© IPI

# Module 3

## National and international protection of geographical indications (GIs)

IGE | IPI
Swiss Federal Institute
of Intellectual Property

Schweizerische Eidgenossenschaft
Confédération suisse
Confederazione Svizzera
Confederaziun svizra

Swiss Confederation

Federal Department of Economic Affairs,
Education and Research EAER
**State Secretariat for Economic Affairs SECO**

## Contents

# 1 National protection of GIs

A variety of legal instruments exist at the national level to protect GIs. In general, GIs can be protected in two ways: either through a sui generis system or by being integrated into the trade mark system (collective or certification marks). In addition, legislation on unfair competition can complement and reinforce the protection provided by these two systems.

## 1.1 Sui generis system

«Sui generis» means «of its own kind». Sui generis GI systems are standalone legal frameworks specifically designed to protect GIs. This implies enacting dedicated GI laws and regulations that establish GIs as distinct and separate intellectual property rights. The main advantage here is that the legislation can be tailored to the unique nature of GIs by including specific registration processes with specific control mechanisms.

Example: Raclette du Valais AOP

### Registration

Under a sui generis system, the GI typically needs to be registered in a procedure that includes public consultation. It also needs to fulfil certain requirements, such as submitting a comprehensive code of practice outlining product specifications, the delimited geographical area and evidence linking the product's qualities to its origin. Once registered, GIs cannot become generic. Unlike other intellectual property (IP) rights, there is no time limit on their protection (except in some legal systems, where the protection is subject to renewal) and, in most registration systems, no fees are requested.

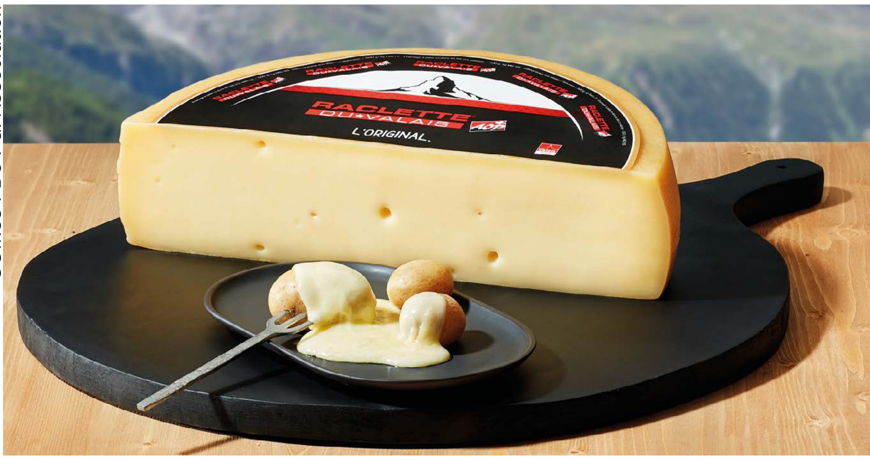
### Scope

Sui generis GI systems offer a broad scope of protection. Imitations or mere evocations that might mislead consumers about the product's true origin are also considered as infringing a GI right. For example, using terms like «type», «kind» and «style» next to the protected GI is prohibited. This safeguards against attempts to mislead consumers by suggesting a connection with a protected GI while acknowledging a different origin.

### Enforcement

Enforcement mechanisms under sui generis systems often involve official controls and monitoring, with public authorities empowered to intervene to ensure compliance. This means that specialised institutions are established to monitor and enforce GI protection, or public authorities in charge of tackling fraud act ex officio in this regard. This is different from enforcement mechanisms under trade mark systems, in which the trade mark owner or its licensee must enforce its rights.

