade mark law than industrial designs, copyright and patent law because they do not only focus on the connection between a product and place but also at the characteristics of the model as a trading instrument.<sup>69</sup>

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<sup>64</sup> Art 2 of the Lisbon Agreement for the Protection of Appellations or origin and their International Registration of 1958.

<sup>65</sup> Bently & Sherman (n 37 above) 977.

<sup>66</sup> G Evans & M Blakeney ‘The international protection of Geographical Indications Yesterday , Today , and Tomorrow’ in G Westkamp (ed) *Emerging issues in intellectual property ;Trade , technology and market Freedom : Essay in honour of Herchel Smith* (2007) chap13, 262; See also Bently & B Sherman ( n 37 above) 977.

<sup>67</sup> Bently & Sherman (n 37 above) 977.

<sup>68</sup> Bently & Sherman (n 37 above) 977.

<sup>69</sup> G Evans & M Blakeney ‘ The international protection of Geographical Indications yesterday , today , and tomorrow’ in Westkamp (ed) ( n 66 above ) 262; see also Bently & Sherman(n 37 above) 978.

### 2.3 The History of the Evolution of Geographical Indications in International Conventions and Agreements

The protection of Geographical indications rights has internationally evolved due to their increasing economic importance. This section will briefly discuss the various international instruments prior to the Agreement on Trade-Related Aspects of Intellectual Property Rights. The Agreement on Trade-Related Aspects of Intellectual Property Rights is the current regime being internationally recognised in so far the regulation of geographical indications are concerned.

The Paris Convention for the Protection of Industrial Property was the first multilateral international instrument to regulate geographical indications. The Paris Convention of 20 March 1883<sup>70</sup> provides for the protection of geographical designations by extending industrial property to include the protection of indications of source or appellations of origin.<sup>71</sup> The provisions of the Convention are said to be limited to false indications because they make no reference to the situation where a term is translated or where the name is accompanied by words such as ‘type’, ‘like’ or ‘style’ indications.<sup>72</sup> Prior to the revision of the Paris Convention in Lisbon in 1958, the Convention required the claimant to prove that the user had fraudulent intentions, however currently the intention of the user is irrelevant.<sup>73</sup> The enforcement of the provisions in the Convention largely depends on the member states to prevent the importation of prohibited goods.<sup>74</sup>

Secondly, the Madrid Agreement for the Repression of False or Misleading Indications of Source on Goods was multilateral agreed to improve the protection of geographical indications. The Madrid Agreement of 1891<sup>75</sup> protects consumers against false indications of source. The agreement prohibits the importation of all goods bearing a false or misleading indication regardless of the intention of the user. The Agreement was made to close the

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<sup>70</sup>G Evans & M Blakeney ‘The international protection of Geographical Indications yesterday, today, and tomorrow’ in Westkamp (ed) (n 66 above) 266.

<sup>71</sup>Bently & Sherman (n 37 above) 979.

<sup>72</sup>Bently & Sherman (n 37 above) 979.

<sup>73</sup>Bently & Sherman (n 37 above) 979.

<sup>74</sup>G Evans & M Blakeney ‘The international protection of Geographical Indications yesterday, today, and tomorrow’ in Westkamp(ed) (n 66 above) 266.

<sup>75</sup>Bently & Sherman (n 37 above) 979. The Madrid Agreement was finalized in 1891 but revised in Washington on 2 Jun.1911, the Hague on 6 Nov.1925, London on 2 Jun 1934, Lisbon on 31 Oct. 1958, Additional Act of Stockholm(14 Jul.1967). There are currently 35 members of the Madrid Agreement including the UK, France and Germany.

gap that the Paris Convention had prior to its revision in Lisbon in 1958.<sup>76</sup> The Agreement also prohibits the use of non-misleading words of indications such as ‘style ‘or ‘like’, for example, champagne-style cheese’.<sup>77</sup> The revision of the Paris Convention cast doubt on the use of the Madrid Agreement.<sup>78</sup>

The Lisbon Agreement for the Protection of Appellations of Origin and their International Registration later came in to strengthen the protection appellations of origin against any misleading use and provide a forum for international registration.<sup>79</sup> The main purpose of the Agreement is to protect producers against the misuse even when the consumers may not be deceived about the nature or origin of the product.<sup>80</sup> The difference between the Madrid Agreement and Lisbon Agreement is that the former protects consumers and the latter protects producers against usurpation or imitation, even if the true origin of the product is indicated.<sup>81</sup> The Agreement also prohibits the use against translations of appellations or accompanying terms such as ‘kind’, ‘type’ ‘make’, or ‘imitation’. For example, the use of name ‘Malawian tea made in London’ is prohibited by the Agreement.

The Lisbon Agreement provides for the registration of appellations of origin at WIPO.<sup>82</sup> For a name to be placed on the international register administered by WIPO, it must first be protected in its country of origin. An application for registration at WIPO can only be made by relevant administrative agencies in the member states, who act on behalf of the group who ‘owns ‘appellation.

Therefore, it is concluded that the Paris Convention and its use of the term ‘indication of source’ is deficient because it is only interested in geographic location of the product regardless of whether such a name provides any desirable qualities. The legal rationale of the Convention, therefore, disregards the common practice of marketing of brand equity where consumers are more interested in the name as connected to certain quality or

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<sup>76</sup>Bently & Sherman (n 37 above) 979.

<sup>77</sup> G Evans & M Blakeney ‘The international protection of Geographical Indications yesterday, today, and tomorrow’ in Westkamp G (ed) (n 66 above) 267

<sup>78</sup>Bently & Sherman (n 37 above) 979.

<sup>79</sup> The Lisbon Agreement was concluded in 1958 and revised in Stockholm on 14 July 1967. The Agreement has currently 23 members.

<sup>80</sup>Bently & Sherman (n 37 above) 980.

<sup>81</sup>Bently & Sherman (n 37 above) 980.

<sup>82</sup>Bently & Sherman (n 37 above) 980.

characteristics.<sup>83</sup> The consumers are interested in the qualities attributed to the name because of satisfaction of their psychological needs.

In addition, the Paris Convention's concentration on the origin of the product itself without regard to the qualities, swayed from its legal essence and foundation which is Intellectual property. The gist of Intellectual property (IP) law is to regulate or protect the creation, use, and exploitation of mental or creative labour, thereby rewarding producers that maintain traditional high standards of quality.<sup>84</sup> This field of law establishes property protection over intangible things such as ideas, inventions, signs, and information.<sup>85</sup> Therefore, by emphasizing a consumer rather than a producer, the Paris Convention created an error in intellectual property law.

The above stated arguments are also equally applicable to regime created by the Madrid Agreement in so far as it offered protection to consumers rather than the producers. In addition, the Madrid Agreement over protects wines in so far as decisions as to whether a product has become generic is concerned. The Agreement provides that the question whether an indication has become generic is decided by member states, with exception of regional appellations for wine, which cannot be declared generic.<sup>86</sup> This is bias towards one product over the many that are important in the world.

Generally, the aforementioned multilateral agreements on geographical indications lacked not only proper legal frameworks but also failed bring divergent concepts on protection of the said rights in the world together. This contributed to their lack of force in forming a single international multilateral legal framework as they were ratified by relatively small number of countries and leaving out major trading countries like USA.<sup>87</sup>

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<sup>83</sup>P Kotler & K L Keller *Marketing management* (2009) 275- 301.

<sup>84</sup>K Das 'International protection of India's Geographical Indications with special reference to Darjeeling' Tea: (September 2006) 9 (5) *The Journal of World Intellectual Property* 460. Das quotes DR Downess & SA Laird 'Innovative mechanism for sharing benefits of biodiversity and related knowledge: Case studies on Geographical Indications and Trademarks' UNCTAD (1999) 6.

<sup>85</sup>Bently & Sherman (n 37 above) 1-2.

<sup>86</sup>Bently & Sherman (n37 above) 979.

<sup>87</sup>HC Jehoram (n 52 above) VII; G Evans & M Blakeney 'The international protection of Geographical Indications yesterday, today, and tomorrow' in Westkamp G (ed) (n 66 above) 268-269. Referring to the Madrid to USA, Germany and Italy are not members which have 35 members. The Lisbon Agreement has 17 countries as of 1996 USA not included.

### 2.3.1 The current regime for the protection of Geographical Indication in the Agreement on the Trade-Related Aspects of Intellectual Property Rights

The history of the TRIPS is tied to the fact that the World Trade Organization (WTO) and its members noted that the divergences in intellectual property regimes were contributing to trade distortion. After negotiating in the Uruguay Round from 1986 -1994, on 1 January 1995, the WTO signed the TRIPS with an idea of harmonising intellectual property regimes for to achieve predictability in trade.<sup>88</sup>

The TRIPS regime applies to all products contrary to the image painted by some jurisdictions which protect and advocate for more protection on agricultural products and foodstuffs.<sup>89</sup> Historically, the concept of geographical indications was closely referring to the notion of *terroir*, literally, “soil” or “terrain” or geographical area. However, *terroir* is now extended to comprehend the human element of the geographical environment, i.e., the skilled exercise of techniques and knowledge acquired, developed and handed down over generations.<sup>90</sup> Therefore, internationally, the language of Article 22.1 of the TRIPS shifted to also include non-agricultural products.

The Agreement requires member states to provide legal means to prevent any misleading use of a place of origin in a manner that misleads the public and as any use that amounts to an act of unfair competition within the meaning of article 10bis of the Paris Convention (1967).<sup>91</sup>

Article 22 (1) of the Agreement requires that product named after a geographic origin must have a given quality, reputation or other characteristics of the good that are essentially attributable to the geographical origin. Unlike Article 23, Article 22 of the TRIPS is limited to the extent that it does not restrict the qualified use of the term, for example, Basmati rice as Texamati rice or American basmati rice and kasmati.<sup>92</sup> The producers may accompany trademarks with expressions such as ‘kind’, ‘type’, ‘imitation’, or the like as long as the national courts of a country of registration deems that there is no deception.<sup>93</sup> Article 22 of

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<sup>88</sup> P Ramsden *A guide to intellectual property law* (2011) 14

<sup>89</sup> Mac Queen (n 57 above) 738; Bently & Sherman (n 37 above) 980.

<sup>90</sup> Ibele (n 53 above) 39.

<sup>91</sup> Bently & Sherman (n 37 above) 980.

<sup>92</sup> HV Chandola ‘Basmati rice: Geographical Indication or Mis-indication’ (2006) 9 (2) *The Journal of World Intellectual Property* 174.

<sup>93</sup> Art. 22(3) of the TRIPS.

the TRIPS recognises non geographical names that connote a geographical origin as long as they are linked to the quality, reputation and other elements there under.

Article 23 of the TRIPS provides for more protection for wines and spirits than for other products. This has been achieved by prohibiting the use of translations of geographic names even if they are true, and the use of accompanying expressions such as ‘kind’, ‘type’, ‘style’ ‘imitation’, or the like.<sup>94</sup> The member states determine also the status of homonymous names.<sup>95</sup> The member states have to determine practical conditions under which the homonymous indications in question will be differentiated from each other in view of the need not to mislead the public.<sup>96</sup> This Article takes into consideration that homonymous indications of a similar product may cause confusion. Article 23(4) of the TRIPS mandates that the TRIPS Council to enter negotiations for the establishment of a multilateral system of notification and registration for wines.

In pursuance of Article 23(4) of TRIPS, negotiations in the World Trade Organization Ministerial Conference in Doha in 2001 showed the controversial future of geographical indications when the member states presented their proposal for revising the regime. The Doha Declaration set a mandate for the negotiation of a multilateral system of notification and registrations of geographical indications for wines and spirits, and possibility of extending the higher level of protection currently given to wines and spirits under Article 23 of TRIPS to all agricultural products.<sup>97</sup> The new approach suggested in the proposal for revision of TRIPS resembles the regime in European Union.<sup>98</sup> As well observed by scholars, these proposed changes are of less benefit to Least Developed Countries, such as Malawi, due to the fact that the proposed protection does not include products originating from their regions.<sup>99</sup>

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<sup>94</sup> Article 23(2) of TRIPS; K Das ‘Socioeconomic Implications of Protecting Geographical Indications in India’ (August 2009) 9-10 [http://wtocentre.iift.ac.in/Papers/GI\\_Paper\\_CWS\\_August%2009\\_Revised.pdf](http://wtocentre.iift.ac.in/Papers/GI_Paper_CWS_August%2009_Revised.pdf), (accessed 2 February 2012)

<sup>95</sup> Bently & Sherman (n 37 above) 980.

<sup>96</sup> G Evans & M Blakeney ‘The International Protection of Geographical Indications Yesterday, Today, and Tomorrow’ in Westkamp G (ed) (n 66 above) 271-272.

<sup>97</sup> Bently & Sherman (n 37 above) 980.

<sup>98</sup> Bently & Sherman (n37 above) 980.

<sup>99</sup> Bently & Sherman (n 37above) 980 -981.

