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# Geographical Indications and Development in the Third World: Towards a Strategic Approach of Intellectual Property Rights in Jamaica - The Case of Blue Mountain Coffee

Marsha Simone Cadogan

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**GEOGRAPHICAL INDICATIONS AND DEVELOPMENT IN THE THIRD WORLD:  
TOWARDS A STRATEGIC APPROACH OF INTELLECTUAL PROPERTY RIGHTS IN  
JAMAICA – THE CASE OF BLUE MOUNTAIN COFFEE.**

MARSHA SIMONE CADOGAN

A DISSERTATION SUBMITTED TO  
THE FACULTY OF GRADUATE STUDIES  
IN PARTIAL FULFILLMENT OF THE REQUIREMENTS  
FOR THE DEGREE OF  
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## **Abstract**

The dissertation is a critical analysis of, and engagement with agricultural and food based geographical indications, the politics of development and international relations, and the prospects of forming reformist linkages between geographical indications and development in Jamaica and the Caribbean's intellectual property landscape. A net importer of intellectual property, Jamaica has yet to fully claim intellectual property as its own.

The dissertation proposes that geographical indication schemes should be envisaged, and practically function as part of Jamaica's development policy. This approach calls for a reformist approach to intellectual property in Jamaica, which includes an awareness of the pitfalls of being a repository base for the hegemons' intellectual property ideals. I approach development and intellectual property rights in the Third World as two terms that are often incongruent with each other, absent a participatory and strategic approach to sustaining viable linkages between the two concepts. A counter-hegemonic intellectual property strategy for Jamaica and the Caribbean focuses on domestic and regional coalition building between key stakeholders, a path that is not without its challenges.

Blue Mountain coffee is used to illustrate and conceptualize a notion of intellectual property working from a Third World people based perspective: for the benefit of those who are often forgotten in Blue Mountain coffee's value chain. I critically address domestic and international challenges that are likely to affect the positioning of

geographical indications as an intellectual property asset of development in Jamaica. From the analyses, the most significant international issues relate to reciprocal rights recognition for geographical indications and product pricing, a factor that is dependent on consumer demand. Power and politics in the international relations of geographical indications impact its ability to be a counter-hegemonic force in Jamaica's intellectual property futures. The role of Jamaica's political culture in facilitating developmental changes through geographical indications is also crucial to the success of the initiative.

International jurisdictional differences over the precise scope of protection accorded to geographical indications are a significant obstacle to the advancement of rights domestically. The dissertation theoretically and practically tackles these issues, and suggest policy recommendations to overcome identified challenges.

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## Acronyms

AOA	Agreement on Agriculture
CARICOM	Caribbean Community
CETA	Comprehensive Economic Trade Agreement
CIB	Coffee Industry Board
EPA	EU-Cariforum Economic Partnership Agreement
EU	European Union
GI	Geographical Indications
IPR	Intellectual property rights
JCGA	Jamaica Coffee Growers Association
JIPO	Jamaica Intellectual Property Law Office
RBFTA	Regional and Bilateral Free Trade Agreements
TRIPS	Trade Related Aspects of Intellectual property right
WIPO	World Intellectual Property Office
WTO	World Trade Organization

## Chapter One: Introduction and Background

### 1. Introduction

The thesis is a critical analysis of food based geographical indications<sup>1</sup> and development in the Third World<sup>2</sup> amidst the political dynamics of the international relations of an imperial centric intellectual property rights regime. The thesis narrows its focus by using Jamaica and its Blue Mountain coffee to illustrate the potential broad based benefits of agricultural and food based geographical indications.

A geographical indication is a concept and law that emerged in Europe as a means of safeguarding a burgeoning and lucrative industry of wines, spirits and specifically unique origin based agricultural and products.<sup>3</sup> Europe has succeeded in building geographical indications as legal and economic empires within Europe and beyond European borders.<sup>4</sup>

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<sup>1</sup> Throughout the dissertation, I use the term agricultural and food based geographical indications to refer to products that have a direct or proximate link to agricultural produce, such as coffee, nutmegs, teas and yams. My characterization of food based products include refined foods and meats manufactured using specific processes that fall within the definitional parameters of geographical indications (example, Kobe beef from Japan, and Roquefort cheese from France).

<sup>2</sup> The Third World may be a geographic space with historical colonial experiences which have produced structures and processes of continued dominance of its peoples. The Third World is also interpreted as a non-geographical space, but as a state of being - the marginalization of impoverished communities, the act of impoverishment on peoples, violence, corruption, and processes which produce unfavorable social, legal, economic and/or political conditions in societies. Balakrishnan Rajagopal, "Locating the Third World in Cultural Geographies" (1998-1999) *Third World L S* 1 at 2.; Amar Bhatia, "The South of the North: Building on Critical Approaches to International Law with Lessons from the Fourth World" (2012) 14:1 *Ore Rev Intl L* 131; Makua Mutua, "What is TWAIL" (2000) 94:1 *Am Soc Intl L* 31 at 31. I discuss these points in chapter 3.

<sup>3</sup> Valdim Mandrov, *European Union Law on Indications of Geographical Origin* (New York: Springer, 2014) at 31-41. [Mandrov, "European Union GIs"].

<sup>4</sup> *Ibid.* I argue in later chapters that there are imperial dimensions to European Union and Switzerland's expansion of geographical indication interests in the Caribbean and other countries. The European Union and Switzerland have managed to exert powerful influence in safeguarding the rights of its geographical

In Europe, agricultural and food based geographical indications accounted for 15.4 billion Euros (\$23 billion two hundred and seventy-five million six hundred and sixty-one thousand, four hundred and sixteen Canadian)<sup>5</sup> in 2012.

Registered geographical indication products from Europe include Jambon de Bayonne (dried cured meats) and Parmigiano Reggiano (cheese from Italy), as well as specified cherries, welsh pork, ham, cheeses, and other types of dairy products.<sup>6</sup> In other jurisdictions, registered and well-known geographical indications include South Africa's Roobios tea and Columbia's café de Columbia. In recent years, and as a result of the proliferation of regional, bilateral and pluri-lateral<sup>7</sup> trade agreements between the European Union and regions/countries such as Central America, Africa, the Pacific and the Caribbean, there is an increase interest in either a *sui-generis*<sup>8</sup> geographical

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indication products internationally. However, I further argue that countries with geographical indication resources can counteract this subtle but persistent hegemonic behavior by promoting their own form of agricultural and food based geographical indications, that are sustainable by consumer demand, reciprocity in legal protection amongst trading partners, effective market penetration strategies, a focus on key stakeholder interests, and cultivation practices.

<sup>5</sup> I used the rate of exchange as at January 21, 2016 Euro to Canadian dollars (\$1.554 Canadian to \$1 Euro).

<sup>6</sup> Europa Database (Available online at Europa, <http://ec.europa.eu/agriculture/quality/door/list.html>, last accessed January 21, 2016).

<sup>7</sup> A pluri-lateral agreement is a trade agreement between more than two countries crossing geographical or continental spaces. The most recent significant pluri-lateral agreement is the Trans-Pacific Partnership Agreement (TPP) between Canada, Mexico, Singapore, Vietnam, the United States, Peru, Chile, Japan, Australia, Brunei Darussalam, Malaysia and New Zealand. On pluri-lateral agreement see Bernard M. Hoekeman and Petros C. Mavroidis, "Embracing Diversity: Pluri-lateral Agreements and the Trading System" (2015) 14:1 *World Trade Rev* 101. Hoekeman and Mavroidis argue that pluri-lateral agreements allow for signatories to discriminate on chosen and implemented policies, procedures and rules, by excluding non-members from the benefits and rules of these agreements.

<sup>8</sup> In the dissertation, *sui-generis* is used to refer to a legislation that is distinct and of its own kind from other types of legislation that may pertain generally to a similar subject matter. A *sui-generis* legislation is

indication legislation, or the use of the legislation to register and develop products for commercialization purposes.<sup>9</sup>

Article 22.1 of the Trade Related Aspects of Intellectual Property Rights (TRIPS)<sup>10</sup> defines a geographical indication as a sign which identifies 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. There are a number of factors that are implicated in this interpretation of geographical indications.<sup>11</sup> In order for a product to be qualified as a geographical indication, there must be a direct linkage between particular characteristics of the

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designed to meet the specific needs of its subjects and the area of law that pertains to the subject. See generally, Deekshitha Ganesan, “Sui generis Is the Answer: Positive Protection of Traditional Knowledge in India” (2016) 11:1 *J Intell Prop L & P Prac* 49.

<sup>9</sup> I have chosen to separate and identify two outlooks on geographical indications in the preceding sentence, as Jamaica, the Caribbean and other regions in the Pacific and Africa have enacted the legislation, but have either no domestic products registered under the legislation, or have only recently engaged with the legislation. Throughout the dissertation, I draw on the two perceptions of geographical indications – as a safeguard for European Union based registered products, and as a form of counter hegemony in an imperialistic intellectual property structure, to show the possibilities and potential futilities of geographical indications (the law) in the global intellectual property rights debate.

<sup>10</sup> Uruguay Round Agreement: Trade Related Aspects of Intellectual Property Rights, Standards Concerning the Availability, Scope and Use of Intellectual Property Rights. Part II, Section 3 Article 22:1. [*TRIPS, GI*]. Albrecht Conrad, “The Protection of Geographical Indications in the Trips Agreement”, (1996) 86 *TMR* 11. On the definition of geographical indications see, Mandrov, “*European Union GIs*” *supra* note 3 at 31-41; Tesh Dagne, “Beyond Economic Considerations: (Re)Conceptualizing Geographical Indications for Protecting Traditional Agricultural Products” (2015) 46:6 *Intl Rev I P C L* 682; Marsha A. Echols, “The Geographical Indications Disputes at the WTO” in Marsha Echols, *Geographical Indications for Food Products, International Legal and Regulatory Perspectives* (Austin: Wolters Kluwer, 2008). [Echols, “*Geographical Indications for Food Products*”].

<sup>11</sup> The historical origin and international legal debates concerning the use of geographical indications are discussed at length in Chapter 4.

product and its territory of origin.<sup>12</sup> The product characteristics are based on its terroir<sup>13</sup> and may be related to its distinct taste, which is influenced by the climate, soil type in the geographical area, and the products' cultivation practices. Local knowledge associated with the processing of the product may also be an essential factor in designating the product as a geographical indication. The production process involved in Venezuela's Chuao Cocoa Bean illustrates the associated characteristics necessary to support the product's affiliation with a geographical indication. The cocoa bean is grown in the small rural village of Chua (the geographic area). In order to produce and maintain its distinctive taste, the production process includes the fermentation and drying of the beans on a special type of flooring.<sup>14</sup>

There is no requirement for the geographical indication to be indigenous to the specific locality. The product's historical origin may have been traceable to migratory practices of early colonizers involved in plantation farming and agricultural practices generally.<sup>15</sup>

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<sup>12</sup> Angela Treagar et al, "Regional Foods and Rural Development" (2007) 23:1 *J Rural Stud* 12; J.S. Canada & A. Vazquez, "Quality Certification, Institutions, and Innovation in Local Agro-food Systems: Protected Designation of Origin of Olive Oil in Spain", (2005) 21:4 *J Rural Stud* 475; Echols, Geographical Indications for Food Products, *supra* note 10; Dominique Barjolle & Bertil Sylvander, *Protected Designations of Origin and Protected Geographical Indications in Europe: Regulation or Policy*, Final Report, FAIR 1-CT 95-0306. Emile Vandecandalaere et al, Linking People, Places and Products, FAO-SINER-GI (Available online at ORiGin, [www.foodquality-origin.org/guide/guide.pdf](http://www.foodquality-origin.org/guide/guide.pdf)).

<sup>13</sup> The term "terroir" links the production of the product with its geographic area by highlighting distinctive characteristics of the product which emerges from its association with a specific territory. Tim Josling "The War on Terroir: Geographical Indications and Transatlantic Trade Conflict" (2006) 57:3 *J Agri Econ* 337.

<sup>14</sup> Estelle Bienabe & Dirk Troskie, GI Case Study: Rooibos, SINER-GI December 2007. Jorge Larson, *Relevance of Geographical Indications and Designations of Origin for the Sustainable use of Genetic Resources*, (Rome: Global Facilitation Unit for Underutilized Species, 2007, [Larson, "GIs and Sustainable Use of Genetic Resources"]).



By way of example, the coffee tree is indigenous to Ethiopia and was brought by merchants to different sections of Europe. Originally, three coffee plants were sent by the French King, Louis XV to his colony St. Martinique, in the Caribbean. Two of the coffee plants died, but the third was brought to Jamaica by the former governor of Jamaica, Sir Nicholas Lawes in 1728.<sup>16</sup>

Jurisdictions which have implemented a geographical indication legislation have either adopted Article 22.1 of *TRIPS*, or a variation of its wording. As an example, India's legislation requires that manufactured goods are only registrable as geographical indications if either the manufacturing, production or its preparation takes place in its geographical origin.<sup>17</sup> Jamaica's GI legislation is all encompassing, and is more in semblance to Article 22.1 wording.<sup>18</sup>

Geographical indications are a multifaceted form of intellectual property right. It acts as a signal of the product's origin and quality. Its distinct characteristics also differentiate

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<sup>16</sup> J.G Vaughn & C.J. Geissler, *The New Oxford Book of Food Plants* (New York: Oxford University Press, 1998). The book provides detailed information on the origin of various plant crops; History of Jamaica's Blue Mountain Coffee, Jamaica Gleaner, (Online at Jamaica Gleaner, <http://jamaica-gleaner.com/pages/history/story0029.html>).

<sup>17</sup> The Geographical Indications of Goods (Registration and Protection) Act 1999, Section 2 (1), (Available online, World Intellectual Property Office, [http://www.wipo.int/wipolex/en/text.jsp?file\\_id=128105](http://www.wipo.int/wipolex/en/text.jsp?file_id=128105)).

<sup>18</sup> The Protection of Geographical Indications Act, 2004, (Available online, World Intellectual Property Office, <http://www.wipo.int/edocs/lexdocs/laws/en/jm/jm004en.pdf>). I discuss Jamaica's legislation further in Chapter 3. Jamaica's geographical indication legislation is bi-functional and is intended to safeguard both alcoholic and non-alcoholic based products. As such, wine and spirit product such as rums can be registered under the legislation.

geographical indication products from similar classed products.<sup>19</sup> Geographical indications also act as a modality of control in the commercialization and production of registered products in two ways. The use of the geographical indication sign militates against infringing uses of the designation in reciprocal jurisdictions.<sup>20</sup> Control also works in restricting stakeholder involvement in the production and/or manufacturing of the geographical indication product, by placing territorial zoning limits on cultivation areas within concerned communities.<sup>21</sup>

In the dissertation two arguments are presented specific to Jamaica and the Caribbean, but also relevant in the narrative of Third World peoples and their usage of intellectual property. Jamaica's engagement with international intellectual property rights law is too keenly focused on the protection of foreign rights, and the representation of local elite interest in its domestic intellectual property rights narrative. Comparatively too little

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<sup>19</sup> Cerkia. Bramley & Estelle. Bienebe, "Why The Need to Consider GIs in the South", In Cerkia Bramley & Estelle Bienebe, *Developing Geographical Indications in the South, The Southern African Experience* (New York: Springer, 2012) at 1-12.

<sup>20</sup> Infringements may still occur, but are likely to be dealt with more effectively in jurisdictions that mutually recognize geographical indications in their laws.

<sup>21</sup> In explaining this point, I provide two examples. Rooibos tea is produced from a rare plant, the Fybios Biome in the sub-Saharan tip of Africa. Droughts during the hot summers and rain during the winter gives the Fybios Biome a distinct taste. The inability of the plant to grow outside of these conditions (naturally) limits the production area of the Fybios Biome to this region. Jamaica's Blue Mountain coffee, though not a geographical indication, is grown in specific regions of the country's mountainous high altitude Blue Mountain regions. Cultivators of coffee below such levels are legally precluded from using the name "Blue Mountain to associate with their beans.

attention is allocated to the practical and strategic<sup>22</sup> development of domestic proprietary rights.

Fifty-four years of colonial independence from Britain is still plagued by an imperial<sup>23</sup> international law<sup>24</sup> which facilitates subjugation of domestic intellectual property interests, and promote the interests of transnational capital classes.<sup>25</sup> Without finding, engaging in, and promoting appropriate forms of intellectual property rights locally, Jamaica and the Caribbean region will continue to be a repository for the intellectual property rules of the west. In this paradigm, notions of intellectual property as assets, intellectual property as aids in developmental policies and intellectual property as the

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<sup>22</sup> I use the word strategic to refer to policies, plans, legislation and regulation enactments, market penetration goals, and objectives that are planned and targeted after careful consideration of how best to achieve clearly defined objectives.

<sup>23</sup> In Antony Anghie's provocative and seminal book on imperialism and its effects on international law, the maneuvers, paths and mechanisms through which Europe polarized a particular ideology of international law is brilliantly explored and critiqued. Anghie explains how the Third World as a geographical peculiarity and as a politically imagined space became and continues to be a repository of the west ideals of how law should work in subjugated spaces. Antony Anghie, *Imperialism, Sovereignty and the Making of International Law*, (New York: Cambridge University Press, 2004).

<sup>24</sup> T.J Lawrence, *The Principles of International Law* (Boston: DC Heath & Co, 1895) at 14. Lawrence explains the emergence of an Eurocentric international law, and the role of historical events in Europe in producing an international legal system to govern relations between itself and its subject territories. The reference to the problems with international law as traceable to its Eurocentric roots is extensively dealt with by Angie, "the Making of International Law", *Ibid*, and Marti Koskenniemi, *Colonization Of the 'Indies' – The Origin of International Law?* Presentation at University of Zaragoza, December 2009).

<sup>25</sup> I refer to transnational capital class as those groups of individuals, international organizations and other bodies which have gained and established influential economic and/or political presence in non-home territories by their involvement in globalization activities. This includes involvement in international trade and investment endeavors. William I. Robinson & Jerry Harris, "Towards A Global Ruling Class? Globalization and the Transnational Capitalist Class", (2000) 64:1 *Sci & Soc* 11.

catalyst to the knowledge economy will only be illusory concepts to the Caribbean region.

### **1.1. Research Objective**

The thesis focuses squarely on the legal regime that governs intellectual property rights in Jamaica and interrogates the implications, challenges, benefits and prospects of registering Blue Mountain Coffee as a geographical indication. The research objective is to create workable relationships between geographical indications, specific agricultural and food based products in Jamaica, and a development oriented policy that recognizes that absent a participatory approach, intellectual property is unworkable as a counter hegemonic revolutionary mechanism. I make the argument that if, appropriately configured, this counter-hegemonic approach can re-orientate Jamaica's intellectual property narrative to foster socio-economic improvements in peoples' welfare, preserve and promote cultural heritage, and add commercial value to local registrable resources.

Jamaica has a number of agricultural and food products that are well-known for their unique taste and type based on their geographic area, cultivation and processing practices and cultural significance. I chose Blue Mountain coffee as a case study for the following reasons. Firstly, Blue Mountain coffee is a commercially established food product in local and international consumer jurisdictions.<sup>26</sup> Secondly, the coffee is registered as a

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<sup>26</sup> As I discuss in chapters 4-7 the major consumer markets for Blue Mountain coffee are Japan, the United States and Europe. China is an emerging consumer market for Jamaica's Blue Mountain coffee.

trademark and, therefore, the relationship between the food product and an intellectual property right system has already been established.

Thirdly, my arguments throughout the chapters implicate incorporating geographical indications scheme within the framing of domestic development policy. I also argue that a counter hegemonic approach to intellectual property rights in Jamaica must prioritize the involvement of as many segments and sectors of the Jamaican populace as is practically possible.

As of January 21, 2016, there are approximately 6000 coffee farmers involved (or were involved)<sup>27</sup> in the cultivation and sale of Blue Mountain coffee. An agricultural or food based geographical indication scheme is effective when it is viable, feasible and sustainable – factors and attributes that are only possible when there is congruence between how it operates, and the quantity and quality of its influence on key stakeholders’<sup>28</sup> lives.<sup>29</sup> Coffee exports accounted for 30% of Jamaica’s agricultural exports in 2009 or United States \$33,615.00 million.<sup>30</sup> Its production value, though lower

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<sup>27</sup> Interview with Rep of Jamaica Coffee Growers’ Association (January 21, 2016).

<sup>28</sup> I refer to key stakeholders as Blue Mountain coffee farmers, Blue Mountain coffee dealers, individuals living in or in neighboring communities, the Coffee Industry Board, and other government departments such as the Jamaica Tourist Board and diaspora participation groups.

<sup>29</sup> I discuss this argument extensively in Chapters 5- 7 of the thesis.

<sup>30</sup> This information was provided by statistical reports from Jamaica’s Coffee Industry Board (July 2015); more up to date information was not available.

than traditional exports such as raw sugar,<sup>31</sup> favors comparatively well with traditionally exported agricultural based products. Therefore, Blue Mountain coffee is an economically rewarding venture with potentially positive cross-sectorial spill-over effects for diverse stakeholders. The interest in using Blue Mountain coffee as a part of my case study is grounded in these reasoning.

Despite proposition in the academic literature between conventional<sup>32</sup> forms of intellectual property right and development, there is insubstantial evidence implicating this paradigm in many Third World societies.<sup>33</sup> Instead, the internationalization of intellectual property right in the Third World has solidified<sup>34</sup> a hegemonic<sup>35</sup> teleological

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<sup>31</sup> Note as well that there is no proven unique characteristic about Jamaican sugar for its certification as a geographical indication. Sugar exports from Jamaica was valued at US \$72 million in 2011/12. United States Department of Agriculture, Global Agricultural Information Network, May 13, 2014 (Available online [http://gain.fas.usda.gov/Recent%20GAIN%20Publications/Sugar%20Annual Kingston Jamaica 5-13-2014.pdf](http://gain.fas.usda.gov/Recent%20GAIN%20Publications/Sugar%20Annual%20Kingston%20Jamaica%205-13-2014.pdf), last accessed August 4, 2016).

<sup>32</sup> The distinction between conventional and unconventional forms of intellectual property rights is trenchantly articulated by Chidi Oguanaman, who notes that conventional IPRs are a western construct and exist to perpetuate the dominant paradigm in the global IP system. Chidi Oguanaman, "Localizing Intellectual Property in the Globalization Epoch: The Integration of Indigenous Knowledge" (2004) 11 *Ind J Glob Leg S* 2.

<sup>33</sup> Ikechi Mgbeoji, TRIPS and TRIPS-PLUS Impacts in Africa in Daniel Gervais, ed. *Intellectual Property Trade and Development, Strategies to Optimize Economic Development in a TRIPS-Plus Era*, (New York: Oxford University Press, 2007) 294. [Ikechi, "TRIPS and TRIPS Plus in Africa"]; Margaret Chon, Intellectual Property and Development Divide, (2007) 27 *Cardozo L Rev* 2821, *Global Property Rights, Access Knowledge and Development*, Peter Drahos & Ruth Mayne (eds.), (New York: Palgrave MacMillan, 2000); Peter Yu, The Global Intellectual Property Order and its Undetermined future, (2009) *WIPO* 1; Peter Yu, Building Intellectual Property Coalition for Development (*Centre for International Governance Innovation*, Working Paper Series No. 37); Chidi Oguanaman, *Intellectual Property in Global Governance: A Development Question*, (London: Routledge, 2012).

<sup>34</sup> I use the term solidified as I argue that prior to TRIPS, the tendency of western countries to misappropriate resources from the Third World as intellectual property, as well as to insist on protectionist mechanisms still existed, but not to the level and intensity that it now persists.

approach to its usage and relevance to Third World peoples. Conventional forms<sup>36</sup> of intellectual property are western constructs of rights. Intellectual property right<sup>37</sup> laws are substantially mobilized to commodify and expropriate an increasing number of intangible resources from the region, without due regard for the Third World narrative. In the Third World, international law<sup>38</sup> has enabled the proliferation of an intellectual

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<sup>35</sup> Antonio Gramsci, *Selections from the Prison Notebooks*, Quentin Hoare & Geoffrey Nowell Smith eds. (London: Elecbook, 1999), Joseph Femia, "Hegemony and Consciousness in the Thought of Antonio Gramsci" (2006) 23:1 *Pol Stud* 29; Robert W. Gordon, "New Developments in Legal Theory" in David Kairys (ed) *The Policies of Law: A Progressive Critique* (New York: Perseus Books, 1998). Gwyn Williams, "Gramsci's Concept of Egeomnia" (1960) 21:4 *Hist Ideas* 586. The reference to hegemony is based on the Gramscian concept of the term. The concept as used throughout this thesis, relates to the dominance of states and institutions in international relations and international law discourse, as well as the dominance of specific actors in civil society. This also influence asymmetries in the interplay between intellectual property rights and development in the Third World.

<sup>36</sup> Daniel Gervais, *Trips and Development* in Daniel Gervais, ed. *Intellectual Property Trade and Development, Strategies to Optimize Economic Development in a TRIPS-Plus Era* (Oxford: Oxford University Press, 2007) 3. Gervais argues that adequate intellectual property rights protection is required to sustain economic development. The author claims that there is a greater likelihood of increases in foreign direct investment if a country has stringent intellectual property policies; Keith E. Maskus. *Intellectual Property Challenges for Developing Countries: An Economic Perspective* (2001) 4 *U Ill L Rev* 471: Maskus opines that developing countries are likely to encounter challenges in the new intellectual property rights regime that punctuate the international fora. However, Maskus asserts that a strong intellectual property rights regime will lead to economic growth in developing countries if their economies are open to international trade and investment; Amy Joceylyn Glass & Kamal Saggi, (2002) 56:2 *J of Int'l Econ* 387: the authors argue that robust intellectual property rights laws do not prevent infringement on a greater level in developing countries compared to firms in the north.

<sup>37</sup> Peter Drahos, *The Universality of Intellectual Property Rights: Origin and Development* (Online: <http://www.wipo.int/tk/en/hr/paneldiscussion/papers/pdf/drahos.pdf>). B.S. Chimni, *A Just World Under Law: A View from the South*, (2007) 22:1 *Am U Intl L Rev* 198; Ikechi Mgbeoji, *Global Bio piracy: Patents, Plants and Indigenous Knowledge*, (Vancouver: UBC Press, 2006).

<sup>38</sup> Marti Koskenneimi, "The Origin of International Law", paper presented at University of Zaragoza, December 2009, James T. Gathii, "International Law and Euro-centricity", (1998) 9:1 *Eur J Intl L* 184. James T. Gathii, "Neoliberalism, Colonialism and International Governance: Decentering the International Law of Governmental Legitimacy" (2000) 98 *Mich. L Rev* 1996; James Gathii, "Alternative and Critical: The Contribution of Research and scholarship on Developing Countries to International Legal Theory" (2000) 41 *Harv Int'l L J* 263. Ikechi Mgbeoji, "The Civilized Self and The Barbaric Other: imperial Delusions of order and the Challenges of Human Security, in Richard Falk, Balakrishnan Rajagopal & Jacqueline Stevens, *International Law and the Third World, Reshaping Justice* (Oxon: Routledge-Cavendish, 2008), [Falk: "*International Law and the Third World*"]; Balakrishnan Rajagopal, "Counter-hegemonic International Law: Rethinking Human Rights and Development as a Third World Strategy, in "Falk: *International Law and the Third World*.

property rights regime which advances the interests of local elites, and sustain the property interests of hegemonic states. Intellectual property rights laws have engendered significant asymmetries in property rights recognition between the periphery and the core. It continues to function in the Third World as a hegemonic instrument which, if left unfettered, produces imperialist outcomes of expropriation, under-valuation of Third World peoples' resources and a disregard of their knowledge in international intellectual property networks.

I make the argument that agricultural and food based geographical indications are a form of counter hegemony in Jamaica's intellectual property rights narrative. The argument is not suggestive that geographical indication registration on its own is counterhegemonic, but rather, asserts that through effective local management of geographical indications, legal reciprocity of rights in major international consumer markets, effective market penetration strategies, and strategic alliances with key regional and international actors, counter hegemony through geographical indications is feasible. As such, the integration of geographical indications as part of development policy works to create outcomes that represent the interests of Caribbean peoples, and Third World communities generally.<sup>39</sup>

## **1.2. Research Questions**

The research focuses on the feasibility of utilizing Blue Mountain coffee as geographical indication assets of development in Jamaica. As such, the research questions posed by the thesis are as follows. Is a re-orientation of Jamaica's intellectual property right

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<sup>39</sup> I discuss this argument extensively in chapters 3-8 of the thesis.



module necessary? On what basis does Jamaica's geographical indication legislation offer avenues for countering the asymmetric trajectory of intellectual property right in Jamaica? Can intellectual property strategizing be incorporated into a development policy that is framed on geographical indication as a counter hegemony in Jamaica's intellectual property discourse? As one of Jamaica's most viable agricultural and food based commodities,<sup>40</sup> on what grounds can Blue Mountain Coffee be envisaged as a geographical indication asset? Most of my research questions directly or indirectly implicate sound domestic development policy as an imperative and critical theme in the query.

Theorizing about development's relationship with intellectual property rights in the Third World is problematic because of economic and political power imbalances between the core and the periphery. These asymmetries institutionalize and internalize norm setting agendas which substantially promote the recognition of foreign based propriety rights in intellectual property. Importantly, the Eurocentric dimension of geographical indications laws, and lack of international consensus on its protection, led to inconsistencies in the scope and availability of intellectual property protection.

However, as I explain in later chapters, agricultural and food based geographical indications engage concepts of collective ownership rights in domestic intellectual property. Such a conceptualization brings to the fore emancipatory prospects of the

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<sup>40</sup> Jamaica Coffee Industry Board Report, (2014).

‘local’ engaging in and with global communities on counter hegemonic terms. The idea of agricultural and food based geographical indications as counter hegemony to global IP imperialism, also requires local stakeholders to practice self-reflexivity<sup>41</sup> in their everyday approaches to the commercialization and management of geographical indication resources. I discuss this point in chapters 6 and 7 of the thesis.

### **1.3. Significance of the Study**

I address Jamaica’s approach to intellectual property right policies in general, by analyzing the unidirectional influence of international actors which have shaped the country’s perception and engagement with dominant forms of intellectual property. The paragraphs below critically address the politics, both international and domestic, that have influenced Jamaica’s intellectual property rights configuration.<sup>42</sup>

As a mode of trade liberalization, the General Agreement on Tariffs and Trade (GATT) not only represented a means of accessing foreign merchandise, and gaining preferential tariffs on agricultural export items,<sup>43</sup> but also launched a new asymmetric relationship in

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<sup>41</sup> In this context, I use the term self-reflexivity to mean mindfulness of an individual’s practices, as a member of an organized group. Individuals’ action may either foster or inhibit the group from meeting its objectives. I argue that the more individual ambitions are aligned with the collective based goals of a GI group, the greater is the likelihood of success in GI strategizing.

<sup>42</sup> In later chapters, the research illustrates that absent a strategic focus on the development of forms of intellectual property that focuses on the commercialization of local well-known products, and a large or substantial segment of the Jamaican under privileged population in its management and commercialization, Jamaica’s geographical indications legislation may further perpetuate the proliferation and sustenance of hegemonic interests.

<sup>43</sup> Jamaica became a contracting party to the international trade system of General Agreement on Tariffs and Trade (GATT) shortly before its independence from Britain in 1962: Jamaica, Ministry Paper No. 24, Jamaica’s Participation in the General Agreement on Tariffs and Trade, June 06, 1962.

Jamaica's international relations narrative. It facilitated the imposition of an intellectual property right system which reinforced the proprietary rights of hegemonic interests. This was made possible through greater trade association with the United States, and by membership to the World Trade Organization.

Jamaica's membership to *the Caribbean Basin Initiative* ("CBI")<sup>44</sup> trade agreement in 1983 was partially premised on the United States' interests in militating against alleged infringement of its proprietary rights in Jamaica.<sup>45</sup>

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<sup>44</sup> The Caribbean Basin Initiative was a United States led trade agreement between the Caribbean, Latin America and the United States. Its objective was to encourage foreign direct investment and economic growth in member countries. Michael Campbell, "The Impact of the Caribbean Basin Initiative Program on Economic Growth and Development in the English Speaking Caribbean Region", (2014)15:3 *J Econ E R* 39. Campbell criticizes the practical workings of the CBI as procuring substantially greater benefits to the United States than to the English Speaking Caribbean. In his research, Campbell pinpoints that between 1994-2009, Trinidad and Tobago was the only English Speaking Caribbean country that experienced positive balance of trade and balance of payments. The other ten English Speaking Caribbean countries, including Jamaica, experienced a negative GDP growth over the period studied, that is, imported more from the United States than that which was exported.

<sup>45</sup> At a hearing concerning the Caribbean Basin Initiative held before the Sub-Committee of International Trade of the Committee on Finance in the United States, the Chairman, Senator Grassley, asserted that the agreement was always concerned with the protection of United States' intellectual property in the Caribbean. According to Senator Grassley:

"I am particularly concerned about whether S. 529 deals adequately with the continuing challenge of protecting U.S. intellectual property rights in the Caribbean Basin. Exports of products protected by intellectual property rights are increasingly vital to our global competitiveness. Congress recognized this back in 1983, when it first extended trade benefits under the CBI program. Because, to be eligible at that time, countries had to provide adequate and effective protection for U.S. intellectual property rights. We reaffirmed this link as recently as last December, when we brought our own intellectual property laws up to the standards of the GATT TRIPS agreement, and called on all other nations to and these were our words-"accelerate the implementation of this landmark agreement." This legislation may not go far enough in advancing this well-established link between trade benefits and intellectual property protection. We cannot afford to relax our vigilance on intellectual property": Comments by then Chairman of the United States' Sub-Committee on International Trade of the Committee on Finance concerning the Caribbean Basin Initiative, May 15, 1995. The reference to section 529 refers to the intellectual property sections of the Caribbean Basin Initiative. (I, 1995 at 2, Heinonline).

The skewed agenda of the of the United States' intellectual property mandate in the Caribbean is also illuminated by the Committee's recommendation of a 3 year review of Caribbean countries' IP laws and rules, so as to determine its conformity to "a more stringent criteria on intellectual property".<sup>46</sup> As the economic interest of hegemonic countries broadened to include a claim on the intangible resources of the periphery, trade negotiations increasingly became centered on protecting foreign based intellectual property right in developing countries.

Prior to the 1980's, there was no significant concern amongst the Jamaican state on the protection of intellectual property rights. Over the period of 31 years, an intellectual property right agenda premised on the protection of foreign based rights slowly became institutionalized in Jamaica's terrain. This paradigm results from the diffusion of imperial IP rules through trade negotiations,<sup>47</sup> and trade and investment agreements with core countries and transnational capitalist classes.<sup>48</sup>

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<sup>46</sup> *Ibid*, at 5.

<sup>47</sup> In a 1983 address to the Jamaican Parliament on the country's foreign economic policy and trade, then Deputy Prime Minister of Jamaica the Honorable Hugh Shearer emphasized the importance of engaging in regional and international trade agreements. Sir Hugh Shearer also referenced intellectual property rights as an area which the country should focus on, although no urgency in IP strategizing was required. Jamaica (Ministry Paper no. 19/83, Foreign Economic Policy and Practice).

<sup>48</sup> An instructive example of this is Jamaica's 1994 Bilateral Investment Agreement with the United States. The United States included the protection of intellectual property as one of the main components of the agreement. As specified by the agreement, investment includes intellectual property rights assets, such as sound recordings and literary works. This legal stipulation sought to address contentions by the United States that there was an influx of sound recording, and satellite transmission infringements in Jamaica. Jamaica's 1994 Bilateral Intellectual Property Agreement with the United States essentially functions as a unilateral IP enforcement modality, aimed at safeguarding the proprietary rights of multinational companies in Jamaica.

It is therefore not surprising that the Uruguay Round of negotiations that established the World Trade Organization contained extensive provisions on intellectual property rights; a domain which was new to the multilateral trading system, though previously canvassed in bilateral trade negotiations between core and periphery countries.<sup>49</sup> The marginal significance of the Caribbean and specifically Jamaica in the intellectual property right policies adapted in the Uruguay Round, illustrated a continued paradigm of international governance by hegemonic interests into the domestic sphere of Third World affairs.<sup>50</sup> *TRIPS* enabled and legitimated the ability of key international actors<sup>51</sup> to impose their IPR policies upon countries such as Jamaica and the Caribbean.

The politics that plague the international relations of intellectual property is also illustrated in the strong linkages between trade growth strategies, and IP provisions in specific regional and bilateral free trade agreements (RBFT) and pluri-lateral agreements.<sup>52</sup> A striking provision in

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<sup>49</sup> John Croome, *Guide to the Uruguay Round Agreements*, (Hague: Kluwer Law International, 1999).

<sup>50</sup> Carolyn Deere, *The Implementation Game* (Oxford: Oxford University Press, 2009); Girvan: “The Caribbean EPA Affair”, Norman Girvan, “Sweetification, Technification, Treatyfication- Politics of the Caribbean-EU Economic Partnership Agreement” (2010) 12 *Interventions Int’l J Third World Stu* 100. Girvan argues that the power asymmetry between the Caribbean and the European Union resulted in an EPA agreement with IPR provisions that substantially represents the interests of the European Union. [Girvan, “Politics of the Caribbean”].

<sup>51</sup> Ruth Okediji, Has Creativity died in the Third World, Some Implications for the Internalization of Intellectual Property, (1995) 24:1 *Den J Int’l L P* 109; Ruth Okediji, IP Essentialism and the Authority of the Firm (2008) 117:2 *Yale L J* 274.

<sup>52</sup> Although the thesis does not deal with the Trans Pacific Partnership Agreement, the treatment of food based geographical indications in the agreement works to stultify the growth of sui-generis GI systems in member countries. The implications for the Caribbean and Jamaica are potentially significant if ratified by Japan, the main consumer market for Jamaica’s Blue Mountain coffee. Should Jamaica use its geographical indication (GI) legislation for the registration of domestic products, the country may still be faced with a hurdle of ensuring that its GI is also acceptable for foreign protection in Japan, based on GI rules in the TPP that prioritizes trademarks over GI registrations. (Trans-Pacific Partnership Agreement – Article 18.30, Recognition of Geographical Indications, available at <http://www.international.gc.ca/trade->

the regulations governing the Caribbean Basin Economic Recovery Agreement (CBERA) is that which creates a mutually inclusive relationship between a Caribbean country's status as a "beneficiary" country<sup>53</sup>, and its ability to enforce United States' IPR interests domestically.<sup>54</sup>

Since 2008, the effects of global imperialism have resulted in a broadening of the intellectual property hegemonic core to include Switzerland and the European Union. As a part of the ratification to the European Union's Economic Partnership Agreement with Caribbean, the European Union required the domestic enactment of GI legislation. Most Caribbean countries enacted geographical indication legislation without any form of prior negotiations or constructive consultations on its methodological application.<sup>55</sup>

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[agreements-accords-commerciaux/agr-acc/tpp-ptp/text-texte/18.aspx?lang=eng](http://agreements-accords-commerciaux/agr-acc/tpp-ptp/text-texte/18.aspx?lang=eng), last accessed January 21, 2016).

<sup>53</sup> Article 2702(5)c 9 of CBERA stipulates that the failure of a Caribbean country to provide adequate, and effective means for a United States' national to enforce its exclusive IP rights, is a basis for the withdrawal or suspension its beneficiary status. Further to this, Article 2702 (5)c 10 creates a justification for the scrutiny of Caribbean countries' IP laws by the United States, by basing designation on the country's vigilance in enforcing United States' IP rights.

<sup>54</sup> CBERA replaces the Caribbean Basin Initiative trade agreement. It is a preferential trade agreement between the United States and 21 Caribbean countries, aimed at fostering trade, and providing aid to Caribbean countries. Article 2702(a) of CBERA defines a beneficiary country as one which is designated as such by the President of the United States, to receive preferential trade benefits, inclusive of duty free treatment for imported Caribbean goods to the United States. The status of a beneficiary country is not guaranteed, neither is it infinite in duration, but may be withdrawn or suspended by the United States, if certain requirements are not met. The non-protection of United States' intellectual property rights in Caribbean countries is expressly mandated as an issue which results in the withdrawal or suspension of trade, and aid benefits.

<sup>55</sup> Norman Girvan, "Sweetification, Technification, Treatyfication- Politics of the Caribbean-EU Economic Partnership Agreement" (2010) 12 *Interventions: International J Third World S* 100. Girvan argues that the power asymmetry between the Caribbean and the European Union has resulted in an EPA agreement with IPR provisions that substantially represents the interests of the European Union.

Recently, the European Union published its own intellectual property right watch document, listing countries that have violated its various forms of its intellectual property rights.<sup>56</sup> I argue that should Jamaica lack vigilance in the enforcement of European Union's agricultural and food based geographical indications locally, the country may also find its policies under scrutiny by the European Union. The issues that I have discussed in this section show the influence of hegemon actors on Jamaica's orientation to intellectual property policy.

I acknowledge that there are avenues for establishing innovation through intellectual property. The problem is with the usage of the legislation by locals, the overarching emphasis on compliance, and the obvious troubling relationship between the hegemonies demands for intellectual property protection, and resulting policy changes in Jamaica's IP landscape. It is against this background that I have identified agricultural and food based geographical indications as a counter hegemonic form of intellectual property for Jamaica.<sup>57</sup>

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<sup>56</sup> European Commission, "Commission Staff Working Document: Report on the Protection and Enforcement of Intellectual Property Rights in Third Countries" Brussels, July 01, 2015 (available online at [http://trade.ec.europa.eu/doclib/docs/2015/july/tradoc\\_153600.pdf](http://trade.ec.europa.eu/doclib/docs/2015/july/tradoc_153600.pdf)).

<sup>57</sup> Chapters 4-8 are intended to show the prospects of growth through the commercialization of food based geographical indications, on bases of strategizing in choice of product, market penetration, development of domestic legal infrastructural resources, and more active and influential involvement in international intellectual property norm setting forums.

#### **1.4. Research Methodology**

The research method used throughout the thesis involves literature reviews, a case study that is focused on Blue Mountain coffee, juridical analysis of relevant case laws, and content analysis of working papers and government and inter-governmental organization reports. Conceptually, I ground the thesis in the framework of an interdisciplinary analysis of law by using Third World Approaches to International law and constructivist reasoning. Third World Approaches to International Law critiques international law's Eurocentric and hegemonic approaches in the construction, use, and relevance of international law to the Third World. Constructivist theory recognizes that international organizations, groups and other powerful non-state actors influence the formation, interpretation and ultimate application of legal rules in the local.

I undertake an empirical legal query<sup>58</sup> by focuses on interpreting, organizing into themes and making a descriptive inference of the research. The dissertation includes a case study as I wanted to contribute a Caribbean critique of intellectual property rights law to the international scholarship and, to offer feasible alternatives to approaches which Jamaica and the region have adopted in encounters with intellectual property right.<sup>59</sup>

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<sup>58</sup> Lee Epstein & Andrew Martin assert that empirical legal research allows the researcher to undertake qualitative (and quantitative) analysis through observation, interpreting and organizing data collection from studies. The empirical legal researcher aims to understand how a phenomenon, rule, issue or practice affects the subjects of law, and also, how the subjects of law – people – affect the operation or use of the rule and practice, and the existence of the issue. Lee Epstein & Andrew Martin, "Some Preliminaries" in Lee Epstein & Andrew Martin, *An Introduction to Empirical Legal Research*, (Oxford: Oxford University Press, 2014).

<sup>59</sup> Contributors who have made invaluable contributions to discussions on intellectual property rights in the region include Keith Nurse and Sharon Le gall. Keith Nurse has written on the creative potential of the copyright sector in the region in adding value to regional economic viability: Keith Nurse, "The Creative Sector in CARICOM: The Economic and Trade Policy Dimensions" Paper prepared for: CARICOM



The research was undertaken after ethics review and approval from the Office of Research Ethics, York University. The procedure involved completing and passing the Tri-Council Policy Statement, a course on ethical conduct for researchers doing research involving humans. In addition, sample questions and informed consent letters along with my dissertation proposal was submitted to the Faculty of Graduate Studies. I was then approved by the Research Ethics Committee, and received an ethics certificate to conduct the field work aspect of the research.

A case study of intellectual property and Jamaica's Blue Mountain coffee enables an understanding of the everyday effects and influences of dominant intellectual property on Jamaican peoples implicated in the research. Secondly, a case study approach allows the researcher to formulate policy recommendations, after analyzing how key stakeholders deal with problems, manage projects and are affected by challenges.<sup>60</sup>

Identifying a relationship between geographical indications and Blue Mountain Coffee is essential in establishing the framework of the research. It is impossible for geographical indications to be conceptualized as intellectual property assets if the characteristics of the

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Regional Symposium on Services, (Antigua & Barbuda, July 2009). Le gall argues for the legal recognition of cultural heritage resources which are popular in Caribbean and Latin America communities (steel pan in Trinidad and Tobago, the Cajon from Peru, the capoeira martial arts/dance practiced in Brazil and the Punta rock music from Brazil as traditional knowledge resources: Sharon B. Le gall, "Intellectual Property, Traditional Knowledge and Cultural Property, Cultural Signifiers in the Caribbean and the Americas", (New York: Routledge, 2014).

<sup>60</sup> David Silverman, "The Practical Relevance of Qualitative Research" in David Silverman "Interpreting Qualitative Data: Methods for Analyzing Talk, Text and Interaction", (London: Sage Publications Ltd, 1993) at 171-194.

specified products are incongruent with the legal definition of a GI. Once a viable relationship is identified, I focused on how best to capitalize geographical indication as an aspect of Jamaica's development policy.

The central focus of the fieldwork was on farmers of Blue Mountain coffee. These groups of key stake holders lease (from the government), or own the farm land. The Achilles heel in Jamaica's Blue Mountain coffee narrative is the plight of small-scale farmers. Farmers cultivate the crops and yet, receive comparatively little in remuneration from its commercialization. The preceding point is relevant to Blue Mountain coffee farmers, most of whom are small farmers. Blue Mountain coffee's registration as a certification mark limits the parameters of proprietorship rights ownership to the Coffee Industry Board. In contrast to geographical indications, this form of intellectual property is unable to recognize collective rights as well as the further prospects of benefits which can be fostered through GIs.

Most fundamental to my argument is the fact that, overall, many small scale coffee farmers experience serious economic difficulties because of their inability to transform their coffee business into a lucrative activity. I have discussed these and other challenges extensively in chapter 5 of the thesis. Comparatively, stakeholders at the higher end of the supply chain such as coffee processors<sup>61</sup> earn substantially more from the commercialization of Blue Mountain coffee, than small sized farmers.<sup>62</sup>

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<sup>61</sup> Coffee processes are businesses which purchase coffee beans from farmers and process and sell the coffee under license from the Coffee Industry Board.

### **1.5. Limitations of the Research**

The research is limited by the contextual background of the study itself. The country has a very young history and little experience with geographical indications. Jerk seasoning is the only product registered under Jamaica's geographical indication legislation; this registration became effective on September 30, 2015. Political and economic issues in Jamaica were not treated as central issues in the research, but were critiqued as challenges that may affect the success rates of geographical indication schemes. Therefore, research angles such as in depth analyses of the impact of political and cultural issues on success rates of geographical indication laws were not central engagements of the study. I suggest that once domestic registration of geographical indication products become more prevalent in Jamaica and the Caribbean, another research should be conducted to compare the dissertation's findings with actual results.

In the interviews, I was unable to obtain substantive comments from Ministry officials; this limited a meaningful analytic engagement with their responses. The responses did not shed light on the questions that I had asked. More meaningful responses were obtained from the country's intellectual property office than from actual government officials.

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<sup>62</sup> Some medium scale farmers also receive low returns from the cultivation and sale of their beans. This point is discussed in chapter 6 of the thesis.

## **1.6. Conventional Debates on Geographical Indications and Arguments Implicating Development**

Discussions about geographical indications are contentious yet encouraging to jurisdictions with interest in developing GIs as part of an intellectual property rights strategy. As I address in later chapters, the European Union envisages agricultural and food based geographical indications as a catalyst for rural development and creativity and innovativeness in intellectual property, through the utilization of broad based socio-economic, commercial and cultural preservation approaches in geographical indication strategizing.<sup>63</sup>

Attempts at forging relationships between geographical indications, agricultural and food-based products and development are illustrated by Columbia's geographical indication scheme for its "Café de Columbia". The capitalization of Café de Columbia as a geographical indication led to increases in income to its coffee farmers, and created entrepreneurial ventures related to coffee cultivation. The venture also stimulated key stakeholders' involvement in community social development programs, such as the building of educational facilities in nearby communities.<sup>64</sup> The approach to the development of geographical indications was transformed from a product centred approach to the development of peoples and places. I also discuss in later chapters, and as the case study illustrates that there are usually challenges to the success of geographical indication schemes. In such instances, as is indicated by Mexico's tequila

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<sup>63</sup> I address this point in chapter 5 of the dissertation.

<sup>64</sup> World Intellectual Property Office, *Geographical Indications: An Introduction* (2008).

case study, the ability of marginal but valuable actors in the supply chain to achieve socio-economic benefits from the capitalization of tequila is affected by powerful stakeholders in the tequila industry.<sup>65</sup>

The literature on agricultural and food based geographical indications is still developing. The legality of geographical indications as a form of intellectual property right continues to be contentiously debated in international forums.<sup>66</sup> Opponents of geographical indications contend that similar recognition is available under trade mark law,<sup>67</sup> unfair competition or consumer protection laws. These laws provide minimal protection for origin based goods.<sup>68</sup>

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<sup>65</sup> Sarah Bowen, "Development from within? The Potential for Geographical Indications in the Global South" (2010) 13:2 *J W Intell Prop L* 231 at 241.

<sup>66</sup> The most recent debate concerned the Lisbon Agreement which has, since May 2015, extended its treaty to recognize the protection of food based geographical indications. The United States opposes the recognition of non-wine and spirit geographical indications and has defended its position in the World Intellectual Property Office Standing Committees, in trade mark forums and in submissions to the Lisbon Union.

<sup>67</sup> Michael Blakeney, *Proposals for the International Regulation of Geographical Indications* (2001) 4:5 *J Intell Prop L* 629; Michael Blakeney, *Geographical Indications and TRIPS* (University of Western Australia, Research Paper 2012); Bernard O'Connor, *The Laws of Geographical Indications* (London: Cameron May, 2007).

<sup>68</sup> Certification and collective marks are basis of protection for GIs under trademark law in many jurisdictions. However, there are significant differences between certification marks and geographical indications. A certification mark acts as a designation which confirms that a product is in compliance with a specified quality standard. There is no exclusivity to the usage of the certification mark. The owner may license the mark to anyone for use on the specified product. However, geographical indications are owned by either the state or a producer group, its ownership base and associated rights are bases for a wide cross section of stakeholders to be involved in the commercialization and development of the product. Frank Schechter, "The Rational Basis of Trademark Protection (1926) 40 Har. L R. 813; William Landes and Richard Posner, "Trade Mark Law: An Economic Perspective" (1987) 30 *J L Econ* 265; G.E Evans, "The Comparative Advantage of Geographical Indications and Community Trade Marks for the Marketing of Agricultural Products in the European Union" (2010) *IIC* 645; See Dwijen Rangnekar, *Geographical Indications and local, Feni Report, 2009*, ([http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=1564624](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=1564624)); Daniela Benaventa, "The Economics of Geographical Indications: GIs modeled as club assets" Graduate

Juridical differences in the legal recognition of geographical indications have led to varying interpretations on its validity as a separate form of intellectual property right. This has resulted in 2 significant developments. Firstly, the availability of protection in national jurisdictions ranges from those which recognize geographical indications as distinct rights, to jurisdiction that provide very limited protection for geographical indications. Secondly, the inability of the *TRIPS* council to establish a consensus on the scope of geographical indication rights facilitated the growth of ‘alternate’ forums to galvanize support for more expansive protection of rights. Amendments to the *Lisbon Agreement*<sup>69</sup> now include the recognition of enhanced rights for agricultural and food based geographical indications, after much opposition from dominant international intellectual property right actors, especially the United States.<sup>70</sup>

The international debate on agricultural and food based geographical indications scarcely includes a Caribbean perspective on the legislation to the domestic landscape. Furthermore, the influence of an imperial centric intellectual property rights structure on the practical application of the geographical indications, and the ability of an agricultural and food-based geographical indication system to be positioned as counter hegemonic IP in Jamaica and the Caribbean, are relevant issues which have not been critically

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Institute of International and Development Studies. Working Paper No. 10/2010. I discuss this point extensively in Chapters 5 and 7.

<sup>69</sup> *Geneva Act on the Lisbon Agreement for the Appellations of Origin and Geographical Indications Lisbon Agreement* (1958), revised at Stockholm (1967), and Amended in 1979.

<sup>70</sup> I discuss the politics and dynamics of the Lisbon Agreement negotiations concerning geographical indications in chapter 7.

analyzed. It is this narrative that I endeavor to add to the international debate on geographical indications, and on intellectual property's relevance in the Third World.

### **1.7. Thesis Framework**

The thesis develops its arguments by critically engaging with 2 theories. Its theoretical perspective links Constructivist International Relations theory and Third World Approaches to International Law (TWAIL) to analyze, criticize, and prescribe Third World representation to the dominant narratives that channel intellectual property right usage in Third World societies.

Constructivists argue that norms, rules and policies are socially constructed, and that powerful actors influence the construction, proliferation and effects of such ideologies.<sup>71</sup> It explains the emergence of collective interests in “institutional facts”<sup>72</sup> and practices, agent's role in re-constituting social and institutional facts, and the effects of this collective social interaction in influencing dominant legal norms. The theory engages in an ideational ontological analysis which queries how international actors' interest shapes

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<sup>71</sup> Emmanuel Adler, Seizing the Middle Ground, *Constructivism in World Politics*. (1997) 3 *European Journal of International Relations* 319, [Alder, “*Constructivism in World Politics*”]. Martha Finnemore and Kathryn Sikkink, Taking Stock: The Constructivist Research Program in International Relations and Comparative Politics (2001) 4 *Ann'l Rev Pol S* 391. [Finnemore and Sikkink: “*International Relations and Comparative Politics*”].

<sup>72</sup> John R. Searle, *The Construction of Social Reality* (New York: The Free Press, 1995) [Searle, Construction of Social Reality”] Institutions engage in a form of social interaction which produces and reproduces influential norms which govern the paradigm of international law and international relations. Based on constructivist theorizing, an institution is defined as a social structure with a set of codified norms and rules which, through socialization, motivates social actors' collective knowledge. See Alexander Wendt, Anarchy is What States Makes of It. *The Social Construction of Power Politics* (1992) *Int'l Org.* 391 at 399.

their identities, and the consequential aspects of inter-subjective knowledge that are so formed.

Constructivist theorizing is important in understanding the trajectory of intellectual property rights law in Third World societies.<sup>73</sup> This is a contrast to other international relations theories which either lack an engagement with social interaction as a basis for norm constitution or, provide insubstantial inclusion of this dynamic in its framework. I briefly discuss the shortfalls of using other forms of international relations theory in my analyses below.

Realists' perspectives view the state as the central actor in international relations.<sup>74</sup> State-centric power directs the 'egoistic' <sup>75</sup> interest of states, and influences power politics between states. Under this framework, policy decisions are the result of deliberations based on states' interest, void of any material consideration of the role of non-state actors

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<sup>73</sup> Asher Alkoby, "Theories of Compliance with International Law and the Challenge of Cultural Difference" (Available online at SSRN, <http://ssrn.com/abstract=1113846>, last visited September 26, 2016). Alkoby persuasively argues that cultural diversities across jurisdictions account for the levels and types of engagement of nations with international law. Alkoby's argument is valid in elucidating the relationship between intellectual property rights policies and compliance levels in many Third World countries. Cultural values influence peoples' understanding of intellectual property, the concept, the law and its relevance to their lives. I further argue however, that cultural values may be superseded by other politico-economic commitments, such as proclivities for improved trade relations with hegemonic powers, thereby leading to subsequent transplantation of robust intellectual property laws in the Third World (contrary to cultural values). See generally, Jean Frederic Morin and Edward Richard Gold, "An Integrated Model of Legal Transplantation: The Diffusion of Intellectual Property Law in Developing Countries" (2014) 58 *Int. S Q* 781.

<sup>74</sup> Kenneth Waltz, *Theory of International Politics* (Illinois: Waveland Press, 1979).

<sup>75</sup> Hans J. Morgenthau, *Positivism, Functionalism and International Law*. (1940) 34 *Am. J.I.L* 260. Christian-Reus Smit, "Constructivism" in Scott Burchill et al, *Theories of International Relations* (New York: Palgrave Macmillan, 2005).



in constituting legal norms. In conceptualizing the state as the base of power, realists also assert that state choices are based on rationality.<sup>76</sup> As such, states political behaviors are based on calculated assessments of other states' actions and the probability of success from different strategies.

Neoliberal institutionalism focuses on international institutions<sup>77</sup> as the main power blocks in international relations. In neo-liberal theory, international institutions orchestrate cooperation between states, and are integral in the formation of states' interests. As rationalist perspectives, these international relations theories envision international law as tools to assist in the resolution of conflicts<sup>78</sup>, and as justification for the use of a preferred policy. The influence of actor identities and interests in the construction, application, reification and changes to international law is not explicated in these international relations theories.

TWAIL provides a counter- hegemonic analysis of international law, and incorporates emancipatory principles of representation into the discourse. TWAIL examines the conceptual distortions that exist in the transposition of legal principles to Third World

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<sup>76</sup> John Mearshimer, *Reckless states and Realism*, (2009) 23 *Int'l Relations* 241; Colin Elman, *Horses for Courses: Why not Neorealist theories of foreign policy* (1996) 1 *Security Studies* 7.

<sup>77</sup> John Duffield, "The Limits of Rational Design". (2003) 57 *Int'l Org* 411.

<sup>78</sup> Martha Finnermore, Susan Sell and Deborah Avante, *Who Governs the Globe*, in Martha Finnermore et al (eds) *Who Governs the Globe* (New York: Cambridge University Press, 2010).

regions, and its influence in perpetuating a distorted narrative of international law in the Third World.<sup>79</sup>

TWAIL scholarship is not without its critics. One of the main critiques of TWAIL is that it pinpoints the imperial centric nature of international law and its inability to effectively represent the interest of the Third World, but does not offer reformist alternatives to the debacles identified in international law.<sup>80</sup> Haskell, in making this critique opines that local institutional dynamics within the south – politics, culture, economic and social issues - shape the impact of international law in the Third World, and this line of reasoning is missing from TWAIL literature. Such a criticism is flawed from the perspective that many TWAIL scholars use an interdisciplinary approach in augmenting the practical realities of international law in the Third World.<sup>81</sup>

The thesis's use of constructivism to explore, illustrate and examine the politics of intellectual property right and geographical indications in Jamaica and the Third World, assist in authenticating TWAIL as a valid critical legal scholarship. More importantly, and a point that addresses Haskell's criticism, my focus on agricultural products and food based geographical indications as a form of counter hegemony to conventional forms of

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<sup>79</sup> As Obiora Okafor convincingly asserts: "TWAIL scholars are solidly united by a shared ethical commitment to the ethical and practical struggle to expose, reform or even entrench those features of the intellectual legal system that help to create or maintain the generally unequal global order" Obiora Okafor, "Critical Third World Approaches to International Law: Theory, Methodology or Both? (2008) 10:4 *Intl Com L Rev* 371. [Okafor, *Critical Third World Approaches to International Law*"]

<sup>80</sup> John D. Haskell, "TRAIL-ing TWAIL: Arguments and Blind Spots in Third World Approaches to International Law", (2014) 27: 2 *Can JL & Jur* 383.

<sup>81</sup> I discuss the TWAIL-ian approach to intellectual property rights law in Chapter 2.

intellectual property in the Third World, is a reformist approach imbued with TWAIL perspectives of active representation amidst opposing global imperial and elite based forces.

### **1.8. Outline of Subsequent Chapters**

The second chapter forms the theoretical framework of the thesis and addresses the hegemonic dimensions of intellectual property law's use in the Third World, and its association with development theorizing. The theoretical approach is explicated by engaging with TWAIL and Constructivist perspectives on international law and international relations.

Chapter three focuses on the intersections between the politics of international relations and the international law of geographical indications. The chapter examines the evolution of geographical indications, and the role of dominant international actors in either enabling or maintaining the current paradigm in the global geographical indications discourse. I also critically address the counter-hegemonic capabilities of agricultural and food based geographical indications, and analyze Jamaica's GI legislation.

Conceptualizing agricultural and food based geographical indications as an intellectual property right's asset is impossible without international and reciprocal recognition of its associated rights. Furthermore, absent strong international consumer demand and premium pricing, there is significantly less potential for local stakeholders to benefit from the commercialization of the registered product.

Chapter 4 provides a comparative jurisprudential analysis of 3 countries approach to the legal protection of geographical indications. These jurisdictions represent the main international consumer markets for Jamaica's Blue Mountain Coffee: Japan, the United States and the European Union (EU Council regulation no.1151/2012 is the single geographical indication legislation for all European Community members). A registered geographical indication is placed in a vulnerable position legally, commercially, and culturally, absent legal reciprocity in its major trading partners' jurisdictions. In this unfortunate context, the domestic registration of the product, and local enthusiasm by farmers, industry regulators, stakeholders and key stakeholder groups, are all compromised by infringements in its major international consumer markets.

The chapter points to two issues: Japan's recent enactment of geographical indications legislation illustrates that Jamaica should increase its momentum on safeguarding its Blue Mountain Coffee as a geographical indication in its major consumer market (Japan). Secondly, United States' growing consumer market for Jamaica's Blue Mountain coffee is only cautioned by its opposition to accommodating geographical indication laws on agricultural and food-based products. In this cautionary legal climate, Jamaica's current response should be to focus on viable infringement strategies in United States' jurisdictions. The chapter discusses these and other issues against the background of politics and power in the international relations of geographical indications. The European Union occupies an interesting position, one which is enviable as a leader in the diffusion of geographical indication norms, and also a hegemon, as its approach to

geographical indications led to the enactment of such laws in many Third World countries, and to the protection of EU based products in Third World markets.

Chapter 5 is the field work chapter of the thesis, and focuses on envisaging Blue Mountain coffee as an intellectual property asset of development in Jamaica. The chapter chronicles and highlights the difficulties of small scale farmers in earning a sustained livelihood from the farming of Blue Mountain coffee. In positioning Blue Mountain coffee as a form of counter-hegemony in Jamaica's intellectual property narrative, it is necessary to highlight current challenges in its cultivation and commercialization, that may be resolved through a more participatory and diversified approach in its governance and legal model. Fluctuations in coffee pricing caused by an undiversified market penetration model, hurricanes, droughts and other natural disasters affecting yields, and severe inequalities in power between small scaled farmers and stalwarts in the industry, illustrate drastic challenges for Blue Mountain coffee. Yet, the current challenges also present policy makers and Jamaican peoples with an opportunity to re-structure the industry by establishing viable linkages between geographical indications, the product and development policy. The chapter engages with these issues from the narratives of small scale farmers' challenges and aspirations.

Chapter 6 uses the data and content analyses of the Blue Mountain coffee field work to critically discuss the measures required to establish a sustainable and viable geographical indication scheme. The chapter engages in analyses of the challenges posed to attaining successful outcomes in geographical indications as a brand, and geographical indications

as an asset of development in Jamaica. I address what I identify as necessary factors for conceptualizing geographical indications with development policy. This centers on what I've termed IP asset management for geographical indications, and include reciprocal legal recognition of rights in consumer markets, appropriate technical and legal approaches in the sustenance of the scheme, and policy directives that are sensitive and accommodative to the social, economic, cultural and political plight and aspirations of small scale Blue Mountain coffee farmers, and other key stakeholders at the lower end of the product's value chain.

Chapter 7 is a critical analysis of Jamaica's interaction (and lack thereof) with the dominant international geographical indication regimes (as example, World Intellectual Property Office Standing Committees, regional, bilateral and pluri-lateral free trade negotiations and agreements, and the *Lisbon Assembly*). Geographical indications cannot be conceptualized as intellectual property assets without extrapolating the influence of international and regional actors in shaping the dominant norms governing its protection. The chapter examines the ability of Jamaica's geographical indication regime to advance a proactive stance in re-orientating the dominant norms associated with the global intellectual property right narrative.

As the final chapter, chapter 8 is a critical summary of the thesis and provides recommendations on solidifying geographical indications as a formidable 'counter-hegemony' to the current global imperialistic intellectual property paradigm associated with Jamaica's intellectual property discourse.

## **Chapter Two: Intellectual Property Rights and International Relations: A Third World Approaches to International Law (TWAIL) – Constructivism Approach to Intellectual Property Rights.**

### **2. Introduction**

Chapter one was an appraisal of the general focus of the thesis and the problems that I have identified with Jamaica's intellectual property system. Chapter one also briefly engaged with debates on geographical indications as a law, and offered insights into its potential as a form of counter hegemonic force in Jamaica's imperialistic and elite-based intellectual property rights system.

Chapter two addresses the theoretical framework which I have used in positing my arguments on intellectual property law's relevance in the Third World, and agricultural and food based geographical indications as a modality of change in Jamaica and the Caribbean's intellectual property policy.

The chapter is a theoretical based discussion of TWAIL scholarship and constructivist theory, and illustrates how these approaches to international law and international relations integrates with (i) criticisms of global imperialism in intellectual property right, (ii) an explanation of the term "Third World", (iii) the notion of development's association with intellectual property right in the Third World, and (iv) positioning agricultural and food based geographical indications as counter hegemony in Jamaica, the Caribbean and the Third World's intellectual property policy. I focus on geographical indications in chapter 3 of the thesis.

## **2.1. Third World Approaches to International Law and Constructivism as a Construct of Law's Flaws and Potentials**

In this section of the chapter, I explain TWAIL and the international relations theory of constructivism, the 2 theories used to frame my arguments on geographical indications, development and intellectual property in the Third World in general. I engage in the analyses of the role of actor interest and identity in the formation and influence of dominant intellectual property rights laws in the Third World. TWAIL critiques international law's relevance in the Third World, identifying hegemonic actors and interests which reify the use of international law in the Third World to subjugate the interest of its peoples.

In the first chapter of the thesis I had discussed the reason for the use of constructivism as the choice of international relations theory in the framing of my arguments. International relations engage in a study of the behavior and relationship between states, inter-governmental organizations and non-governmental organizations. Constructivism is an international relations theory that analyzes the formation of dominant actor interests and identities through the study of norm creation, norm diffusion, and the resulting institutionalization of actor interests as main stream norms. In explaining constructivism, scholar Martha Finnemore note:

“A constructivist approach does not deny that power and interest are important. They are. Rather, it asks a different and prior set of questions: it asks what interests are, and it investigates the ends to which and the means by which power will be used. The answers to these questions are not simply idiosyncratic and unique to each actor. The social nature of international



politics creates normative understandings among actors that, in turn, coordinate values, expectations, and behavior”.<sup>82</sup>

I argue that constructivism fully complements the premise and emancipatory tenets of TWAIL-ian scholarship. By explaining the social construction of norms, the shaping of actor interests and identities and power’s role in politics, constructivism buttresses TWAIL’s agenda in illustrating international laws’ flaws, and the quest to forge interests and alliances which re-orientate international law’s principles and effects. I will discuss this in greater detail in later parts of the chapter. In the next paragraph I define the Third World and development using TWAIL constructivism. These terms are used frequently throughout the chapters, and therefore warrant an explanation.

### **2.1.1. Defining the Third World**

The Third World’s voice is often thought to be lost or mis-translated when discussants are either not from the region or, engage in dialogue from the north. The approach that I have adopted throughout this thesis is one which critically engages with Third World identity to illustrate a narrative which is reflective of the spaces’ broadly shared experience with intellectual property rights law. However, while recognizing that a re-configuration of the Third World’s encounter with intellectual property rights laws is more effective and purposeful when the spaces’ voice is included in the discourse, the analysis also acknowledges that a critical engagement with the western discourse which has facilitated the proliferation of these laws is necessary.

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<sup>82</sup> Martha Finnemore, “Constructing Norms of Humanitarian Intervention” in Peter Katzenstein (ed), *The Culture of National Security: Norms and Identity in World Politics* (New York: Columbia University Press, 1996) at 3.

The Third World is not a homogenous space; neither is the term used to unequivocally refer to the end of colonialism, or to conjure identical or similar historical epoch of its peoples. The Third World references marginalized peoples' experiences post-independence, and recognize that there is often a symbiotic relationship between its spaces and more powerful countries and actors. The space is also one which, having been exploited for hundreds of years by core countries for its natural and human resources, remains a contested arena for resource use and ownership, and the 'othering'<sup>83</sup> of its peoples and states in international law.

Also implicated in my use of the term 'Third World' is the recognition that there are no binary points of hegemonic power in international relations. Europe no longer represents the center of global power. Power is de-centered by hegemonic groups outside and within peripheral regions to influence the economic, social and political narratives of Third World peoples. Engaging with the Third World in this way brings to the fore TWAIL-ian Makua Mutua's delineation of the term. Mutua states:

“...Third World is a political reality. It describes a set of geographical, oppositional, and political realities that distinguish it from the West. It is a historical phenomenon that has a dialectic relationship with Europe in particular and the West in general. The Third World is more truly a stream of similar historical experiences across virtually all non-European societies that

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<sup>83</sup> Othering refers to the continued marginalization of former colonized countries by powerful western countries and, the effects of power imbalances between class and gender based groups within the periphery. As used throughout this thesis, my articulation of the term incorporates the asymmetrical dimensions of intellectual property laws operation in the periphery, primarily the non-representation of marginalized groups in its formulation, and its misapplication to the local. Anthony Anghie, *On critique and the Other* in Anne Orford (editor) *International Law and its Othering* (Cambridge University Press: Cambridge, 2006).

has given rise to a particular voice, a form of intellectual and political consciousness”.<sup>84</sup>

Mutua’s reference to the Third World provides geographic, historical and political account of distinctions between the Third World and the west.