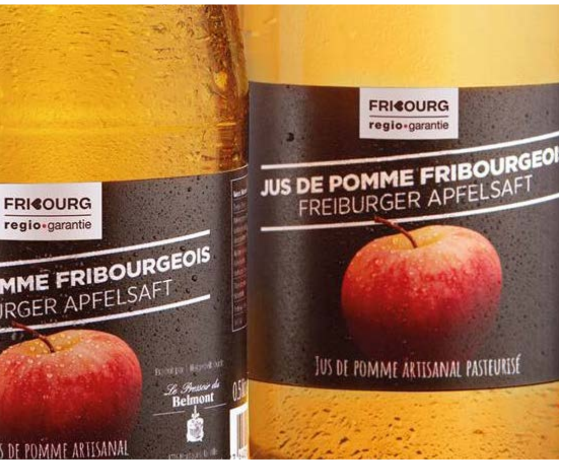
©Swiss PDO-PGI Association



Raclette du Valais cheese

## 1.2 Trade mark system

Some jurisdictions protect GIs through trade mark systems. A GI can be registered as a particular type of trade mark – generally a collective mark or a certification mark – rather than as a dedicated type of intellectual property.




© Terroir Fribourg

Fribourg Regio Garantie

### Certification marks

Certification marks certify that the products or services bearing them possess specific characteristics. The certification mark's owner, which cannot use the certification mark itself, is then responsible for ensuring that the goods or services using the mark adhere to the defined characteristics and standards which are specified in the rules of use. However, a certification mark may simply identify the production location without necessarily implying that there is a connection between the product's special quality and its origin.
Example for a certification mark that is not a GI but indicates the geographical origin: Fribourg regio garantie https://www.swissreg.ch/database-client/register/detail/trademark/1207205472

### Collective marks

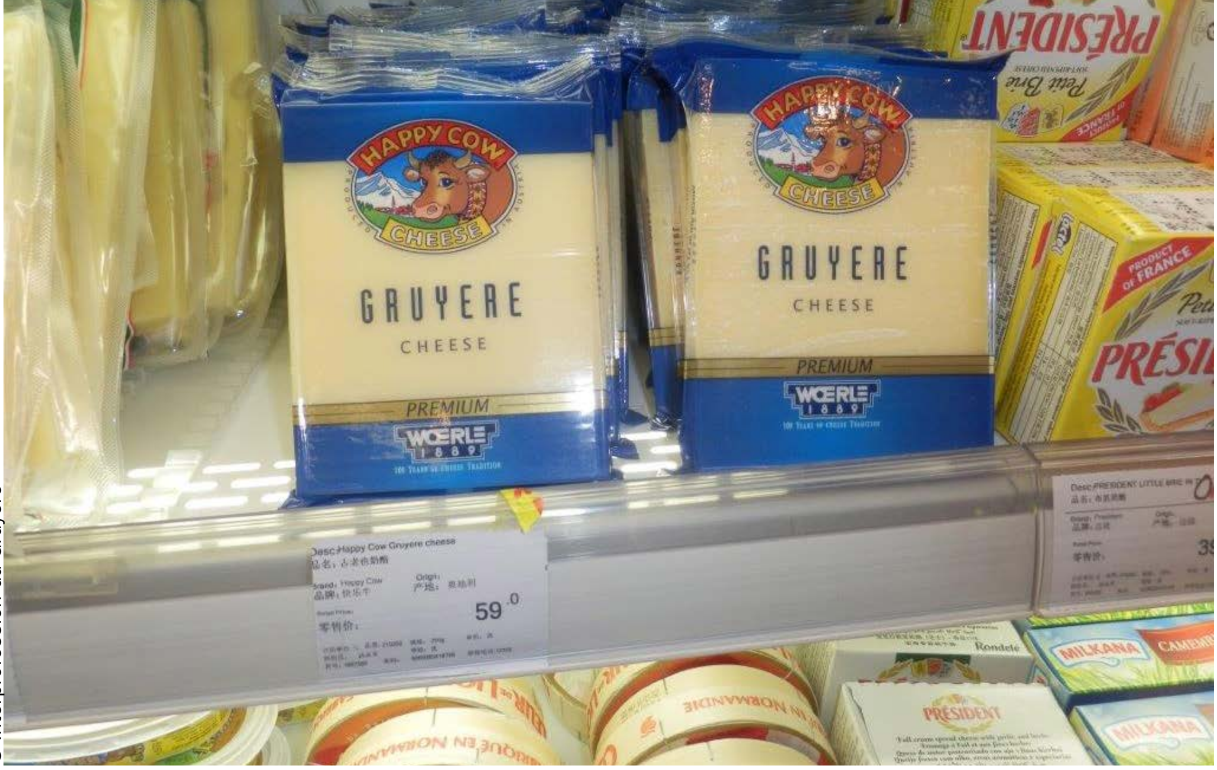
Collective marks indicate that the products or services originate from members of a particular group, which are listed in rules of use. They emphasise the collective nature of the sign, which is a feature they share with GIs. The owner of the collective mark decides who is authorised to use it. A collective mark does not necessarily imply that there is a connection between the product's special quality and its origin.
Example: Wildfang Bodensee is a collective mark that is not a GI but indicates the geographical origin. https://www3.wipo.int/madrid/monitor/en/showData.jsp?ID=ROM.1654879