The TRIPS also envisaged a situation where trademarks and geographical indications are in conflict in so far as registration is concerned.<sup>100</sup> Article 24 provides that where a trade mark identical or similar to a GI has been applied for or registered or used in good faith before the application of these TRIPS in the member state or before the protection of the geographical indication in the country of origin, such a registration is valid and cannot be challenged. In addition, Article 24(6) of the Agreement prohibits the registration of Geographical indications which are generic or have become generic. GIs are said to be generic when they are identical to the customary names for such goods or services. In the case of wines GIs are generic when they are identical to the name of a grape variety found in a member country.<sup>101</sup> Article 24 (9) of the TRIPS exclude from protection geographical indications which are not protected or have ceased to be protected or are in disuse in the country of origin.

It is clear from the analysis above that the TRIPS Agreement offers two different levels of protection to products generally and on the other hand wines and spirits in Articles 22 and 23 respectively. Article 22 of the TRIPS only protects product generally against the use which may mislead the public or constitute an act of unfair competition; while Article 23 of the same does not require any the manifestation of confusion or likelihood of deception. The protection is automatic. Furthermore, the TRIPS does not provide legal means to protect GIs as it leaves such measures in the hands of each member state.<sup>102</sup>

#### **2.4 Regional and national regulatory frameworks for the protection of Geographical Indications: A sample study of European Union, United States of America and China**

This section will analyse how geographical indications are protected in a regional set up where several countries have harmonised their system in line of the TRIPS obligations. The European Union is the best example of a regional system that harmonised geographical indications protection in the world. On the national level the United States of America and China have different systems which are worthy studying before looking at the system in Malawi in chapter 3.

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<sup>100</sup> G Evans & M Blakeney 'The international protection of Geographical Indications yesterday, today, and tomorrow' in Westkamp (ed) (n17 above) 273-274.

<sup>101</sup> Chandola (n 92 above) 173.

<sup>102</sup> Chandola (n 92 above) 172.



### 2.4.1 The regulatory frame work for Protecting Geographical Indications in European Union

It is worth noting on the onset that the system in European Union (EU) is very extensive and complex. In the regard this study will briefly concentrate on key points that are relevant. The European Union has passed a series of laws to regulate geographical designations using different terms with different implications. European Union law regulates GIs in the category of agricultural products and foodstuffs in two ways namely: Sui generis (special) system and Community Trade Mark Regulation (CTMR) system respectively.<sup>103</sup>

The sui generis regime in EU operates in four modes. It has the protection of geographical indications for (i) wines, (ii) spirit drinks (iii) agricultural products and foodstuffs and; (iv) for agricultural products and foodstuffs for Traditional Specialities Guaranteed (TSG) respectively.<sup>104</sup> However, national laws for specific member states apply to all non-agricultural geographical indications.<sup>105</sup>

This study will not look at mode of regulating agricultural products and foodstuffs for Traditional Specialities Guaranteed (TSG) because of the similarities it has to the 3 modes that will be discussed. However, it suffices to say that the (TSG) is used to describe traditional foods and recipes registered under the traditional Specialities Regulations of 20 March 2006.<sup>106</sup> The requirements for registration are that the product must specifically express the special characters of the foodstuff or product from other similar products of the same category and that the mode of production must be traditional or established by custom.

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<sup>103</sup>GE Evans 'The Strategic Exploitation of Geographical Indications and Community Trade Marks for the Marketing of Agricultural Products in the European Union' (2010) 1 (2) *The WIPO Journal: Analysis of Intellectual Property Issues*; [www.wipo.int/about-wipo/en/wipo.../pdf/wipo\\_journal\\_1\\_2.pdf](http://www.wipo.int/about-wipo/en/wipo.../pdf/wipo_journal_1_2.pdf) (accessed 18 January 2012); The Regulation 207/2009 on the Community Trade Mark (codified version) (CMTR).

<sup>104</sup>Mac Queen et al (n 57 above) 739. Mentions all four modes of protection; W Cornish & D Llewellyn 'Intellectual Property: Patents, Copy right, Trade Marks and Allied Rights (2007) 912. Cornish and Llewellyn only mentions three modes of protection.

<sup>105</sup>Mac Queen et al (n 57 above) 739.

<sup>106</sup>Bently & Sherman (n 37 above) 978.



### 2.4.1.1 European Community Regulation number 510/2006 on the Protection of Geographical Indications and Designations of origin for Agricultural products and Foodstuffs

The protection of geographical designations in EU is governed by the Regulation 510/2006 on the Protection of Geographical Indications and Designations of Origin for Agricultural Products and Foodstuffs (GI Regulation).<sup>107</sup> There are two types of protection provided for in the Regulations.<sup>108</sup> The term ‘*protected designation of origin*’ (PDO) describes protection for designations of origin that originate in specific place, region or country and that the quality or characteristics of the product are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors. The production, processing and preparation must take place in the defined geographical area.<sup>109</sup>

The other term used in the European Union is ‘*protected geographical indication*’ or PGI. A product becomes a PGI<sup>110</sup> when it takes after a name of a region, a specific place or, in exceptional cases, a country where its specific quality, reputation, or other characteristics are attributable to<sup>111</sup> the processing, production or preparation of the product may take place in the geographical area specified.<sup>112</sup>

A PGI is similar to a PDO except that the causal link between the place of origin and the quality of the product may be a matter of reputation rather than verifiable fact.<sup>113</sup> PGI differs from a PDO in that in so far as the latter is concerned all production, processing, and preparation need to take place in the named geographic area.<sup>114</sup> Processing, preparation or production of a PGI may take place in another area.<sup>115</sup>

After registration protection accorded to PGI or PDO is automatic to all member states. Geographical indications from third countries may be registered, although they do not come

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<sup>107</sup>Bently & Sherman (n 37 above) 981.

<sup>108</sup>Bently & Sherman (n37 above) 978.

<sup>109</sup>Bently & Sherman (n37 above) 978.

<sup>110</sup>Bently & Sherman (n 37 above) 982.

<sup>111</sup>Bently & Sherman (n 37 above) 978.

<sup>112</sup>Bently & Sherman (n 37above) 983.

<sup>113</sup>Bently & Sherman (n37 above) 982.

<sup>114</sup>Mac Queen et al (n 57 above) 741.

<sup>115</sup>Mac Queen (n 57 above) 741: Bently & Sherman (n 37 above) 984.

from a country with a system similar to the Regulations.<sup>116</sup> It is a requirement for registration that the product must have special characteristics distinguishing it from other products. Specifications of a product provide criteria for determining the success of registration because they demarcate the ambit of protection and the identity of the product. In addition, Article 5 of the Regulations stipulates that after registration any subsequent producer and processor must comply with the set out standards therein.<sup>117</sup>

The law also allows the registration of geographical designations which cross geopolitical borders. Applicants from several member states within a geographical area where a product comes from may initiate a joint application that extends beyond a single member state. To speed the resolution of disputes of geographical boundaries the jurisdiction over such cases lays with national courts not the European Court of Justice.<sup>118</sup>

The gist of Article 8 (2) of GI Regulation 510 /2006 is the requirement<sup>119</sup> that the registered product should bear an appropriate associated label to show that it is a geographical design and the qualities or the reputation from a designated area. The specification must clearly distinguish the product and link it to the geographic area.<sup>120</sup>

The process of registration involves applicants submitting application forms to a relevant national agency which examines the same in light of the criteria explained above. The agency sends the application for the final approval of the Commission. The Commission examines the application in light of requirements under Article 4 of the GI Regulation 510/2006. Upon approval the Commission publishes a summary of the specifications of the product in the Official Journal of the European Communities thereby opening a period of six months within which any objections may be raised against registration for non-compliance with Article 2 of the GI Regulation 510/2006.<sup>121</sup> In the absence of any objection the Commission then publishes the application in the Official Journal confirming that geographical indication has

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<sup>116</sup>Bently & Sherman (n 37 above) 982.

<sup>117</sup>Bently & Sherman (n 37 above) 985.

<sup>118</sup>Bently & Sherman, (n 1 above) 985. *Carl Kuhne ( and others ) v JutroKonservenfabrik , Case C 269/99 [2001]ECRI-9517 (ECJ)* it was held that decisions as to whether boundaries were to be drawn in relation to the PGI was not a matter for ECJ but for the German courts. This case involved boundary of a PGI called Spreewald gherkins. See Bently & Sherman, (n 37 above) 985.

<sup>119</sup>Bently & Sherman (n 37 above) 984.

<sup>120</sup>Bently & Sherman, (n 37 above) 986.

<sup>121</sup>Bently & Sherman (n 37 above) 986.

been registered. If there are any objections the EU Regulatory Committee is involved to resolve the matter in accordance with Article 7(5) and confirmation is pending.

The examination depends on whether it would be a fair practice to register the same or it would lead to actual or likelihood of confusion. Upon the successful resolution of the matter in favour of registration the application is entered into a register of protected Designation of origin and Protected Geographical Indications at the Commission. Lastly a publication in the Official Journal is made again as indicating the registered name.<sup>122</sup>

The nature of GI Regulations in EU is such that the rights are not to any particular individuals or a specific group; it is an abstract group. The rights are for anyone whose products meet the prescribed geographic and qualitative characteristics.

In EU there is a distinction between the registration of the name and the agricultural product or foodstuff to which the name applies.<sup>123</sup> In terms of names, one can only register ‘*Geographic names*’, therefore, fictitious and invented names are cannot be registered. However, traditional non-geographical names designating an agricultural product foodstuff originating in a region or a specific place are considered as designation of origin. For example ‘feta’ is a geographic name which does not represent any real place.<sup>124</sup>

The names must not be generic.<sup>125</sup> A name is generic when it has become a common name of, or the term commonly used to describe an agricultural product of foodstuff. Generic name offers the public no connection of a product to a specific geographical place. A name may lose its uniqueness although originally it related to a specific place there by becoming generic.<sup>126</sup> Registration of a geographic name that includes a generic name is allowed in so far as the new name is distinctive.<sup>127</sup> The determination of whether a name is generic is circumstantial depending on the place of origin, where the product is consumed, how it is viewed in other member states, the relevant national and community laws involved.<sup>128</sup> Article 13 of the Regulations provides that once a name is registered it cannot become generic.

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<sup>122</sup>Bently & Sherman (n 37 above) 988.

<sup>123</sup>Bently & Sherman, (n 37 above) 989.

<sup>124</sup>MacQueen (n 57 above)741. For example ‘Feta’ which means in Latin ‘to slice’ does not designate any geographic place but is registered under Article 2(3) as a traditional non- geographic name.

<sup>125</sup> Article 3(1) of the GI Regulation 510/2006

<sup>126</sup>Mac Queen et al (n 57 above) 742.

<sup>127</sup>Bently & Sherman (n 37 above) 990.

<sup>128</sup>Bently & Sherman (n 37 above) 991.

Homonymous names which are already registered at national level may be registered in EU. Homonymous names are names that are spelt or pronounced in the same way.<sup>129</sup> There must be a clear distinction between the name already existing in the register and the subsequent name or homonymous name. Article 3(3) (a) of the GI Regulation 510/2006 provides that the homonymous name must not affect the preceding producer unfairly or it must not mislead the consumers. The subsequent name can only be registered if it will not cause confusion and infringe the existing traditional usage of the words.

Dual protection of geographic names as geographical designation and trademarks is prohibited. Article 1 (1) of the GI Regulation 510/2006 provides that it is not allowed to register a renowned or reputable trade mark which has been used for a long time and which may mislead consumers as to the identity of the product as a geographical designation or indication.

#### **2.4.1.2 European Union regulatory framework for the protection of wines as Geographical Indication**

Wines bearing geographic names are protected by EC Regulation number 1234/2007, which incorporates EC Regulation number 479/2008.<sup>130</sup> Article 118 of the Council Regulation 1234/2007 together with its implementing rules have been defined in Commission regulation (EC) number 607/2009 of 14 July 2009 which establishes a Common Agricultural Markets Organization (CMO). The EC Regulation number 607 of 2009 specifically provides rules for certain agricultural products and wines registered therein.<sup>131</sup> GI wines from third countries may be registered therein or protected through bilateral agreements.<sup>132</sup> The duty to enforce the protection of wines is on the member states.

The definition of GI in wines regime is different from the GI Regulation 510/2006 for agricultural products and foodstuffs. Article of 118b of Regulation 1234/2007 modifies the

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<sup>129</sup>Bently & Sherman (n 37 above) 991.

<sup>130</sup> D Thual & F Lossy 'Q&A Manual European Legislation on Geographical Indications' 8 February 2011 11 [www.ipr2.org](http://www.ipr2.org) or [http://www.ipr2.org/storage/Q&A\\_Manual\\_European\\_legislation\\_on\\_GIs1013.pdf](http://www.ipr2.org/storage/Q&A_Manual_European_legislation_on_GIs1013.pdf) (accessed 18 January 2012). See consolidated version of Regulation 1234/2007 dated 1 January 2011 <http://eur-ex.europa.eu/LexUriServ/LexUriServ.do?uri=CONSLEG:2007R1234:20110101:EN:PDF/2007> and See also , consolidated version of Regulation 479/2008 dated 7 February 2.2009 <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=CONSLEG:2008R0479:20090207:EN:PDF>

<sup>131</sup>Thual&Lossy (n 130 above) 11.