The Third World is not used to invoke the misperception that the socio-cultural, historical, geo-political and legal dynamics of these regions have only been relevant after colonization. Furthermore, there are heterogeneity of cultures, differences in legal, social and political dynamisms within the Third World that have produced its own form of power imbalances, and conflicts.<sup>85</sup> Conflicts within Third World countries, amongst different Third World regions, amongst multinational corporations and large commercial groups in various spheres of the global, mark the need for a broadened focus on geopolitics of the Third World; a focus that is not simply rooted in ‘history’.

I position the Third World as a contested and challenged arena, and also as a space for opportunities arising from its subjugated position in the international relations of intellectual property rights law. Globalization has facilitated the growth of diffusion of capital, in which the modes of production are fragmented throughout the global community, including within Third World countries. This paradigm has brought with it,

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<sup>84</sup> Makua Mutua, “What Is TWAIL”? (2000) 94 *ASIL* 31.

<sup>85</sup> Brian Meeks compilation of the unique political, social, and economic challenges facing Caribbean countries provides an insightful positioning and critique of the region’s issue. He argues that the end of colonialism in the Caribbean brought hopes of independence, much of which remain unfulfilled. The book addresses the search for individual political freedom and state independence from the west, and the economic pitfalls of the region. Brian Meeks, “*Critical Interventions in Caribbean Politics and Theory*” (Mississippi: University Press of Mississippi, 2014). [Meeks, “Critical Interventions”].

and facilitates the development of a transnational capitalist class that uses imperialistic methods to perpetuate the marginalization of the Third World; even within Third World spaces. Compounding the debacle is the problem that in many areas of international affairs, the ‘global’, maintain a steady grip on the ability of the ‘local’ to effectively tackle its own challenges, or implement policies that are conducive to their interests and aspirations.

The Third World is also defined as an interactional space, in which it is the lived experiences of a group which marginalizes and separates them from dominant influential groups in societies. As such, the Third World experience is not identified as a geographic area underscored by historical colonialism, but is a social construct of relational experiences between groups of peoples.

TWAIL scholars Rajagopal<sup>86</sup> and Bhatia have articulated a definition of the Third World that is not directly, squarely or remotely linked to the European encounter, but to experiences of violence, poverty, technological backwardness or such similar social, political, economic and legal deprivations encountered by groups in societies. Although I do not use this definition in my arguments in the chapters, it is an interpretation that I would engage in a different context. Jamaica and the Caribbean’s plantation slavery, indentured labor, Third World experiences and importantly, its continued subservient

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<sup>86</sup> Balakrishnan Rajagopal, “Locating the Third World in Cultural Geographies” (1998-99) *Third W L Stud* 1; Amar Bhatia, *The South of the North – Building on Critical Approaches to International Law with Lessons from the Fourth World*, (2012) 14:1 *Ore Rev of Intl L* 131.

position as the ‘dominated’ in too many spheres of the global imperial order, warrants a definition of the Third World on terms which recognize that the implications of its historical colonial experiences is still an observable handicap to quests for independence in international law.

### **2.1.2. Linkages between Development in the Third World and International law**

In this section, I undertake an analysis of the conceptual and practical linkages between development in the Third World and international law, and use the discussion to frame my critique of approaches to intellectual property rights law in the Third World.

My contribution to the field proposes the shaping and operation of development policy that is built on a participatory intellectual property framework. Geographical indications can only be envisaged as intellectual property right assets for Jamaica if they are effectively administered,<sup>87</sup> protected internationally, and sustained by active engagement through strategic alliances international IP networks.<sup>88</sup> I refer to intellectual property right assets as intangible resources which generate, or have strong potentials of generating economic, cultural and social benefits for businesses, communities and key stakeholders involved its commercialization. I conceptualize development as a process and an ambitious objective that strongly implicates these tenets.

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<sup>87</sup> I explain and discuss this argument in chapters 6 and 7 of the thesis.

<sup>88</sup> I address this point in chapter 8 of the thesis.

My arguments on development are made to achieve two purposes. Firstly, I argue that the development paradigm is historically and conceptually contingent upon the influence of particular states,<sup>89</sup> dominant individuals, groups and international organizations.<sup>90</sup> These actors have augmented a narrative of development which perpetuate hegemony in approaches to policy choices in the Third World.

The second argument is that Jamaica's colonial experience led or contributed to an acculturation of the norms of the colonial 'plantocracy' class into the interests and identities of the country's local elites. The 'plantocracy' class refers to individuals who acquired their wealth through the exploits of Jamaica's sugar plantations during the colonial period. These Europeans acquired socio-economic and political affluence in

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<sup>89</sup> Jennifer Beard, *The Political Economy of Desire: International Law, Development and the Nation State* (London: Taylor & Francis, 2006) at 159-160. [Beard "*Political Economy, International Law*"].

<sup>90</sup> On the role of multinational companies, the nation state, local elites and regional bodies in shaping the development encounter in former colonial regions, see: Tanya Murray Li, *The Will to Improve: Governmentality, Development and The Practice of Politics* 90-122 (Duke University: North Carolina, 2007), ["Li, Development and the Practice of Politics"]. See also Marti Koskenniemi, "Empire and International Law" (2011) 61 *Univ. Toronto L.J.* 1. Koskenniemi provides a historical account of how the use of certain vocabulary in the European narrative has influenced the imperial dimensions of international law. According to Koskenniemi, the right of ownership to property, the emergence and authority of the state and the advancement of mercantilist interest in the fifteenth and sixteenth centuries were borne out of natural law principles. This natural law principle of dominion over others, and the right to control resources dominated legal discourse throughout the centuries and is evident today in the dominance of the west in the formulation and implementation of international treaties.

Jamaican society<sup>91</sup> because of their economic gains from agricultural exports to Europe and other countries.<sup>92</sup>

A form of elitism, having its origins in Jamaica's 'plantocracy', and the experiences of slaves, indentured laborers and plantation workers, still exists in contemporary Jamaican society. This is played out in the practices of locals whose identities and interests are shaped by the affluence of their social class. Two observations are notable. Imperialistic development policies are adapted at the domestic level, and are frequently managed by political and/or social elites.

Secondly, and related to my first argument, this segment of Jamaica's society is influenced by dominant global imperialistic perceptions of approaches to be used in engagements with social or governmental development programs.<sup>93</sup> These approaches are not workable without their domestication, framed and centered on the interests of a wide cross-section of Jamaican peoples.<sup>94</sup>

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<sup>91</sup> John Stewart, *A View of the Past and Present State of Jamaica*, (Oliver & Boyd: Edinburgh, 1823) at 119-122; Franklyn W. Knight, *The Caribbean, The Genesis of a Fragmented Nationalism* (New York: Oxford University Press, 1990) p. 76.

<sup>92</sup> Trevor Burnard, "The Grand Mart of the Island, The Economic Function of Kingston Jamaica in the Mid Eightieth Century in Katheen E. Montieth & Glen Richards, *Jamaica in Slavery and Freedom, History, Heritage and Culture*", (The University of the West Indies Press: Kingston 2002) p. 226.

<sup>93</sup> Michaeline Crichlow, *Negotiating Caribbean Freedom: Peasant and the State in Development* (Oxford: Lexington Books, 2005).

<sup>94</sup> According to a 2014 study, 1/5 of Jamaica's 2,717,991 million population are below the poverty line, living on \$7500.00 Jamaica Records Increase in Poverty, Jamaica Observer November 30, 2014 (available online, [http://www.jamaicaobserver.com/news/Jamaica-records-increase-in-poverty\\_18031723](http://www.jamaicaobserver.com/news/Jamaica-records-increase-in-poverty_18031723)). Programs capable of contributing to development should be representational of Jamaica's marginalized and its under-employed groups; Patricia Northover & Michaeline Critchlow: *Size, Survival & Beyond* in Norman

## 2.2. The Concept of Development from TWAIL-Constructivist Perspective

Constructivist theorize international relations from bases of how actors' behavior, position and influences are formed, reflected and proliferated amongst and within organization, groups and states. Central languages and words in constructivism are "how", "how possible", "interests", "identity formation", and "interaction".<sup>95</sup> Therefore, the arguments that a constructivist scholarship are concerned with are related to social construction modalities of how actors' behavior influence actions, how actions influence norms, the interconnectedness between norm creation, norm diffusion, and the institutionalization and internalization of dominant norms in international sectors.

In using constructivist theory, I am interested in an understanding of what shapes intellectual property norms in Jamaica, the Caribbean and Third World communities generally, the interplay between dominant actors and the internationalization of geographical indication law and policy, the reasons for the proliferation of geographical indications legislation in the Caribbean, the type of debates, policy choices and arguments on geographical indications that are prominent in intellectual property right communities, and prospects of positioning geographical indications as assets for the Caribbean region.

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Girvan & Brian Meeks, *The Thought of The New World The Quest for Decolonization* (Kingston: Ian Randle Publishers, 2010).

<sup>95</sup> J.T Checkel, "The Constructivist Turn in IR Theory" (1998) 50 *World Politics* 324.



In engaging with constructivism, the possibilities of TWAIL discourse as an emancipator of intellectual property rights law is more practical and achievable. Ideas and praxis on creating effective Third World representation in intellectual property are feasible as policies, when there is clear understanding of actor influences in the formation and application of international law as dominant norms in local communities. Identified issues in the limitations of international law must then be re-orientated and re-engaged to reflect Third World values and interests.<sup>96</sup>

Constructivism's focus on the inter-subjectivity of the knowledge discourse that exists in the interaction between domestic and international actors is the most salient basis on which to initiate theorizing on the concept of development in the Third World. This assertion is based on social interactions between groups within hegemonic societies which produce a norm consensus that create dominant political, legal and economic discourses. By inter-subjectivity, I am referring to shared understanding or meanings among a group of individuals or entities on issues, rule or, area of discourse.

I engage in discussions on the formation of actor interest and identities and the proliferation of norms from an interactional perspective. In this approach, norms are not static, neither do they exist as independent variables, but are created and do change, based on actors' interpretation of the constituents of the norm, and by epistemic

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<sup>96</sup> Obiora Chinedu Okafor, *Enacting TWAILIAN Praxis in Non-Academic Habitats: Toward A Conceptual Framework*, *Symposium On Theorizing TWAIL Activism, AJIL Unbound*, August 02, 2016.

communities' perception and ability to proliferate and institutionalize specific norms as dominant ideologies in societies.

I argue that it is the interpretation of norms – as reinforced through interpretive shared understandings within certain groups both locally and internationally – which form the basis of rules that define how development policy is conceptualized.<sup>97</sup> Scholars Finnermore and Sikkink,<sup>98</sup> in examining the role of norm dynamics in the formation of dominant knowledge, assert that norm consensus dictates appropriate forms of conduct and principles used in interactions amongst international actors.

Norms may either facilitate changes to how a form of knowledge is interpreted, or reinforce an existing paradigm associated with the norm.<sup>99</sup> Applying constructivist theorizing to the concept of development supports the argument that societal norms, which are formed through collective understandings and human interaction- is the basis for creating the normative and epistemic interpretation<sup>100</sup> of development, at any

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<sup>97</sup> Finnermore and Sikkink “*International Norm Dynamics*”, *supra* note 71.

<sup>98</sup> According to Finnermore and Sikkink, three stages are involved in the internalization of dominant norms governing relations between states. A powerful state or body (norm entrepreneurs) influences a group of states (norm leaders) to embrace a chosen ‘normative’ application of a norm. The norms become transfused globally as a dominant shared consensus if norm leaders have secured compliance (through various forms of pressure and fundamentally, by being legitimated as legal norms in international organizations) amongst other international state actors. In the final stage, the norm becomes ingrained in society as dominant knowledge governing actors’ identities, interests and actions. *Ibid* at 895.

<sup>99</sup> I argue that the technical assistance provided by the World Intellectual Property Office, the European Union and other powerful bodies to peripheral countries impart forms of knowledge about intellectual property rights laws which reinforces power inequalities between the core and the periphery.

<sup>100</sup> Adler, “*Constructivism in World Politics*”, *supra* note 71.

particular time. These practices become institutionalized through legal principles and underlie the ideologies used in ‘civilizing’ the periphery.<sup>101</sup>

Despite the prevalence of development theorizing in the academic literature,<sup>102</sup> there is a lack of consensus on the precise scope and meaning of the notion of ‘development’. Development scholars Pieterse and Escobar rightly argue that a universal approach to development is inconsistent with the institutional capacity and socio-political dynamics of Third World countries.<sup>103</sup> Pieterse defines development as an “organized intervention in collective affairs according to a standard of improvement”.<sup>104</sup> Escobar more poignantly focuses on the political dimensions of development, by maintaining that it is more aptly described as “an apparatus that links forms of knowledge about the Third World with the deployment of forms of power and intervention”.<sup>105</sup> The commonality in

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<sup>101</sup> Antony Anghie, *Imperialism, Sovereignty and the Making of International Law* (Cambridge: University Press, 2005). [Anghie, “The Making of International Law”]. Ikechi Mgbeoji, *Civilising*. Mgbeoji critiques the use of imperialism in facilitating continual dominance by western countries in the methodological approach to development in periphery states; See also Chidi Oguamanum, “Local Knowledge as Trapped Knowledge: Intellectual Property, Culture, Power and Politics” (2008) 11 *J W Intell Prop* 29. Oguamanum rightly argues that the internationalization of intellectual property rights has excluded local knowledge from the imperial construct of dominant knowledge that constitutes intellectual property rights.

<sup>102</sup> Jan Neverdeen Pieterse, *Development Theory* (Sage, London: 2009). Pieterse explores the conflicting approaches to development and supports a development orientation that engages with “critical globalism”, that is, interrogates the challenges with civil society, international organizations, market forces and interstate agencies in development policy orientations. [Pieterse, “*Development Theory*”].

<sup>103</sup> *Ibid.* Jan Neverdeen Pieterse, “The Development of Development Theory: Toward Critical Globalism” (1996) 3 *International Political Economy* 541. Arturo Escobar, *Encountering Development: The Making and Unmaking of the Third World*, (Princeton University Press: New Jersey, 1995) [Escobar, “Encountering Development”]; Jan Neverdeen Pieterse, “My Paradigm or Yours? Alternate Development, Post-Development, Reflexive Development” (1998) 29:2 *Dev C* 343.

<sup>104</sup> Pieterse “*Development Theory*”, *supra* note 102.

<sup>105</sup> Arturo Escobar, “Imagining a Post-Development Era? Critical Thought, Development and Social Movements (1992) 31 *Soc T, Third World & Third World Is* 20 at 23. [“Escobar: Critical Thought and

Pieterse's and Escobar's definition of development is that both refer to the presence of 'intervention' as a necessary element in the development process.

However, the role of international organizations, influential groups and state actors in articulating and orientating development policies in the Third World toward forms of knowledge that are more aligned with their own aspirations and ambitions, brings Escobar's theorization on development to the forefront of my argument. Intervention without participation from Third World peoples is unlikely to produce results. I emphasize an essential and controversial point that the involvement of the Third World in development arguments and policies is insufficient to effectuate participatory outcomes.

A Third World approach to the development narrative warrants a focus on social inclusiveness of Third World peoples in the orientation of ascent policies in the Third World.<sup>106</sup> As I later discuss in this section and in subsequent chapters,<sup>107</sup> notions of intellectual property right's relevancy to the Third World call for a theoretical orientation towards, and practical engagements with its marginal classes, and with its domestic

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Development?"]. Escobar critiques the failures of the dominant development paradigm in developing countries and argues for the formulation of development theorizing based on Third World representation. Imperative to Escobar's argument is the use of social movements in effectuating changes to development policies.

<sup>106</sup> *Ibid.*

<sup>107</sup> I discuss this point in Chapters 5 and 7 of the thesis.

resources.<sup>108</sup> Counter hegemony in intellectual property right is impossible without this ideological construct. In the section below, I focus on international law and development, and then discuss arguments on intellectual property right and development from a Third World perspective.

I theorize that agricultural and food-based geographical indications must be envisaged as socio-economic and cultural assets, having implications that transcend the commerciality of the products, illuminating the foundations of a Third World approach to intellectual property. This approach centralizes on identifying and developing the contributions of people, and their communities to the vitality of registered geographical indication products. Therefore, it is relevant to engage in this analysis, to expose the flaws of main stream ‘development’ and intellectual property right discourses.

### **2.2.1. The Politics of International Law and Development**

Discussions about development cannot be adequately espoused without reference to the role of international law in defining and re-orienting development policies in the Third World.<sup>109</sup> As a legitimizing force, international law (absent forceful Third World intervention) enables the dominant principles underlying development to be internalized

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<sup>108</sup> I refer to the “marginal classes” as the non-elites in Third World communities. Ikechi Mgbeoji’s critical piece on the elite-centric nature of intellectual property rights in Africa shows that domestic intellectual property has yet resulted in involvement of the average African in its intellectual property landscape. Ikechi Mgbeoji, “The Comprador Complex: Africa’s IPR elite, Neo-colonialism, and the Enduring control of African IPR Agenda by External Elites”, *Osgoode Legal Studies Research Paper No. 32/2014*.

<sup>109</sup> Anghie, “Making of International Law”, *supra* note 73; Chidi Oguamanam, *Intellectual Property in Global Governance*, (Routledge: London, 2012) at 223-230, [Oguamanam, “*IP in Global Governance*”].

as rules<sup>110</sup>, reinforced through influential social actors, and applied as asymmetrical development policies in the periphery.<sup>111</sup>

Although there is no single consensus on the definition of development, what is clearly obvious from the literature<sup>112</sup> is that the ontologies of development changes over time. My reference to the ontologies of development relates to the specification of the concept that determines the particular narrative of the discourse and in particular, forms the basis of understanding the nature of ‘development’.<sup>113</sup> Therefore, the notion of what is construed as development is based on collective meanings, interpretations and

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<sup>110</sup> Anne-Marie Slaughter Burley International Law and International Theory: A Dual Agenda (1993) 87 *Am. J of Int'l* 205 “Slaughter, “International Law”. Myers S. McDougall, Law as a Process of Decision: A Policy Oriented Approach to Legal Study (1956) 1 *NATLF* 53. Myers S. McDougall & Michael Reisman International Law Essays: *A Supplement to International Law in Contemporary Perspectives* (New York: Foundation Press, 1981); Alexander Wendt, Constructing International Politics, (1995) 20:1 *Int'l Sec* 71. [Wendt, “Constructing International Politics”]. Martha Finnermore & Kathryn Sikkink: Taking Stock: The Constructivist Research Program in International Relations and Comparative Politics (2001) 4:1 *Ann Rev Pol S* 391.

<sup>110</sup> Irma Alderman, Fallacies in Development Theory and Their Implications for Policy in Joseph Stiglitz & Gerald Meir (eds) *Frontiers of Development Economics* (New York: Oxford University Press, 2000) at 103. Amartya Sen, *Development as Freedom* (New York: Oxford University Press, 1999), [Sen, Development as Freedom’].

<sup>112</sup> On non-legal theories of development in the Third World, including a critique of development practices: Cheryl McEwan, *Third Worldism Theory and Development* (New York: Routledge 2009); Arturo Escobar, “Imagining a Third World Era? Thought, Development and Social Movements (1992) 31:1 *Soc Text* 20, and Arturo, “Encountering Development” *supra* note 105.

<sup>113</sup> My use of the term ontologies is most closely aligned with W.V. Quine, who noted that an ontological reference must be grounded in relation to the variables of the theory itself. W.V Quine, “Ontology and Ideology” (1951) 2:1 *Phil Stud* 11. I Since the variables of development are not constant or independent but interconnected, the space of intellectual property education in fostering understandings of the relevance and worth of domestic IP is also salient in positioning geographical indications as assets of development. This notion of legal education and development is explored in Michael J. Trebilcock & Mariana Mota Prado, “The Rule of Law and Development: Legal Education” in, *An Advanced Introduction to Law and Development* (Cheltenham: Edward Edgar Publishing Ltd, 2014), 51-52.

assumptions<sup>114</sup> between powerful actors and legal institutions in the global community. These collective meanings and interpretations shape the identities and interest of these groups, create an epistemic community, and have influenced the theoretical narrative of western development discourse and the social reality<sup>115</sup> which it produces.

I define an epistemic community as enclaves for the identification and construction of governing norms which are disseminated through interactions amongst powerful states and social actors. These norms become institutionalized as rules governing international law and development. Holzner and Max, in their analysis of the social structure of knowledge formulation, note that epistemic communities focus on the “entire constellation of values, techniques ... shared by its members”.<sup>116</sup>

The salience of social interaction to epistemic communities is more aptly delineated by academic Peter Haas.<sup>117</sup> Peter Haas postulates that epistemic communities are networks with “...authoritative claim to policy-relevant knowledge and...a shared set of normative and principled beliefs” which influence outcomes.<sup>118</sup> I approach the concept of epistemic

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<sup>114</sup> *Supra* note 18; Stefano Guzzino “The Concept of Power: A Constructivist Analysis” (2005) 33 *Millennium J Int'l S* 495.

<sup>115</sup> John R. Searle, *The Construction of Social Reality* (New York: Free Press, 1995), 79-126. [Searle, “*Construction of Social Reality*”].

<sup>116</sup> Bulkart Holzner & John H. Max, *Knowledge Application: The Knowledge System in Society* (Boston: Allyn and Bacon, 1979) p.107.

<sup>117</sup> Peter Haas, “Epistemic Communities and International Policy Coordination” (1992) 46:1 *Int'l O* 1, [Haas, “*Epistemic Communities*”]. See also E. Adler, *Communitarian International Relations: The Epistemic Foundations of International Relations* (New York: Routledge, 2005).

<sup>118</sup> *Ibid*, Haas, “*Epistemic Communities*” at 7.

“communities” as one which includes a broader network of key players involved in the framing of development policy, that is a diversity of actors such as interest and elite based groups and individuals. As such, throughout the thesis I identify international intellectual property right organizations, intergovernmental organizations, and dominant business groups and governments bodies as in local and international communities, as examples of epistemic communities.

### **2.2.2. Critique of Western Ideologies of Development from Third World Perspectives**

Conceptualizing the Third World as spaces to be developed emerged in western ideologies on development,<sup>119</sup> and is still used to inform western theorization on international law and development.<sup>120</sup>

Modernization theory was used to theorize the transformation of ‘uncivilized’ countries into ‘civilized’ spaces, by forecasting the periphery as territories without histories, cultures and social structures. I further argue that modernization theory’s focus on transforming ‘uncivilized’ territories into developed spaces produced ideological themes in law and development arguments which limited ‘development’s’ ability to benefit the periphery. The growth of neo-liberalism in western theorization on economic progress has manifested into a predilection of exploitation of peripheral resources. Neo-liberalism

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<sup>119</sup> Ruth Gordon & Jon Sylvester, *Deconstructing Development* (2004) 22:1 *Wis Intl LJ* 1. [Gordon: “*Development*”]. Brian Tamanha, *The Lessons from Law and Development Studies* (1995) 89:3 *AJIL* 470.

<sup>120</sup> *Ibid.*



facilitates the growth of a development ideology which perpetuates forms of imperialism in peripheral countries. To ignore the histories, cultures and socio-economic dynamics of a heterogeneous Third World is a blunder in development approaches.<sup>121</sup>

I argue that neo-liberalism advances a development perspective which secures and sustains the interests of transnational capitalist classes<sup>122</sup> through international law, and debilitates the emancipatory futures<sup>123</sup> of the Third World. The liberal conceptualization of development in colonial spaces changed overtime from the perception that development was a wholly evolutionary process to one that required intentional involvement by the state to reduce poverty and unemployment nationally.<sup>124</sup>

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<sup>121</sup> Frederick Hayek, *The Road to Serfdom* (New York: George Routledge & Sons, 1944). Frederick Hayek's conceptualization of neo-liberalism as an ideology focused on its ability to promote welfare through individual liberty, while downplaying economic affairs. Themes relevant to law and international relations are soundly echoed in David Harvey's interpretation of the concept by critiquing the use of international rules in advancing the proprietary interest of powerful states and international organizations in less powerful countries. David Harvey, *Spaces of Global Capitalism: A Theory of Uneven Geographical Development* (London: Verso, 2006).

<sup>122</sup> The Washington Consensus played an influential role in the framing of Neo-liberal policies. See Immanuel Wallerstein's critique of western influence in the conceptualization and use of "universal" policies. Wallerstein argues that Europe and the United States have used universalism to justify neo-liberal reform and truth about free market economics, to gain global acceptance of their policies. Immanuel Wallerstein, *European Universalism, The Rhetoric of Power*, (New York: New Press, 2006).

<sup>123</sup> Prabakash Singh, "Macbeth's Three Witches: Capitalism, Common Good and International Law" (2012) 14:2 *Or Rev Intl L* 47. [Singh, "Capitalism, Common Good and International Law"].

<sup>124</sup> See M.P Cohen & R.W Shenton, *Doctrines of Development* (Routledge: London, 1996) p 12. Walter Rodney, *How Europe Underdeveloped Africa* (Great Britain: Bogle-L'Ouverture Publications, 1972).

Arguments that propose that development is both an immanent process and one which requires intentional intervention by state actors<sup>125</sup> are socially construed from a knowledge structure which is produced, reproduced and reified through various international organizations and non-state actors.<sup>126</sup> I argue that this systemic dynamism portrays the epistemological dimensions of development. An epistemic community's interpretation of development rules, become internalized and institutionalized as dominant legal principles and norms, forge states and actor interests, and determine the scope and results of development policies.

Therefore, a western construct of development tends to be both an inclusionary and exclusionary mechanism; representing a modality of advancement for the aspirations of transnational capital classes,<sup>127</sup> while restraining or limiting similar trajectories for non-elites in Third World societies. The World Intellectual Property Office's Development Agenda<sup>128</sup> is illustrative of this framework. The Development Agenda is indicative of a program, built on hegemonic intellectual property ideals that infiltrate a practice of non-

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<sup>125</sup> Maria Eriksson Baaz, *The Paternalism of Partnership: A Third World Reading of Identity in Development Aid* (New York: Zed Books, 2005).

<sup>127</sup> Brian Meeks, "Jamaica on the Cusp of Fifty: Whither Nationalism and Sovereignty?" in Linden Lewis (ed) *Caribbean Sovereignty Development and Democracy* (New York: Routledge, 2013) at 228-239.

<sup>128</sup> Neil Natanel, *The Development Agenda: Global Intellectual Property and Developing Countries* (Oxford University Press: Oxford, 2008). Peter Yu, A Tale of Two Development Agenda (2009) 34 *Ohio Northern University Law Review* 23. See World Intellectual Property Office Development Agenda: <http://www.wipo.int/ip-development/en/agenda/recommendations.html>. Cluster A: WIPO's technical assistance should be: development-oriented, demand-driven and transparent, taking into account the priorities and the special needs of developing countries, especially LDCs, as well as the different levels of development of Member States and activities should include time frames for completion. In this regard, design, delivery mechanisms and evaluation processes of technical assistance programs should be country specific.

representation of Third World peoples in IP policy configurations.<sup>129</sup> I also reinforce a regrettable and critically realistic point that the inability of western constructs of development to produce marked results in the Third World is also attributed to practices of Third World elitism and politics in the region.<sup>130</sup>

The problematic relationship between international law and development in the Third World is that the legal principles which govern development policies are created without meaningful regard for its peoples' ambitions and aspirations. It is here that Lon Fuller's theory on the internal morality<sup>131</sup> of law becomes relevant in extrapolating the normative principles that should guide the operation of international law in the periphery. This has significant implications for attaining a paradigmatic shift in the peripheries' development narrative.

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<sup>129</sup> I also argue that the United Nations Millennium Development Goals are incorporated into other aspects of developmental policies that are utilized to frame related initiatives in the periphery. As an example, associating the United Nations Millennium Development Goals with food security through agricultural initiatives has not manifested into developmental gains for most peripheral countries. Philip McMichael & Mindi Schneider Food Security Politics and the Millennium Development Goals, (2011) *Third World Quarterly* 32. This is also reflected in WTO Doha Negotiations on Agreement on Agriculture: where agricultural negotiations are governed by development principles but are still non-representative of most peripheral countries agricultural production interests.

<sup>130</sup> I address this issue later in this chapter in the section that critiques development policy in Jamaica.

<sup>131</sup> Lon Fuller, *The Morality of Law* (New Haven: Yale University Press: New Haven, 1969), chapters 2 -5 [Fuller, "Morality of Law"]. See also Lon Fuller, *Human Interaction and The Law* (1969) *AJ* 1 at 3. Fuller's contentions are based on theorizing that customary law should form the basis of enacted rules. Fuller saw, customary law as an "unwritten code of conduct" which emerged through social processes of human interaction. This social setting creates norms which would appropriately sanction and encourage human conduct. The theme is evident in the author's propositions on law's morality.

According to Fuller, the legal normativity of law is based on principles which should be contextually grounded in its social reality.<sup>132</sup> Fuller rejects legal positivist's<sup>133</sup> arguments on rule-making<sup>134</sup> and instead purports that laws 'legality' emerges from interactions through human conduct.<sup>135</sup> As such, the integrity of a legal regime is dependent upon its ability to be transparent and fair, to be reflective of societal needs through the promulgation of laws and reciprocity between groups, the absence of retroactivity, clarity in enacted rules, and the avoidance of contradiction in its application.<sup>136</sup> The overarching theme which underscores Fuller's reasoning, is that there should be a relationship between the stated objectives of laws, the underlying rationale for its enactment and a non-altruistic objective of promoting societal interests.<sup>137</sup>

I argue that much of the theoretical arguments of TWAIL are infused with principles which are supportive of international laws' orientation towards its internal morality. The internal morality of law is based on its integrity. I make the argument that law's internal

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<sup>132</sup> *Ibid.*

<sup>133</sup> The positivist reason from the perception that the state is *the* legitimating force in law. Henry L. Hart, *The Concept of Law* (Oxford: Oxford University Press, 1994) at 79-117.

<sup>134</sup> See Fuller's critique of Henry L. Hart's concept of law where Hart purports that law's construct is independent of social variables. Rulemaking dictates conduct; conduct is not implicated in the formation of legal rules.

<sup>135</sup> Fuller notes that human conduct is essential in the application of legal rules, "human conduct to the governance of rules involves of necessity a commitment to the view that man is, or can become, a responsible agent, capable of understanding and following rules, and answerable for his defaults." p. 162.

<sup>136</sup> Fuller *supra* note 110 at 110-199. Fuller further identifies the ideal 'moral community' through which laws' internal morality would be exercised. Legal rules are interpreted and proactively applied, based on their effects on members of the community. Fuller, *supra* note 139 at 182.

<sup>137</sup> *Supra* note 110. These themes are explicit in Fuller's enunciated desiderata.

morality is itself determined by the ability of actors to influence changes to the knowledge paradigm associated with the existing legal order. The ability of peripheral countries to gain substantial recognition internationally for emerging forms of intellectual property right<sup>138</sup> is impossible without implicating its “legal normatively”.<sup>139</sup> Though Fuller’s contentions are idealistic, the tenets implicitly reverberate in legal arguments<sup>140</sup> which critique the hegemonic nature of international law.

The importance of Fuller’s arguments to the interactionality<sup>141</sup> of international law is well articulated in the constructivist arguments of scholars Brunne and Toope. By using Fuller’s legal theory as a foundation in their arguments, Brunne and Toope<sup>142</sup> posit that the normative rationality of international law is to be extrapolated from its internal morality. Brunnee and Toope focus on the dynamic social construction of norms that create and legitimize law. Using Fuller’s eight principles on the morality of law as a framework, the scholars posit that law is legitimized through social interaction amongst

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<sup>138</sup> For a discussion of other forms of emerging intellectual property rights see Graham Dutfield, *Protecting Traditional Knowledge: Pathways to the Future*, International Commission on Trade and Sustainable Development. Issue Paper No. 16; Susy Frankel, “The Mismatch of Geographical Indications and Innovative Traditional Knowledge” (2011) 29 *Prometheus: Critical Studies in Innovation* 3; Chidi Oguanaman, *International Law and Indigenous Knowledge, Intellectual Property, Plant Biodiversity and Traditional Medicine* (Toronto: University Press, 2006).

<sup>139</sup> Fuller, “*Morality of Law*”, *supra* note 110.

<sup>140</sup> See Ikechi Mgbeoji, *The Civilised Self and the Barbaric Other: Imperial Delusions of Order and Challenges of human security*, in Richard Falk, Balakrishnan Rajagopal and Jacqueline Stevens, *International Law and the Third World: Reshaping Justice*, (Routledge: London, 2008) at 152.

<sup>141</sup> I am referring to the ability of states, international organizations, intergovernmental organizations and other dominant actors to influence the norms, values and legal rules of the each other.

<sup>142</sup> Jutta Brunnee and Stephen Toope, *International Law and Constructivism: Elements of an Interactional Theory of International Law*, (2001) 39 *Colum. J. Trans'l L.* 19. [Brunnee and Toope: *International law and Constructivism*].

dominant actors, and that its interactionality, built on a shared understanding of values, and the desired outcomes of norm participants. This socio-legal theory on rule formulation, its dissemination and influence in states, recognizes the important role of influential states and non-governmental organizations as norm entrepreneurs in the legality of rules. Law's legitimacy emerges from a shared understanding of its "underlying social norms"<sup>143</sup>, active participation by dominant actors, and from the legality of law in states. The authors argue that the legality of law results from an understanding between lawgivers and citizens that rules are understood, complied with, and upheld by the state.

Law is legitimate when is persuasive - that is, its persuasiveness influences social actors' behavior in the reinforcement of its legal principles. This is based on social actors' knowledge, interests and identities, and the ability of epistemic communities to disseminate the shared dominant understanding of legal rules.<sup>144</sup> Imperative to international law's persuasiveness is its ability to be accepted as legitimate by those who are to be governed (or, are governed) by its principles. As Okafor has posited, the legitimacy of an international rule may facilitate its reinforcement by state actors: "the legitimation of an... international rule may reinforce the rule or norm"<sup>145</sup> associated with international law. The notion of law also brings to the fore the concept of

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<sup>143</sup> *Ibid.*

<sup>144</sup> See also Obiora Okafor, *The Global Process of Legitimation and the Legitimacy of Global Governance* (1997) 14 *Ariz J Int L Rev* 117. [Okafor, "*Legitimation and Legitimacy*"].

<sup>145</sup> *Ibid* at 124.

‘legalization’,<sup>146</sup> that is, what legalizes law and the space and place of global politics in shaping law. After all, international law is never an isolated phenomenon, but is shaped by the beliefs, traditions, cultures and interactions of and between societies.

Brunne and Toope posit that it is the internal morality of law which provides the normative basis for law to be perceived as legitimate by most actors. The authors note “if legal rules and a legal system as whole, aspire towards, and to an appreciable measure achieve the conditions that make law possible, the rule and system will likely attract allegiance”.<sup>147</sup> It is fallacious to assume that legal principles formulated by the hegemonic core can be a persuasive force of international law governing peripheral states, because it lacks adequate participation by the Third World.

A focal theme emerging from the interactionality of law is that law must be participatory. Power inequalities<sup>148</sup> between states and groups within states, influence knowledge construction, direction and the applicability of the laws which are so formed. Therefore,

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<sup>146</sup> Martha Finnemore & Stephen J. Toope, “Alternatives to ‘Legalization’: Richer Views of Law and Politics” (2001) 55:3 *Intl O* 743.

<sup>147</sup> *Supra* note 111 at 32.

<sup>148</sup> G. John Ikenberry and Charles A. Kupchan present a critically persuasive theorization on the almost infinite influence of power in international relations. The hegemon exercises power through coercion, or through socialization. Power as coercion employs a sanction and material incentive ideological construct in which influential states obtain consensus from less powerful states, by attaching sanctions to relational benefits. The hegemon also exercises power over nations by directly influencing the substantive beliefs of local elites who then influence changes in the perception of state leaders: “Hegemonic control emerges when foreign elites buy into the hegemon’s vision of international order and accept it as their own – that is, they when they internalize the norms and value orientations espoused by the hegemon and accept its normative claims about the nature of the international system”. G. John Ikenberry and Charles A. Kupchan, “Socialization and Hegemonic Power” (1990) 44:3 *Intl O* 283 at 285.

development policies which are facilitated through international law cannot be representational of Third World peoples unless the social structures through which legal norms emerge, are re-constituted. At present, the narrative of development through international law re-produces “differences between differences”, and “sets the excluded on an aspirational or evolutionary path towards it”.<sup>149</sup> Balakrishnan Rajagopal, in critiquing international law’s role in perpetuating a trajectory of non-development, posits that development policies<sup>150</sup> fail to satisfy the stated objectives in the periphery. Rajagopol argues that “the politics of development is complex...”<sup>151</sup> and shapes international institutions interests and associated legal norms.<sup>152</sup>

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<sup>149</sup> Peter Fitzpatrick, *Modernism and Grounds of Law*, (New York: Cambridge University Press, 2001) at 38.

<sup>150</sup> B.S. Chimni, *The Past, Present and Future of International Law: A Critical Third World Approach*, (2007) 8 *Melb. J. Int’l LJ* 499 at p. 509.

<sup>151</sup> Balakrishnan Rajagopal, *Counter-hegemonic International Law: Rethinking Human rights and development as a Third World Strategy* in Richard Falk, Balakrishnan Rajagopal & Jacqueline Stevens (eds) *International Law and the Third World: Reshaping Justice* (New York: Routledge-Cavendish, 2008).

<sup>152</sup> Luis Eslava & Istbanul Vignettes: *Observing The Everyday Operation of International Law*, (2014) 2:1 *Lon Rev Intl L* 1 3; Anghie, “Making of International Law”, *supra* note 27; B.S Chimni, “Third World Approaches to International Law: A Manifesto (2006) 8:1 *Intl Com L Rev* 3 [“Chimni, “Third World Approaches to International Law”]; M. Sornarajah, *Power and Justice: Third World Resistance in International Law* (2006) 10:4 *Sing YB Intl L* 19. Obiora Okafor, *Critical Third World Approaches to International Law (TMAIL) Theory, Methodology or Both?* (2008) 10 *Intl Comm L Rev* 371 [Okafor, “Critical Third World Approaches to International Law”]; Balakrishnan Rajagopol, *From Resistance to Renewal: The Third World Social Movements and the Expansion of International Institutions*. (2000) 41:2 *Harv Intl L J* 529.



International law is historically Eurocentric and continues to be western in construct.<sup>153</sup> The central problem with international law is that because its foundations are grounded in Eurocentrism's focus on western sovereignty, it is unable to adequately represent the varied interest of Third World communities.<sup>154</sup> The relationship between international law and development is not solely based on its Eurocentric origins, but on the continued configuration and use of legal principles<sup>155</sup> to perpetuate imperialism, and reproduce a narrative which silences its active Third World representation.<sup>156</sup> By casting an alternative history of international law from a non-European perspective, TWAIL posits that the 'development discourse' – configured by the west and applied to the rest – renders progress in the periphery untenable, because it excludes the active participation of Third World peoples in the formulation of legal policy prescriptions.<sup>157</sup>

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<sup>153</sup> Martti Koskenniemi, "The Politics of International Law Twenty Years Later" (2009) 20 *Eur J Intl L* 7. Martti Koskenniemi, "Empire and International Law" (2011) 61 *UTLJ* 1. Alan Boyle and Christine Chinkin, *The Making of International Law*, (Oxford: Oxford University Press, 2007); Antony Anghie, "The Evolution of International Law: Colonial and Postcolonial realities" (2006) 27:5 *Third World Quar* 739.

<sup>154</sup> Anghie, "*The Making of International Law*", *supra note 23*.

<sup>155</sup> *Ibid*, "Anghie, "The Making of International Law", *supra note 23*; Okafor, "Critical Third World Approaches to International Law" *supra note 152*.

<sup>156</sup> Gayatri Chakravorty Spivak, "Can the Subaltern Speak?" in Bill Ashcroft, Gareth Griffiths & Helen Tiffin eds. *The Third World Studies Reader*, 2<sup>nd</sup> edition. (London: Routledge, 2007).

<sup>157</sup> Chimni, "*Third World Approaches to International Law*" *supra note 152*, James Thuo Gathii, TWAIL: A Brief History of its Origins, its Decentralized Network and tentative Bibliography (2011) 3 *Trade L Dev* 26; "Anghie, "*The Making of International Law*, *supra note 23*.

As Anghie eloquently points out in his critique of international law and its linkages with development in former colonies, the laws associated with ‘modernizing’ the former colonies were framed to extend ownership and control of the regions’ resources to European powers.<sup>158</sup> Anghie notes “the fact that the terms of the exploitation were set by the colonial powers or the mandatory powers inevitably led to the sacrifice of native interests”.<sup>159</sup>

Anghie’s historical account<sup>160</sup> of the role of colonialism in shaping international law’s role in the development process is relevant for two reasons. Firstly, the altruistic principles that guided the use of international law in the colonial period, that advanced the welfare of ‘natives’ are still used in the knowledge construction of development policies in the Third World.

Secondly, because international law creates a norm consensus<sup>161</sup> that embodies particular policies and regulation pertinent to the application of a specific development orientation, without active participation from the Third World in its construction, such development

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<sup>158</sup> Anghie, *supra* note 23, “*The Making of International Law* at 160.

<sup>159</sup> *Ibid.*

<sup>160</sup> Anghie “*The Making of International Law*” *supra* note 23. Anghie notes that the Mandate System was used to collect information about the colonized territories to draft appropriate laws for the region. This “technologies of management” was used to establish contemporary international institutions such as the World Bank and the International Monetary Fund.

<sup>161</sup> See Alan Boyle & Christine Chinkin, *The Making of International Law*, (Oxford: Oxford University Press, 2007). The authors contend that the principles of international law are significantly influenced by non-state actors (such as international organizations) through processes of norm consensus. These processes effect changes in the development of international law and its application in international jurisdictions.

policies will remain an imperialistic<sup>162</sup> means of control.<sup>163</sup> The reference to imperialism relates to the use of capital and technological resources to exercise control over Third World peoples and, as a means of perpetuating domination and marginalization in these regions.<sup>164</sup>

An imperialistic ideology promotes its own proprietary interests internationally, while falsely purporting to support similar agendas in the periphery.<sup>165</sup> Anghie rightly notes that international law is “subjected to various pressures that might ultimately result in the emergence of an international system that permits, if not endorses and adopts quite explicitly imperial practices”.<sup>166</sup> This proposition is not futuristic but has already transpired: imperialism through international law restricts the scope of development in the Third World. As argued in the section below, as a creature of international law the dominant narrative associated with intellectual property rights in the Third World has an

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<sup>162</sup> James Thuo Gathii, *Imperialism, Colonialism and International Law*, (2007) 54 *Buffalo L R* 1013. [Gathii, “*Imperialism and International Law*”]. Gathii’s polemic commentary relates the expansion of international law in non-western countries with the west’s use of imperialism strictures. The scholar argues that colonialism facilitated the growth of imperialism in peripheral states using international law.

<sup>163</sup> Balakrishnan Rajagopal, *International Law from Below: Development, Social Movements and Third World Resistance* (Cambridge: Cambridge University Press, 2003). [Rajagopal, *International Law from Below: Development*”].

<sup>164</sup> Gathii “*Imperialism and International Law*” *supra* note 162. See also Anghie, “*Making of International Law*, *supra* note 23 at 273.

<sup>165</sup> Glynn Williams et al, “Representing the South” in Glynn Williams et al (2<sup>nd</sup> ed) “*Geographies of Developing Countries: The Global South in a Changing World*” (New York: Routledge, 2014) at 25-49.

<sup>166</sup> Anghie, “*Making of International Law*” *supra* note 23, p.274; The dissemination of development oriented policies through international law is usually characterized by an overly bureaucratic, state-centered, impenetrable and inaccessible scheme that defeats social welfare goals. Balakrishnan Rajagopal, *International Law from Below: Development, Social Movements and Third World Resistance* (Cambridge: Cambridge University Press, 2003), [Rajagopal, *International Law from Below: Development*”].

imperialistic undertone. Powerful states, multinational companies and interest groups influence and limits the ability of less powerful state actors to utilize intellectual property as assets of development.<sup>167</sup>

Decolonization<sup>168</sup> has not changed the skewed paradigm marking international law's application in the Third World. I use the term decolonization to describe the imagined communities of former colonized subjects, where the contestation over identity and resources are no longer a barrier to achieving social and economic progress. Decolonization created the illusion that international law is 'universal'<sup>169</sup> and therefore, has a similar rational and consequence as that which is applicable to hegemonic states and peoples.

### **2.3. Intellectual Property Rights from a TWAIL-Constructivist Perspective**

Intellectual property right' law legitimates the use of knowledge as intangible legal property.<sup>170</sup> This legal conceptualization of knowledge as property,<sup>171</sup> and the knowledge

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<sup>167</sup> Chidi Oguanaman, "Local Knowledge as Trapped Knowledge" (2008) 11 JWIP 29. Geographical Indications; Chidi Oguanaman, "Beyond Theories: Intellectual Property Dynamics in the Global Knowledge Economy" (2008-09) 9:2 *Wake Forest L Rev* 104.

<sup>168</sup> Brian Meeks & Norman Girvan eds., *The Thought of the New World, The Quest for Decolonisation*" (Kingston: Ian Randle Publishers, 2010).

<sup>169</sup> Anghie, "The Making of International Law", *supra* note 23 at 196; Sovereignty and the Third World state, *supra* note 24, Rajagopal, "*International Law from Below: Development*" *supra* note 84.

<sup>170</sup> Ikechi Mgbeoji, *Global Bio-piracy: Plants and Indigenous Peoples*, (Vancouver: UBC Press, 2005); Peter Drahos, *A Philosophy of Intellectual Property Rights*, (Michigan: Dartmouth, 1996), [Mgbeoji: "*Global Biopiracy*"] Ikechi Mgbeoji, Bio-cultural Knowledge and The Challenges of Intellectual Property Rights Regimes For African Development, (Keynote address at Nigerian Institute of Advanced Legal Studies, 2012). Chidi Oguanaman, *Intellectual Property Rights in a Global Governance, A Development Question*. (London: Taylor Francis, 2012); [Chidi: "*IP in Global Governance*"]; Peter Drahos, *Global Intellectual Property Rights: Knowledge, Access and Development* (London: Palgrave MacMillan, 2002).

<sup>171</sup> *Ibid.*

economy<sup>172</sup> is used to justify the expropriation and commercialization of intangible resources from the Third World. It is increasingly incorporated into development theorizing, and reinforced through social, legal and political interaction amongst intellectual property right epistemic communities and international law generally.<sup>173</sup>

Laws associated with the use of intellectual property are international in nature, based on their incorporation in the *TRIPS* agreement. Constructivist theorizing supports my argument that politics<sup>174</sup> plays an important role in the obligatory nature of intellectual property rights laws in the Third World. Therefore, politics is an integral aspect of compliance with intellectual property rights laws by Third World spaces, and is also salient in its formulation, current usages, and possibilities.<sup>175</sup> Since the advent of *TRIPS*

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<sup>172</sup> Chidi Oguanaman, “Beyond Theories: Intellectual Property Dynamics in the Global Knowledge Economy” (2008-09) 9:2 *Wake Forest L Rev* 104.

<sup>173</sup> Doris Estelle Long, “Democratizing Globalization” Doris Estelle Long makes a critical observation on the impact of globalization on the conception and workings of intellectual property rights Post-TRIPS. Long laments that globalization facilitates a western construction of intellectual property in which emphasis on consumerism threatens the economic and cultural importance of intellectual property to less powerful groups. The paradox of this is that globalization has also led to the growth of collective identities and the ‘indigenization of culture’, in which disempowered groups have turned to regionalism and other forms of non-multi-lateral integration to counter the effects of a fragmented intellectual property system. Doris Estelle, ‘Democratizing’ Globalization: Practicing the Policies of Cultural Inclusion, (2010) 10: 1 *Cardozo J Intl & Comp L* 217. I note as a caveat to her critique however, that globalization creates obstacles to the advancement of a grass root approach to intellectual property. This problem is exacerbated by the churning of what I term hegemonic regionalism, as is illustrated by the EU, and mega-agreements led by the United States (Trans Pacific Partnership Agreement) which continue to dictate and direct the trajectories of IP policy making.

<sup>174</sup> Alexander Wendt, “Constructing International Politics”, (1995) 20:1 *Intl Security* 1.

<sup>175</sup> Martha Finnermore & Stephen J. Toope, “Alternatives to “Legalization”: Richer Views on Law and Politics” (2001) 55:3 *Intl O* 743. Finnermore and Toope intricately dissect the meaning of law in a politicized world, concluding that law’s impact is derived from rules which are applicable, unambiguous, not retroactive, constant over time, feasible and are not inconsistent with official action. Law’s legitimacy ought to be generated from this conceptualization.

through the Uruguay Round,<sup>176</sup> Caribbean, Latin American<sup>177</sup> and African<sup>178</sup> countries have either adopted or amended their intellectual property legislation to conform to *TRIPS*.

However, there is a distinct asymmetrical relationship in TRIPS compliance between the Third World and hegemonic states.<sup>179</sup> The popularity of TRIPS-PLUS<sup>180</sup> agreements by the proliferation of bilateral, regional free trade and investment agreements has also

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<sup>176</sup> Uruguay Round Agreement: Trade Related Aspects of Intellectual Property Rights, Standards Concerning the Availability, Scope and Use of Intellectual Property Rights. Part II, Section 3 Article 22:2. [TRIPS].

<sup>177</sup> Carlos Correa, Expanding Patent Rights in Pharmaceuticals in Neil Netanel ed. *The Development Agenda*, (New York: Oxford University Press, 2009) at 247. [Correa, “*Development Agenda, Global Intellectual Property Rights and Developing Countries*”].

<sup>178</sup> Ikechi Mgbeoji, TRIPS and TRIPS-PLUS Impacts in Africa in Daniel Gervais, ed. *Intellectual Property Trade and Development, Strategies to Optimize Economic Development in a TRIPS-Plus Era*, (New York: Oxford University Press, 2007) at 294. [Ikechi, “*TRIPS and TRIPS Plus in Africa*”].

<sup>179</sup> Thomas Pearson, “Life is Not for Sale, Confronting Free Trade and Intellectual Property in Costa Rica” (2013) 115:1 *Am Anthropology* 58. Pearson discusses the effects of Costa Rica’s free trade agreement with the United States (CAFTA-DR) on the country’s indigenous seeds and plant varieties through a series of observational style interviews with affected individuals. The free trade agreement led to the enactment of legislation which appropriated seeds and plants as intellectual property, despite local opposition to the implementation of such provision; Peter Yu, “Déjà vu in the International Intellectual Property Regime”, (Available online at SSRN, [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=2486257&download=yes](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2486257&download=yes), last accessed on September 20, 2016). Peter Yu discusses the prevalence of TRIPS-Plus provisions in trade and investment agreements as part of a wider discussion chronicling and critiquing the ongoing international changes in the negotiating platforms of intellectual property rights: multi-lateral, pluri-lateral to non-multi-lateral agreements.

<sup>180</sup> TRIPS-PLUS refers to the era and state of play of intellectual property after the implementation of World Trade Organization’s Trade Related Aspects of Intellectual Property; a period that is characterized by the hegemon’s demand for higher standards of intellectual property rights, the implementation of stringent intellectual property standards in many Third World countries, and the continued diffusion of imperialistic ideals in the operation of intellectual property. See, Hafiz Aziz Ur Rehman, “India, TRIPS-PLUS Free Trade Agreement and the Future of Access to Essential Medicines, (2010) 19:3 *Inf Com T L* 267; Bryan Christopher Mercurio, TRIPS PLUS Provisions in FTAS: Recent Trends (Available online at SSRN: <http://ssrn.com/abstract=947767>, last accessed on September 20, 2016); Ikechi, *TRIPS and TRIPS Plus in Africa*, *supra* note 178.

legitimated the internalization of robust intellectual property policies in many Caribbean countries.<sup>181</sup>

Reus-Smit maintains that states recognize international law as relevant based on a process of political deliberation. He identifies several issues that international actors are concerned with in politically deliberating their adherence to legal obligations.<sup>182</sup> Fundamental amongst those identified are the identity of the actor, the actors' objectives in participating in international relations, and how the actors' identity is related to its preferential choices. Reus-Smit rightly argues that it is impossible to understand a state's obligation to international law without taking its historical narrative into account. These historical narratives contain the underlying political agenda that engender the nature of national legal regimes. The argument is reinforced in TWAIL theorizing, which more explicitly and poignantly chronicle the passivity of Third World communities in the formulation and application of international law.<sup>183</sup>

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<sup>181</sup> In June 2015, the Jamaican government voted to amend the duration of its copyright protection from fifty to 95 years. As a net importer of foreign copyright materials, the Jamaican jurisdiction has further concretized its interest in promoting the protection of foreign IP rights by this extension. I argue that Jamaica's intellectual property policy is significantly influenced by the United States' demands for IP compliance, as is indicated by the country's yearly inclusion on the United States Special 201 Watch list; European Communities-Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs – Complaint by Australia, World Trade Organization, WT/DS290/R. available online (docsonline.wto.org). Complaint by Argentina - WT/DS290 Annex C and D Addendum, Arguments of Third Parties, Argentina C-1A.10., (available online at docsonline.wto.org/imrd/GEN\_searchResult.asp); *See generally*, Dispute DS 285: United States and Antigua: Measures Affecting the Cross Border Supply of Gambling and Betting Services (available online at [https://www.wto.org/english/tratop\\_e/dispu\\_e/cases\\_e/ds285\\_e.htm](https://www.wto.org/english/tratop_e/dispu_e/cases_e/ds285_e.htm)).

<sup>182</sup> Christian Reus-Smit, *Politics and International Legal Obligation* (2003) 9 *Eur J Intl Rel* 4 [Reus-Smit, "Politics and International Legal Obligations"].

<sup>183</sup> Anghie, "The Making of International Law", *supra* note 23.

It is critical to analyze the role of politics<sup>184</sup> in the discourse associated with intellectual property in Third World societies, because it is the processes of interaction and deliberation that produces and reproduces actors' identities, and shapes their interests. Such dialogic interaction amongst international organizations, powerful states and individuals in core and periphery countries influences the asymmetric paradigm of intellectual property laws. A crucial dimension of politics is power.<sup>185</sup> In regards to international organizations, constructivist theorists Barnett and Finnermore maintain that they:

...can become autonomous sites of authority, independent from the state "principals" who may have created them, because of power flowing from at least two sources (1) the legitimacy of the rational-legal authority they embody and (2) control over technical expertise and information.<sup>186</sup>

As such, power enables international institutions and other powerful actors to dictate the meaning and relevance of resources, classify intangible resources as intellectual property commodities, and determine the boundaries of policies associated with such resources. I argue that politics and intellectual property rights laws are therefore mutually constitutive of each other, and have engendered significant asymmetries in property rights recognition between the periphery and core countries: the ontology of the political is evident in the epistemic construct of intellectual property in the international sphere.

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<sup>184</sup> Michael Barnett and Martha Finnermore "The Politics, Power and Pathologies of International Organization" (1999) 53:4 *Intl O* 699. [Barnett and Finnermore: *Politics and Power, International Organizations*].

<sup>185</sup> *Ibid.*

<sup>186</sup> *Ibid.*



This explains the increasingly maximalist trajectory of intellectual property right<sup>187</sup> and its narrative in many Third World societies. As Oguamanam laments, “the less developed countries’ economies and their vulnerable populations are at the receiving end of the distributional disequilibrium regarding access to knowledge and public goods in this unbalanced global IP system”.<sup>188</sup>

A TWAIL interrogation of the approach to intellectual property rights laws in the Third World further illustrates that the space has been, and continues to be marginalized in the global intellectual property system. The expropriation of resources<sup>189</sup> from Third World spaces, its commodification as international intellectual property; the continued insistence by the west for the region to increase its protection standards including criminal penalties for types of infringement<sup>190</sup>, are all examples that illustrate the asymmetrical dynamics of this trajectory.

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<sup>187</sup> Sell, *supra* note 73, “*Global IP Upward Racket*”; Oguamanam, IP in Global Governance, *supra* note 111; Valentina Sara Vadi, Access to Medicine versus Protection of Investment in Intellectual Property’ in Amanda Perry (ed) “*Law in The Pursuit of Development*” (New York: Routledge) 2010 at 52-67.

<sup>188</sup> Oguamanam, *supra* note 111 “*IP in Global Governance*”.

<sup>189</sup> Rosemary Coombe, Objects of Property and Subjects of Politics: Intellectual Property Laws and Democratic Dialogue Source. (1991) 69 *Texas Law Review* 1853; Ikechi, “Trips and Trips Plus in Africa, *supra* note 178. Andreas Rahmatian, Neo-Colonial Aspects of Global Intellectual Property Protection (2009) 12 *J of World Int. Prop* 40.

<sup>190</sup> Okediji, “Back to Bilateralism” *supra* note 73, Oguamanam, *IP in Global Governance*, *supra* note 111.

Although the terrain of intellectual property rights law has changed by the emergence of a greater number of global actors,<sup>191</sup> the change has been to encompass exclusivity over a greater number of resources.<sup>192</sup> The significant extent to which intellectual property rights laws function as a mechanism for powerful actors to sustain and increase their proprietary interest globally makes it a form of imperialism.<sup>193</sup> TWAIL theorizing does not only critique the asymmetries of international law's use in the Third World, but also posits that resistance should be built in its application.<sup>194</sup> As Rajagopol vehemently contends, "domination by the powerful has always produced resistance".<sup>195</sup> Representing the Third World in international intellectual property law is tenable.

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<sup>191</sup> On this point, the World Intellectual Property Office recently (September 17, 2015) published its 2015 index on Global innovation in intellectual property. Amongst the 141 countries which have emerged as top intellectual property innovators are Estonia (23<sup>rd</sup> most innovative country in 2014), Malta (26<sup>th</sup> most innovative country in 2014), Chile (42<sup>nd</sup> most innovative country in 2014) and Costa Rica. The countries are emerging players in the global intellectual property rights regime. World Intellectual Property Office, "The Global Innovation Index 2015: Effective Innovation Policies for Development", September 2015 ([http://www.wipo.int/edocs/pubdocs/en/wipo\\_gii\\_2015.pdf](http://www.wipo.int/edocs/pubdocs/en/wipo_gii_2015.pdf)); See generally, Maria Jose Abud, Carols Fink et al, "The Use of Intellectual Property in Chile" Chilean National Institute of Industrial Property-World Intellectual Property Office Working Paper, March 2013; Organization for Economic Co-operation and Development, "Enhancing Market Openness, Intellectual Property Rights and Compliance through Regulatory Reform in Estonia", OECD201 (available online at <https://www.oecd.org/estonia/48262981.pdf>).

<sup>192</sup> James Boyle, "A Manifesto on WIPO and The Future of Intellectual Property" (2004) 3:1 *Duke L & Tech Rev* 9. [Boyle, "A Manifesto on WIPO"].

<sup>193</sup> Gathii "Imperialism and International Law" *supra* note 57; See also Anghie, "Making of International Law, *supra* note 23 at.273.

<sup>194</sup> Chimni, "Third World Approaches to International Law: A Manifesto", Obiora Okafor, "Critical Third World Approaches to International Law: Theory, Methodology or Both? (2008) 10:4 *Intl Comm L Rev* 371. "Okafor, Newness, Imperialism and International Legal Order".

<sup>195</sup> Balakrishnan Rajagopol, "Reshaping Justice, International Law and Third World: An introduction" (2006) 27:5 *Third World Quar* 5 at 711.

TWAIL-ians have opined on the reformist modalities of the scholarship in creating spaces for a conceptualization of international law which is particularized based on local people, local bodies, and the nation state. Scholars Eslava and Pahuja, in rationalizing TWAIL's need to critique and engage with international law from a people-based perspective, propose that the scholarship's ability to make a marked impact on the universality of international law, requires a methodological approach that acknowledges the 'particularization' of its subjects.

Particularization means the specific situation of Third World subjects of international law which brings to the fore the observation that laws' hegemony cannot adequately represent, nor be constructively applicable to Third World peoples. The importance of identifying loopholes in international law as strategic reformist opportunities, and approaching problematic issues with practical TWAIL-ian praxis is also asserted by Okafor. Okafor emphasizes that a practical approach to a representational international law requires that the praxis in which practitioners, scholars and other key stakeholders methodological engage with international law must be constantly plugged into the "TWAIL electricity grid".<sup>196</sup> In effect, such a practical engagement with the challenges of international law involves use of inclusiveness and representational praxis to guide constructive attempts at policy reconfigurations.

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<sup>196</sup> Obiora Okafor, "Praxis and the International (Human Rights) Scholar: Towards The Intensification of Twailian Dramaturgy" Keynote speech delivered at, TWAIL Cairo Conference, February 21-24, 2015.

TWAIL's engagement with the resistance to, and historical colonial origins of international law, and constructivist's interrogation into the construction of meanings and interpretation of actors and their identities, offers an insightful narrative into how intellectual property rights law functions in the Third World, and how it can be transformed.

The dominant epistemic<sup>197</sup> dimensions of intellectual property right in Third World societies continue to be informed by the knowledge structure of the west. It is the west that defines the normative dimensions of intellectual property right<sup>198</sup> and controls the mechanisms that ultimately determine whether greater protection can be extended to emerging non-conventional forms of intellectual property, such as geographical indications and traditional knowledge.<sup>199</sup> However, international law is a construction of social reality. Therefore, it is conceivable for law to be de-constructible.<sup>200</sup>

Derrida points out that law is an authorized forced, justified from within even if there are counter responses or opposition to the to the law elsewhere that makes it unjust.<sup>201</sup> I

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<sup>197</sup> Adler, "Constructivism in World Politics" *supra* note 120.

<sup>198</sup> Oguamanam, *IP in Global Governance*, *supra* note 73. Boyle, "A Manifesto on WIPO", *supra* note 84; Peter Drahos, "When the Weak Bargain With The Strong: Negotiations in World Trade Organization" (2003) 8 *Intl Neg* 79.

<sup>199</sup> Konstantia Koutouiki & Katharina Rogalla von Bieberstein, The Nagoya Protocol: Sustainable Access and Benefit Sharing For Indigenous and Local Communities, (2012) 13:4 *VJEL* 513.

<sup>200</sup> Jacques Derrida, *The Force of Law: The Mystical Foundation of Authority* (1990)11: 5 *Cardozo L Rev* 921, ["*Derrida, Force of Law*"].

<sup>201</sup> Derrida, "*The Force of Law*" *supra* note 201.

make the argument that international law obtains its force from treaties and rules, and as importantly, from the actions of influential actors who further justify the use and enforceability of the law through their perspectives of the law. The enforcement of intellectual property right internationally is a concept, and a practicality that requires a degree of justification for its use, but also lacks force if it is widely envisaged by the state and local Third World communities as unjust. I use the term unjust here in a ‘Derridan’ sense, to relate to what I’ve term the ‘constitutive make up of law’- the interests which have galvanized into dominant norms, policy choices- leading up to the implementation of imperialistic rules, actors’ behavior, and any occurrences that directly or indirectly influence the formulation of intellectual property rights law.

### **2.3.1. Intellectual Property Rights and Development in the Third World**

Hegemonic influence on development theorizing is implicit in the dominant theme that links intellectual property rights with development. For a critical engagement with this discourse, the section focuses on the dominant ideology governing intellectual property organizations, and power imbalances between states in perpetuating an imbalanced intellectual property narrative in the Third World.

Most intellectual property right legislation and policies have insignificant impact on local development. Furthermore, key actors in the international fora have enabled the imposition of more robust forms of intellectual property in Third World societies using

regional, bi-lateral, and pluri-lateral<sup>202</sup> free trade agreements.<sup>203</sup> These initiatives are hegemonic,<sup>204</sup> facilitated the liberalization of trade, and are used both to commodify and safeguard intangible resources as intellectual property, often to the detriment of Third World communities.<sup>205</sup>

Building successful relationships between development and intellectual property means using counterhegemonic approaches to promote forms of Third World intellectual property that are domestically relevant and are commercially viable as consumer products.

Therefore, I define the role of development in intellectual property rights from the following perspective. The first is the implementation of inclusive social, economic,

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<sup>202</sup> *Supra* note 7.

<sup>203</sup> Susan K. Sell, “The Global IP Upward Ratchet, Anti-counterfeiting and Piracy Enforcement Efforts: The State of Play”, Third World Network, published 2008. ( Available online at [http://www.twinside.org.sg/title2/intellectual\\_property/development.research/SusanSellfinalversion.pdf](http://www.twinside.org.sg/title2/intellectual_property/development.research/SusanSellfinalversion.pdf).) [Sell, “Global IP Upward Ratchet”]. Sell argues that the maximalist approach to intellectual property rights is driven by the United States’ focus on augmenting its power, minimizing opposition to its trade practices and safeguarding its overseas business interests. See also Ruth Okediji “Back to Bilateralism? Pendulum Swings in International Intellectual Property Protection” (2003) 1 U. Ottawa L. Tech. J. 125. Okediji critiques the increasing use of bilateral agreements by the United States, in accommodating “forum shifting” and enabling the imposition of strong IPRs in developing countries. [Okediji, *Back to Bilateralism?*]. Chidi Oguamanam “IP in Global Governance: A Venture in Critical Reflection” (2011) 2 W.I.P.O.J 2. [Oguamanam, “*IP in Global Governance*”]. My reference to “key actors” pertains to individuals, states, non-governmental organizations, international institutions and other social actors whose influential positions in the global IP order impacts policy choices in the direction.

<sup>204</sup> On the dynamics of hegemony in international politics, Robert Keohane notes that a hegemonic state is one that has access to crucial raw materials, control the major sources of capital, maintain a large market for imports and hold comparative advantage in high value goods. Robert Keohane, *Cooperation and Discord in the World Political Economy*, (New Jersey: Princeton University Press, 2005).

<sup>205</sup> The proliferation of regional, bilateral and pluri-lateral free trade agreements augmenting compliance with strong intellectual property rights provisions are facilitated through these practices.

cultural policies and structures that are representative of a wide cross section of peoples in Third World communities.

The second point concerns the contestation of ownership to intellectual property rights between Caribbean peoples and hegemonic groups such as transnational capital classes in the United States and Europe. Unequal bargaining leverage, economic and political imbalances in international relations facilitate the enforcement of robust intellectual property standards in many Third World communities. In this trajectory, development from within the Third World is impossible. The relationship between intellectual property rights and development should be understood as the strategic positioning of Third World intangible assets to foster socio-economic improvements in peoples' lives, and to safeguard their cultural heritage. A commitment by Third World communities to support the domestic ownership and commercialization of intellectual property illustrates a strong relationship between intellectual property rights and development. A development oriented intellectual property strategy is one that recognizes the value of local protectable resources, provide intellectual property education to local communities, and uses a participatory approach in the design of intellectual property rules.

The relative passivity of Jamaica and the Caribbean in the internalization of intellectual property norms has manifested in the region's acceptance of an IPR agenda in which it is marginally represented. This has affected its ability to proactively counteract intellectual

property's hegemonic paradigm, thereby substantially stifling its emancipatory capacity.<sup>206</sup>

Conceptualized as such, intellectual property rights in peripheral communities is only relevant where it functions as an asset which engineers, contributes or is aligned with domestic development goals as opposed to an aspect of "imperialism".<sup>207</sup> My proposition on agricultural and food based geographical indications is supported by this approach. The notion of intellectual property right as a Third World asset is substantially dependent upon the appropriateness and relevance of the intellectual property to the specific Third World community. Therefore, the proliferation of an imperialist intellectual property

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<sup>206</sup> A striking exception to this paradigm is World Trade Organization's Dispute Settlement ruling which granted Antigua and Barbuda the right to suspend its compliance to TRIPs in regards to the protection of United States proprietary interests in its country. Although the specifics of the case are not relevant to this thesis, the cross-retaliatory measure adopted by Antigua exemplifies how peripheral countries can utilize intellectual property as a bargaining mechanism for advancing their domestic interests. WTO DS285 – Antigua and Barbuda and the United States – Measures affecting Cross Border Supply of Gambling and Betting Services (Available online at: [https://www.wto.org/english/tratop\\_e/dispu\\_e/cases\\_e/ds285\\_e.htm](https://www.wto.org/english/tratop_e/dispu_e/cases_e/ds285_e.htm), last visited September 19, 2016). Cross retaliation is a redress measure to the successful complainant to World Trade Organization's Dispute Settlement Understanding that enables the member to suspend intellectual property concessions given to the disputing party. Article 22.1: Compensation and the suspension of concessions or other obligations are temporary measures available in the event that the recommendations and rulings are not implemented within a reasonable period of time. However, neither compensation nor the suspension of concessions or other obligations is preferred to full implementation of a recommendation to bring a measure into conformity with the covered agreements. Compensation is voluntary and, if granted, shall be consistent with the covered agreements. Uruguay Round Agreement, Understanding on Rules and Procedures Governing the Settlement of Disputes, (Available online at World Trade Organization, [https://www.wto.org/english/docs\\_e/legal\\_e/28-dsu\\_e.htm](https://www.wto.org/english/docs_e/legal_e/28-dsu_e.htm), last visited September 19, 2016). See generally, Frederick M. Abbot, "Cross-Retaliation in TRIPs: Options for Developing Countries" International Centre for Trade and Sustainable Development Programme on Dispute Settlement and Legal Aspects of International Trade, Issue Paper No. 8, April 2009; FSU College of Law, Public Law Research Paper No. 374. (Available online at SSRN: <http://ssrn.com/abstract=1415802> or <http://dx.doi.org/10.2139/ssrn.1415802>).