The logo for Wildfang Bodensee fish

### Disadvantages of protecting GIs through trade mark systems

Even though collective marks and certification marks could be an option for GI protection in jurisdictions where sui generis systems are not available, their limitations cannot be ignored:

- A collective or certification mark must be distinctive. This requirement is particularly difficult to meet in the case of GIs given that, by definition, a GI describes the origin of the products.
- Therefore, such a trade mark is generally not the geographical name alone, but a combination of verbal and graphical elements. Terms belonging to the public domain, e. g. geographical names, are usually not individually protected when they are parts of a combined trade mark.
- Unauthorised producers might be able to register a similar or misleading mark, potentially diluting the reputation of the GI.
- The protective power of trade marks is often limited by the need for individual ownership, use-based requirements, and weaker oversight regarding production standards and quality control.
- The costs are quite high, when considering the fees for renewal and the need to enforce the protection (e. g. opposition to subsequent trade marks applications).





A supermarket selling cheese labelled 'Gruyère', even though the cheese was not produced in the geographical area of the GI 'Gruyère'.

## 1.3 Unfair competition system

Aside from GIs and trade marks, laws on unfair competition and passing off, which tackle the issue of dishonest business practices, may offer certain protections in specific cases against misuse of GIs.

### Misrepresentation

Unfair competition laws prohibit in particular market practices that mislead the public. This could include misrepresentation of the geographical origin of products. ‹Passing off› occurs if one party misrepresents their goods or services as those of another, thus causing damage to the other party's established reputation. False representation of another party's products as one's own is also forbidden.

### Burden of proof

Enforcement of unfair competition practices is generally more complicated than the defence of a registered right, as it requires proof of an established reputation and of usurpation or confusion of consumers, damages, etc. Unfair competition laws are therefore not a sufficient standalone mechanism for GI protection, but rather a safety net if a denomination is not yet registered or cannot be registered.

### Disadvantages

The legislation on unfair competition and consumer protection includes general provisions aimed at protecting consumers and competitors against misrepesentation and free-riding, but it is not specifically designed to protect GIs.

## 1.4 Comparison of sui generis systems and trade mark systems

Sui generis GI systems and trade mark systems are both based on registration. Sui generis systems offer the most adequate and effective means of protecting GIs. This can be seen in the table below, which summarises the general features of both systems. The features that are particularly favourable for GIs are highlighted in bold and those which are particularly disadvantageous for GIs are highlighted in italic:

| Sui generis systems | Trade mark systems |
|---|---|
| **‹Best right› principle** | *‹First come, first served› principle* |
| **Pre-existing name** | *Sign must be sufficiently distinct from earlier trade marks* |
| Exclusively verbal form | Verbal or graphical form, combined or three-dimensional forms, sonic signs, etc. |
| **Descriptive character by nature** | *Descriptive nature constitutes grounds for refusal* |
| **No formal owner (right to PDO-PGI ≠ right over PDO-PGI)** | *Trade mark owner (licence, rules of use, transfer, etc.)* |
| **Collective use (in accordance with specifications)** | *Use regulated by the trade mark owner* |
| **Examination of production conditions, product characteristics and geographical area** | *No examination of product characteristics by the registering authority* |
| Public opposition procedure open to all interested parties (producers, local authorities, associations, etc.) | Opposition possible by the owner of an earlier trade mark. |
| Unlimited, without renewal | Duration of protection limited, but can be renewed indefinitely |