<sup>132</sup>Thual&Lossy (n 130 above) 11.

two definitions of Protected Designation of Origins or Designation of origin (PDO), and Protected Geographic Indications or Geographical Indication (PGI) to fit in the wine sector. Therefore, the definition of PDO or Designation of origin among other elements states that the grapes from which the wine comes must exclusively be from the specified geographical area and the vine varieties must belong to *Vitisvinifera*.<sup>133</sup> It is also required that production, processing and preparation takes place in the designated geographical area.

Geographical indication or PGI in terms of wines includes the ordinary elements, but for the extension to the fact that the wine should have at least 85% of the grapes used for its production come exclusively from this geographical area. The wine must also be obtained from vine varieties belonging to *Vitisvinifera* or a cross between the *Vitisvinifera* species and other species of the genus *Vitis*.<sup>134</sup> Production, processing and preparation must strictly be from the specified geographic area.

#### **2.4.1.3 European Union regulatory framework for the protection of spirits as Geographical Indication**

The spirit drinks which are geographical indications are protected by the EC Regulation number 110/2008.<sup>135</sup> Annex III of Regulation 110/2008 provides for the protection of wines and spirit drinks which are specifically listed there under as geographical indications. The Annex III also specifies the registration procedures for the protection of GIs for spirits at the European level which differs significantly from the registration procedure for wines and other agricultural products.<sup>136</sup>

Unlike the European Regulations on GIs for agricultural products and foodstuffs (Regulation 510/2006) and for wines (Regulation 1234/2007), Regulation 110/2008 for the protection of spirits does not differentiate between PDO and PGI. The definition in Article 15 of Regulation 110/2008 includes geographic place, specifications of quality or reputation. The name and qualities must be attributable to the geographic place.

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<sup>133</sup>Thual&Lossy (n 130 above) 12-13.

<sup>134</sup>Thual&Lossy (n 130 above) 12-13

<sup>135</sup>Thual&Lossy (n 130 above) 12. See consolidated version of Regulation 110/2008 dated 20.1.2009

<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=CONSLEG:2008R0110:20090120:EN:PDF>

<sup>136</sup>Thual&Lossy(n 130 above) 12-13.

Thual and Lossy provide the differences in the agricultural and foodstuff regime, wine and spirit regimes in so far as PDO and PGI are concerned.<sup>137</sup> Generally, PDOs and PGIs differ because for PDOs, the raw materials must come from the defined geographical area. There is no such rule for PGIs (or GIs for spirits), except for wines as PGIs that at least 85% of the grapes used for its production must come exclusively from the specified geographical area that the other 15% should come from the same EU member state. This means that 100 % of the grapes are required for PDOs to come from the specified geographic area. Unlike PDOs, PGIs (or GIs for spirits) are not essentially required to have an exclusive link between the specific quality, reputation or other characteristics and the geographical origin. Therefore, the PGI must be merely “attributable to that geographical origin. Thirdly, as far as the agricultural product or foodstuffs which are GIs are concerned, PGIs only need one of the three stages - production, processing or preparation - to take place in the defined geographical area, whereas for PDOs all stages must take place in the defined geographical area. This rule does not apply to the wine sector as production must take place in the geographical area of origin for both PDOs and PGIs.

There is no requirement for logos to be placed on wines and spirit GIs. However, under GI Regulation 510/2006 for Agricultural products and foodstuffs it is imperative for products there under to have logos.<sup>138</sup> Furthermore, logos are optional in wines.

The procedure for registering wines is similar to that of all other agricultural products and foodstuffs.<sup>139</sup> There is a national phase which applicants must follow before registering at EU level. On the other hand, spirits drinks are registered directly at EU level. Products from third countries falling in these categories are registered directly at the EU level on condition that they are registered in the country of origin.<sup>140</sup> The underlying point is that all applicants must specify the geographic area, the methods of production and the uniqueness of their products.

All regulations for GIs in EU prohibit the registration of names that are generic or common name in light of the meaning provided for in the Regulation 510/2006 (GI regulation). Homonymous names are allowed to the extent that they do not mislead the public and taking into account the traditional usage of the name.<sup>141</sup> In circumstances where there is a registered GIs in any category and unregistered of the same sort, the law allows for the co-existence of

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<sup>137</sup>Thual & Lossy (n 130 above) 15.

<sup>138</sup>Thual & Lossy (n 130 above) 20.

<sup>139</sup>Thual & Lossy (n 130 above) 22- 27.

<sup>140</sup>Thual & Lossy (n 130 above) 30-32.

<sup>141</sup>Thual & Lossy (n 130 above) 37.

the two. However, the unregistered product is allowed to exist for a period of 15 years, if it was in use 25 years before 24 July 1993.<sup>142</sup>

#### **2.4.1.4 The protection of Geographical Indication under the European Union Trademark Law**

The Community Trade Mark Regulation 207/2009 (CTMR) is a unitary right providing registered trade mark protection throughout the European Union.<sup>143</sup> The CTMR is next and parallel to all national trademark laws in EU. Therefore, prior rights in national systems may prevent the registration of a Community trademark.<sup>144</sup> The right is renewable at 10-year intervals, indefinitely, while the mark continues use.<sup>145</sup>

CTMR defines a geographic name as a source of the product as originating from a particular undertaking; while the sui generis GI regime describes geographical indication as an agricultural product that originates in a specific place from which its reputation is derived.<sup>146</sup> Both CTMR and the sui generis regime are meant for agricultural products although the list of permitted products in the CTMR is very wide.<sup>147</sup>

The advantage of the Community trademark system is that any natural or legal person can apply for registration.<sup>148</sup> Secondly, the applications may be filed either through the Trade Mark Registry of an EU member state or directly at the Office for Harmonization in the Internal Market (OHIM). The disadvantage is that applications are easily challenged; consequently, applicants are likely to spend more resources on litigation. This challenge stems from the trade mark law's presumption that geographical names are prima facie descriptive, therefore, available for the use to other traders throughout a single market.<sup>149</sup> Hence, the applicant has to provide absolute distinctiveness on the onset to avoid

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<sup>142</sup>Thual & Lossy (n 130 above) 38.

<sup>143</sup>TC Jehoram et al *European Trademark Law; Community Trademark Law and Harmonized National Trademark Law* (2010) chap 14 para 14.1.1.

<sup>144</sup>TC Jehoram (n 143 above) 14 para 14.1.2.

<sup>145</sup>Evans (n 103 above) 160.

<sup>146</sup>Evans (n 103 above) 161.

<sup>147</sup>Evans (n 103 above) 167.

<sup>148</sup>Evans (n 103 above) 161.

<sup>149</sup>TC Jehoram et al (n 143 above) para 18.1; Evans (n 103 above) 166. Art.4 (1) (c) of the CTMR prohibits the registration of trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the geographical origin of the goods.



legal opposition.<sup>150</sup> CTMR like the sui generis Regulations prohibit the registration of geographical names that have become generic.<sup>151</sup>

The distinctiveness of geographic name must be within the meaning of the trademark as a sign that is “capable of distinguishing the goods or services of one undertaking from those of other undertakings”.<sup>152</sup> In order to identify the undertaking, a trade mark must acquire a secondary meaning that renders it distinctive of the business.

There is no need to define the linkage or the designated area.<sup>153</sup> The trademark geographical indication is independent of any link between the product and its geographical origin. This is an alternative to the sui generis regimes in terms of applications whose reputation fails to be linked to the geographic area.

There is an exception to the rule prohibiting the registration of names of goods or services which are descriptive and fail to be distinctive. This provides another way in which a geographic name may become a trademark. The condition is that the name must acquire distinctiveness through use in the course of trade.<sup>154</sup>

The CTMR provides for the registration of geographic names as community collective mark.<sup>155</sup> The Community collective mark may be used to overcome the problem of geographical descriptiveness. The law allows community collective marks to be used as signs that serve to designate geographical origin because these marks are demarcated by membership of the association which owns them, but not by defined area of land.<sup>156</sup>

#### **2.4.1.5 Protection of non- agricultural products in European Union**

Much as agricultural products and food stuffs or beverages are emphasized in EU there is a segment of GIs, which is very important to other countries which do not produce agricultural geographical indications. Non-agricultural products that enjoy GI protection typically include

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<sup>150</sup>Evans (n 103 above) 161-162.

<sup>151</sup>Evans (n 103 above) 172.

<sup>152</sup>Evans (n 103 above) 166.

<sup>153</sup>Evans (n 103 above) 165.

<sup>154</sup>Article 7(3) states “Paragraph 1(b), (c) and (d) of the CTMR. See Evans (n 103 above) 166 ;

<sup>155</sup>TC Jehoram (n 143 above) para 18.1.

<sup>156</sup>Evans (n 103 above) 167. Article 66 of the CTMR.



handicrafts, jewellery and textiles.<sup>157</sup> However, in EU it is national laws for specific member states that apply to all non-agricultural geographical indications and not the EU regulations.<sup>158</sup>

Although there is no regulation so well organized like that of agricultural GIs, protection of non- agricultural GIs at the EU level may be said to be in the Community trade mark (CTMR). This regime allows for the protection of geographical names under certain conditions, however, it is largely applies to agricultural products.<sup>159</sup>

A study by the European Union Commission on the position of the protection of non-agricultural products under GIs regime in EU and other five third countries namely: Brazil, China, India, Russia and Switzerland,<sup>160</sup> showed that producers of the afore said category in EU are better protected under the trademark route.<sup>161</sup> The study showed that India and Russia have a well elaborate sui generis protection for non-agricultural products.<sup>162</sup> Furthermore, it was reported that China has both the sui generis and trademark types of protection for GIs that encompassed non-agricultural products<sup>163</sup>

#### **2.4.1.6 Concluding remarks on the European Union regulation of Geographical Indications.**

The sui generis GI protection in EU is supreme to the Community Trademarks system because the latter does not prohibit the registration of product with expressions ‘type’, ‘like’ or translations.<sup>164</sup> When there are conflicts in terms of priority GIs in the sui generis regime may challenge the registration of the Community trademarks unless the latter are well-known marks that using them as GIs would mislead the public.<sup>165</sup> When a GI Regulation registered name is registered first, the trademark GI cannot be registered or if it happens so, the trademark can be revoked upon the application of the GI Regulation right

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<sup>157</sup> K Das (n 84 above) 460.

<sup>158</sup> Mac Queen (n 57 above) 739.

<sup>159</sup> Directorate General for Trade of the European Commission ‘The study on the protection of Geographical Indications for products other than wines, spirits, agricultural products or foodstuffs’ November 2009 2 [http://trade.ec.europa.eu/doclib/docs/2009/december/tradoc\\_145630.pdf](http://trade.ec.europa.eu/doclib/docs/2009/december/tradoc_145630.pdf) ( accessed 30 January 2012)

<sup>160</sup> Directorate General for Trade of the European Commission (n 159 above) 3.

<sup>161</sup> Directorate General for Trade of the European Commission (n 159 above) 5.

<sup>162</sup> Directorate General for Trade of the European Commission (n 159 above) 5.

<sup>163</sup> Directorate General for Trade of the European Commission (n 159 above) 5.

<sup>164</sup> Evans (n 103 above) 176.

<sup>165</sup> Evans (n 103 above) 176.

holders.<sup>166</sup> However, a GI Regulation registered geographic name may be registered to co-exist with a CTMR GI if the same is done honestly.<sup>167</sup>

The international perspective of system in EU is that it is solely based on agricultural stuff on which it has produced for a very long time and wishes to protect. The system appears to be tailor made to suit EU interests to the annoyance of other countries. This is evident by difficulties in concluding the TRIPS discussion under the Doha Round negotiation.<sup>168</sup> Therefore, the main lesson behind EU's regime is that each country should have a system that suits it best while taking into account the TRIPS obligations to harmonise national laws to the international standards.

## 2.4.2 The Geographical Indications regime in United States of America

### 2.4.2.1 Introduction

The law in the United States of America does not single out geographic denominations for any special form of protection.<sup>169</sup> The protection of geographical indications in US stems from a collection of unrelated laws and regulations.<sup>170</sup> The laws are premised on the need to protect consumers from confusion and deception.<sup>171</sup> The most important of the set of laws that govern the geographical indications are the Federal trademark laws and the Lanham Trademark Act of 1946 as amended (the 'Lanham Act').<sup>172</sup>

The USA has opposition to the sui generis protection of GIs, but rather protects geographical indication through the trade mark law.<sup>173</sup> The United States Patent and Trademark Office

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<sup>166</sup>Evans (n 103 above) 176.

<sup>167</sup>Evans (n 103 above) 176-177.

<sup>168</sup> D Vivas-Eugui & C Spennemann 'The evolving regime for the Geographical Indications in WTO and in Free Trade Agreements' in CM Correa & AA Yusuf (eds) *Intellectual property and international trade: The TRIPS Agreement* (2008) 209.

<sup>169</sup> JT McCarthy 'United States law of Geographic Denominations' in HC Jehoram *Protection of Geographic Denominations of goods and services*, (1980) vol 3 149.