<sup>207</sup> Okafor, "Newness, Imperialism and International Legal Order", *supra* note 127.



right trajectory that capitalizes on the protection of foreign based rights as bases for advancing robust regimes,<sup>208</sup> runs counter to this argument.

### **2.3.2. WIPO's Development Agenda, Sustainable Development Goals and Prospects for Growth in the Third World**

The World Intellectual Property Office's (WIPO) association with the UN Millennium Development Goals (MDG)<sup>209</sup> and the newly established Sustainable Development Goals (SDG)<sup>210</sup> critically brings under scrutiny its ability of aligning its development agenda with these objectives. As a branch of the United Nations<sup>211</sup>, it is not surprising that the Development Agenda should be an integral part of the realization of poverty reduction and developmental prospects in the Third World. This assertion remains questionable in practice.<sup>212</sup>

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<sup>208</sup> Keith Maskus, Intellectual Property Challenges for Developing Countries, An Economic Perspective (2001) *U Ill. L. Rev.* 247.

<sup>209</sup> United Nations Millennium Development Goals represent forecasted development objectives to eradicate poverty and thereby improve the social and economic conditions of individuals in 'developing' countries. (Available online at United Nations: <http://www.un.org/millenniumgoals/bkgd.shtml>, last visited September 20, 2016).

<sup>210</sup> United Nations Sustainable Development Goals, (Available online at United Nations <http://www.un.org/sustainabledevelopment/sustainable-development-goals/>, last visited September 20, 2016).

<sup>211</sup> The World Intellectual Property Office (WIPO) became a specialized agency of the United Nations in 1974. Agreement between the United Nations and the WIPO, Article 1. (Available online at WIPO, <http://www.wipo.int/treaties/en/agreement/index.html>, last visited September 20, 2016).

<sup>212</sup> Sisule Musungu, Assessing WIPO's Contribution to the Achievement of the Millennium Development Goals Committee on the Development of Intellectual Property Rights, CDIP 8/4 'Musungu, "WIPO, Development"; Ron Merchant & Sisule Musungu, Essential Elements of a WIPO Development Agenda. Chidi Oguamanam, Governance Structures and Regime Dynamics in Intellectual Property in Chidi Oguamanam, Intellectual Property in Global Governance A Development Question, (Taylor Francis: London, 2012) [*"Chidi, Intellectual Property"*].

The Development Agenda is augmented as normative principles governing the implementation and use of intellectual property right in the procurement of development results in the Third World. The Agenda was established amidst conflicts by developing countries over dissatisfaction with the effects of a hegemonic global IP regime.<sup>213</sup> According to WIPO's report, the Development Agenda<sup>214</sup> should be reflective of 'internationally agreed development goals and targets...including those of the MDG'.<sup>215</sup> The Sustainable Development Goals (SDGs) supersedes the Millennium Development Goals, and contain objectives which implicate WIPO's Development Agenda. The World Intellectual Property Office (WIPO) has yet to fully incorporate the SDGs into its Development Agenda. However, it has stated that support to member states in the development of their intellectual property system will continuously be provided.<sup>216</sup> Furthermore, targets which are related to intellectual property have been identified.<sup>217</sup>

I focus on technical and legal assistance provided under WIPO's Development Agenda to the Third World under the United Nations development goal objectives. In the

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<sup>213</sup> Christopher May, *The World Intellectual Property Organization: Resurgence and the Development Agenda* (London: Routledge, 2007); Jeremy de Beers, *Implementing the World Intellectual Property Development Agenda* (Ottawa: Wilfred Laurier University Press, 2009).

<sup>214</sup> *Ibid.*

<sup>215</sup> Committee on the Development of Intellectual Property Rights, 2010. CDIP/5/3

<sup>216</sup> World Intellectual Property Office, "WIPO And the Post 2015 Development Agenda", Committee on Development and Intellectual Property, 16<sup>th</sup> Session Geneva November 9-13, 2015 (Available online at [http://www.wipo.int/edocs/mdocs/mdocs/en/cdip\\_16/cdip\\_16\\_8.pdf](http://www.wipo.int/edocs/mdocs/mdocs/en/cdip_16/cdip_16_8.pdf), last visited September 20, 2016).

<sup>217</sup> *Ibid* at 8. Sustainable Development Goal, Target 8.2 and 8.3: "Promote sustained, inclusive and sustainable economic growth, full and productive employment and decent work for all". Target 8.2 refers to "technological upgrading" which relates to a number of WIPO support activities. Target 8.3 makes specific reference to creativity and innovation, which is explicit in WIPO's mission statement. *Ibid* at 7.

summary and recommendation chapter of the thesis,<sup>218</sup> I discuss prospects for the use of Sustainable Development Goals in sustaining geographical indication's linkage with agricultural and food-based products.

The World Intellectual Office's mandate of providing technical and legislative assistance in the implementation and administration of intellectual property rights laws is identified as integral to this target. According the World Intellectual Property's Development Agenda<sup>219</sup>, the objective of technical assistance is to promote a 'development oriented' model of intellectual property regime which conforms with the needs of peripheral countries.

An examination of WIPO's intellectual property initiatives in many Third World countries indicate that the agency's resources<sup>220</sup> are ardently mobilized in initiating technical and legislative<sup>221</sup> assistance projects as its platform for 'development'. I am not contending that the World Intellectual Property Office's initiatives are focused solely on technical assistance. However, I assert that other 'development' oriented initiatives are infused around principles of 'technical and legislative assistance' to establish an IP

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<sup>218</sup> These points are made in Chapter 9.

<sup>219</sup> WIPO Development Agenda, Technical Assistance and Capacity Building. Cluster A.

<sup>220</sup> *Ibid*; Committee on Development and Intellectual Property, CDIP/4/2 2009; World Intellectual Property Office, Committee on Development and Intellectual Property, CDIP/9/15 of October 09, 2015 16<sup>th</sup> Session at 6 (Available online at [http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=39002](http://www.wipo.int/meetings/en/details.jsp?meeting_id=39002)), last accessed September 20, 2016).

<sup>221</sup> Christopher May, *The World Intellectual Property Organization: Resurgence and the Development Agenda* (London: Routledge, 2007) [May, "WIPO, Resurgence and the Development Agenda"].

infrastructure in the Third World that is aligned with the mandate of dominant international actors. This is also facilitated through its norm setting activities.<sup>222</sup> Musungu, in critiquing the Development Agenda, asserts that internal leadership at WIPO is instrumental to the implementation of successful and feasible policy frameworks.<sup>223</sup>

Arguably, the impasse between development and intellectual property right is that the dominant actors who construct the regime's norm setting agenda<sup>224</sup> are non-aligned with the peripheral's intellectual property interests. As critically asserted by Oguanaman, the approach adopted in the implementation of the Development Agenda, "shape the future of progress or lack thereof"<sup>225</sup> of intellectual property initiatives. The latter is more apparent in the association of intellectual property right and development in the Third World.<sup>226</sup> Influential members of the World Intellectual Property Office construct and augment intellectual property norms which advance their own proprietary interests. The

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<sup>222</sup> WIPO Development Agenda, Cluster B. Norm setting Activities. Ruth Okediji, in questioning the ability of WIPO to create changes in the international IP order, asserts that the agency is institutionally incapable of transforming the dominant norms governing IP. Ruth Okediji, *WIPO-WTO Relations and the Future of Global Intellectual Property Norms* (2008) 39 *Neth YB Int'l* 69.

<sup>223</sup> Sisule F. Musungu, *The Role of WIPO's Leadership in the Implementation of the Development Agenda* in Jeremy de Beer, *Implementing the World Intellectual Property Development Agenda* (Ottawa: Wilfred Laurier University Press, 2009) [de Beer, "*Implementing the WIPO Development Agenda*"]; See also Carolyn Deere, *Reforming Governance to Advance the WIPO Development Agenda*, in de Beer, "*Implementing the WIPO Development Agenda*".

<sup>224</sup> Carolyn Deere, *The Implementation Game*, *supra* note 50.

<sup>225</sup> Chidi, "*Intellectual Property*", *supra* note 199.

<sup>226</sup> Peter Drahos and John Braithwaite, "Hegemony Based on Knowledge: The Role of Intellectual Property" (2004) 21 *Law in Context* 204 ["Drahos and Braithwaite "*Hegemony Based Knowledge*"].

proliferation of these legal norms often promotes inequitable forms of intellectual property regimes in the Third World which are substantially aligned with elitism.

I argue that the institutionalization of the World Intellectual Property Office's mandate amongst hegemonic states facilitate the internalization<sup>227</sup> of their norms as strategies for advancing its intellectual property interests in the Third World. As such, it is plausible that the provision of technical and legal assistance produces intellectual property policies in the Caribbean which are incongruent with the social, legal and institutional capacity of CARICOM countries.<sup>228</sup>

Jamaica's legislation and its geographical indication policy have underlying themes similar to the mandate of Switzerland's geographical indication policy. Furthermore, the comparatively minimal representation and participation of the Caribbean network in WIPO committees strongly indicates that the region has minute influence in the adoption of domestically conducive IP policies.<sup>229</sup> In effect, it re-produces the imbalances of the

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<sup>227</sup> *Supra* note 113; Slaughter, 'International Law and International Relations *supra* note 91; Alder, "Constructivism in World Politics", *supra* note 71.

<sup>228</sup> I address these arguments on legal and technical assistance more specifically in chapters 4 and 7 in reference to assistance provided by Switzerland to Jamaica, in the shaping of its geographical indications legislation.

<sup>229</sup> In this context, I am comparing the Caribbean's intellectual property involvement in international negotiations to Latin America and the Caribbean's African counterparts in the African Caribbean Pacific Union (ACP). The ACP is a 79-member organization that, by its union has entered 'new' trade relationship with the European Union (ACP-EC Partnership Agreement). A significant component of this relationship is the implementation of EU standard intellectual property rights provisions in African and Caribbean countries. African countries were reluctant to implement many of the intellectual property rights mandates requested by the European Union, but the Caribbean were not hesitant to sign off on the European Union's request for ratification. The Caribbean's Economic Partnership Agreement with European Union was the result of this process. Norman Girvan, "Technification, Sweetification,

IP order by aligning the commercializing of intellectual property with elite groups in the region. There is a hopeful exception to this trajectory. Jamaica's forceful submissions to WIPO's Standing Committee on the protection of its country name as an IP asset with developmental implications has garnered recognition from other participants.<sup>230</sup> Participation in WIPO's Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore Cultural Expressions is also noted.<sup>231</sup>

Two instrumental barriers to progress identified by group members are concerns regarding the transparency of norm setting provisions, and the astronomical costs incurred in implementing intellectual property enforcement measures.<sup>232</sup> I argue that the composition and interests of this epistemic community<sup>233</sup> influence the agendas undertaken, and the trajectory of legal norms associated with the intellectual property development discourse. An international intellectual property system which stifles access

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Treatyfication – Politics of the Caribbean EU-Economic Partnership Agreement”, (2010) 12:1 *Interventions: Intl J of Third World S* 100.

<sup>230</sup> Standing Committee on the Law of Trademarks, Industrial Design and Geographical Indications, June 2009. SCT/21/6; Standing Committee on the Law of Trademarks, Industrial Design and Geographical Indications SCT/26/9. I further discuss this issue in chapter 4.

<sup>231</sup> World Intellectual Property Office, IGC 27 Update: Negotiators advance on texts for the protection of traditional knowledge and traditional cultural expressions, Traditional Knowledge, Genetic Resources and Folklore/Traditional Cultural Expressions, April 11, 2014 (Available online at WIPO, [http://www.wipo.int/newsletters-archive/en/docs/tk\\_update\\_2014\\_19.html](http://www.wipo.int/newsletters-archive/en/docs/tk_update_2014_19.html), last visited September 27, 2016).

<sup>232</sup> Standing Committee on the Law of Trademarks, Industrial Design and Geographical Indications, Established in 1998.

<sup>233</sup> Haas “*Epistemic Communities*”, *supra* note 105.

to knowledge and creativity,<sup>234</sup> uses robust infringement measures as a justification for the enforcement of rights, and promotes domestic intellectual property rules that are incongruent with the practical realities of the Third World, invalidate arguments on its usage with local development policies.

Yu, in evaluating the prospects for strategic intellectual property alliances on development has remarked that they present a “rare and unprecedented opportunity to reshape the international intellectual property system...”.<sup>235</sup> Notably however, the formation and solidification of hegemonic interests amongst influential state actors and international organizations have facilitated the emergence of strategic alliances<sup>236</sup> within these networks. The European Union, Switzerland and the United States are strongly implicated in the political dynamics of these networks, as well as the relative influence of emerging influential actors such as Brazil, Japan and India.<sup>237</sup>

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<sup>234</sup> James Boyle, *The Second Enclosure Movement and the Construction of the Public Domain*, (Available online at <http://law.duke.edu/pd/papers/boyle.pdf>); Jerome Reichman and Keith Maskus, *The Globalization of Private Knowledge and the Privatization of Global Public Goods*, (2004) 7 *J Intl Econ L* 279.

<sup>235</sup> Peter Yu, *Building Intellectual Property Rights Coalition for Development*. September 2008, Working Paper No. 37 at 10, [Yu, “*Building IP Coalitions*”].

<sup>236</sup> Deere, *The Implementation Game*, *supra* note 223. May “WIPO, Development Agenda”, *supra* note 221; Yu, *Ibid*.

<sup>237</sup> World Intellectual Property Office, *Committee on Development and Intellectual Property Tenth Session*, November 2012, Document No. CDIP 10/12; World Intellectual Property Office, *Standing Committee on the Law of Trademarks, Industrial Design and Geographical Indications*, 28<sup>th</sup> session, December 2012, Document no. SCT/28/8.

Without a paradigmatic shift in the politics of the global intellectual property regime, and the willingness of domestic jurisdictions to ‘own’ intellectual property, it is unlikely that there will be observable changes beyond focuses on IP enforcement measures. The World Intellectual Property Office has recently embarked on an independent review of its Development Agenda. I expect that one of the main changes will be its degree of compatibility with the Sustainable Development Goals and its targets.

### **2.3.3. Other Coalition Platforms Implicating Development**

Although the politics<sup>238</sup> of a hegemonic intellectual property right system does not affect its ability to frame development objectives, it questions its capacity to effectively produce actual results. Yu asserts that the growth of intellectual property coalitions are ideal strategies for advancing appropriate development oriented IP structures<sup>239</sup> in ‘developing’ countries. The scholar posits that if alliances are “strategically used” they are likely to facilitate a “pro-development agenda”, and may enable countries to “establish a united negotiating front”.<sup>240</sup> Because the dominant legal intellectual property norms are constructed by influential countries<sup>241</sup>, international organizations and non-governmental bodies<sup>242</sup>, it influences the regimes’ ability to integrate development

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<sup>238</sup> Barnett and Finnemore: “*Politics and Power, International Organizations*”, *supra* note 190.

<sup>239</sup> Yu, “*Building IP Coalitions*”, *supra* note 235.

<sup>240</sup> *Ibid*, at 11.

<sup>241</sup> Margaret Chon, “Intellectual Property Divide”, in Daniel Gervais, *Intellectual Property, Trade and Development: Strategies to Optimize Economic Development in a TRIPS Plus Era* (Oxford: Oxford University Press, 2009).

<sup>242</sup> Drahos and Braithwaite, *Hegemony Based Knowledge*, *supra* note 226.



through IP, as constructed from a marginalized Third World perspective. Therefore, I argue that the Third World's participation in international networks which advance a "pro-development agenda"<sup>243</sup> is non-beneficial unless the following is attained. Firstly, promoting domestic intellectual property as assets in Third World regions counteract the imperialistic narrative constructed by the west. A small Third World space that has identified a bundle of intellectual property right as domestic assets is more likely to advocate for and actively participate in international IP forums with dominant actors.<sup>244</sup>

Secondly, without power, strategic alliances with actors<sup>245</sup> having shared perceptions and influential authority, handicap advances in Third World representations at the international level. Oguamanam correctly asserts that the growth of IP coalitions amongst emerging powers<sup>246</sup> has facilitated greater representation and recognition of their interests at the international level. As posited by Oguamanam, the formation of these strategic alliances have allowed states to "cultivate and consolidate their regional clout for advancing"<sup>247</sup> intellectual property and development initiatives.<sup>248</sup>

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<sup>243</sup> Yu, *supra* note 235. See also Daniel Gervais, "TRIPS and Development" in Daniel Gervais (ed) *Intellectual Property, Trade and Development: Strategies to Optimize Economic Development in a TRIPS Plus Era* (Oxford: Oxford University Press, 2009).

<sup>244</sup> I discuss this argument in the context of geographical indications in depth in chapter 7.

<sup>245</sup> Thomas Frank, Legitimacy in the International Legal System (1998) 82 *Am J Int'l L* 705.

<sup>246</sup> Oguamanam, "Managing Intellectual Property in Global Governance, in "Intellectual Property, Global Governance", *supra* note 89.

<sup>247</sup> *Ibid*, at 222.

Arguably, the effectiveness of regional and international coalition groupings is dependent upon its power to legitimate<sup>249</sup> its preferred intellectual property agenda, as an aspect of advancing a paradigmatic shift in intellectual property objectives. As an example, Brazil, India and South Africa strategize their intellectual property and development objectives through the formation of a trade alliance network (India-Brazil-South Africa) which includes intellectual property right as broader aspect of trade related goals.<sup>250</sup> This epistemic community has enabled these actors to more effectively articulate their collective interests through WIPO, WTO forums and affiliations with influential non-governmental organizations. Brazil, India and South Africa emerged as influential actors in the Development Agenda Group<sup>251</sup>, and have proactively participated in WIPO's development oriented forums.<sup>252</sup>

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<sup>248</sup> A strategic alliance between Caribbean countries is an integral enabling factor that I have identified as essential to the development and sustenance of agricultural and food based geographical indications scheme in the Caribbean.

<sup>249</sup> Harold Koh, "Why Do Nations Obey International Law", (1997) 48 *Y LJ* 2599.

<sup>250</sup> India-Brazil-South Africa, formed in 2003 (See [http://www.ibsa-trilateral.org/index.php?option=com\\_contact&Itemid=20](http://www.ibsa-trilateral.org/index.php?option=com_contact&Itemid=20)).

<sup>251</sup> Seventeen countries were instrumental in the formation of the Development Agenda. The countries included in this group were Cuba, Brazil, India, South Africa, Egypt, Uruguay, Sri-Lanka, Pakistan, Philippines, Guatemala, Indonesia and Iran.

<sup>252</sup> Committee on Development and Intellectual Property Right, CDIP 10/2, Tenth session Nov 2012; Committee on Development and Intellectual Property Right, CDIP Ninth session, May 2011.

Less powerful peripheral countries however, are unable to garner strategic alliances<sup>253</sup> despite making concessions<sup>254</sup> on intellectual property to hegemonic actors. The growth of forum-shifting<sup>255</sup> through regional and bi-lateral free trade (RBFTs) agreements between the core and the periphery has further misaligned intellectual property right with development, and facilitated the “development divide”.<sup>256</sup>

Robust compliance with foreign based intellectual property rights demanded by regional, bilateral and pluri-lateral agreements<sup>257</sup>, substantially compromises the ability of intellectual property right to positively correlate with development objectives in the Third World. This is especially apparent in intellectual property regimes in which there are minimal usages of the domestic IP infrastructure to foster ‘local’ growth of intellectual property. Therefore, it is practically difficult to integrate intellectual property rights with development, and conceptually retarded as a policy mechanism to envisage IP

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<sup>253</sup> Peter Drahos, “When the Weak Bargain With The Strong: Negotiations in World Trade Organization” (2003) 8 *Int’l Negotiation* 79.

<sup>254</sup> Deere, *The Implementation Game*, *supra* 223; Drahos and Braithwaite “Hegemony Based Knowledge” *supra* note 226. Many peripheral countries agreed to TRIPS based on prospects of trade concessions with core countries, particularly the United States.

<sup>255</sup> Ruth Okediji, “Back to Bilateralism? Pendulum Swings in International Intellectual Property Protection” (2003) 1 *U Ottawa L Tech J* 125, Peter Yu, *The Global Intellectual Property Right and Its Undetermined Future*, *supra* note 3.

<sup>256</sup> Margaret Chon, *Intellectual Property and Development Divide*, (2007) 27 *Cardozo L Rev* 2821; Robert Ostergard, *Economic Growth and Intellectual Property Rights Protection: A Reassessment of the Conventional Wisdom*, in Daniel Gervais, “*Intellectual Property Trade and Development*” *supra* note 33; Carlos Correa “Bilateralism in Intellectual Property: Defeating the WTO System for Access to Medicines” 2004 *Case W. Res. J. Int’l L* 79.

<sup>257</sup> Keith Maskus, “Intellectual Property Challenges for Developing Countries: An Economic Perspective” (2001) *U Ill L Rev* 471.

as assets in the Third World, without fostering forms of intellectual property that are relevant to Third World peoples.

Agricultural and food-based geographical indications are positioned in this thesis as a form of intellectual property that is relevant to the Caribbean as it embodies (or potentially embodies) qualities such as ‘domestic and collective ownership’, the development of innovative income opportunities through strategic resource use, and a nation branding approach that goes beyond the state itself, to a focus on people and cultural development through intellectual property strategizing.

Below, I address the politics of policy in development approaches in Jamaica. This is salient in conceptualizing and forming sustainable agricultural and food based geographical indication initiatives, representational of Jamaican peoples’ aspirations and potentials.

#### **2.4. Policy as a Development Approach in Jamaica**

The paradox of development in the Third World is strongly exemplified in Jamaica’s development paradigm. The Third World is not a homogenous space, but is diverse in its historical, social, cultural and legal structures.<sup>258</sup> As such, although dominant norms are formed through processes of interaction<sup>259</sup>, differences in social structures facilitate a

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<sup>258</sup> Rex Nettleford, *Cultural Action and Social Change: An Essay in Caribbean Cultural Identity* (Kingston: Institute of Jamaica, 1979). Carl Stone, *Democracy and Clientelism in Jamaica* (New Brunswick: Transaction Books, 1980), [Stone, “*Clientelism*”].

<sup>259</sup> Alder, “Constructivism in World Politics”, *supra* note 71; Searle, “Construction of Social Reality”; *supra* note 11; Finnermore and Sikkink, *Norm Dynamics*, *supra* note 76.

development narrative which, though subject to ‘othering’<sup>260</sup> is particular to each Third World community.<sup>261</sup>

Theorizing about intellectual property rights laws and development in the Third World calls for an interrogation of the imperialistic practices that structure development policies. These arguments cannot be fully encapsulated without dissecting the role of hegemonic identities in inscribing themes of non-representation in Jamaica’s development narrative.

I make the argument that unless geographical indications are practically envisaged as an aspect of development policy in Jamaica, non-elite representation will be minimal. Importantly as well, without implicating the use of the term ‘development’ in the notion of geographical indications as unconventional but resourceful tools of intellectual property, formulating policies built on themes of participation and collective ownership rights over private rights<sup>262</sup> is untenable.

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<sup>260</sup> Edward Said, *Orientalism Reconsidered*, (New York: Telos Press, 1985); Gayatri Spivak, *Can the Subaltern Speak*, in Cary Nelson and Larry Goldberg *Marxism and the Interpretation of Culture* (Chicago: University of Illinois Press, 1998). On othering, Crichlow posits that “Caribbean peoples seek freedoms but encounter places steeped in racisms, prejudices, and other forms of othering”. Crichlow, *Entanglements* at 124.

<sup>261</sup> Crichlow, “Negotiating Caribbean Freedom” *supra* note 94; Annette Baker, *Freedom and Welfare in the Caribbean: A Colonial Dilemma* (New York: Harcourt Brace & Co, 1949); Northover and Crichlow, “Size, Survival and Beyond” in Brian Meeks & Norman Girvan, *The Thought of the New World – The Quest for Decolonization* (Kingston: Ian Randle Publishers, 2010) at 136, [Northover & Crichlow, “Size, Survival and Beyond”]; Ransford Palmer, *The Caribbean Economy in the Age of Globalization* (New York: Palgrave Macmillan 2009). Michaeline Crichlow, *Making Waves: Disengagements, Entanglements, Movements* (2012) 6 *Global South* 1, [Crichlow, “Disengagements”].

<sup>262</sup> However, note that although geographical indications confer rights that are groups based, they are still private rights as they exclude others from ownership.

In this exposition, two points are noteworthy. Firstly, the west's focus on trade liberalization has facilitated the introduction of a hegemonic discourse which is incongruent with Third World development. Secondly, local elites and dominant political groups are influential in determining the inclusiveness and impact of policies associated with development. Pragmatically therefore, policy formulations on social and economic ascent are substantially class based and directed by political and elite preferences.<sup>263</sup>

Jamaica's affiliation with international conventions<sup>264</sup> and organizations facilitated the emergence of domestic policies, some of which have stifled social progress. Western patterns of development theorizing often influence the approach taken by the Jamaican state in the choice of policies adopted, because what is construed as 'beneficial' by its core international partners, is blindly accepted as such by the state.<sup>265</sup>

Harold Koh articulates that countries adhere to international rules because the associated norms have become internalized as acceptable rules in society. Koh posits that:

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<sup>263</sup> See Frantz Fanon, *Black Skins White Masks*: Fanon pinpointed the tendency of local bourgeoisie in former colonized states to adapt the dominant norms of colonizers. This behavior perpetuates social class biases and is evident in Jamaica's civil society. Frantz Fanon, *Black Skins White Masks*, (New York: Grove Atlantic Inc., 2008).

<sup>264</sup> General Agreement on Tariffs and Trade (GATT), Jamaica was involved in NAFTA negotiations but was never a party to the agreement. World Trade Organization and affiliated trade negotiations (Doha Round of negotiations in which it plays a passive role. Although not the focus of this thesis, International Monetary Fund structural adjustment programs have had a debilitating effect on the country's economy and on its ability to invest in social welfare programs. The country's debt services ratio 140% of its Gross Domestic Product in 2014 (Bryan Miller, "Jamaica's Debt to GDP will be reduced", *Jamaica Information Service*, March 02, 2014 available online at <http://jis.gov.jm/jamaicas-debt-gdp-ratio-will-reduced/>, last visited November 30, 2015).

<sup>265</sup> Trevor Munroe, *The Politics of Constitutional De-colonization*, (Mona: Institute of Social and Economic Studies, 1972); James Milete "Doctrines of Imperial Responsibility' (1966) *New World Quarterly* 2. Don Marshalls, *National Development and the Globalization Discourse: Confronting Imperatives and Convergence Notions* (1996) 17 *Third World Quar* 5.

“as governmental... actors repeatedly interact within the transnational legal process, they generate and interpret legal norms and seek to apply these norms domestically...to the extent that these norms are internalized they become...determinants of why nations obey.”<sup>266</sup>

Koh’s articulations are grounded in constructivism’s tenet of shared knowledge and norm diffusion through interactions between states and state actors. Compliance to hegemonic rules and norms are achieved through a “transnational legal process”, in which an influential entity or actor initiates engagement on issues, and implores other states and interest groups to internalize the perception of the norm within their state.<sup>267</sup> In transnational legal process, states comply with international rules based on interpretation, interaction and internalization. The constitutive process of rule interpretation within states, and validation through interaction and participation, eventually leads to an internalization of the norm by re-constituting the identities and interest of the parties involved.<sup>268</sup> The norm is further reified by aggressive norm entrepreneurs in the global mainstream, notwithstanding domestic incompatibility with its provisions.

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<sup>266</sup> Harold Koh, *Why Nations Obey Law* (1997) 106 *Yale L. J.* 2599 at 23. [Koh, “*Why Nations Obey*”]. See also Thomas Frank, *Legitimacy in the International Legal System* (1998) 82 *Am. J. Int’l L.* 705. Frank’s influential work discusses the basis for rule adherence amongst countries that work closely with international organizations. [Frank, “*International Legal System*”]. Unlike Koh, Frank argues that nations comply with international law based on a calculated analysis of the fairness of the process involved in the accepted principles. Compliance then, is not facilitated or causally connected with interpretation and interactions (constructivism arguments), but through “communitarian peer pressure” experienced by state members. Compliance is impossible if the rules are not communicated to actors but, as Frank posits it is authority which validates the rule. This symbolic validation elicits compliance from actors, based on the inscribed meanings and influence associated with the institutional body or state projecting such laws.

<sup>267</sup> *Ibid.*

<sup>268</sup> I make the point that this occurs if the legal norm is accepted as legitimate by influential domestic stakeholders.

Jamaica's colonial encounter<sup>269</sup> and the reinforcement of power imbalance through global imperialism in its contemporary society, have led to the systemic marginalization of its identity in many spheres of international relations and international intellectual property rights law.<sup>270</sup>

My argument implicates the Jamaican state. I maintain that notwithstanding its domestic relevance, policies with developmental implications are complied with based on power inequalities between Jamaica and its hegemonic counterparts. Many of these inequalities are legitimated and reinforced through international law<sup>271</sup>, specifically through international conventions and treaties which the country has ratified.<sup>272</sup>

By way of example, I argue that the contestation over the safeguard of foreign intellectual property right in Jamaica manifested in the United States embedding themes

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<sup>269</sup> Abigail Bakan, *Ideology and Class Conflict in Jamaica: The Politics of Rebellion*, (Ottawa: McGill University Press, 1990). Bakan interrogates the effects of Jamaica's ninetieth century labor rebellions on shaping contemporary resistance by laborers to local class and political conflicts. The effects of colonialism on trends in politics and culture by Jamaica's people is also explored in Hilary Beckles and Verene Shepherd eds. *Caribbean Freedom, Society and Economy from Emancipation to the Present* (Kingston: Ian Randle Publishers, 1993).

<sup>270</sup> I argue that the politics of international intellectual property rights is one such aspect of marginalization of the Jamaican state. I have detailed this point in chapter 1. See also Jacqueline Anne Braveboy-Wagner in "The Conduct and Management of CARICOM's Foreign Policy" in Jacqueline Anne Braveboy-Wagner *Small States in Global Affairs: The Foreign Policies of the Caribbean Community*" (New York: Palgrave Macmillan, 2008) at 204-229. Braveboy-Wagner assesses the Caribbean's position in relation to its international counterparts and argues that political, economic cultural issues account for the minimal and varied successes in Caribbean foreign policy.

<sup>271</sup> Alder, *supra* note 71, "Constructivism in World Politics"; Brunnee and Toope: International law and Constructivism *supra* note 114. Thomas M. Franck, International Law: Through National or International Courts? (1962) 8 *Vill L Rev* 139.

<sup>272</sup> Boyle, "Making of International Law", *supra* note 161.



of development into intellectual property protection arguments. Prior to TRIPS, the country's membership to GATT enabled the United States to more easily insist on intellectual property rights amendment to legislation, and membership to other international treaties protecting intellectual property rights. This was augmented on the basis that "effective implementation of measures...are critical to strengthening markets" and to "increase participation in economic growth".<sup>273</sup> I argue that the relationship between domestic economic growth and intellectual property rights is elusive, because the conceptualizations of the associated norms are based on the hegemon's own principles.

Similarly, I argue that Jamaica's geographical indication legislation was enacted because 'rights based' themes were subsumed into trade negotiation arguments of the European Union and Switzerland.<sup>274</sup> Despite an astronomical external debt<sup>275</sup> and the prevalence of social deprivation conditions in urban and rural communities,<sup>276</sup> the Jamaican state has expended significant capital towards compliance with international rules.

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<sup>273</sup> Intellectual Property Rights In Jamaica: An Action Plan Final Report, United States Agency for International Development (*September 1995*).

<sup>274</sup> I discuss this point issue in chapter four.

<sup>275</sup> Most of Jamaica's gross domestic product revenue is used to re-pay external loans. Jamaica's debt servicing ratio is amongst the worst in the Third World: Statistical Institute of Jamaica (Statin: [www.statin.ja.gov.ja](http://www.statin.ja.gov.ja)). The country's debt to gross domestic product ratio was 139% in 2014. Ministry of Finance and Public Service (budget reports).

<sup>276</sup> Thomas Klak, *Globalization and Neoliberalism: The Caribbean Context* (Maryland: Rowman and Littlefield, 1998).

By way of example, the state's intellectual property rights infringement regulations are robustly implemented, notwithstanding social and economic constraints of the Jamaican state. Because the safeguard of foreign owned intellectual property right has become internalized by the Jamaican state as a legal norm, the country has accepted as 'legitimate' the core's promise of 'growth through intellectual property' without protestations.

An important theme emerging from Jamaica's development narrative is the inability of the state<sup>277</sup> to effect non-hegemonic changes to its relationship with core countries. Power imbalance persists, thereby affecting its capacity to effect meaningful social changes local communities.<sup>278</sup> Escobar's scholarly contribution to the politicization of Third World development is captured in his definition of the "axes" of development:

"The forms of knowledge that refer to it and through which it is comes into being and its elaborated objects, concepts, theories and the like; the system of power that regulates its practice; and the forms of subjectivity fostered by

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<sup>277</sup> Joel Migdal, *Strong Societies and Weak Societies, State Society Relations and State Capabilities in the Third World*, (New Jersey: Princeton, 1988). Migdal "Strong States". See also, Joel Migdal (eds), *State Power and Social Forces: Domination and Transformation in the Third World* (Cambridge: Cambridge University Press, 1994). Joel Migdal argues that the ability of Third World countries to engineer development is dependent upon its own power structure. Migdal contends that peripheral states with strong social controls are more likely to attain stated developmental objectives.

<sup>278</sup> Northover and Crichlow, "Size, Survival and Beyond" supra note 75; Crichlow, *Negotiating Freedom* supra note 97; Brian Meeks, "Jamaica on the Cusp of Fifty: Whither Nationalism and Sovereignty?" in Brian Meeks "Critical Interventions in Caribbean Politics and Theory" (Mississippi: University of Mississippi Press, 2014) at 183. Meeks critiques the relevance of sovereignty to Jamaica the state, both in a regional and international context. There is relative sovereignty in the country's position on matters such as opposition to the United States invasion of Iraq and to the ousting of Haiti's President Aristide. However, in other areas such as international trade and intellectual property, it is conceded that sovereignty is compromised. [Brian Meeks, "*Critical Interventions*"].

this discourse through which people come to recognize themselves as developed or undeveloped”.<sup>279</sup>

Central to this argument is the role of power relations within and outside of the state in either perpetuating spatial unevenness in development<sup>280</sup> or facilitating spaces of change. Western based development strategies are infused with principles of non-representation<sup>281</sup> and biases towards elite groups in the local. I argue that modern governmentality<sup>282</sup> has facilitated the prevalence of biased power relations in the Jamaica society.

In their critique of the debilitating effects of state-citizen relationship in the Caribbean, scholars Northover and Crichlow posit that patterns of modern governmentality are illustrated in states with social “power relations that are not just inter-subjective or institutional but ...also articulate emergent structural properties which guide the possibility of conduct”.<sup>283</sup> My reference to modern governmentality is informed by the Foucauldian conceptualization of power concentration in the state. The authority of the state is maneuvered to orchestrate conduct and outcomes which reflect the state’s agenda, despite its non-alignment with society’s interests. The ontology of power in the

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<sup>279</sup> Arturo Escobar, *Encountering Development: The Making and Unmaking of the Third World* (New Jersey: Princeton University Press, 1995) at 10.

<sup>280</sup> Patrick Northover, “A critique on Sen’s Development as Freedom”, (2012) 6:1 *The Global S I*.

<sup>281</sup> Crichlow, “*Negotiating Caribbean Freedom*”, *supra* note 97.

<sup>282</sup> *Supra* note 149. Michael Foucault, “The Subject of Power” (1982) 8 *Critical Inquiry* 777 at 778. Foucault articulates that power is a “total structure of actions brought to bear upon possible actions”. Power influences actors conduct because it “incites...it makes easier or more difficult; in the extreme it constrains or forbids absolutely”.

<sup>283</sup> Northover and Crichlow, “*Size, Survival and Beyond*”, *supra* note 264.

Jamaican state produces differences in the structure of relations<sup>284</sup> between the state and civil society.

Fundamental to this point is the effect of party patronage<sup>285</sup> in the distribution of resources in Jamaica. It has been argued in some spheres that party patronage is no longer a prevalent phenomenon in Jamaica as community involvement in the everyday operation of politics has increased.<sup>286</sup> I argue that as long as political and social affiliations dictate (regardless of the magnitude of its occurrence) an aspect of resource allocation and policy choices, it remains a live issue.<sup>287</sup> Historically, the Jamaican state was not only instructive in the administration and regulation of domestic policies, but used political strategies to control the appropriation of resources to the local.<sup>288</sup>

Approaches to development have yet to fully incorporate “ordinary people, so that in their lives the encounter with development creates a contradictory blend of support,

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<sup>284</sup> Munroe, *The Politics of Constitutional Decolonization*, *supra* note 155; Northover and Crichlow “Size, Survival and Beyond” *Ibid*.

<sup>285</sup> Carl Stone, *Clientelism*, *supra* note 149 at 93. Stone notes that party patronage “class and ideological considerations in party allegiance are essentially rationalizations of perceived capability to deliver material and social inducements in exchange for support”.

<sup>286</sup> Brian Meeks, “Reinventing the Jamaican Political System” in Brian Meeks, *Critical Interventions in Caribbean Politics and Theory*, *supra* note 198.

<sup>287</sup> Rupert Lewis, “Party Politics in Jamaica and the Extradition of Christopher “Dudus” Coke”, (2012) 6:1 *The Global S* 38.

<sup>288</sup> *Supra* note 204.

resistance and transformation”.<sup>289</sup> The unfortunate plight of ordinary Jamaican peoples in agricultural development policies is well documented by Crichlow’s research on the effects of the institutionalization of neoliberal rules into the domestic sphere.

The trend towards the privatization of many agricultural sectors was initiated through Jamaica’s compliance with policy directives from various western based agencies, including the International Monetary Fund, the World Bank, and the United States Agency for International Development. Crichlow documents that small scale farmers and less politically favored individuals were de-prioritized groups in Jamaica’s quest to comply with the west’s structural adjustment<sup>290</sup> programs:

Such policies called for the repositioning of the place of the Jamaican working peoples in a reforming polity. Those of them involved in agriculture were no longer upheld as the sector’s saviors, but as hindrances. A new level of intolerance began to pervade the Jamaican polity, one that delinked poverty from the sphere of collective concern back onto the body and personal agenda of the individual. Concerns about production, privatization and investment led to a new style of governance.<sup>291</sup>

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<sup>289</sup> Michaeline A. Crichlow, “Development Agrarian Culture” in Michaeline A. Crichlow, *Negotiating Caribbean Freedom*, *supra* note 93 at 5.

<sup>290</sup> Structural adjustment programs are economically driven loan policies that mandate specific rules of compliance prior to the granting of loans to countries. The World Bank and the International Monetary Fund are the two global institutions that provide the loans and formulate the policies attached to these loans. The fundamental concern with structural adjustment programs is that they perpetuate poverty in the Third World. See, Juliet Elu, “The Journey So Far: The Effect of Structural Adjustment Programme, Sustainable Growth, and Development in the Caribbean Region” (2000) 14:3 *W J B Stud* 202.

<sup>291</sup> *Ibid* at 146.

The tragedies<sup>292</sup> of Jamaica's experience that impact the practicalities of development are aptly explained by the following three realities. Firstly, gaps between the aspirations of ordinary Jamaicans and the means of attaining such goals plague its emancipatory reality.

Secondly, foreign and local elite-based pressures to implement ill-designed policy directives that are not accommodative of the interest of Jamaica's majority but, are framed as implicating development, remain a problem in the country's narrative.

I thirdly note the existence and prevalence of bureaucratic government departments that resist changing to the detriment of the same development goals which they profess to uphold. Therefore, my argument establishes that development is also contingently based on transformations in internal power structures that govern state-citizen relationships.

The transformative capacity<sup>293</sup> of aspects of intellectual property rights is instrumental<sup>294</sup> in also influencing changes to the paradigm of power relations between state and citizens

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<sup>292</sup> David Scott intricately weaves the saddened story of the Caribbean's post-independence experience as one which is unable to attain its futures of social and economic mobility, because of its vulnerability to local tragedies. In this "problem-space", socio-economic mobility goals are half-experienced but never fully attained because of interactions from "within and without". David Scott, "The Tragic Vision in Postcolonial Time" (2014) 129:4 *PMLA* 799.

<sup>293</sup> Jacques Derrida, *The Force of Law, The Mystical Foundation of Authority* at 949-989 (available online at [http://users.polisci.wisc.edu/avramenko/methods/derrida\\_theforceoflaw.pdf](http://users.polisci.wisc.edu/avramenko/methods/derrida_theforceoflaw.pdf)). The state uses law to justify a chosen set of norms in society. The force of change cannot be derived from legal institutions but from a re-interpretation of the norms through societal confrontations. Derrida argues that the possibility of re-configuring law is dependent on the constitutive of 'laws interest', which I refer to as the "epistemic communities of legal change". The possibility of re-orienting intellectual property rights to Third World interests therefore requires the inclusion of its peoples in the formulation, formatting and administration of intellectual property rights in its communities.

in Jamaica. It is against this background that I envisage agricultural and food based geographical indications as a transformative force of law and policy that may assist in changing power relations between state and citizens, and change the impact of policy directives that implicate local development.<sup>295</sup>

## **2.5. Chapter Summary**

The emancipatory capacity of intellectual property right as tools of development for peripheral countries remains substantially elusive. The practice of safeguarding ‘private rights’ has perpetuated intellectual property norms which focus on its robust protection, and has facilitated an imperialist narrative in the international law and relations of intellectual property. As such, development modules which incorporate intellectual property frameworks have difficulty in attaining pragmatic results when there is systemic focus on safeguarding foreign and elite based rights. Changing the epistemic framework of intellectual property as an asset of development in Third World regions warrants the infusion of principles of Third World peoples’ representation into the norm-setting agenda that governs the use of intellectual property. This challenge is apparent in Jamaica’s narrative. It informs a legislative and regulatory trajectory which, in reinforcing the imperial norms of the west is unable to effectively engage in developing an intellectual property infrastructure which is beneficial to the ‘local’.

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<sup>294</sup> See Fuller, who argues that law’s success is dependent upon the “energies...insight and conscientiousness of those who conduct it and “fated because of this dependence”. Lon Fuller, *American Legal Philosophy at Mid Century*, (1954) 6 J of Leg Ed 457.

<sup>295</sup> The caveat to this point is that geographical indications are only counter-hegemonic when specific local and international ‘enabling factors’ are operable. I discuss this point in chapters 7 and 8 of the thesis.

The next chapter addresses three issues, the origins of geographical indications are discussed to provide a historical background to its status in international jurisdictions. I then focus on the political dynamics which led to the enactment of Jamaica and the Caribbean's geographical indication legislation. My reference to political relates to the power imbalances in trade negotiations that resulted in EU-Cariforum-Economic Partnership Agreement, and the provision of technical and legal assistance by Switzerland's IP office in the development and trajectory of Jamaica's geographical indication model.

My politico-legal engagement with geographical indications then focuses on its linkage with agricultural innovation and growth by a critical assessment of agricultural and food based geographical indications case studies in specific Third World communities. Chapter 3's purpose is to analyze the international legal framework of geographical indications, and to provide the rationale for proactive Caribbean engagements with resources that are registrable as geographical indications.



## **Chapter Three: Geographical Indications and the Politics of International Relations- Origins, Evolving status and Implications for the Third World**

### **3. Introduction**

Chapter 2 was a critical review of TWAIL and constructivist literature on intellectual property rights law and the influence of power, actor identities and interest in shaping and diffusing dominant international law norms. In addressing these issues in chapters 3, my objective was to underscore the contentions in approaches to workable forms of intellectual property rights in the Third World, illustrating that domestic ownership and usage of intellectual property is relevant in creating IP counter hegemony in the Third World.

Chapter 3 lengthily discusses geographical indications, its history, its definitional parameters, and contestations in the Doha Round between dominant countries over an extension in its protection. The chapter is also an analysis of geographical indication policies in the European Union and Switzerland, two countries which have influenced the framing of geographical indications legislation in Jamaica and the Caribbean.

In order to illustrate the prospects of geographical indications as intellectual property assets, I also examine the relationship between geographical indications and agricultural projects and development policy. The chapter is divided into ten parts which deal with these issues sequentially. The first part of the chapter begins with an historical discussion of the origins of geographical indications.

### 3.1. Historical origins of Geographical Indications

The European Union<sup>296</sup> is influential in the formulation and development of laws governing geographical indications.<sup>297</sup> As the dominant actor in the proliferation of geographical indication norms, the European Union was the initiator and main proponent lobbying for the inclusion of geographical indication protection in *TRIPS*.<sup>298</sup>

Historically, Europe envisioned intellectual property rights as a module for social ascent,<sup>299</sup> capable of fostering economic progress through the creation of rights in intangible assets, and its protection through legal regimes. I situate the European Union as one of the ‘core’ hegemonic groups that maneuver the rights associated with intellectual property law towards its own imperialist interest.<sup>300</sup> This norm is most evident in the proliferation of regional and bilateral trade agreements with selected Third

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<sup>296</sup> Felix Addor & A. Grazioli, Geographical Indications Beyond Wines and Spirits: A Roadmap Towards better protection for Geographical Indications in WTO/TRIPS (2002) 5:6 *J W I P O* 867; Michael Blakeney, The Protection of Geographical Indications After Doha: Quo Vadis? (2006) 9:3 *J of Intl Econ L* 575.

<sup>297</sup> Dwijen Rangnekar, Geographical Indications – A Review of Proposals at the TRIPS Council: Extending Article 23 to Products other than Wines and Spirits, Issue Paper No. 4; J Audier, Protection of Geographical Indications in France and Protection in Other Countries, (WIPO, GEO/EGR/9798, Available online at [http://www.wipo.int/mdocsarchives/WIPO\\_GEO\\_EGR\\_97/WIPO\\_GEO\\_EGR\\_97\\_8REV.pdf](http://www.wipo.int/mdocsarchives/WIPO_GEO_EGR_97/WIPO_GEO_EGR_97_8REV.pdf), last visited September 27, 2016).

<sup>298</sup> World Intellectual Property Office, Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, SCT/2/7 (May 10 1999), WIPO/TM/TBS/96/5: Protection of Geographical Indications in France and the European Union, (Available on line, WIPO [http://www.wipo.int/meetings/fr/details.jsp?meeting\\_id=2968](http://www.wipo.int/meetings/fr/details.jsp?meeting_id=2968), last visited September 27, 2016).

<sup>299</sup> Debora Halbert, “The World Intellectual Organization: Past, Present and Future” (2007) 54:2 *J Copyright Soc* 253.

<sup>300</sup> See Andreas Rahmatian, “Neo-Colonial Aspects of Global Intellectual Property Protection” (2010) 10 *J W Intl P* 40.

World countries, in which the recognition of European Union based geographical indication rights are condition precedents to its ratification. The importance of norm diffusion amongst local and international epistemic communities<sup>301</sup> in the development of geographical indication laws is markedly evident in its historical origin. The concept of a geographical indication emanated from themes in 3 European treaties, which sought to associate the protection of specific agricultural and food based products as forms of intellectual property rights.

The French were the first to associate a legal regime with food origin through the passage of the Law of 1905, which recognized “an appellation of origin” as a form of intellectual property right; no definition was included in the legislation.<sup>302</sup> Originally created to address the usurpation of specific French wines from fraudulent commercial practices, the French law restricted the use of terroir based designation to specified wines, unless it was grown or produced in a specific area.<sup>303</sup>

Further amendments were made to the French law in 1919 and 1935, to create safeguards for product quality by mandating specific technical standards of production. Demands for greater precision in product quality amongst agricultural associations and government bodies led to an instrumental change to the French law of 1919, to include the definition

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<sup>301</sup> *Supra* note 104.

<sup>302</sup> J.C McCarthy & V. Colby Devitt, Protection of Geographical Denominations, Domestic and International (1979) 69 *TMR* 16. Dev Gangjee, *Relocating the Law of Geographical Indications* (Cambridge: Cambridge University Press, 2012).

<sup>303</sup> *Ibid.*

of an appellation of origin. Accordingly, *French law 66-48 of 1966* defined an appellation of origin as “the geographical name of a country, region or locality, which serves to designate a product originating therein, the quality and characteristics of which are due to the geographical environment, including human factors”.<sup>304</sup> The *Lisbon Agreement’s* interpretation of an appellation of origin was used to construct the definition of law 66-48.<sup>305</sup> *The Paris Convention*<sup>306</sup> was the first international treaty to incorporate an appellation of origin in its provision, and provided for the protection of designated products against unfair competition. Although the *Paris Convention* does not define an appellation of origin or an indication of source, it substantially enumerates the grounds for protection and prohibitive acts associated with the rights.<sup>307</sup>

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<sup>304</sup> World Intellectual Property Office, Industrial Property, Monthly Review of the United International Bureaux For the Protection of Intellectual Property”, October 1966 (available online at [http://www.wipo.int/edocs/pubdocs/en/intproperty/120/wipo\\_pub\\_120\\_1966\\_10.pdf](http://www.wipo.int/edocs/pubdocs/en/intproperty/120/wipo_pub_120_1966_10.pdf)).

<sup>305</sup> Lisbon Agreement on the Protection of Appellation of Origin and their International Registration [http://www.wipo.int/lisbon/en/legal\\_texts/lisbon\\_agreement.html#P22\\_1099](http://www.wipo.int/lisbon/en/legal_texts/lisbon_agreement.html#P22_1099). [Lisbon Agreement]. The Lisbon Agreement defines an appellation of origin as the geographical denomination of a country, region, or locality, which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors.

<sup>306</sup> Paris Convention for the Protection of Industrial Property, Article 1(2). The protection industrial property has as its objects ...indications of source or appellations of origins, and the repression of unfair competition). online, [www.wipo.int/treaties/en/ip/paris/trtdocs\\_wo020.html](http://www.wipo.int/treaties/en/ip/paris/trtdocs_wo020.html).

<sup>307</sup> Article 10bis: Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition. Article 10bis (3i) all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor; (3iii) indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.

A more extensive recognition was subsequently provided in the *Lisbon Agreement*<sup>308</sup> which recognized a broad spectrum of rights associated with an appellation of origin and for the first time, provided an explicit definition of the term.<sup>309</sup> Pursuant to the *Lisbon Agreement* an appellation of origin is protected in other member states as long as it is protected in the country of origin and registered with WIPO's International Bureau.<sup>310</sup>

The Agreement not only protects the misleading use of an appellation of origin, but also its imitation or usurpation, notwithstanding the inclusion of the true name of origin on the product or, if the words are accompanied by the term "kind, type, make, imitation or the like".<sup>311</sup> Both treaties represented Europe's interest in establishing a dominion of power over the ownership of rights in the commercialization of specific food based and agricultural products commodities. Third World representations in the *Paris* and *Lisbon* agreements in the early twentieth century strongly indicate that there was minimal

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<sup>308</sup> Lisbon Agreement on the Protection of Appellation of Origin and their International Registration, Article 2: means the geographical denomination of a country, region, or locality, which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors. (2) The country of origin is the country whose name, or the country in which is situated the region or locality whose name, constitutes the appellation of origin which has given the product its reputation.

<sup>309</sup> Lisbon Agreement on the Protection of Appellation of Origin and their International Registration [http://www.wipo.int/lisbon/en/legal\\_texts/lisbon\\_agreement.html#P22\\_1099](http://www.wipo.int/lisbon/en/legal_texts/lisbon_agreement.html#P22_1099). As of May 2015, the Lisbon Agreement is now amended to include protection for geographical indications: Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications. I discuss its amendments in relation to Jamaica and the Caribbean in Chapter 7 of the thesis.

<sup>310</sup> *Ibid*, Article 1(2), Article 1(5) is also implicated as it pertains to the notification and refusal of registrations among member states.

<sup>311</sup> *Supra* note 299.

interest in procuring rights associated with appellations of origin.<sup>312</sup> The representation of Third World regions in the *Lisbon Agreement* is still minimal in the twenty first century.<sup>313</sup>

As dominant actors in the framing of geographical indications regulations, the European countries were the main proponents in early WIPO negotiations on the establishment of a multi-lateral treaty for geographical indications.<sup>314</sup> Differences in the scope of protection for geographical indications internationally, meant that there was a lack of consensus amongst state actors on the normative rules governing its use. WIPO's 1974 proposed geographical indications<sup>315</sup> treaty focused on the prohibition of goods with deceptive geographical indications, and the establishment of an international registry for protected products.<sup>316</sup> These provisions were similar to those in the *Lisbon Agreement*. However, the World Intellectual Property Office's multi-lateral treaty was never implemented as similar negotiations were proceeding under proposals to revise the *Paris Convention*.

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<sup>312</sup> Jamaica became a signatory to the Paris Convention amidst international trade negotiations culminating in the TRIPs agreement. The country acceded to the Paris Convention on September 24, 1999. (World Intellectual Property Office, [www.wipo.int/treaties/en/notifications/paris/treaty\\_paris\\_195.html](http://www.wipo.int/treaties/en/notifications/paris/treaty_paris_195.html)) Arguably, Jamaica's interest in the Paris Convention was substantially based on complying with international demands for nationally safeguarding foreign based property rights associated with industrial property. Other Caribbean territories ratified the Paris Convention based on colonial affiliations with their former colonizing territories: Cuba's membership to the Paris Convention in 1884 can hardly be said to have been influenced by its interest in safeguarding local forms of industrial property.

<sup>313</sup> More information on the *Lisbon Agreement* is discussed in later parts of this chapter.

<sup>314</sup> WIPO SCT/6/3/ 2001. See also, Ruth Okediji, The International Intellectual Property Roots of Geographical Indications, (2007) 82:3 *Chicago-Kent LR* 1329.

<sup>315</sup> *Ibid.*

<sup>316</sup> WIPO, Committee of Experts on the International Protection of Appellations of Origins and Indications of Source, 2<sup>nd</sup> Session Dec.1-5, 1975.

A similar trajectory was noticeable in negotiations concerning amendments to the scope of appellations of origins under proposed revisions to the *Paris Convention*.<sup>317</sup> Its objectives were ambitious: to broaden the scope of protection for appellations of origin and indications of source and arguably, to appease developing countries by allowing such members to reserve the right to 200 geographical indications for future use.<sup>318</sup> The implication here is that the identified geographical indications could not be used as a trade marks.

Pursuant to the initial draft of *Article 10quarter*, ‘developing countries’ would have the right to reserve 200 geographical indication names associated with either a specific locality, or with its name and provide notification to the International Bureau, which would inform all members of the *Paris Convention* of the registration. The notification effectuated protection in all member states for 20 years. Caribbean representations in these negotiations were minimal.<sup>319</sup>

I argue that politics facilitated ‘rights based’ themes in these negotiations. Geographical indication ownership was (and still is) concentrated amongst a few European

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<sup>317</sup> PR/DC/4.

<sup>318</sup> *Ibid.*

<sup>319</sup> Only 2 Caribbean countries were members to the Paris Convention during this period: Dominican Republic and Cuba. Jamaica ratified the convention in 1999 as an obligation to its WTO TRIPs agreement.

countries.<sup>320</sup> The legal validity of geographical indications in foreign territories is uncontested without reciprocity of recognition. Therefore, proposing the reservation of rights to ‘developing countries’ represented a means of securing support for their agenda. This is evident in subsequent draft amendment proceedings to the *Paris Convention* in 1982<sup>321</sup>, which proposed a significant reduction in the number of geographical indications which a developing country could reserve.

The number was reduced from 200 to 10, and rights could only be reserved for goods that were already registered. Negotiations concerning a revision of the *Paris Convention* were never concluded because of a lack of consensus amongst contracting parties on the norms which should govern the use of geographical indications.<sup>322</sup>

Increasing the global scope of protection for geographical indication emerged as a concern for WIPO in 1990.<sup>323</sup> Pressures to enhance the scope of geographical indication provisions surmounted based on dissatisfaction in the divergence of protection available

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<sup>320</sup> Gangjee, “Geographical Indications” supra note 216. See also Europa, European Union geographical indications database: [www.ec.europa.eu](http://www.ec.europa.eu); DG Agriculture and Rural Development, Background Paper to the Green Paper on Agricultural Product Quality, 2008; Fay Frank ‘EU System For Geographical Indications For Agricultural Products And Foodstuffs’, Worldwide Symposium On Geographical Indications, World Intellectual Property Organization (WIPO), Sofia. June 2009. Most of the global geographical indications are owned by France, Italy, Spain and Portugal. Switzerland is an emerging political force in the configuration of GI regulations in peripheral countries.

<sup>321</sup> PR/DC/51, Diplomatic Conference for the Revision of the Paris Convention.

<sup>322</sup> *Ibid.*

<sup>323</sup> GEO/CE/1/2, Committee of Experts on the International Protection of Geographical Indications, (Available online at WIPO, [http://www.wipo.int/mdocsarchives/GEO\\_CE\\_I/GEO\\_CE\\_I\\_2\\_E.pdf](http://www.wipo.int/mdocsarchives/GEO_CE_I/GEO_CE_I_2_E.pdf), last visited September 27, 2016).



between member countries, the limited scope of provisions in the *Paris Convention*, and minimal state membership to the *Lisbon Agreement*.<sup>324</sup> The Committee adopted the term “geographical indications” to encompass designations associated with both an appellation of origin, and an indication of source. Central to the themes proposed were the establishment of an international registration system, the autonomy of member states to choose the nature of protection accorded to geographical indications, the subject matter of protection, and enforceability issues. As with previous international negotiations concerning geographical indications, the delegates were unable to reach a consensus on the formation of a new treaty.<sup>325</sup>

Europe increasingly attached greater importance<sup>326</sup> to an intellectual property based agricultural policy, engineered to secure product quality, increases in consumer demand, and to gain international market share for its agricultural products.<sup>327</sup> This culminated in the European Union’s first geographical indication regulations in 1992, which was

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<sup>324</sup> There were only 15 contracting members to the Lisbon Agreement in 1990, 2 of which were from the Caribbean: Cuba and Haiti. To date its membership is minimal. Jamaica is not a contracting party to the Lisbon Agreement but this may change given the expanded agenda of the Lisbon Agreement to recognize extensive rights for non-wine and spirit geographical indications.

<sup>325</sup> GEO/CEO/1/3, Committee of Experts on the International Protection of Geographical Indications.

<sup>326</sup> See Geoffrey Garrett & Barry Weingast, *Ideas, Interest and Institutions: Constructing the EC’s Internal Market*, in Judith Goldstein & Robert Koehane (eds) *Ideas and Foreign Policy* (Ithaca: Cambridge Press, 1993). Garret and Weingast trace the impact of interaction amongst powerful states actors in Europe in influencing the formation of the European Union as well as its embodying principles and interests.

<sup>327</sup> This emerged from concerns to protect identified consumer brands from usurpation and to demarcate the connections between the ‘terroir’ and the product. European Commission Directorate, *Food Quality Policy in the European Union, Protection of Geographical Indications, Designations of Origins and Certificates of Specific Character For Agricultural Products and Foodstuffs*. (Guide to Community Regulations, 2004).

influenced by the French law on appellations of origin.<sup>328</sup> It is also evident the European Union's first geographical indication legislation on agricultural products and foodstuffs, EC Regulation 2081/92, used a similar interpretation of geographical indications as that found in the *Lisbon Agreement's* definition of an appellation of origin. Article 2.2(b) of EC Regulation 2081/92 defined a geographical indication as

“a specific place, or in exceptional cases, a country used to describe an agricultural product or foodstuff which originates in that region...and possesses a specific quality, reputation or other characteristics attributable to that geographical origin...”<sup>329</sup>

The objective of EC Regulation 2081/92 was to increase the quality standard associated with a specified agricultural product.<sup>330</sup> The regulation was amended in 2006 to more substantially align market development goals with product diversification, economic prosperity, agricultural innovativeness and rural development. Emphasis was placed on regulating labeling, and providing more regulatory guidance on the scope of geographical indication protection in member countries.<sup>331</sup> Further changes were made in November 2012 to European Union's geographical indication regulation.<sup>332</sup> The regulation now outlays extensive provisions on the scope of the law, more clearly

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<sup>328</sup> Council Regulation 2081/92 of 14 July 1992 on the protection of geographical indications and appellations and designations of origin for agricultural products and foodstuff. [EC Regulation 2081/92].

<sup>329</sup> *EC Regulation 2081/92.*

<sup>330</sup> *Ibid., EC Regulation 2081/92.*

<sup>331</sup> *EC Council Regulation 510/2006 of 20 March 2006 on the Protection of Geographical Indication and Designations of Origin for Agricultural Products and Foodstuffs.*

<sup>332</sup> *Regulation (EU) No. 1151/2012 Of the European Parliament and the Council of 21 November 2012 on Quality Schemes for Agricultural Products and Foodstuffs.*

demarcates its relationship with trade-marks, and provides extensive powers to the Commission to amend or enact future rules.<sup>333</sup>

In the Uruguay round of negotiations, the European Union was instrumental in the framing of the geographical indications provisions which were incorporated under *TRIPS*.<sup>334</sup> Most international state actors had little interest in implementing geographical indication legislation as a distinctively different, yet similar basis of protection was available under trademark law, as certification or collective marks. As critiqued in the next section, *TRIPS* has not been a propellant of change in the laws concerning geographical indications.

Instead, changes to the international scope of geographical indications are facilitated through regional and bilateral agreements between the European Union or other powerful European countries and the Third World. The European Union has also been influential in gaining Canada's support through the Canada Economic Trade Agreement (CETA), to mutually recognize over 170 European agricultural products and food stuff as geographical indications.<sup>335</sup> Therefore, this trend indicates that the European Union is at

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<sup>333</sup> I discuss these issues in Chapter 4, (4.3-4.3.6).

<sup>334</sup> See section below on "The Scope of Geographical Indications Protection in the TRIPS Agreement".

<sup>335</sup> Article 7, Consolidated Canada European Union Comprehensive Economic and Trade Agreement, Annex 1 to the Agreement. (available online at <http://www.international.gc.ca/trade-agreements-accords-commerciaux/agr-acc/ceta-aecg/text-texte/22.aspx?lang=eng#221>).

the forefront of initiatives to enhance the global protection of agricultural and food based geographical indications.<sup>336</sup>

In the next section I critically examine how geographical indications have been interpreted in the TRIPS agreement. The analyses include issues related to its enhanced protection in Doha Negotiations. I also address the politics and ‘differences’ between specific core and peripheral countries in influencing the trajectory of GI laws.

### **3.2. The Scope of Geographical Indications Protection in the TRIPS Agreement**

The introduction of Article 22.1<sup>337</sup> to *TRIPS* essentially broadened the scope of geographical indication registrable products to include non-food and agricultural items such as handicrafts.<sup>338</sup> Article 22.1 demarcates a linkage between the characteristic(s) of the good and its geographical origin. Quality is enumerated as an optional requirement. It is not required to satisfy the linkage between the good and the locality. Therefore, pursuant to TRIPS, a registrable geographical indication may be a good that has other characteristics, such as reputation, which can be traced to its locality.

Member countries are legally obligated to prevent the usurpation of geographical indication goods. Article 22.2-4 enumerates the minimum standard of protection

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<sup>336</sup> *Supra* note 238.

<sup>337</sup> *Uruguay Round Agreement, Standards Concerning The Availability, Scope and Use of Intellectual Property Rights, Part II. Article 22.1* Geographical indications are, for the purposes of this Agreement, 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>338</sup> *Ibid*; Farook Ahmad Mir & Farutul Ain, “Legal Protection of Geographical Indications in Jammu and Kashmir-A Case Study of Kashmiri handicrafts”, (2010) 15:3 *JIPR* 220.

accorded to geographical indications. Member countries should provide the legal means for interested parties to prevent the use of a designation or presentation which is suggestive of the origin of the good, in a manner that misleads the public as to the actual geographical origin of the good.<sup>339</sup> Protection of the registered product against unfair competition in another member country is also explicitly recognized under TRIPs, and includes prohibition of the use of an indication or allegation which is liable to mislead the public “as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity of the goods”.<sup>340</sup>

Article 22.3 stipulates that a member country or an interested party should refuse or invalidate the registration of a trademark, if use of the indication misleads the public as to the actual origin of the good. There is no mandatory obligation by a member country to include a refusal or invalidation of a trademark in its legislation on the grounds of misleading the public, or confusion with a geographical indication. This remains a legislative option within each country’s discretion. In instances of conflict between

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<sup>339</sup> Uruguay Round Agreement: Trade Related Aspects of Intellectual Property Rights, Standards Concerning the Availability, Scope and Use of Intellectual Property Rights. Part II, Section 3 Article 22:2. [TRIPs, GI]

<sup>340</sup> Article 22:2 of TRIPs makes specific reference to the Paris Convention’s interpretation of unfair competition as is described in Article 10bis of the Paris Convention. Article 10bis, Unfair Competition: 10bis (1) The countries of the Union are bound to assure such countries effective protection against unfair competition, (2) Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition (3) The following in particular shall be prohibited: (i) all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities or competitor; (ii) false allegations in the course of trade such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor, (iii) indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity of the goods.

trademarks and food based geographical indications, *TRIPS* is more specific on delineating trademark rights and enumerating the limitations of GI protection. The validity or eligibility of registration for a trademark cannot be prejudiced by GI registration where the trademark has been “applied for or used in good faith”.<sup>341</sup>

*TRIPS* limit the scope of non-wine and spirit geographical indication protection between World Trade Organization member countries on two bases. Firstly, the plaintiff must prove that unfair competition<sup>342</sup> has occurred by the use of the indication or designation. Secondly, the public must have been misled by the use of a false indication as to the origin of the product.

The limitation in the scope of protection provided by *TRIPS* has led to international contentions between interested and dis-interested parties of the World Trade Organization. As I discuss later in this chapter and in subsequent chapters, conflicts over the scope and extent of geographical indication rights have led to forum shifting. The most current forum shifting resulted in the highly contested amendment to the *Lisbon*

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<sup>341</sup> *TRIPS GI*, section 22.4, *supra* note 3.

<sup>342</sup> Unfair Competition must be on grounds of “unfair” as stipulated by *Article 10bis* of the Paris Convention: (1) The countries of the Union are bound to assure to nationals of such countries effective protection against unfair competition. (2) Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition. (3) The following in particular shall be prohibited:

(i) all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor;

(ii) false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor; (iii) indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.

*Agreement.* Furthermore, the remarkable expansion of the European Union's agenda for the global recognition of geographical indication rights has led to introduction of protection mechanisms in regional and bilateral free trade agreements.

Although there has been only a single submission of dispute to the World Trade Organization's Dispute Settlement Body concerning geographical indication protection, the dispute illuminated the divergence of meaning, disparity of protection, and also, highlights remaining contentious points between member countries.<sup>343</sup>

The dispute was initiated in 2003 by Australia and the United States against the European Union. It concerned EC regulation 2081/92 on the reciprocity of protection, and the registration requirements of member countries' GIs in the EU.<sup>344</sup> The European Union's geographical indication legislation is comparatively more extensive than that of its international trading counterparts.<sup>345</sup> The complainants alleged that European Union's geographical indication legislation on reciprocity violated the principle of national

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<sup>343</sup> WT/DS290 European Communities – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs. April 17, 2003.

<sup>344</sup> EC Regulation 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs. The United States, Argentina, Canada, Brazil, China, Columbia, Chinese Taipei, Guatemala, India, Mexico, New Zealand and Turkey were added as third party complainants.

<sup>345</sup> Guide to Geographical Indications, Linking Products and their Origin, (International Trade Centre, 2009); European Commission Directorate: Protection of Geographical Indications, Designations of Origin and Certificates of a Given Quality (Working Paper, 2004); European Union, Protection of Geographical Indications in 160 countries in Geographical Indications Handbook, June 2007.

treatment<sup>346</sup> by requiring that WTO member countries provide a geographical indication registration system similar to that of the EU. It further alleged that the regulation required reciprocal protection of European Union's geographical indications, prior to the recognition of rights for non-EU member countries and nationals.<sup>347</sup>

The claim also asserted that the European Union required WTO member countries to examine geographical indication applications for consistency with its own regulation, transmit geographical applications to the EC, handle objections from their countries, and implement product inspection procedures similar to those in the EU.<sup>348</sup> Australia, the United States and other third party complainants contested this provision on the basis that it provided less favorable treatment to nationals of their country.<sup>349</sup> On the allegation

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<sup>346</sup> The principle of national treatment forms an essential component of the Paris Convention for the Protection of Industrial Property and TRIPS, a treaty which must be ratified by all member of the Paris Convention and WTO members. Article 2.1 of TRIPS also specifies that in intellectual property rights matters WTO members must comply with Articles 1-12, 19 of the Paris Convention. Within the context of national treatment, Articles 2 and 3 of the Paris Convention are relevant to the current analysis. According to Article 2 of the Paris Convention, nationals of any country in the Union should be given the same rights and protection as those accorded to the member country's own nationals. Article 3 extends national treatment protection to nationals who are not from countries within the Union but who are domiciled or have a real and effective industrial or commercial establishment in a territory within the Union.