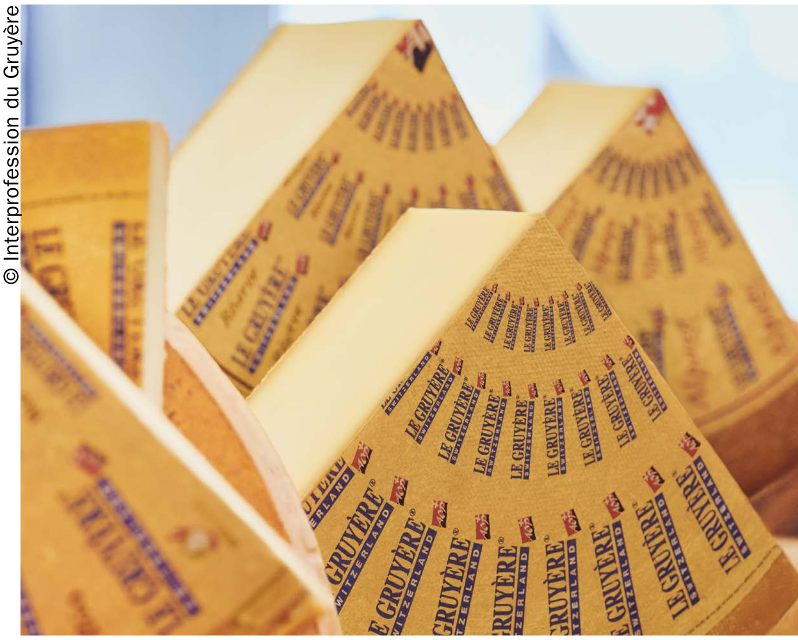
# 2 International protection of GIs

As with other forms of IP, GI rights are territorial in nature. In other words, a GI is a legally recognised right protected only in the jurisdiction and territory in which it has been registered. There is a need for extraterritorial (international) protection of GIs in a globalised economy as intense trade relations and global commerce provide a market for GI products anywhere in the world.

The Paris Convention of 1883, the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods of 1891 and the WTO's Agreement on Trade-Related Aspects of Intellectual Property Rights – TRIPS  of 1994 provide for general protection of GIs in all countries and regions that have signed the agreements (contracting parties), without applying to any particular designation. However, it is up to each party's jurisdiction to decide whether a designation should be considered a GI and be protected as such. Implementation is also left to each party's legal and administrative system.

For any given GI, international protection can be confirmed through two principal mechanisms: 1) direct registration in a third country; 2) protection through a bilateral agreement or the Lisbon System.

© Interprofession du Gruyère




Gruyère is a Swiss GI product that is also very well known internationally. The denomination "Gruyère" is also protected as a GI for a cheese originating in the neighbouring region in France.

## 2.1 Direct registration in a third country

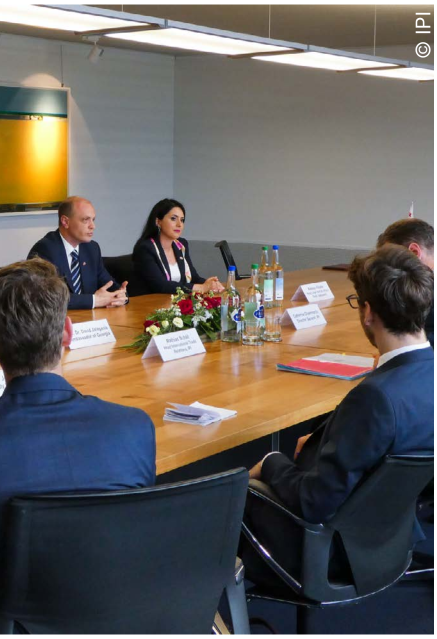
In line with the principle of national treatment set out in the TRIPS Agreement, most national *sui generis* registration systems are open to applications for foreign GIs. However, this possibility is not extensively used by GIs, because:

- it is costly i.e., a local lawyer usually has to be hired, and all documents have to be translated into the official language of the country concerned; and
- the procedure may be long, especially due to the difficulties for a given country's authorities in assessing the elements of a GI that is located in another country.