<sup>170</sup>L Bandekgay & CH Mead 'International protection of Appellations of Origin and other Geographic Indications' (September – October 1992) 82 (5) *The Trademark Reporter* 767.

<sup>171</sup>McCarthy 'United States law of Geographic Denominations' in HC Jehoram (n 169 above) 149.

<sup>172</sup>Bandekgay & Mead (n 170 above) 767.

<sup>173</sup> BH Malkawi 'The Intellectual Property Provisions of the United States -Jordan Free Trade Agreement: Template or Not Template' (March 2006) 9 (2) *The Journal of World intellectual property* 215.

(USPTO) process applications for both trademarks and GIs since there is no distinction of processes.<sup>174</sup> This is a governmental authority regulating the trademark system.

The law provides that a mark serves to identify goods or services emanating from a single business source.<sup>175</sup> The subsequent sub sections will discuss in a more elaborate way the distinction between different marks regulating the use of geographical indications.

#### **2.4.2.2 The Regulation of Geographic Indications through Trademarks, Service marks and Composite marks in USA.**

The United States of America did not historically place cultural or economic importance on GIs. Many GIs developed as generic terms when early European immigrants came to the USA. The USA is hostile to GIs because they provide protection indefinitely, and it believes that no one can obtain an exclusive right to use geographic name to preclude others from using the geographical term.<sup>176</sup> An example of a GI which is registered as a trademark in USA is Darjeeling tea.

The Lanham Act defines a trademark as follows:<sup>177</sup>

The term 'trademark' includes any word, name symbol, or device, or any combination thereof (1) used by a person ... (2) ...to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods....

A service mark is similar to trademark and refers to the source of services rather than goods. There is a contrast between trademarks or service marks and geographical indications. Trademarks identify a single, sometimes anonymous business as the source of the product for which it is used, while the latter communicates something about the geographic origin of the product that any consumer may understand that the product may emanate from any business

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<sup>174</sup> United States Patent and Trademark Office 'Geographical Indication protection in the United States' 1, [http://www.uspto.gov/web/offices/dcom/olia/global/pdf/gi\\_system.pdf](http://www.uspto.gov/web/offices/dcom/olia/global/pdf/gi_system.pdf) (accessed 31 October 2011).

<sup>175</sup> Bandekgay & Mead (n 170 above) 765.

<sup>176</sup> Malkawi (n 173 above) 215; Bandekgay & Mead (n 170 above) 768.

<sup>177</sup> Ibele (n 53 above) 42-48. See Lanham Act (1946), 15 U.S.C. 1051

within the specified region.<sup>178</sup> Geographical indications or appellation of origins go beyond mere source by indicating qualities of the product or its reputation as connected to the origin.

Section 2 (e) (2) of the Lanham Act<sup>179</sup> provides that a geographic term may be registered under certain circumstances when it functions as a trademark. The law, however, prohibits the registration of marks which were primarily geographically descriptive.<sup>180</sup> Therefore, GIs are trademarks and afford proprietary rights to persons who use word, names, symbols, or devices to identify their goods or services. In a nut shell, GIs must acquire secondary meaning sufficient to qualify for trademark or services mark protection. This is similar to the provisions of CTMR in Europe.

It is a trademark policy in US that consumer perceptions determine the distinction between a word, name, symbol, or device that serves as a trademark or one that serves as geographical indication or appellation of origin but not as trademark.<sup>181</sup> GIs which do not indicate a single business source but a general geographic area as generic geographic terms are not protected in US even if they are internationally protected.<sup>182</sup>

Acquisition of secondary meaning also means that the applicant of a GI must prove that the consumers do not perceive the product as indicating a source of origin, but as a trademark through a continuous and substantially exclusive use of the indication mark.<sup>183</sup> The applicant must also show that the use of the geographic indication apart from being a trademark is not creating confusion, mistake or deception to consumers.<sup>184</sup>

Geographically descriptive marks may be registered without having a secondary trademark meaning when incorporated in composite mark which contain other non-descriptive elements.<sup>185</sup> The requirement in this case is that the composite name must be viewed as whole to be non-descriptive, for example, the name ‘American girl’.<sup>186</sup>

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<sup>178</sup>Bandekgay & Mead (n 170 above) 768.

<sup>179</sup>Bandekgay & Mead (n 170above) 768.

<sup>180</sup>Bandekgay & Mead (n 170 above) 768. See The Lanham Act 15 USC.1052 (e) (2)

<sup>181</sup>Bandekgay & Mead (n 170 above) 769.

<sup>182</sup>Bandekgay & Mead (n170 above) 769. See also section 2(e) of the Lanham Act.

<sup>183</sup>Bandekgay & Mead (n170 above) 770. Lanham Act 15 USC. 1052 (f).

<sup>184</sup>Bandekgay & Mead (n 170 above) 770-771.

<sup>185</sup>Bandekgay & Mead (n170 above) 771.

<sup>186</sup>McCarthy ‘United States law of Geographic Denominations’ in HC Jehoram (n 169 above) 152. In the case of *Hamilton-Brown Shoe Co. v Wolf Bros. & Co.*, 240 US 251,60 Led629, 36 S Ct 269 (1916) the name ‘American girl’ was held to be an appropriate composite mark comprising a GI.

The other category of prohibited marks are those which are ‘primarily geographically deceptively mis-descriptive’ or deceptive.<sup>187</sup> A geographic term that describes the origin inaccurately is cannot registered. This extends to a composite mark which refers to a product as originating from a place which is not true. This is because the name becomes primarily geographically deceptive and mis-descriptive. However, the exception to the rule is when such a geographic term is inaccurate and arbitrarily referring to a place of origin.<sup>188</sup> For example, to refer a name as ‘Malawian homemade cheese’ when it is made in Russia is a geographically mis-descriptive.<sup>189</sup> Another example is ‘Dutch’ when used for paint may be registered as an arbitrary name, but if used for cheese for which Holland is known for it is not registered.<sup>190</sup>

Geographic indications which have become or are generic are not registered in US as they do not indicate any specific product.<sup>191</sup> The name becomes generic when the owner of the geographical indication fails to prevent others from using the term for other goods or services not necessarily originating from the region suggested by the geographic indication. The federal registration of generic terms may be cancelled at any time.<sup>192</sup> Therefore, such generic names or signs are not protected as geographic terms or signs any producer is free to use the designation for its goods or services.<sup>193</sup>

The law in US also uses certification and collective marks to regulate the use of geographical indications. Generally, there is a vocabulary problem in terms of certification marks and collective marks since in some jurisdiction the two terms are used as being one and having the same meaning.<sup>194</sup> In US the two have different meanings. Collective marks refer to marks which identify members of an organization with standards for admission while certification marks do not indicate that sellers or makers belong to any organization, only that the product meets certain standards.<sup>195</sup>

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<sup>187</sup> Bandekgay & Mead (n170 above) 771.

<sup>188</sup> Bandekgay & Mead (n170 above) 771.

<sup>189</sup> Bandekgay & Mead (n 170 above) 771.

<sup>190</sup> McCarthy ‘United States law of Geographic Denominations’ in HC Jehoram (n 169 above) 151.

<sup>191</sup> Bandekgay & Mead (n 170 above) 774.

<sup>192</sup> McCarthy ‘United States law of Geographic Denominations’ in HC Jehoram (n 169 above) 181.

<sup>193</sup> United States Patent and Trademark Office (n 174 above) 1.

<sup>194</sup> G Kunze & F Gevers ‘Reports and Additional Comments on Geographical Indications’ (September – October 1992) 82 (5) *The Trademark Reporter* 1002.

<sup>195</sup> AL Fletcher & DJ Kera ‘Articles and Reports on the Forty Fourth Year of Administration of the Lanham Act Trademark Act of 1946’ (November – December 1991) 81 (6) *The Trademark Reporter* 729.

Certification marks are different from trademarks both in nature and purpose in so far as they relate to Geographical designations. However, Trademarks and certification marks are mutually exclusive in that if a mark is a trademark, it cannot be registered as a certification mark.<sup>196</sup> Certification marks are the most effective way of protecting geographical indication in United States.<sup>197</sup> Ibele summarizes the definition of a certification mark under section 45 of the Lanham Act as:<sup>198</sup>

... any word, name, symbol or device, or any combination thereof (1) used by a person other than its owner, ... (2) ... to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods ....

The difference between certification marks and other marks in so far as geographical designations are concerned is that a certification mark is not owned by the owner.<sup>199</sup> Secondly, certification marks do not identify a particular business source, rather they certify to consumers that products bearing the mark share certain characteristics and or come from a common geographic location.<sup>200</sup> Unlike trademarks which when descriptive are prohibited, certification marks are essentially descriptive and are lawfully registered. Certification marks do not require obtaining a secondary meaning prior to registration.

The purpose of certification marks is to preserve the freedom of all persons in the region to use the term; and to prevent abuses or illegal uses of the marks to the detriment of person entitled to use the same. The Government directly or through a body is the one which enforces the rights as against third parties.<sup>201</sup>

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<sup>196</sup>McCarthy 'United States law of Geographic Denominations' in HC Jehoram (n 169 above) 157.

<sup>197</sup>Bandekgay & Mead (n 170 above) 776.

<sup>198</sup>Ibele (n 53 above) 42; JT McCarthy 'United States law of Geographic Denominations' in HC Jehoram (n 169 above) 157.

<sup>199</sup>Bandekgay & Mead (n 170 above) 776.

<sup>200</sup>Bandekgay & Mead (n 170 above) 776.

<sup>201</sup>Bandekgay & Mead (n 170 above) 777.

### 2.4.2.3 Other forms of legal protection for Geographical Indications in United States.

Bandekgay and Mead provide a summary of laws that protect GIs in US since the laws are numerous.<sup>202</sup> Firstly, most states in US have statutes and common law principles which prohibit the use of false and misleading statements in connection with goods or services.<sup>203</sup> It is also unlawful to use deceptive designation of origin for goods and services since it amounts to unfair competition.<sup>204</sup>

Secondly, the Country of Origin Labelling Requirements Service and the Federal Trade Commission (FTC) which requires all goods imported into US to have description of country of origin. The label must be indelible and permanent on a conspicuous place in English.<sup>205</sup> Other administrative bodies have also regulations that govern transactions concerning geographical indications such as food, drugs or wines.<sup>206</sup>

Internationally, the United States is a party to International Convention for the Protection of Industrial Property under which it has an obligation to protect all trade names and commercial names from third countries without the obligation of registration.<sup>207</sup> Therefore, geographic denominations from foreign countries are protected as domestic products.<sup>208</sup> United States is not a party to the Lisbon Agreement for the protection of Appellations of Origin and Their Registration and the Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods.<sup>209</sup> The reason is that these agreements take away the power of courts to declare appellations of origin generic.<sup>210</sup>

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<sup>202</sup>Bandekgay & Mead (n 170 above) 777.

<sup>203</sup>Bandekgay & Mead (n 170 above) 777. See The Californian Business and professions Code, section 17500. It prohibits the use of untrue and misleading statements.

<sup>204</sup>McCarthy 'United States law of Geographic Denominations' in HC Jehoram (n 169 above) 160.

<sup>205</sup>Bandekgay & Mead (n 170 above) 778; McCarthy 'United States law of Geographic Denominations' in HC Jehoram (n 169 above) 163. The Tariff Act 19 CFR: 134.0-134.55.

<sup>206</sup>Bandekgay & Mead (n 170 above) 778-779.

<sup>207</sup>McCarthy 'United States law of Geographic Denominations' in HC Jehoram (n 169 above) 172.

<sup>208</sup>McCarthy 'United States law of Geographic Denominations' in HC Jehoram (n 169 above) 172.

<sup>209</sup>Bandekgay & Mead (n 170 above) 781-782.

<sup>210</sup>McCarthy 'United States law of Geographic Denominations' in HC Jehoram (n 169 above) 173.



#### 2.4.2.4 Conclusion

It is observable that the regulation and protection of geographical indications in US is purely a trademark system. There is no distinction between the other devices used as marks and geographic names. Therefore, any mark can become generic in so far as the consumers and courts deem it so. This is why internationally the US is in opposition to the European Union proposal of a Sui generic system where geographical indications are made superior to trademarks. However, the trademark system in US is similar to the CMTR in the European Union countries.