<sup>347</sup> European Communities-Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs – Complaint by Australia, World Trade Organization, WT/DS290/R. available online (docsonline.wto.org). Complaint by Argentina - WT/DS290 Annex C and D Addendum, Arguments of Third Parties, Argentina C-1A.10., (Available online docsonline.wto.org/imrd/GEN\_searchResultasp).

<sup>348</sup> Council Regulation (EEC) No 2081/92 of 14 July 1992, Article 12: Without prejudice to international agreements, this Regulation may apply to an agricultural product or foodstuff from a third country provided that: - the third country is able to give guarantees identical or equivalent to those referred to in Article 4, - the third country concerned has inspection arrangements and a right to objection equivalent to those laid down in this Regulation, - the third country is prepared to provide a protection equivalent to that available in the Community to corresponding agricultural products for foodstuffs coming from the Community. Article 12.3: "The Commission shall examine at the request of the country concerned, and in accordance with the procedure laid down in Article 15 whether a third country satisfies the equivalence conditions and offers guarantees...as a result of its national legislation."

<sup>349</sup> *Ibid.*



of a breach of national treatment, the Dispute Resolution panel's report held that EC's regulation did not recognize the principle of national treatment. The panel also concluded that there was no finding that the product inspection requirements were inconsistent with WTO obligations.<sup>350</sup>

Australia and the United States further claimed that EC's regulation diminished the legal protection of trademarks, contrary to *TRIPS* and the *Paris Convention*, by disallowing the co-existence of a trademark during the course of trade with an identical or similar GI. They further claimed that it facilitated unfair competition.<sup>351</sup> *TRIPS* clearly provides for a greater level of protection of trademarks that are in use or registered, than that accorded to geographical indications.<sup>352</sup> It is not surprising that the panel's report on EC's

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<sup>350</sup> Marsha Echols, in her commentary on the Dispute Settlement Body's ruling, notes that the panel report not only clarifies the national treatment obligation of the host country to other member countries, but also reinforces the favorable treatment given to trademarks over geographical indications within the WTO. Marsha A. Echols, "The Geographical Indications Disputes at the WTO" in *Geographical Indications for Food Products, International Legal and Regulatory Perspectives*, (Wolters Kluwer: Austin, 2008). [Echols, *Geographical Indications for Food Products*].

<sup>351</sup> The specific provisions are summarized as follows: Article 1 of *TRIPS*: Members should not be required to implement more extensive protection than is required by the Agreement, Article 2 of *TRIPS*: Compliance with the *Paris Convention*, Article 16: The exclusive right of a trademark owner to prevent third parties from using a sign that is similar or identical to the registered trademark during the course of business so as to result in a likelihood of confusion. The likelihood of confusion is presumed in the case of an identical sign for identical goods; Refusal, cancellation or prohibition of a trademark which constitutes a reproduction, imitation or translation, liable to create confusion with a well-known mark., Article 20 of *TRIPS*: Use of a trademark during the course of trade should not be unjustifiably encumbered by special requirements...in a manner detrimental to its capability to distinguish the goods or services of one undertaking from those of other undertakings and Article 24.5 of *TRIPS*: Where a trademark has been registered or rights have been acquired through use in good faith before a geographical indication is protected in its country of origin, a member country should not implement its GI measures so as to prejudice the eligibility or the validity of registration of a trademark on the basis that the trademark is similar or identical to a geographical indication. Articles 10, 10bis and 10ter of the *Paris Convention*: Provisions concerning false indication and unfair competition.

<sup>352</sup> *Ibid*, Article 16.

regulation reinforced what is already inferred from the *TRIPS* Agreement. The panel concluded that the EC regulation was not inconsistent with TRIPS, by allowing the registration of a GI that conflicted with a prior trademark. The regulation was sufficiently constrained by the use of the exception provision in the TRIPS Agreement.<sup>353</sup> In deliberating its decision, the panel noted that EC's regulation on the co-existence of a trademark with a geographical indication was subject to the TRIPS provision on limited exception. Therefore, concurrent use of a trademark with a similar sign/mark denoting a GI necessitates that the legitimate interest of the trademark owner and third parties be taken into account.

As enumerated in *TRIPS* and clarified by the panel's ruling, this line of reasoning espouses the argument that concurrent usage conflicts are likely to be resolved in favor of the trademark owner. The panel explained that since the EC had explicitly noted that the trademark owner retains the right to prevent the use of a GI in the European Union, the owner's right to prevent conflicting use was not infringed by the regulation. Furthermore, the right of co-existence with a trademark that is accorded to geographical indications was only applicable to those which had been registered. The significance of this finding is ambiguous and arguably trivial, since the European Union had already registered and continues to register most of its commercially viable agricultural products and foodstuff as geographical indications.

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<sup>353</sup> Article 17 of TRIPS: Members may provide limited exceptions to the rights conferred by a trademark, such as fair use of descriptive terms, provided such exceptions take account of the legitimate interests of the owner of the trademark and of third parties. Panel Report, paragraph 7.646 – 7.661.

In an effort to align its regulation with the panel's ruling, the European Union amended its geographical indication regulation in April 2006.<sup>354</sup> Examination of geographical indication applications and objection procedures are now dealt with by the EU member in which registration is sought by the foreign national.<sup>355</sup> There is no longer a requirement for participation by 3rd party governments in the application process.<sup>356</sup> In relation to the protection of trademark rights of third parties, the amended regulation stipulates that a geographical indication cannot be registered if it is liable to mislead consumers as to the true identity of the product.<sup>357</sup> The regulation allows for the co-existence of a trademark with a geographical indication in situations where the trademark has been registered or established by use in good faith within a Community territory before the date of protection of the geographical indication or, prior to Jan 1.1996, as long as there are no grounds for revoking or invalidating the trademark.<sup>358</sup>

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<sup>354</sup> *Council Regulation 1151/2012*. [“*Amended EEC Regulation*”].

<sup>355</sup> *Ibid*, Application for Registration: ...Applications are made to the Member State on whose territory the geographical area is situated. The Member State examines it and initiates a national objection procedure, ensuring that the application is sufficiently publicized and allowing a reasonable period within which any natural or legal person having a legitimate interest and established or resident on its territory may lodge an objection.

<sup>356</sup> *Amended EEC Regulation*, Article 5.3, *supra* note 353.

<sup>357</sup> *Amended EEC Regulation*, Article 3.4, *supra* note 353.

<sup>358</sup> The grounds for revocation include: Non-use of the trademark in the Community territory and the absence of a proper reason for non-use; if the trademark has become a common name through acts or inactivity or, if the trademark is liable to mislead the public as to the nature, quality or geographical origin of a good. Council Regulation (EC) No. 40/94 of December 1993 on the Community Trademark, Article 50. The grounds for invalidity include: bad faith on the part of the applicant in the filing of the trademark application, the existence of an earlier trademark or, if the trademark's use is prohibited by another earlier trademark's right to name, right of personal portrayal, copyright or industrial property: Council Regulation (EC) No. 40/94 of December 1993 on the Community Trademark, Article 51.1b, 52.2(a), 52.2(b), 52.2(c) and 52.2(d).

According to the WTO's report on the amended regulation, Australia and the United States are in disagreement on the extent of compliance by the EC with the Dispute Settlement Body's recommendations.<sup>359</sup>

### **3.3. Geographical Indications in the Doha Round of Negotiations**

Negotiations amongst World Trade Organization member countries through the Doha Round related to geographical indications (hereafter "Doha") remained contentious since the inception of such proceedings. The Doha Ministerial Declaration<sup>360</sup> provides the basis for ongoing negotiations on the scope of geographical indication protection amongst WTO member countries by stipulating that members have agreed to negotiate on extending Article 23 protection to non-wine and spirit GIs.<sup>361</sup>

Article 23 of TRIPS is restricted to wine and spirit geographical indications. Article 23 enables an enhanced level of protection, by prohibiting the use of a sign/mark on a wine or spirit even when its usage does not mislead the public as to its origin. As an example, the current protection available for non-wine and spirit geographical indications would not prohibit the use of the words "*Huile d'olive Nice made in Canada*" from being used, although the olive oil is a registered geographical indication in France and the European

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<sup>359</sup> Dispute Settlement: DS290 – European Communities- Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs. World Trade Organization, (Available online: [www.wto.org/english/tratop\\_e/dispu\\_e/ds290\\_e.htm](http://www.wto.org/english/tratop_e/dispu_e/ds290_e.htm)).

<sup>360</sup> The Doha WTO Ministerial Declaration of 2001 is a mandate which aims to provide a forum for achieving the objectives of trade liberalization, economic development and effective participation by developing and least developed WTO countries involved the international trade system.

<sup>361</sup> Paragraph 18. Doha WTO Ministerial 2001: Ministerial Declaration WT/MIN(01), Adopted November 14, 2001 (Available online: [www.wto.org/english/thewto\\_e/minis\\_e/min01\\_e/minded\\_e.htm](http://www.wto.org/english/thewto_e/minis_e/min01_e/minded_e.htm)).

Union. There is no likelihood of misleading the public since the origin of the olive oil is clearly noted; this is the extent of Article 22.2 protection.

However, if non-wine and spirit geographical indications were given enhanced protection under Article 23, the words “*Huile d’olive Nice made in Canada*” could not be used as an accompanying expression indicating the style, kind or imitation of the olive oil, as this association is explicitly prohibited from use. Furthermore, if Article 23 were to extend to non-wine and food geographical indications, the registration of a trademark for goods that contain a geographical indication must be invalidated or refused by a member country, or upon the request of an interested party. Article 23’s inclusion of non-wine and spirit geographical indications would enable the use of negotiations in the Council of TRIPS to establish a multilateral system of notification and registration of GIs in contracting member countries. These points will be elaborated on later in this section.

Two fundamental points are noteworthy in the Doha debates concerning geographical indications. Firstly, unlike conventional forms of intellectual property right, there is no clear distinction in conflict regarding the scope of protection between hegemonic countries and Third World communities. The European Union, Switzerland, India, Mauritius and Jamaica are examples of regions/countries that are in favor of extending Article 23’s protection to non-wine and spirit GIs.<sup>362</sup> The United States, Australia,

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<sup>362</sup> Issues Related to The Extension the Protection of Geographical Indications Provided For in Article 23 of the TRIPS Agreement to Products other than Wines and Spirits: Compilations of Issues Raised and Views Expressed, Note By the Secretariat, World Trade Organization General Council Trade Negotiations Committee, WT/GC/W/546 May 18 2005.

Canada and a number of Latin American countries were and continue to be opposed to the extension of enhanced protection to geographical indications.<sup>363</sup> Although there is an absence of general cohesion amongst developing countries on the extension of geographical indication protection, the Doha negotiations illustrated a distinctive paradigm on “rights based arguments”.

With the marked exception of the European Union, pressing demands for increased protection of geographical indication goods were made by developing and least developed countries. Over the past few decades, the United States consistently maintained a stringent position on the protection of conventional forms of intellectual property right in foreign countries. However, the country is vehemently opposed to the enhanced protection of rights associated with geographical indications.<sup>364</sup>

Secondly, the state of negotiations has reached an impasse with sharp divisions on how geographical indications should be internationally recognized and enforced. Therefore, it is not surprising that no consensus was reached through the Doha Round on the enhancement of protection to non-wine and spirit GIs. This has not reduced the dynamism of stakeholders advocating enhanced protection, but has facilitated the emergence of alternative forums for achieving protection; namely through bilateral and regional agreements.

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<sup>363</sup> *Ibid.*

<sup>364</sup> I discuss the polarizing position of the United States in Chapters 4 and 7.

The rest of this section will discuss the state of geographical indication negotiations in the Doha Round, and the perspectives of 4 countries/regions on the scope of GI protection: The European Union, The United States, Switzerland, and Jamaica. These geographic specifications are chosen because the groups have varied perspectives on the recognition and protection of geographical indications. I argue that although the European Union, Switzerland, and Jamaica<sup>365</sup> are in favor of an international enhanced level of protection for non-wine and spirit GIs, the interest in doing so are different. The final section will discuss and critically evaluate the use of bilateral and regional trade agreements to advance the increased recognition of rights associated with non-wine and food GIs internationally.

### **3.3.1. Geographical Indications in the Doha Negotiations: The European Union's Position**

The European Commission<sup>366</sup> ardently lobbied for greater protection of geographical indications in the *TRIPS Agreement* by the extension of Article 23 to include non-wine and spirit GIs. Its interest in adopting a common approach for the regional and international protection of GI rights is most ardently exemplified in the 1979 case of *Rewe Zentrale v Bundesmonopolverwaltung (Rewe)*. *Rewe* involved a contestation over the ability of Germany to import wine from France for commercial use, based on the specification and alcoholic content of the wine. In acknowledging that a standard

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<sup>365</sup> In reference to Jamaica, this point is developed and argued in Chapters 7 and 8.

<sup>366</sup> The European Commission is an institution which drafts all laws and policies related to the European Union. One of its main purposes is to represent the European Union internationally in negotiation agreements with other countries. European Union – European Commission (Information available on line [http://europa.eu/about-eu/institutions-bodies/european-commission/index\\_en.htm](http://europa.eu/about-eu/institutions-bodies/european-commission/index_en.htm)).

approach to the marketing of foreign products in member states was needed, the EC court held that the contestation created “an indirect obstacle to imports”<sup>367</sup> and, was a distortion to trade. The ruling facilitated the free movement of legally produced goods between European member states, notwithstanding the requirements posed by technical standards.

The EC is strategically positioned to benefit from enhanced international protection given that the region globally accounts for most of the registered agricultural and food based geographical indications. There are currently 785 agricultural and food based registered geographical indications in the European Union.<sup>368</sup> The groups’ interest in lobbying for an extension of Article 23 is based on securing market access of its GI products in overseas countries, sustaining the local culture of farming communities and harnessing rural development through increased income for rural farmers, as well as fostering agricultural diversification.<sup>369</sup> Against this background, the EC submitted a draft amendment to Articles 22-24 to the TRIPS Council outlining proposed changes which are more aligned with the region’s position on GIs.

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<sup>367</sup> *Case 120/78 Rewe-Zentral AG v Bundesmonopolverwaltung für Branntwein* [1979 ECR 649] at 9.

<sup>368</sup> Available online at EU Agricultural and Rural Development GI and Appellation of Origin Database, [http://ec.europa.eu/agriculture/quality/door/list.html?recordStart=0&filter.dossierNumber=&filter.comboName=&filterMin.milestone\\_mask=&filterMin.milestone=&filterMax.milestone\\_mask=&filterMax.milestone=&filter.country=&filter.category=&filter.type=PGI&filter.status=](http://ec.europa.eu/agriculture/quality/door/list.html?recordStart=0&filter.dossierNumber=&filter.comboName=&filterMin.milestone_mask=&filterMin.milestone=&filterMax.milestone_mask=&filterMax.milestone=&filter.country=&filter.category=&filter.type=PGI&filter.status=), last visited September 27, 2016).

<sup>369</sup> Recital 2-4 of “*Amended Regulation*”, supra note 353.



The EC posited that its proposed amendment to Article 23 and the creation of a multilateral registry are illustrative of a “forward looking, “balanced” approach to the enhancement of geographical indications protection under TRIPS.<sup>370</sup> This perspective is likely based on the proposed safeguarding of trademark holders’ rights under Article 24.5. Pursuant to Article 24.5, a trademark cannot be invalidated or become ineligible for registration on the basis that it is identical or similar to a geographical indication. The proposed Doha Round amendments portrayed reactive response to the misappropriation of EU geographical indications in other countries. The EU also proactively attempt to safeguard the proprietary interest of of existing geographical indications that have penetrated international markets. I discuss the most relevant changes proposed by the European Union in the failed Doha Round negotiations below.

### 3.3.2. **Increasing the Scope of Geographical Protection under Article 23**<sup>371</sup>

Under a revised Article 23, the use of a geographical indication on agricultural goods and foodstuff that are either not from the true place of origin or, is not connected with the actual place of origin associated with the good, would be prohibited.<sup>372</sup> Phrases on the label of a good denoting a connection by “style”, “imitation” or “style” would fall within the indications/signs that are prohibited from use.<sup>373</sup> Furthermore, an interested party

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<sup>370</sup> *Ibid.*

<sup>371</sup> Geographical Indications, Communications from the European Communities. World Trade Organization: General Council Trade Negotiations Committee Council for Trade Related Aspects of Intellectual Property Rights Special Session. WT/GC/W/547 June 2005. [Proposed EC Article 23 amendment].

<sup>372</sup> *Ibid*, page 8.

<sup>373</sup> *Ibid.*

would have the right to request the invalidation or refusal of registration of a trademark which consists of a geographical indication that is not from the true country of origin. A member country would also be entitled to include this provision in its domestic geographical indication legislation.<sup>374</sup>

Protection would also be extended to homonymous geographical indication<sup>375</sup> names as long as no false representation is made to the public on the product's origin. Although infringement actions would be guided by the likelihood of misleading the consumer and the equitable treatment of producers, member countries would be vested with the authority to determine the level of differentiation between homonymous indications.

### **3.33. Concurrent usage of Wine and Spirit Geographical Indications with Agricultural and Food based Geographical Indications**

The European Commission also included a provision in its proposal that allowed for the use of a geographical indication associated with a wine or spirit that is similar to a GI in a member country, if the wine or spirit geographical indication had been in continuous use ten years prior to April 15, 1994 or, if it were used in good faith prior to that date. The provision would also facilitate the concurrent use of geographical indications associated with wine and spirit and agricultural and food based products, if the former was in continuous use for more than twelve years.

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<sup>374</sup> Proposed EC Article 23 amendment note, *supra* note 371.

<sup>375</sup> Homonymous geographical indications are pronounced alike, or spelt out alike but relate to two different products from different geographical origins.

### **3.3.3. Validity of trademark Registrations vis a vis Geographical Indications<sup>376</sup>**

This provision was lauded by the European Commission as a concession to other member countries whose trademark rights would otherwise be prejudiced by an enhanced GI protection. A trademark that is similar or identical to a geographical indication, but which has been in use before the amendments come into force would not be invalidated for misleading the public as to its true origin. However, this provision would not be valid if the member states' domestic law already contained legislation for the invalidation of trademarks on these grounds. Invalidation may also be brought by an interested party to a proceeding.

The concession is a mere nuance. Essentially, the use of the provision results in the grandfathering of trademarks that are similar or identical to geographical indications. Therefore, trademarks that are similar to a geographical indication, and which have been in use after the proposed amendment, are not immune from invalidation if requested by an interested party. Furthermore, if the invalidity of a trademark bearing similarity to a geographical indication cannot be contested on grounds of misleading the public, it may be possible for a WTO member to draft or interpret its domestic geographical indication regulation permitting an invalidation of the trademark.

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<sup>376</sup> *Ibid*, Article 24.5.

### **3.3.4. Multilateral system of Notification and Registration for non-wine and spirit Geographical Indications**

There is no novelty in the establishment of a multilateral registry for geographical indications. The European Commission's proposition in the Doha Round negotiations was an international extension of its regional scheme. Furthermore, the proposition represented an attempted transposition of the international registration system that is used under the *Lisbon Agreement*.

The European Commission was the main proponent in the Doha Round for the establishment of a multilateral system of notification and registration for agricultural goods and foodstuffs. Its online registry for non-wine and food GIs was established in 1992.<sup>377</sup> The online registry contains information on products that have either applied for registration, are registered as geographical indications or, whose product names have been published in the Official Journal of the European Union for purposes of notification and reservation.<sup>378</sup> The EC's interest in internationalizing a multilateral system of notification for non-wine and spirit GIs is embedded in safeguarding the protection of its geographical indication products in international markets. The main points proposed by the EC in advocating the establishment of a multilateral system of notification are noted in the paragraphs below.

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<sup>377</sup> European Commission: Agriculture and Rural Development – Non-wine and Spirit GI database ([http://ec.europa.eu/agriculture/quality/schemes/index\\_en.htm](http://ec.europa.eu/agriculture/quality/schemes/index_en.htm)).

<sup>378</sup> A member country may contest the eligibility of a GI which has been published by lodging a reservation with the EC.

Participation in the notification and registration scheme would be voluntary. A member's participation would be activated once the administering body is notified of a geographical indication which satisfies the requirements of *TRIPS*.<sup>379</sup> The geographical indication should be currently protected, and in use in the member state. For participating member countries that have not lodged a reservation or, who have withdrawn a notification, the legal effect of notification is to provide a rebuttable presumption of the eligibility of protection.

Protection within each participating WTO member state would not be refused on the grounds of a reservation based on non-compliance with TRIPs or, a false representation of the goods' origin to the public. Furthermore, the European Commission proposed that member countries should also notify the administering body of any application for trademark registrations containing geographical indications that have been registered or applied for, if requested by the notifying member. The proposal further stipulated that if the product was not in compliance with TRIPs definition of a geographical indication, WTO member countries could not refuse GI protection of the product. Secondly, protection should be refused if the good falsely misrepresents its origin. Finally, no protection should be accorded to a product which is identical to a name in common usage with a wine or spirit, product of the vine, plant variety or animal breed.

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<sup>379</sup> The applicable definition is stipulated in Article 22: 1. Geographical indications are, for the purposes of this Agreement, 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.

A scrutiny of the proposed scheme illustrates 3 salient points, the latter 2 of which were the focus of contention with countries such as United States, Canada and Japan. Firstly, the scheme envisions the use of the registry as a database of non-wine and food geographical indications. It therefore provides quantitative and factual information on the products which have applied or have been registered as geographical indications, and those which have been published for purposes of reservation.<sup>380</sup>

Secondly, although the proposition stipulated an 18-month period after the submission of the geographical indication to the registry during which a reservation can be lodged by a member country, no clear policy or regulation associated with resolving such a dispute is identified. Failing the resolution of a disputed geographical indication claim by a

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<sup>380</sup> *Supra* note 35. The reservation may be based on one of the following grounds: (a) the notified geographical indication does not meet the definition of a geographical indication specified in paragraph 1 of Article 22 of the TRIPS Agreement;

(b) the notified geographical indication, although literally true as to the territory, region or locality in which the goods identified by it originate, falsely represents to the public that the goods originate in its territory, as provided for in paragraph 4 of Article 22 of the TRIPS Agreement;

(c) the notified geographical indication is identical with the term customary in common language as the common name for a wine or spirit in the territory of the Member lodging the reservation ("the challenging Member") or, with respect to products of the vine, with the customary name of a grape variety existing in the territory of the challenging Member as of the date of entry into force of the WTO Agreement, or, with respect to plants or animals, with the name of a plant variety or animal breed existing in the territory of that Member as of the date of entry into force of the WTO Agreement as amended, as provided for in paragraph 6 of Article 24 of the TRIPS Agreement.

member country, the geographical indication is still registered after the 18-month period, accompanied by a notation of the reservation on the registry.

Thirdly, unless explicitly provided for by domestic legislation, the geographical indication of another member country cannot be contested on the basis that it is similar or identical to another GI. The only ground for opposition is if the challenging country's geographical indication has been in use in the member country for at least 10 years prior to the amendment to *TRIPS*. In elucidating this point, I note the following fact pattern of involving two countries, A and B, in which country B seeks to register its coffee Bx as a geographical indication in country A. However, country A already has its own registered GI coffee Bz with a similar indication to country B's coffee which emphatically, has been in continuous use or used in good faith since 2006. Hypothetically, should the geographical indication provisions of *TRIPS* be amended in 2016 to reflect the European Commission's propositions, country B would not be entitled to the recognition of enhanced protection for its coffee in country A. Since EC's proposed provision favored domestic geographical indications which have been in continuous use for a minimum of 10 years, (or was being used in good faith) over a similar GI from another member country, it prevents the geographical indication registration of the member country's product. In this specific example, the geographical indications registration of country B's coffee in country A would not be possible.

The United States opposed most of the European Commission's proposed geographical indication amendments of *TRIPS*. It argued that member countries should choose to

implement an intellectual property system that is most appropriately aligned with its own legal system. Divergences from this would indicate a compromise of the principle of territoriality.<sup>381</sup> The United States submitted that adequate protection for GIs is already available under trademark law via the use of certification marks, collective marks or guarantees.<sup>382</sup> Foremost among the contentious issues that have emerged in the Doha Round, are those related to the extension of Article 23 protection, the grandfathering of trademark rights, the absence of member countries autonomy to resolve conflicts associated with the continuous use of prior trademarks, and the relevance of a multilateral system of registration for non-wine and food GIs. These issues are critically analyzed in the section below.

### **3.4. The United States' Opposition to Geographical Indication Extension**

According to the United States, GIs have been protected under the *Lanham Act* as a certification mark, with a history of protection dating back to 1946.<sup>383</sup> As such, the

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<sup>381</sup> Refer to joint submission from the United States, Canada, Chile, South Africa, Argentina et al: Proposed Draft Trips Council Decision on the Establishment of a Multilateral System of Notification and registration for wine and spirits, p.1. (Available online at WTO, [http://www.wto.org/english/tratop\\_e/trips\\_e/gi\\_background\\_e.htm#wines\\_spirits](http://www.wto.org/english/tratop_e/trips_e/gi_background_e.htm#wines_spirits)). Australia's submission to TRIPS council also mirrors the United States' argument on the compromise of territoriality if geographical indication protection were to be enhanced to include non-wine and spirit GIs. WT/GC/W546: Issues Related To The Extension Of The Protection Of Geographical Indications Provided For In Article 23 of the trips agreement To Products Other Than Wines And Spirits [WT/GC/W546: "Issues related to the Extension of Protection of GIs].

<sup>382</sup> *Ibid.* The United States jurisprudential treatment of foreign based geographical indications is critically analyzed in chapter 4.

<sup>383</sup> Geographical Protection In the United States', Dispute Settlement DS174. The United States Trademark Act, section 45 defines a certification mark as any word, name, symbol, or device, or any combination thereof-- (1) used by a person other than its owner, or (2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this Act, to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work



United States argues that increasing the scope of GI protection to agricultural products is unwarranted.<sup>384</sup> A central tenet of the European Union's GI legislation is the active role of government bodies in the oversight of the system. However, the United States ideology implicates minimal government involvement in private rights. Rights associated with geographical indications are envisaged as private rights which are already enforceable through existing law.<sup>385</sup> In effect, this culminates in a limited interpretation to the norms associated with geographical indications.

By classifying a certification mark as a geographical indication, the United States has candidly dismissed prospects of amending its intellectual property laws to include geographical indications as a singular form of right. In defending the adequacy of certification marks to address concerns by foreign GI owners, the United States posits that marks which denote a geographical term not only limits its usage to those in the region, but also "prevents abuses and illegal uses of the mark".<sup>386</sup> However, the contentious point in the debate, is the substantive differences between a certification mark and a geographical indication; this creates challenges for the enforceability of geographical indication rights in the United States.

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or labor on the goods or services was performed by members of a union or other organization. ([http://www.uspto.gov/web/offices/dcom/olia/globalip/pdf/gi\\_system.pdf](http://www.uspto.gov/web/offices/dcom/olia/globalip/pdf/gi_system.pdf)).

<sup>384</sup> International Trademark Association, Doha's Impact on TRIPS, Balancing Geographical Indications Protection, (World Trade Organization report, May 2002).

<sup>385</sup> WIPO IPC/W/386, Implications of Article 23 extension.

<sup>386</sup> *Ibid.*

Committee submissions by the United States to the WTO Dispute Settlement Body illustrate that it viewed the proposed geographical indications amendments to TRIPS as producing an imbalance of rights in the global intellectual property order.<sup>387</sup> There is much ambiguity in this declaration, given that the United States is the most dominant proponent for the enforceability of its IP rights in foreign countries, notwithstanding the relevance of the legislation to Third World communities.<sup>388</sup> The United States posits that resources allocated for the protection of foreign based geographical indications would be misdirected, and be a commercial loss because the legislation does not apply to any of its local products.<sup>389</sup> The forecasted cost incurred in changing its laws and legal system to accommodate the protection of foreign based rights is posited to be unjustifiable.<sup>390</sup>

As powerful non-state actors in World Trade Organization proceedings, the International Trademark Association has also forcefully iterated that enacting GI legislation would cause a loss of generic names, loss to ownership rights in some trademarks and a duplication of the rights already associated with certification marks.<sup>391</sup>

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<sup>387</sup> WTO, Council for the Trade Related Aspects of Intellectual Property, Implications for Article 23 Extension, IPCW386 para. 4. (November 8, 2002) para. 2.

<sup>388</sup> Ikechi Mgbeoji, TRIPS and TRIPS Plus, *supra* note 180 Andreas Rahmatian, Neo-Colonial Aspects of Global Intellectual Property Protection, (2009) 1 *J of W Intell'l Prop* 40.

<sup>389</sup> *Ibid.*

<sup>390</sup> *Ibid.* p.5.

<sup>391</sup> *Ibid* p. 2-7.

The United States envisages an unrelenting efficacy in the ability of *Article 22*<sup>392</sup> of *TRIPS* to prevent the misleading use of geographical indications.<sup>393</sup> However, contestations over the domestic validity of foreign certification marks in United States jurisdiction have not always shown such efficacy. The inability of India to frame its claim against RiceTec, a United States based company, as a violation of its geographical indications exemplifies this point.

The ability of a foreign geographical indication to sustain protection as a certification mark in the United States is more tenable when its name denotes and evokes a strong connection to its geographical origin. India could not resort to United States' trademark law as an alternative approach to its challenge of the patentability<sup>394</sup> of Basmati rice by RicetTec. According to the United States jurisprudence on certification marks, the name 'Basmati' would not explicitly relate to a geographic area but to the descriptive (aromatic) characteristics of the commodity. Descriptive meanings are protected if they convey the origin of the product to the consumer.<sup>395</sup> A reasonable cause of action can only be contested on grounds which challenge the genericity<sup>396</sup> of the product. India's

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<sup>392</sup> *Supra* note 146.

<sup>393</sup> *Supra* note 291 at .3.

<sup>394</sup> Patentability refers to the exclusive right granted to an inventor to make, sell or use an invention for a specified number of years.

<sup>395</sup> United States Trademark Law, 5 USC 1052 s.f.

<sup>396</sup> See *Tea Board of India v The Republic of Tea Inc, [Tea Board India]*.. Genericity is determined by the qualities of the product which must necessarily evoke a strong public perception on the origins of the product. The non-protection of generic goods is enumerated in Article 24.6 of TRIPS: Nothing in this Section shall require a Member to apply its provisions in respect of a geographical indication of any other Member with respect to goods or services for which the relevant indication is identical with the term

hurdle to a successful trademark challenge is the inclusion of the term “US grown” or “American Basmati rice” on Rice Tec packaging, which clearly indicates the source of the product.

India’s contestation over its right to prevent the misleading use of the Darjeeling tea brand in the United States, more aptly evidences a satisfactory interpretation of TRIPS Article 22 in its domestic law.<sup>397</sup> In *Tea Board of India v Republic of Tea*, the Tea Board of India had filed an opposition in the United States to prevent the usage of the word “Darjeeling Nouveau” on its licensee’s teas; citing likely confusion with consumers as a basis for its non-registration. Darjeeling is an Indian geographical indication which is registered as a certification mark in the United States.<sup>398</sup> In upholding Tea Board of India’s claim, the trade mark appeal board reasoned that the strong market presence of the “Darjeeling” brand in the United States, and the identical characteristics of both tea products portended a likelihood of confusion amongst consumers.<sup>399</sup>

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customary in common language as the common name for such goods or services in the territory of that Member.

<sup>397</sup> *Ibid*, *Tea Board of India*. The case also has significant implications for the genericity of geographical indications, as it identifies that it is the public’s perception of the product that determines if the name has become generic. See also *Re Vanity Fair Inc.* 2007 WL 4616262.

<sup>398</sup> S.C. Srivastava, Protecting the Geographical Indication for Darjeeling Tea, Managing the Challenges for WTO Participation, Deepi Kolady, William Lesser & Chinyue He, “The Economic Effects of Geographical Indications on Developing Country Producers (2011) 14:2 *WIPO Journal* 157. Geographical Indication of Goods (Registration and Protection Act) 1999, India.

<sup>399</sup> *Supra* note 284.

The United States strongly opposes the European Union's proposed claw back measures which, if effectuated, facilitate the exclusive use and ownership to 41 associated trade names to European producers.<sup>400</sup> Cost implications to producers posed by the potential loss of reputation and market access are central to its concerns, as domestic producers' right to use the product name would be forfeited.<sup>401</sup>

These contentions were between power structures which historically, use their influential positions to expropriate economic wealth<sup>402</sup> from the periphery. The arguments would be classed as non-meritorious if they were between the United States and least powerful peripheral groups.

Despite various proceedings, the Doha Round negotiations have reached an impasse, without any consensus on the resolution of these issues between the United States and other international actors.

### **3.5. Switzerland's approach to Geographical Indications**

Switzerland has emerged as one of the more influential international actors involved in supporting enhanced levels of protection internationally for agricultural and food based

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<sup>400</sup> WIPO/GEO/SFO/03/11 Geographical Indications and Trademarks, The Road from Doha; IP/C/W386; May Yeung and William Kerr, Are Geographical Indications a wise strategy for Developing Countries: Greenfields, Clawbacks and Monopoly Rents. (2011) 14 *JiPL* 353.

<sup>401</sup> *Ibid.*

<sup>402</sup> James Gathii, Neoliberalism, Colonialism and International Governance: De-centering the International law on Governmental Legitimacy (2000) 98 *Mich L Rev* 1996.

geographical indications.<sup>403</sup> Switzerland has used its relationship with the European Union to revamp its legislation<sup>404</sup> and thereby provide a more unified system of protection for GIs.<sup>405</sup> Its legislation outlays an extensive recognition for agricultural and food based geographical indications. This is not a mere coincidence. The Swiss government's incorporation of agriculture as a part of its Constitution sharply influenced its focus on developing its geographical indication platform to reflect its agricultural mandate.<sup>406</sup> Its mandate is focused on securing the terroir of agricultural products that is, sustaining the human and ecological factors which enable cultivation and sustenance of the product.<sup>407</sup>

Article 3 of Switzerland's geographical indications ordinance enumerates that a geographical indication is "used<sup>408</sup> to describe an agricultural product or a processed agricultural product" which "originating in that region, place or country and "which possesses a specific quality, reputation or other characteristics attributable to that geographical origin, and that is produced, processed or prepared in a defined geographical area".<sup>409</sup> Compliance with specific regulatory conditions is necessary if the

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<sup>403</sup> WTO TN/IP/W/12/Add.1.

<sup>404</sup> Article 3. SR 910.12, Ordinance on the Protection of designations of Origin and geographical indications for agricultural products and processed agricultural products. [Switzerland, "GI Article 3].

<sup>405</sup> *Ibid.*

<sup>406</sup> Switzerland's Agricultural Policy: Objectives, Tools and Mandates, (Available online at <https://www.cbd.int/financial/pes/swiss-pesagriculturalpolicy.pdf>, last visited September 27, 2016).

<sup>407</sup> *Ibid.*

<sup>408</sup> Switzerland, GI Article 3, *supra* note 403.

<sup>409</sup> *Ibid.*

agricultural product is to be protected under the regulation.<sup>410</sup> The geographical indication regime includes a central registration system which documents all agricultural based registered GIs.<sup>411</sup>

Rights based themes about ownership are also evoked in Switzerland's trademark law, which recognizes a *sui-generis* system of protection for geographical indications. The act prevents the use of agricultural goods that provides false or misleading indication to its geographical origin.<sup>412</sup> The Swiss government has used its geographical indications legal regime as a platform to establish more significant relationships with peripheral countries in which it has a GI interest.<sup>413</sup> Jamaica is one such country.

Switzerland has strategically aligned itself with state actors and non-governmental bodies<sup>414</sup> to further safeguard the ownership base of its agricultural and food-based geographical indications. I argue that this attempted transposition of its legal norms has

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<sup>410</sup> Article 2 of the Regulation notes the product must include: specific elements of the labeling; b. description of the distinctive shape of the product if it exists; c. elements relating to the packaging, if the applicant group can justify the packaging must take place in the geographical area defined in order to safeguard product quality and traceability or control.

<sup>411</sup> Switzerland Federal Office of Agriculture.

<sup>412</sup> Article 47(3) Is prohibited to use: (a). inaccurate indications of source; (b). designations may be confused with an incorrect indication of origin;(c). a name, an address or a mark in relation to goods or services from another source when creating a likelihood of deception, SR 232.11.

<sup>413</sup> Switzerland has formed bilateral treaties for the protection of geographical indications with other European countries: France, Hungary, Spain, Germany and Russia. Switzerland's Federal Institute for the Protection of Intellectual Property. (Available online at <https://www.ige.ch/en/about-us.html>, last visited October 14, 2016).

<sup>414</sup> These actors include the European Union, OriGIN, Jamaica and other countries within the African Caribbean Pacific group.

resulted in an imperialist strategy of influencing the formation of GI legislation in peripheral countries. Under WIPO's technical assistance mandate Switzerland has been instructive in the engineering of Jamaica's GI legislation.<sup>415</sup> This development later led on September 01 2014, to the signing of a bilateral treaty for the protection of Swiss based geographical indications in Jamaica.

### **3.6. The Lisbon Agreement as an Alternative Platform for Geographical Indication Protection**

This part of the chapter is a historical account of the negotiations that led to recent recognition of geographical indications under the Lisbon Agreement. In the paragraphs below I discuss the amendments that were proposed, the main enacted provisions of the new agreement, and implications for Third World countries.

Prior to May 21, 2015, the *Lisbon Agreement* provided protection and a system of registration for appellations of origin. Contracting parties of the Lisbon Union agreed to revise the Agreement, thereby providing extensive protection for geographical indications in member countries.<sup>416</sup> Compared to other main stream forms of intellectual property treaty, its membership base is substantially smaller. Most its member states are European.<sup>417</sup> A substantial portion of the amended provisions are similar to the European

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<sup>415</sup> Jamaica Intellectual Property Office, Geographical Indications Project: Jamaica and Switzerland.

<sup>416</sup> World Intellectual Property Office, "Negotiators Adopt Geneva Act at Lisbon Agreement Diplomatic Conference" May 20, 2015 (available online [http://www.wipo.int/pressroom/en/articles/2015/article\\_0009.html](http://www.wipo.int/pressroom/en/articles/2015/article_0009.html)).

<sup>417</sup> Of the 28 contracting parties to the Lisbon Agreement, there are 11 European countries. The other members of the Lisbon Assembly include 6 African countries, 4 Asian countries and 5 from the 'Americas': Cuba, Costa Rica, Nicaragua, Peru and Mexico. (Lisbon Union Assembly members: online,



Union's proposed amendments to Article 22.1 of *TRIPS*.<sup>418</sup> In this section, I critically analyze the implications of this for countries with GI interests.

The old *Lisbon Agreement* safeguarded designated geographical denomination<sup>419</sup> linked to a geographical region by a quality or characteristics, including "natural or human factors". The agreement defined such products as "appellation of origin".<sup>420</sup> The reference to "denominations" is not limited to a geographical place but, may include in its definition indirect designations associated with a country of origin.<sup>421</sup> The minimal membership to the *Lisbon Assembly Union* infers that there is non-interest by the broader intellectual property right community in joining the Union. Juxtaposed to the strong European representation on the *Lisbon Union Assembly*, there is only one Caribbean membership, that of Cuba.<sup>422</sup>

Suggested draft amendments to the Agreement were debated through WIPO with an interest in expanding its membership base, and as importantly, the content of its

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[http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&search\\_what=B&bo\\_id=11](http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&search_what=B&bo_id=11)).

<sup>418</sup> This is discussed earlier in the chapter (European Union's position on GIs in the Doha Round).

<sup>419</sup> Dev Gangjee, "The Appellation of Origin: Geographical Denomination" in Dev Gangjee *"Relocating the Law of Geographical Indications"*, *supra* note 302.

<sup>420</sup> Refer to discussion earlier in the chapter on the history and evolution of geographical indications.

<sup>421</sup> Gangjee, *supra* note 302 at 143-144.

<sup>422</sup> World Intellectual Property Office, *Lisbon Agreement*, [http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&search\\_what=B&bo\\_id=11](http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&search_what=B&bo_id=11); Geneva Act of the *Lisbon Agreement on Appellations of Origin and Geographical Indications*, (available online at [http://www.wipo.int/wipolex/en/treaties/text.jsp?file\\_id=370115](http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=370115), last accessed February 15, 2016).

coverage. I assert that based on the divergences in interests of the dominant actors engaged in the amendment proceedings, the proclivity to make recommendations is founded on non-altruistic reasons. That is, of influential GI countries advancing their own norm setting agenda within the international geographical indications debate. However, this does not trivialize the potential for the Third World to capitalize on the *Lisbon Agreement* as an aspect of a counter-hegemonic approach to the international GI discourse. Participants involved in transforming (or maintaining) the provisions of the *Lisbon Agreement* include influential non-member actors such as Switzerland, the United States, and the European Union. Notably, the convergence of interests between Switzerland and the European Union in the legal recognition of GIs is potentially beneficial in advancing the international recognition of a *sui-generis* GI jurisdiction. Both jurisdictions protect GIs on a *sui-generis* basis and, were influential in drafting provisions of the draft agreement.<sup>423</sup>

Differences in the domestic level of GI protection has manifested into international divergences in the type and nature of legal recognition of geographical indication.<sup>424</sup> The agreement enumerates that the basis of GI protection should be dependent upon either a “legislative or administrative act, a judicial decision or registration” in the geographical country of origin.<sup>425</sup> The influence of inter-governmental organizations in expanding the

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<sup>423</sup> Refer to the section above on the European and Switzerland’s approach to GIs.

<sup>424</sup> This point is discussed in section 4 (Geographical Indications).

<sup>425</sup> Article 28 (iii): any intergovernmental organization may sign and become party to this Act, provided that at least one member State of that intergovernmental organization is party to the Paris Convention and provided that the intergovernmental organization declares that it has been duly authorized, in accordance

scope of GI protection jurisdictionally is illustrated by the inclusion of these international actors in facilitating GI protection. This provision applies to the European Union, but requires the membership of at least one intergovernmental organization member country and a declaration of authorization from the body, before membership status is granted to intergovernmental organizations. Article 1 of the *Lisbon Agreement* lists intergovernmental organizations as legitimate contracting parties to the Agreement.

The greater significance of the amendment is in its implication for regions such as the Caribbean. There is insubstantial representation of the regional Caribbean (CARICOM)<sup>426</sup> in the international law of intellectual property right, and a striking absence of a regional coalition on the geographical indications debate. The amendments should represent a catalytic momentum for Caribbean countries, inclusive of Jamaica to capitalize from a unified regional coalition<sup>427</sup> in the promotion of regional GI interests.

The fundamental provision of the *Lisbon Agreement* which is favorable to Third World geographical interest is the recognition of an international protection for GIs, accorded through membership status. The essential caveat to this is, absent membership to the Lisbon Union Assembly, there is no mutual recognition of the GI unless protection

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with its internal procedures, to become party to this Act and that, under the constituting treaty of the intergovernmental organization, legislation applies under which regional titles of protection can be obtained in respect of geographical indications, Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications.

<sup>426</sup> Caribbean Community. This regional body is comprised of a group of 15 Caribbean countries, including Jamaica.

<sup>427</sup> Peter Yu, “*Building Coalitions*”, *supra* note 145.

already exists in the countries' legislation. As such, a contracting member of the Lisbon Union Assembly with a strong agri-based GI product(s) is more likely to benefit from its membership if its main GI export markets (countries) have also ratified the agreement. Also enumerated in the amendment is the stipulation that an internationally registered geographical indication is protected against a usurpation or imitation of its product and, protects against a false representation to the public of the product's origin. This provision mirrors the enhanced protection available to wine and spirit GIs under *Article 23 (1)* of *TRIPS*, and is intended to protect the reputation of well-known products. In addition, the strong bargaining leverage of the European Union in global geographical indication debates arguably influenced the inclusion of this provision in the amendment.<sup>428</sup>

Of importance in the amendments is the treatment of GI "genericity".<sup>429</sup> Pursuant to the revised *Article 12*, a geographical indication which has gained protection in a contracting state (via an intergovernmental organization), or through its national law cannot become generic and lose its legal protection. It provides *prima facie* autonomy between member states in resolving disputes over the genericity of a geographical indication.<sup>430</sup> In

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<sup>428</sup> Permanent Delegation Of the European Union to the UN Office and Other International Organizations in Geneva, "Q&A With The EU On The Benefits Of Amending The Lisbon Agreement", May 05, 2015 ([http://www.eeas.europa.eu/delegations/un\\_geneva/press\\_corner/all\\_news/news/2015/20150505\\_lisbon\\_en.htm](http://www.eeas.europa.eu/delegations/un_geneva/press_corner/all_news/news/2015/20150505_lisbon_en.htm)).

<sup>429</sup> The treatment of generic GIs in European case law is discussed below (Geographical Indications in the EU-Cariforum Agreement).

<sup>430</sup> *Lisbon Agreement*, Notes on Article 10, supra note 382

circumstances of contestation over an alleged generic GI, contracting parties may decide if the presumption is rebuttable,<sup>431</sup> based on their national interpretation of the law.

Earlier draft Lisbon revisions had suggested a generic moratorium period of 5 years during which a member country may continue to use the generic name.<sup>432</sup> This provision would have overshadowed the benefits of the agreement for many Third World jurisdictions. A geographical indication which is unable to gain legal protection in a member states' jurisdiction based on a moratorium on generic-ness is prevented from capitalizing from GI branding. The challenged posed by the ruling in the *Tea Board of India* case as earlier discussed strongly exemplifies the issue addressed in this argument.<sup>433</sup> The provision is no longer a part of the enacted agreement.

A significant hurdle for Third World countries imposed by the *Lisbon Agreement* concerns how best to resolve disputes of invalidity<sup>434</sup> or refusal<sup>435</sup> of registration by another contracting party to the Assembly. Upon the request for an international registration of a geographical indication, a notification is issued to contracting member states. Member states or interested parties, who oppose the registration, may file a

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<sup>431</sup> *Ibid.*

<sup>432</sup> Article 18. *Lisbon Agreement*, supra note 382.

<sup>433</sup> Supra note 361, *Tea Board of India*.

<sup>434</sup> Under the amendment, a GI cannot be deemed as invalidated without the holder of the right contested the grounds for invalidation. *Lisbon Agreement*, Article 21.

<sup>435</sup> An interested contracting party may refuse to recognize the legality of a GI based on its conformity with the GIs stated characteristics, or, on the basis of the party's national law. See Chapter 111, Rule 9, Declaration of Refusal; Text, Article 19 and 20.

petition for a “competent authority”<sup>436</sup> to issue a declaration of refusal for the GI.<sup>437</sup> Pursuant to the revised Lisbon text, a claim or defense of invalidity or refusal is initiated by the “competent authority”<sup>438</sup> of the member country, or by the competent authority on behalf of an interested party.

Lack of sufficient financial and legal resources obstructs the ability of small vulnerable<sup>439</sup> Third World societies to participate in successfully defending IP disputes.<sup>440</sup> Although a geographical indication cannot be invalidated without the right holder’s defense of its invalidity, resource constraints may prevent contestation over its use. The new Lisbon Agreement imposes a fee based system for the international registration of GIs.<sup>441</sup> Fees are payable for the registration, modification to, and extraction of information regarding GIs. For Third World communities with limited

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<sup>436</sup> Competent Authority is defined in the draft text as an authority notified in accordance with the regulations by a contracting party. In practical terms, this body may represent an agency mandated to monitor and regulate a jurisdiction’s IP legal affairs, such as an intellectual property office

<sup>437</sup> Article 15.1 *Geneva Act on the Lisbon Agreement on Appellations of Origin and Geographical Indications*, May 20, 2015, (available online [http://www.wipo.int/wipolex/en/treaties/text.jsp?file\\_id=370115](http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=370115), last accessed February 15, 2016).

<sup>438</sup> *Ibid.* A competent authority is defined in Article 3 as an entity that is responsible for the administration of the Lisbon Act in its territory, and for communications with the International Bureau under this Act and the Regulations. The Contracting Party shall notify the name and contact details of such Competent Authority to the International Bureau, as specified in the Regulations, Article 3.

<sup>439</sup> The term “small vulnerable state” is used to reference Caribbean countries which are import dependent, have significant levels of debt and whose “socio-economic” structures responds negatively to international pressures. The Growing Vulnerability of Small Island Developing States, (University of the West Indies Research Paper, Sept 20, 2002).

<sup>440</sup> Peter Yu, *Building Coalitions*, *supra* note 235. Also inferred in Ikechi Mgbeoji’s critique of TRIPS in Africa: “Mgbeoji, TRIPS and TRIPs Plus, *supra* note 196.

<sup>441</sup> *Supra* note 436, *Lisbon Agreement*, Article 7: Fees.

access to financial and legal resources, commitment to a fee based system, and the risk of refusal/invalidity of its GI registration may pose barriers to participating in the system.

Dispute resolution through the World Intellectual Property Office's Arbitration and Mediation Centre<sup>442</sup> may represent a comparatively cost effective means for contracting parties to contest an objection over an invalidation or refusal of a geographical indication registration. Interestingly, resort to this forum is not mentioned in the text. The ability of the Centre's decision to bind the contracting parties is dependent upon each country's willingness to incorporate the ruling in its national law. Based on power imbalances between the core and periphery in the international law of IP,<sup>443</sup> without strategic alliances, peripheral communities may experience challenges in enforcing favorable rulings on geographical indication registrations in the core's jurisdiction.

However, despite these potential barriers, the *Lisbon Agreement* is indicative of a changing trajectory in the legislative approach to the international intellectual property rights discourse on geographical indications. Much of its actual implication is dependent on the ability of Third World communities joining and having a substantial consumer presence in Lisbon Union countries. I discuss this latter point in Chapter 7. Envisioning the *Lisbon Union* as one solution to the failed Doha Round, means that fair and results-

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<sup>442</sup> World Intellectual Property Office Arbitration and Mediation Centre facilitate the resolution of intellectual property disputes between private parties.

<sup>443</sup> Mgbeoji, "Global Bio-piracy", *supra* note 196, Chidi Oguanaman, "Localizing Intellectual Property in the Globalization epoch, *supra* note 2. Margaret Chon, "Intellectual Property Divide, *supra* note 240; Ruth Okediji, *The International Relations of Intellectual Property: Narratives of Developing Country Participation in the Global Intellectual Property System* (2003) 7 *Sing J. of Intl & Comp L* 315.

based interactions between states, inter-governmental organizations and relevant social groups must transcend the hegemonic trend associated with the international laws of GIs. The extent to which this is possible is based on the power politics between dominant international actors and geographical indications interests in the Third World.

### **3.6. Examining Geographical Indications in Third World Societies: Approaches, Interests and linkages**

The Doha Round of Negotiations emerged as one the most influential platform for the evolution and transformation of norms governing geographical indications in the Third World. However, it failed. As a central international actor in negotiations, the European Union has used its position to influence the paradigm of policies associated with agri-based geographical indications in peripheral countries. Third World countries with agri-food products which are potentially capable of registration, increasingly envisage geographical indication as a base to exert a right to the ownership of their resources.<sup>444</sup>

Debates related to increasing the level of protection for geographical products has also manifested in the emergence of agriculture<sup>445</sup> as an important policy framework for advancing development. Regional and bilateral free trade agreements (RBFT) between

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<sup>444</sup> Sisule Musungu, The Protection of Geographical Indications and the Doha Round: Strategic and Policy Considerations for Africa (December 2008, IP Issue paper issue 8, Quno). Sigerio Escurdo, International Protection of Geographical Indication and Developing Countries (July 2001, Working Paper no.10, South Centre).

<sup>445</sup> C Bramley & JF Kirsten, Exploring the Rational for protecting Geographical Indications in Agriculture (2007) 46:1 *Agrekon* 1; Jorge Larson Guerra, Geographical Indications in Situ Conservation and Traditional knowledge (International Centre for Trade and Sustainable Development, Policy Brief 3); G E Evans, The Comparative Advantage of Geographical Indications and Community Trademarks for the protection of Agricultural Products (2010) 24 *YB Int'l* 224.



European and Third World countries are increasingly used to disseminate dominant norms regarding the scope and protection of agri-food GIs. The implications of this dynamism to re-configuring the global intellectual property order are examined in this section.

### **3.7.1. Assessing Third World Countries' Involvement in Geographical Indications Negotiations**

The failures of the Doha Round to re-configure existing international legislation on geographical indications has influenced the emergence of alternate structures for securing enhanced protection for agricultural products. Evoking rights based themes for enhanced legal protection of GIs is not new to contemporary debates. Efforts to increase the scope of protection for non-wine and spirit GIs were foremost amongst the interest of groups from peripheral countries in early attempts to revise the Paris Convention.<sup>446</sup> Power imbalances between states have constrained less influential peripheral countries from initiating amendments to GI legislation without the leadership of European countries.

Unsuccessful attempts have been made to address GI concerns in negotiations associated with the Agreement on Agriculture (AOA) in the Doha Development Agenda.<sup>447</sup>

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<sup>446</sup> I discuss this point in the section pertaining to the historical origins of Geographical Indications (above).

<sup>447</sup> Uruguay Round, Agreement on Agriculture is part of the WTO agreements. Its mandate is to establish a fair and market oriented agricultural trading system through negotiations. Articles 4-6 enumerate the rules and commitments governing the mandate of the AOA: Market Access, domestic support for products and export subsidies. [http://www.wto.org/english/docs\\_e/legal\\_e/14-ag\\_01\\_e.htm](http://www.wto.org/english/docs_e/legal_e/14-ag_01_e.htm). See also Carmen Gonzalez, Institutionalizing Inequality: The WTO Agreement on Agriculture, Food Security and Developing

Supporters of geographical indications extensions have sought to engage *Article 3* and *Article 20* of the AOA as grounds for the inclusion of GI negotiations within agricultural negotiations.<sup>448</sup> *Article 3*<sup>449</sup> enumerates a commitment to improved market access for agricultural products. A commitment to continued negotiations regarding the reform of agricultural policy is the focus of *Article 20*.

The European Union has spearheaded a broad-based interpretation of *Article 3*<sup>450</sup> to include the inability of agricultural and food based geographical indications to access consumer markets. It further articulates that this paradigm contradicts with the agreement's commitment to promoting a fair and market-oriented agricultural system. Since product differentiation based on origin is an integral feature of GIs, proponents argue that a usurpation of the GI brands in foreign markets prevent agricultural producers from securing market access.<sup>451</sup> Arguably, divergences in interests and identities amongst Third World states have polarized the agriculture debate on GIs to one of mere triviality. Intellectual property right issues have not been a focal point of debates in the

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Countries (2002) 27 Colum. J Env't l 433. Gonzalez argues that power asymmetries between core and peripheral countries in WTO negotiations facilitate the introduction of policies which favor agricultural producers in core states.

<sup>448</sup> Agricultural Negotiations: Geographical Indications Phase 3. [http://www.wto.org/english/tratop\\_e/agric\\_e/negs\\_bkgrnd21\\_ph2geog\\_e.htm](http://www.wto.org/english/tratop_e/agric_e/negs_bkgrnd21_ph2geog_e.htm); WTO TN/C/W52, July 2008.

<sup>449</sup> *Article 3*: Market access concessions contained in Schedules relate ... to other market access commitments as specified therein.

<sup>450</sup> *Supra* note 326.

<sup>451</sup> The EC's proposal for Modalities in the WTO Agriculture Negotiations.

agricultural negotiations of Doha. It is unlikely that an agreement which is focused on non-intellectual property right mandate can be an effective modality for changing the episteme of the dominant intellectual property narrative.

The absence of unanimous support for geographical indications extension in the WTO has resulted in a forum shifting of the debate to regional and bilateral free trade agreements (RBFTs). The European Union<sup>452</sup> and Switzerland have been the main international actors promoting the usage of RBFT agreements for the recognition of an enhanced protection for agricultural and food based geographical indications.

I maintain that 2 significant implications are associated with this paradigm. Firstly, the proliferation of RBFT agreements between the European Union and Third World countries far outnumber that which is initiated by the latter group. The European Union has strategically positioned itself as the dominant knowledge ‘cartel’<sup>453</sup> for the conceptualization and evolution of GI rights. The protection of its geographical indications in international markets forms a focal provision of these agreements. Based on the disproportionate number of geographical indications owned by EU states compared to other peripheral actors, it is strongly contended that the European Union’s

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<sup>452</sup> Although embattled by financial crisis, the European Union still remains influential in the formulation of international trade policies. The European Union has developed a knowledge niche market in the proliferation of ‘transformative’ GI norms to specific epistemic communities. Sophie Meuiner & Kalypso Nicolaidis “The European Union as a Conflicted Trade Power” (2006) 13 Journal of European Pub. Policy 906.

<sup>453</sup> Chidi Oguamanam, Managing Intellectual Property in global governance in Chidi, “Intellectual Property: Global Governance”, *supra* note 89.

interest in RBFTs further perpetuates imperialist interactions in intellectual property regimes. Absent a relevance to the ‘local’, the Third World will continue to utilize its domestic law to safeguard the proprietary interest of foreign firms.

The second point represents a counter-hegemonic approach to intellectual property rights law’s tendency to subjugate the ‘local’ through the inequitable application of its legal norms in the periphery. Without mutual recognition of GIs, a country is unable to safeguard the increased protection of agri-food products as GIs in foreign jurisdictions. Power<sup>454</sup> is strongly implicated in the ability of a Third World state to assert such claims. Without strong alliances with powerful countries, the likelihood of successfully executing an RBFT is minimal. RBFTs with the European Union is beneficial to Third World states only if the GI legislation is used to foster local production and increases in international consumer markets. Therefore, situating GIs as a counter-hegemonic approach to intellectual property necessitates a more constructive use of favorable RBFTs by Third World states. I will now examine the GI provisions in the EU-ACP agreement, with specific reference to EU-Cariforum Economic Partnership Agreement (Cariforum-EPA).

The Cariforum-EPA is segmented into seven agreements based on the geographical location of member countries.<sup>455</sup> The Caribbean was the first region to ratify the

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<sup>454</sup> Barnett and Finnermore, “Politics and Power, International Organizations”, *supra* note 184.

<sup>455</sup> The Eastern and Southern African Group, Caribbean Group (Cariforum), East African Community, South African Development Community, Economic Community of West African States, Communauté

agreement and it did so very quickly.<sup>456</sup> The agreement was ratified with minimal deliberation<sup>457</sup> on the applicability of intellectual property rights provisions to its local narrative. Neither were there any deliberations on implementing an ‘interim agreement’ with the European Union. The technical language of the provisions and the non-disclosure of information to civil societies for review, politically excluded the region from actively negotiating for more suitable provisions. Juxtaposed to the Caribbean region, most African countries proactively re-negotiated aspects of the agreement. This continues the unequal relationship between the Caribbean and the European Union, which is infused with power asymmetries which has its historical origins in its plantation slavery experiences. I make the argument that the Caribbean’s willingness to ratify the agreement was based on dynamic power imbalances<sup>458</sup> which has facilitated the idealization of western concepts<sup>459</sup> of intellectual property laws.

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économique et monétaire de l’Afrique Centrale (between the EU and Cameroon) and EU-Pacific states (Papua New Guinea and Fiji). <http://www.acp-eu-trade.org/index.php?loc=epa/>

<sup>456</sup> Norman Girvan, *A Fork in Road? The Effect of the EPA on the CSME* (University of the West Indies, Public Lecture 2008). Havelock R. Brewster, *The Anti-Development Dimension of the European Communities Economic Partnership Agreement* (Paper presented at Commonwealth High Level Technical Meeting, April 2008).

<sup>457</sup> *Ibid.*

<sup>458</sup> Frank, *International Legal System*, supra note 271.

<sup>459</sup> Koskenneimi, supra note 5; Okafor, *Newness, Imperialism and International Legal Order*, supra note 13, Antony Anghie, *The Evolution of International Law* (2006) 27 *Third World Quar* 739 [Anghie, “*The Evolution of International Law*”].

### 3.7.2. Geographical Indications in the EU – Cariforum Agreement

The EU-Cariforum<sup>460</sup> intellectual property provisions enumerate an extensive recognition of rights associated with non-wine and food geographical indications.<sup>461</sup>

There is an explicit reference to development concerns in the EU-Cariforum. Article 1(a) notes that an objective of the agreement is to contribute,

“to the reduction and eventual eradication of poverty, through the establishment of a trade partnership, consistent with the objective of sustainable development, the *Millennium Development Goals* and the *Cotonou Agreement*”.

Additionally, provisions should be interpreted to complement Caribbean countries development goals.<sup>462</sup> The interpretation and application of geographical indication legislation should also conform to Article 8 of *TRIPs*.<sup>463</sup> Article 8 denotes recognition of the normative scope of IPRs in peripheral countries, measures adopted “should promote the public interest in sectors of vital importance to their socio-economic ...development”.

Ratification of the EU-Cariforum agreement is impossible without signing of the *Cotonou Agreement* [*Cotonou*]. *Cotonou* incorporates a commitment to the protection of geographical indications into its mandate which theoretically, should influence the

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<sup>460</sup> Cariforum represents a group of 15 Caribbean countries: Jamaica, Antigua and Barbuda, Bahamas, Barbados, Belize, Dominica, Dominican Republic, Grenada, Guyana, Haiti, Guyana, St.Christopher and Nevis, St. Lucia, St Vincent and the Grenadines, Suriname and Trinidad and Tobago.

<sup>461</sup> Office Journal of the European Union, EU-Cariforum Economic Partnership Agreement L 289/14.

<sup>462</sup> Article 1(a)-1(f).

<sup>463</sup> Article 146, *supra* note 340.

application of GI provisions in the *EU-Cariforum agreement*. According to Article 46.1 of *Cotonou*:

*parties should* recognize the need to ensure an adequate and effective level of protection of intellectual, industrial and commercial property rights, and other rights covered by TRIPS including protection of geographical indications, in line with the international standards with a view to reducing distortions and impediments to bilateral trade.<sup>464</sup>

The agreement establishes that the protection of geographical indications should be governed by European Union rules, or by that of the Cari-forum member country. The protection is extensive and substantially represents a codification of EU's demands in the Doha Round. Pursuant to the agreement, a member state has an obligation to protect the misappropriation of a geographical indication.<sup>465</sup> Designations on products which wrongly purport to be associated with a geographic area and mislead the public are prohibited from use.<sup>466</sup> Similar prohibitions are placed on products which are used in a manner which constitutes unfair competition under *Article 10bis* of the Paris Convention.<sup>467</sup>

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<sup>464</sup> *Cotonou Agreement*, between the European Union and Caribbean countries. The Cotonou Agreement is a regional preferential trade agreement between the European Union and African, Caribbean and Pacific countries (European Commission, text of the Cotonou Agreement, <http://www.europarl.europa.eu/document/activities/cont/201306/20130605ATT67340/20130605ATT67340EN.pdf>, last accessed January 21, 2016).

<sup>465</sup> Article 145 B(2), *supra* note 460.

<sup>466</sup> Article 145 B(3), *supra* note 460.

<sup>467</sup> Article 10bis of the Paris Convention pertains to Unfair Competition. The provision enumerates a number of acts that contravene commercial practices and result in unfair competition (a) Any act of competition contrary to honest practices in industrial or commercial matters (b), all acts which of a nature creates confusion whatever with the establishment, the goods, or the industrial or commercial activities of a competitor, (c) the use of indications or allegations which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability of their purpose or the quantity of the goods. *Paris Convention for the Protection of Industrial Property, Article 10bis*.

Goods which are in the same class of product as the protected designation are prohibited from using the protected name, notwithstanding an indication of the products true origin. This prohibition applies despite the inclusion of the words “kind, type, style, imitation, method” or similar expressions.<sup>468</sup>

The EPA-Cariforum prohibits the protection of a geographical indication if the term is ‘identical’ to “customary common language” used to refer to goods in either the European Union, or Caribbean territories.<sup>469</sup> Generic names are therefore excluded from registration as they do not convey the true origin or unique characteristics of a product. Undoubtedly, this provision represents the transposing force of legal norms in the diffusion of norm-setting rules<sup>470</sup> to international actors. The European Union’s position on ‘genericity has informed the substantive content of the associated provision in EPA-Cariforum. For an analytic understanding of the term, I will discuss the European Union’s interpretation of a ‘generic’ product. This implicates Caribbean countries with geographical indication consumer markets in the EU. Genericity is important to geographical indication owners, as it safeguards the protected name by prohibiting its usage as a common language associated with other products.<sup>471</sup>

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<sup>468</sup> Article 145 B (3) (1)(3), *supra* note 460.

<sup>469</sup> Article C (3), *supra* note 460.

<sup>470</sup> Finnermore and Sikkink: “Norm Dynamics”, *supra* note 77.

<sup>471</sup> William Landes & Richard Posner, *Trademark Law: An Economic Perspective* (1987) 30 J T L & Pers 65, Teresa Scassa, “Section 7 of the Trade-marks Act” in Teresa Scassa, *Canadian Trademark Law*, (Markham: LexisNexis, 2010) 307-310.



Contestations over the meaning of ‘genericity’ are arguably more relevant for European countries based on the substantial number of names for which protection is sought in Cariforum countries. Article 3 of EC’s regulation 2081/92 denotes that generic names are un-registrable as geographical indications.<sup>472</sup> Generic names are used to define “the name of an agricultural product or a foodstuff which, although it relates to the place or the region where this product or foodstuff was originally produced or marketed, has become the common name of an agricultural product or a foodstuff.”<sup>473</sup> A product name is interpreted as generic based on three factors outlined in EC’s regulation. The first relates to the existing situation in the country of origin, and specifically the area of consumption.

The second factor considers the existing situation concerning the perception of the product in other member countries. The judicial interpretation of national or community law is final determinant of genericity. This legal conceptualization of a ‘generic term’ was primarily influenced by the contestation over the usage of the word ‘Feta’ cheese as a protected GI from Greece.<sup>474</sup> The EC court held that 2 correlated factors are integral in determining whether a product has become generic. The public’s perception is vitally important in determining whether a geographical indication has lost its connected

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<sup>472</sup> EC Regulation 2081/92, Article 3.

<sup>473</sup> *Ibid*, 3.1.

<sup>474</sup> *Federal Republic of Germany and Kingdom of Denmark v The European Communities* C465/02 and C-466/02. The EC court determined that the name Feta is a Greek designation which is not generic in any other member state as there was a strong association of the cheese with the relevant public, based on connotations linking legal, cultural and historical factors with its origin.

meaning with its country of origin.<sup>475</sup> Secondly, the labeling must convey to the consumer historical or cultural aspects of the product which must be strongly connected to its origin.

The dual protection of homonym geographical indications in both the EU and Cariforum countries is stipulated in EPA-Cariforum.<sup>476</sup> The basis for protection is based on ‘distinctions in practice between the geographical indication and the “homonym product” and the absence of false representation to consumers.’<sup>477</sup> This provision is potentially relevant to Caribbean countries which may have an interest in registering a product with an identical name to an EU product. Although the provision notes that challenges to homonym names should be guided by principles which ‘treat producers in an equitable manner’, it is the power configurations of the legal order which would influence this outcome.

A product is unable to be registered as a geographical indication in the European Union if its usage conflicts with a renowned trademark and is liable to mislead the public as to its origin. However, the same right is not accorded to new trademarks. Under the agreement, registration of a trademark is refused if it is identical or similar to a geographical indication.

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<sup>475</sup> *Ibid* at para. 22-57.

<sup>476</sup> Article 146 C(3), *supra* note 460.

<sup>477</sup> *Ibid*.

### 3.7.3. Geographical Indication Legislation in the Caribbean

The ratification of the EPA-Cariforum led to the enactment of *sui-generis* geographical indications legislation in 13 Caribbean countries.<sup>478</sup> The remaining Caribbean countries recognize the protection of geographical indications through trademark rights as certification or collective marks, or under consumer protection laws.<sup>479</sup> I assert that the potential of fostering the domestic registration of geographical indications products can be enhanced by the creation of a regional CARICOM body to administrate the governance of regional GIs.<sup>480</sup>

### 3.7.4. Jamaica's Geographical Indications Legislation

Jamaica's geographical indications legislation<sup>481</sup> (*the Act*) forms a base for transforming the ideological misconceptions associated with the dominant discourse on intellectual property rights. The argument should not be interpreted as dismissing the role of international actors and dominant local groups in constraining the development of a non-hegemonic approach to intellectual property right. However, the legislation acts as a

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<sup>478</sup> St. Christopher and Nevis: Geographical Indication Act 2007, <http://www.stkittsnevis.gov.kn/pdf/Acts/2007/200706.pdf>; Trinidad and Tobago, Geographical Indications Act <http://www.wipo.int/wipolex/en/details.jsp?id=3912>; Barbados, Geographical Indications Act 1998 <http://www.wipo.int/wipolex/en/details.jsp?id=330>; Antigua and Barbuda, Geographical Indications Act 2003; Dominica: Geographical Indications Act, 1998; St. Lucia: Geographical Indications Act 2000, St. Vincent and the Grenadines: Geographical Indications Regulation 2008.

<sup>479</sup> Bahamas introduced a bill in mid-September 2015 to enact its geographical indication legislation, K.Quincy Parker, "IP Bill Progress WTO Accession" *The Nassau Guardian*, (Sept. 21, 2015). (Available online at, <http://www.thenassauguardian.com/bahamas-business/40-bahamas-business/59323-ipbills-progress-wtoaccession>, last accessed October 30, 2015). Up to the time of writing, the bill had yet to become law.

<sup>480</sup> I further develop this argument in Chapter 8, the summary chapter of the thesis.