Despite these difficulties, as of April 1st, 2025, almost 60 non-EU GIs had been registered by the EU through direct applications (not counting designations registered under a bilateral agreement or those from UK since Brexit), but this remains a very limited number given that there are no fees and that applications can be submitted in a number of languages, including English.

GIs can also apply for a trade mark in a third country. But if their designation in their country of origin is a *sui generis* GI, they cannot use the WIPO Madrid System.

## 2.2 Bilateral agreements on GI protection



Representatives of the Georgian and Swiss intellectual property (IP) offices.

The number of bilateral agreements that mutually recognise and protect GIs has grown over the last 15 years. Nevertheless, the concept is not brand new: a number of such agreements were concluded between European countries in the 1960s and 1970s. Even the Treaty of Versailles in 1919 contained a provision on GIs, which banned Germany from using the French terms «Cognac» and «Champagne».

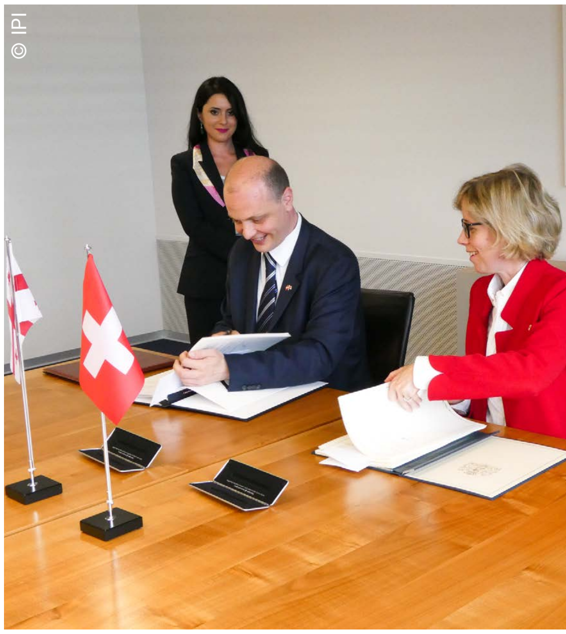
### Types of international agreement

Some of these agreements are in fact plurilateral agreements, meaning that they have more than two parties (e.g. the Trade Agreement between the EU, Colombia and Peru signed in 2012 and extended to Ecuador in 2016). But for the ease of reading, they are all designated as bilateral agreements in the text below. In addition, some of these agreements are stand-alone agreements, covering only the protection of GIs and in some cases indications of source as well, whereas the remaining agreements are free trade agreements (FTAs) or partnership agreements that cover many other issues. Stand-alone agreements are negotiated between like-minded countries with regards to the protection of GIs, whereas FTAs may provide GI protection for only one party within a global deal.

### Reasons for bilateral agreements

1. It is above all the EU that has used this type of agreement to develop a high level of protection for its GIs outside its territory. After the WTO multilateral negotiations on GIs froze in 2010, the EU increasingly negotiated bilateral agreements on GIs or included GIs in trade negotiations. This was mainly due to the fact that the protection level provided by the TRIPS Agreement is much lower than the protection provided in the EU, with the exception of GIs for wines and spirits (see module 1).
2. Another reason for the increase in bilateral agreements is the stalemate of the WTO's Doha Development Agenda (2001). This round of negotiations included discussions on extending the higher level of protection afforded to wines and spirits under Article 23 of TRIPS to other products as well. Since this extension was never agreed upon, many countries, including Switzerland and the EU, explored alternative solutions to obtain a higher level of protection for their GI products in other countries, including bilateral agreements.

For more detailed information on the negotiations on GIs at the WTO, visit: https://www.wto.org/english/tratop_e/trips_e/gi_e.htm



Nikoloz Gogilidze, Head of the Georgian IP office Sakpatenti, and Catherine Chammartin, Director General of the IPI, at the signing of the bilateral agreement on the protection of geographical indications and designations of origin in 2018.