### 2.4.3 Legal protection of Geographic Indications in China

#### 2.4.3.1 Introduction

The laws in China are Chinese; therefore, the subsequent discussions have been based on commentaries and translations of other scholars on the matter. The history of GIs in China is recent, however much has been done to fulfil its international obligations in protecting the same.<sup>211</sup> However, the wind of change to have intellectual property laws that are pro-international trade came in China with the joining of the WTO in 2001.<sup>212</sup>

China has two main systems of protecting GIs.<sup>213</sup> It has both the sui generis and trademark protection for GIs.<sup>214</sup> However, there is a third way of protecting GIs which was established in 2008 to protect raw agricultural products including GIs.<sup>215</sup> The state, through public authorities, is responsible for the policing and ensuring GI protection. However, in the trademark system protection is only offered to producers who request for protection from the public authority.<sup>216</sup> The public authorities are the Department of Quality Supervision,

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<sup>211</sup>BM Bashaw 'Geographical Indications in China: Why Protect GIs with both Trademark Law and AOC-Type Legislation?' 17(1) *The Pacific Rim Law & Policy Journal* 74 <http://digital.law.washington.edu/dspace-law/bitstream/handle/1773.1/566/17PacRimLPolyJ73.pdf?sequence=1> (accessed 2 February 2012)

<sup>212</sup>A Endeshaw 'Intellectual Property in Asian Emerging Economics, Law and Policy in the Post-TRIPS Era: A Review of Intellectual property in China' (2010) 43 -56; See also G Wang 'Application of geographical indication systems in China: Jinhua ham case study: Case study on quality products linked to geographical origin in Asia' 5 <http://www.foodquality-origin.org/documents/JinhuaHam.pdf> (accessed 2 February 2012)

<sup>213</sup>Directorate General Trade of European Commission (n 159 above) 5.

<sup>214</sup>Bashaw (n 211 above) 73.

<sup>215</sup>Thual & Lossy (n 130 above) 18.

<sup>216</sup>Commission of the European Communities 'Protection of Geographical Indications in 160 countries around the world': Part II of the Report on 'Geographical indications and TRIPs: 10 Years Later...A roadmap for EU



Inspection, and Quarantine; the State Administration of Industry and Commerce;<sup>217</sup> and the Ministry of Agriculture (MOA).<sup>218</sup>

#### **2.4.3.2 The Sui Generis law for the protection of Geographical Indications in China**

The sui generis regime is provided for in the Regulation on Protection of Products of Geographical Indications which was issued on 7 June 2005, and came into force on 15 July 2005. The application of this regulation is supervised by State under the department of Administration of Quality Supervision, Inspection and Quarantine (AQSIQ).<sup>219</sup>

The sui generis regime in China regulates all products whether agricultural or non-agricultural but does not include services. Examples of non-agricultural products registered there under are: Dehua porcelain (2006, Fujian Province), Zhenjiang vinegar (2001, Jiangsu Province), Zizhou astragalus root (2008, Shanxi Province) and Puer tea (2008, Yunnan Province).<sup>220</sup> Article 2 of decree (no. 78) of June 2005 which promulgates ‘Regulations for the protection of geographical indication products’ defines geographical indication as the EU legislation but for the inclusion of the fact the GIs must be produced by traditional methods.<sup>221</sup>

The registration under this regime starts with an application filed with the General Administration of Quality Supervision, Inspection and Quarantine (AQSIQ) where approval or the registration for protection must be obtained. The district and local government administration systems where the GIs come from are also used in the process to verify their existence. The applicant is required to furnish the specification with standards of production and management norms. These specifications are similar stipulated in the EU Regulations on GIs.<sup>222</sup> The registration procedure has sections (i) Application for registration; (ii) Formal and substantial examination of the application; (iii) Publication of the decision to grant a protection title to a GI or refusal of application. Therefore, AQSIQ does not only provide

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GI holders to gain protection in other WTO Members’ 38 [trade.ec.europa.eu/doclib/html/135089.htm](http://trade.ec.europa.eu/doclib/html/135089.htm) or [www.camaras.org/publicado/europa/pdf/tradoc\\_135089.pdf](http://www.camaras.org/publicado/europa/pdf/tradoc_135089.pdf) (accessed February 2012).

<sup>217</sup>Commission of the European Communities (n 216 above) 41.

<sup>218</sup>G Wang ‘Application of geographical indication systems in China’: Jinhua ham case study: Case study on quality products linked to geographical origin in Asia’ 6 <http://www.foodquality-origin.org/documents/JinhuaHam.pdf>. (accessed 2 February 2012)

<sup>219</sup>Commission of the European Communities (n 216 above) 38.

<sup>220</sup>Wang (n 218 above) 8.

<sup>221</sup>Wang (n 218 above) 8.

<sup>222</sup>Commission of the European Communities (n 216 above) 39.

legal protection, but also enhances product quality by supporting research and improved technology. AQSIQ also helps producers to seek market opportunities.<sup>223</sup>

The regulations outline for mechanisms for opposing registration. The objections must be raised within two months after the publication of acceptance of application by the AQSIQ. The AQSIQ organizes an expert committee to conduct technical examinations over the opposition applications.<sup>224</sup>

Geographical indications must be used within two years after registration, otherwise after registration is cancelled. The law in China and EU have a similar level of protection to the effect that they both prohibit unauthorized uses of registered geographical indications.<sup>225</sup> This protection extends to situations where the true origin is indicated but a geographical indication is used in translation or in combination with expressions such as “sort of”, “kind of”, “imitation” and “the like”.

However, unlike in the EU, the Chinese sui generis set up does not require applicants to fill a standard application form. The application contains the name and address of an applicant; the particulars certifying materials of GI products. The application for protection of GI products is also required to have the name and classification of products, the boundary of geographical origin and Geographical features.<sup>226</sup>

Furthermore, the specification in the application must indicate the quality elements of the product. This must include physical, chemical, microbiological and organoleptic characteristics, and their correlations with the natural and human factors of the region as specified by the geographical indication. The specification must also include production techniques, processing techniques, food safety and hygienic requirements.

The popularity of products, production, sales and historical facts of the product in question must also be stated clearly as part of the reputation. Technical standards of the GI products under application are of paramount importance.

It is therefore, well observed that the required specifications under the Chinese law resemble those of EU, thereby making it easy for GIs in EU to be recognized in China.<sup>227</sup> The AQSIQ is

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<sup>223</sup>Wang (n 218 above) 8.

<sup>224</sup>Commission of the European Communities (n 216 above) 39.

<sup>225</sup>Commission of the European Communities (n 216 above) 39.

<sup>226</sup>Commission of the European Communities (n 216 above) 40.

<sup>227</sup>Commission of the European Communities (n 216 above) 40.

responsible for the enforcement of GIs under the sui generis in China both nationally and internationally.<sup>228</sup>

### 2.4.3.3 The Chinese Trademark Law and how it regulates Geographical Indications

The Chinese Trademark law<sup>229</sup> also regulates geographical indications. The law provides for the processes for registration and administration of collective and certification mark respectively. The law is administered by the State Administration for Industry and Commerce (SAIC). The trade marks law provides both for goods and services in the category of GIs. The law directly provides for GIs regulation.<sup>230</sup>

Geographical indications in the trademarks system in China have a similar definition to that provided by the EU Regulation and TRIPS.<sup>231</sup> The geographic names and signs that meet the requirements of the law are registered as collective or certification marks. Unlike the US system, the SAIC procedures prevent the use and transfer of the certification mark rights outside the designated geographical area of the GI.<sup>232</sup> This idea contradicts the logic of certification trademarks which allows anyone to produce similar goods as long as they meet the specifications. Therefore, the system in China shows both, the originality and hybridization of EU and US law.<sup>233</sup>

A collective mark may be used by any natural or legal person or other organization whose goods satisfy the conditions set out in the registration. However, different organizations who

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<sup>228</sup>Wang (n 218 above) 7.

<sup>229</sup> Commission of the European Communities (n 216 above) 39. The Chinese Trademark law was made on the 23 August 1982 amended on 22 February 1993 and on 27 October 2001. The Regulation for the Implementation of the Trademark Law of the People's Republic of China was promulgated by Decree N° 358 of the State Council of the People's Republic of China on 3 August 2002, and effective as of 15 September 2002.

<sup>230</sup>Bashaw (n 211 above) 78.

<sup>231</sup>Wang (n 218 above) 7; W Xiaobing & I Kireeva 'Q&A Guidelines on China Legislation on Geographical Indications: Legislative Situation on GIs in China' (February 2011) 2

[http://www.gi-visit-press.eu/download/China\\_Legislation\\_on\\_Geographical\\_Indications.pdf](http://www.gi-visit-press.eu/download/China_Legislation_on_Geographical_Indications.pdf) (accessed 18 January 2012). Article 16(2) of the China Trademark law defines Geographical indications as signs "that identify a particular good as originating in a region, where a given quality, reputation or other characteristic of the good is essentially attributable to its natural or human factors".

<sup>232</sup>W Xiaobing & I Kireeva 'Q&A Guidelines on China Legislation on Geographical Indications: Legislative Situation on GIs in China' (February 2011) 16

[http://www.gi-visit-press.eu/download/China\\_Legislation\\_on\\_Geographical\\_Indications.pdf](http://www.gi-visit-press.eu/download/China_Legislation_on_Geographical_Indications.pdf).

<sup>233</sup>Wang (n 218 above) 7.

own registered marks assist in the protection and are entitled to examine whether the requirements for use are respected.<sup>234</sup>

The law requires that an application for registration must be accompanied by documents showing the given quality, reputation or any other characteristic of the goods indicated by the geographic indication.<sup>235</sup> All documents must be submitted in Chinese.<sup>236</sup> The quality and reputation must be linked to the natural and human factors of the region indicated by the geographic indication.<sup>237</sup> The boundary of the region indicated by the geographic indication must also be clearly spelt. The criterion used is similar to that of EU regulations.<sup>238</sup> The fraudulent, misleading, false and mis-descriptive geographic names are prohibited; however, registrations which are misleading but were made in good faith before the law coming to force continue to be valid.<sup>239</sup>

#### **2.4.3.4 Protection of Geographical Indications under the Ministry of Agriculture: The third system of protecting GIs in China**

The third system of protecting GIs in China was established by the Ministry of Agriculture (MOA) in 2008 and focuses mainly on raw agricultural produce.<sup>240</sup> This system regulates the management of agricultural products of geographic origins.<sup>241</sup> The aim is to protect materials for the production of GIs in accordance with the law on Agricultural Product Quality Farming and the Ministry of Agriculture standards. The entire registration process is managed by MOA's Centre for Quality and Safety of Agricultural Products.<sup>242</sup>

The underlying economic agenda in the law is to protect GIs so as to support sustainable development in rural areas. Therefore, only agricultural products are eligible to the protection under the Measures for the Administration of Geographical Indications of Agricultural

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<sup>234</sup>Xiaobing & Kireeva (n 232 above) 17. See. Article 6(2) of *Regulation for the Implementation of the Trademark Law*.

<sup>235</sup>Commission of the European Communities (n 216 above) 40; Xiaobing & Kireeva (n 232 above) 21.

<sup>236</sup>Xiaobing & Kireeva (n 232 above) 22.

<sup>237</sup>Xiaobing & Kireeva (n 232 above) 21.

<sup>238</sup>Commission of the European Communities (n 216 above) 41.

<sup>239</sup> W Tianxiang 'Report Q191 on the Relationship between Trademarks and Geographical Indications in China' 2 <https://www.aippi.org/download/commitees/191/GR191china.pdf> (Accessed 2 February 2012)

<sup>240</sup>Xiaobing & Kireeva (n 232 above) 21.

<sup>241</sup>Xiaobing & Kireeva (n 232 above) 6. The Measures for the Administration of Geographical Indications of Agricultural Products were adopted at the Fifteenth executive meeting of the Ministry of Agriculture on 6 December 2007 and came into force on 1 February 2008. The Chinese version is available at: [http://www.gov.cn/ziliao/flfg/2008-01/10/content\\_855116.htm](http://www.gov.cn/ziliao/flfg/2008-01/10/content_855116.htm).

<sup>242</sup>Wang (n 218 above) 9.

Products.<sup>243</sup> Industrially processed products are excluded from the protection. All other requirements in these regulation in China are similar to those in the sui generis system for agricultural and foodstuff GIs in EU. The process in this category also resembles those outlined in the sui generis system in China.

#### **2.4.3.5 Other methods of legal protection of GIs in China: China's Unfair Competition Law, Product Quality Law, and Consumer Rights Law**

The other laws which regulate the GIs in China are not specifically designated for that purpose; they generally govern the business conduct.<sup>244</sup> These laws are: the Unfair Competition Law, the Product Quality Law, and the Consumer Rights Law.<sup>245</sup>

The principles of law governing unfair competition and “passing off” are actionable under the Law against Unfair Competition (“Unfair Competition Law”).<sup>246</sup> Any conduct that contravenes lawful rights and interests of another business operator, for example, wrongful use of a protected GI, falls in the ambit of an act of unfair competition. This law forbids the use of false indications of origin. Furthermore, it prohibits falsifying and making misleading guarantees suggestions of quality. Counterfeiting, forgery and unauthorized use of a name, mark, package, or decoration of a well-known product is also punishable by criminal penalties.<sup>247</sup>

The Product Quality Law applies to anyone who manufactures or sells any product within China.<sup>248</sup> Article 5 of the law prohibits the false representation place of origin or forgery or fraudulently uses marks denoting quality or authenticity. In general, the law prohibits passing off.

The Consumer Rights Law is closely related to the Product Quality Law and reinforces the Trademark Law, the Unfair Competition Law, and the Product Quality Law by prohibiting

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<sup>243</sup>Xiaobing & Kireeva (n 232 above) 10.

<sup>244</sup>Bashaw (n 211 above) 86.

<sup>245</sup>Bashaw (n 211above) 86.