<sup>481</sup> *The Protection of Geographical Indications Act 2004*, Act 5-2004 [Jamaica, *Geographical Indication legislation*].

catalyst for engineering a practical broad based approach to paths to development, through linkages with agricultural products, alignment with influential epistemic communities on norm setting, a participatory network of key stakeholders. This section analyses Jamaica's geographical indication legislation and the country's association with the European Union and Switzerland in the shaping of its geographical indication policy.

Jamaica uses the same wording as *TRIPs* to define a protectable geographical indication.

Part 2 of the *Act* defines a geographical indication as:

an indication which identifies a good as originating in the territory of a country, 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>482</sup>

Agricultural goods are specifically recognized under the *Act* as registrable products:

“goods mean any natural or agricultural product or any product of industry or handicraft”.<sup>483</sup> The *Act* enumerates the general basis of protection of both non-wine and spirit GIs as well as wine and spirit geographical indications.

Goods which contravene the rights of a designated geographical indication by misleading the public as to its geographical origin, are prohibited from such use.<sup>484</sup> In addition, the use of designations about the origin of the product, which results in an act of unfair competition, is prohibited. The *Act* prevents the use of indications which misleads the

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<sup>482</sup> *Ibid.*

<sup>483</sup> *Ibid.*

<sup>484</sup> Jamaica *Geographical Indication Legislation*, *supra* note 481.

public the origin of the product by the use of expressions such as “kind”, “type”, “style”, “imitation”, or “comparable to” on the product.<sup>485</sup>

The *Act* protects against the use of designation which, although literally true as to its territory or origin falsely represents to the consumer that it originates in another territory. There is no definition of “unfair competition” in the Act. However, Article 37(1)a of Jamaica’s *Fair Competition Act*<sup>486</sup> is an essential cross reference which is implicated in an understanding of the rights conveyed by section 3(iii) of the Act. Article 37(1)a of *Jamaica’s Fair Competition Act* stipulates 37(1)a:

“A person shall not, in pursuance of trade and for the purpose of promoting, directly or indirectly, the supply or use of goods or services or for the purpose of promoting, directly or indirectly, any business interest, by any means— (a) make a representation to the public that is false or misleading in a material respect...”<sup>487</sup>

The *Fair Competition Act* is enforced administratively by Jamaica’s Fair Trade Commission (the Commission).<sup>488</sup> It is outside the scope of this thesis to engage in an analysis of the Commission’s cases. However, several of the Commission’s prosecution

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<sup>485</sup>*Ibid*, 3(ii).

<sup>486</sup> The Act was enacted in 1993 to combat anti-competitive practices in commercial transactions. According to Jamaica’s Fair Trade Commission, the objective of the Act, (i) Encourage competition in the conduct of trade and business in Jamaica, (ii) Ensure that all legitimate business enterprises have an equal opportunity to participate in Jamaica’s economy, and (iii) provide consumers with better products and services, and a wide range of choices at the best possible price: Ministry of Industry, Investment and Commerce, Fair Trading Commission. (available online [www.jftc.com](http://www.jftc.com), last accessed July 18, 2015).

<sup>487</sup> Jamaica, The Fair Competition Act, 1993 (available online [http://www.wipo.int/wipolex/en/text.jsp?file\\_id=214831](http://www.wipo.int/wipolex/en/text.jsp?file_id=214831), last accessed February 06, 2015).

<sup>488</sup> Jamaica’s Fair Trade Commission, Functions and Powers (online at <http://www.jftc.com/AboutUs/FunctionsAndPower.aspx>, last accessed February 06, 2015).

cases relate to misleading advertising practices, to which fines and other forms of penalties are imposed against violators.<sup>489</sup>

There is insufficient data available to assess the Commission's approach to unfair competition practices related to GIs. Violation proceedings of the Commission are buttressed by its use of the court system to initiate actions, and enforce penalties.<sup>490</sup> In terms of the affiliation between the *Fair Competition Act* and geographical indications, the primary concern will be the ability of the Commission to enforce section 37(1)a in a timely and effective manner against infringers.

Applications to register geographical indications can be made by a producer group<sup>491</sup> or, by a competent authority. Registration is restricted to producer groups that are carrying on business in the geographical area specified as the cultivation or production area of the product. Arguably, this aspect of the legislation reinforces the norms used to interpret the participatory aspects of a geographical indications, as it limits inclusion to specific groups. If there are no grounds of refusal, the registry provides the registrant with a geographical indication designation.<sup>492</sup> Grounds for refusal of geographical indication

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<sup>489</sup> Jamaica Government Report, "Ministerial Report For Fair Trade Commission on Performance for Financial Year 2008/2009. I was unable to obtain current data on the numbers of misleading advertising cases the Commission has dealt with for years 2010- present.

<sup>490</sup> *Ibid.*

<sup>491</sup> The *Act* defines a producer as, a producer of agricultural products, an exploiter of natural products, a manufacturer of products of industry or handicraft, or a person who deals or trades in agricultural, natural or handicraft products. Part 1(2). Interpretations.

<sup>492</sup> *Supra* note 463, Part 9.

designation include a challenge to the legal validity of the impugned product. As such, successful challenges on the linkages between the product and its origin, and compliance with regulations on codes of practice, are examples of legal validity issues that may cause registration to be refused.

Challenges to the registration of a product are also based on public morality or public order standards or, on procedural registration matters. Geographical indications that are not registered in its country of origin, or which have fallen into disuse are not protected. A certification of registration is issued once validity has been finalized. The registration enables geographical indication rights holder to “to use a registered geographical indication in relation to the goods so specified, if those goods possess the quality, reputation or other characteristics specified in the Register”.<sup>493</sup>

Trademarks which contain deceptive geographical information that will mislead the public as to the true origin of the product are either revoked or refused from registration.<sup>494</sup> This is facilitated on the request of an interested party or by the registrar. Remedies for infringement include injunctions, award of damages or any other remedy that the Court holds to be appropriate.<sup>495</sup>

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<sup>493</sup> Jamaica Geographical Indication Legislation, *supra* note 357.

<sup>494</sup> *Ibid*, Part 18.

<sup>495</sup> *Part 2. Section 3(2)*.

A striking feature of the act are the criminalization of geographical indication infringements. Offences are sanctioned by either monetary fines, or imprisonment for between 1-5 years. Up to the time of writing (February 15, 2106), one product is registered under the legislation; jerk seasoning. The actual impact of this recent registration has not been reported. I argue that more usage of the Act is required, with a targeted approach to agricultural and food based products that are likely to be success as intellectual property assets of development. Should a paradigm of low registration continue, Jamaica's trend of using domestic intellectual property rights legislation to protect foreign and elitist interest is perpetuated. I further discuss this argument in chapters 7 and 8.

### **3.7.5. Assessing the Linkages: Jamaica's Geographical Indication legislation, The EPA and Switzerland's Geographical Indications Policy**

Jamaica's membership to Cariforum facilitated its ratification of the EPA-Cariforum agreement. It is undeniable that its interest in formulating a geographical indication regulation in 2009 was influenced by its acceptance of the agreement.

More importantly, Jamaica has forged geographical indication alliances with powerful groups from core countries. Switzerland's relationship with Jamaica's intellectual property office is an instructive example of this trajectory. Under the auspices of WIPO's technical assistance mandate, the Swiss government has provided technical assistance<sup>496</sup> to Jamaica in the amendment of its geographical indication legislation and policy

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<sup>496</sup> Geographical Indication Project: Jamaica and Switzerland (Jamaica Intellectual Property Office).



framework. Rules defining and limiting the participatory aspects of GIs, the role of each institutional actors and the identification of potentially registrable products as geographical indications were all established through interactions with the Swiss state. Switzerland has always played an influential role in the proliferation of an intellectual property agenda which advanced its domestic interest. As far back as the late ninetieth century, its interests in intellectual property facilitated the emergence of a single administrative body for the Paris and Berne Conventions.<sup>497</sup>

Power dynamics between local stakeholders have arguably influenced the choice of sectors for geographical indications commercialization in Jamaica. Local elite producers and manufacturers have directed the debate to the registration of products which, though well known, are based on protecting the ‘brand’ in foreign markets. I emphasize this point because the hegemon’s ideological focus on the privatization of intellectual property rights continues to inform Jamaica’s perception of the value of intellectual property.

Therefore, although geographical indications engage concepts of social inclusion, they are still perceived as private rights that exclude others from its commercialization and benefits. Conceptualized as such, it is difficult to channel arguments of development to the ‘local’ through agricultural and food based geographical indications, without a re-

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<sup>497</sup> Arpad Bogsch, *The First Twenty Five Years of the Intellectual Property Organization from 1967 to 1992* (WIPO Publication no. 881. 1992).

orientation and re-configuration of the norms governing intellectual property rights in the Third World. State-citizen relations are also central to this re-configuration.<sup>498</sup>

### **3.7. Geographical Indications and Food Products: Development Linkages**

The association of geographical indications with agricultural and food based products have evolved to include broader themes of ownership and re-appropriation of intangible resources to Third World countries through intellectual property laws. Importantly, this presents opportunities for re-orientating the biased dimensions of intellectual property law to be more representative of Third World interests.

Efforts to increase the scope of protection for agricultural and food based geographical indications, and to recognize geographical indications as a singular and separate form of intellectual property have been partially successful. However, as my thesis posits, the challenge for the Third World is in attaining reciprocal recognition of geographical indication rights in international jurisdictions. The mere domestic registration of geographical indications is insufficient to project this paradigm.

The discussion below concerns the practical aspects of an agricultural and food based geographical indication scheme, which implicate and promote its usage as an asset of development in the Third World. My arguments recognize that there are constraints

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<sup>498</sup> Northover and Crichlow, “Size, Survival and Beyond”, *supra* note 98; Migdal, Strong States Weak States, *supra* note 277.

posed by international actors in non-reciprocal jurisdictions, and internal political and cultural dynamics that may affect actual outcomes.

### **3.8.1. Establishing Geographical Indications through Agricultural Initiatives**

The dominant themes espoused by the European Union geographical indications debates are primarily concerned with increasing and securing market access for agricultural and food based products.<sup>499</sup> This norm has shaped many Third World states' approach to the framing of their geographical indication policies. Safeguarding market access for products is impossible without product differentiation. This is especially relevant in consumer markets in which there are minute differences between products.<sup>500</sup>

Geographical indication neutralizes information asymmetry by providing consumers with more substantial information about the product's origin.<sup>501</sup> Consumers are usually more willing to pay a premium price for origin-based products.<sup>502</sup> Increasingly, many Third World communities have developed an interest in registering traditional agricultural and food based products as geographical indications. The growth of emerging and traditional agricultural and food sectors<sup>503</sup>, interest in knowledge

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<sup>499</sup> Sections 3.1-3.7.2, above.

<sup>500</sup> George Akerloff, "The Market for Lemons: Quality Uncertainty and the Market Mechanism", (1970) 84:3 *Quar J Econ* 488.

<sup>501</sup> See also Waseem Afazl and Daniel Roland, "Information Asymmetry and Product Valuation: An Exploratory Study", (2009) 35:4 *J of Info Sci* 192. Consumers are likely to value a product more if more information is available on product quality.

<sup>503</sup> Massimo Vittori, "The international debate on Geographical Indications: The Point of View of the Global Coalition of GI Producers" (2010) 13:2 *J W I P* 304; Felix Addor and A. Grazioli, "Geographical Indications Beyond Wines and Spirits, a Roadmap for a Better Protection for Geographical Indications"

preservation within Third World communities, and equitable income distribution for key stakeholder groups<sup>504</sup> are noted as the most relevant interests of Third World communities. However, the legal norms which govern the possibilities and limits of geographical indications are just as important in configuring a counter-hegemonic approach to its usage.

I will discuss three issues that are relevant to sustaining agricultural and food based products as geographical indications. The prospect of enhancing development through agricultural geographical indications<sup>505</sup> in Jamaica is impossible without the inclusion of this framework. These factors relate to product specification standards, income distribution amongst right holders, and the preservation of the agricultural product through re-cultivation and community support.

Another essential factor which is central to the configuration of geographical indications is the type of legislation used as rights' recognition, and the domestic jurisdiction's efficiency and ability to enforce its rights in international consumer markets. On this point, the establishment of *sui-generis* legislation for the protection of geographical indications is a more suitable platform for recognizing GI rights.

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(2002) 5:6 *J W I P* 865; Kal Raustalia & Stephen R. Munzer *The Global Struggle over Geographical Indications* (2007) 18:2 *Euro J Intl L* 336.

<sup>504</sup> *Ibid.*

<sup>505</sup> Giovanni Bellentti, Andrea Marescotti, Silvia Scaramuzzi, "Paths of Rural Development Based on Typical Product: A Comparison Between Alternative Strategies, (Available online [http://ifsa.boku.ac.at/cms/fileadmin/Proceeding2002/2002\\_WS04\\_07\\_Belletti.pdf](http://ifsa.boku.ac.at/cms/fileadmin/Proceeding2002/2002_WS04_07_Belletti.pdf)).

Geographical indications are registered as designations because the product possesses characteristics which augment its terroir features. Geographical indications schemes use a code of practice<sup>506</sup> to govern and stipulate its products quality. Codes of practice are regulations which delineate the territorial zone of production, and the acceptable methods of production.<sup>507</sup> Rules governing the techniques of production are important in justifying the linkage between its territory and the product.<sup>508</sup> The norms developed in this process are used to validate the protection and registrability of the product. I argue that this process may be either participatory or exclusionary, based on the involvement of epistemic communities in the construction of code of practice norms.

In instances where the code of practice is formulated solely by the state and elite producers, it is less representative of the knowledge of marginalized though integral stakeholders in the scheme. This is problematic. The knowledge used in the cultivation of the product originates from traditional practices in farming communities. The more involved farmers are in the construction of regulations, the greater are the implications

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<sup>506</sup> Angela Treagar et al, "Regional foods and Rural Development" (2007) 23:1 *J Rur St* 12. J.S. Canada & A. Vazquez, "Quality Certification, Institutions and Innovation in Local Agro-food Systems: Protected Designation of Origin of Olive Oil in Spain", (2005) 21:4 *J Rur St* 475.

<sup>507</sup> As an example, the Antigua coffee bean is cultivated in a particular area of Guatemala which is delimited by specific reference to altitude, soil and climatic conditions.(Available online at Antigua Coffee: [http://antiguacoffee.org/portal/index.php?option=com\\_content&task=view&id=12&Itemid=26](http://antiguacoffee.org/portal/index.php?option=com_content&task=view&id=12&Itemid=26)).

<sup>508</sup> An example of this practice is the production of South African's Rooibos herbal tea. Its product specification stipulates that Rooibos tea should only be cultivated in Fynbos biome, a specified winter rainfall elevated area in South Africa. The soil used in its cultivation should be deep and well drained, and can only be a derivative of a Table Mountain Sandstone.

for preserving the traditional modes of production.<sup>509</sup> In Third World spaces where there are stark social class contestations, elite groups are more influential in the formulation and amendments to specification standards.

Similarly, power asymmetries between countries may influence the adoption of new techniques of production based on new norm diffusion from hegemonic states and elite interests. Bowen's research on Mexico's Tequila<sup>510</sup> illustrates that involvement by international stakeholders in product specification process depletes product quality and adversely affects local farming interests. Product features related to its 'authenticity and quality' is compromised by the development of new norms<sup>511</sup> associated with production. Multinational manufacturers of Tequila in Mexico have engaged in various alterations in its product specification which have affected the interests of local marginalized farmers. These norms "neither define the quality of agave nor seek to maintain traditional practices". However, there is norm compliance by local producers

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<sup>509</sup> Chidi Oguanaman and Tesheger Dagne "Geographical Indications for Ethiopian Coffee and Ghanaian Cocoa" in Jeremy de Beer, Chidi Oguanaman & Tobias Schonwetter (eds), *Innovation and Intellectual Property, Collaborative Dynamics in Africa*, (South Africa: UCT Press, 2014) at 77-109. Oguanaman and Dagne note "In this sense, a GI promotes a dual dynamic of open access to knowledge and culture among a closed group of communities who comply with the communities' requirement for a culturally acceptable method of production in a restricted geographical boundary. Beyond their economic significance, GIs can also prevent cultural appropriation by ensuring that a product is associated with a defined geographical place where communities have established bonds between culture, ancestral lands, resources and the environment" at 81. [Oguanaman and Dagne, "*Ethiopian Coffee*"].

<sup>510</sup> Sarah Bowen, "Development from within? The Potential for Geographical Indications in the Global South" (2010) 13 *J Int'l P L* 231 at 241.

<sup>511</sup> *Ibid* at 243.

based on efforts to secure market access to international consumers, specifically the United States.<sup>512</sup>

Geographical indication products that are not well-known and supported in consumer markets<sup>513</sup> are incapable of generating adequate income for producer groups.<sup>514</sup> Since uses of designations are restricted to stakeholders within the producer group, it follows that income generated from its commercialization is allocated primarily to members of the group.<sup>515</sup> Case studies in Europe and African countries have shown marginal to substantial linkages between the geographical indication of agricultural and food based products and its retail pricing.<sup>516</sup>

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<sup>512</sup> Bowen, *supra* note 510.

<sup>513</sup> Bertil Sylvander, "Some factors of success for Origin Labeled Products in Agri-Food Supply Chains in Europe: market, internal resources and institutions", in Bertil Sylvander "The Socio-economics of Agri-food Supply Chains: Spatial, Institutional and Co-ordination Aspects" *INRA Actes Communications*. 2000. 171. Cerkia Bramley, Estelle Bienabe, and Johann Kirsten "The Economics of Geographical Indication" (WIPO Journal). Dimitri Skuras and Efthalia, "Regional Image and the Consumption of Regionally Dominated GI products, (2004) 41:4 *Urb S* 801.

<sup>514</sup> I refer to producer groups as social actors who are involved in the cultivation, manufacturing and distribution of the product. Estelle Bienabe & Dirk Troskie, *GI Case Study: Rooibos*, Siner-GI December 2007. Jorge Larson, *Relevance of Geographical Indications and Designations of Origin for the Sustainable use of Genetic Resources*, Global Facilitation Unit for Underutilized Species, 2007 [Larson, "'GIs and Sustainable Use of Genetic Resources'"]; Oguanaman and Dagne, *Ethiopian Coffee*, *supra* note 509.

<sup>515</sup> William A. Kerr, *Enjoying A Good Port with Clear Conscience: Geographical Indicators, Rent seeking and Development*, (2006) 7:1 *Est J Int'l L Pol* 1. This does not take into account the spill-over effects from the commercialization of GIs (Chapter 5 case study).

<sup>516</sup> Daphne Zagrofos, *Geographical Indications and Socio-Economic Development (Working Paper 3)* [Zagrofos, *Geographical Indications*]. Sisule Musungu, *The Protection of Geographical Indications in the Doha Round (Quino IP Issue Paper No. 8)* [Musungu: *Protection of Geographical Indications*]. Lennert Schubler, "Protecting Single-Origin Coffee" with the Global Coffee Market: The Role of Geographical Indications and trademarks (2009) 10:2 *Estey Cen J Intl T P* 149. Oguanaman and Dagne, "*Ethiopian Coffee*", *supra* note 509. Oguanaman and Dagne's research on Ethiopia's coffee illustrated a two-tiered pricing system. Coffee is sold either on the Ethiopian Coffee Exchange (ECX) or, by farming cooperatives and large scale growers directly on the international market. The latter produced a US \$.20 premium relative to coffee sold on the ECX (US \$2.01-\$2.02 per pound).

The direct socio-economic benefits of agricultural and food based geographical indications are based on its ability to adequately remunerate producers for the commercialization of the asset. The practices of Cambodia's Kampong Speu Palm sugar producer group<sup>517</sup> are an instructive example of the pattern of economic distribution that is possible within a producer group. Its producer group includes palm tree sugar farmers, individual collectors who purchase the sugar from the sugar farmers, as well as 4 local sugar distributors. The producer group includes a 15-member board to govern branding and product quality concerns. Increased consumer and producer awareness regarding the brand and the benefits of geographical indications designation have led to increases in the price, and sale volume of the sugar.<sup>518</sup>

Small-scale farmers encounter fundamental challenges with the production of their products.<sup>519</sup> These challenges create an obstacle to the cultivation and marketing of their produce.<sup>520</sup> Financial constraints experienced in obtaining resources for cultivation, and inability to access lucrative marketing channels, are fundamental flaws affecting rural agricultural subsistence in many Third World regions.<sup>521</sup> However, involvement in

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<sup>517</sup> Larson, "*GIs and Sustainable Use of Genetic Resources*, *supra* note 514.

<sup>518</sup> *Supra* note 380.

<sup>519</sup> In chapter 5, I discuss the difficulties experienced by small and medium scale coffee farmers in the cultivation of Blue Mountain coffee beans.

<sup>520</sup> *Ibid.*

<sup>521</sup> *Supra* note 390; Proposals on Agriculture WTO Negotiations on Agriculture Negotiating Proposal on behalf of Members of Caribbean Community (CARICOM). G/AG/NG/W/100, (Available online World Trade Organization, [https://www.wto.org/english/tratop\\_e/agric\\_e/negs\\_bkgrnd02\\_props\\_e.htm](https://www.wto.org/english/tratop_e/agric_e/negs_bkgrnd02_props_e.htm), last visited September 29, 2016).



agricultural and food based geographical indication enterprises may enable farmers to benefit from economies of scale, by reducing the costs incurred in crop cultivation and harvesting.<sup>522</sup> By joining the producer group, farmers may be able to purchase resources at a lower price, gain expertise in cultivation, and tap into marketing channels that were previously unreachable.<sup>523</sup>

The equitable distribution of income<sup>524</sup> is a fundamental challenge to the social ascent of marginalized stakeholders within the group. Because of the diverse socio-economic composition of the producer group, imbalances in power relations may influence the ability of marginalized members to attain better incomes from their product. In terms of hierarchy, this problem is likely to be experienced by small-scale farmers who, are at the lower end of the value chain, compared to distributors and manufacturers of the registered product. Despite the ‘inclusivity’ of geographical indications, actors may be excluded from participation in the scheme because of an inability to pay membership dues to producer groups.<sup>525</sup> I maintain that a strategic growth-centered approach for

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<sup>522</sup> Dwijen Rangenbar, “The Socio Economics of Geographical Indications – A Review of Empirical Evidence from Europe” UCTAD-ICTSD Project on IPRs and Sustainable Development, Issue Paper No. 8.

<sup>523</sup> William Van Caanegem, “Registered Geographical Indications: Between Intellectual Property and Rural Policy” (2003) 6:5 *J WIPO Pol* 699 at 705.

<sup>524</sup> Zagrofos, Geographical Indications, *supra* note 516; Musungu: “*Protection of Geographical Indications*”, *supra* note 516.

<sup>525</sup> *Ibid.* A Pacciani, G. Belletti et al, “The Role of Typical Products in Fostering Rural Development and the Effects of Regulation (EEC) 2081/92\_73<sup>rd</sup>”, Seminar of the European Association of Agricultural Economists.

agricultural and food based geographical indications as development policy,<sup>526</sup> requires a focus on fostering increased remuneration for lower-income stakeholders, through workable and accessible legal and social policy frameworks.<sup>527</sup>

A *sui-generis* geographical indications jurisdiction should be envisaged as a starting point in the re-engineering of the international law of GIs to enable practical development results in Third World communities. *Sui-generis* legislation provides a base for a “comprehensive”<sup>528</sup> domestic framework for the recognition of geographical indication rights. This regulatory framework usually enumerates the basis of protection<sup>529</sup>, the specific regulatory requirements for protection, and may contain administrative rules associated with safeguarding the right. As an example, Jamaica’s GI legislation is based on a *sui-generis* system.<sup>530</sup>

A *sui-generis* geographical indication system must also be relevant to its domestic jurisdiction. It must be accessible and (based on the extent of involvement by the state<sup>531</sup>)

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<sup>526</sup> See Escobar “Alternatives to Development”, *supra* note 87; Sally Shortall, “Are Rural Development Programs Socially Inclusive: Social Inclusion, Civic Engagement, Participation and Social Capital, Exploring the Differences” (2008) 24:4 *Journal of Rural Studies* at 457.

<sup>527</sup> This argument is further discussed in Chapter 6 analyses of integrating a geographical indication scheme as an intellectual property asset in the commercialization and management of Jamaica’s Blue Mountain coffee.

<sup>528</sup> Marsha Echols, “*Geographical Indications for Food Products*”, *supra* note 350.

<sup>529</sup> *Ibid*; Dev Gangjee “Relocating the Law of Geographical Indications” *supra* note 302.

<sup>530</sup> I discuss this point in the section above on Jamaica’s Geographical Indication legislation.

<sup>531</sup> For a discussion on this point, refer to Chapter 6 of the thesis.

proactive in defending GI rights in overseas jurisdictions. As Mgbeoji has persuasively posited in a critique of TRIPs legislation in Africa<sup>532</sup>, the implementation of intellectual property laws in the ‘local’ without its actual usage invalidates arguments on a correlation between intellectual property and development in the Third World. I use this critique to elucidate my argument. Non-usage of geographical indication legislation by domestic actors does nothing to advance its ‘emancipatory’ capabilities. Therefore, as a starting point, products which either command a premium price (or have the potential of commanding a premium price) should be registered under the legislation, and be incorporated into a workable geographical indication framework. Furthermore, the accessibility of the governance infrastructure to local producers and farmers is crucial. Exorbitant registration fees may pose a barrier to the use of the *sui-generis* system.

A significant obstacle to a sustainable *sui-generis* system is the inability of the state to assert and maintain infringement claims in foreign<sup>533</sup> jurisdictions, because of a lack of financial resources. Defending Italy’s Parma-based GIs in foreign jurisdictions cost over \$1million per annum.<sup>534</sup> Comparatively, under similar situations, a small-vulnerable<sup>535</sup> Third World state may lack the financial resources to defend its brand in overseas

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<sup>532</sup> Mgbeoji, “*TRIPS and TRIPS plus Africa*”, *supra* note 33.

<sup>533</sup> Giovanni Belletti & Andrea Marascotti, “GI and Social Economic Issues” (2006) Siner-GI Working Paper 2; Tim Josling, Daniele Giovannucci, “Guide to Geographical Indications” (International Trade Centre: Geneva 2009).

<sup>534</sup> Sebastian Broncolio, “Protecting Local Uniqueness and Identity: Tools to Protect Product Distinctiveness in the Global Economy”, (Conference Paper, Washington DC. 2007).

<sup>535</sup> *Supra* note 415.

jurisdictions. This poses constraints on the viability of an effective domestic geographical indication scheme.

The feasibility of advancing development policy through agricultural and food based geographical indications is dependent upon the following four factors. Firstly, the use of a *sui-generis* legislation regime for the registration and protection of geographical indications more aptly secures and safeguards its recognition. Secondly, national legal and institutional infrastructures must be proactive in administering geographical indications locally, and in enforcing the right against infringements in international consumer markets.

Thirdly, the product must be capable of attracting a premium price in international jurisdictions, especially in its main export markets. Finally, the international recognition of the agricultural and food based geographical indications as rights is essential, or, reciprocity of recognition between the domestic jurisdiction and its main exporting markets.

### **3.7. Chapter Summary**

The presence of active local representation in fostering a fair and equitable geographical indication system is as salient in its viability as the international legal infrastructure which supports geographical indication norms. Despite the lack of a unified international coalition on the legal recognition of geographical indications, there have been significant inroads in galvanizing and solidifying interest in a re-oriented geographical indications culture. The impasse in the Doha Round and continued disgruntlements over the revised

*Lisbon Agreement* are not indicative of an absolute dismissal of the importance of geographical indications to Third World communities. Neither should passivity by certain groups in the negotiation of more appropriate intellectual property provisions in free trade agreements implicating geographical indications be envisaged as a general backlash to the prospects of a counter-hegemonic framework. Envisioning agricultural and food based geographical indications as an intellectual property asset of development in the Third World is impossible without the integration of a reformist intellectual property right perspective into the domestic sphere of the 'local'. Furthermore, geographical indications legislation is of little use to Third World societies if domestic resources are not the central focus of the legislation, and its operation.

A paradigmatic shift in the international law of geographical indications to be more representative of Third world peoples' interests is feasible, but only through strategic coalition, and interest convergence amongst key actors. Emerging regional and international intellectual property forums facilitate either the re-engineering of geographical indication legal norms, or a perpetuation of the dominant hegemonic ideology associated with the current intellectual property order. As such, the inclusion of geographical indication protection under the revised *Lisbon Agreement* may reduce the power politics in this contested field.

In the next chapter, I focus on the jurisdictional approach to the protection of geographical indications in three international consumer markets, the European Union,

the United States and Japan. These jurisdictions are Jamaica's main consumer markets for the export of its Blue Mountain Coffee.<sup>536</sup>

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<sup>536</sup> The case study methodology is discussed in Chapter 1.

## **Chapter Four: Jurisdictional Approach to Geographical Indications in Japan, the United States and the European Union.**

### **4. Introduction**

In Chapter 3, I identified and analyzed the history of geographical indications and the main instruments of, and actors involved in geographical indications norm diffusion in international intellectual property sectors. I also conducted an analyses of Jamaica's geographical indication legislation, and the relationship between geographical indications, agriculture and development policy.

Chapter 4 engages in a jurisprudential analysis of the treatment of geographical indications in three countries - Japan, United States and the European Union. These jurisdictions represent the main international consumer markets for Jamaica's Blue Mountain coffee. The chapter illustrates how the jurisdictions engage with geographical indications. The success of agricultural and food based geographical indications in international jurisdictions is based on its ability to successfully counteract infringements, and the ability of right holders to negotiate for more amenable terms of protection for registered products. Geographical indications cannot be conceptualized as assets of development without its reciprocal recognition in the exporting jurisdictions' main consumer markets. The chapter also illustrates the power and politics of transnational capitalist classes in influencing the type of debates and policies governing agricultural and food based geographical indications.<sup>537</sup>

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<sup>537</sup> Koh, *supra* note 266.

Currently, Blue Mountain Coffee is registered as a collective mark under Japan's trademark law, and as a certification mark in the United States and Europe.<sup>538</sup> Japan is the main consumer market for Jamaica's Blue Mountain coffee, with the United States and Europe being the second and third largest consumers respectively. In the 2012/2013 financial period for Jamaica's coffee exports, 74% of its Blue Mountain coffee beans were exported to Japan; a slight decrease over the previous period. Over the past decade, Japan has accounted for 81% of the country's Blue Mountain coffee export.<sup>539</sup>

The chapter is divided into three main sections with various sub-sections. Each segment critically discusses the legislative and judicial approach to geographical indications in a specific jurisdiction. The first part discusses the various legislation in Japan which accord protection to geographical indications. Japan recently enacted a *sui-generis* system for the registration and protection of geographical indications. However, I have chosen to discuss Japan's treatment of origin based goods under its trademark law, as Jamaica's Blue Mountain coffee is registered as a trademark in Jamaica. Reciprocity of recognition between both countries would require the registration of Blue Mountain coffee as a geographical indication in Jamaica. There are also provisions under Japan's *Unfair Competition and Prevention Act* and the *Unjustifiable Premium and Misrepresentation Act* which may safeguard the interest of foreign right holders.

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<sup>538</sup> "Buruumauntenkoohi", Blue Mountain Coffee, Japan, live.

<sup>539</sup> Interview with the Coffee Industry Board. These statistics are discussed more extensively in Chapter 6.



The second main segment of the chapter analyzes United States' legislation which foreign geographical indication rights holders may register and protect their products. As such, the section engages in a critical analysis of the legislative and judicial treatment of certification marks in the United States. The chapter ends with an analysis of European Union's regulation on agricultural and food based geographical indications, a very extensive scheme which the jurisdiction developed and uses for domestic and global dominance in the projection and safeguard of its rights.

#### **4.1. Japan**

##### **4.1.1. Geographical Indications in Japan: Recent Developments**

Japan passed its Geographical Indication legislation (*the Act*) in June 2014,<sup>540</sup> and enacted the Act in June 2015. The relevance of the European Union's geographical indications legislation transcends beyond its region. Its influence in the drafting of Japan's legislation is illustrated in its content, which is closely aligned with the European Union's focus on promoting agricultural development through its GI legislation.

Since 2001, Japan and the European Union were involved in trade discussions, aimed at fostering trade and investment between both countries.<sup>541</sup> In 2013, trade discussions culminated in a focus on developing a free trade agreement between Japan and the

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<sup>540</sup> Act for Protection of Names of Designated Agricultural, Forestry and Fishery Products and Foodstuffs, Japan, (Available online, Ministry of Agriculture, Forestry and Fisheries, <http://www.maff.go.jp/e/>, last accessed September 29, 2016).

<sup>541</sup> Chronology of EU-Japan relationship, Delegation of the European Union to Japan website (<http://www.euinjapan.jp/en/relation/chronology/> last accessed March 31, 2015).

European Union.<sup>542</sup> The protection of intellectual property rights is one of the major provisions of this agreement, including the promotion and safeguard of geographical indications in both countries. Negotiations are ongoing.<sup>543</sup> However, it is interesting to note that Japan, like its European Union trading partner, pinpoints an interconnection between the protection of geographical indications, and the promotion of agricultural reform in its economy. Japan's Prime Minister Shinzo Abe, has identified this strategic focus on brand development in his 'Abenomics'<sup>544</sup> revitalization plan of 2014. The *Act* is part of Japan's government Revitalization strategy,<sup>545</sup> which has as its objective engineering new insights and initiatives into fostering growth in its economy, inclusive of through agricultural, forestry and fishery industries, all of which are protectable as geographical indications.

The bilateral free trade and economic partnership agreement between Japan and Switzerland is also germane in analysing the changed stance of Japan on the enactment

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<sup>542</sup> Official announcement of [launch of negotiations](http://ec.europa.eu/archives/commission_2010-2014/president/news/archives/2013/03/20130325_2_en.htm) for Economic Partnership and Free Trade Agreements between the European Union and Japan, European Commission website, [http://ec.europa.eu/archives/commission\\_2010-2014/president/news/archives/2013/03/20130325\\_2\\_en.htm](http://ec.europa.eu/archives/commission_2010-2014/president/news/archives/2013/03/20130325_2_en.htm), last accessed March 31, 2015).

<sup>543</sup> EU-Japan 9th Round of Trade talks further Consolidates Negotiation Texts, February 27, 2015, European Commission website (<http://trade.ec.europa.eu/doclib/press/index.cfm?id=1267>, last accessed March 31, 2015); EU-Japan FTA – Opportunities and Challenges, Cecilia Malmstrom, European Commissioner Speech, March 13, 2015.

<sup>544</sup> The economic plan is so termed after his last name.

<sup>545</sup> Japan's Revitalization Strategy, 2014, Japan's Challenge for the Future (available online <http://www.kantei.go.jp/jp/singi/keizaisaisei/pdf/honbunEN.pdf> last accessed March 30, 2014).; Speeches and Statements by the Prime Minister, Policy Speech by Prime Minister Shinzo Abe to the 189<sup>th</sup> Session of the Diet, February 12, 2015 (available online [http://japan.kantei.go.jp/97\\_abe/statement/201502/policy.html](http://japan.kantei.go.jp/97_abe/statement/201502/policy.html) last accessed April 07, 2015).

of geographical indication laws. Japan and Switzerland signed the bilateral free trade agreement in 2009. The agreement includes extensive provisions on the reciprocal recognition of geographical indications in both countries. *Article* 119(2)a defines a geographical indication as:

“indications which identify a product as originating in a Party, or a region or locality in that Party, where a given quality, reputation or other characteristic of the product is essentially attributable to its geographical origin.”<sup>546</sup>

Similar to European Union’s council regulation on geographical indications,<sup>547</sup> the *Act* makes specific reference to the promotion of agriculture as a main component of its geographical indication mandate. *Article* 1 makes reference to the *TRIPS* mandate for the protection of intellectual property right in member countries. The section further stipulates that the purpose of the *Act* is to promote the protection of the interests of specific agriculture, forestry and fishery production in the country. The term specific agriculture refers to “agricultural produce and food whose production area is a specific place, region or state, and its given quality, reputation or other characteristics is essentially attributable to the production area”.<sup>548</sup>

The agreement goes beyond the minimum protection mandated by *TRIPS* for geographical indications. In addition to provisions specifying the obligation of both

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<sup>546</sup> Bilateral Free Trade and Economic Partnership Agreement Between Japan and the Swiss Federation (available online <http://www.mofa.go.jp/region/europe/switzerland/epa0902/agreement.pdf> last accessed March 31, 2015).

<sup>547</sup> EC Council Regulation 1151/2012 - European Economic Community Council Directive, *supra* note 542.

<sup>548</sup> Definitions, *supra* note 540.

countries to prevent infringements caused by the use of the indication to mislead the public as to its origin, each contracting party should provide enhanced protection for geographical indications. As such, each contracting party to the bilateral free trade agreement should ensure that geographical indications are not used on products, even if its true origin is indicated, or used in association with such terms as “kind”, “type”, “style”, “way”, “imitation” or “method”. The agreement provides significant safeguard against product infringement for rights holders.

The substantive component of Japan’s geographical legislation is manifested in its definition of “specific agricultural and marine products”, which is referenced in section 1(3) of the *Act*. Specific agricultural and marine products refer to goods which are grown or manufactured in a specified location and production area, and whose characteristics are attributed to that area.<sup>549</sup> A geographical indication is then defined as the display of names associated with specific agricultural and marine products, as detailed in the *Act*.<sup>550</sup>

The enactment of Japan’s geographical indications legislation is welcoming news for Jamaica’s Blue Mountain coffee stakeholders who have an interest in the geographical indications registration of its coffee. Japan is the major export market for Jamaica’s Blue Mountain coffee. The reciprocal enhanced recognition for geographical indications is an essential enabling factor in promoting GIs as assets of development. Therefore, the shift

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<sup>549</sup> Definitions, *supra* note 540, s.1(2),(3).

<sup>550</sup> *Supra* note 540, s 1(4).

in Japan's perspective is commendable, as it creates an intellectual property environment that is more conducive for the recognition of Jamaican geographical indications in its consumer markets. Prior to advanced trade associations with the European Union and Switzerland, Japan's scant interest in advancing GIs internationally was apparent in its alignment with the United States in only supporting a World Trade Organization notification system for the registration of geographical indications. Such a perspective potentially constrains the proliferation of legal norms and discussions which aim to advance the enhanced recognition of agricultural and food based geographical indications internationally.

In the segments below I engage in a critical discussion on the various legal provisions under which country of origin goods or GI based goods are currently protected in Japan.

#### **4.1.2. The Unfair Competition and Prevention Act**

Although Japan has been a signatory to the Paris Convention since 1899, there was minimal interest<sup>551</sup> in implementing specific legislation which dealt extensively with unfair competition until 1934. This paradigm was also noticeable in Japan's attitude<sup>552</sup> to the ratification of other forms of intellectual property right treaties which incorporated provisions on unfair competition, specifically the *Madrid Agreement on the Repression*

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<sup>551</sup> Christopher Heath, *The System of Unfair Competition Prevention in Japan*, (London: Kluwer Law, 2001) at 3. Heath undertakes an in-depth analysis of the legislative history of Japan's Unfair competition laws. [Heath, "Unfair Competition Prevention, Japan"].

<sup>552</sup> *Ibid*; See also Christopher Heath "Inventive Activity, Intellectual Property and Industrial Policy" in Wilhelm Rohl (ed) *History of Law in Japan since 1868* (The Netherlands: Koninklijke Brill, 2005) at 452-485.

*of False or Deceptive Indications of Source on Goods.*<sup>553</sup> At the beginning of the twentieth century, Japan's perception of the interplay between economic progression and intellectual property right for countries in the infancy stages of economic progression influenced its unwillingness to implement substantive legislation on unfair competition.<sup>554</sup> The widely held view was that the imitation and copying of foreign products was permissible as means of attaining industrial and economic advancement.<sup>555</sup>

Japan's *Unfair Competition and Prevention Act (Unfair Competition and Prevention Act)* was implemented in 1934 amidst pressure from member states of the Madrid Agreement.<sup>556</sup> Initially, the act provided minimal safeguard against infringements associated with the misleading use of indications, and restricted its applicability to the intentional and deliberate use of the disputed indication.<sup>557</sup> Minimal litigation is based on this legislation. More importantly, protection under the *Act* is restricted to "well known marks".<sup>558</sup> Subsequent amendments were made to the *Act* in 1993 and 2003, which

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<sup>553</sup> Article 1 of the Madrid Agreement for the Repression of False or Deceptive Indication of Source on Goods mandates (within member countries) for the seizure of goods (upon importation) which portray a false or deceptive indication directly or indirectly of the place or country of origin of the goods. Madrid Agreement on the Repression of False or Deceptive Indication of Source, Article 1, (Available online, World Intellectual Property Office, [http://www.wipo.int/treaties/en/text.jsp?file\\_id=286779](http://www.wipo.int/treaties/en/text.jsp?file_id=286779), last accessed October 14, 2016).

<sup>554</sup> G. Rahn, *The Role of Industrial Property In Economic Development: The Japanese Experience* (1983) 14 *IIC* 442.

<sup>555</sup> *Ibid.*

<sup>556</sup> Heath, "*Unfair Competition and Prevention*", *supra* note 551.

<sup>557</sup> *Ibid.*

<sup>558</sup> *Unfair Competition Prevention Law*, Law no. 47 May 9<sup>th</sup> 1993 last. amended 2003. Article 2(i) and 2(ii).

broadened the scope of protection for indications of source. Of these amendments, one is of substantial importance to the arguments made in this section: a less restrictive interpretation is given to the meaning of specific terms used in denoting the scope of protection available under the act. I will elaborate on this point in the discussion below.

The scope of my analysis on the *Unfair Competition and Prevention Act* is restricted to provisions related to the use of an indication of goods or “indication” in a manner which causes confusion amongst consumers. Provisions pertaining to trade secrets are outside the scope of this thesis. The applicable provisions which this section is concerned with are governed by Article 2(i), 2(ii), 2 (iii).

In order for an act to be rendered an ‘unfair competition’, Article 2(i) enumerates *inter alia* that the act must have caused confusion with “another person’s goods or business”.<sup>559</sup> Japan’s Supreme Court provides a broad based interpretation to this particular section of the provision. Acts that result in confusion are not limited to those in which a person uses a mark that is similar or identical to that of another business which is involved in competitive endeavors.<sup>560</sup> An act will be also be confusing if the person, though engaged in a distinctively different business activity, uses a similar or identical

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<sup>559</sup> *Ibid.*

<sup>560</sup> *Chanel SA v Shizuko Sugimara*, Hanrei Jiho No. 1655. (Supreme Ct); *Koso v Jokoku* Hanrei Jiho No. 1119:34; *Kirin Brewery Co. v Liner Beer Co.* Hanrei Jiho No. 414:29 (Supreme Ct).

well known mark of a company which lead consumers to assume that there is an existing affiliation between both businesses.<sup>561</sup>

The act defines an “indication of goods” and an “indication” as a name connected with a person’s business, trade name, trademark, mark, container or package of goods or any other indication used for an indication of goods or business. Japanese jurisprudence has interpreted an “indication of source” or an “indication” as a sign, name or symbol which distinguishes<sup>562</sup> a product from another, and has been widely accepted by consumers as a distinguishing characteristic of product differentiation. In a case concerning allegations of the use of a plaintiff’s sampling tube product configuration<sup>563</sup>, the Osaka District Court ruled that an indication of source has an “objectively outstanding characteristic that cannot be found in other goods of the same type”.<sup>564</sup>

A more detailed interpretation of an indication of source was established in another Osaka District Court ruling involving the alleged mis-use of the plaintiff’s eye glass toupe configuration by the defendant corporation.<sup>565</sup> In dismissing the plaintiff’s claim that the defendant used an identical eye glass configuration in its product, the court noted that a product configuration can be regarded as identifying the source of goods if its

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<sup>561</sup> *Ibid*, Chanel SA v Shizuko Sugimara.

<sup>562</sup> 2010 (Wa) 41231; 2003 (Wa) No. 12778 (Osaka District Court, Civil Division); 2005 (Wa) No. 11055 (Osaka District Court civil division; 2007 (Wa) No. 1688; 2005 (Ne) No. 10034.

<sup>563</sup> 2005 WA. 11055 (Osaka District Court, civil division).

<sup>564</sup> *Ibid*.

<sup>565</sup> 2010 (Wa) 41231.



features are distinctly unique compared to other products. Secondly, changes to product designs will not affect its designation as an indication of source, if there is a “common configuration with a unique feature” between both versions of the product. However, this commonality must be distinguishable from other similar products, and must be widely accepted by consumers as a mark of product differentiation.

In order for the act to apply, the product must not only incorporate an indication of source but, must also be a well-known or famous mark. The reference to well-known marks is specifically enumerated in Article 2(i). Article 2(i) stipulates:

the act of causing confusion with another person’s goods or business by using an indication of goods or other indication which is either identical or similar to another person’s indication which is well known amongst consumers or purchasers... constitutes unfair competition.<sup>566</sup>

The reference to well-known or famous marks is interpreted in Japanese jurisdiction to be a name or symbol which is widely publicized, known and accepted by the public and consumers as associated with a product.<sup>567</sup> It is therefore a mark that signifies consumers’ identification of a product, by associating the product with a name or symbol.

In an unfair competition litigation<sup>568</sup> involving the wrongful use of the plaintiff’s eyeliner packaging, the Osaka court upheld the plaintiff’s claim on the basis that its

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<sup>566</sup> *Supra* note 558.

<sup>567</sup> 2011 (Gy-ko) 10436, 2007 (Wa) 1688).

<sup>568</sup> *Hugo Boss AG v Boss* 2007 (Wa) 1688.

product constituted an indication of source that was a well-known mark. The basis for this ruling was the expansive advertising coverage of the product in the media, its acceptance amongst female consumers as the packaging indicative of the product's brand, and its astronomically significant sale numbers. Well-known marks are also validated as such by the number of years in which the product has been in existence, and is accepted by consumers as a mark which is associated with a particular product.<sup>569</sup> The mark must have a territorial market presence to be protected under the act.

Article 2(xiii) is potentially of significant importance to owners of geographical indications. Although this section of the act does not refer to geographical indications, it implicates the misleading use of a place of origin on a product as an act of unfair competition. Pursuant to Article 2(xiii), "the act of indicating on goods in a manner which is likely to be misleading with respect to the place of origin, content, quality or manufacturing process" constitutes unfair competition. Furthermore, assigning or delivering products containing misleading place of origin information, the display, export or importation of such products, are also indicative of unfair competition.

The next sections discuss Japan's trademark jurisprudence for products that are not recognized as geographical indications in their country of origin, such as Jamaica's Blue Mountain coffee.

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<sup>569</sup> *Hangkyu Corporation v Hangkyu Jukatu Co Ltd.* 2011 Wa 15990.

#### 4.1.3. Scope of Trademark<sup>570</sup> protection: “Use” provisions

The *Act*<sup>571</sup> defines a trademark as any character, sign, or three-dimensional shape or a combination of these three specifics which is “used in connection with the goods of a person”<sup>572</sup> who produces, certifies or assigns the goods as a business. The reference to “use” is also extended to the use of the trademark in connection with the services<sup>573</sup> of a person who provides or certifies the services as a business. Pursuant to Article 2(iii), there are various grounds which indicate that a mark is “used” in a manner to satisfy its registrability as a trademark.

For the purposes of this analysis, these acts include affixing “the mark to goods or packaging of goods”<sup>574</sup>, and “to display or distribute advertisement materials, price list or transaction documents to which the mark is affixed”<sup>575</sup>, inclusive of through electromagnetic device. Actual as well as intended “use” is an acceptable criterion for trademark registration. In order to be ‘registrable’ there must be a bona fide intention to use the trademark in the future. As Japan’s Intellectual Property High Court<sup>576</sup> has

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<sup>570</sup> For a history of Japan’s trademark act see Kazuko Matsuo, “The New Japanese Trademark Law” (1963) 53 *T Rep* 118; Kenneth L. Port, *Trademark and Unfair Competition Law and Policy*, (North Carolina: Carolina Academic Press, 2007).

<sup>571</sup> *Trademark Act*. Law No. 127 of 1959 as amended Act. No. 55. 2006 [“Trademark Act, Japan”].

<sup>572</sup> *Ibid.* Article 2.

<sup>573</sup> *Trademark Act*, Japan, Article 2(ii), *supra* note 571.

<sup>574</sup> *Trademark Act*, Japan, Article 2(3i), *supra* note 571.

<sup>575</sup> *Ibid.*

<sup>576</sup> 2009 (Gyo-ke) 10354 (HC, 4<sup>th</sup> division).

attested, the depiction of a trademark on a newsletter or website also constitutes “use”, if the mark shown is a direct depiction of that which is associated with the actual product. Therefore, an e-newsletter or website which depicts an advertisement of a catalogue of goods in a manner that creates a specific relationship between the trademark and the designated goods is envisaged as falling within the ‘use’ parameters of Article 2 and 3(viii).<sup>577</sup>

From an analytical perspective, the ‘use’ provision denoted in Articles 2 and 3 is more aptly understood in conjunction with Article 50 (1). Article 50 (1)<sup>578</sup> provide grounds for the rescission of a trademark if it has not been used in connection with a designated good or service for 3 consecutive years. There is a caveat to this provision that enables the trademark to be validated, if used by the rights owner within 3 years of the registration<sup>579</sup> date of the trial requesting the rescission of the trademark. It is possible for the trademark to be validated if the right owner uses a trademark during the three years preceding the request for requisition, which is deemed identical to the registered trademark.<sup>580</sup>

Japanese jurisprudence has provided the following interpretation on the ‘use’ requirement that satisfies the ‘validation’ of a trademark. A right owner’s trademark that is displayed and depicted on a registered good in similar manner to that used to register

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<sup>577</sup> *Ibid*, p.2.

<sup>578</sup> *Trademark Act*, Japan, Article 50(1), *supra* note 571.

<sup>579</sup> *Trademark Act*, Japan Article 50(2), *supra* note 571.

<sup>580</sup> 2011 (Gyo-Ke) 10243 (HC 2nd division).

the mark is satisfies the ‘use’ provision, and is a valid trademark. In a High Court case involving the invalidation of the defendant’s non-exclusive license to use a trademark depicting strawberries on its packaging, it was held that minute differences between the registered mark and that used on the defendant’s packaging, did not prevent the trademark from being “used” in the course of business. This finding pre-supposes that the product remains distinguishable; that is, customers can differentiate the product from that of others, and determine the source of the goods. Secondly, validating a trademark as being used in this circumstance also implies that the mark is substantially identical to the original characters/symbols used to register the trademark.<sup>581</sup>

#### **4.1.3.1. Registrable Trademarks**

Articles 3 and 4<sup>582</sup> enumerate the scope of trademarks that are capable or incapable of use in connection with goods. Only specific provisions applicable to the analyses in this chapter will be discussed. Similar to other jurisdictions,<sup>583</sup> a trademark cannot represent the “common name” of a good or service, or that which is normally used to describe a good or service.<sup>584</sup>

The Supreme Court has interpreted the term “common name” as one which is generally recognized or associated with a good or service. It follows therefore that generic

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<sup>581</sup> See below for a discussion of this aspect of the registrability of trademarks in Japan.

<sup>582</sup> *Trademark Act- Japan*. Article 3 and Article 4, *supra* note 571.

<sup>583</sup> Example of these jurisdictions are the United States and the European Union.

<sup>584</sup> *Trademark Act-Japan*. Article 3(i) and Article 3(ii), *supra* note 571.

names<sup>585</sup> are not registrable as trademarks. In determining the “generic-ness” of a name, Japanese case law<sup>586</sup> has noted the following. A name is deemed to be common and unregistrable as a trademark if it is in common usage amongst consumers and manufacturers (inclusive of competitors). As such, it is impossible to conclusively identify any significant level of ‘distinctiveness’ in the product name. Common usage may also be decided by evaluating the historical economic and societal background which existed during the period of usage, and the relationship between the proposed name and the goods. The nature of the business which manufactures or produces the good is also important. If the product name is marginally common, and emanates from an industry which has no direct meaning or relationship with the industry, it is likely to be envisaged as generic, and denied registration as a trademark.

A registrable trademark must also be ‘distinguishable’<sup>587</sup> and enable consumers to differentiate the client’s product from that of its competitors. In order to be classified as “distinguishable”, the trademark must be of a unique or peculiar shape or name<sup>588</sup>, possess distinct<sup>589</sup> characteristics which, combined with the product itself creates a level of differentiation from that of its competitors’ product. Furthermore, the shape of a good

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<sup>585</sup> An analysis of the judicial treatment of generic names in relation to geographical indications in the United States and the EU is discussed in the latter sections of this chapter.

<sup>586</sup> 2012 (Gyo-ke) 10404 (IP High Court, 1<sup>st</sup> division), 2007 (Gyo-Ke) 50494 (IP High Court, 3<sup>rd</sup> division).

<sup>587</sup> 2010 (Gyo-Ke) 10366 (IP High Court, 4<sup>th</sup> division); 2009 (Gyo-Ke) 10052 (IP High Court, 4<sup>th</sup> division).

<sup>588</sup> *Ibid*; 2011 (Gyo-Ke) 10426.

<sup>589</sup> 2012 (Gyo-ke) 10404 (IP High Court, 1<sup>st</sup> division).

is not deemed to be inherently distinctive, if it is used to enhance its function<sup>590</sup> or for decorative purposes. Notably, a mark representing the place of origin of a product is un-registerable unless the trademark has acquired recognition through its use among consumers, as that which is associated with a business.

Arguably, the emphasis upon product differentiation and distinctiveness is also implicitly incorporated into Article 4(x) and 4(xv)-(xvi) of the trademark act. In these provisions, it is apparent that it is the distinctiveness of a good from that of another (and the prospects of causing confusion with the public), which will determine its registrability as a valid trademark. Article 4(x) stipulates that it is impermissible to obtain registration for a mark which is identical or similar to a well-known mark used to indicate a good or service of a business.<sup>591</sup> A mark which is likely to confuse the public<sup>592</sup> based on its identical nature or similarity to a registered mark is specifically prohibited from registration under 4xv. Similarly, marks which are likely to mislead the consumer as to the quality of the good are un-registerable pursuant to Article xvi.

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<sup>590</sup> 2007 (Gyo-Ke) 50494 (IP High Court, 3<sup>rd</sup> division).

<sup>591</sup> Trademark Act, *supra* note 11. Section 4(x): "...no trademark shall be registrable if the trademark is inter alia, identical with, or similar to, another person's trademark which is well known among consumers as that indicating goods or services in connection with the person's business, if such a trademark is used in connection with such goods or services or goods or services similar thereto".

<sup>592</sup> *Sony K.K v Sony Food K.K*, No. (468) 27 Pat. Off. Oct. 1960. reported in, T. Doi "The Protection of Well Known Foreign Trademarks in Japan" 1969(3) Law In Japan 104.

In a recent Intellectual Property High Court decision<sup>593</sup> involving the invalidation of the name “3ms”, the court held that the impugned mark was likely to confuse the public based on its level of similarity with the well-known mark “3m”. The IP High Court decision was based on the following factors. Firstly, there is similarity in appearance and pronunciation between both marks; 3ms is pronounced as ‘suriieemuzu’ and 3m is pronounced as ‘suriemu’. Secondly, 3m is known as a famous mark in Japan, and attained this level of prominence prior to the filing of the defendant’s application for trademark. Thirdly, the mark’s affiliation with a diverse group of products including some of which were connected with some aspects of the defendant’s goods and services, could lead to the reasonable conclusion that the public is likely to be confused by the simultaneous use of both marks in the industry. On this basis the court held that, “traders and consumers are likely to fall under confusion that said services pertain to the said services of the plaintiff...”.<sup>594</sup>

#### **4.1.3.2. Specific Provisions related to Collective Marks**

Collective marks are registrable on two separate grounds under Japan’s trademark legislation. These grounds are recognized under Article 7(1) and 7(2) of the Act. As Article 7(1) notes, a collective trademark is a trademark which is used by the members of an incorporated association or other association, and is registered by the association. A

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<sup>593</sup> 2012 (Gyo-ke) 10414 (IP High Court, 1<sup>st</sup> division).

<sup>594</sup> *Ibid*, p2.



registration which is facilitated via a collective trademark legally recognizes the association's collective ownership of the mark.

A trademark may also be registered as a regionally based collective mark.<sup>595</sup> Article 7(2) is a relatively new legislation, which came into effect on April 02, 2005. The legislation defines a 'regionally based collective mark' as a mark consisting of a geographic name and the common name of goods or services that is used by an industrial business or cooperative association. Essentially, Article 7(2) creates an exception to the use of a generic name in association with a trademark. The common name may either be generic or one which is customarily used to associate with the product.

The legislation further defines 'the name of a region' as the place of origin of the product, or the name of the place which has a "close relationship" with the origin of the product.<sup>596</sup> Importantly, the regionally based mark must be well-known by consumers in the region or in the nearby prefecture. There are minimal judicial decisions on this provision. Japan's High Court<sup>597</sup> has interpreted the criterion of "well-knownness" as one which, because of use by consumers in a particular region, has become known within the region, and in nearby vicinities as indicating the goods of a particular business. A finding of "well-knownness"<sup>598</sup> is dependent upon the size of the business

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<sup>595</sup> The Trademark Act, Article 7-2(1), *supra* note 571.

<sup>596</sup> *The Trademark Act*, Article 7-2 (2), *supra* note 571.

<sup>597</sup> 2009 (Gyo-Ke) 10433.

<sup>598</sup> *Ibid.*

association (its member composition), the share composition of the product in the marketplace compared to other similar products, and an evaluation of the trademark registration status of similar business entities.<sup>599</sup>

Arguably, the introduction of regional based collective marks creates opportunities for geographical indication products to gain a form of legal recognition that is associated with its place of origin. However, comparatively, this is of nominal significance to the level of protection accorded to a product which is legally recognized as a geographical indication in the importing country.

#### **4.1.3.3. Well Known Marks – Scope and Limits**

Well-known marks are given special protective status under Japan's Trademark Act.<sup>600</sup>

Well-known marks are classed as such based on an acquired high degree of distinctiveness through use widely recognized geographic areas, among relevant traders and/or end users. A factual contextual approach is used in deciding whether a mark is well-known.<sup>601</sup> Consideration is given to (i) the actual use of the mark, (ii) extent, degree, duration and geographical area in which the mark is used, (iii) the mark's market share (iv) evidence of press and media coverage through advertisement and promotion of

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<sup>599</sup> Hiroko Onishi, *Well-Known Trade Marks: A Comparative Study of Japan and the EU* (New York: Routledge, 2015).

<sup>600</sup> Article 4(1)(10), Japan's Trademark Act, *supra* note 571: No trademark shall be registered if it is identical with, or similar to, another person's trademark which is well known among consumers as that indicating goods or services in connection with the person's business, if such a trademark is used in connection with such goods or services or goods or services similar thereto.

<sup>601</sup> Japan Patent Office Examination Guidelines for Trademarks, Well-known Trademarks of Another Person, (available online at [https://www.jpo.go.jp/tetuzuki\\_e/t\\_tokkyo\\_e/pdf/tt1302-002/3-9.pdf](https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/pdf/tt1302-002/3-9.pdf)).

the mark, and (v) quantitative evidence of extent of consumer awareness through market surveys.<sup>602</sup>

The juridical interpretation of well-knownness is preserving of widely recognized marks in circumstances of justified and verifiable claims. In *DCC Coffee v Daiwa Coffee*, the claimant argued that the registration of ‘DCC Coffee’ by the registrant was invalid as its unregistered trade-mark had become well-known by the time DCC had registered its mark. In dismissing Daiwa Coffee’s claim, the court held that a strong connection between the product and the mark needs to be established by relevant major traders in Japan, or, be well-known by more than 50% of relevant traders in one or a few neighbouring prefectures.<sup>603</sup> DCC Coffee was known in only 30% of its relevant trading circles, and less than 30% known in neighbouring prefectures.<sup>604</sup> The claim therefore failed.

Foreign trade-marks may be classified as well-known marks notwithstanding the absence of its registration in Japan.<sup>605</sup> The mark’s distinctiveness is acquired through substantial

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<sup>602</sup> *Ibid*, Chapter II, Article 3(2) Distinctiveness acquired Through Use.

<sup>603</sup> Hiroko Onishi, Syuchi-syohyo in Japan in Hiroko Onishi *Well Known Trade Marks: A Comparative Study of Japan and the EU*, (New York: Routledge Press, 2015) at 160-161. [Onishi, “Well Known Marks”]

<sup>604</sup> *Ibid*.

<sup>605</sup> Article 4(1)(19), Trademark Act: No trademark shall be registered that is identical with, or similar to, a trademark which is **well known** among consumers in Japan or abroad as that indicating goods or services pertaining to a business of another person, if such trademark is used for unfair purposes (referring to the purpose of gaining unfair profits, the purpose of causing damage to the other person, or any other unfair purposes, the same shall apply hereinafter) (except those provided for in each of the preceding items). [*Emphasis added*].

sales volume in its country of origin and/or in other countries. Extensive advertisements of the goods or services in other countries also buttresses a foreign trade-mark claim of well-knownness.<sup>606</sup>

#### **4.1.4. Unjustifiable Premiums and Misleading Representations Act Concerning country of Origin Goods.**

Japan's Fair Trade Commission has jurisdiction over the country's *Unjustifiable premiums and Misleading Representations Act*<sup>607</sup> (the *Act*), which enables the Commission to conduct hearings against businesses that have falsely misrepresented the place of origin of specific goods. The *Act* is affiliated with the *Anti-Monopoly Act*<sup>608</sup> and facilitates the issuance of cease and desist orders by the Commission upon complaints against a business for falsely misrepresenting a product's origin. Originally enacted in

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<sup>606</sup> Onishi discusses the case of a United States information technology magazine "Computer World" that initiated a claim against a Japanese publishing house who had registered the name "Computer World" for use in association with newspapers and magazines. The United States business claimed that its mark was well-known based statistical evidence on large sale volumes within its territory, as well as in Japan and Canada. I note, in reproducing a segment of the court's judgement from Onishi's writings "A mark can be well known even if it was well known only in the limited and selected range of consumers or traders, so long as there is no confusion. Ibid p. 163.

<sup>607</sup> *Act Against Unjustifiable Premiums and Misleading Representations* (Act No. 154 of May 15 1962) ["*Unjustifiable Premiums Act*"].

<sup>608</sup> The purpose of the Anti-Monopoly Act is stated as:

To prohibit "private monopolization ,unreasonable restraint of trade and unfair trade practices, by preventing excessive concentration of economic power and by eliminating unreasonable restraint of production, sale, price, technology, etc.,and all other unjust restriction on business activities through combinations, agreements, etc., to promote fair and free competition, to stimulate the creative initiative of entrepreneurs, to encourage business activities, to heighten the level of employment and actual national income, and thereby to promote the democratic and wholesome development of the national economy as well as to assure the interests of general consumers". *The Anti-Monopoly Act, The Act on the Prohibition of Private Monopolization and Maintenance of Fair Trade*. Act No. 54 of April 14, 1947.

1973, the *Act* was amended in 2003<sup>609</sup> to empower the Commission with greater authority to perform its functions.

Subsequent amendments to the *Act* were made in 2014, mandating businesses to implement measures to prevent the misleading representation of their products, and to enact a system of fines based on the extent of liability of the mis-representor.<sup>610</sup> The latter is regarded as an unjustifiable premium if the company made false allegations as to comparable quality of their products, or charges a price that is substantially greater than the quality of the product.

Compared to the Commission's hearings on other matters, there have been minimal orders and hearings for misrepresentations concerning country of origin products. However, the *Act* provides an alternative means for foreign right owners of GI products to launch proceedings if a misrepresentation has occurred. Its general effectiveness is still undetermined based on the minimal orders which have been issued, and the level of

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<sup>609</sup> *The Law to Amend the Premiums and Representations Act. Japan Fair Trade Commission* ([http://www.jftc.go.jp/en/pressreleases/yearly\\_2003/may/individual\\_000382.html](http://www.jftc.go.jp/en/pressreleases/yearly_2003/may/individual_000382.html)) (Last accessed August 20 2013). [Law to Amend the Premiums and Representations Act'].

<sup>610</sup> Act No. 134 of 1962, as amended by Act No. 118 of 2014, Article 5 & 8. any representation where the quality, standard or any other content of goods or services is portrayed to general consumers as being much better than that of the actual goods or services, or much better than that which other businesses supply, contrary to fact; or any representation by which the price or any other trade terms of the goods or services could be misunderstood by general consumers to be much more favorable than the actual goods or services supplied, or to be much more favorable than those of other businesses that supply the same kind of or similar goods or services.

compliance from ‘mis-representors’. However, despite this, the Commission has made significant changes to the enforcement of the act in efforts to mitigate its breach.<sup>611</sup>

The specific provisions which are implicated are Sections 4(1) and 4(1)iii of the Act. The Commissions 1973 Regulation<sup>612</sup> concerning country of origin goods is directly related and is applicable to all transactions that fall under these provisions. According to section 4(1), “no entrepreneur shall make such representation as provided for in ... connection with transactions regarding a commodity or service which he supplies”.<sup>613</sup> Section 4(1) is the preamble to three enumerated misrepresentations that are prohibited by the Act. The applicable provision that I am concerned with because of its relevance to this analysis is section 4(1) iii. Pursuant to section 4(1) iii no entrepreneur should make representations which relate “to transactions as to a commodity or service which is likely to be misunderstood by consumers in general, and which has been designated by the Fair Trade Commission”<sup>614</sup> as a form of misrepresentation. Representation is defined under the Act as advertisements or any means by which a business induces customers to make a transaction in regards to a product.

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<sup>611</sup> *Ibid.*

<sup>612</sup> Misleading Representations on Country of Origin Goods (FTC Notification no. 34 of 1973).

<sup>613</sup> *Law to Amend Premiums and Representations Act, Section 4(1), supra* note 609.

<sup>614</sup> *Ibid.*

There is a prohibition against representations which the Fair Trade Commission deems to “induce customers unjustly and to impede fair competition”.<sup>615</sup> The act specifically notes that “designation”<sup>616</sup>, as used in 4(1)iii, includes “Misleading Representation of Country of Origin Goods”.<sup>617</sup> This representation includes reference to a country name, its abbreviation and the map of country to designate a false country of origin.<sup>618</sup>

On a finding of misrepresentation, the Commission issues ‘cease and desist’ orders to violators. An examination of orders indicates that the measures ordered to be implemented are usually the same.<sup>619</sup> Arguably, cease and desist orders are not inherently binding but require proactive adherence from violators,<sup>620</sup> the business community which the violator is affiliated with, and wide scale publication of the misrepresentation to consumers. In a proceeding against a business<sup>621</sup> regarding the labeling of gloves manufactured in China as made in Japan, the Commission order included that the following requirements be implemented. A public announcement of the

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<sup>615</sup> *Supra* note 592, *Unjustifiable Premiums Act*.

<sup>616</sup> *Ibid.*

<sup>617</sup> *Ibid.*

<sup>618</sup> Guidelines for the Interpretation of the Notification concerning Unfair Representation of the Country of Origin. (October 16 1973 Secretary General No. 12).

<sup>619</sup> Misleading Representations against K.K Garo, Miyabe K.K and Murakatsu K.K, Japan Fair Trade Commission, Oct 31, 2003; Misleading Representation against Daimutu Kogyo on manufacturing country of sandals Dec. 04, 2003; Hearing Decision Against TomorrowLand Co. Ltd and World Co. Ltd Dec. 06, 2007; (Japan Fair Trade Commission [www.jftc.go.jp/en/pressreleases/index.html](http://www.jftc.go.jp/en/pressreleases/index.html)).

<sup>620</sup> Cease and desist Order against K.K Urushihara on misleading representations on manufacturing country of gloves. Nov 10 2003. (Available online at, [www.jftc.go.jp/en/yearly\\_2003/nov/individual\\_000340.html](http://www.jftc.go.jp/en/yearly_2003/nov/individual_000340.html), last visited September 29, 2016).

<sup>621</sup> *Ibid.*

misrepresentation was necessary, and a requirement that the company take measures to prevent its recurrence.<sup>622</sup>

The effectiveness of cease and desist orders is dependent upon whether these deterrent measures are strictly interpreted by infringers and the infringers' business community. There is no guarantee that orders will be enforced and therefore, no guarantee that a recurrence of the misrepresentation will not occur. I argue that the effective enforcement of cease and desist orders requires a concerted effort from the concerned business community, and the implementation of stringent deterrence measures to prevent further misrepresentations. Unfortunately, these are not always forthcoming. The potential of infringers to comply with cease and desist orders is arguably greater if non-compliance will likely cause a downturn in their business activities.

#### **4.1.5. Summary (Japan)**

The imbalance in geographical indications reciprocity between Jamaica and Japan is not based on enactment of laws, but the non-registration of Blue Mountain coffee as a geographical indication. As such, the most easily obtainable protection is registration as a collective mark. The Trademark act recognizes<sup>623</sup> the exclusive and non-exclusive rights of owners on designated products, and safeguards these rights as long as they are 'registrable'. A high standard of protection is accorded to well-known marks. However,

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<sup>622</sup> *Ibid.*

<sup>623</sup> *The Trademark Act* Japan, Articles 25, 30, 31(2), 36 and 38, *supra* note 571.



evidence attesting to the well-knownness of the mark either within or outside of its country of origin must be submitted to validate its registration status. Japan's *Unfair Competition Act* is only accessible for products that are well known by Japanese consumers. This poses a level of difficulty for foreign agricultural and food based products that are not well known in the Japanese market, as this proceeding would be inaccessible to right holders. In regards to Jamaica, its Blue Mountain Coffee has gained extensive recognition by consumers in the Japanese market. Therefore, a claim under the *Unfair Competition Act* is not precluded, nor under the country's *Trademark Act*.