Most bilateral agreements on GIs are negotiated with the following aims:

1. **To boost the level of protection:** A central objective in bilateral GI agreements is generally to get a higher level of protection in the territory of the contracting party than that available under national law and multilateral frameworks such as TRIPS. In some cases, the negotiation of a bilateral agreement leads to the establishment of a sui generis GI system or to the improvement of an existing sui generis GI system, in particular with regard to the protection standard.
2. **To create lists of protected designations:** Specific GIs are mutually recognised and protected by the parties, after public consultation to identify potential conflicts with other rights. This approach ensures clear and enforceable protection for the designated GIs, leaving less room for ambiguity or disputes. GIs can often be added or removed at a later date based on agreed procedures.
3. **To make GI lists more comprehensive:** In many agreements, all GIs of the parties that are recognised or protected at the national level are set out in the lists of protected designations. This means that the lists don't just include the most economically important GIs or wine and spirit GIs, but also «minor» GIs whose organisations would hardly have the resources to obtain international protection any other way (even the costs associated to the Lisbon System may be out of reach for some GI organisations).
4. **To make enforcement more efficient:** The government agencies (IP offices, authorities in charge of combating fraud, customs) of the contracting parties are often requested to provide structured enforcement mechanisms and to act ex officio.

Tenili cheese – a Georgian AOP product, which is also protected in Switzerland under the bilateral agreement on GIs between Georgia and Switzerland, concluded in 2018.

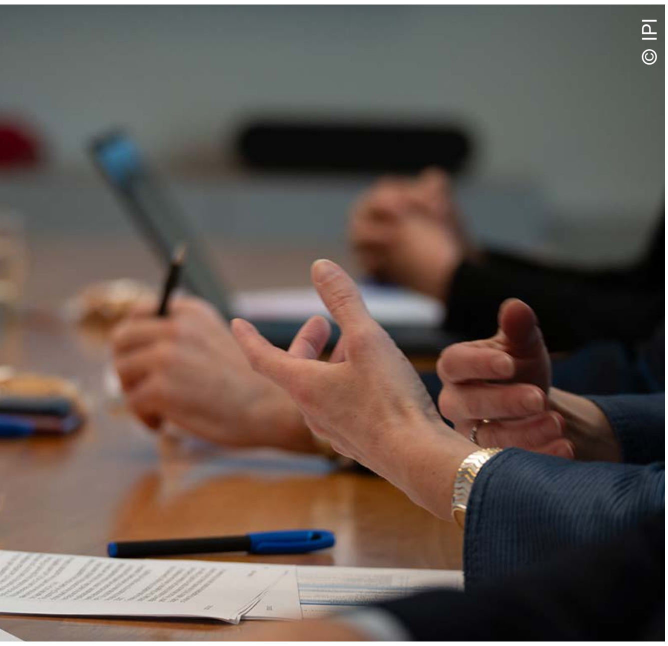
### Challenges of bilateral agreements

There are also challenges associated with bilateral agreements. The most significant difficulties are the length of the negotiation process, potential imbalances between the two parties and unequal bargaining power. This could be the case in particular if the parties have very different levels of development in their GI systems. For example, the EU often holds a stronger bargaining position than its partners, thanks to its robust and well-established GI system and its huge market.
There may also be an imbalance regarding the number of designations to be protected by the parties. If the two negotiating countries share the same views on the matter, the difference in numbers of protected GIs is not so important (mostly symbolic). However, it they do not share the same views, only a short list of GIs may be covered. For the last 15 years, the EU has only opened its market in return for protection for its GIs. This is one of the reasons why negotiations between the EU and Australia have not succeeded so far. Australia considers that the EU market is not open enough to justify protecting a list of EU GIs in return.

Moreover, GI protection can conflict with pre-existing trade mark rights, leading to legal disputes. It is, therefore, important that bilateral agreements specifically address this issue and set out provisions on coexistence with prior trademarks that might conflict with protected GIs.