<sup>246</sup>Bashaw (n 211 above) 85. Bashaw provides the source of Competition Law in China as the ‘Law against Unfair Competition’ (promulgated by the Standing Comm. Nat’l People’s Cong., Sep.2, 1993, effective Dec. 1, 1993), *translated in* <http://www.npc.gov.cn/zgrdw/english/news/newsDetail.jsp?id=2204&articleId=345047> (last visited Nov. 25, 2007) (P.R.C.) [Unfair Competition Law].

<sup>247</sup>Bashaw (n 211 above) 85.

<sup>248</sup>Bashaw (n 211 above) 86.

passing off, the use of false indications of origin, and the illegitimate use of marks.<sup>249</sup> Any person who violates the Consumer Rights Law face the same consequences other provided for laws. Therefore, the law provides for a harmonized framework of statutory protections.

#### 2.4.3.6 Conclusion on the discussion of China

The existence of many government departments dealing with the same area brings a challenge of inconsistencies in the application of the law in China.<sup>250</sup> This conflict is exemplified in the case of Jinhua ham<sup>251</sup> where the plaintiff registered the product under trademark law and the defendant registered the same as agricultural products.<sup>252</sup> The Court's ruling permitted the co-existence in the use of "Jinhua Ham" by the plaintiff and the defendant. The Court confirmed that both sides have legal basis to use their trademark or designation of origin product. Therefore, the three legislations can be treated as practically coordinative and actually independent means for GI protection in China. The co-existence of rights entrenched by judiciary may deprive one GI holder of the effective exploitation of his rights and may have negative impacts on the consumer by misleading them. Therefore, for better protection, it is necessary to apply for the GI protection under different systems at the same time to avoid any coexistence and inconveniences.<sup>253</sup>

Although the three frameworks are disjointed in term of application in China, the principles underlying them are in harmony. Inconsistencies in application of the law by independent offices may be imminent; the courts like, in Jinhua case, have come in harmonize the systems. The courts' approach is based on the rule of "first in time, first in right", and the principle of co-existence in the use. The courts have also weighed the circumstances of the situation and reputation of the GIs to determine if there is any possibility of misleading the consumers.<sup>254</sup>

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<sup>249</sup>Bashaw (n 211 above) 86.

<sup>250</sup>Commission of the European Communities (n 216 above) 41.

<sup>251</sup>Bashaw (n 211 above) 86. Bashaw commenting on the case of Zhejiang Province Food Co. v. Shanghai Tai Kang Food Co (Shanghai Intern. People's Ct., Oct.31, 2005). (Jinhua Ham Case).

<sup>252</sup>Xiaobing & Kireeva (n 232 above) 7.

<sup>253</sup>Xiaobing & Kireeva (n 232 above) 11.

<sup>254</sup>Tianxiang (n 239 above) 4.

## 2.5 Observations and remarks on the regulatory frameworks for the protection Geographical Indications

The preceding analyses of national and international regimes for the protection of GIs have shown different approaches in this field of Intellectual property. It is also clear that though national interest have caused the differences in the legal means of regulating GIs, harmonisation towards the TRIPS Agreement standards is still at the centre of legislation.

Bashaw suggests that there are three approaches of regulating GIs in legal systems namely: 1) the trademark approach, 2) the GI-specific legislation approach, which includes appellations of controlled origin (“AOC”), 3) or the unfair competition approach as backed by consumer protection laws and the common law principles.<sup>255</sup> This study concurs with Bashaw that among the three the trademark and the GI specific legislation approaches dominate.<sup>256</sup> However, this study differs from Bashaw’s point by observing that there are four systems of regulating the aforesaid rights. The study suggests that the fourth system is a dual system where both trade mark and a sui generis protection operate simultaneously. The fourth mode of protection has been learnt from China and EU. However, the system in EU cannot be completely categorised as falling under the fourth mode as it has ranked the sui generis regime higher than the trademark system.

While Bashaw<sup>257</sup> criticizes the dual system in China for being confusing, Vivas-Eugui and Spennemann<sup>258</sup> suggest that dual protection could be an answer to the differences in the legal tradition of trademarks and sui generis GI systems. Vivas-Eugui and Spennemann draw their aspiration from the bilateral agreement between USA and Chile where the language therein compels both parties to offers protection to the others’ GIs in so far as they understand the definition of the term GIs. In this case, the regime protects both the appellations of origin and certification and collective marks simultaneously. This Agreement recognises both regimes without distinction.

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<sup>255</sup>Bashaw ( n 211 above ) 74

<sup>256</sup>Bashaw (n 211 above) 74.

<sup>257</sup>Bashaw (n 211 above) 86.

<sup>258</sup>Vivas-Eugui & Spennemann ‘ the Evolving Regime for the Geographical Indications in WTO and in Free Trade Agreements’ in Correa., & Yusuf (eds) ( 168 above) 211-212 .



It is also suggested that it is more advantageous to protect GIs as trademarks because they are real private property rights which the registrant may prevent others from using them. The basis of this argument is that GIs are not true private intellectual property rights; therefore it is only by using the Trademark System that they confer property rights.<sup>259</sup> Registrants of trademarks control the use of marks and may transfer rights in their marks. For example, the GIs in a trademark system in China can be assigned or transferred as a property right<sup>260</sup> on condition that the production must be in the same geographical area<sup>261</sup>. In contrast to the trademark system the ultimate right in a Sui Generis system is the right of use. In the sui generis regime, the government defines GIs, determines who is eligible to use it, and enforces the regulations governing their use. For example, in China the AQSIQ may fine and disqualify a person who is not using the geographic name.<sup>262</sup> In addition, a sui generis protection provides for absolute protection of the GI name for all legitimate producers in the area under the supervision of the public authority.<sup>263</sup>

There is a counter argument to the above sentiments that sui generis regimes provide for direct or indirect commercial use of a registered name for products not covered by the registration. As long as the products conform to the geographic area, reputation and the quality required, they qualify to be called under particular geographic names. The rights can be enjoyed by many people within a given area over natural resources or traditional and indigenous knowledge or cultural resources. Trademarks on the contrary take away such community rights and monopolises them.

Some scholars argue that trademark GIs are well marketed and are of high economic values because the collective bodies or associations responsible have the know-how to manage.<sup>264</sup> The associations involved in the registration invest more in marketing the GIs and control the quality thereby enhancing the producer's innovation and creativity. Furthermore, unlike the general governmental protection, it is imperative for associations to police the use and misuse of the GIs due to their direct benefit of the business. This argument castigates GIs in a sui generis regime for being collective rights where no one has the zeal to supervise.

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<sup>259</sup>Bashaw (n 211above) 87.

<sup>260</sup>Tianxiang (n 239 above) 1.

<sup>261</sup>Xiaobing & Kireeva (n 232 above) 16; Thual & Lossy (n 130 above) 18.

<sup>262</sup>Bashaw (n 211above) 84.

<sup>263</sup>Tianxiang ( n 211above)1

<sup>264</sup>Thual & Lossy (n130 above) 18.

<sup>265</sup>Bashaw (n 211 above) 97.



However, this study observes that this argument may be challenged looking at the vigour and organisation of public authorities in EU in fostering geographical indication rights of its members and producers. The EU is behind the changes of the TRIPS to protect their GIs for the benefit of its producers and economies. For the least developed countries like Malawi protection cannot be left to private associations which lack capacity to enforce the rights. Therefore, young industries have to be nurtured by governmental authorities so as to grow and compete on the global market. In so far as protecting GIs from third countries is concerned, governmental authorities are better placed to coordinate the enforcement.

The disadvantage of trademark system is that there is no prohibition of use of names in translation and expressions like “style or “type. As long as a name is not misleading, it may be used. However, in a sui generis regime, it is prohibited to misuse a name or to use an imitation or evocation of the name product.<sup>265</sup> This protection extends to instances where the use of such expressions is pointing to a true origin of the product.

Generally, trademark protection is granted to GIs according to the principle “first in time, first in right.”<sup>266</sup> This means that priority is given to the GI that was registered first. The principle “first in time, first in right” is not automatically applied for GIs in the EU. A GI can be registered and co-exists with an existing trademark if all the GI requirements are met. On the contrary, a trademark cannot be registered if a GI name is already protected.<sup>267</sup> However, in a sui generis regime, well known trademarks are respected when they are first in time in terms of registration. However, in China, due to the nature of tripartite protection, there is no hierarchy of GI rights as per the regime and the ‘first in time, first in right’ principle is used by the Courts to resolve registration conflicts.<sup>268</sup>

## 2.6 Concluding Remarks

The study of trademarks systems has revealed more differences than similarities in approach between US and EU on one hand and China on the other. In USA and EU, registered trademark GIs are exclusive rights on the use of the name or logo. However, China prohibits

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<sup>265</sup>Thual & Lossy ( n 130 above) 16 -18

<sup>266</sup> See the above discussion on USA.

<sup>267</sup>Thual & Lossy (n 130 above) 16-17.

<sup>268</sup>Bashaw (n 211above) 86.

the registration of GIs as pure trademarks; it only allows the registration of GIs as collective or certification marks.

This study, therefore, agrees to the China's approach of regulating geographical indications by both trademarks and sui generis systems (the dual system). Most countries have trademarks laws which may be modified to include geographic names. These systems can be complimented by a more elaborate sui generis regime to cover up loop holes inherent in trademark law. The ranking of the rights should be in paripassu. The conflicts should be resolved on the principle of 'first in time' and of coexistence if it is not misleading to the consumers. This may solve the dead-lock in the Doha Round negotiations where some parties are still indifferent to each other's legal means of protecting GIs.<sup>269</sup>

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<sup>269</sup> D Vivas-Eugui & C Spennemann ' The Evolving Regime For the Geographical Indications in WTO and in Free Trade Agreements' in CM Correa & AA Yusuf ( n 168 above) 166-209.

## Chapter Three

# THE PROTECTION OF GEOGRAPHICAL INDICATIONS IN MALAWI

### 3.1 Introduction

The preceding chapters have revealed that despite the existence of international systems, national laws are very crucial to enforcement of geographical indications rights. This confirms the idea that intellectual property rights have always adhered to the principles of territoriality, exclusivity and priority; hence, national laws define how rights can be acquired and enforced.<sup>270</sup>

National laws have two forms of regulating intellectual property rights. The regulation is done by providing statutory provisions or through common law.<sup>271</sup> These laws may be specific on geographical indication or generally preventing misconduct in business. We have also observed from the preceding chapters that WTO member states are aligning their national statutory laws to the standard required in TRIPS Agreement.

Malawi, the subject matter of this study, is a member of WTO and a party to the Agreement on Trade Related Aspects of Intellectual Property Rights since 31<sup>st</sup> May 1995.<sup>272</sup> Malawi is also a signatory of the Paris Convention from 6 July 1964 and a member of the World Intellectual Property Organization from 11 June 1970.<sup>273</sup> Malawi is also a member of the African Regional Industrial Property Organization for English-speaking Africa (ARIPO) (established by the Lusaka Agreement of 9 December 1976) from 15 February 1978 and a party to the Banjul Protocol on marks in the framework of ARIPO from 6 March 1997.<sup>274</sup> There is no bilateral agreement between the EU and Malawi specific to GIs.<sup>275</sup>

Specifically, the Laws of Malawi do not provide for the regulation of geographical indications in Malawi. As we have learnt from the introduction to chapter 2, geographical

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<sup>270</sup> J Bullbrook 'Geographical Indications within GATT' (July 2004) 7(4) *The Journal of World Intellectual Property* 501.

<sup>271</sup> Bullbrook (n 270 above) 502.

<sup>272</sup> World Intellectual Property, Malawi's Intellectual Property Profile, Malawi: <http://www.wipo.int/lcds/en/country/pdf/mw.pdf> (Accessed 4 November 2011)

<sup>273</sup> Commission of the European Communities (n 216 above) 251.

<sup>274</sup> Commission of the European Communities (n 216 above) 251.

<sup>275</sup> Commission of the European Communities (n 216 above) 251.

indications are more akin to trademarks in so far as other intellectual property rights;<sup>276</sup> therefore, the study has to have recourse to the Trademark Act in Malawi.

### **3.2 The Geographical Indications from the perspective of the Trademark Act in Malawi**

The Trademark Act in Malawi came into effect on 1 April 1958 and has not been amended so far.<sup>277</sup> This Act was made way before the provisions of the Agreement on Trade- Related Aspects of Intellectual Property came with the current obligations on harmonization. The Act was enacted in 1957 as a replica of the United Kingdom Trade Marks Act of 1938.<sup>278</sup>

There is no regime for the protection of geographical indications in the Laws of Malawi even in the Trademark Act No 14 of April 1958 or Trade Descriptions Act No. 18 of August 1987.<sup>279</sup> However, efforts to review the Trademark Act are underway in terms of discussions so as to include novel issues such as geographical indications.<sup>280</sup>

Section 2 of the Trademark Act in Malawi defines a ‘mark’ as including a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof.<sup>281</sup> A trade mark means:<sup>282</sup>

...except in relation to a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trade mark, a mark registered or deemed to have been registered under section 42.