The next section analyzes the United States approach to agricultural and food based geographical indications under its *Lanham and Tariff Acts*, as well as under the common law. The United States accounts for the second largest consumer market of Jamaica's Blue Mountain coffee, with an export share of 16.04% for the 2012/13 period. Since 2003, there has been a steady increase in the number of green beans exported to the United States' consumer market.<sup>624</sup> I initiate the discussion by addressing the economic and political impetus behind the United States' opposition to extending enhanced protection to non-wine and spirit geographical indications.

#### **4.2. Divergences: Geographical Indications and the United States**

The United States opposition to geographical indications is based on an economic and political determination to safeguard the economic interests of its domestic producers. There is a conflictual relationship between trademarks and the legal protection of

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<sup>624</sup> Interview with Coffee Industry Board (Sept. 2013).

geographical indications in the United States. Origin based goods are protected in accordance with the *Lanham Act*, as certification or collective marks.

Refusals to extend the enhanced protection for non-wine and spirits geographical indications to other forms of geographical indications generally were voiced very strongly in the failed Doha Round negotiations by the United States.<sup>625</sup> This strong opposing view forms the United States norm consensus on geographical indications. Reciprocal legal recognition for agricultural and food based geographical indications by the United States calls for changes to its trademark legislation. I further maintain that a significant change to its political culture on intellectual property would need to ensue before the United States practically considers geographical indications as anything but a threat to the sustenance of its trademark industries.

According to a 2012 report by the United States Patent and Trademark Office and its Economic Statistics Administration Unit,<sup>626</sup> trademark intensive industries accounted for 22.6 million jobs in the United States in 2010. I've included this statistic to pinpoint the relatedness between the economic interests of United States trademark producers, and the resulting legal stance in safeguarding domestic products against competition from foreign firms.

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<sup>625</sup> I discuss this point in Chapter three of the thesis.

<sup>626</sup> Intellectual Property and the United States Economy: In Focus, (Economic and Statistics Administration, United States: March 2012).

The United States envisages geographical indications as a barrier to trade and market competition. Jurisdictions with high producing food based industries that use trademark legislation as the choice of intellectual property for the protection of rights associated with the product's commodification, are generally reluctant to extend Article 23 protection beyond wine and spirits.<sup>627</sup> U.S Special 301 Watch List for the year 2014 is indicative of this point. An excerpt of the report notes that:

“The United States is working intensively through bilateral and multilateral channels to advance U.S market access interests, and to ensure that the trade initiatives of other countries, including with respect to geographical indications do not undercut U.S industries geographical indications...the United States is pressing its objectives in a variety of contexts, including at the WTO, WIPO an Asia-Pacific Economic Cooperation as well as in our bilateral agreements...the U.S goals include, ensuring that grants of GI protection do not violate prior rights (for example, in cases where a U.S company has a place name, ensuring that grants of GI protection do not deprive interested parties of the ability to use generic or common terms...ensuring that interested persons have notice of, and opportunity to oppose or to seek cancellation of any GI protection that is sought or granted and, opposing efforts to amend the TRIPS Agreement to extend to other products the special protection that is provided to GIs for wines and spirits.”<sup>628</sup>

This anti-agricultural and food based geographical indication paradigm is also observable amongst agricultural lobby groups in the United States and in comments and

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<sup>627</sup> The Trade Related Aspects of Intellectual Property, Article 23 provides enhanced levels of protection for wine and spirit based GIs. World Trade Organization members must provide protection against the use of GI names of registered wine and spirits, even if such name is used in manner denoting “kind”, “style”, “imitation” or the like. Trademarks which contain reference to a wine and spirit based geographical indication must be refused registration as invalidated based on its reference and similarity to the wine and spirit based GI.

<sup>628</sup> 2014 Special 301 Report to Congress, United States Trade Representative, at 24.

commentary by United States political leaders representing agricultural groups' interest.<sup>629</sup>

There are implications for trademark rights holders if agricultural and food based geographical indication status were to be acquired and recognized in the United States. This is a proposition that the European Union forcefully suggested in the Doha Round negotiations.

Amongst the European Union demands was the 'claw-back' of specific GI product names from general commercial usage, to be reserved solely for usage by the EU. As agricultural and food based geographical indications are not recognized under *sui-generis* legislation in the United States, there are instances of similar name usage which are not caught or protected under United States trademark legislation. There is no infringement or restriction of such product names being used in these instances. Therefore, advancement of GI rights in the United States is stymied by the economic interest of food and beverage producers in protecting their consumer market against a dilution and usurpation of the brand.

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<sup>629</sup> Sentinel News, "Hatch Introduces Historic Trade Promotion Authority Legislation", April 18, 2015 (available online at [http://www.sentinelnews.net/article/18-4-2015/hatch-introduces-historic-trade-promotion-authority-legislation#.VT\\_uAU0XKUK](http://www.sentinelnews.net/article/18-4-2015/hatch-introduces-historic-trade-promotion-authority-legislation#.VT_uAU0XKUK)); Consortium for Common Food Names, "Consortium for Common Food Names Praises Congress for Trade Promotion Authority Provision that Defends U.S Food and Beverage Producers Against Geographical Indications Abuse" April 21, 2015 (available online at <http://www.commonfoodnames.com/ccfn-praises-congress-for-trade-promotion-authority-provision-that-defends-u-s-food-and-beverage-producers-against-geographical-indications-abuse/>).

Against this background, the United States has unequivocally vocalized its position on geographical indications in various international IP forums. Strong arguments against geographical indication rights recognition were advanced by the United States in the World Intellectual Property Office's Standing Committee on the Law of Trademarks, Industrial Design and Geographical Indications, and in submissions made by the International Trademark Association against GIs.<sup>630</sup> The United States had also expressed its disapproval of the *Lisbon Agreement's* extension of protection to food based GIs.<sup>631</sup>

In its submissions to the World Intellectual Property Office Working Group on the Lisbon System, the United States argued that enhanced recognition for GIs under the *Lisbon Agreement* would result in unfair competition to trademark holders.<sup>632</sup> Its preference is for TRIPS Agreement provisions for non-wine and spirit GIs, which allow flexibility in contracting parties' approaches to GIs.<sup>633</sup> The absence of a contracting

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<sup>630</sup> United States Patent and Trademark Office & World Intellectual Property Office, "Worldwide Symposium on Geographical Indications" (July 09-11, 2003); World Intellectual Property Office, Standing Committee on the Law of Geographical Indications – Proposal by the Delegation of the United States, 34<sup>th</sup> Session, November 18, 2015 (WIPO SCT/34/5).

<sup>631</sup> This point is covered in Chapter 6 of the thesis.

<sup>632</sup> Working Group on The Development of The Lisbon Union, 8<sup>th</sup> Session, December 2-6, 2013 (LI/WG/DEV/87/PROV) at 4.

<sup>633</sup> *Ibid* at 5. Pursuant to Article 22.1 (2) In respect of geographical indications, Members shall provide the legal means for interested parties to prevent:

(a) the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good;

(b) any use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention (1967).

party's discretion to determine its own approach to the protection of GIs is a significant brunt of contention for the United States with the revised *Lisbon Agreement*.

#### **4.2.1. The United States: Certification and Collective Marks**

Certification and Collective marks provide minimal safeguard for the protection of agricultural and food based geographical indications. According to section 4 of the *Lanham Act*, collective and certification marks are registrable as trademarks, and are entitled to the protection embodied in the trademark act.<sup>634</sup> Certification marks<sup>635</sup> refer to words, symbols or a combination of both which is used by businesses other than its owners, which certifies regional or other origin, or that a product has met a specific standard of quality.<sup>636</sup> Furthermore, a certification mark also denotes that the work involved in the manufacture of a product was performed by members of a specific

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<sup>634</sup> The *Lanham Act*, Section 1054. Subject to the provisions relating to the registration of trademarks, so far as they are applicable, collective and certification marks, including indications of regional origin, shall be registrable under this Act, in the same manner and with the same effect as are trademarks, by persons, and nations, States, municipalities, and the like, exercising legitimate control over the use of the marks sought to be registered, even though not possessing an industrial or commercial establishment, and when registered they shall be entitled to the protection provided herein in the case of trademarks, except in the case of certification marks when used so as to represent falsely that the owner or a user thereof makes or sells the goods or performs the services on or in connection with which such mark is used. Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trademarks.

<sup>635</sup> See Chapter 1; For a detailed history of certification and collective marks in the United States see Paul Duguid, "The Uncertain Development of collective and certification marks" (Available online <http://people.ischool.berkeley.edu/~duguid/articles/CofP-2.pdf>); William M. Landes & Richard Posner, *Trademark Law an Economic Perspective* (1987) 30:1 *J L & Econ* 2.[Landes & Posner, "Trademarks"].

<sup>636</sup> *Section 45, Lanham Act*; See also J. Thomas McCarthy, *McCarthy on Trademarks*, McCarthy Sec 19:91. (Westlaw).

association.<sup>637</sup> There is no specific federal standard for certifiers.<sup>638</sup> Each certification standard is determined by the association which the product is affiliated with.<sup>639</sup>

Collective marks are trademarks used by members of an association or trademarks which an association has a bona fide intention of using in the course of trade. Its use in the course of trade requires that the mark be included on the label or container of the product, and that the product be sold or transported in commerce. The fundamental difference between certification and collective marks<sup>640</sup> is that the former requires a seal verifying the product's affiliation with the association, while use of the latter's mark is only permissible if the business belongs to the specific association.<sup>641</sup> In the sections below, I engage in a juridical analysis of certification marks in the United States.

#### **4.2.2. Certification Marks**

Certification marks are accorded the same jurisprudential consideration as trademarks primarily because its provisions form part of the *Lanham Act*.<sup>642</sup> Pursuant to the Lanham Act in order to facilitate its registration, certification marks must meet certain specific

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<sup>637</sup> *Ibid.*

<sup>638</sup> Between 1978 to 1985, the Federal Trade Commission made a number of unsuccessful attempts to establish general certification standards for products. See 43 Fed Reg. 57269 (Dec 7 1978), 48 Fed Reg. 15484. The federation reviews standards on a case by case basis.

<sup>639</sup> *Re Standard & Poor's Corp* 19 U.SP.Q.2d 1684: The court held that the symbol "BBB" is a certification mark used by Standard & Poor to illustrate to investors that a security has met a specific standard.

<sup>640</sup> *Landes & Posner, Trademarks, supra* note 635.

<sup>641</sup> *Opticians Association of America v Independent Opticians of America*, 734 F.Sup 1171.

<sup>642</sup> *Levy v Kosher Overseers Ass'n of America* 104 F.3d 38.

criteria. In this section I will examine and critically discuss the legislative provisions of the *Lanham Act* concerning the registrability and legality of certification marks and the judicial interpretation of these provisions.

As stipulated in section 4<sup>643</sup> of the *Lanham Act*, certification marks are entitled to the protection of the Act unless they are being used by a non-owner or non-user to “represent falsely” that the product is made or sold by the actual owner or users. In furtherance to this, section 14(5)<sup>644</sup> notes that the validity of certification marks is dependent upon any of the following four conditions. The person or business who has registered the mark should ‘legitimately’ control its use.

As noted in the *Tea Board of India* case<sup>645</sup> involving contestation over the right to use the name ‘Darjeeling’, the “control” requirement of the legislation serves two purposes. The value of the mark is protected as an indication of source. The Trademark Trial and Appeal Board also noted that by ensuring that the registrability of the mark was based on its certification standards, the provision prevents the public from being misled as to the origin or genuineness of the product.<sup>646</sup> Courts have interpreted the control provision as one which requires monitoring and enforcement of its certification mark by

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<sup>643</sup> Section 4 Trademark Act, 15 U.S.C 1054.

<sup>644</sup> Section 14(5) Trademark Act, 15 U.S.C 1054.

<sup>645</sup> *Tea Board of India v Republic of Tea Inc.* 80 USPQ 2d 881. *Midwest Plastic Fabricators Inc v Underwriters Labs Inc.* 906 F.2d 1568 [“*Tea Board of India*”].

<sup>646</sup> *Ibid.*



registrants.<sup>647</sup> Notwithstanding this interpretation, jurisprudence recognizes that absolute control is not possible.<sup>648</sup>

In a dispute brought by the Switzerland makers of SWISS watches<sup>649</sup> against a United States watch manufacturer using a similar name to its certification mark, the Appeal Board held that ‘adequate monitoring’ sufficed to validate the control legislative requirement. The Swiss registrants were extensively involved globally in monitoring and enforcing its certification mark, including the abandonment of various opposition applications in the United States.

The registrant’s adequate control of its certification mark should also guard against its use by third parties, to the extent that the mark fails to be recognized as an indication of the good, or becomes generic.<sup>650</sup>

Section 14(5) also stipulates that the registrant should not be involved in producing or marketing the concerned product. Thirdly, the only permissible use of the certification mark by the registrant is to certify the concerned product. Finally, the registrant cannot

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<sup>647</sup> *Ibid*, *Engineered Mechanical Services Inc v Applied Mechanical Technology Inc*. 584F Sup 1149 (QL).

<sup>648</sup> *Midwest Plastic Fabricators v Underwriters Lab Inc* 906 F.2d 1568; *Swiss Watch International Inc v Federation of the Swiss Watch Industry*, 101 USPQ 2d 1731 (QL). [“Swiss Watch”].

<sup>649</sup> *Ibid*, “Swiss Watch”.

<sup>650</sup> *Tea Board of India*, *supra* note 229.

“discriminately refuse” certification to a user who has conformed to the specific standard requirements.<sup>651</sup>

#### **4.2.3. The Test of Likelihood of Confusion**

Section 2 of the *Lanham Act* is generally applicable to certification marks to the same extent as the acts’ relevance to trademarks. Pursuant to section 2(d), a mark which is similar<sup>652</sup> to one which is already registered and is likely to ‘deceive’, cause confusion or mistake among consumers when used in connection with a good, cannot be registered as a trademark. Although actual confusion is not required<sup>653</sup>, there must be a substantial likelihood of confusion with the public in regards to the concerned product. This provision is available to registrants of certification marks in infringement claims.

Jurisprudence has interpreted that the likelihood of confusion with another mark is based on eight factors. Case law indicates that where the factors are ‘closely balanced’, the decision should be resolved in favor of the senior user.<sup>654</sup> Each factor is not decisive<sup>655</sup> but is dependent upon an accumulative analysis of all variables, and a “balancing of the

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<sup>651</sup> *Ibid.*

<sup>652</sup> *The Lanham Act*, Section 2d.

<sup>653</sup> But see *Phipps Bros. Inc v Nelson’s Oil and Gas Inc* 508 NW 2d 885. Actual confusion bolstered the case against the alleged infringers and led to a finding of likely to confuse the public.

<sup>654</sup> The United States Federal Circuit court established the list of factors which the district courts use to varying extents. See *Quantum Fitness Corp v Quantum Lifestyle Ctrs LLC*, 83 F Supp 2d 810 (SD Tex).

<sup>655</sup> *Scott Fetzer Co. v House of Vacuums Inc* 381 F3d 477 (5<sup>th</sup> Cir).

conclusions from each factor”.<sup>656</sup> As the *Dupont* case<sup>657</sup> authoritatively notes, these variables are based on (a) the strength of the mark (b), its similarity with the allegedly infringing mark, (c) the similarity of the products (d) the likelihood that the owner will bridge the gap, (e) occurrences of actual confusion, (f) the reciprocal of the defendant’s good faith in adopting its own mark, (g) the quality of the alleged infringer’s product, and (i) the sophistication of the buyers. In *Dupont*, the plaintiff successfully claimed that its Teflon certification mark was infringed by the defendant’s use of the mark “Eflon” on zippers. I discuss the most pertinent of these factors. Some of these factors are more aptly discussed together, while the others deserve a more extensive discussion because of their substantive influence on case outcomes.

The strength of the mark is dependent upon its distinctiveness and its ability to effectively signify its source of origin. Notably important is its acceptance by the public as a mark signifying its source, or the level of creativity and uniqueness<sup>658</sup> in the coining of the term.<sup>659</sup> The most decisive factors that are salient to the courts’ enquiry in determining a likelihood<sup>660</sup> of confusion, are those related to similarity between the marks and the fundamental analogies and distinguishing features between the products.

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<sup>656</sup> *Kiki Undies Corp; Lyons Partnership v Giannolas* 179 F3d 384 (5<sup>th</sup> Circuit Court).

<sup>657</sup> *E.I Dupont de Nemers & Co. v Yoshida Intern Inc.* 393 F. Supp 502 (DCNY). [“*Dupont*”].

<sup>658</sup> *Arrow Distilleries v Globe Brewing Co.* 117 F2d 347 (4<sup>th</sup> Cir 1941).

<sup>659</sup> *Ibid.*

<sup>660</sup> *Re S&L Training Stable Inc.* 88 USPQ 2d 1216 (TTAB 2008).

The degree of similarity between the mark and the alleged infringer's mark is not conclusively decisive of an infringement, especially if the products are from non-competing industries. The fundamental factors that courts consider are the marks 'appearance, sound and meaning'.<sup>661</sup> In the *Dupont* case, the similarity between the names "Teflon" and "Eflon" had no substantive effect on the court's finding of non-infringement. Both trademarks were from non-competing industries, although this on its own is not dispositive of a case.

A different result was reached in a case concerning the use of a trademark containing the term 'American Century'.<sup>662</sup> American Century Proprietary filed an infringement claim against American Century Casualty for the use of its name. Both companies were from non-competing enterprises, investment and insurance services. The Federal Appeal court held that Century Casualty's use of the name "American Century" was likely to cause confusion to the public. The company's practice of abbreviating its name to that of the plaintiff's in its commercial transactions was envisaged as indicative of causing confusion among prospective purchasers. The court noted that prospective purchasers were likely to logically conclude that both companies were affiliated with each other. The jurisprudence regarding picture and symbol marks<sup>663</sup> indicates that similarity

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<sup>661</sup> *Elvis Presley Inv v Capece* 141 F3d 188; *Re Martin's Famous Pastry Shoppe Inc* 748 F2d 1565 (Fed Cir 1984).

<sup>662</sup> *American Century Proprietary Holdings Inc v American Century Casualty Company* 295 Fed App 630 (C.A 5 Tex 2008).

<sup>663</sup> *Exxon Corp v Texas Motor Exchange Inc.* 628 F2d 500 (5 Cir) ['Exon']; *General Food Corps v Ito Yokado Co.* USPQ 822 (TTAB 1983); *Time Warner Entertainment Co.* 65 U.S.P.Q 2d 1650; *Ava Enterprises Inc. v Audio Boss USA Inc.* 77 USPQ 2d 1783.

between marks is even less of a decisive factor in infringement allegations. The most decisive and controlling factor in these cases is the “visual”<sup>664</sup> similarity of appearances between marks. Visual similarity between marks is a matter of degree, which is dependent upon the ‘overall impression created by the mark’<sup>665</sup> as opposed to any singular feature in each symbol.

In a contestation over the right to use the registered trademark “Blue Moon” by the brewing company Coors<sup>666</sup>, the court held that despite the similarity in names and symbols between the two concerned entities, “visual similarity” was not dispositive of the case. The over-arching decisive factor to establish likelihood of confusion was the similarity between the goods and services offered by both entities. The Court of Appeal held that the fact that the registered trademark was owned by a restaurant and the alleged infringing mark was that of a brewery, should guide the analysis in determining the likelihood of confusion with the public. Generally, the greater the similarity between the two goods the more probable is the courts’ decision to rule in favor of the senior registered owner, and establish that there is likely confusion with the public. I critically discuss this in the next paragraph.

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<sup>664</sup> *First Sav Bank F.S.V v First Bank System Inc.* 101 F 3d 645; 40 USPQ 2d 1783; *Daimler Benz Atkiengesellschaft v Mitsubishi Jukogyu Kaisha* 172 USPQ 86 (TTAB 1971); *Kellogg Co. v Toucan Golf Inc.* 337 F3d 616; *Re TSI Brands Inc.* 67 USPQ 2d 1657.

<sup>665</sup> *Exxon*, *supra* note 663.

<sup>666</sup> *Re Coors Brewing Company* (2003)343 F 3d 1340 (CA).

The degree of similarity between products is more likely to establish or refute a likelihood of confusion in an infringement allegation.<sup>667</sup> Less emphasis is placed upon similarity between marks when the products are directly competitive<sup>668</sup> or closely related with each other. An analysis of cases<sup>669</sup> indicate that products which are from the same classes of goods, that have a strong buyer recognition in the commercial context including by reference to the specific trademark, are likely to be successful against infringement allegations.

In a Court of Appeal case<sup>670</sup> involving contestation over the registration of the term “Quirst” to refer to soft drinks, the senior trademark owner successfully challenged its registration on the grounds of its similarity with its soft drink product “Squirt”. There is no clear and complete consistency from case law analyses of a finding of likelihood of confusion with the public, based primarily on the degree of similarity between products. In *First Western Federal Savings*,<sup>671</sup> both services were from the banking sector, though the alleged infringing business primarily targeted the real estate sector. Despite similarities in the name “First Western” and the closeness of affiliation between the

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<sup>667</sup> *Attrezi LLC v Maytag Corp* 436 F3d 32.

<sup>668</sup> *Georgia-Pacific Consumer Product LP v Myers Supply Inc* 2009 WL 2192721.

<sup>669</sup> *Re SL&E Training Stable Inc* 88 USPQ 2d 1216; *General Food Corps v Borden Inc* 191 USPQ 674; *Nautilus Group Inc v Icon Health & Fitness* 373 F 3d 1330; *Century 21 Real Estate Corp v Century Life of America* 970 F 2d 874 (Fed Cir. 1992); *Re Viterra Inc* 671 F 3d 1358; *Bridgestone Americas Tire Operations LLC v Federal Corp* 673 F 3d 1330.

<sup>670</sup> *Squirtco. v Seven-Up co.* 628 F 2d 1086.

<sup>671</sup> *First Western Federal Sav Bank v Western Bank Sturgis* 636 NW 2d 454. (SDSC).

services, the court negated a finding of infringement. The court focused on the specific service provided by the real estate business and held that the nature of its service was sufficient grounds on which its business could be distinguished from that of its registered trademark competitor. Therefore, the likelihood of confusion was not established.

Generally, circuit and district courts do not place substantial weight<sup>672</sup> on the probability of the registered trademark user expanding its product catalogue to include the defendant's product. Often referred to as 'bridging the gap', this factor considers the likelihood of confusion between products based on either their probability of relatedness, or actual direct competition. This provision is usually of minimal significance<sup>673</sup> in determining the likelihood of confusion amongst members of the public, and in a finding of infringement by the courts.

Evidence of actual confusion<sup>674</sup> is not necessary to establish confusion. However, it is imperative that consumers are 'likely' to be confused by the use and existence of the allegedly similar mark. The absence of reported confusion between similar products<sup>675</sup> which have been in circulation for a long period is interpreted by the courts as proof of a

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<sup>672</sup> *Vittaroz Corp v Borden Inc* 644 F 2d; *City of Rome NY v Verizon Communications Inc.* 362 F 3d 168; *Virgin Enterprises Ltd v Nawab* 335 F 3d 141.

<sup>673</sup> *Mobil Oil Corp v Pegasus Petroleum Corp* 818 F 2d 254.

<sup>674</sup> *Chevron Chemical Co. v Voluntary Purchasing Groups Inc.* 659 F2d 695; *Continental Scale Corp v Weight Watchers International Inc* 517 F2d 1378; *CAE Inc v Clean Air Engineering Inc* 267 F3d 660.

<sup>675</sup> *Versa Prods. Co. v Bifold Co.* 50 F3d 208; *Nabisco Inc v PF Brands Inc* 191 F 3d 208; *CareFirst of Maryland Inc v First Care PC* 434 F3d 263.

lack of actual confusion among consumers. Similarly, evidence of actual confusion is insignificant for allegedly ‘confusing’ products<sup>676</sup> which have only been in circulation for short periods.

It is also apparent that there is a greater probability for an inference of “no likelihood of confusion” in cases<sup>677</sup> where both contending products have been in commercial existence for long periods, without any form of actual confusion between the products. This analysis was used in an infringement case concerning the use of the trademark “Care First”<sup>678</sup> by the insurance company Blue Cross. An infringement allegation was brought by a physician association trademarked “First Care”. The Court of Appeal<sup>679</sup> held that there was no likelihood of confusion between the two entities, on the basis that the *de minimis* level of proven confusion could not substantiate a finding that customers were likely confused. Only 2% of the customers surveyed were confused with the names of both organizations. In comparison, in a case contending an infringement allegation of the term “Seacrest” and “Secrets”,<sup>680</sup> a 30% finding of confusion among consumers via surveys was sufficient to establish a ruling of ‘likely’ to confuse consumers.

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<sup>676</sup> *Ibid.*

<sup>677</sup> *Care First of Maryland v First Care PC* 434 F 3d 263 [“Care First”]; *Scotch Whiskey Association v Majestic Distilling Co Inc.* 958 F 2d 263.

<sup>678</sup> *Ibid.*, ‘Care First’.

<sup>679</sup> *Ibid.*

<sup>680</sup> *Coryn Group III LLC v O.C Seacrest Inc.* 868 F. Supp 2d 468.



Jurisprudence<sup>681</sup> has established that survey evidence indicating 10% or more of customer confusion is adequate to substantiate that customers are likely confused by the similarity between products.

Establishing a likelihood of confusion between the defendant and the plaintiff's product is also explicitly required under section 32 of the Lanham act in proving infringement. I will discuss 2 of the 3 requirements for proving infringement under section 32 in the two paragraphs below. The 3<sup>rd</sup> requirement under section 32 specifically concerns the likelihood of confusing the public with the impugned mark and that of the plaintiff's. Pursuant to section 32,<sup>682</sup> use of a registrant's mark by an unauthorized person in commerce in a manner which is likely to cause confusion with the registrant's mark, is deemed an infringement. The basis of a section 32 analysis is threefold: the plaintiff must not only prove that the impugned mark is likely to confuse consumers, but the mark must also be in use, and in commerce. Fundamentally however, the same factors analyzed in the above discussion are used to determine the likelihood of confusion with the registrant's mark. This issue is analyzed below.

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<sup>681</sup> *Sara Lee Corp v Kayser-Roth Corp* 81 F 3d 455; *Henri's Food Product Co Inc v Kraft Inc* 717 F 2d 352 (7<sup>th</sup> Cir 1981).

<sup>682</sup> *Lanham Act*, 15 US 1114 section 32.

#### **4.2.4. Trademark Infringement under section 32 of the Lanham Act and its Applicability to Certification Marks**

The infringement of trademarks under section 32 requires proof that the registrant's mark is valid and protectable<sup>683</sup>, is owned by the registrant, and that its alleged unauthorized use is likely to cause confusion amongst consumers. Section 32 (1)a<sup>684</sup> stipulates that any person who partakes in the non-consensual use of the registrant's mark in commerce, whether in the form of a reproduction, counterfeit, copy or its colorable imitation<sup>685</sup> in connection with the sale, offering for sale, distribution or advertising of the good is liable for civil action remedies of infringement.<sup>686</sup> Furthermore as I have previously analyzed, the unauthorized "use in commerce" of the registrant's mark in connection with a product, must necessarily cause a likelihood of confusion with consumers between the impugned product/mark and that of the registrant's.

The use of the registrant's trademark must be in a manner which causes confusion by its depiction or illustration on the defendant's product. There must necessarily be an association between the alleged infringer's inclusion of the mark on its product and, the registrant's product which causes a likelihood of confusion with consumers as to the

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<sup>683</sup> A valid and protectable trademark is one which adheres to the provisions of the trademark act, is capable of registration, and is protectable based on the legal requirements stipulated under the act.

<sup>684</sup> *Lanham Act* section 32 (1) a.

<sup>685</sup> Colorable imitation is defined in the Lanham Act as any mark which is likely to cause consumers to be confused, deceived or mistaken as to its source: Lanham Act, section 45, USCA 1145; See also *McLean v Fleming* 96 US 245, 1877 WL 18479, which provided a narrow and strict interpretation of the term as a mark which "requires careful inspection to distinguish the spurious trademark from that of the genuine". This interpretation has not been followed by the Lanham Act or courts: *Qualitex Co v Jacobson Products Co Inc.* 514 US 519, 34 USPQ 2d 1161.

<sup>686</sup> Remedies for infringement are discussed below.

‘origin’ of the product. On this basis, the mere inclusion of a registrant’s name on an alleged infringer’s website<sup>687</sup> as a pop-up advertisement was not envisaged as ‘use’ as it did not infer an association with the registrant’s website.

However, more substantial correlations between the registrant’s and the impugned trademark increase the probability that the ‘use in commerce’ threshold will be met. The inclusion of “adwords”<sup>688</sup> on an alleged infringers’ website which are similar or the same as that of the registrant’s mark<sup>689</sup> is held to be ‘use in commerce’ of the mark, and is an infringement. Similarly, the inclusion of a registrant’s trademark as a search term by the alleged infringer<sup>690</sup> in a manner that causes its product to be wrongly associated with that of the defendant on internet searches may qualify as ‘use in commerce’. Arguably, establishing that an allegedly infringing trademark is ‘used’ is based upon the actual or prospective likelihood that there is confusion created by the usage of the impugned trademark.

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<sup>687</sup> *1800 Contacts Inc. v WhenU.com Inc* 414 F3d 400.

<sup>688</sup> Adwords are search terms or text used on websites which prompts an association with a particular product or service. See, Eddy Ventose, Google Adwords and trademark infringement in the United States, (2012) 7:10 *J Intl P L & Prac* 705.

<sup>689</sup> *Rhino Sports Inc v Sport Court Inc.* 2007 WL 1302745.

<sup>690</sup> *North American Medical Corp v Axiom Worldwide Inc.* 522 F3d 1211; *Adidas AG v Adidascrazylight2.com* 2013 WL 1651731.

Courts have established that the impugned trademark is used ‘in commerce’ if its use has substantially affected the commercial interstate viability of the plaintiff’s trademark.<sup>691</sup> It is sufficient for infringements to occur in a single state for the ‘in commerce’ threshold to be met. On this basis, there is no necessity for an infringement to be ‘interstate’.<sup>692</sup> The fundamental factor which is implicated in this analysis is for the impugned trademark to have substantially interfered ‘economically or otherwise’<sup>693</sup> with the commercial viability of the plaintiff’s trademark on an interstate level. The reference to the term “substantially” implies that a high evidentiary proof of interference must exist. However, contrary to this, all that is required is that the defendant’s act negatively affects the reputation and sale of the plaintiff’s product. Interestingly, acts which are “sporadic and irregular”,<sup>694</sup> and conducted in areas where the plaintiff has not established a commercial presence are not deemed as ‘in commerce’ activities.

The use of the impugned mark on an intrastate level is held to be used ‘in commerce’ in instances where a local business substitutes another product for the registered trademarked product<sup>695</sup> and sells it to consumers. Despite the local scope of the activity, the court noted that the act of substitution “undermined the reputation” and the

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<sup>691</sup> *Drop Dead Co. v S.C Johnson & Sons Inc.* 326 F. 2d 87 (9<sup>th</sup> Cir 1963); *Christian Dior S.A.R.L v Miss Dior of Flatbush Inc.* 173 U.S.P.Q. 416; *Rug Doctor LP v Mohawk Brands Inc.* 2007 WL 4287251 (Trademark Trial & Appeal Board); *Re Gerhard Horn Investments Ltd* 1983 WL 51788.

<sup>692</sup> Interstate as used in this analysis means activities between states in the United States.

<sup>693</sup> *Re Gerhard Horn Investments Ltd* 1983 WL 51788.

<sup>694</sup> *R.P. Hazzard Co. v Emmerson Shoes* 89 F Supp 211 (D.C Mass).

<sup>695</sup> *Coca-Cola v Stewart* 621 F 2d 280.

nationwide enforcement of the Coca-Cola brand. Such a finding necessarily implies that the plaintiff's mark is registered interstate or on a national level. Therefore, absent an interstate presence, infringement contestation over intrastate (local) usage of a mark does not satisfy the 'in commerce'<sup>696</sup> threshold when the marks are used in separate and distinct areas within the state.

The applicability of the 'in commerce' factor also extends to 'extraterritorial' commercial situations. I refer to extra-territorial commercial situations as those transactions in territories outside of the United States that implicate goods produced in the United States. I argue that this is remarkably advantageous for United States registered mark holders seeking to enjoin foreign defendants from unjustly infringing their mark. However, it bears no relevance to Jamaican trademark right holders with a commercial presence in the United States, as there is no equivalent legislative trademark provision in these jurisdictions.<sup>697</sup>

As the Supreme Court has noted,<sup>698</sup> the *Lanham Act* jurisdictional scope extends to unfair trade practices in foreign countries by United States citizens, notwithstanding that the impugned acts may have been committed in foreign territories. This position is also reinforced by section 45, which establishes that commerce includes all trade and

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<sup>696</sup> *Faciane v Starner* 129 F. Supp 430.

<sup>697</sup> Jamaica, *The Trademark Act*, 1999.

<sup>698</sup> *Steele v Bulova Watch Co.* 344 US 280, 73 S. Ct. 252 (1952 ["Steele"]).

commercial activity which is regulated by congress. As a federally registered trademark is under the jurisdiction of congress, then by implication so is all commercial activity governed under the *Lanham act* via the registration of marks.<sup>699</sup>

The *Lanham Act* applies to foreign commerce if three conditions are satisfied.<sup>700</sup> Firstly, the alleged infringements must have adversely affected American foreign<sup>701</sup> commerce. The effect cannot be minimal but must have resulted in a “cognizable injury” to the registrant. Courts have interpreted a ‘cognizable injury’ as circumstances in which the plaintiff has incurred economic harm from the defendant’s infringement.<sup>702</sup> Thirdly, there should be a strong linkage between the interest of the American registered trade mark and the concerned foreign country, to justify the usage of extraterritorial authority.

The *Lanham Act* was implicated in a Mexican enterprise unauthorized use of United States’ Bulovan watch parts to assemble watches for sale in Mexico.<sup>703</sup> The Supreme Court adamantly noted that the broad jurisdiction of congress extended to protect against the infringement of its citizens’ trademark rights. The integral factors which determine the applicability of the Lanham Act to overseas infringement claims are the incidences of

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<sup>699</sup> See also *Application of Silenus Wines Inc.* 557 F2d 806.

<sup>700</sup> *Timberlane Lumber Co v Bank of America National Trust & Savings Ass’n* 549 2 Fd 597 (9<sup>th</sup> Cir. 1976); *Star-Kist Foods Inc v P.J Rhodes Co.* 769 F 2d 1393 (9<sup>th</sup> Cir).

<sup>701</sup> *Ibid.*

<sup>702</sup> *Trader Joe’s Company v Hallatt* 2013 WL 5492515. *Timberlane Lumber Co v Bank of America National Trust & Savings Ass’n* 549 Fd 597 (9<sup>th</sup> Cir).

<sup>703</sup> *Steele*, supra note 698.

infringements, and the connecting factor between the product's country of origin and the foreign market. Another fundamental issue is the effect of the foreign infringer's actions on the registered mark's reputation and sale prospects. The objective<sup>704</sup> of trademark registration is to protect and foster the commercial net worth and goodwill of the concerned product. Undoubtedly therefore, mitigating foreign infringements which may negatively affect the goodwill and commercial viability of the registered product is necessary to a fulfillment of the expansive objectives of the act.

In a case<sup>705</sup> concerning the importation of the plaintiff's gaming machines to Venezuela, and the unauthorized registration of the machines as the plaintiff's goods, section 32 of the Lanham Act was used to initiate and establish a successful infringement claim. All three of criteria were satisfied. The sale of the impugned machines affected the ability of the American company to import its gaming machines into the Venezuelan market. Secondly, the alleged activity adversely affected the American company's profitability as sales from machines that could have been sold to the Venezuelan consumer market were forfeited. The inability to facilitate sales to the Venezuelan market is indicative of 'cognizable injury' to the American trademark holder.

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<sup>704</sup> Section 45 of the *Lanham Act* reinforces this point.

<sup>705</sup> *Aristocrat Technologies Inc v High Impact Decision & Entertainment* 642 F. Supp 2d 1228.

The third criterion involves a balancing test<sup>706</sup> which I've identified as involving economic and legal considerations in both jurisdictions. Although the factors used in the balancing test vary among circuit and district courts, they are essentially similar.<sup>707</sup> The legal considerations which are implicated are subsequently discussed. Firstly, the degree of conflict in law and policy between both jurisdictions concerning the registration of the product is instrumental to the application of the act. In this case, the defendant had registered the gaming machines as trademarks in Venezuela, which brought the proceeding within the jurisdiction of the Venezuelan government. The court opined that there was a high potential for conflict if United States authority were asserted to resolve an issue that was already within the jurisdiction of local Venezuelan authority. However, other legal considerations trumped this specific factor in favor of an assertion of the *Lanham act*. A majority of the defendants were American citizens and had strong affiliations with the United States, as a segment of the defendant's business was carried out in Nevada, United States. Comparatively, the court also envisaged that compliance efforts were more likely to be effective in the United States as the defendants' principal place of business was located in that jurisdiction. The defendants also had substantial assets in the United States.

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<sup>706</sup> *Ocean Garden v MarkTrade Co Inc.* 953 F2d 500, 504 (9<sup>th</sup> Cir 1990); *Reebok Intern Ltd v Marnetech Enterprises Inc.* 970 F 2d 442 (CA).

<sup>707</sup> As an example, the fourth circuit court uses three factors in its analysis: (a) The effect on United States Commerce, (b) the citizenship of the defendant, and (c) conflict with foreign law. See *Basis Intern Ltd v Research In Motion Ltd* 827 F 2d 1302.



The fourth factor which is instrumental to the balancing test is the economic effects of the alleged activity on United States commerce. As courts have opined,<sup>708</sup> the greater the economic loss to the United States corporation the more justified is an assertion of extraterritorial jurisdiction. In the *Aristocrats* gaming machines case above, the ninth circuit court held that the unauthorized use of the American company's trademark in Venezuela negatively affected the company's profitability and trade between both jurisdictions.

The extent to which the foreign enterprise intended to harm American commerce is also considered in the balancing analysis. The courts have analyzed 'intention' on a case by case basis. In *Aristocrats*, the defendants had falsely represented to the plaintiffs that the registered Venezuelan trademark would have been assigned to the plaintiffs subsequent to its registration. Their refusal to assign the trademark was deemed by the ninth circuit court as an intentional act of infringement. The final factor concerns outweigh of the conducts related to the violations in both jurisdictions. A finding that most of the violations which caused the infringement occurred in the foreign jurisdiction is likely to facilitate an exercise of extraterritorial jurisdiction. Of course, this factor must be analyzed cumulatively with the other considerations in the balancing test. The court in *Aristocrats* admitted that sales of the infringing gaming products occurred in Venezuela, but also opined that the defendants' actions involved the false representation of United States products. The court was unable to conclusively decide this factor as comparatively

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<sup>708</sup> *Ocean Garden v MarkTrade Co Inc.* 953 F2d 500, 504 (9<sup>th</sup> Cir); *Star Kist Foods Inc. v P J Rhodes & Co.* 769 F 2d 1383.

between jurisdictions, it noted that there was no single incident which had a more substantial impact on the violation.

The extra-territorial analysis was also salient in granting a successful infringement claim<sup>709</sup> against the Canadian company Research in Motion's (RIM) use of an American company software trademark in its conference show exhibits in Singapore. The court held that RIM's use of the trademark,<sup>710</sup> albeit in a conference setting in a foreign country (Singapore) likely confused consumers as to its source, which affected the profitability of the American software company. RIM's extensive business presence in the United States was another decisive factor in granting the extraterritorial jurisdiction of the *Lanham Act* to prevent further infringement.

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As section 32 stipulates, its provision is applicable to all registered marks under the *Lanham act*. This is inferred in section 32(1) (a) and (b) which uses the term a "registered mark" to refer to marks which are entitled to the use of the provision. As such, certification marks are subjected to section 32, and importantly, right holders are entitled to use of the provision on an infringement action. This point is of course dependent on the actual registrability of the certification mark, that is, its validity according to the *Lanham act*.<sup>711</sup>

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<sup>709</sup> *Basis Intern Ltd v Research in Motion Ltd* 828 F Supp 2d 1302.

<sup>710</sup> *Ibid*, para 4-7.

<sup>711</sup> I have discussed this requirement in the first section of this chapter.

Infringement remedies<sup>712</sup> are restricted to injunctive relief in circumstances where the defendant is an innocent infringer or, the business's sole involvement was limited to printing or advertising the infringed mark. In such instances, the specific relief which is applicable is an injunction<sup>713</sup> against the further printing or advertising of materials containing or illustrating the registered mark. The test to determine whether the defendant is an 'innocent infringer' is based on what is "objectively reasonable"<sup>714</sup> in the circumstances. Relying on this interpretation, a commercial printer<sup>715</sup> could not claim an innocent infringer status for publishing a Century 21 mark in a telephone directory, since he had knowledge that the business was no longer a Century 21 franchise.<sup>716</sup> The classification of an action as 'objectively reasonable' is based on the proposition that the infringer did not knowingly partake in the infringement, but did so without actual or constructive knowledge that its usage of the mark is unauthorized.

I maintain that the most significant hurdles to an infringement claim posed by section 32 for foreign rights holders are those associated with proving a likelihood of confusion, and satisfying the 'in commerce' threshold.

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<sup>712</sup> Section 32 (2) a and 2(b), *Lanham Act*, Trademark Remedies and Infringement.

<sup>713</sup> *Ibid.* But see *Tiffany Inc v EBay Inc* 576 F Supp 2d 463, aff med 600 F 3d 93(2d Cir): The defense of innocent infringer held not applicable to Ebay as it did not merely display the infringing trademark on its website, but maintained adequate control over the listing on its site.

<sup>714</sup> *Ibid.*

<sup>715</sup> *Century 21 Real Estate Corp v R.M Post Inc* 8 USPQ 2d 1614.

<sup>716</sup> *Ibid.*

#### **4.2.5. Section 43(1) a and (b) of the *Lanham Act***

Pursuant to section 43 1(a),<sup>717</sup> the false designation of goods as originating from a source which differs from its actual origin, and which causes or is likely to cause confusion, deception or mistake among consumers, results in a trademark infringement for civil actions. The provision also extends coverage to marks which are used in a commercial context to falsely represent as marks from a specific geographic origin.<sup>718</sup> The section also applies to the failure of importers to disclose the actual origin of products.<sup>719</sup> I note with emphasis that the section does not pertain to claims of false registration. Therefore, a defendant's false misrepresentation denoting that its product is trademark registered is not within the scope of a section 43 (1) a claim.<sup>720</sup>

The prohibition against misrepresentation of geographic origin is a stand-alone provision; there is no requirement for an analysis on the likelihood to confuse the consumer. In comparison, litigation concerning the false designation of goods necessarily requires proof that the consumer is or, is likely to be confused by the usage of

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<sup>717</sup> Section 43 (1) a: Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which— is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.

<sup>718</sup>Section 43 a 1(b), Lanham Act: in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

<sup>719</sup> *Alto Products Corp v Ratek Industries Ltd* 40 USPQ 2d 1738.

<sup>720</sup> *Computer Associates Int'l Inc v Computer Automation Inc.* 678 Supp 424.

the mark. There has been varying success by plaintiffs' use of section 43 1(a) and 1(b) to prohibit misrepresentations on the geographic origin of their products, or to prevent its usage in a manner to cause confusion amongst consumers. The misrepresentation of a product's geographic origin refers to misrepresenting its origin in advertising to consumers.<sup>721</sup> In *Penord Ricard*, Cuba's Havana rum<sup>722</sup> was unsuccessful in their attempt to prevent Bacardi's Havana Club brand from using the Havana Club name on its label. Despite the similarity in name, the court opined that Bacardi explicitly stated on each bottle that the rum was made in Puerto Rico. There was no reference to a Cuban origin. The court ruled there was an unambiguous differentiation in geographic origin between both products which could not result in infringement.

The judicial analysis of the cases is based upon different approaches on the substantive matters involved. The Court of Appeal emphasized that its decision was not based on an analysis of the registrability of "Havana Club" as a trademark but, on the prospects of falsely misrepresenting the good's geographic origin through advertising. Fundamentally therefore, the court's decision did not preclude the plaintiff initiating an action for trademark infringement under section 43 1(a) of the act.

Although evaluated based on section 2(e) of the *Lanham Act*,<sup>723</sup> a different decision<sup>724</sup> was reached regarding the proposed use of the term Havana by Bacardi in relation to rum

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<sup>721</sup> *Penord Ricard USA LLC v Bacardi USA Inc* 653 F 3d 241.

<sup>722</sup> *Ibid.*

<sup>723</sup> Refer to section above for an analysis of section 2 e.

and alcoholic cocktails. The Trademark Trial and Appeal Board held that Bacardi's intended registration of the Havana mark was 'geographically deceptively mis-descriptive',<sup>725</sup> leading customers to justifiably assume that the products originated in Cuba. The crucial difference between section 2(e) and section 43a 1(b) analysis is that the latter is primarily concerned with false advertising of the geographic origin of the product. It may appear that the result is semantic. The term 'Havana' is widely known in the United States to affiliate with Cuban rum. However, labeling that ambiguously indicates that the product originates from a source outside of Cuba, distinguishes the brand from its Cuban counterpart. The Court of Appeal in the Havana Club case also asserted that the decision may have been different if the Puerto Rican origin of the rum was illegibly printed on the label.

Falsely re-branding a product without the right holders' authorization by removing its original label is prohibited under section 43(1)a as false designation. Courts have defined this practice as 'express reverse passing off'.<sup>726</sup> In the next three paragraphs, I will discuss the approach courts have taken in adjudicating matters pertaining to the false designation of goods.

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<sup>724</sup> *In re Bacardi & Co. Ltd* 48 USPQ 2d 1031.

<sup>725</sup> *Ibid.*

<sup>726</sup> *Web Printing Controls Inc. v Oxy Dry Corp* 906 F 2d 1202; *Federal Electric Co Inc v Flexlume Corp* 33 F 2d 412. *Roho Inc v Marquis* 902 F 2d 356, 359 (5 Cir).

Courts have interpreted the term “false designation” to relate to<sup>727</sup> a producer or manufacturers’ misrepresentation on the source of origin of goods sold in a commercial context. This may include the act of mis-labeling or re-labeling products which results in consumers’ misperception of the actual origin of the goods, thereby causing consumer injury.<sup>728</sup> The Supreme Court<sup>729</sup> has noted that “origin” refers to the producer of the tangible final/finished product. A successful false designation claim encompasses the fulfillment of four conditions.<sup>730</sup> The plaintiff must prove that the contested product originated with its own enterprise as opposed to that of the defendant.<sup>731</sup> Secondly, the source of the product must have been falsely represented by the defendant. The false designation must likely cause confusion among consumers. Finally, the plaintiff must have incurred harm from the defendant’s false designation of origin.

There is an absence of consistency in case law on the incidences of re/mis-labeling which constitute false designation. Essentially, the result is dependent upon the substantive nature of the cases. I use the term re-labeling to refer to the removal of the original manufacturers label and its replacement with the defendant’s own label. False designation does not apply to the use of a producer’s good as a component in the

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<sup>727</sup> *Dastar Corp v Twentieth Century Fox Film Corp* 123 S. Ct. 2041, 66 USPQ 2d 1641 (US. 2003). [“Dastar”].

<sup>728</sup> *Ibid.* The court has interpreted consumer injury as a buyer’s deception as to the origin of a product, based on its labeling.

<sup>729</sup> *Darstar*”, *supra* note 727.

<sup>730</sup> *Lipton v Nature Co.* 71 F 3d 464 (2 Cir 1995); *Sygenta Seeds Inc v Delta Cotton Co-op Inc* 457 F 3d 1269.

<sup>731</sup> *Ibid.*

defendant's finished product. This jurisprudential interpretation led the court in *Bretford Manufacturing*<sup>732</sup> to assert that the inclusion of the plaintiff's component in the manufacture of the defendant's table did not constitute false designation.

Similarly, a contention by a cushion manufacturer over trademark infringement<sup>733</sup> was refuted by the fifth circuit court on the basis that the cushion's inclusion in the defendant's final product was not false designation. In *Roho*,<sup>734</sup> the defendant had purchased several of the plaintiff's cushions, removed the labels, sewn them together, and sold the product as bed mattresses. The court held that there was no liability as the defendants' final product was distinguishable from that of the original product. Violation of the Lanham act is not primarily founded on physical differences between the plaintiff's product and the defendant's final product. In *Syngenta Seeds*,<sup>735</sup> the Court of Appeal held that the re-packaging of the plaintiff's seed by the defendant, and the use of its own brand name on the re-packaged bags, did not constitute a violation of section 43 1(a).

The Court's analysis centered on a query of the reputational harm incurred by the plaintiff's trademark from the repackaged product. It found none, based on its opinion

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<sup>732</sup> *Bretford Manufacturing Inc v Smith System Manufacturing Corporation* 419 F 3d 576, 75 USPQ 2d 1858 (7<sup>th</sup> Circuit).

<sup>733</sup> *Roho Inc v Marquis* 902 F 2d 356 (WL).

<sup>734</sup> *Ibid.*

<sup>735</sup> *Syngenta Seeds Inc v Delta Cotton Co-op Inc.* 457 F 3d 1269 (WL).



that consumers were not aware that they were purchasing a different seed type than that which was on the stated packaging. The decision was highly influenced by the intended purpose of the re-packaged items, which differed from that of the plaintiff's crop seed. According to the court's analysis, there was no substantial correlation between the Syngenta's seed and that of the defendant's. The defendant's product was primarily sold for animal feed purposes, and packaged under its own brand.<sup>736</sup> The court opined that Syngenta incurred no reputational harm as the defendant's activities<sup>737</sup> were geared towards a different commercial purpose than the owner's brand. Therefore, this informed its conclusion that Syngenta Seeds was not deprived of its market share.

The rationale for this decision is undoubtedly premised on the limits of trademark law. The purpose of trademark protection<sup>738</sup> is to promote the right holder's product, through fostering customer retention and extension and enhancing its commercial reputation. This is attained through branding. However, the trademark does not protect the functionality<sup>739</sup> of the product, that is, those characteristics which are based on its novelty and non-obviousness. Trademark protects the non-functional characteristics of the product. These non-functional characteristics are those features that are not essential

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<sup>736</sup> *Ibid.*

<sup>737</sup> *Ibid.*, para 10-13.

<sup>738</sup> *General Baking Co. v Gorman* 3 F 2d 891 (CCA 1<sup>st</sup> Cir 1925); *Coach Inc v We Care Trading Co Inc.* 67 Fed Appx 626 (2 Cir. 2002). Frank Schechter, *The Rational Basis of Trademark Protection*, (1927) 40 *Harv L Rev* 813.

<sup>739</sup> *Pagilerio v Wallace China Co.* 1952 CA 9 (WL).

to the use or purpose of the product, or do not affect its cost or quality.<sup>740</sup> Although the court did not expressly discuss the functionality of the impugned product, this analysis was inferred in discussions concerning the plaintiff's patent infringement claim<sup>741</sup> for breach of the *Plant Variety Protection Act*.<sup>742</sup> Functionality is more closely aligned with patent rights. I will not discuss this issue since it is not the focus of this thesis.

As *Dastar* indicates,<sup>743</sup> the Supreme Court later clarified the scope of false designation claims by firmly asserting that it is applicable to situations in which the source of the final product is misrepresented, and the customer is deceived by the misrepresentation. The defendant *Dastar* had acquired, extensively edited and commercially sold a compilation of world war II video series, using its own label on the final product. A violation of section 43 (1)a was not found, on the basis that there was no misrepresentation of the origin of the final product; the videotape manufacturer was *Dastar*. The court further asserted that if the defendant had purchased the plaintiff's videotape and merely repackaged the acquired tapes as its own, the false designation claim would have been upheld.

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<sup>740</sup> *Hartford House Ltd v Hallmark Cards Inc* 1986 DC Colo; 647 F Supp 1533.

<sup>741</sup> *Syngenta*, *supra* note 720.

<sup>742</sup> Protectability of Plant Varieties and Certificates of Protection. 7 USCA 2483 PPVA, Section: (1) Every certificate of plant variety protection shall certify that the breeder (or the successor in interest of the breeder), has the right, during the term of the plant variety protection, to exclude others from selling the variety, or offering it for sale, or reproducing it, or importing it, or exporting it, or using it in producing (as distinguished from developing) a hybrid or different variety there from, to the extent provided by this act.

<sup>743</sup> *Supra* note 712.

A false designation of origin claim may be applicable to foreign right owners of certification mark under the following situation. A certification mark which not only denotes the quality of the product, but also explicitly stipulates as a part of its branding, its geographic origin may claim under section 43.1(a) on infringements of misrepresentation of origin. As such, the claim presupposes that the alleged infringer has falsely designated the certification marks' owner's product as its own or that of another. In the absence of reciprocal geographical indication legislation in the United States, GIs' registered as certification marks may resort to this provision in applicable situations.

#### **4.2.6. Trademark Dilution and Famous Marks**

The prevention of trademark dilution for famous marks is also explicitly noted in section 43.<sup>744</sup> A trademark dilution claim is available for rights holders whose marks are famous and distinctive<sup>745</sup>, and have been used in commerce to impair the distinctiveness of the owner's mark. Dilution may either be caused by tarnishment or blurring of the mark.<sup>746</sup> A claim for dilution by blurring<sup>747</sup> occurs if a right holder's mark has been used to associate with another product in a manner which is likely to non-distinguish to the consumer the right holder's product from that of the alleged infringer. Dilution by

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<sup>744</sup> *Ibid*, section 43 3(c).

<sup>745</sup> Distinctiveness may be inherent or acquired, section 43 3(c) *Lanham Act*.

<sup>746</sup> *Ibid*. Barton Beebe, "A Defense of the New Federal Trademark Anti-Dilution Law" (2006) 16:4 *Fordham IP Media Ent. L J* 1143. Stacey L. Duggan, "What is Dilution Anyway" (2006) 105:8 *Michigan L R First Impressions* 103.

<sup>747</sup> *Starbucks Corp v Wolfe's Borough Coffee Inc.* 588 F 3d 97, (105 2 Cir 2009); *Deere & Co v MTD Products* 41 F 3d 39.

‘tarnishment’ occurs if the right holders’ trademark is used to by another entity in a manner which either associates or connotes an affiliation with the senior’s mark. These two scenarios are discussed in the sections below. Prior to a recent amendment, trademark dilution claims were barred against federal registrants.<sup>748</sup>

A rights-holder may only proceed with a trademark dilution claim if its mark is famous. This “famous” criterion creates an obstacle for rights holders whose marks have not attained this status, and nullifies a claim for dilution. According to section 43 1(c), courts may consider the following non-exclusive factors in assessing if a mark is famous or distinctive. In analyzing the judicial interpretation which has been accorded to these factors, I shall consider most of them accumulatively. A mark is famous based on:

- (a) the degree of inherent or acquired distinctiveness of the mark;
- (b) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
- (c) the duration and extent of advertising and publicity of the mark;
- (d) the geographical extent of the trading area in which the mark is used;
- (e) the channels of trade for the goods or services with which the mark is used;
- (f) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought;
- (g) the nature and extent of use of the same or similar marks by third parties; ....<sup>749</sup>

The juridical interpretation of this provision has led to the protection of marks which have acquired household fame. Some courts stipulate that the mark should be ‘inherently

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<sup>748</sup> Louis Pollack and Malla Pollack, *Legal Theories of of Liability, Dilution. Callmann on Unfair Competition, Trademark and Monopoly (WL)*.

<sup>749</sup> *Lanham Act*, section 43 (1) c.

distinctive, and assert that a mark's fame is based on its 'acquired distinctiveness'. The level of acquired distinctiveness is based upon the ability of the mark to self-identify as being associated with the concerned product in the marketplace.<sup>750</sup> It must be well known as the mark which is affiliated with the product, a position which is earned based on its commercial exposure.

In contrast to this, inherent distinctiveness relates to the mark's "theoretical capacity to serve forcefully as an identifier of its owner's goods, regardless of whether the mark has fulfilled those expectations".<sup>751</sup> As firmly stated by congress in its 1995 report on trademark dilution, the provision on famous marks was intended to exclude marks which were only known in parts of the country, and whose commercial existence was comparatively short in duration.<sup>752</sup> This excludes marks which are only known in niche sectors, and primarily is applicable to marks which are generally well known.<sup>753</sup> In *Friesland Brand BV*,<sup>754</sup> the plaintiff failed to prove its trademark was famous as the court opined that its sales were comparatively negligible, and its advertising limited to publication in a single newspaper in one city. In contrast to this finding, Burberry brand

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<sup>750</sup> *Burberry Ltd v Euro Moda Inc* 2009 WL 1675080; *TCPIP Holding Co v Haar Comms Inc.* 244 F 3d 88 (WL).

<sup>751</sup> *TCPIP Holding Co v Haar Comms Inc.* 244 F 3d 88 at 97.

<sup>752</sup> House Report. 104-375.

<sup>753</sup> *Christopher P. Smithers Found Inc v St. Luke's-Roosevelt Hospital Ctr.* 2003 WL 115234.

<sup>754</sup> *Friesland Brand BV v Vietnam Nat Milk Co.* 228 F Supp 2d 399.

of clothing and fashion items<sup>755</sup> was held by the second circuit court to be a famous mark, based on its wide-scale commercial exposure in the United States consumer market.

The dilution provision has been applied sparingly and inconsistently by courts. Courts have been cautious of a monopolistic application of the dilution remedy, safeguarding against a stifling of free competition in the consumer market. Opponents and the more cautious trademark scholars have argued that an expansive application of the dilution remedy prevents others from using either a similar or the concerned mark on dissimilar products and services.<sup>756</sup>

Dilution has also been questionable and contestable as an action that can damage the viability of famous marks. This is based upon the perception that consumer recognition of famous marks is strongly associated with the distinctive quality or feature of the product. In circumstances where the trade mark is used on a dis-similar product or service, the likelihood of diluting the impugned brand name is dependent on the reputation and strength of the mark. Marks which are established in the consumer market are those which attract strong consumer recognition in the commercial context. I argue

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<sup>755</sup> *Burberry Ltd v Euro Moda Inc* 2009 WL 1675080.

<sup>756</sup> B. Beebe, A Defense of the New Federal Anti-dilution Law (2006) 16 *Fordham IP Media Ent L J* 1143. Handler Are the State Anti-dilution laws Compatible with the National Protection of Trademarks (1985) 75 *Trademark Rep.* 269. J.T. McCarthy Proving a Trademark has been Diluted: Theories or Facts (2004) 41 *Houston L Rev* 713.

that contestations over the usefulness and expansiveness of trademark dilution are based on the inability to establish a general limit on the application of the concept.

Dilution by blurring is the gradual diminution in the strength of the plaintiff's mark by the junior user's use of the mark to associate with its product or service, resulting in its inability to function as a unique identifier of the plaintiff's mark. The distinctiveness of the mark must have been diminished by the existence of the impugned mark. In regards to blurring, "distinctiveness" refers to the "ability of the famous mark uniquely to identify a single source and thus maintain its selling power".<sup>757</sup>

Dilution by blurring results only if there has been a subliminal connection<sup>758</sup> of the plaintiff's mark in the consumer's mind with that of the junior user's product or service. If no mental connection exists then the plaintiff's action cannot be sustained. As cases have asserted, the likelihood of dilution will suffice for an application of the provision; actual dilution does not need to be proven. In *Tiffany (NJ) v Ebay*,<sup>759</sup> the sale of counterfeit Tiffany jewelry by the online retailer failed as a dilution claim as Ebay did not associate the Tiffany brand with any other product except with that of the brand itself. Despite the counterfeit nature of the jewelry, they were not offered for sale as an affiliation of another brand. This fact pattern negated a claim for dilution by blurring.

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<sup>757</sup> *Louis Vitton Malletier S.A v Haute Diggoty Dog LLC* 507 F 3d 252.

<sup>758</sup> *Fruit of the Loom Inc v Girouard* 994 F 2d 1359.

<sup>759</sup> *Tiffany (NJ) v eBay Inc* 600 F 3d 93.

The term ‘tarnishment’ as used in trademark dilution encompasses claims in which the plaintiff’s trademark is used in association with a non-affiliated product or service, and its usage damages the reputation of the plaintiff’s mark. The term applies when the goodwill and reputation of a trademark are damaged by its association with a product or service of a disreputable or shoddy quality. Prior to 2006, dilution by ‘tarnishment’ was not explicitly recognized under the Lanham Act. This subsequently changed in 2006 on the revision of the Federal Anti-Dilution Act, in which ‘tarnishment’ is specifically enumerated as a dilution claim.<sup>760</sup>

In dilution by tarnishment claims, there must be an identifiable harm to the plaintiff’s trademark caused by its association with an inferior quality or shoddy product. The concept also applies to the association of the plaintiff’s mark with ‘unwholesome wares’, ‘obscene enterprises’<sup>761</sup> and illegal activities.

In *Starbucks v Wolfe’s Borough Coffee Inc*,<sup>762</sup> the plaintiff was unsuccessful in its dilution by tarnishment claim as the court held that the defendant’s use of the term “Charbucks Blend” was insufficient to establish a likelihood of dilution. The defendant manufactured and sold coffee under the brand name “Charbucks Blend”. The court asserted that the mere use of the name did not infer that customers associated a negative

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<sup>760</sup> *Lanham Act*, section 43(c).

<sup>761</sup> *Polo Ralph Lauren L.P v Schuman* 1998 WL 110059; *J&B Wholesale Distributing Inc v Redux Beverages LLC* 2007 WL 4563457.

<sup>762</sup> *Starbucks v Wolfe’s Borough Coffee Inc* (2009) 588 F 3d 97 (WL).



mental connotation with the brand only by reference to the mark ‘Charbucks Blend’. The reasoning was based on the reputation of the defendant’s coffee, which was valued by its consumers, and unlikely to create a negative connotation of the Starbucks trademark. This case is distinguished by *Diane Von Furstenburg Studio*<sup>763</sup> (DCF) in which the defendant used the plaintiff’s trade mark on its inferior quality dresses which were of “shoddy workmanship”.<sup>764</sup> The court rightly held that the association of the DCF brand with the defendant’s clothing line marred the reputation of its high quality products.

Certification rights holders may claim under section 43 1(c) only if their marks are famous. This excludes the accessibility of the dilution remedy claim to certification marks which are not well known in the United States’ consumer market. On this basis, agricultural and food based products registered as certification or collective marks in the United States which have not gained wide-scale consumer recognition, are blocked from capitalizing on this provision of the *Lanham act*. This situation further justifies the need for reciprocal recognition of agricultural and food based geographical indications in the Third World’s main international consumer markets. This is not forthcoming in the United States.

In the next section, I discuss United States *Tariff Act’s* approach to infringement of certification marks.

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<sup>763</sup> *Diane Von Furstenburg Studio v Synder* 2007 WL 2688184.

<sup>764</sup> *Ibid*, para. 4.

#### 4.2.7. Violations of Certification Marks under Tariff Act, section 526(e)

The importation of counterfeit products registered as certification marks are explicitly prohibited as a violation of the Tariff Act.<sup>765</sup> On this basis, the section<sup>766</sup> functions to prevent the importation of counterfeit goods in the United States. The importation of counterfeit certification mark products is a violation of the custom laws, and such products are subject to seizure.<sup>767</sup> The provision is applicable to certification marks which have been used without the authorization of rights holders on products to falsely denote a product's affiliation with the brand.

Under section 526(e), the concept of 'counterfeit' is based upon the average consumer's perception of a false product.<sup>768</sup> Three requirements must be met prior to a claim under this section. The products must be of foreign origin, be labeled with a counterfeit mark, and must have been imported in violation of the *Lanham Act*.<sup>769</sup> Counterfeit is defined as "a spurious mark...used in connection with trafficking in any goods that is identical to or substantially indistinguishable from a mark registered...".<sup>770</sup> Section 42 of the *Lanham Act*<sup>771</sup> prohibits the importation of articles which falsely denote a trademark that is

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<sup>765</sup> *Tariff Act*, section 526 (e) [*Tariff Act*].

<sup>766</sup> For a history of the Tariff Act see F.W.Taussig, *The Tariff History of the United States Part I* (5<sup>th</sup> online edition) (New York: The Knickerbocker Press: 2003).

<sup>767</sup> *Tariff Act*, *supra* note 765.

<sup>768</sup> *Montres Rolex S.A v Synder* 718 F 2d 524.

<sup>769</sup> *United States v 10510 Packaged Computer Towers, More or Less*, 152 F. Supp 2d 1189.

<sup>770</sup> 15 United States Code Annotated sec 1127.

<sup>771</sup> *Lanham Act*, section 42. No article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer, or trader, or of any manufacturer or trader located in any

federally registered in the United States. The section further recognizes as a violation the use of a foreign manufacturers' name on a counterfeit<sup>772</sup> product, and the false designation of origin of foreign products.<sup>773</sup>

The section also applies to importers which have used certification marks on products that are not associated with the actual mark. In *US v Able*,<sup>774</sup> the Tommy Hilfiger mark was labeled on watches, a product which the brand did not manufacture as a part of its product line. On the seizure of the counterfeit goods by customs and an appeal of the judgment, the ninth circuit court held that seizure under the *Tariff act* applied. The ruling was made even though at the time of importation Tommy Hilfiger was not a manufacturer or seller of watches. The court opined "...customs may impose a civil penalty pursuant to section 526<sup>775</sup> upon an importer of merchandise bearing a counterfeit mark, even though the owner of the registered mark does not manufacture the same type of merchandise".<sup>776</sup> It was the use of the registered mark which constituted a violation the act. Section 526(e) is not a standalone provision; it does not operate without the

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foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trademark registered in accordance with the provisions of this Act or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any customhouse of the United States.

<sup>772</sup> Under the *Lanham Act*, counterfeit trademarks are those which are identical to the original mark.

<sup>773</sup> *Ibid.*

<sup>774</sup> *United States v Able Time Inc.* 545 F 3d 824.

<sup>775</sup> *Supra* note 711, "Tariff Act".

<sup>776</sup> *Supra* note 718.

active involvement of certification mark right holders and the United States Custom department. As such, to initiate seizure and forfeiture procedures, right holders must notify the custom department of suspected infringement. However, foreign certification mark holders are unable to register their marks with customs, as a means of capitalizing on this provision unless there is an existing treaty operating between the trading partners' countries.

Section 42 of the *Lanham Act* explicitly stipulates that foreign certification marks may record their trademark registration with United States customs, as long as there is an existing treaty or convention between both countries. I make note of this point for the following reason. The prevention of counterfeit imports under the Tariff Act makes specific reference to section 42 of the *Lanham Act*.<sup>777</sup> Foreign rights holders who are unable to capitalize on the Tariff Act's provision for the recordation of registration, may utilize the *Lanham Act* as a basis of trademark recordation with United States customs. Therefore, this provision provides an alternative medium for the recordation of certification mark registration with United States customs.

#### **4.2.8. The Common law and Certification Marks**

It is possible for certification marks to be protected under common law that is, the extension of protection without federal or state registration. There is a caveat to this mode of protecting certification marks as it restricts the infringement remedies that are

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<sup>777</sup> This is discussed earlier in the section.

accessible to the rights holder. Importantly, the dilution remedy is only applicable under statutory law.<sup>778</sup>

There have been few cases<sup>779</sup> decided under the common law related to the infringement of certification marks. The common law was used to validate Cognac's brandy as an alcoholic beverage from the Cognac region of France,<sup>780</sup> despite the absence of regional or state registration. The Trademark Board held that the term was not a generic term for brandy. According to the Board, Cognac is reserved as a brand through international bilateral agreements between France and the United States. As such, the United States is obligated to preserve the brand in local consumer markets as that which is associated with brandy from Cognac, France.<sup>781</sup> On this basis, it is apparent that the existence of a bilateral or multi-lateral treaty specifying reciprocal protection for product names, the common law may be used to safeguard the rights of certification marks.

It has been held that the reputation which a brand has attained,<sup>782</sup> as well as its years of commercial existence may justify the validation of a certification mark under the

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<sup>778</sup> Restatement (Third) of Unfair Competition section 25: One may be subject to liability under the law of trademarks for the use of a designation that resembles the trademark, trade name, collective mark or certification mark of another without proof of a likelihood of confusion only under an applicable dilution remedy.

<sup>779</sup> *State of Florida v Real Juices Inc* 330 F Supp 428; *Pillsbury-Washburn Flour Mills Co v Eagle* 86 F 608 (7<sup>th</sup> Circuit).

<sup>780</sup> *Institut National Des Appellations d'Origine v Brown-Forman Corp* 47 USPQ 2d 1875, 1998 WL 650076 (TTAB 1998).

<sup>781</sup> *Ibid.*

<sup>782</sup> *Ibid.*

common law. This is based on the rationale of preventing unfair competition.<sup>783</sup> As a means of obtaining optimal protection for certification marks (notwithstanding the limitations for geographical indication rights holders) most foreign rights holders of federally register their mark. Therefore, although the common law is applicable to certification marks, I argue that it is an avenue which will be rarely used by foreign rights holders. The more versed the right holders are in international intellectual property law; the keener will be their aptitude in ensuring that the most viable form of protection is accorded to their products. Under the common law, trademark dilution remedy is not available to certification mark holders. On this basis, although applicable to certification marks, the common law restricts the remedies available to a certification mark rights holder.