Finally, effectively enforcing GI rights in partner countries can be a significant challenge, even with strong provisions. Enforcement requires resources, expertise, experience and a commitment from the partner country's government. This can be particularly difficult for countries with limited experience in GI protection and/or a rudimentary enforcement system.

Bilateral v. multilateral agreements
Despite these challenges, bilateral agreements remain one of the most efficient mechanisms for obtaining extraterritorial protection for GIs. However, the protection is per definition only within the territory of the other contracting party. Multilateral agreements, on the other hand, establish a minimum standard of protection across a large number of countries. That is why they remain a relevant mechanism for protecting GIs at the international level, in addition to bilateral agreements.


© IPI

## 2.3 The Lisbon System

### 2.3.1 Lisbon Agreement

The Lisbon Agreement, signed in 1958, and administered by the World Intellectual Property Organization (WIPO), emerged as a dedicated instrument for protecting appellations of origin (AOs). An appellation of origin is a specific kind of geographical indication that is produced entirely in a given region using raw materials exclusively from that region and that has certain characteristics typical for that region. While earlier treaties, like the Paris Convention of 1883 and the Madrid Agreement of 1891, provided some groundwork for protecting geographical names linked to products, the Lisbon Agreement formalised the concept of AOs, set out a protection standard and established an international registration system. By the late 2000s, a convergence of factors spurred the need to reform the Lisbon Agreement and create a more robust and inclusive system to protect all GIs.

### 2.3.2 Geneva Act to the Lisbon Agreement

The Geneva Act (2015) adopted certain modifications in order to address the shortcomings of the Lisbon Agreement:

1. **Expanded scope:** The most significant change was that the Geneva Act extends the protection under the system to GIs as defined in the WTO TRIPS Agreement. Both AOs and GIs enjoy the same high protection standard.
2. **Enhanced protection:** The Geneva Act increased the level of protection. It prohibits the following:
   - Use of the protected designation for goods of the same kind that do not originate in the geographical area of origin or that do not comply with other applicable requirements.
   - Use of the protected designation for goods that are not of the same kind as the AO or GI in question if such use would indicate or suggest a connection between those goods or services and the beneficiaries of the AO or GI and would be likely to damage their interests or impair or dilute them in an unfair manner, or take unfair advantage of that reputation. Any other practice liable to mislead consumers as to the true origin, provenance or nature of the goods.
   - Imitation of the AO or GI, even if the true origin of the goods is indicated or if the AO or GI is used in translated form or is accompanied by terms such as «style», «kind», «type», «make», «imitation», «method», «as produced in», «like», «similar» or the like.
   - Genericisation: AOs or GIs cannot be considered to have become generic.
3. **Relation with trade marks:** In order to address the concerns about potential conflicts between AOs/GIs and prior trade marks, the Geneva Act explicitly protects prior trade mark rights applied for or registered in good faith. Coexistence is an option that is left to the legislation of contracting parties.
4. **Increased flexibility:** The Geneva Act stipulates procedures for managing modifications to international registrations and the refusal and grant of protection. It also sets out options for contracting parties. For example, they can request information on the AO's or GI's link to its origin or on individual fees.
5. **Membership:** Initially, the Lisbon Agreement was only available to member states of the Paris Convention. The Geneva Act opened up membership to intergovernmental organisations (IGOs) such as the EU and the African Intellectual Property Organization (OAPI), which became contracting parties in 2019 and 2022 respectively.

Key differences between the Lisbon Agreement and its Geneva Act:

| Feature | Lisbon Agreement | Geneva Act |
|---|---|---|
| **Scope** | Limited to appellations of origin (AOs) | Expanded to include both appellations of origin (AOs) and geographical indications (GIs) |
| **Level of protection** | Protection against usurpation and imitation | Extended protection to also prevent the use of AOs/GIs for dissimilar goods and services |
| **Relations with trade mark** | Interaction with trade mark rights is regulated in less detail and less explicitly | Explicitly harmonises interaction with trade mark rights, safeguarding prior rights |
| **Membership** | Open to member states of the Paris Convention | Open to member states of the Paris Convention, WIPO members and IGOs |