This study concurs with the observation by the Malawi Law Commission that the definition of a trademark in the Act is very long, ambiguous and leaves out key words.<sup>283</sup>

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<sup>276</sup>Ibele (n 53 above) 39

<sup>277</sup> Malawi Law Commission ‘Report of the Law Commission on the Review of the Trademarks Act’ unpublished zero draft’ May 2011. The draft report recognizes the obsolescence of the Trademarks Act and proposes changes which are still under discussions.

<sup>278</sup>Malawi Law Commission (n 277 above) 7.

<sup>279</sup>Commission of the European Communities (n 216 above). 251

<sup>280</sup>J Chigaru (n 2 above) 37 ; See also Author Unknown ‘ Malawi’s Vision 2020 and Malawi Growth and Development Strategy’ (2006-2011) 17 [www.sadc.int/index.php/download\\_file/view/77/270/](http://www.sadc.int/index.php/download_file/view/77/270/)(accessed 4December 2011)

<sup>281</sup> Source provided by WIPO <http://www.wipo.int/wipolex/en/details.jsp?id=9334>.

<sup>282</sup>Malawi Trademark Act of 1958 Sec 2 WIPO website <http://www.wipo.int/wipolex/en/details.jsp?id=9334>.

Section 7 of the Trademark Act in Malawi gives precedence to the rights of the registered marks over unregistered. The rights of registered are supreme even in cases of passing off. Therefore, the Act recognizes that the tort of passing off is a way of protecting intellectual property rights.

The Act provides for the registration of trademarks for goods or classes of goods.<sup>284</sup> The Act therefore excludes the registration of services. Unlike the Trademark Law in United States which provides specifically for service marks, the Act in Malawi is silent.<sup>285</sup> Unlike the CTMR which is restricted to agricultural products, the term ‘goods’ in the Act in Malawi encompasses all products.

Section 9 of the Act gives exclusive proprietary rights to the registrant and it prohibits the use of the trademark by third parties without permission.<sup>286</sup> It also prohibits the use of parallel or identical marks to the registered mark that would likely deceive or cause confusion in the course of trade.

Section 14 of the Act requires that for a mark other than a certification trade mark to be registered it must be distinct. The Registrar or any tribunal appointed in pursuant to the Act has powers to determine whether a mark is distinctive and the applicant has the right to appeal against such a decision.<sup>287</sup> Sections 14(2) and 15 of the Act provide that distinctiveness of a mark means capability to distinguish the goods of the registrant from others in the course of trade. This standard of distinctiveness is similar to that of US Trademark Law and European Community Trade mark Regulations. However, the difference in the Act in Malawi is that it does not provide for designation of origins.

The Trademark Act in Malawi prohibits the registration of a trade mark or part of a trade mark which is likely to deceive or cause confusion, or would be contrary to law or morality, or any scandalous design.<sup>288</sup> This prohibition is similar to the trademark law in CTMR, US

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<sup>283</sup> Malawi Law Commission ‘Report of the Law Commission on the Review of the Trademarks Act’ unpublished zero draft May 2011 17-19.

<sup>284</sup> Malawi Trademark Act of 1958 Sec 8 (n 17 above)

<sup>285</sup> Bandekgay & Mead (n 170 above) 769.

<sup>286</sup> Department of Registrar general, Ministry of Justice of Malawi ‘Making a Mark : An Introduction to Trademarks for Small and Medium-sized Enterprises in Malawi’ (2011) 1 Intellectual Property for Business Series 7 [http://www.wipo.int/sme/en/documents/guides/customization/making\\_a\\_mark\\_malw.pdf](http://www.wipo.int/sme/en/documents/guides/customization/making_a_mark_malw.pdf)

<sup>287</sup> Malawi Trademark Act of 1958 sec14 (3) (n 17 above).

<sup>288</sup> Malawi Trademark Act of 1958 Secs 16 & 17 (n 17 above).

and China, where the underlying principle of the regulations is to prevent deceit and confusion to the public.

The rights in the trademark are transferable or transmittable or can be assigned by the proprietor through the procedure outlined in Part V of the Act.<sup>289</sup> This principle is behind all trademark laws in world.<sup>290</sup>

Certification marks are called certification trade marks in section 42 of the Trademark Act in Malawi. The section provides that a certification trademark is:<sup>291</sup>

... A mark adapted in relation to any goods to distinguish in the course of trade goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic from goods not so certified....

The term ‘adapted to distinguish’ means that the origin, quality, mode of manufacture referred to is capable of differentiating the said products from others in the course of trade. This definition well places the protection of GIs which by definition are ‘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.<sup>292</sup> However, this section falls short of the standard raised by TRIPS by leaving out the question whether the quality, manufacture or other necessary characteristics must be linked to the origin. Unlike geographical indications, the definition of certification trademark indicates that each specification therein is independent from each. For example, if one proves the origin he does not have to prove the mode of manufacturing or special qualities. Consequently, certification trademarks in Malawi are indication of source of origin as provided by Paris Convention of 1891, not GIs per se as provided in TRIPS Agreement.

The certification trademark may also be transferable to another person by the proprietor with the consent of the Registrar.<sup>293</sup> This approach is similar to that of US, but contrary to that of

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<sup>289</sup>Malawi Trademark Act of 1958 sec 27 (n 17 above); Department of Registrar General, Ministry of Justice of Malawi (n 286 above) 7.

<sup>290</sup>Bashaw (n 211above) 87.

<sup>291</sup> Malawi Trademark Act of 1958 (n 17 above)

<sup>292</sup> Article 22 of the TRIPS Agreement

<sup>293</sup> Sec 42(8) of the Trademark Act, Cap 49:01 of the Laws of Malawi (n 17 above)

China, where the transfer is only possible when the proprietor does so to another person within the geographic area.<sup>294</sup> Section 42 (10) of the Act provides for a person or public authority which shall be certifying that goods originate from a certain area and qualify as designated certification trademark.

A thorough reading of the Trademark Act in Malawi also reveals that there is no provision for collective marks.<sup>295</sup> Contrary to the trademark laws in European Union , US and China, the Act in Malawi left out the terms ‘geographic name or designation or origin’ in the meaning of trademarks. Contrary to the trade mark law in USA there is no provision for composite marks in the Act.

### **3.3 The current discussions in the Malawi Law Commission on the proposed amendments to the Trademark Act in Malawi**

The Malawi Law Commission has the mandate to review the Trademark Act in Malawi. This came after it was noted that Malawi has obligations to harmonise its intellectual property law framework due to the obsolete existing laws. Therefore, this study will deal with the proposed review limited to so far as it relates to geographical indications. The proposals are in unpublished Draft Report of May 2011 subject to further discussion until it becomes a bill in parliament and later law.<sup>296</sup>

The discussions of the review of the Trademark Act in Malawi have not so far proposed the inclusion of geographic names as trademarks.<sup>297</sup> This does not mean that they have proposed for an independent sui generis law as in EU countries or China. However, the proposal recommends the inclusion of Part VII in the Trademark Act of 1958 to specifically deal with geographical indications.<sup>298</sup> The proposal includes adopting the definition of geographical indications in the TRIPS Agreement in the law.<sup>299</sup> The regulations proposed are similar to that

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<sup>294</sup>Xiaobing & Kireeva( n 232 above)16

[http://www.ipr2.org/storage/Q&A\\_Manual\\_European\\_legislation\\_on\\_GIs1013.pdf](http://www.ipr2.org/storage/Q&A_Manual_European_legislation_on_GIs1013.pdf) (accessed 18 January 2012)

<sup>295</sup>Malawi Law Commission (n 277 above) 43.

<sup>296</sup>Malawi Law Commission (n 277 above).

<sup>297</sup>Malawi Law Commission (n 277 above).The reading of the entire documents, the recommendations and proposed changes.

<sup>298</sup> Malawi Law Commission ( n 277 above)

<sup>299</sup>Malawi Law Commission (n 277 above) 62.

of a sui generis regime in EU in so far as registration requirements are concerned.<sup>300</sup> The proposals also include the prohibition against the registration of generic geographical indications. Unlike the sui generis regime in EU, the proposals in Malawi have put together the regulation of wines and spirits in part VII of the proposed law as different subsections. Unlike the EU regulation which emphasizes protection of agricultural goods, the proposed provisions refer to all products. The geographical indications will be supervised by the Trademark Office and the Registrar like the other intellectual property rights.

Section 7 (e) of the proposed law provides that trademarks shall not be registered where they denote a misleading geographic origin and the true quality of the goods.<sup>301</sup> This entails that a geographical indication may be registered as trademark if used distinctively, honestly and denoting a true origin. However, the law would have come out clearly on the point to dispel all doubts that may be created by the lacuna.

Section 7 (c) of the proposed law is to the effect that trademarks which consists solely of marks indicating common names of the goods or services shall not be registered. This means that composite marks and arbitrary names of origin will be registered as trademarks if they are used in good faith and do not mislead the public as to the true origin of goods.

The proposal has also recommended the inclusion of well-known marks, collective marks and certification marks as part of the law in Part VI.<sup>302</sup> Collective marks were not provided for in the Trademark Act of 1958. In the proposed law, collective marks refer to marks which identify members of an organization with standards for admission.<sup>303</sup> Section 37(5) of the proposed law provides that collective marks are trademarks. Therefore, if an association registers geographical indications which are distinct and not misleading to the public, such a collective mark may be allowed.

The proposals do not provide for the co-existence of homonymous names registered as trademarks and geographical indications. For trademarks, if a mark is registered while there is an existing unregistered use, the two may co-exist.<sup>304</sup> On the other hand, section 42 (f) of the proposed law states that a GI cannot be registered if it is similar or identical to an existing

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<sup>300</sup> Malawi Law Commission (n 277 above) 63-65.

<sup>301</sup> Malawi law Commission (n 277 above) 101.

<sup>302</sup> Malawi Law Commission (n 277 above) 120-121.

<sup>303</sup> Malawi Law Commission (n 277 above) 123 Sec 37 (6) of the proposed law.

<sup>304</sup> Malawi Law Commission (n 277 above) 105. Commentary on sec 13 of the proposed law.



trademark or GI.<sup>305</sup> Therefore, the law will close opportunities where a name of a place registered under a trademark, which arbitrarily denotes a product can co-exist with the same geographic name registered as a GI for a different product. This is because in so far as geographic names are concerned; the principle of exclusivity is altered. Geographic names are special rights which connote collectiveness for all people in the geographic area. Even Article 23 of TRIPS Agreement does not prohibit homonymous names but only calls for members to provide practical ways of coexistence in avoiding deceit and confusion to the public.

The Part VII of the proposed law does not specify whether a registered GI may become generic or not. Section 42 only provides for names that are generic at the time of registration. Unlike the Malawian Trademark Law, the EU Sui generis regime specifically deals with the issue of whether GI names can become generic after registration by stating that once GIs are registered they may not become generic. In US, due to the trademark system, GIs may be declared generic by the court if consumers view them as such.

Section 42 (e) of the proposed law provides for the registration of GIs from third countries. Among other conditions for registration, the foreign GI must be protected in the country of origin. This provision closes arguments whether the proposed system in Malawi would protect foreign GIs. However, Section 42 of the proposed law requires that foreign GIs be registered in Malawi following the specification there under. The specifications, as observed are similar to a sui generis system in EU or China. Therefore, the trademark GIs registered in US or China or CTMR may not fit into the specifications despite being protected in their country. This means that the proposed law is not consistent with the most favoured nation (MFN) principle in TRIPS as section 42 of the same casts doubt as to whether all foreign GIs from all approaches would be protected. This argument also cast doubt on whether the GIs from Malawi would be protected enough in jurisdictions where Trademark systems apply.

The office of the Registrar General is the one responsible for overseeing the registration of trademarks, patents and geographical indications. The enforcement of geographical indications originating from Malawi does not end on registration. Unlike trademarks which are protected by the owner, geographical indications in a sui generis regime are enforced by public authorities. The first schedule of the proposed law pursuant to Section 38 has

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<sup>305</sup>Malawi Law Commission (n 277 above) 126.

envisaged a certifying body for quality products under certification marks. However, the law is silent on such an important point in so far as geographical indications are concerned.

It must be noted that geographical indications in a *sui generis* regime are collective rights used by anyone whose products would meet the required standard. Therefore, the proposed Part VII of the law has a lacuna in so far the practical aspects of enforcement, advertisement and marketing are concerned. In the absence of any public system, small farmers are penalized in terms of quality development and enforcement of rights.<sup>306</sup> The enforcement of geographical indications in foreign jurisdictions is problematic to small rural enterprises without the intervention of public authorities.

### 3.4 Concluding Remarks

The current Trademark Act in Malawi does not provide for the regulation and protection of geographical indications. This means that currently unregistered geographical indications may be protected in Malawi by the common law principles of passing off and unfair competition. In addition, one may register geographical indications as certification trademarks.

The reliance on the common law position is not conducive to the growth of an industry because producers or dealers may spend their meagre resources on litigation to clarify their rights. This is why the Malawi Law Commission is discussing the fate of intellectual property rights in Malawi. However, it is clearly observed that the proposed statutory system of regulating geographical indications in Malawi is lacking in some respects in so far as the TRIPS is concerned. Furthermore, the proposed law may not necessarily help in the protection of GIs originating from Malawi in foreign jurisdictions or all foreign GIs to be registered in Malawi taking into account the current struggle between *sui generis* regimes and trademark systems.