#### **4.2.9. Infringement actions: Choice of courts and costs.**

The cost of litigating trademark infringement in the United States is often exorbitant. Litigants from small Third World economies encounter more significant challenges based on exchange rate issues which may create an obstacle to initiating litigation proceedings. A claim may be initiated in either the federal or state court. Both courts have concurrent jurisdictions.<sup>784</sup> As affirmed in *Mims v Arrow*, “in cases arising under federal law there is a deeply rooted presumption in favor of concurrent state

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<sup>783</sup> Unfair competition is governed by each state’s common law and relates to actions which confuse consumers as to the source or origin of products. See American Law Institute, Restatement of the Law, Third Unfair Competition (Michigan: American Law Institute, 1995).

<sup>784</sup> *Tafflin v Levitt* 493 US 455, *Mims v Arrow Financial Services LLC* 132 Sct 740 [‘Mim’].

jurisdiction...”.<sup>785</sup> Comparatively, proceedings in federal courts are more expensive than those initiated in state courts. Although a claimant may initiate proceedings in a state court, the defendant may choose to continue the case in a federal court. This is permissible and may be disadvantageous to a plaintiff with limited resources to obtain federal legal representation.

Resource limitations are the most significant hurdle for a foreign geographical indications right holders with interest in initiating and sustaining an infringement action. I argue that famous brands are in a more advantageous position in securing litigation funding than are less popular brands. I make this argument based on the following reason. A product which has attained significant commercial success in selected international consumer markets is more likely to be legally monitored by more than one stakeholder in its domestic jurisdiction. In the case of geographical indication products registered as certification marks in the United States, foreign stakeholders may include the producer group, as well as government bodies which have an interest in safeguarding and promoting the product’s association with its geographic origin. On this basis, procuring funds for infringement proceedings, although challenging, is still feasible.

### **4.3. Geographical Indications in the European Union: EC Regulation 1151/2012**

#### **4.3.1. Politics Driving Policy**

The European Union is the third largest consumer market for Jamaica’s Blue Mountain coffee. Consumer demand is an integral component of fostering geographical indications

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<sup>785</sup> *Ibid, Mim.* The case concerned whether state courts had the exclusive jurisdiction over a claim to privately enforce an act against abuses of telephone technology.

as an intellectual property asset for Jamaica. Products which are not well known internationally, may gain increased recognition in overseas markets by Jamaican nationals who have emigrated, and have sustained a fondness for native foods. The European Union's general approach to geographical indications was critically examined in chapter 3. However, the sections below examine the approach the European Court of Justice has adopted in interpreting EC Regulation 1151/2012,<sup>786</sup> and its implications for foreign right holders of geographical indications. The implications are made specific to Jamaica and the Caribbean.

Geographical Indications have been legally recognized as a separate and distinct from of intellectual property right in the European Union since 1992.<sup>787</sup> The European Commission governs the administration of geographical indications in the European Union through its Council Directive Regulation 1151/2012.<sup>788</sup> Significant amendments were made to the regulations in November 2012, to provide for a coherent, producer and product centered approach to the commercialization and advancement of agricultural products and foodstuff.<sup>789</sup> The European Union has taken an innovative approach to the advancement and safeguard of agricultural and food based geographical indication

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<sup>786</sup> *Council Regulation (EC) No. 1151/2012* 21 November 2012 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs. ["EC Council Regulation 1151/2012"].

<sup>787</sup> I covered this point in chapter 3.

<sup>788</sup> *EC Council Regulation 1151/2012*, Eur-Lex- Access to European Union Law, *supra* note 786.

<sup>789</sup> *EC Council Regulation 1151/2012*, *supra* note 786. The regulation that was in force prior to Regulation 1151/2012 was *EC Council Regulation 510/2006* and *2082/92*.



advancement, on the premise that the region recognizes that they possess a comparative advantage in this area of intellectual property. The emphasis is on conveying high standard of information to consumers, on respect for intellectual property, and on sustainably providing fair remuneration to farmers, a structure built upon a diversification in agricultural practices.<sup>790</sup>

The European Union is instrumental in the diffusion of geographical indication norms internationally. I use the term norm diffusion<sup>791</sup> to refer to the process and transformation of specific policies, rules, laws and principles from an international actor(s) to the domestic arena. The transferred dominant norms are domestically institutionalized through local actor's acceptance of such policies, and are internalized as rules. Norm diffusion can also occur as a bottom-up process.<sup>792</sup> In the latter case, specific norms of an influential domestic actor are transplanted in the international fora, and become a

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<sup>790</sup> *EC Council No. 1151/2012, supra* note 786 Article 1(1), 1(2) and Article 4. Article 4: A scheme for protected designations of origin and protected geographical indications is established in order to help producers of products linked to a geographical area by: (a) securing fair returns for the qualities of their products; (b) ensuring uniform protection of the names as an intellectual property right in the territory of the Union; (c) providing clear information on the value-adding attributes of the product to consumers.

<sup>791</sup> Annika Bjorkhal, Norm-maker and Norm-Taker: Exploring the Normative Influence of the European Union in Macedonia, (2005) 10:2 *Euro For Aff Rev* 257; Judith Kelley, *Ethnic Politics in Europe. The Power of Norms and Incentives* (Princeton: Princeton University Press, 2005); Martha Finnemore, *National Interest in International Society*, (Ithaca: Cornell University Press, 1996). See also Matthias Hofferbach & Christian Weber who caution that a constructivist approach to norm analysis should start from the premise that norms are not standards of behavior – a perspective that suggests that they are independent variables which do not change. Hofferbach and Weber assert that norms should be envisaged as outlooks which are socially produced, therefore 'ever changing'. Such a notion of norm construction facilitates expansive discussions on actors, the formation of interests and identities and asymmetries in choice of policies in international relations. Matthias Hofferbach & Christian Weber, *Lost in Translation: A Critique of Constructivist Norm Research*, (2015) 18:1 *J of Intl Rel & Dev* 75.

<sup>792</sup> Anne-Kathrin Glatz, "Norm Diffusion" Top-Down or Bottom Up? Small Arms Norms in El Salvador, South Africa, and on the International Level" Paper delivered at the 47<sup>th</sup> *Annual Conference of the International Studies Association, Chicago*.

globally accepted norm. The process is possible through various linkages between the ‘norm-maker’ and the ‘norm taker’. I argue that trade negotiations and agreements, as well as intellectual property right forums and alliances are action grounds for the diffusion of dominant IP norms.

The European Union has a multi-faceted approach to the governance of geographical indications all premised on attaining a fair remuneration to farmers and increased market access for such products.<sup>793</sup> Internationally, the European Commission focuses on the dissemination of its GI norms to Third World countries as well as a number of developed and emerging economies, through the use of regional and bilateral free trade agreements for the reciprocal recognition of enhanced rights for GI products. As such, its aim is to secure the protection of EU based geographical indication agricultural and food products in international jurisdictions.

Domestically, the European Commission has created direct policy linkages between the advancement of agriculture, rural development and geographical indications within European member countries. This chosen path in the European Union’s geographical indication narrative, and the effects of this approach in influencing the international relations of GIs is discussed below.

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<sup>793</sup> European Commission, Regulation (EU) No 115/2012 of The European Parliament and of the Council of 21 November 2012 on Quality Schemes for Agricultural Products and Foodstuffs; Geographical Indications and TRIPS 10 Years Later, Insight Consulting Commissioned Study, 2015.

The European Union advances its interest internationally for the reciprocal recognition of GIs through various free trade agreements including the Economic Partnership Agreements with African Caribbean Pacific Group of Countries (ACP),<sup>794</sup> the Transatlantic Trade and Investment Partnership negotiations, and the EU-Canada Comprehensive Economic and Trade Agreement (CETA). All agreements are aimed at fostering trade and/or investment between the regions. The European Union has positioned these agreements as bases for negotiating for the protection of its agricultural and food based geographical indications in these jurisdictions.

Negotiations are ongoing in the Transatlantic Trade and Investment Partnership Agreement. The Transatlantic Trade and Investment Partnership is an agreement between the United States and the European Union. For the purposes of this discussion, my arguments are concerned only with EU's demands for the enhanced protection of its GI products in the United States. Its mandate to secure the protection of EU geographical indication products has led the European Union to demand the legal protection of "an agreed list"<sup>795</sup> of geographical indication products, which are currently not recognized as protectable under United States trademark law. This is not yet settled, but it is likely that

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<sup>794</sup> The African Caribbean Pacific Group is comprised of 79 countries, 16 countries from the Caribbean, 48 from Sub Saharan African and 15 countries from the Pacific. The group of 16 Caribbean countries are Antigua and Barbuda, Barbados, Bahamas, Dominica, Dominican Republic, Guyana, Haiti, Jamaica, Grenada, St. Kitts & Nevis, St. Lucia, St. Vincent & the Grenadines, Trinidad and Tobago, Cuba, and Suriname.

<sup>795</sup> European Union's Intellectual Property Rights Proposal under the TTIP, *European Commission Website* (Available online at Europa, <http://trade.ec.europa.eu/doclib/press/index.cfm?id=1230>).

any proposed extension of the *Lanham Act* to safeguard non-United States' intellectual property interest will be stringently opposed by the United States.

The United States protectionist intellectual property stance<sup>796</sup> is steeped in a political culture which advances the rights of its domestic industries; a position which it aggressively promotes in the international IP fora through robust IP compliance policies. Non-wine and spirit GIs are accorded minimum protection under United States *Lanham Act*, and there is a striking unwillingness by the United States Congress<sup>797</sup> and interest groups in protecting GIs based on unwanted competition and the usurpation of their own brands. Therefore, the prospects of European Union GIs securing legal protection in the United States is minimal, unless there is substantially more to be gained from the Agreement than from the implications of conceding to EU's requests.

Interests in geographical indications as a protectable form of intellectual property among the African Caribbean Pacific Group, is strongly influenced by trade negotiations and the ensuing Economic Partnership Agreement between the Group and the European Union.

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<sup>796</sup> William W. Fisher III, *The Growth of Intellectual Property – A History of the Ownership of Ideas in the United States*, (Available online, <http://cyber.law.harvard.edu/property99/history.html>); United States' protectionism in its domestic IP industries is practiced in behemoth extents in its Special 301 Reports. These yearly reports date back to 1989, list countries globally which have not "adequately" complied with the United States' demands for intellectual property rights laws and policy compliance.

<sup>797</sup> United States Congressional Leaders Urge WIPO to Allow Full Participation At Upcoming Geographical Indication Conference, *Consortium for Common Food Names* (February 12, 2015 available online <http://www.commonfoodnames.com/u-s-congressional-leaders-urge-wipo-to-allow-full-participation-at-upcoming-geographical-indications-conference/>) ; United States Dairy Industry Drives Home Concerns on Geographical Indications and Common Food Name Issues During TTIP Stakeholders Forum, *Consortium for Common Food Names* (February 4<sup>th</sup> 2015, Available online <http://www.commonfoodnames.com/u-s-dairy-industry-drives-home-concerns-on-geographical-indications-and-common-food-name-issues-during-ttip-stakeholders-forum/>) .

The European Union's free trade agreements with South Korea,<sup>798</sup> Singapore,<sup>799</sup> Columbia,<sup>800</sup> Peru<sup>801</sup>, Ukraine<sup>802</sup> and Central America<sup>803</sup> encompass three different continents,<sup>804</sup> and are catalyst for advancing enhanced protection of geographical indications in these countries. By way of the free trade agreements, the European Union has (or will, depending on the enforcement date of the agreements) secured the protection of several food based GIs,<sup>805</sup> inclusive of Jambon de Bayonne (ham) and Prosciutto di Parma (cheese) in these countries.

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<sup>798</sup> EU-Korea Free Trade Agreement. Agriculturally based GIs are protected in South Korea under its Agricultural Product Quality (Act No. 5667 of January 21, 1999, as amended up to Act No. 9932 of January 18, 2010) (Available online at WIPO, <http://www.wipo.int/wipolex/en/details.jsp?id=10760> last accessed April 09, 2015).

<sup>799</sup> The EU-Singapore Free Trade Agreement (Available on the European Commission's website, <http://trade.ec.europa.eu/doclib/press/index.cfm?id=961> last accessed April 09, 2015). Singapore has a *sui-generis* legislation in force for the protection of geographical indications, Geographical Indications Act, (Available online at [http://www.wipo.int/wipolex/en/text.jsp?file\\_id=129655](http://www.wipo.int/wipolex/en/text.jsp?file_id=129655) last accessed April 09, 2015).

<sup>800</sup> Trade Agreement between the European Union and Columbia and Peru, (Available online, European Commission, <http://eur-lex.europa.eu/legal-content/EN/TXT/?uri=OJ:L:2012:354:TOC> last accessed April 09<sup>th</sup> 2015).

<sup>801</sup> *Ibid.*

<sup>802</sup> EU-Ukraine Trade Agreement negotiations: EU-Ukraine Deep and Comprehensive Free Trade Agreement (Available online at EC [http://trade.ec.europa.eu/doclib/docs/2013/april/tradoc\\_150981.pdf](http://trade.ec.europa.eu/doclib/docs/2013/april/tradoc_150981.pdf), last accessed April 09, 2015). The Agreement has yet to be finalized.

<sup>803</sup> EU-Central America: Trade Relations Under the Association Agreement, European Commission (Luxemburg: Publication Office of the European Union, 2012).

<sup>804</sup> These continents are Asia, Europe and Latin America.

<sup>805</sup> European Union-Ukraine Association Agreement: Deep and Comprehensive Free Trade Agreement (Available online at EC, [http://trade.ec.europa.eu/doclib/docs/2013/april/tradoc\\_150981.pdf](http://trade.ec.europa.eu/doclib/docs/2013/april/tradoc_150981.pdf), last accessed April 14, 2015), List of European GIs protected in the European Union-Central America Free Trade Agreement (Available online at EC, [http://trade.ec.europa.eu/doclib/docs/2011/march/tradoc\\_147695.pdf](http://trade.ec.europa.eu/doclib/docs/2011/march/tradoc_147695.pdf), last accessed April 14, 2015).

The negative influence of power asymmetries which have become commonplace in IP negotiations is apparent in specific provisions of these agreements. An instructive example of this is Ukraine's concession to phase out the use by its local producers of the product names Parmigiano Reggiano,<sup>806</sup> Roquefort<sup>807</sup> and Feta<sup>808</sup> over a period of 7 years. These names are all European Union based GI products. This process leads to an interesting observation.

The European Union uses regional and bilateral free trade agreements (RBFTs) as a norm diffusion<sup>809</sup> mechanisms to achieve its failed 'claw back' proposals which it had submitted during WTO's Doha Round negotiations.<sup>810</sup> Under the failed Doha Round negotiations, the European Union had proposed that World Trade Organization member countries should reserve the name of its registered geographical indications by phasing

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<sup>806</sup> Italian protected designation of origin (IT/PDO/0117/0016).

<sup>807</sup> French protected designation of origin (FR/PDO/0217/0131).

<sup>808</sup> Greek protected designation of origin (EL/PDO/0017/0427).

<sup>809</sup> Norm diffusion refers to the process by which legal and global norms of international actors are transplanted into a national jurisdiction. The term also applies to the reverse, that is, the transplantation of policies or innovative ideas from the national sphere unto the international fora. Johanna Martinson, *Global Norms: Creation, Diffusion and Limits*, World Bank Report August 2011; Sanjeev Khagram et al, *Restructuring World Politics: Transnational Social Movements, Networks, And Norms* (Minneapolis: University of Minnesota Press, 2002).

<sup>810</sup> Reference to the use of bilateral, regional and multi-lateral platforms and trade agreements to promote a geographical indication approach to agricultural products and foodstuffs is also emphasized in the latest update to EU's Council Regulation on these products. The 20<sup>th</sup> Preamble to the Regulation states: Provision should be made for the development of designations of origin and geographical indications at Union level and for promoting the creation of mechanisms for their protection in third countries in the framework of the World Trade Organisation (WTO) or multilateral and bilateral agreements, thereby contributing to the recognition of the quality of products and of their model of production as a factor that adds value. *Supra* note 772, *EC Council Regulation* 1151/2012, Provision 20.

out local products affiliation with such names.<sup>811</sup> The proposal was contentious at best and failed because of opposition from other powerful countries.<sup>812</sup> The European Union's alternative mode of attaining "claw backs" is also indicative in its agreement with Central America, by which the region has agreed to recognize and reserve 200 GIs from the European Union in its local consumer markets.<sup>813</sup>

I argue that the European Union's political stance on geographical indications internationally has a twofold effect in the jurisdiction of its trading partners. Further, the dynamisms of geographical indications norm diffusion may result in an interest in geographical indications by non-EU trading partners, from the wide scale proliferation of discussions in the international IP fora. This is apparent in the increased interest in agricultural and food based GIs by countries who, previous to international GI debates and contestations, had minimal or no inclinations toward its protection.<sup>814</sup> I address the first claim made concerning the effects of the European Union's geographical indication policy directive in the paragraph below.

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<sup>811</sup> May T. Yeung & William Kerr, Increasing Protection of GIs at the WTO: Clawbacks, Greenfields and Monopoly Rents, Paper presented at, *International Agricultural Trade Research Consortium Meeting*, (Washington, DC, January 7-9, 2008).

<sup>812</sup> This is discussed in chapter 3.

<sup>813</sup> EU-Central America: Trade Relations Under the EU-Central America Association Agreement, (Luxembourg: Publications Office of the European Union, 2012).

<sup>814</sup> Many third world countries interest in GIs may have started in the Doha Round negotiations but were extensively influenced by regional and bilateral free trade agreements with the EU. The Caribbean region is an example of this phenomenon.

The protection of European Union agricultural and food based GIs in trading partners' jurisdictions mean that the norm recipient either makes changes to its intellectual property structure to provide enhanced protection for food based GIs generally, or, structure its laws to accommodate the recognition for specific European Union product names.<sup>815</sup>

In jurisdictions which have yet to identify feasible and practical uses of geographical indications domestically, there is likely to be a tendency to focus on the protection of GIs (use of infringement measures) than on its ability to be used as an asset of development locally. The latter is achieved through sustainable linkages with agriculture, key stakeholders, and a lucrative consumer market.<sup>816</sup> This phenomenon is observable in Jamaica's experience with the European Union through the EU-Cariforum Economic Partnership Agreement, and with its bilateral geographical indication protection agreement with Switzerland.

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<sup>815</sup> Jean Frederic Morin and Edward Richard Gold have added to the critical discourse of how and why western styled intellectual property rights laws are transplanted to Third World countries. Their deliberations related to norm formation and diffusion and the role of politics and power in diffusing more powerful countries perceptions of intellectual property into the domestic jurisdiction of the Third World. The authors developed an index to measure the degree of transplantation that have occurred in selected Third World countries based on United States' demands and treaties. Five modalities of transplantation were identified: emulation, coercion, contractualization, regulatory competition and socialization. I argue that to varying extents these modalities of norm diffusion accounts for the transplantation of the norm. However, their arguments do not account for internal dynamics that may substantially account the degree of compliance and engagement with the IP law after its inclusion into domestic law. Jean Frederic Morin and Edward Richard Gold, "An Integrated Model of Legal Transplantation" *The Diffusion of Intellectual Property Law in Developing Countries* (2015) 58:4 *Intl S Q* 781.

<sup>816</sup> This is discussed in Chapter 6.



The Swiss government has had a more direct impact on the formulation of Jamaica's geographical indication legislation, having provided technical assistance for training and development beginning in 2008.<sup>817</sup> Switzerland does not emphasize or promote geographical indications under an agricultural policy which implicates rural development as the European Union, but instead practices a culture focused on the protection of its Swiss GI brands in international jurisdictions.<sup>818</sup> This is observable in Switzerland's "Swissness" policy, which focuses on the promotion of Swiss brands locally and internationally through securing the legal protection of its GIs in foreign jurisdictions. Switzerland's trademark legislation has also been revised to extend protection to the use of the Swiss cross on Swiss products.

The agricultural and food based geographical indication knowledge economy has led to the emergence of three paradigms. Countries have sought to develop an association of geographical indications with their domestic and traditional resources. By way of example is Mexico, with the registration of its Tequila, Columbia, with the geographical indication registration of its Café de Columbia (coffee), and India with its registered Darjeeling tea. These jurisdictions have attained varying levels of success in their geographical indications strategy.<sup>819</sup> Another trend resulting from the diffusion of GI norms is the enactment and enforcement of GI legislation without its usage by the

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<sup>817</sup> I discuss this issue in Chapter 3 of the thesis.

<sup>818</sup> Swiss-ness Legislative Amendment: Background, Goal and Content, Swiss Federal Institute of Intellectual Property; Federal Act on the Protection of Trade Marks and Indications of Source, Amendments of June 21, 2013.

<sup>819</sup> This point is discussed in chapters 3 and 6.

domestic jurisdiction. The Caribbean region is an example of this paradigm. Thirdly, contestations between influential actors over the appropriateness and necessity in recognising high standards of GI protection in domestic jurisdictions have increasingly surfaced. This issue is noticeable in intellectual property relations concerning geographical indications between the United States and Lisbon Union members.

I have argued elsewhere in the thesis that Jamaica has not embraced geographical indications as assets of development, but as a tool to mitigate infringements of its brands internationally. Switzerland's role in the formulation of Jamaica's geographical indication legislation has facilitated the dissemination and internalization of this norm consensus among key stakeholders.<sup>820</sup> Therefore, notwithstanding the enforcement of the EU-Cariforum Economic Partnership Agreement, Jamaica's geographical indication legislation and policy focus (though the latter is in its infancy), is substantially influenced by Switzerland's policy. As noted by a representative from the Jamaica Intellectual Property Office, "Jamaica's GI scheme has benefitted from the Swiss government".<sup>821</sup>

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<sup>820</sup> I've argued this point in more detail in Chapter 6.

<sup>821</sup> Interview with representative from the Jamaica Intellectual Property Office (Sept. 04, 2013).

### 4.3.2. Judicial Interpretation of EC Regulation 1151/2012

The regulation is applicable to geographical indications, traditional specialties guaranteed,<sup>822</sup> and designations of origins. As defined by the regulation, a designation of origin (PDO) refers to “a specific place or region used to describe an agricultural product”.<sup>823</sup> The agricultural product must originate in the region,<sup>824</sup> and must possess qualities or characteristics which are ‘exclusively’ based on its geographical area. Furthermore, the agricultural product must be produced, processed and prepared in the defined geographical area.

The European Court of Justice unequivocally reinforced this point in the case of *Ravil Sarl v Bellon Import*.<sup>825</sup> The case dealt with the importation of Gran Padano cheese from Italy to France which was then grated and packaged in France and sold to consumers. The contentious issue concerned the permissibility of grating the cheese in France, on the grounds that it affected the quality of the product, and was in non-conformity to the technical specifications of the regulations. Proponents of the action opined that restricting the entire processing to Italy was a quantitative restriction<sup>826</sup> on exports.<sup>827</sup>

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<sup>822</sup> Traditional Specialities Guaranteed are products that are legally recognized as protectable and protected based on the traditional processing or manufacturing procedures used in their production.

<sup>823</sup> *EC Council Regulations* 1151/2012, Article 5(1) a.

<sup>824</sup> *Ibid.* See also *Northern Foods plc v Department for Environment, Food and Rural Affairs* 2005 EWHC 2971 (Quicklaw).

<sup>825</sup> *Ravil Sarl v Bellon Import* C-469/00, (CJEU). [“Ravil”].

<sup>826</sup> European Council prevents obstacles to the free movement of goods between European Union member countries. In *Procureur du Roi v Dassonville*, 1974 E.C.R. I-837, the European Court of Justice explains quantitative restrictions on exports as “all trading rules enacted by member states which are capable of hindering, directly or indirectly, actually or potentially, intra-community trade are to be considered as measures having an effect equivalent to quantitative restrictions” pp.5. See Mattias Derlén & Johan

The court correctly ruled that grating and packaging the cheese in another territory may undermine the quality and reputation of the cheese. As such, the processing conditions likely compromised the “organoleptic characteristic” which produced its authentic composition.<sup>828</sup> I argue that this ruling reinforces the characteristics and standards which differentiate a designation of origin from non-protected products. A product is registered under the regulation, and is extended protection based on its conformity to certain specifications. These specifications promote and sustain the quality and essential characteristics upon which differentiation is founded. A bifurcation of the preparation process of the cheese between two territories may result in the disrepute of the specifications which should attest to the quality and authenticity of the product.

A different decision was reached in the case of Prosciutto di Parma Ham<sup>829</sup> (*Parma Ham*) which, though manufactured in Italy, was imported into England, sliced then packaged and labeled under the original manufacturer’s name. This case also implicated Article 13(1) c of the regulations, which prohibits the misleading indication of origin on registered products. In assessing whether Parma Ham could only be processed and sliced in Italy, the court of justice opined that the essential characteristics of the ham were not altered by this activity. The court further asserted that the slicing specification did not protect a commercially material characteristic of the ham. On this basis, the slicing

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Lindholm, “Article 28c and Rules on Use: A Step Towards Workable Doctrine on Measures Having Equivalent Effect to Quantitative Restrictions” (2010) 16 *Col I J E L* 191.

<sup>827</sup> *Ibid*, para 40-43.

<sup>828</sup> *Ravil*, *supra* note 825 at para 60-123.

<sup>829</sup> *Consorzio del Prosciutto di Parma v Asda Stores Ltd*. C-108/01 (CJEU).

specification was held to be a quantitative restriction on exports, and invalid as a requirement of the ham's designation of origin status. It is notable that the European directive on geographical indications places substantial emphasis on their ability to enhance the viability of agricultural sectors in member states. In addition, the free movement of agricultural and food based products between member states is a policy measure promoted by these regulations, as long as the products conform to EC regulations on product specifications.

The significant difference between a designation of origin and a geographical indication is in the specification of locations concerning the production and processing area. There is no requirement for the geographical indication food-based product to be produced and processed in the defined geographical area.<sup>830</sup> It is sufficient for the product to be produced, processed or prepared in the geographical area. On this basis, agricultural and food based products which are cultivated in the geographical zone and processed outside of this area are still registrable as GIs. Registration for geographical indication products is submitted to the member state in which protection is sought.

Council Regulation 1151/2012 intention is to provide a harmonized approach to the application, commercialization and sustenance of agricultural and food based geographical indications in the EU. The regulation's sixty-five preamble illuminates

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<sup>830</sup> EC Regulation 1151/2012, Article 5(2): For the purpose of this Regulation, 'geographical indication' is a name which identifies a product: (a) originating in a specific place, region or country; (b) whose given quality, reputation or other characteristic is essentially attributable to its geographical origin; and (c) at least one of the production steps of which take place in the defined geographical area.

EU's creativity in formulating a directive that is multi-representational of interests and outcomes. The importance of product specifications in assuring product standard and most importantly consumer preference is enumerated as salient to the conception and application of EU's regulation. The linkages between the territory, product and community are emphasized, as is the relevance of product diversification in the commercialization of geographical products. The legislation codifies and clarifies much of the ambiguity that were in its predecessor legislation.<sup>831</sup>

Most interesting, and serving as an essential foundation to the workings of the European Union's approach, is the relationship between Community GI law, national obligations and approaches to agricultural and food based geographical indications. Regional protection of agricultural and food based geographical indications in the European Union is based on GI registration at the Community level. Member states' role in the registration process is to ensure that the registrant's application meets national law requirements. The role of EU's Commission has broadened and has become more specified by amendments to the current regulation. The Commission is empowered to delegate future rules on geographical indications with the assistance of Member states.

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<sup>831</sup> For example, the scope of protection for geographical indications is a more detailed mandate of rules than Regulation 510/2006. It more particularly details and outline provisions of scope of protection, labelling, Commission responsibility and co-existence or conflicts with trade-marks, plant varieties and homonym names, as examples. Transitional period of 5-15 years is provided for products which contravene Article 13(1) (direct or indirect commercial use of the protected name), if an admissible statement of opposition is filed stating that if the product were to be registered, it would jeopardise the existence of an entirely or partly registered name. The admissible statement of opposition may also state that the product has been legally marketed in the territory for at least five years before the date of the Commission's publication of the GI registration in the Official Journal of the European Union. Article 15, Transitional Periods for Use of Protected Designations of Origin and Geographical Indications, EC Council Regulation No. 1151/2012.

Furthermore, it is the Commission's responsibility to scrutinize applications, ensuring that there are no "manifest errors" in the interpretation of Union laws, and that the applications are in conformity with the interest of non-Union stakeholders.<sup>832</sup> The European Commission is also empowered to make decisions on registrations with the assistance of Member States, so as to shorten the length of time taken to register geographical indications.<sup>833</sup>

The Commission's scrutiny of GI registrations is aptly outlined in *Carl Khune and Others*, a case brought by Germany's national court to the Court of Justice over a competitor's disgruntlement with its designation of a specified geographic area as the production area of Spreewalder Gurkens.<sup>834</sup> Germany had submitted the name to the EU Commission under its simplified procedure for GI registration, which facilitated a fast track process for the registration and protection of names within member states. Under the simplified procedure, names which member states have identified and disclosed through documented submissions to the Commission are registered as GIs, without any further scrutiny or verification.

In the Spreewalder Gurkens case, Germany's designation of the geographical area of production led to the exclusion of the producer's gerkins from the de-limited area, which transpired into conflicts over the lawful designation of its use of "Spreewalder Art" on its

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<sup>832</sup> EC Council Regulation, Preamble No. 58-65.

<sup>833</sup> *Ibid*, No. 61.

<sup>834</sup> *Carl Kühne GmbH & Co. KG and Others v Jütro Konservenfabrik GmbH & Co. KG*, C-269/99 ((available online at <http://curia.europa.eu/juris/liste.jsf?language=en&num=C-269/99>)).

products. The Court of Justice upheld the validity of German's government designation of Spreewalder Gurken because the national government and the Commission had correctly exercised jurisdictions ensuring that conditions for product registration were met.<sup>835</sup> *Carl Khune* illustrates the role and jurisdiction of the EU Commission and national states in the registration process of GIs:

the decision to register a designation as... a PGI may only be taken by the Commission if the Member State concerned has submitted to it an application for that purpose and that such an application may only be made if the Member State has checked that it is justified. That system of division of powers is attributable particularly to the fact that registration assumes that it has been verified that a certain number of conditions have been met, which requires, to a great extent, detailed knowledge of matters particular to the Member State concerned, matters which the competent of that State are best placed to check.<sup>836</sup>

A registered geographical indication confers upon right holders “a collective monopoly over its commercial use”<sup>837</sup> and endeavors to prevent “unjust enrichment”<sup>838</sup> by other individuals. The regulation justifies the enactment and use of GI legislation as based on several reasons.<sup>839</sup> These include fostering quality agricultural products, sustaining a strong linkage between product and its origin, and meeting the needs of consumers who

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<sup>835</sup> Germany had expanded the production area for gherkins to include an economical viable territory resulting in a “doubling” of the original de-limited zone. Opponents to the government's agro-economic strategy had voiced concerns on the extension of the de-limited area but, without success, as the government proceeded with the simplified procedure for registration of Spreewalder Gurken. *Ibid*, para. 19-21.

<sup>836</sup> *Ibid*, para 53.

<sup>837</sup> *Canadane Cheese Trading & Kouri*, [1997] ECR I-4681.

<sup>838</sup> *Ibid*.

<sup>839</sup> Preamble, EC Council Regulation 1151/2012, *supra* note 730.



are conscious about the source and manufacturing/processing procedures of their foods.<sup>840</sup>

Comparatively, foreign rights holders with registered geographical indications in European member states are granted a substantive level of protection which is more significant than that existing in the Japanese or United States jurisdiction.

Article 13<sup>841</sup> enumerates the scope of protection for registered products. A registered geographical indication cannot directly or indirectly be used commercially in connection with a comparable product. A registered name is infringed if the direct or indirect use of the name exploits the reputation of the registered name. In addition, any direct or indirect commercial usage of a name that exploits the name, even when the product is used as an ingredient is prohibited.<sup>842</sup>

The misuse of the registered GI name on imitative products, notwithstanding an indication of the true origin of the product is prohibited. A registered geographical indication is also protected against false or misleading indication of its origin, nature, provenance, or essential qualities depicted on inner or outer packaging or labeling of products.<sup>843</sup> Furthermore, any practice which is capable of “misleading the consumer as

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<sup>840</sup> *Ibid.*

<sup>841</sup> Article 13, *supra* note 730.

<sup>842</sup> EC Council Regulation, Article 13(1a) and 13 (1)b.

<sup>843</sup> *Articles* 13 (1)b and (1) c.

to the true origin”<sup>844</sup> of the registered GI is prohibited. False or misleading information on the packing of products in a container that is liable to convey false information as to the product’s origin is an infringement of the protected name. Pursuant to *Article 13(2)*, geographical indications cannot become generic names. Article 13(2) is not an absolute guarantee against claims generic-ness. Although registered geographical indications cannot become generic, generic names cannot be registered as geographical indications.<sup>845</sup>

#### **4.3.3. Further Judicial Interpretation on scope of protection: Article 13(1)**

EC’s 1151/2012 aims to safeguard the use of GI registered name against misleading uses, and against actions by competitors which either directly or indirectly affects the commercial viability of the product. I use the term commercial viability to refer to the ability of the agricultural and food based geographical indication to maintain its reputational quality in its consumer markets, thereby effecting demand. This point underlies the analysis courts have given in interpreting Article 13(1).

The contextual interpretation provided by the European Court of Justice<sup>846</sup> on the term ‘evocation’ as used in Article 13 1(b),<sup>847</sup> is that it refers to imageries that consumers

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<sup>844</sup> *Article 13 (1)d.*

<sup>845</sup> Article 6(1), Generic Nature, Conflicts with Names of Plant Varieties, Animal Breeds with homonyms and trademarks, EC Regulation 1151/2012.

<sup>846</sup> *Consorzio per la Tutela Formaggio Gorgonzola v Kaserei Champignon Hofmaster GmbH* [1999] All ER D 236. [“*Consorzio*”].

associate with another product, having already acquired familiarity with the GI registered product. As such, if imageries of the registered product come to the fore when the consumer is confronted with the similar named product, evocation is proved. Evocation may also occur when there is no likelihood of confusion between the products.<sup>848</sup> Importantly, outcomes are case specific and requires an evaluation of the fact pattern of each case that invoke issues concerning Article 13(1).

In *Conorzio*,<sup>849</sup> claims over the use of the name ‘Cambozola’ in Austria to market blue cheese illustrates how evocation is dealt with by the CJEU. The trademark ‘Cambozola’ was registered prior to the GI registration of the plaintiff’s product. In this case, the owner of the geographical designation “Gorgonzola” (cheese manufactured in Italy) initiated a claim against the ‘Cambozola’ trademark seeking to prohibit its marketing, and a cancellation of its trademark in Austria. The Gorgonzola GI owners claimed that the trademark infringed on its rights, and misled consumers as to the true origin of the product. The case was referred to the European Court of Justice for a preliminary ruling on the jurisdiction of the national Austrian court to prohibit the marketing of Cambozolas’ cheese, despite labeling that specified its true origin.

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<sup>847</sup> Article 13(1)b, EC Council Regulation 1151/2012: Registered Names shall be protected against: any misuse, imitation or evocation, even if the true origin of the product is indicated or if the protected name is translated or accompanied by an expression such as ‘style’, ‘type’, ‘method’, ‘as produced in’, ‘imitation’ or similar.

<sup>848</sup> *Conorzio*, *supra* note 846.

<sup>849</sup> *Supra* note 846.

The court noted 2 fundamental points. Firstly, it asserted that the use of the name Cambozola to associate with blue cheese evoked similarities with the protected GI cheese Gorgonzola, although the packaging indicated the true origin of the product. This clearly implicated Article 13(1) b.<sup>850</sup>

The second point qualifies the decision. The European Court of Justice noted that Article 13(1) must be evaluated based on whether the Cambozola trademark was registered in good faith<sup>851</sup> in Austria. The court firmly asserted that national courts had the jurisdiction to decide the factual issues concerning the invalidity or revocation of trademarks, based on the laws which were in force at the time of the registration. The court held that this evaluation was instrumental in determining whether the trademark owner had intended to mislead consumers. These requirements are explicitly and even more clearer specified in Article 14(2) of EC's geographical indications regulation.

By way of Article 14(2), trademarks that are registered in good faith prior to the date of submission for GI registration to the Commission, shall continue to be used and renewed, notwithstanding the registration of the geographical indication. Its continued used is permitted as long as the trade mark is not invalidated or revoked. Community trade mark may be revoked if the mark was registered despite findings of descriptiveness or non-

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<sup>850</sup> Article 13(1)(c): any misuse, imitation or evocation, even if the true origin of the products or services is indicated or if the protected name is translated or accompanied by an expression such as 'style', 'type', 'method', 'as produced in', 'imitation' or similar, including when those products are used as an ingredient.

<sup>851</sup> This requirement is discussed below.

distinctiveness.<sup>852</sup> Descriptive marks are non-registrable as trademarks as they are functional and describe the product rather than serve as the differentiating hallmark of the product. Under Community law, absolute invalidity of trade marks occurs if the applicant had applied for the mark in bad faith on applying for the mark or, if the mark was registered contrary to the legal grounds on which marks are valid.<sup>853</sup>

Yet greater finality was reached in evocation claims concerning the production, marketing and sales of ‘Parmesan’ hard cheese in Germany.<sup>854</sup> The case was brought by the European Communities Commission against German authorities after several economic operators complained that ‘Parmesan’, a hard cheese from Germany, was not produced in accordance with Italy’s Parmigiano Reggiano’s PDO specification.

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<sup>852</sup> Council Regulation EC 207/2009 of 26 February 2009 on Community Trade mark, [Community Trade mark] Article 51: The rights of the proprietor of the Community trade mark shall be declared to be revoked on application to the Office or on the basis of a counterclaim in infringement proceedings: (a) if, within a continuous period of five years, the trade mark has not been put to genuine use in the Community in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use; however, no person may claim that the proprietor's rights in a Community trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application or counterclaim, genuine use of the trade mark has been started or resumed; the commencement or resumption of use within a period of three months preceding the filing of the application or counterclaim which began at the earliest on expiry of the continuous period of five years of non-use shall, however, be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application or counterclaim may be filed; (b) if, in consequence of acts or inactivity of the proprietor, the trade mark has become the common name in the trade for a product or service in respect of which it is registered; (c) if, in consequence of the use made of it by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services. 2. Where the grounds for revocation of rights exist in respect of only some of the goods or services for which the Community trade mark is registered, the rights of the proprietor shall be declared to be revoked in respect of those goods or services only.

<sup>853</sup> Article 52 (1), Absolute Grounds for Invalidity, *Community Trademark*, 1. A Community trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings: (a) where the Community trade mark has been registered contrary to the provisions of Article 7; (b) where the applicant was acting in bad faith when he filed the application for the trade mark.

<sup>854</sup> *Commission of the European Communities v Germany*, Case C-132/05, CJEU [*Parmesan case*].

Parmigiano Reggiano is a protected designation of origin in Italy for hard cheese, whether grated or intended to be grated. Germany claimed that Parmigiano Reggiano was protected only in its exact form under Article 13(1) b, the name did not evoke affiliations with the Italian version of the cheese, and that it was not bound to proceed with infringement claims on its own motion.<sup>855</sup> The CJEU held that the presence of phonetic and visual similarities was likely to lead consumers, when confronted with hard cheese, grated or un-grated, labelled as Parmesan to evoke imageries of Italy's Parmigiano Reggiano.<sup>856</sup>

The expansiveness of protection accorded to geographical indication is exemplified in the provisions of Article 13(1). An infringement of a geographical indication is not

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<sup>855</sup> *Ibid*, *European Communities v Germany*, Para 19.

<sup>856</sup> *Supra* note 835, *European Communities v Germany*, at paras 31-48. Although an evocation claim was founded, the case was decided in favor of Germany on the basis that its government was not obligated to initiate infringement proceedings against Parmesan marketers and producers. Rules governing product specification are covered by Article 7 of EC's Regulation 1151/2012. In addition, the Commission is empowered to lay down rules on the form of specification to be provided in applications for geographical indication registration. Registered geographical indications should comply with specifications on: the name to be protected as it is used, whether in trade or in common language, and only in the languages which are or were historically used to describe the specific product in the defined geographical area; a description of the product, including the raw materials, if appropriate, as well as the principal physical, chemical, microbiological or organoleptic characteristics of the product; the definition of the geographical area delimited, and, where appropriate, details indicating compliance with the requirements, evidence that the product originates in the defined geographical area, a description of the method of obtaining the product and, where appropriate, the authentic and unvarying local methods as well as information concerning packaging, if the applicant group so determines and gives sufficient product-specific justification as to why the packaging must take place in the defined geographical area to safeguard quality, to ensure the origin or to ensure control, taking into account Union law, in particular that on the free movement of goods and the free provision of services; details establishing the following: the link between the quality or characteristics of the product and the geographical environment; where appropriate, the link between a given quality, the reputation or other characteristic of the product and the geographical origin. (g) the name and address of the authorities or, if available, the name and address of bodies verifying compliance with the provisions of the product specification pursuant to Article 37 and their specific tasks; (h) any specific labelling rule for the product in question.

limited to instances of falsely denoting the origin of goods, but to any form of manufactured imitation or style of the product.

#### **4.3.4. Generic names and Geographical Indications under EC Regulation 1151/2012: Article 6(1), Article 6(2)**

The legislation prevents the use of geographic names on geographical indication products that are generic. As such, names which, though related to a region or place associated with the foodstuff or agricultural product, but has become a common name of the product in the Community, are not registrable as geographical indications.<sup>857</sup>

The European Court of Justice has held that an objective process is undertaken in determining whether a name has become generic.<sup>858</sup> A generic name is one which refers to “what is common to all species”<sup>859</sup> of a class of products. Generic names are generalizations and in this capacity, are used to refer to products of a general class rather than to a specific product. It is plausible for geographical names that were once significant to have lost their association to a specific locality and become non-distinctive names. Article 41<sup>860</sup> provides guidelines on factors which are imperative in evaluating the ‘generic-ness’ of a specific name. The stipulated directives noted are, the existing

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<sup>857</sup> The Commission is empowered to adopt additional rules to guide Member States in determining the generic status of rules in the European Union. Preamble No. 63. EC Council Regulation 1151/2012, Articles 41 and 56.

<sup>858</sup> *Alberto Severi v Regione Emilia-Romagna*, C-446/07, (CJEU).

<sup>859</sup> *Germany v Commission of the European Communities* C-465/02 and C-466/02, (CJEU). [Feta cheese case].

<sup>860</sup> Article 41, *supra* note 733.

situation in the areas of consumption, and the relevant national or Union legal acts. The Feta cheese decision illustrates the practical workings of the legislation.<sup>861</sup> The case concerned whether the term “Feta” had become generic in reference to cheese, or if the name could only be used in reference to Feta cheese processed in Greece.

The court held that the term was not generic, and substantiated its reasons based on the following factors. In terms of consumption patterns, the legitimacy of the name in the country of origin was validated by Greek consumers’ association of the term with cheese processed only in Greece. This information was gathered from customer surveys. Furthermore, a substantial number of consumers from other EU member states associated ‘Feta’ as cheese originating in Greece. The court firmly noted that it is not necessary for the name to be well known throughout the entire European Union as that which is associated with Feta from Greece. The essential factor is that it is envisaged as well known in local areas of consumption, as well as in member and non-member states where it is consumed. Interestingly, the use of the name in Denmark, Germany and France in reference to Feta, though processed under dissimilar conditions and procedures did not dissuade the courts’ reasoning.

In regards to geographical indication legislation in member states, the Feta name was not protected in all states but was legally protected in its country of origin (Greece) and Austria. In addition to the importance of legislation and area consumption patterns, the

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<sup>861</sup> *Feta Cheese case*, *supra* note 859.



Feta cheese case further establishes that ‘facts directly and indirectly’<sup>862</sup> relevant to the case may be important to the analysis, as well as opinions of the scientific committee. This ruling has been used to inform analysis in subsequent cases.

Names which have yet to be registered by the European Commission,<sup>863</sup> but for which information has been forwarded for registration purposes, cannot be deemed as generic unless the Commission has ruled on the application. The CJEU emphasized this position in *Alberto v Regione* after the applicant’s sausage was held as infringing the registered name of sausage originating in an area of Italy, both products using the name “Salame Tipo Felino”, to refer to sausage produced in Modena. The applicant’s product was unregistered; neither did it originate in Modena. The court in Modena, Italy referred the matter to the ECJ to clarify issues concerning misleading labeling and generic-ness.

The matter of generic-ness was pertinent as the Italian court needed clarification on when it was appropriate to classify a product as generic. There were reasonable grounds to construe that the product name was now associated with recipes and used by other producers outside of its area of origin. The CJEU held that a designation could not be generic pending the forwarding of application for registration to the Commission. During this period, EC jurisprudence dictates that it is permissible to use the geographic name

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<sup>862</sup> *Ibid*, para 180.

<sup>863</sup> *Alberto Severi v Regione Emilia-Romagnia* C-446/07 (CJEU). [“*Alberto*”].

associated with the foodstuff on labeling and advertising, as long as the average reasonably informed consumer is not misled by the labeling.<sup>864</sup>

I argue that this is a commendable interpretation of the legislation and safeguards the protection of names for rights holders who have already started the registration process. The argument against this extension of rights points to a commercial monopolization of rights in the specified consumer market,<sup>865</sup> contrary to the fair promotion of trade. The monopolization of the consumer market by a few GI brands is one of the most significant contentious issues asserted by opponents of GI extension to agri-food products. This argument has merits but, the economic, cultural and social benefits (inclusive of spill over benefits) validate its existence and development.

Geographical indications are differentiated from other products based on their special or unique essential characteristics that are related to terroir, culture and peoples. These characteristics are inherent from the products connection with its place of origin, and the value is formed from strategic approaches to its management and commercialization. Consumer preferences which are based on these differentiated qualities should not be envisaged as a monopolization of the market, but based on consumer choices driven by quality preferences.

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<sup>864</sup> *Ibid.*

<sup>865</sup> *Alberto, supra* note 863.

The restrictive approach to classifying product names as generic is very well illuminated in the *Parmesan* case.<sup>866</sup> The Commission had implicated German authorities in the marketing of hard cheese labelled as Parmesan in Germany. The issue was an alleged infringement of Parmigiano Reggiano from Italy, protected as a protected designation of origin in the European Union. In efforts to defend the claim, Germany contended that Parmesen had become a generic name. The CJEU held that Parmesen was not generic. Germany had provided insufficient evidence to validate its claim of generic-ness.

The court takes the following factors into account in deciding if a name is generic. The places of production of the product concerned both inside and outside the member state which obtained the registration of the name at issue. Secondly, the consumption of the product, and how it is perceived by consumers inside and outside that member state. Thirdly, the existence of national legislation specifically relating to the product, and finally, the way in which the name has been used in Community law.<sup>867</sup> Germany had limited its evidence to dictionary definitions and to secondary literature. There was no evidence provided on consumer's comparative perception of Parmigiano Reggiano imported into Germany from Italy, with that of consumption in Parmesan. If the consumption of Parmigiano Reggiano in Germany did not conjure Italian cultural traditions and civilization, then the claim that Parmesan had become generic would be established. The absence of evidence made the analysis unfruitful.

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<sup>866</sup> *Parmesan* case, *supra* note 840.

<sup>867</sup> *Ibid.*

#### **4.3.5. Relationship between Geographical Indications and Trademarks: Articles 14 (1) and 14 (2).**

Trademarks which are registered or have been used prior to the registration of a geographical indication may continue to be used,<sup>868</sup> notwithstanding the existence of the registered geographical indication. This stipulation is only permissible on the basis that there are no grounds for invalidity or revocation of the trademark, pursuant to Community trademark law.<sup>869</sup> In evaluating this stipulation, the European Court of Justice in *Bavaria*<sup>870</sup> asserted that the GI designation of the beer<sup>871</sup> Bayeris Bier did not prevent the validity of the trademark Bavaria from use in association with beer in Italy.

The Bayeris Bier rights holders sought an injunction to prevent the use of the name ‘Bavarian’ on beers in Italy. The court noted that the opponent’s Bavarian trademark was registered in good faith. According to the court, a trademark registered in ‘good faith’ refers to one which was registered in compliance with the ‘rules of law’<sup>872</sup>, both international and local...at the time of the application and registration’.<sup>873</sup> Since the

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<sup>868</sup> *Supra* note 730, EC Regulation 1151/2012, Article 14(2).

<sup>869</sup> As noted in *Conorzio*, the invalidity or revocation of trademarks are dealt with at the national court level and not by the Community legislature. *Supra* note 748, “*Conorzio*”.

<sup>870</sup> *Bavaria NV v Bayerischer Brauerbund ev* C-343/07 [“*Bavaria*”].

<sup>871</sup> Beer is categorized as foodstuff under Annex 1 to EC Regulation 1151/2012 on Quality Schemes for Agricultural Products and Foodstuffs (available online: [http://eur-lex.europa.eu/eli/reg/2012/1151/oj#ntr22-L\\_2012343EN.01000101-E0022](http://eur-lex.europa.eu/eli/reg/2012/1151/oj#ntr22-L_2012343EN.01000101-E0022) last accessed September 01, 2016).

<sup>872</sup> Used in this context, the court’s reference to ‘rule of law’ means compliance with the legislative provisions of the Act which governs trademark in the jurisdictions.

<sup>873</sup> *Bavaria*, *supra* note 870, para 156-157.

court's jurisdiction is concerned solely with Community legislation on geographical indications, it focused on Bayerischer's compliance with Articles 14(1) and 14 (2).

In reifying the relevance of Article 14(2), the court asserted that the principle of coexistence was enshrined in the regulation, which explicitly enabled the trademark "Bavaria" to exist with the GI Bayeris Bier, which originated in Bavaria. A similar dispute arose in Germany concerning the right to use the 'Bavaria' trademark,<sup>874</sup> given the GI registration of Bayeris Bier for beer. The European Court of Justice ruled that Article 14(1) was applicable in resolving the dispute.

Upon the registration of a geographical indication designation, no trademark bearing a similar or same name can be registered;<sup>875</sup> all such registrations are refused by the EC Commission.

#### **4.3.6. Expansiveness of EC's Regulation: European Member States law on GIs v EC Regulation on Geographical Indications v TRIPS**

Inconsistencies in European member states GI laws with EC regulation on GIs are resolved in favor of the EC regulation. The directive is also applicable to bilateral treaties between member states, regardless of the substantive provisions which are covered in the treaty. However, international treaties are exempt from this application of EC's principle.

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<sup>874</sup> *Bavaria NV v Bayerischer Brauerband* ev C-120/08 [2010] ECR I 13393.

<sup>875</sup> *Ibid*, Article 14(1).

This issue was extensively debated by the European Court of Justice in a case<sup>876</sup> concerning contestation by the company ‘Budvar’ over the commercial presence of the beer ‘Bud’ in Austria. Budvar argued that the name “Bud” was protected in Austria under the *Lisbon Agreement* as an appellation of origin<sup>877</sup> associated with beer. On this basis, it argued that its competitor Anheuser-Busch was prohibited from using the name “Bud” or “American Bud” in its beer advertisements in Austria. The court firmly opined that the purpose of EC’s GI regulation was to ensure uniformity in laws related to GIs within all member states. It further noted<sup>878</sup> that uniformity in GI regulations ensured that products designated under its regulation are produced according to its specifications, and were more likely to sustain the quality of agricultural products.

Anheuser-Busch was not precluded from using the name ‘Bud’ in its commercials in Austria, as the plaintiff Budvar had not registered the name as a geographical indication under EC regulations.

#### **4.4. The Implications of EC Regulation for Jamaica and Caribbean GI Right holders in European Union Consumer markets.**

The position of non-EU geographical indications rights holders with interests in European Union consumer markets is relevant to Third World communities. An issue which is of significance to foreign exporters of agricultural and food based geographical

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<sup>876</sup> *Budejovicky Budvar v Rudolf Ammersin GmbH* [“Budejovicky”].

<sup>877</sup> An appellation of origin and the Lisbon Agreement are discussed in Chapter 4.

<sup>878</sup> *Budejovicky*, paras.90-129, *supra* note 762.

indication products to the European Union is the extent to which their products are protected under EC's geographical indication regulation.

The expansiveness of EU's regulation does not necessarily mean that it substantively safeguards the rights of foreign GI right holders. In this regard, conformity with the provisions of European Union regulations is necessary. Jamaica and the Caribbean's GI requirements regarding product specification are different from that which is stipulated under the EC regulation. Therefore, foreign GI registrants must ensure that product specifications are in conformity with Articles 37(2).<sup>879</sup> Furthermore, if the product is not placed on the market for a seven-year period, or on questionable connections between the product and its terroir, the Commission is placed with the authority to cancel the registration.<sup>880</sup>

Ambiguities regarding the registrability of a product are usually referred to the Commission for review by the member state which has received the request for GI registration. A plausible concern for Jamaican and Caribbean GI registrants (foreign

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<sup>879</sup> Application for GI registration is submitted to the member state in which protection is sought. The member state has the jurisdiction to evaluate the registrability of an applicant's registration request. Article 37 (2): 2. In respect of designations of origin, geographical indications and traditional specialities guaranteed that designate products originating in a third country, the verification of compliance with the specifications before placing the product on the market shall be carried out by: (a) one or more of the public authorities designated by the third country; and/or (b) one or more of the product certification bodies.

<sup>880</sup> EC Council Regulation 1151/2012, Article 54: 1. The Commission may, on its own initiative or at the request of any natural or legal person having a legitimate interest, adopt implementing acts to cancel the registration of a protected designation of origin or of a protected geographical indication or of a traditional speciality guaranteed in the following cases: (a) where compliance with the conditions of the specification is not ensured; (b) where no product is placed on the market under ...the protected geographical indication for at least seven years.

registrants) is the possibility of refusal of EU registration on grounds of ‘generic-ness’. I have previously discussed the EU’s position on generic products. Notably, a member state cannot refuse registration of a product on the basis of a generic name, pending the forwarding of the application to the European Commission for registration.<sup>881</sup> Under this circumstance, two fundamental factors are salient in safeguarding the interest of the foreign registrant.

Firstly, the national law concerning “generic-ness” of the particular member state in which GI protection is sought must be considered. Secondly in instances of contestation on grounds of generic-ness, the CJEU stipulates that the impugned name can still be used, as long as the consumer is not misled by the labeling of the product as to its origin. This enables the foreign registrant who is involved in such proceedings to gain entrance into the EU consumer market, or that of the member state. However, under these circumstances the foreign registrant is unable to fully safeguard its rights, and/or defend against possible infringements. This is because its position is compromised until the resolution of the legality of its designation.

A potential deterrent to commercialization and the registration of Jamaica and the Caribbean’s GI products in the European Union is the cost of infringement and litigation proceedings. In jurisdictions in which cost is a fundamental deterrent, government or other key stakeholders should strategically register only, and commercialize products in foreign markets which are feasibly capable of producing a profit, economically, socially

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<sup>881</sup> *Alberto Severi v Regione Emilia-Romagna*, C 446/07.



and culturally. Registration should be restricted to products of which there is a high or sustained consumer demand. If the product is well-known or famous in consumer markets, the modalities of intellectual property protection such as designation as well-known or famous marks under EU, Japan's or the United States' trade-mark law are alternatives, or additions to GI registration.

#### **4.5. Chapter Summary**

The treatment of geographical indications in international jurisdiction is not uniformed or consistent. Domestic enactment of geographical indications legislation and the local registration of products cannot ensure the success of a geographical indication sustainable module. The juridical treatment of geographical indications in international consumer markets in which the foreign product is registered is significantly important in its positioning as an IP asset of development. I am not stating that adequate protection suffices as the main base for the success of a GI scheme. However, it is one of the major supporting factors in the geographical indications development narrative.

The United States is not a conducive jurisdiction for advancing domestic stakeholders' interest in geographical indication protection. Trademark law cannot be conceptualized or proffered as frameworks for agricultural and food based geographical indication protection, when the definition of GIs is outside the scope of any form of rights associated with a trademark. Consumer demand and preferences for products cannot be shifted to jurisdictions which have reciprocal geographical indication legislation. Therefore, a geographical indications rights holder will be placed in circumstances when

the consumer market which it is operating in only recognizes certification or collective marks as bases of protection.

Despite the various modes of non-*sui generis* protection for geographical indications in the Japanese market, currently the most proactive form of legislation for Jamaica's Blue Mountain coffee is Japan's trademark law, as a collective mark or as a well-known mark. Japan's recent enactment of geographical indication legislation means that the next proactive step is for the registration of its Blue Mountain coffee as GI, to gain protection in Japan's consumer market.

In the United States, it is commendable that geographical indication rights holder can utilize the protection (though limited) under United States *Tariff Act* as an added mode of protection against infringement.

The most extensive recognition rights is that accorded by EC's regulation 1151/2012. It is far reaching and encompasses the failed ambitions of the Doha Round to establish a higher standard of protection for GIs. My observation here does not mean that there are no caveats for foreign GI rights holders with either an interest in European Union registration, or who have already registered products under the regulation. A foreign geographical indications rights holder must ensure that its product meets the legislative requirements of the region's EC directive. I envisage that the most significant hurdles for Jamaica and the Caribbean are those related to proving product 'non-generic-ness' and costs related to registration and litigation.

## Chapter Five: Blue Mountain Coffee as a Geographical Indication in Jamaica

### 5. Introduction

“I need fertilizer for the coffee trees, a fertilizer cost \$6500.00 per bag, my farm needs 5 bags...if I have coffee to pick the picker wants \$1500.00 per day, then the man who weeds the land with a weed whacker wants \$2500.00, so it doesn't make sense economically all the time”.<sup>882</sup>

Chapter four discussed the jurisprudential approach of Japan, the United States and the European Union to food based geographical indications. It was imperative to undertake this analyses as the reciprocal recognition of geographical indications in Jamaica's major consumer market is necessary for positioning agricultural and food based geographical indications as assets of development.

Chapter five investigates, chronicles and analyzes current challenges in Jamaica's Blue Mountain coffee industry that may be either resolved or mitigated by a participatory and strategic approach to geographical indications. I focus on the plight of small scale farmers, who cultivate Blue Mountain coffee on family lands in the Blue Mountains or, on lands leased from the Jamaican government. The interviews were conducted between September 10, 2013 and January 21, 2016.

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<sup>882</sup> Interview with Blue Mountain coffee farmer on the prospects of continuing coffee cultivation based on current challenges in the industry. At the time of interview, farmers sold coffee beans for between J\$7000.00-\$10,00.00 per box, (October 30, 2015), BCF 14.

The chapter engages with specific issues identified in the research objectives and questions which I answer in the thesis.<sup>883</sup> Research questions such as, Can intellectual property strategizing be incorporated into a development policy that is framed on geographical indication as a counter hegemony in Jamaica's intellectual property discourse?; On what grounds can Blue Mountain Coffee be envisaged as a geographical indication asset?,<sup>884</sup> can only be answered by identifying the key stakeholders in the industry, identifying the challenges of the most vulnerable groups that influence the production and sustainability of the product, and formulate GI based policy directives that are likely to mitigate these problems.

As one of Jamaica's oldest and internationally well-known food based product, forming sustainable linkages between Blue Mountain coffee, geographical indications and a development oriented intellectual property policy necessitates a focus on the plight of the most vulnerable peoples responsible for its production – i.e., small-scale farmers.

Small-scale Blue Mountain coffee farmers are impacted most severely in the supply chain from price fluctuations, changes in consumer demand, natural disasters, and from gaps in government assistance; all of which are issues that frequently plague Jamaica's coffee industry. At the same time, an approach to a Blue Mountain coffee geographical indication scheme that is transparent, accountable, integrated and participatory, is more likely to be representational of the economic, social and cultural aspirations of small-

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<sup>883</sup> See, Chapter One, Sections 1.1-1.4.

<sup>884</sup> *Ibid.*

scale farmers. I maintain that without a focus on small-scale farmers, the practical effect of GI registration of Blue Mountain coffee is the perpetuation of an elite-centered intellectual property system in Jamaica, that lacks identifiable and fundamental input and participation from marginal classes. A participatory geographical indication strategy is also counter hegemonic, attempting to stem transnational class-based and elitist ideological tides that influence the knowledge structures governing how, and to whose benefit geographical indications is used.

The first section of the chapter discusses the cultivation practices of Blue Mountain coffee and the challenges encountered by farmers in the cultivation and harvesting of coffee beans. The subsequent sections illustrate current economic and socio-political<sup>885</sup> issues experienced by farmers in the cultivation and commercialization of Blue Mountain beans.

The importance of particularizing each geographical indication strategy to be specific to the product, its community and its key stakeholders are central to its success. Furthermore, and more importantly, it is highly probable that the absence of specific

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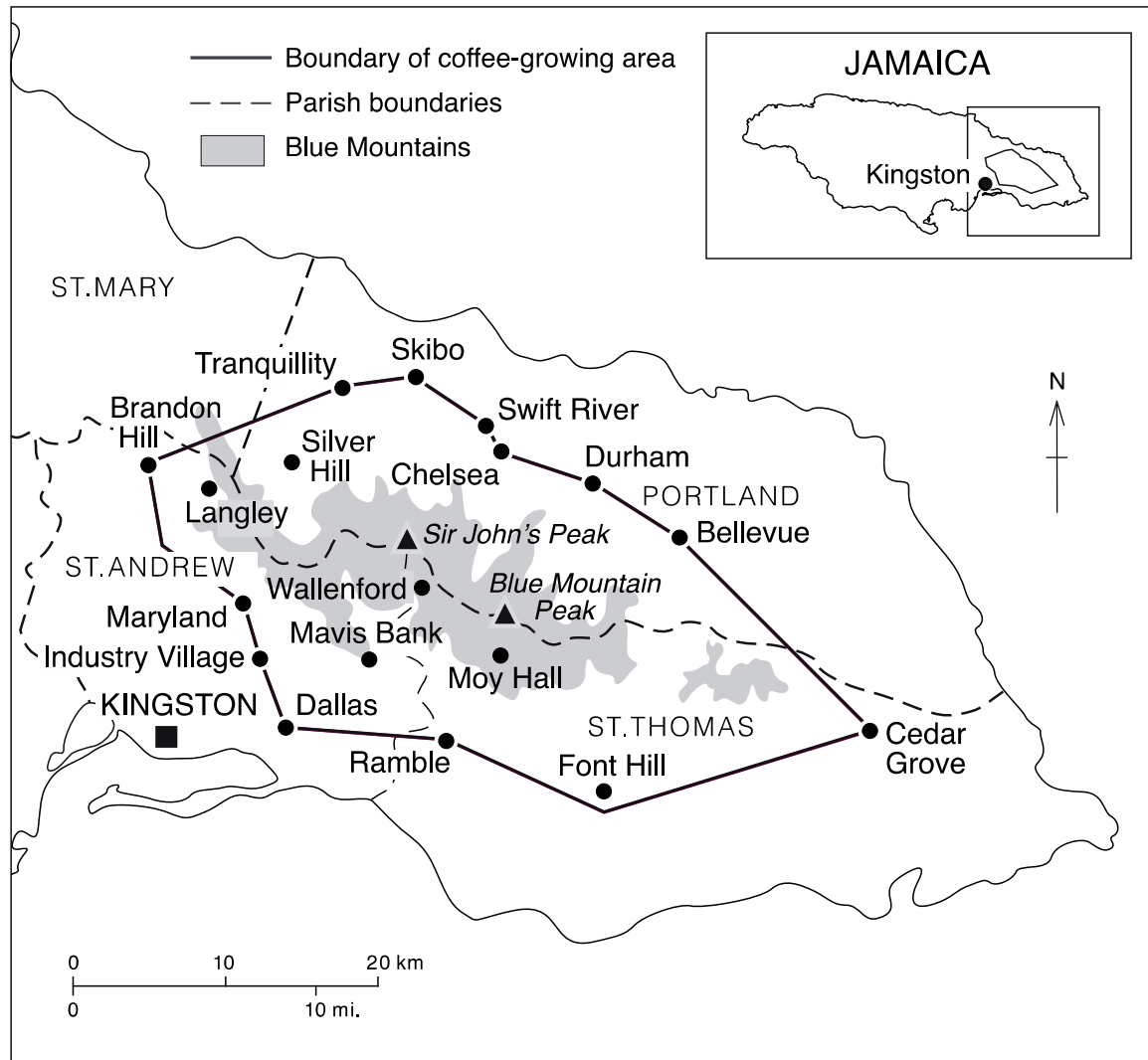
<sup>885</sup> I specifically note socio-political issues as it plays an important role in state-citizen relationships in Jamaica, especially among lower classed individuals. Socio-political issues pertain to social and political dynamics which prevent or leverage peoples' ability to effectively participate in the growth and well-being of a country. In narrowing the specification of this definition to the Blue Mountain coffee industry, socio-political issues pertain to the relationship between the government, the Coffee Industry Board and small-scale farmers, and whether this relationship hinder or elevate the small farmers' ability to fully capitalize from the cultivation and commercialization of Blue Mountain coffee. See, Patricia Northover & Michaeline Critchlow: "Size, Survival & Beyond in Norman Girvan & Brian Meeks, *The Thought of The New World The Quest for Decolonization*" (Kingston: Ian Randle Publishers, 2010); Michaeline Crichlow, *Negotiating Caribbean Freedom*, *supra* note 93.

“enabling”<sup>886</sup> factors may negatively affect the effectiveness of the geographical indication strategy.

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<sup>886</sup> This term is discussed extensively throughout this chapter, and is also defined in more detail in later sections. It is used throughout this chapter to refer to factors or conditions which effect results, or factors/conditions that are conducive to producing results-oriented changes in agricultural and food based geographical indications’ relationship with its key stakeholders.

**Fig.1. Map of Blue Mountain Coffee Cultivation Areas in Jamaica.<sup>887</sup>**



<sup>887</sup>Cartographer, Department of Geography, York University (2015).

### **5.1. Sample Size**

A total of 26 persons were interviewed. Of this number, 15 represented Blue Mountain coffee farmers, and 11 represented individuals and groups from other sectors which I identified as salient actors to add credibility to the research.

Prior to the research, I had no personal knowledge of, association with, or means of establishing communication with coffee farmers and key stakeholders in Jamaica. I knew of the Coffee Industry Board and its governance of all the export, import, and cultivation practices of coffee in Jamaica. I thereby started off the field work with queries to the Coffee Industry Board on ways of contacting Blue Mountain coffee farmers in Jamaica. The Coffee Industry Board provided a template of information from which I gathered farmer names and working telephone numbers to conduct the research. The farmers' sample size was also made possible through snow-balling, as the personal data from the Coffee Industry Board's template were not all accurate.<sup>888</sup>

Of the 15 Blue Mountain coffee farmers, 10 cultivated their beans on small plots of land of up to 10 acres (small-scale farmers), 4 cultivated their beans on plots of land between 11-60 acres (medium-sized farmers), and 1 farmer cultivated his beans on more than 60 acres of land (large-scale farmer). Out of a number of 15 Blue Mountain coffee farmers interviewed nine were males, and six of the participants were females. On average, the female farmers interviewed all practiced coffee cultivation on less than five acres of land.

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<sup>888</sup> Some of the farmers were deceased or, the telephone numbers were no longer in operation.



In order to obtain the most diverse, accurate and extensive information as logically possible, I also interviewed representatives from institutions which I envisage as influential (whether directly or indirectly) to an understanding of the research and its outcome. As such, representatives from Jamaica's Intellectual Property Office (3), CARICOM Secretariat (1), the Ministry of Foreign Affairs and Trade (1), the Rural Agricultural Development Agency (2), and the Coffee Industry Board (3) were also interviewed. Most interviews were conducted by telephone; some participants chose to respond by email. Participant responses were written down during the telephone calls and were not tape recorded.

## **5.2. Evaluating Interview Data**

After compiling the interview data, I analyzed the collected information according to responses obtained from the interview questions, and from the conversations that transpired during the course of the interviews. New information or topics that were not initially used in my approach to interview questions, but were obtained during the research and which were relevant to the topic were also included in the analyses.

Responses were manually coded and grouped according to similar and recurring responses in the collected data. As an example, responses pertaining to farmer interest in membership to a coffee association were analyzed according to the following observations: (i) medium to large scale farmers had varying degrees of interest in membership to a coffee association; (ii) the greater the extensiveness of farming activity by farmers, the greater the interest in forming a coffee association with the objective of providing guidance to small-scale farmers; (iii) all small-scale farmers interviewed had

no confidence in the ability of a coffee association to make any significant difference in their cultivation and commercialization of coffee; (iv) there is a gap in coordination, goals and outlook between the existing coffee association, the Coffee Industry Board and small-scale farmers. Differences in perspective and goals across these groups affect the prospect of forming a viable producer group.<sup>889</sup>

I have not isolated the collected data as grounds for making conclusive arguments. However, I have used the information along with content analysis of working papers, newspaper articles and Jamaican parliamentary proceedings, to form a reasoned critical analysis of the prospects of value- based geographical indications usages in Jamaica.

### **5.3. Coffee Cultivation**

The Blue Mountain region is at an altitude of 7402 feet above sea level. The coffee crop is cultivated and harvested over a year-long period, beginning August 01 through to August 31 of the following year. In the highest parts of the Blue Mountain, yields may take up to eight months to mature to full reaping levels.<sup>890</sup> Coffee farmers practice inter-crop<sup>891</sup> planting of vegetables, bananas and plantains as a way of supporting the growth of the Blue Mountain<sup>892</sup> coffee plant. The Coffee Industry Board has established

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<sup>889</sup> I discuss these findings in Chapter 6 of the thesis.

<sup>890</sup> Interview with Rep , Jamaica Coffee Growers' Association (January 21, 2016).