### 2.3.3 Registration processes under the Lisbon Agreement and the Geneva Act

General information about the Lisbon System:
https://www.wipo.int/en/web/lisbon-system/

Main Provisions and Benefits of the Geneva Act of the Lisbon Agreement (2015):
https://www.wipo.int/publications/en/details.jsp?id=4346

Example of implementation (Switzerland):
https://www.ige.ch/fileadmin/user_upload/recht/international/e/A5_Lisbon_System_web_bf.pdf

## 2.4 Comparison between different registration systems

| Feature | Direct registration in one country | Registration under bilateral agreements | Registration under the Lisbon System |
|---|---|---|---|
| **How specific?** | A direct application can be submitted at any time, in line with the strategy of each GI organisation. | Bilateral agreements offer a high degree of specificity and tailoring, allowing countries to address their particular GI protection needs and constraints. They generally include lists of specific GIs to be mutually recognised and protected. This reduces ambiguity and potential disputes. | This is the global protection system for GIs (including AOs) administered by WIPO. The Lisbon Agreement and its Geneva Act establish an international registration system and provide a high protection standard. |
| **Which countries?** | A GI organisation may decide to apply in a third country according to its economic interests, legal context, etc. | One other country. Countries can strategically prioritise the protection of GIs that are particularly important to their economic and cultural interests (short list). | Extended protection to also prevent the use of AOs/GIs for dissimilar goods and services |
| **Potential for greater protection?** | No. The protection standard is set by the national legislation. | Yes. Bilateral agreements allow countries to push for stronger standards of protection. | Yes. The protection standard provided by the Geneva Act is the highest one. |
| **How flexible?** | National procedures apply. | Bilateral agreements can be more easily adapted to evolving circumstances. GIs can be added or removed from the protected list. | An international registration may be modified and a renunciation of protection (for a contracting party) may be withdrawn, etc. |
| **Risk of imbalance?** | No. | Yes. Negotiations can lead to imbalances, particularly if parties have significantly different levels of development in their GI systems. This could cause a stalemate of negotiations. | The applicable rules are agreed among the Lisbon Union Members (in principle by consensus). |
| **How expensive?** | A direct application is quite costly, even if there are no administrative fees. | Bilateral agreements entail multiple intensive separate negotiation processes with each country/party. This is very expensive, especially as GIs only receive protection in the few countries involved. | The registration fees and the individual fees in the Lisbon System are moderate, but can still represent an obstacle for small GI organisations. |
| **Market access?** | Direct registration may facilitate market access, e.g. giving GIs the right to use the national official symbol. | Bilateral agreements only regulate the protection of GIs in the countries involved, but agreements may facilitate exports. | The Lisbon System is an easy way to get protection in all contracting parties, but it does not address market access. |
| **Resolution of conflicts with prior rights?** | Resolution in line with national law and procedures. No deal negotiation possible. | Resolution via different means set out in the agreement itself. Deal negotiation possible. | Resolution in line with national law and procedures of the contracting parties. Information available in Lisbon Express database. Direct negotiations possible. |
| **What type of enforcement?** | Under national legislation, the same mechanisms apply to all national and foreign registered GIs. But the costs are higher for a foreign GI due to the need for translations, a local agent, etc. | Most bilateral agreements provide for assistance between the countries involved in case of infringement. National legislation also applies. | The Geneva Act sets out a protection standard and enforcement means for GIs in the contracting parties. The Lisbon System allows direct negotiations between contracting parties. |

## Imprint

Edited and published by the Swiss Federal Institute of Intellectual Property (IPI).

This publication was prepared within the framework of the Swiss PartnershIP – Intellectual Property Cooperation Programme and co-funded by the Swiss State Secretariat for Economic Affairs (SECO) and the IPI.

Swiss PartnershIP
Intellectual Property Cooperation Programme

**Authors:**
Erik Thévenod-Mottet, Zeinab Ghafouri, Nicolas Guyot, Reto Meili (IPI)

**Project management and translation:**
Swiss Federal Institute of Intellectual Property

**Graphic layout and typesetting:**
Ammarkt AG

**Image credits:**
See individual images for details