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<sup>306</sup>Agropolis International Thematic Directory number 11 DURAS Project Innovative partnership for sustainable development' Supporting small farmers through the establishment of geographical indications in southern Africa (June 2010) 1  
[http://www.agropolis.org/pdf/chapters\\_duras/supporting\\_small\\_farmers\\_southern\\_africa.pdf](http://www.agropolis.org/pdf/chapters_duras/supporting_small_farmers_southern_africa.pdf) (accessed 28 October 2011)

## Chapter Four

# CONCLUSION AND RECOMMENDATIONS

### 4.1 Introduction

The preceding chapters introduced the subject matter of the study and discussed how geographical indications rights are being regulated in Malawi and some other sampled jurisdictions. The international perspective of the geographical rights was also briefly discussed. The successes and loop holes of the studied jurisdictions have also been highlighted.

Therefore, this chapter will revisit the problem statement to see whether the objectives of the study have been met. The chapter will also make brief look at the findings from the preceding chapters. Lastly, recommendations will be made on how to close loop holes in the law in Malawi by taking into account the success of the existing system and the lessons learnt from the sampled jurisdictions.

### 4.2 Recapitulation of the Research Problem

Chapter 1 highlighted the main question which was supposed to be dealt with by this study. The question was whether the current intellectual property framework in Malawi as provided by the Trademark Act of 1958 offers protection to geographical indications in terms of the country's obligations under TRIPS. The ancillary question was whether the current regime in Malawi would enable rights holders of geographical indications to enforce their rights in Malawi and in foreign jurisdictions. The two questions were supposed to be answered in the light of the struggle between protections under the trademark system and sui generis system. The EU is a leading member of the sui generis system while US is a member for the trademark system.

It was the hypothesis of the study that there is no regulation of geographical indication rights in the Trademark Act of 1958 because it has not been amended after the inception of TRIPS in 1990s. The objective of the study was to know how such rights are currently protected and to propose changes if the findings are in the negative. The objective was made on the basis

that Malawi as a member of WTO is under obligation to harmonise her laws in alignment with the TRIPS Agreement.

The answer to the problem statement has been to the negative and has proved the hypothesis true. The objectives of study also been achieved as summarised and concluded by the subsequent sections of this chapter.

### **4.3 Concluding the thesis Problem**

The analysis in chapters two and three have dealt with the problem statement by studying the evolutions of geographical rights on the international scene, the broad concepts underpinning geographical indications and the current international regime under TRIPS. In addition, the study investigated and evaluated the regional application of geographical indications in European Union countries. United States and China provided the nuances of geographical indications at national level. The aim was to find out the operations of different jurisdictions in so far as the provision of legal means for the regulation of GIs is concerned. The above investigations were aimed at helping in the analysis of whether the law in Malawi is TRIPS compliant.

The investigation revealed that currently the TRIPS Agreement is the international ruling system of intellectual property rights. The earlier international agreements and conventions regimes failed to have the worldwide support and to harmonise different approaches to the protection of geographical indications. The TRIPS Agreement has also elevated geographical indications rights.

Despite the worldwide support of the system under TRIPS, the world is still divided into two major factions in so far as the statutory regulations of geographical indications are concerned. The principles of territoriality, exclusivity and priority in intellectual property rights have been used in national laws to protect national interests. Much as the WTO would want to reduce trade distortions by harmonising the intellectual property regime, every nation is looking at the same while thinking of how it will benefit its producers economically. Chapter 2 of this paper looked at EU, United States and China where it is evident that harmonisation has been done in accordance with national interests.

The European Union has a sui generis system which provides for agricultural products, wines and spirits. The EU is protecting such rights due to the economic value and to avoid economic consequences that may come by not enforcing them. The European Union also protects geographical indications which are agricultural products by the Community Trademark Regulations (CTMR). The CTMR protects GIs as trademarks, collective mark or certification marks. The requirement is that the geographic name must be distinct and not in conflict with an existing GI or well-known trade mark. The sui generis regulations are superior to trademark laws in terms of GIs. Public authorities do a great deal of supervision, marketing and quality maintenance. Non-agricultural products which fall in the category of GIs are protected by national laws especially under trademark laws.

The United States regulates GIs as trademarks and internationally it opposes the regulation of GIs as sui generis rights. All geographic names are generic and descriptive unless they acquire secondary meaning by denoting a unique undertaking or through use. Geographic names are distinct if there are certification marks. The registrant has exclusive rights over the GI.

The investigation of the Chinese system of regulating GIs indicated that it has both the trademark and sui generis systems which are applied simultaneously. One may even register a GI in both systems. Therefore, in China, all foreign GIs may be registered and recognised as in their country of origin regardless of the system. The main criticism of the system in China is that there are several public bodies which govern the registration, supervision, enforcement and marketing of GIs. The public bodies apply the law differently thereby conflicting in some instances. The courts usually come in to resolve the conflicts.

The study also revealed that both the trademark and the sui generis systems have pros and cons which have not been conclusive due to the fact that empirical evidence is lacking. It is also noted that some countries like Malawi are still in the process of harmonising their national laws in light of the TRIPS, therefore whether any system is better than the other is not conclusive yet.

The current position of the law in Malawi is that there is no specific provision for geographical indications. Therefore, the current, Trademark Act of 1958 is inconsistent to the

TRIPS Agreement. However, certification trademarks may be used to protect GIs to a limited extent.

Malawi is in the process of reviewing the Trademarks Act to harmonize it with current trends. Among other issues, there are proposals on how the revised Act in Malawi should regulate geographical indications rights. The proposals have recommended that a sui generis law on geographical indications should be inserted in Part VII of the Act.

Chapter 3 of this study has analysed the strengths and the deficiencies of the proposed law. It is not a perfect sui generis system and that it leaves the question of how trademark GIs from other jurisdictions will be protected in Malawi. Malawian registered GIs would also have problems of registration in jurisdictions with the trademark system. Some areas have been left out in the proposed law which this study wishes to be critically and openly debated before the proposals come into law. The decisions to include or exclude such areas must be well informed and justified.

It follows, therefore, that the Trademark Act in Malawi must be reviewed as noted by the Malawi Law Commission. Furthermore, the proposed revision by the Malawi Law Commission must still be revisited to deal with the loop holes revealed by this study to avoid unnecessary litigation in the future.

#### **4.4 Recommendations**

The legal theory of autopoiesis states that the law is equated to a living organism, for example an amoeba.<sup>307</sup> It is self-reproducing and referencing.<sup>307</sup> However, the law cannot live without getting concepts from the environment or social set up in which it lives to be a part of system, because if it does not do so, it would be obsolete and die.<sup>308</sup> Therefore, this study recommends that the law in Malawi must get concepts from the changing environment so as to remain relevant to the changes made by the TRIPS and for Malawi to fulfil its international obligations as a state. The rights under discussion may also be beneficial to Malawi's economy.

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<sup>307</sup> A D'Amato 'International Law as an Autopoiesis System' 15 November 2003 17  
<http://anthonydamato.law.northwestern.edu/auto/PLANCK-1.pdf> (accessed 1 March 2012).

<sup>308</sup> D'Amato (n 307 above) 17.

In view of the investigations made in the preceding chapters, this study recommends that Malawi should borrow concepts from the system in China to solve the current legal quandaries in the field of GIs. However, pure legal transplantation of the law in China without adapting it to the peculiar situation in Malawi would not be prudent.

The law that provides intellectual property rights akin to geographical indications in Malawi is the Trademark Act of 1958. Chapter 3 of this study revealed that the Trademark Act in Malawi falls short of terms that denote geographic designations as trademarks, collective marks and certification marks. Therefore, this study recommends that the proposed law should include such notions as part of trademarks law in Malawi following the trademark system in China. However, it must be borne in mind that the trademark system in China only provides for geographical indications as collective and certification marks. In that regard, the law must incorporate the position in US and Community Trademark Regulations (CTMR) in EU which allow GIs to be registered as trademarks upon fulfilling certain conditions. This would be a cost efficient review because Malawi already has an existing trademark system.

In addition, the law should have a sui generis system for GIs as the Malawi Law Commission has proposed to be in Part VII of the Act. The law should then provide for the co-existence of homonymous names in conditions where the trademark GIs and sui generis GIs collide in similarity. This will guarantee that one can register the same GI as trademark and a sui generis GI under Part VII of the proposed law. The law must also provide that GI names may become generic after registration in the sui generis system like in China, if the names fall into disuse or it have not been used after registration.

The proposed law must be commended for merging the different regulations existing in the EU regime. The proposed law has already covered all products, that is to say, wines and spirits which are GIs into one law.

This study also recommends that the Malawi Bureau of Standard, a body which has a mandate to certify the quality of products in Malawi, must be specifically mentioned in the law. The Ministry of Industry and Trade which is responsible for imports and exports programs in Malawi must also be specified in the law to dispel all doubts in so far as the public body's involvement in the marketing, control and research in these special rights is

necessary. Geographical indications need a special body for the certification of quality and research for them to have real economic value. This task cannot be left in the hands of the office of Registrar General in the Ministry of Justice of Malawi. The Registrar General's Office has expertise in the general supervision of the enforcement of intellectual property, but lacks capacity in the certification of quality and marketing.

The proposal makes mention of the establishment of the Companies and Intellectual Property Office which should coordinate all relevant offices including the Malawi Bureau of Standards and the Ministry of industry and Trade in so far as intellectual property is concerned. Geographical indications may exist in Malawi, but efforts to research and market them may cause problems. This may be the case because it is estimated that more than 11 million people (more than three quarters of the population) live in rural area and over 60% of the population live below the poverty line.<sup>309</sup> This entails that GIs are likely to come from these areas where organisation and marketing will be problematic in so far as collective rights are concerned. Therefore, the study concurs with observation that abovementioned government bodies have to be involved for the growth and development of GIs.

However, in order to achieve harmony in the system the roles of the different expert government bodies in geographical indication rights must be spelt in law to avoid the situation China, where the application of different government bodies is inconsistent to one another. In this way, the government will have full control of the systems and its benefits too.

The use of the existing Trademark Act by revision and inclusion of the relevant missing parts will minimise the costs of setting up new offices for the advocated intellectual property rights. Moreover, the use of the above mentioned existing offices will also achieve the same objective. The use of the existing law and offices is a precautionary measure of saving costs where the extent of benefits of GIs are uncertain and has not backed up by appropriate quantitative research.

Therefore, this study concludes by recommending that Malawi should have a dual system of regulating geographical indication rights based on the ideology of rural development. Gangjee noted that a long standing obstacle to international harmonisation efforts of GIs has been the

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<sup>309</sup>Chigaru (n 2 above) 1.



diversity of various national concepts.<sup>310</sup> Therefore, the dual system of regulating GIs will help Malawi to stand secure in the presence of epistemic, conceptual and institutional mess in this field of IP.

#### **4.5 Areas of Future Research**

The subject matter of this study is complex without quantitative research on the existing GIs in Malawi and whether they are worthy regulation with high costs from the onset. Malawi is rich in indigenous products and knowledge which might be exploited as GIs. However, further quantitative research is imperative to verify the position. When the GIs laws were introduced in India, 61 GI products were registered.<sup>311</sup> This study seeks to provoke such response and research in Malawi for the benefit of all. This may help in the alleviation of poverty by the use of important cultural and natural heritage.

#### **4.6 Overall Conclusion**

It has been observed that the statutory laws do not specifically provide protection for GIs in Malawi. The common law and general business practices are not direct in approach either to prevent abuses of the said rights. Therefore, the law is lacking in the role of guiding people to the existence of their rights in geographical indications. The rationale of this conclusion is that unlike the common law and business practices which may only come in to govern the parties at the stage of litigation when violations are already committed, statutory laws are loud, clear, accessible and far reaching in guiding people before engaging in any business transactions.

Furthermore, the law as it is in Malawi, is inconsistent with the TRIPS provisions since it does not provide protection to GIs rights yet. On the other hand, the law in this area as proposed by the Malawi Law Commission may not lead us to the desired state. Therefore, further improvements as recommended by this study have to be considered before the country is stuck with a new law which may be unsatisfactory. This is because when proposals come into force as law as they are, the people of Malawi will have to be governed by them

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<sup>310</sup>Gangjee (n 52above) 5.

<sup>311</sup>PR Jena & U Grote ( n 26 above) 13.

regardless of the demerits until the time when the nation will have another change of changing them.<sup>312</sup>

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<sup>312</sup>S Guest et al 'Jurisprudence and legal theory' (September 2004)  
52.[http://www.londoninternational.ac.uk/current\\_students/programme\\_resources/laws/subject\\_guides/jurisprudence/juris\\_chs1to4.pdf](http://www.londoninternational.ac.uk/current_students/programme_resources/laws/subject_guides/jurisprudence/juris_chs1to4.pdf) (accessed 28 October 2011). John Austin's Positivist legal theory.

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