<sup>891</sup> Intercropping involves cultivating other types of crops in close proximity to the main crop as means of promoting interaction between the plants. Farmers practice intercropping *inter alia* as a means of controlling weeds in their fields (Interviews with Blue Mountain Coffee Farmers, September 2013, July 2015).

<sup>892</sup> In 1728 the Governor of Jamaica introduced the Blue Mountain coffee plant to colonial Jamaica. The governor had acquired the Arabica plant in Haiti; although its historical origin is traceable to Ethiopia. The

standards for the harvesting of cherry beans. These standards focus on promoting consistent quality in the cultivation and processing of coffee beans. A large scale Blue Mountain coffee farmer noted that:

“of late, (the Board) have been playing a key role in the preservation of Jamaica Blue Mountain Coffee, they have informed a number of farmers on the type of coffee plant that they should grow in terms of the export market, no longer should we be planting a variety of seedlings, but the *typica plant*, because that is what the industry was built on”.<sup>893</sup>

Coffee beans are hand-picked. Stale, discolored or odorous beans cannot be reaped for use. The coffee is then stored on wooden or concrete floor in a well-ventilated area or in a shaded area on a “cured concrete” barbecue for a period of 6 weeks.

Only a minimal amount of green beans can be included in the reaped coffee which is boxed, and sent to the coffee work<sup>894</sup> depot. The beans are then boxed for transfer to a

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coffee plant was cultivated on plantations in St. Andrew on a small-scale, and as the nineteenth century progressed, coffee cultivation increased to over 15,000 tonnes. In this period, the coffee industry’s control by Jamaican elites was essential to its economic viability. Emancipation and the ending of the slave trade led to significant decline in its production. By 1850, production and export had fallen substantially to 1486 tonnes. Jamaica’s Coffee Industry Board was established by the government in 1948 to manage the country’s declining coffee industry. The Coffee Industry Board was established after recommendations from the ‘Wakefield Report’, which opined that an organized and centralized department for governing the production of coffee was necessary to rehabilitate the industry. After the formation of the Coffee Industry Board and up to the early part of Jamaica’s post-independence period, (1957-1967), Blue Mountain coffee was primarily sold to English importers. By 1968 the Coffee Industry Board realized that its coffee sale to English importers were for purposes of importation to Japanese consumer market. On this basis, since 1968 the board began its importation of Blue Mountain coffee directly to Japan, in efforts to capitalize on its growing consumer market. Japan still remains the main consumer market for Jamaica’s Blue Mountain coffee. The Wakefield Report: Coffee Industry Board; *The Coffee Industry Regulation Act*, 1951 L.N/35/53.

<sup>893</sup> Interview with large scale Blue Mountain Coffee Farmer (October 22, 2015) BCF 11. Such a favorable view of the Coffee Industry Board was not shared by all interview participants. This is noted later in the chapter.

<sup>894</sup> Coffee Works is the processing plant for coffee beans in Jamaica.

coffee works location.<sup>895</sup> In order to ensure compliance with the Coffee industry board's standards, the coffee bean is also floated on a test basis once it arrives at the depot. Most coffee works are located in relatively close proximity to coffee farms. In instances of transportation difficulties between the farming location and the processing site, the coffee works transport the boxed coffee from the farmer's farm to its depot.<sup>896</sup>

Consistency in the quality of Blue Mountain coffee is maintained by a code of practice which should be complied with by all coffee farmers and processors. Enforced by the Coffee Industry Board, the code of practice stipulates the approach that is to be taken in the cultivation, harvesting and processing of coffee. Although the code of practice applies to all coffee farming in Jamaica, additional cultivation and harvesting practices of Blue Mountain coffee farmers facilitate a higher standard of quality assurance measures than other types of coffee. I argue that this further contributes to the distinguishing features of Jamaica's Blue Mountain coffee. I will first discuss the code of practice for coffee farming, and then analyze the challenges encountered by Jamaican Blue Mountain coffee farmers in the daily activities of planting, reaping and selling coffee.

### **5.3.1. Code of Practice for Coffee Cultivation**

Coffee nurseries must be operated on suitable land on which soil analyses is done to ensure compatibility with fertilizer choice and forecasted ideal growth of coffee beans. The Coffee Industry Board is integral in this process. An extension officer from the

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<sup>895</sup> Source: Interview with farmers and Jamaica Coffee Industry Board representative (September 17, 2013 and November 02, 2015).

<sup>896</sup> Blue Mountain coffee farmer interview (September 10, 2013), BCF 4.

board is assigned to the farmer's proposed nursery to ensure that specific environmental safeguards are practiced. These include drainage systems to prevent run off water from flowing into nearby rivers and streams, and proper land clearing practices. The Board's involvement is not limited to providing pre-nursery guidance assistance. The Board also conducts on-going monitoring of coffee farms, and provides crop cultivation assistance to coffee farms.

Among small-scale coffee farmers, once common contention was the low involvement of the Coffee Industry Board in the cultivation of Blue Mountain coffee. A small-scale farmer planting on 1.75 acres' asserts that, "they come, but nothing happens".<sup>897</sup> Compared to medium to large scale farmers, small-scale farmers were more likely to complain of non-involvement by the Coffee Industry Board in cultivation assistance.

Coffee farmers are also required to practice proper irrigation procedures and efficiently dispose of waste materials from coffee harvesting. This issue is not always dealt with appropriately by coffee farmers who are uncertain of how best to dispose of waste materials because of limited resources. As I discuss below, field sanitation is imperative to the management of pest infestation on farms. The code of practice also encourages the

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<sup>897</sup> Interview with small-scale coffee farmer, (November 02, 2015), BCF 12.

use of organic manure,<sup>898</sup> and cautions against the use of inorganic fertilizers. However, organic manure is expensive.

### **5.3.2. Environmental Challenges to Cultivation and Harvesting**

The most significant problems identified by coffee farmers relates to to coffee infestation, specifically the *Hypothenemus hampei* (coffee berry boarer insect), the coffee leaf rust, and the effects of hurricanes and drought on crop yields.

Hurricanes and droughts are challenges which are impossible to control. Bush fires are also a concern.<sup>899</sup> A coffee farmer noted, “there is nothing to protect the farms from disaster such as hurricanes and droughts, these affect yields”.<sup>900</sup> A Blue Mountain coffee stakeholder further commented on the effect of hurricanes and droughts stating that, “when hit by hurricanes, the absence of insurance coverage means that farms become unproductive”.<sup>901</sup> Farmers are frustrated by the effects of droughts, storms and hurricanes on their coffee fields. This was a commonality in response from all interviewed farmers. A female farmer who has been cultivating Blue Mountain coffee for 30 years noted that “we have had drought for two years, we need help”. A male coffee farmer comments that

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<sup>898</sup> Chicken manure is used by many farmers, but it is expensive to purchase (analysis of interviews with small-scale farmers). Medium and large scale farmers do not complain about the cost of fertilizer to the same extent as small farmers.

<sup>899</sup> Interview with Blue Mountain coffee farmers, (September 10 and 17, 2013), BCF 3.

<sup>900</sup> Interview with Blue Mountain coffee farmer, (September 10, 2013) BCF 5.

<sup>901</sup> Interview with a Blue Mountain coffee key stakeholder, (September 17, 2013), BCF 2.

“we have had drought (2013-2015) for two years, I currently have a little coffee but because of the drought and the cost of fertilizer I can’t reap a box of coffee from my land”.<sup>902</sup>

Hurricanes and droughts, such as Hurricane Ivan in 2004 and droughts up to 2015, destroy the coffee crop and affect the industry’s targeted yields. A statistical report of Blue Mountain cherry beans history of production illustrates that yield production was drastically reduced after Hurricane Ivan in 2004 to 2005 by almost 300,000 boxes.<sup>903</sup> Production levels have not retained pre-2004 figures up to the time of writing.

Of the two coffee infestations that affect yield, the coffee berry boarer is the most problematic.<sup>904</sup> Coffee pest and fungal infestation cause a reduction in harvesting yield by reducing the quantity of beans that can be harvested and used in the production process. Despite the Coffee Industry Board’s introduction of traps to catch the coffee berry boarer in 2001, coffee farmers<sup>905</sup> complain that the berry boarer still affects their beans. Cumulatively, the coffee berry boarer and hurricane damage to the Blue Mountain coffee crop are frustrating for farmers. In lamenting on this crisis and implicating the government in the debacle, a Blue Mountain coffee farmer states,

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<sup>902</sup> Interview with small-scale coffee farmer, (November 02, 2015), BCF 13.

<sup>903</sup> Coffee Industry Board, “Cherry Production History from Crop year 1981/82-Present” (2015 Report).

<sup>904</sup> Interviews with Blue Mountain Coffee farmers. Leaf rust infestation also affects coffee yield.

<sup>905</sup> *Ibid.*

“the berry boarer disease has been affecting the plants for a while...the hurricane is a challenge that is out of man’s control, small farmers had no equipment to handle hurricane issues and the government did not help in time, this caused a serious dive in coffee production, which has not fully recovered”.<sup>906</sup>

Field sanitation is essential to the eradication of the coffee berry boarer infestation. The Coffee Industry Board advises coffee farmers to clear fields of post-harvest waste in efforts to minimize pest infestation. Notwithstanding the benefits of pest control, farmer compliance with pest control practices is not consistent, based on cost impediments encountered in acquiring crop fertilizers. In frustration, a female coffee farmer states,

“As a woman in farming, the situation is bad, Hurricane Sandy devastated my farm, there were a lot of trees to be disposed of and it is not as if they can be cut for lumber, and I have received no help to resuscitate the farm, not one red cent”.<sup>907</sup>

Farmers still encounter difficulties with pest and fungal infestation. Interestingly, large scale farms are more likely to adapt to and implement new measures geared at reducing pest infestation. The small to medium sized coffee farms practice traditional pest prevention techniques, and is reluctant to implement new techniques in eradicating or reducing pest infestation.<sup>908</sup> According to one farmer “cultural practices can help to alleviate the problem, proper field sanitation, pruning on time, postharvest field sanitation and good drainage practices”.<sup>909</sup>

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<sup>906</sup> Blue Mountain Coffee farmer, cultivating on large acreage – over 60 acres, (Interview, October 26, 2015, BCF 10).

<sup>907</sup> Interview with small-scale coffee Blue Mountain coffee farmer, (November 02, 2015), BCF 9.

<sup>908</sup> Interviews with small to large scale Blue Mountain coffee farmers.

<sup>909</sup> Interview with medium scale Blue Mountain coffee farmer, (September 10, 2013), BCF 6.



Despite these precautions, the financial cost of pest and fungal eradication on Blue Mountain coffee farms is burdensome to small and medium sized farmers.<sup>910</sup> The financial burden involved in coffee cultivation has caused many farmers to abandon their field. Although I focus on economic issues later in this chapter, I make this point for the following reason. Abandoned fields are haven for pests such as the coffee berry borer. Farmers whose fields are adjacent to an abandoned coffee lot must contend with pest control issues from these fields, which compound their own eradication efforts.

The control of coffee infestation is an integrated process. The Coffee Board stipulates that farmers should use an integrated pest management technique in dealing with coffee pest infestation. The Board's "integrated management technique" is an approach which involves field clearing, the use of organic manure or mandated fertilizers and tree pruning. Arguably, mandating the use of specific pest control mechanisms is a rational and salient measure which promotes consistency in the quality of Blue Mountain coffee. However, the economic cost of combating infestation is a significant problem to many coffee farmers. This issue is at times exacerbated by the costs of fertilizing the coffee crop to promote its growth.

The Coffee Industry Board advises farmers on the specific types of fertilizers which should be used on the coffee plant. A number of farmers have stated that the cost of

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<sup>910</sup> *Ibid.*

fertilizer is often expensive and poses an economic challenge. A small-scale farmer commented that, “it is an obstacle to coffee cultivation”.<sup>911</sup> Another Blue Mountain coffee farmer commented that fertilizer cost “is one of the man-made challenges of coffee cultivation...the cost of input is very high”.<sup>912</sup> A female small-scale Blue Mountain coffee farm further commented that, “the hurricane in 2004 and 2006 destroyed everything, the government came and looked at the property but I didn’t get any help”.<sup>913</sup>

The use of manure to fertilize the coffee plant is practiced by some farmers.<sup>914</sup> This practice tends to be more prevalent amongst small scale Blue Mountain coffee farmers.<sup>915</sup> Although the Jamaican government recently provided fertilizers to a number of coffee farmers through an international grant,<sup>916</sup> this provision is insubstantial to counter the economic challenges incurred in purchasing fertilizers.<sup>917</sup> In addition, the Coffee Industry Board limits the provision of fertilizer to farmers that have active coffee fields. An elderly female small-scale farmer who has been planting coffee for thirty years complains,

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<sup>911</sup> Interview with small-scale coffee farmer, (September 10, 2013), BCF 2.

<sup>912</sup> Interview with Blue Mountain Coffee Farmer (October 26, 2015), BCF 8.

<sup>913</sup> Interview with small-scale Blue Mountain coffee farmer (September 13, 2013), BCF 4.

<sup>914</sup> Interview with coffee farmers.

<sup>915</sup> I make this statement from an analysis of interview responses.

<sup>916</sup> Jamaica Gleaner, May 17, 2012 “Coffee Farmers get fertilizer to increase crop production” (Available online: <http://jamaica-gleaner.com/gleaner/20120517/business/agro1.html>).

<sup>917</sup> *Ibid.*

“If you are not actively planting coffee, then there is no help to purchase fertilizer, you must have coffee to sell in order to obtain fertilizer, the coffee industry board use to assist the farmer, but they are not helping anymore...the government use to assist in, they’d send us documents to fill out, I’d fill it out and return it to them, then they would send the fertilizer and take the cost of the fertilizer out of what they pay you, not anymore”.<sup>918</sup>

The operations of the Jamaica Coffee Growers Association<sup>919</sup>, a coffee farming association is a commendable initiative which, though lacking in mainstream key stakeholder support, provides assistance to farmers in obtaining fertilizer at a comparatively reasonable price.

I will discuss the administration and scope of duties of Jamaica’s Coffee Growers Association later in this chapter. However, at this juncture I will make 2 points on the mandate of the organization which is relevant to farmer assistance. Firstly, the Jamaica Coffee Growers Association was formed to represent the interest of small coffee farmers,<sup>920</sup> and specifically, in securing better coffee prices and materials for farmers. Secondly, through economies of scale<sup>921</sup> the Coffee Growers Association provides fertilizers to coffee farmers at a reduced rate in comparison to market prices. The organization’s mandate is ambitious, commendable and fairly feasible. However, although membership is voluntary, there is reluctance by some coffee farmers to join the

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<sup>918</sup> Interview, with small-scale coffee farmer planting on 1.75 acres of land. (October 26, 2015), BCF 14.

<sup>919</sup> Jamaica Coffee Growers` Association.

<sup>920</sup> Interview with representative from Jamaica’s Coffee Growers’ Association (Sept 17, 2013), JCGA 1.

<sup>921</sup> I refer to economies of scale as cost advantages to an organization based on its size, and level of representation of members of a particular group. Paul Krugman, Robin Wells & Anthony Myatt, *Micro-economics*, (New York: Worth Publishers, 2005).

organization.<sup>922</sup> Without membership, coffee farmers who require subsidy assistance in purchasing fertilizers are unable to access the resources of the Coffee Growers Association.

The recent divestment of one of Jamaica's major coffee farm and processing plants, Wallenford Farms (Farm), to a private owner has facilitated the promotion of 'production-oriented' initiatives to farmers. Under this arrangement, coffee farmers who provide cherry beans to the Farm gain access to fertilizers at a reduced rate. The purchase price of the fertilizer is only payable upon delivery of the farmer's boxed coffee to the farm's processing plant.<sup>923</sup> As such, the provision of fertilizers without immediate payment by coffee farmers is facilitated under this scheme. An ambitious initiative, it was undoubtedly implemented to mutually benefit both parties, the 'Farm' and its coffee bean suppliers (farmers). The fertilizer is sold at a more competitive rate than the farmer's main supplier; this creates an additional revenue stream for the Farm. I argue that the arrangement is indicative of an improvement over the prior situation, but still represents a cost outlay to small and medium sized coffee farmers.

Pest management difficulties, lack of adequate resources to purchase fertilizers, hurricanes and droughts are issues which affect the yield of coffee beans for Blue Mountain farmers. These issues directly impact the quantity of coffee which is harvested

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<sup>922</sup> This point is discussed in detail below.

<sup>923</sup> *Supra* note 877, interview with representative from Jamaica's Coffee Growers' Association.

for processing, and subsequently the amount of remuneration received for boxed coffee. This point is critically discussed below in the section which analyses the economic benefits, and challenges involved in Blue Mountain coffee production for farmers in Jamaica.

#### **5.4. Economic Barriers**

Blue Mountain coffee is primarily sold to international consumer markets in Japan, United States and Europe. In addition to this, China represents an emerging and growing consumer market for Blue Mountain coffee.<sup>924</sup> In support of this emerging business venture, a medium sized coffee farmer stated that the China's interest in Blue Mountain coffee is an opportunity "to diversify the market".<sup>925</sup>

Despite the premium price applicable to Blue Mountain coffee in international markets,<sup>926</sup> coffee farmers do not receive reciprocal remuneration for their beans. The issue is the same domestically. Coffee processors, large scale farmers and large scale distributors of Blue Mountain coffee receive the bulk of profits generated from the commercialization of the product.<sup>927</sup> The financial frustration of a female small-scale farmer illustrates the debacle. She ceased coffee cultivation on the family owned Blue

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<sup>924</sup> Coffee Industry Board website ([www.ciboj.org](http://www.ciboj.org)).

<sup>925</sup> Interviews with medium to large scale coffee farmers, the Coffee Growers Association and the Coffee Industry Board (August 25, 2013; July 28, 2015 and November 03, 2015).

<sup>926</sup> From Coffee Industry Board interviews, and conversation with Blue Mountain coffee farmers (July 28, 2015 and November 05, 2015).

<sup>927</sup> Interview with coffee farmers over the course of the research.

Mountain property and re-orientated her farming engagements to the operation of a small chicken farm.<sup>928</sup>

On average, until as recent as 2015, coffee farmers received approximately Jamaican \$3500-\$4000.00 (\$35.00-\$40.00 Canadian).<sup>929</sup> A medium scale coffee farmer cultivating on 13 acres of land commented that “funds from coffee was better in previous years than it is now, the cost of input has increased”.<sup>930</sup>

Recently, the price has increased to as much as Jamaican \$7500.00-12,000.00 (Canadian \$75.00-\$120.00).<sup>931</sup> The recent increase in the price paid for Blue Mountain coffee is due to an increase in demand more than that which can be met by the current production amounts. A Blue Mountain coffee farmer explains the reason for price increases in beans,

“with divestment of the coffee industry there is now a demand, but having suffered from low pricing before that, there was not sufficient berries around, now prices are up because of a shortage of coffee beans”.<sup>932</sup>

A box of harvested coffee represents approximately 9.5 pounds of green beans. The price farmers receive for boxed coffee has not remained stagnant over the years.<sup>933</sup> However,

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<sup>928</sup> Small-scale farmer interview (BCF 15).

<sup>929</sup> Interview with coffee farmers, and with the Jamaica Coffee Growers Association.

<sup>930</sup> Interview with coffee farmer, (September 10, 2013) BCF 1.

<sup>931</sup> Interview with representative from Jamaica’s Coffee Growers ‘Association (January 21, 2016), JCGA 1; Interview with coffee farmers (November 05, 2015).

<sup>932</sup> Interview with coffee farmer (October 26, 2015), BCF 10.

despite this observation the amount paid for coffee is substantially inadequate for small and medium sized farmers whose livelihood is dependent upon coffee production. In terms of price mark ups, in 1979 Blue Mountain Coffee farmers were paid an average of Jamaican \$24.00 per box for coffee. By 1988 the amount paid to farmers had increased to Jamaican \$84.00, and by 1998 had increased to Jamaican \$1650.00 (\$16.50 Canadian).<sup>934</sup>

A more favorable price for green beans will not, on its own, act as a catalyst for increased farming activity by many farmers. A medium sized farmer commented that “this will not cause farmers who had left their farms to start farming again...it takes too much to start over”.<sup>935</sup> An elderly female farmer who planted coffee on 2 acres of Blue Mountain coffee land said that, despite the increase in price paid for boxed coffee,

“I’m not really into farming again, they (thieves) steal too much, once I turn my back they steal what I plant..and I don’t live in the community, I left the farm, asked my son to take it over and he has no interest, I planted bananas on the farm too, but I’m not going back into it (farming)”.<sup>936</sup>

The Coffee Industry Board charges a processing fee, (cess) for each box of coffee delivered to a processing plant. Pursuant to the *Coffee Industry Board’s Regulation*,<sup>937</sup> cess is payable on each box of coffee sold by farmers. Cess is levied by the Coffee

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<sup>933</sup> A review of Coffee Industry Board Annual Reports, 1957-1998.

<sup>934</sup> *Ibid.*

<sup>935</sup> Interview with medium sized coffee farmer (July 28, 2015), BCF 7.

<sup>936</sup> Interview with small-scale coffee farmer (July 11, 2015) BCF 8.

<sup>937</sup> *Jamaica Coffee Industry Board Regulations.*

Industry Board as an administration fee, and is an amount which is due on the delivery of the boxed coffee. A female coffee farmer explains how cess works, “when the bean is sold, they (the Coffee Industry Board) subtract cess amounts from the money they give you for the beans”.<sup>938</sup>

The current amount payable as cess on Blue Mountain coffee is Jamaican \$100.00 per box or Canadian \$10.00 per box. The practical effect of cess is indicated in the subsequent example. A farmer who delivers 250 boxes of beans to Wallenford farm (processing facility) pays \$25,000.00 (Canadian \$2500.00) as cess to the Coffee Industry Board. The amount is deductible from the portion of funds farmers receive for each box of cherry beans.<sup>939</sup> Farmers’ dissatisfaction with cess is more apparent in low remuneration periods. A small-scale farmer noted that he is “not comfortable with it, people in general do not like to be taxed; a lot of coffee farmers are upset about it”.<sup>940</sup>

Although cess is a variable fee, I have observed that over the past 20 years there has not been significant increases in the fee.<sup>941</sup> In 1988, the cess payable for each box of Blue Mountain cherry beans was Jamaican \$35.00. A hundred-dollar payable per boxed coffee in 2016 is not indicative of a substantial price change. Although yearly increases

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<sup>938</sup> Interview with small-scale coffee farmer, (October 26, 2015) BCF 11.

<sup>939</sup> This information was obtained from interviews with coffee farmers.

<sup>940</sup> Interview, (May 10, 2013) BCF 1.

<sup>941</sup> Annual Reports, Jamaica Coffee Industry Board.



in cess amounts are not substantial, the amount chargeable per box is a cost outlay to farmers, and lessen the amount received in remuneration.

Coffee farmers are not paid instantly at the time of delivery of their beans to the coffee works plant. Delay in payments is a significant challenge, and has worsened the financial position of small sized coffee farmers over the past 15-17 years. As noted by farmers, a portion of the purchase price is paid upon the delivery of the boxed cherry beans, and the remainder is paid later. The duration of time between delivery of the coffee and payment varies, and in some instances, has been as lengthy as a year after delivery.<sup>942</sup> As with other commercial products the demand for Blue Mountain Coffee influences its supply.

Similarly, the demand for Blue Mountain coffee internationally directly impacts the markets that are available to coffee farmers to sell their beans. The amount of coffee beans exported by Jamaica to its major international consumer markets fluctuate in most years. In 2003, Jamaica exported over 1 million kilograms of green beans to Japan.<sup>943</sup> In 2012/13, the amount of green bean exported to Japan was over 400,000 kg. Although this is a significant decline, it represents an increase over the 2011 period.<sup>944</sup> Periods of high

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<sup>942</sup> The topic of cess brought up a significant and notable divide between small and medium to large scale farmers. Cess is a problem to many small farmers as it reduces the amount they are eventually paid for their beans. The medium to large scale farmer analyzes the situation differently. A large scale farmer notes, “coffee is supplied between August to December, but because of the higher price for beans, it means that the farmers first payment is more, although cess is deducted from it” (Interview with Blue Mountain Coffee farmer, October 26, 2015).

<sup>943</sup> Report from Jamaica’s Coffee Industry Board.

<sup>944</sup> *Ibid.*

or low demand for coffee beans directly influence the waiting period for payments. Furthermore, a downturn in economic conditions in the Japanese market in the mid 2000's affected the financial viability of the Blue Mountain coffee industry in Jamaica. The financial imperils of Japan's economy has led, over the past 13 years, to a fluctuation in the export of Jamaica's Blue Mountain coffee to its consumer market.<sup>945</sup>

Historically, the contractual agreement between the Coffee Industry Board and Japanese importers provided for advance payments to be made, prior to the delivery of the coffee.<sup>946</sup> In 1983, the Jamaican government signed a loan agreement with the Japanese government whereby 5941 million yen was loaned to coffee farmers, in efforts to re-structure coffee plantations in the Blue Mountains.<sup>947</sup> The loan was for purposes of further capitalizing on the Japanese consumer market, boosting the local economy and providing jobs to farmers.<sup>948</sup> It is evident that the advance payment arrangement was based on the relationship which both countries had fostered with each other. The advance payment practice enabled coffee processors to pay coffee farmers for their cherry beans, and facilitate an adequate payment mechanism for the processors' production expenses.

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<sup>945</sup> *Ibid.*

<sup>946</sup> Coffee Industry Board of Jamaica, Annual Reports, ([www.ciboj.org](http://www.ciboj.org))

<sup>947</sup> Jamaica, Blue Mountain Coffee Development Project Report ([http://www.jica.go.jp/english/our\\_work/evaluation/oda\\_loan/post/2002/pdf/140\\_full.pdf](http://www.jica.go.jp/english/our_work/evaluation/oda_loan/post/2002/pdf/140_full.pdf))

<sup>948</sup> *Ibid*; Interview with representative from Jamaica Coffee Growers' Association (September 17, 2013), JCGA 1.

However, as of 2009, Japanese importers stopped the practice of advance payments for its purchase of Blue Mountain coffee.<sup>949</sup> The end of advance payments for Blue Mountain coffee continues to be a significant paradigmatic shift for coffee farmers, and smaller coffee processing facilities. The change in the Japanese market buying trend is based on competition from cheaper brands, and a financial downturn in the country's economy.

Over-reliance on the Japanese consumer market and its advance payment practice has substantially affected the financial viability of Jamaica's Blue Mountain coffee to farmers and some processors. I will first discuss the transition to 'on-time payment' by Japanese importers to coffee farmers. A payment system in which the purchase price is paid upon delivery of the green beans has the following effect on specific stakeholders in Jamaica's Blue Mountain coffee industry. Firstly, coffee processors are at times unable to purchase cherry beans on a timely basis from coffee farmers because of lack of sufficient financial resources.

In other situations, coffee processors purchase only portions of the farmers' beans. The inability to purchase the farmer's entire reaped beans causes a financial loss to the coffee farmer, which is exacerbated for small sized farmers, especially single income households. A number of coffee farmers have ceased coffee cultivation because of this issue. A female small-scale coffee farmer explains "since Hurricane Gilbert in 1988

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<sup>949</sup> *Ibid*

things keeping worse, people just throw everything aside – give up – and start planting banana and plantains instead”.<sup>950</sup>

Up to the period January 21, 2016, the Blue Mountain coffee market in Jamaica remained in a period of greater demand than current supply of green beans.<sup>951</sup> Therefore, farmers’ beans are purchased, but abandoned coffee lands and lack of interest in re-farming or increasing the scale of farming activity by small farmers, continue to be a challenge.<sup>952</sup> However, despite the challenges, a small-scale female coffee farmer who cultivates on 1.5 acres of Blue Mountain land remains enthusiastic,

“Before the price increase, we had a lot of coffee and didn’t have anything to do with it (means of selling it), I still have the land space, if the price stays as it is I will continue to plant coffee...I can survive from coffee production full time”.<sup>953</sup>

Secondly, it is arguable that an over-reliance on the Japanese market limits the commercial opportunities for Blue Mountain coffee to effectively penetrate other international markets. I make this point because, based on the existence of an established consumer market, fewer resources are allocated towards fostering alternate consumer markets. The recent efforts made by the Coffee Industry Board to gain entry to new

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<sup>950</sup> Interview with Blue Mountain coffee farmer – medium scale, BCF 12 (October 26, 2015).

<sup>951</sup> Interview with Rep 1, Jamaica Coffee Growers’ Association (January 21, 2016).

<sup>952</sup> This point was mentioned earlier in the chapter.

<sup>953</sup> Interview with small-scale coffee farmer BCF 13 (November 02, 2015).

consumer markets is commendable.<sup>954</sup> However, I am contending that this diversification should have occurred earlier, as a proactive measure, rather than as a reactive measure.

The financial challenges have exacerbated to the extent that the government borrowed funds from 2 local development banks to purchase the 2011/12 coffee crop from farmers.<sup>955</sup> Many small sized coffee farmers have been forced to abandon coffee cultivation because of the unavailability of markets to purchase their beans. In commenting on the situation a Blue Mountain coffee farmer stated, “lots of farmers have turned away from the farm or reduced their acreage”.<sup>956</sup>

Other farmers attempt to capitalize on inter-cropping<sup>957</sup> of the coffee farm by planting and selling plantains, bananas, scallions, thyme and/or other vegetable crops. A female small-scale coffee farmer commented that she “planted plantains on the farm, I made money from it too”.<sup>958</sup> It was a lucrative supplement to coffee farming while her coffee plot remained active. Inter-cropping or the planting of an additional crop for the purposes

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<sup>954</sup> Jamaica Gleaner, New Markets needed for Jamaican Coffee in China ( <http://jamaica-gleaner.com/gleaner/20121205/business/business5.html>); Jamaica Blue Mountain Coffee Breaks into UK markets with Harvey Nichols contract, Jamaica Coffee Industry Board’s website (<http://www.ciboj.org/index.php?id=9>).

<sup>955</sup> Jamaica Gleaner, New Markets needed for Jamaican Coffee in China ( <http://jamaica-gleaner.com/gleaner/20121205/business/business5.html>); Jamaica Blue Mountain Coffee Breaks into UK markets with Harvey Nichols contract, Jamaica Coffee Industry Board’s website (<http://www.ciboj.org/index.php?id=9>).

<sup>956</sup> Interview with coffee farmer (September 10, 2014).

<sup>957</sup> The planting of non-coffee crop in between the coffee plants to promote shade and soil support.

<sup>958</sup> Interview with coffee farmer, (July 29, 2015).

of selling provides a means of paying property taxes on the farmed land. As noted by one farmer, the financial debacle is so extensive that without the cultivation and sale of vegetables the property taxes for his coffee plot cannot be paid.<sup>959</sup>

Another Blue Mountain coffee farmer explained that even in periods of work, there is also a problem with labor,

“so many persons are looking for jobs, even now other small coffee farmers are seeking employment with me so as to obtain enough funds to purchase a bag of fertilizer...labor is a problem, I have to bring in people from neighboring parishes, similar to a farm worker program with 10-15 people living on the farm, to get workers for the farm, I use to go to the sugar cane communities to get people to work on the farm, these are hard-working people...all changed after the Japanese coffee market crashed, everything came crashing down”.<sup>960</sup>

Many coffee farmers have noted that the deregulation of the industry has worsened their financial position, although it initially led to the entrants of more farmers in the industry.

A medium scale coffee farmer explains,

“I started farming Blue Mountain coffee in 1990, after deregulation I remember planting coffee and selling it to the government, prior to that, only the rich man could be in it, the average farmer could not manage it. After deregulation the markets opened up, big companies and prominent upper class individuals started cultivation as well”.<sup>961</sup>

A recent issue that has resulted from the divestment of Jamaica’s coffee industry is the confiscation of small-scale coffee farmers’ land to Wallenford farms<sup>962</sup> through

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<sup>959</sup> Interview with small-scale coffee farmer (September 13, 2013).

<sup>960</sup> Interview with Blue Mountain Coffee farmer (September 10 2013), BCF 9.

<sup>961</sup> Interview with medium scale coffee farmer, (September 10, 2013) BCF 9.

<sup>962</sup> Wallenford Farm is a coffee plantation and processing plant that was previously owned by the Jamaican government. Blue Mountain coffee is cultivated on over 5000 acres of land in Jamaica’s Blue Mountains (information available on Wallenford Farms website, <http://wallenford.com/about.php>, last accessed

questionable lease agreements. A representative from the Coffee Growers 'Association explains the problem,

Wallenford farm now leases the land from the government and there are legal challenges. First, lands were leased to the farmers and then without the farmers having surrendering them, the same lands are now leased to Wallenford farms without the termination of the farmers' lease. There is no funding to challenge this and the government is of no help....the whole thing is a mess".<sup>963</sup>

Deregulation has also affected cultivation practices. Cultivation practices as used in this context refer to the farmer's ability to effectively produce coffee without pest and fungal impediments. Farmers have asserted that there was a stronger involvement by the Jamaican government up to the mid 1990's in the administration and financial support of the coffee industry. In a deregulated economy, state owned enterprises are sold to private firms as a means of reducing the economic burden of the state and of increasing revenue.<sup>964</sup> Coffee farmers have noted that prior to the onset of the twenty first century, the Jamaican government was more directly involved in pesticide and fungal management by spraying their crops and providing fertilizers at minimal or no cost.<sup>965</sup>

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January 21, 2016). Wallenford Farms was purchased from the Jamaican government by Michael Lee Chin, a Jamaican Canadian in 2013 for US \$16million. I was unable to obtain an interview with a representative from the farm.

<sup>963</sup> Interview with representative from Jamaica Coffee Growers Association (January 21, 2016), JCGA 1.

<sup>964</sup> Edward Rubin, Deregulation, Reregulation and the Myth of the Market, (1998) 45:4 *Wash L Rev* 1249; M Shamsul Haque, The Fate of Sustainable Development Under Neo-Liberal Regimes in Developing Countries (1999) 20:2 *Int'l Pol Sci Rev* 197.

<sup>965</sup> Interview with coffee farmers.

Commenting on the current lack of government assistance, and implicating political favoritism in the allocation of fertilizers, a small-scale female farmer laughs in frustration and notes,

“Nobody helps. Everything is done by favor, they give their favorite people. Persons who have no coffee receive fertilizer from the government, they take it and sell it and because of that the production cannot go on for those who need it and cannot afford it – you know politics – everything is run by politics”.<sup>966</sup>

Although the government has provided funding to the coffee industry to mitigate damages to farms and processing plants done by hurricanes and storms, there has been no substantial wide-scale funding since the Japanese financed loan in 1983.

The economic challenges discussed above affects coffee farmers to varying extents. Ninety percent of Blue Mountain coffee farmers practice its cultivation on a small-scale.<sup>967</sup> Of this percentage, many small farmers have ceased cultivation, reduced the scale of cultivation or started working in other jobs to supplement their income. A growing trend observable among some coffee farmers is the practice of abandoning their farms and working on larger farms as hired laborers. A large scale farmer opines that it is very difficult to subsist solely on Blue Mountain coffee farming,

“If you have sufficient money to survive on without depending on coffee cultivation, it is a chance investment, there are so many variables outside of your control, one of them is weather, it is not a good choice to place your entire life savings into the coffee cultivation, I am being practical, I have invested millions into Blue Mountain coffee and have not seen the return up

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<sup>966</sup> Interview with small-scale coffee farmer, (October 26, 2015), BCF 12.

<sup>967</sup> Interview with representative from Jamaica Coffee Growers Association (JCGA).



to this day. You either have to keep going at it or make a serious decision to get out of it”.<sup>968</sup>

A female farmer was more optimistic, despite the absence of assistance from the government,

“I can’t survive on coffee alone, I just cannot. I have to put in a lot of work. Since the price of coffee has increased, it is more encouraging to continue, but there is the problem of praedial larceny<sup>969</sup>...as the price increases, people are more prone to steal the coffee beans...as a woman it makes things difficult”.<sup>970</sup>

Despite these difficulties, there are still a few favorable initiatives and programs which assist in fostering hope among coffee farmers that the industry will improve. A specific coffee processing plant recently increased the price per box payable for cherry beans from farmers<sup>971</sup> by Jamaican \$100.00 or Canadian \$10.00. I argue that this incremental increase is beneficial to farmers, although it does not adequately offset their cost outlay. The recent local market price increase in coffee beans is positive, but also produces challenges for farmers. The significant issues facing the Blue Mountain coffee industry in Jamaican cannot be resolved by the use of intellectual property rights.

The narratives of Blue Mountain farmers illuminate that globalization has brought added difficulties to the survival of coffee farming as a livelihood, that now necessitates an

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<sup>968</sup> Interview with large scale coffee farmer (October 26, 2015), BCF 10.

<sup>969</sup> Praedial larceny is the theft of agricultural produce or animals from farmers’ land. (*Praedial Larceny Prevention Act*, 28 February 1983, Acts of 17 1992, 12 2002).

<sup>970</sup> Interview with small-scale coffee farmer (October 26, 2015) BCF 13.

<sup>971</sup> Interview with representative from Jamaica Coffee Growers’ Association, (JCGA), JCGA 1.

integrated approach to intellectual property. A collaborative approach to protection, remuneration, product sustenance and diversification is required, that I posit, is achievable through strategic approaches to geographical indications.

### **5.5. Chapter Summary**

The research was predominately centered on small-scale coffee farmers, in efforts to interrogate the relationship between food-based geographical indications and the socio-economic welfare of key stakeholders who are involved in coffee farming as a means of livelihood. For this purpose, the lower end of the supply chain was my focus. Economic difficulties, and lack of adequate safeguards to combat environmental problems caused by plant infestations, hurricanes, storms and droughts, are the main challenges impeding growth within the coffee industry for farmers. The next chapter is the second segment of the field work and uses the research results to propose and inform best approaches in the structuring, management and sustenance of a Blue Mountain coffee GI scheme.

## **Chapter Six: Critical Analysis of Blue Mountain Coffee as a Geographical Indication- Legal and Technical Framework and Assessment of Outcome**

### **6. Introduction**

In Chapter 5, I discussed the economic and environmental challenges encountered by Jamaican Blue Mountain coffee farmers, as well as by the industry. This was necessary to illustrate the issues, favorable and un-favorable, which affect the Blue Mountain coffee industry, specifically its impact on small and medium sized farmers.

In this chapter I use the data and content analysis from chapter 5 to augment an approach to, and a structure for a Blue Mountain coffee geographical indication scheme.

As the chapter indicates it is a practical approach which is not without its challenges. In order to thoroughly engage with this analyses, I will first discuss the current legal framework protecting Blue Mountain coffee in Jamaica.

The subsequent sections evaluate the prospects of a viable and sustainable geographical indication linkage with Jamaica's Blue Mountain coffee and development policy by critical consideration of the technical and legal requirements necessary to envisage Blue Mountain coffee as a GI, and the advantages of, and obstacles to a feasible relationship between GIs and a 'Jamaican' development policy. Agricultural and food based geographical indications must be commercialized and protected on bases which recognize the contribution of small and medium scale coffee farmers in the establishment and sustenance of the product, and the scheme.

### 6.1. Current Legal Framework for Blue Mountain Coffee in Jamaica

The Blue Mountain coffee is registered as a certification mark in Jamaica and in international consumer markets. Pursuant to sections 3(1) and 3(2) of Jamaica's trademark legislation, a certification mark is a mark which distinguishes the product from a non-marked product, and which may also designate or identify a good with a geographic origin.<sup>972</sup> In order to enable registration, the registrant must specifically note the persons authorized to use the mark, the characteristics which the mark certifies and, the approach used by the certifying body to test the characteristics of the mark.<sup>973</sup>

The certification mark is owned by the Jamaican government through its Coffee Industry Board. The Coffee Industry Board licenses the mark to authorized persons for use on Blue Mountain coffee. A representative from the Coffee Industry Board explains,

“In order for one to become a dealer of Blue Mountain Coffee, they are required to apply for a coffee license. If trading locally (in Jamaica), and is desirous of selling roasted coffee, then an application should be made for a Special Coffee Dealers License. To trade (buy and sell) green beans, a Coffee Dealer's License is required. For persons overseas (outside of Jamaica), an application for a Foreign Importers Registration should be made”<sup>974</sup>

Currently, there are 24 licensed dealers authorized to use the Blue Mountain coffee certification mark on their coffee.<sup>975</sup> These dealers must be cultivators of Blue Mountain coffee. According to the *Coffee Industry Board* regulation, a coffee dealer “is a person

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<sup>972</sup> Jamaica's *Trademark Law*, 1999. ss 1 & 2.

<sup>973</sup> Jamaica *Trademark Law*, 1999 section 4.

<sup>974</sup> Interview with representative from Jamaica's Coffee Industry Board (January 16, 2014) CIB Rep 1.

<sup>975</sup> Jamaica Coffee Industry Board website ([www.ciboj.org](http://www.ciboj.org).)

holding a license under the *Agricultural Produce Act*<sup>976</sup> which entitles the individual to purchase and sell coffee<sup>977</sup>. Therefore, a coffee dealer license enables the holder to cultivate Blue Mountain coffee, and to purchase and sell the beans and roasted product. A contentious problem experienced by small-scale coffee farmers is their inability to become coffee dealers because of the mandatory production threshold required to achieve this status. Coffee dealers must produce or have the farm capacity to produce 6000 boxes of cherry beans per calendar year; verifiable by three years of reports or records.<sup>978</sup>

The application fee for a coffee dealers license is Jamaican \$5000 Jamaican (Canadian \$50.00). I argue that the primary obstacle for a transition from a coffee farmer to a coffee dealer is the production requirements, as the registration fee is negligible in comparison to the other pre-requisites. Coffee dealers and coffee works are subjected to the *Coffee Industry Regulations* which stipulate various compliance measures which must be adhered to in order to continue a relationship with the Coffee Industry Board. For example, each coffee dealer must keep a current and detailed record of all purchases, collection and sale of coffee made in the island. The records may be inspected by a representative from the Coffee Industry Board at any time.

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<sup>976</sup> *Agricultural Product Act*, s.2. (Act 31 of 1995).

<sup>977</sup> *Jamaica Coffee Industry Regulation Act*, section 2.

<sup>978</sup> Coffee dealer application form, Jamaica Coffee Industry Board.

Similarly, pursuant to the regulations, a Coffee Industry Board representative may visit and inspect a coffee farm at any time to ensure that the farm is operating in accordance with the Board's guidelines. The same measure applies to all coffee works. Several coffee works also cultivate coffee on plantations. A representative from the Coffee Industry Board is legally entitled to inspect the records of the coffee works plant, and visit its site for compliance related issues.

As a processing plant, each coffee work must comply with the country's *Factories Act* (*Factories Act*, 1943). The *Factories Act* stipulates the manner and conditions under which factories involved in the processing or adaptation of sale of any material should operate. One required specification of the *Factories Act* is that all factories must be registered<sup>979</sup>, a process which is facilitated after an inspection by a chief factory inspector from the Ministry of Labor.

The Coffee Industry Board is the sole exporter and importer of coffee to Jamaica.<sup>980</sup> Therefore, all licensees of Blue Mountain coffee have a limited right to the use of the certification mark, as all exports must be authorized by the CIB. The certification mark entitles the user to the use of the mark on Blue Mountain coffee. The authorized user is

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<sup>979</sup> *Factories Act*, s.6.

<sup>980</sup> The Act which established the Coffee Industry Board in 1948, the Coffee Industry Regulation Act, gives absolute power to the CIB to conduct, promote, develop, and stipulate various rules on the cultivation, sale and purchase of coffee and coffee lands in Jamaica (Coffee Industry Regulation Act, available online, <http://moj.gov.jm/sites/default/files/laws/The%20Coffee%20Industry%20Regulation%20Act.pdf>).

either a coffee dealer, a coffee works or an individual or entity which has purchased Blue Mountain coffee from an authorized seller, and uses the mark in its sale of the coffee.

Section 11 of the *Coffee Industry Regulation* stipulates that the “Blue Mountain” name cannot be used by any person or entity unless authorized in writing by the Coffee Industry Board. The section also prohibits the non-authorized activity in any transaction related to “Blue Mountain”, including its sale and purchase. Contravention of the *Coffee Industry Regulation* results in a summary conviction of Jamaican \$20,000.00 fine (Canadian \$200.00), or triple the price of the coffee which was purchased, sold or manufactured. There is no definitive evidence available on which fine is more frequently enforced.

## **6.2. Blue Mountain Coffee as a Geographical Indication: Technical and Legal Issues**

There is significant interest among small and some medium sized farmers in a geographical indication system. Not all Blue Mountain coffee farmers know of the term ‘geographical indication’. Among those who have heard of the reference to “geographical indication”, are aware of the term from a commercial perspective. On this basis, government agencies such as the Coffee Industry Board and the Jamaica Intellectual property office (JIPO) promote geographical indications as a mechanism to protect the “Blue Mountain” brand against infringement in international markets.

Based on interview responses, coffee farmers are less familiar with geographical indications as a socio-economic IP asset. There is also a troubling unfamiliarity with the

law itself. In this section, I will discuss and analyze the technical and legal issues involved in registering Blue Mountain coffee as a geographical indication. I had discussed issues involved in Mexico's Tequila<sup>981</sup> industry in Chapter 4, and will comparatively identify these issues in analyzing the prospects for a workable GI Blue Mountain coffee scheme in specific segments. In addition, Columbia's experience with its Café de Columbia GI designation is also examined to assess its implications for this study.

### **6.2.1. Technical Requirements**

I refer to technical requirement as measures which are necessary to sustain the unique attributes which differentiates Blue Mountain coffee from its competitors. I also refer to technical requirements as non-legal measures which establish a consistent framework for sustaining the quality of Blue Mountain coffee.

I maintain that minimal technical requirements would be involved in registering Blue Mountain coffee as a geographical indication for the following reason. There is an established regulation, code of practice, and quality certification standards which have been in force since the late 1940's.<sup>982</sup> The enactment and enforcement of the Coffee Industry Regulations in 1948 and 1953 stipulates the conditions under which Blue Mountain coffee is to be cultivated, produced and sold. By way of example, the Coffee

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<sup>981</sup> Tequila has been registered as an appellation of origin in Mexico since 1978. The Protection of Geographical Indications in Mexico, Symposium on the International Protection of Geographical Indications, World Intellectual Property Office, November 28-29 2001.

<sup>982</sup> *Coffee Industry Regulation Act*, 1953, Code of Practice, Coffee Industry.



Industry Regulation enumerates the specific areas in which Blue Mountain coffee can be grown,<sup>983</sup> and monitors its production collection and sale through the Coffee Industry Board. Furthermore, the Coffee Industry Board provides technical assistance to farmers at no cost in the inspection of farms, and advice on farming practices. These guidelines also include the specific types of fertilizers which can be used on Blue Mountain coffee.<sup>984</sup> The coffee's registration as a certification mark has facilitated the implementation and use of specific standards which have sustained the quality of the product.

A contentious issue that might be a challenge to the formation of a successful GI scheme is the organization of an effective and workable producer group. It is the producer group which, through collaborative objectives and initiatives, promotes the commercial IP value of the GI product, and share in the profits generated from its protection. As other studies have shown,<sup>985</sup> there is a more equitable distribution of profits in a producer group based on the cooperative efforts of members.

As such, I contend that a workable and results-oriented Blue Mountain coffee producer group should be comprised of coffee farmers, coffee works (depot), coffee dealers,

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<sup>983</sup> *Coffee Industry Regulation Act 1953.*

<sup>984</sup> There are four types of fertilizers which can be used on the Blue Mountain coffee plant, the 15535, 231020, urea and sulphate. The latter two are used during the early growth of the coffee and the 15535 and 231020 are used during its growth. Interview with representative from the Jamaica Coffee Growers' Association (September 10, 2013).

<sup>985</sup> Sisule Musungu, *The Protection of Geographical Indication and the Doha Round: Strategic and Policy Considerations For Africa*, Quaker United Nations Office, (Available online, Quaker United Nations Office: [www.quno.org/sites/default/files/resources/QUNO](http://www.quno.org/sites/default/files/resources/QUNO)); Petra van de Koop et al, "Origin based Products: Lessons for Pro-Market Development" Research Paper, (Royal Tropical Institute, Amsterdam, 2006).

distributors and representatives from the coffee industry board and the Jamaica Intellectual Property Office (JIPO). JIPO and the Coffee Industry Board are administrative and monitoring stakeholders who facilitate compliance, IP registration, licensing and technical assistance to Blue Mountain coffee and its farmers. Although production costs are relatively expensive compared to other competitors, coffee works, coffee dealers and distributors receive the most remuneration from the commercialization of Blue Mountain coffee.<sup>986</sup> There is evidence of reluctance and non-interest by medium to large scale coffee farmers, coffee works (depots) and coffee dealers to join a producer group. In response to whether there is an interest in joining or actively participating in a coffee farming association a large-scale farmer stated that:

“I was a part of the Coffee Growers Association when it first started, success was good in its early years, but it is not the same now. Small farmers are part of the problem they are not very bright when it comes to business or taking small farming as a business. When you organize a meeting to assist them, all they want to hear about is price – when will they get paid for their berries”.<sup>987</sup>

A small-scale female farmer commented that she had joined the Coffee Growers Association but,

“I am not interested in it..I paid the membership fee, and I didn’t even receive a membership card. Anything that needs to be done as a coffee farmer you have to do it on your own, you have to do your own thing”.<sup>988</sup>

A group or membership network is not new to Blue Mountain coffee stakeholders, specifically farmers. Prior to 2011, Blue Mountain coffee farmers could voluntarily join the All Island Coffee Growers Association. As a government organization, the All Island

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<sup>986</sup> Refer to the section on economic challenges associated with Blue Mountain coffee farming.

<sup>987</sup> Interview with large scale coffee farmer (October 30 2015).

<sup>988</sup> Interview with small-scale coffee farmer (October 30, 2015).

Coffee Growers Association was affiliated with the country's general agricultural body, the Jamaica Agricultural Society.

Historically, there has been discontent amongst the members of the group, which culminated with its dissolution in 2011 after much consternation regarding the availability of coffee insurance to farmers and non-payment of registration fees.<sup>989</sup> The formation of a new re-structured organization, the Coffee Growers Association in 2012 has a similar objective, and asserts more transparency and representativeness in its mandate.<sup>990</sup> However despite the minimal fee<sup>991</sup> payable for membership, not all Blue Mountain coffee farmers have joined the Coffee Growers Association. Membership by medium and large scale farmer is substantially minimal. These stakeholders assert that there is no benefit to be gained by joining the association.

Many farmers, inclusive of small-scale coffee farmers, prefer to cultivate and manage their farms independently of any cooperative effort from an association. On questioning, most coffee farmers interviewed on their interest in joining a coffee farming association responded as “no”, or “not really interested”<sup>992</sup>. One reason for this reluctance is likely based on recent contestations over a defunct coffee insurance fund. Members of the

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<sup>989</sup> *The Coffee Industry Board v All Island Coffee Growers' Association* 2004 HCV 1657.

<sup>990</sup> Interview with representative from Jamaica's Coffee Growers Association (September 17, 2013).

<sup>991</sup> Membership to the Coffee Growers Association is Canadian \$5.00 per annum or Jamaican \$500.00 per annum (Interview with representative from Jamaica's Coffee Growers Association).

<sup>992</sup> This information was provided from interviews with coffee farmers during the course of the research.

former coffee association contributed to the fund, and unpaid registration fees which led to the dissolution of the association. I will briefly discuss the issue related to the coffee insurance fund insofar as it implicates farmers' willingness to join the Coffee Growers' Association, and its failed objective in providing a safeguard for coffee farmers. This discussion further informs the analysis on the level of success or effectiveness of a Blue Mountain coffee producer group, and therefore the feasibility of implementing a successful GI scheme.

In 1992, the Coffee Industry Board established a fund from part proceeds of coffee cess received from farmers; this program was known as the "coffee insurance fund". Theoretically, this program was an advantage to coffee farmers whose crops continually experienced problems during hurricanes, storms, droughts and other environmental disasters. Included in the funds objective was to provide coverage against "fire, including bush fire, landslide, earthquake, hurricanes, riot, strike and civil commotion".<sup>993</sup>

However, it was eventually ascertained that the fund could not be legally conceptualized or defined as an insurance fund, and had to be closed. In a claim between the Coffee Industry Board and the All Island Coffee Growers' Association,<sup>994</sup> the Supreme Court of Jamaica held that there was no insurance coverage provided by the fund. The court noted that the fund did not entitle the Coffee Industry Board to compensate growers for the

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<sup>993</sup> *The Coffee Insurance Fund*, section 20.

<sup>994</sup> *Coffee Industry Board v All Island Coffee Growers Association*,

value of their lost crop. Secondly, the funds coverage was limited to the available funds in its accounts, and no insurance policy was issued by the Board to the farmers. Furthermore, the court held that cess was not authorized to be used as an insurance premium by the Coffee Industry Regulations Act. In addition, neither was all the cess used by the Board as “insurance payments”. This was an unfavorable decision to coffee farmers who had contributed to the program.

Furthermore, substantial unpaid fees owed by the former association led the governing body to dissolve the existing organization, and to form a newly created group. Of the 6000 registered Blue Mountain coffee farmers, there are currently 1000 who are members of the newly formed non-profit Coffee Growers Association. Other small farmers are reluctant to join the association because they assume that there are no substantial gains from membership.

The association’s mandate is to “provide representation at all levels to coffee farmers”,<sup>995</sup> inclusive of bargaining for better coffee prices and more accessible and reasonable priced farm materials.<sup>996</sup> With a membership of mainly small sized farmers and the reluctance of medium and large scale farmers to join the association, there is an obvious challenge for forming a producer group that is representative of the coffee industry. I refer to this tendency by non-participants as the “independent approach”. I argue that the independent

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<sup>995</sup> An interview with representative from Jamaica Coffee Growers’ Association.

<sup>996</sup> *Ibid.*

approach by key stakeholders, who receive more favorable financial rewards from coffee production and its distribution, hinders the effectiveness of a Blue Mountain producer group. A lack in active participation and membership in an association which represents coffee growers has a significant meaning for the viability of a producer group. The producer group is likely to be ineffective in facilitating substantial economic improvements for farmers. Low membership and the absence of wide-scale representation from all key stakeholders are the reasons for this speculation.

### **6.2.2. Legal Issues: Ownership and Management of the GI Designation**

The Coffee Industry Board owns the Blue Mountain coffee certification mark, and has been involved in its administration and regulation for the duration of its intellectual property history.<sup>997</sup> It is assumed that ownership of the Blue Mountain GI designation would be owned by the government's Coffee Industry Board.<sup>998</sup> The coffee industry board has been regulating the industry since its inception. The country's intellectual property office has stated that the coffee industry board's regulatory experience makes it the most suitable and viable stakeholder for the management of the designation. This statement does not infer wide-scale interest by key stakeholders in changing the mode of intellectual property protection from that of certification mark to geographical indications.

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<sup>997</sup> This dates back to the 1940's (History of Coffee In Jamaica, available online at: <http://www.ciboj.org/index.php?id=72&p=1>).

<sup>998</sup> Communication with representative from the Jamaica Intellectual Property Office, (2013-2014).

I maintain that the most significant legal hurdle is the extent of private sector involvement in the Blue Mountain coffee industry. The private sector is involved in both the farming and production of Blue Mountain coffee to a significant extent. Specifically, one private firm has recently bought a major coffee plantation and coffee works plant from the government, and now accounts for most of the farming lands in the Blue Mountains. Based on interview results, medium and large scale farmers and processors have minimal or no interest in joining a producer organization.

The lack of collaboration and integration of interests amongst key stakeholders may hinder the formation of an inclusive producer organization. I argue that while this does not affect the geographical indication registration of Blue Mountain coffee, it affects its ability to be representative of small-scale farmers' interests.

In a study on Mexico's Tequila,<sup>999</sup> Bowen notes that stakeholders at the higher end of the supply chain effect the most influence on the regulation (or lack thereof) of the industry. These stakeholders are tequila distilleries, bottlers and distributors. This dominance in influence is prevalent despite state ownership of the Tequila designation. Jamaica's Coffee board is experienced in the legal regulation of the industry. However, if a geographical indication scheme were to be implemented for Blue Mountain coffee, administrative and regulatory decisions regarding Blue Mountain needs to be inclusive of representation from small-scale farmers.

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<sup>999</sup> Sarah Bowen and Ana Zapata, "Geographical Indications, terroir and socio-economic and ecological sustainability: the case of tequila" (2009) 25:1 *J Rural S* 108.

### **6.2.3. Defining Blue Mountain coffee as a Geographical Indication**

A geographical indication is defined under Jamaica’s legislation as an “indication which identifies a good as originating in the territory of a country, 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>1000</sup>

In establishing the linkage between Jamaica’s geographical indication legislation and Blue Mountain coffee, the following are salient to the discussion. Pursuant to part 2 of the Act, the legislation extends protection to agricultural or agri-product goods.<sup>1001</sup> According to Jamaica’s GI regulation, there must be a direct link between the geographical area, and the quality or reputational characteristics which designate the good as being distinctive.<sup>1002</sup> As stipulated by Jamaica’s Intellectual Property Office (JIPO), Blue Mountain coffee satisfies these legal requirements.<sup>1003</sup>

The *Coffee Industry Regulation Act* stipulates various specifications which must be complied with in order for coffee to be designated as “Blue Mountain”. Fundamentally, the *Coffee Industry Regulation* and its code of practice are legal measures which satisfy the definitional requirements of Jamaica’s GI legislation.

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<sup>1000</sup> Supra note 458, Jamaica’s *Geographical Indication legislation*, Part 2.

<sup>1001</sup> *Ibid.*

<sup>1002</sup> Jamaica’s *Geographical Indication Regulation*, 2009.

<sup>1003</sup> JIPO’s role in the formulation of Jamaica’s GI legislation was discussed in Chapter 3. The office was also instrumental in identifying Blue Mountain coffee as a product which is GI registrable.



Under the *Coffee Industry Regulation*, Blue Mountain coffee is defined as coffee which is grown in specific designated areas in the Blue Mountain, and processed/manufactured at specifically enumerated licensed coffee works in the island. The regulation enumerates the various sections within the Blue Mountains in which coffee can be grown.<sup>1004</sup> The regulation also lists coffee works which can process or manufacture Blue Mountain coffee.<sup>1005</sup> On this basis, the coffee regulation stipulates the specific territory where Blue Mountain coffee is grown, and infers characteristics about the coffee based on its growth and cultivation practices.

Furthermore, the Coffee Industry Board extensively monitors and regulates the cultivation of Blue Mountain coffee. The board performs its functions to comply with the *Coffee Industry Regulations*. There is a direct relationship between the board and the regulations, as it was the advent of the regulations which led to the establishment of the board. Based on the certification and compliance measures enforced by the Coffee Industry Board, Blue Mountain coffee is only grown in legally specified areas. In furtherance of this argument, I make the following point. As a compliance and quality assurance mechanism, the board stipulates that cherry beans can only be sold by

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<sup>1004</sup> Schedule, *Coffee Industry Regulation Act 1953*: Starting at Skibo and proceeding in an east-southerly direction to Swift River, thence east-south easterly to Chelsea; thence east southerly to Durham (Samba Hill), thence south-easterly to Belleview, thence south easterly along the western slope of John Crow Mountain to Cedar Gove; thence westerly to Font Hill; thence **north**westerly **to** Ramble; **thence** westerly **to** Good **Hope**; thence **north**westerly to Dallas; **thence** north westerly **to** Industry Village; thence north and westerly **to** Maryland; thence north-westerly to Golden Spring; *thence* northerly to Brandon Hill: **thence** north-easterly to Tranquility; thence east-north-easterly **to** **Skibo**.

<sup>1005</sup> *Schedule, Coffee Industry Regulation*. The regulation notes that the Coffee Board has the legal authority to designate new sites as coffee works location.

registered coffee farmers. On inspection of the cherry beans, coffee works officials provide a receipt and voucher to the farmer. The receipt and voucher serves 2 functions. Firstly, it operates as a record of payment by which farmers can track payments received from processors. Secondly and more important to this argument, receipts and vouchers are used as a tracking mechanism by the Coffee Board, to ensure that only registered farmers cultivate coffee. According to the Board, although the system is not the most competent, it has been able to keep the passing off of regular beans as cherry beans at a minimum.<sup>1006</sup>

The distinct Blue Mountain coffee taste is acquired and sustained<sup>1007</sup> through the cultivation practices, and through quality control measures enforced at the processing and cupping<sup>1008</sup> stages. These measures are bases upon which Blue Mountain coffee satisfies the definition of geographical indications, as required by section 2 of Jamaica's GI legislation.

The next section discusses utilizing Blue Mountain coffee as an intellectual property asset of development. On this basis, I identify and critically interrogate feasible benefits from its GI capitalization. Furthermore, I discuss the challenges which may either hinder or reduce its beneficial impact on small and medium scale coffee farmers.

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<sup>1006</sup> Interview with representative from the Coffee Industry Board (September 10, 2013).

<sup>1008</sup> Jamaica's Coffee Industry Board defines cupping as "the process of evaluating the aroma and taste characteristics of a sample of coffee". The activity is done to determine if the coffee should be purchased or sold. Green and roasted beans are visually inspected to provide a "fair indication of cup quality"; Sensory Evaluation of Coffee- Cup testing, Coffee Industry Board. Available online (<http://www.ciboj.org/pdf/CoffeeCuppingProgramManual.pdf>)

#### **6.2.4. Legal Cost of Sustaining a Blue Mountain Coffee GI Designation**

Although it is envisaged by the government that the designation would be managed by the state,<sup>1009</sup> legal geographical indication brand management is still a concern. The reference to legal brand management is to the administration of Blue Mountain coffee GI designation in local and international jurisdictions to prevent, or mitigate infringement occurrences.

Initiating and defending geographical indications and trademark infringements in international jurisdictions is an expensive venture. From a comparative perspective, the following is notable. Columbia's "Columbian coffee" is registered as a certification mark in the United States. Defense against the infringement of Columbian coffee name/symbol in the United States has been a costly endeavor.<sup>1010</sup> Successful legal brand management involves a proactive stance by key stakeholders in the protection of the GI designation. In protecting its brand, Columbia's Coffee Federation<sup>1011</sup> monitors internet advertisements, conducts random sampling of coffee advertised as "Columbian", and

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<sup>1009</sup> This was asserted by a legal representative from the Jamaica Intellectual Property Office (Interview discussion: September 12, 2013 and October 22, 2013).

<sup>1010</sup> World Intellectual Property Office, Making the Origin Count: The Columbian Experience", (Available online at WIPO, <http://www.wipo.int/ipadvantage/en/details.jsp?id=2617>, last visited September 30, 2016).

<sup>1011</sup> The Coffee Federation administers the Café de Columbia brand and also manages the production and distribution of the coffee (Available online at, <http://www.cafedecolombia.com/en/familia>, last accessed January 27, 2016).

monitors trade mark and licensing usage through its in house intellectual property office.<sup>1012</sup>

Currently, the legal brand management of Blue Mountain's certification mark is undertaken by the Coffee Industry Board. There is no significant involvement by the Jamaica Intellectual Property Office in it. Based on the number of stakeholders who are right holders in its intellectual property, I argue that a collaborative effort from both departments is required in safeguarding a GI designation. As such, the interests of small and medium scale farmers are more likely to be better protected when there is representation from a network of stakeholders who are knowledgeable in intellectual property asset management and its link with development.<sup>1013</sup>

Furthermore, the legal management of a Blue Mountain GI designation involves more than intellectual property expertise. Without financial and technical resources to expend on litigation and protection measures, there is minimal safeguard of the geographical indication designation.

I argue that the costs of protecting a Blue Mountain coffee GI brand can also be shared with the producer group through membership fees. The caveat to this argument is that the

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<sup>1012</sup> Bruce Corker, "Columbian Coffee – How they protect the Columbian coffee": Available online (<http://www.konacoffeefarmers.org/kona-labeling/columbia-coffee-federation-protecting-columbian-coffee/>).

<sup>1013</sup> This point is discussed more extensively in the next section.

producer group may be financially incapable of sharing in the cost of protecting the GI designation if adequate funds cannot be raised from its members. Currently, there are 2 coffee associations in Jamaica, the dominant of the 2 being the Coffee Growers Association.<sup>1014</sup> Annual membership fee to the association is Jamaican \$500.00 (Canadian \$5.00). It is plausible that if a GI producer group were to be formed, the membership dues would be more substantial than \$500.00. The inability of the producer group to contribute to legal brand protection may occur in 2 circumstances.

Firstly, if the producer group is unable to gain sufficient membership from a wide cross section of key stakeholders<sup>1015</sup>, then its financial vibrancy is negatively affected. Small-scale farmers are financially strained and may not be able to pay into an exorbitant fee scheme. Secondly, a successful GI scheme requires a collaborative group-oriented effort from key stakeholders in sustaining the GI brand. If the producer group were to be comprised of mostly elite representations,<sup>1016</sup> then contestations on how best to allocate resources may result in indecisions to contribute to legal brand challenges. This may also result if there are power imbalances in the producer group.

The Coffee Industry Board currently allocates Jamaican \$5 million or Canadian \$50,000.00 annually towards infringement of all its coffee brands in its 51 international

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<sup>1014</sup> The Jamaica Association of Coffee Growers also represents coffee farmers.

<sup>1015</sup> My reference to key stakeholders is to small-scale farmers, medium scale farmers, large scale farmers, coffee dealers and coffee processors (coffee works).

<sup>1016</sup> I refer to elites group as coffee dealers, large scale farmers, coffee works and some large scale distributors of Blue Mountain coffee.

consumer markets.<sup>1017</sup> According to the Board, infringement of its Blue Mountain certification mark is most prevalent in the United States and China. Arguably, this legal expenditure is inadequate to combat infringements internationally. The Coffee Board notes that its financially strained position prevents a more significant outlay of funds on legal brand management.

A Blue Mountain GI scheme would need substantially more financial resources on legal brand management to safeguard its brand. Adequate protection of the GI brand against infringement presents a more conducive position for the interests of rights holders to be advanced. Inadequate protection may negatively affect demand, pricing, remuneration to key stakeholders especially farmers,<sup>1018</sup> and dilute brand status.<sup>1019</sup> It is therefore necessary for all key stakeholders to be collectively involved in legal brand management. This includes an awareness that GI defense in international jurisdictions is required, and a collaborative and proactive effort in expending funds to protect the designation.

The issues discussed in this section and the segments above dealt with anticipated concerns in registering and establishing “Blue Mountain” coffee as a GI designation. In the next section, I will discuss salient measures and policies which, if incorporated into the scheme, will more likely produce effective results. This discussion then provides the

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<sup>1017</sup> Report from the Coffee Industry Board, (2014).

<sup>1018</sup> Dwijen Rangnekar” The Socio-economics of geographical Indications-A review of Empirical evidence from Europe” UNCTAD and ICTSD Issue Paper no. 8, 2004.

<sup>1019</sup> Dev Gangjee, Relocating the Law of Geographical Indications, (Cambridge: Cambridge University Press, 2012).

framework for critically analyzing the advantages and challenges associated with conceptualizing Blue Mountain coffee as an IP asset of development in Jamaica. The analysis is salient to my thesis which argues that as a practical form of IP, geographical indications are a feasible IP asset of development for Jamaica and the Caribbean.

### **6.3. Blue Mountain Coffee as an Intellectual Property Asset: Integral Measures and Policies**

In order to be conceptualized as an asset of development, geographical indications must be socially inclusive, either financially rewarding (or potentially financially rewarding) to rights holders, and foster employment across gender groups and economically deprived stakeholders. Furthermore, without adequate consumer demand for the product, none of the above stated possibilities are feasible.

In the sections below, I will critically discuss how a registered geographical indications Blue Mountain coffee can be envisaged as an IP asset of development. On this basis, the sections engage with the following arguments. Firstly, the ability of small and medium scale Blue Mountain coffee farmers to participate in a GI scheme is essential to the program's effectiveness. Secondly, the mandate, structure and decision making capacity of the producer group is integral to sustenance of a "Blue Mountain" GI scheme. In furtherance of this point, there should be an observable increase in the price paid by coffee processors to coffee farmers. In this context, development is not implicated without an increase in remuneration to the small-scale farmer.

Thirdly, sustaining the linkages between "Blue Mountain" coffee, terroir and development requires active participation, shared goals and interests from key

stakeholders. As such, participation cannot be restricted to coffee farmers, coffee processors, coffee dealers, distributors and the Coffee Industry Board. Along with the government's intellectual property office, it is proposed that the following groups proactively participate in the promotion of the brand and the fostering of the GI scheme.

These proposed stakeholders are the Jamaica Tourist Board, the Ministry of Industry, Investments and Commerce and individuals (mostly females) who reap the coffee beans during the harvesting period. The latter group of stakeholders are not coffee farmers, but are employed by coffee farmers to pick the cherry beans from the coffee farm. As noted by a coffee farmer,<sup>1020</sup> because the farms are located in isolated hilly areas where there are no residential communities, there are often difficulties in securing adequate labor during harvesting periods. I refer to this group as “Blue Mountain” coffee pickers. I propose that this group of individuals should either be a part of the producer group, or form an association which liaison, and operates in close affiliation with the producer group. I make this point for the following reason. If Blue Mountain coffee pickers coalesce as an organized group, the group is in a more favorable position to bargain for better wages. Secondly, a coffee pickers group with shared values on the cultural and socio-economic importance of Blue Mountain coffee is more likely to foster community interests in sustaining the GI linkage. This is impossible if coffee pickers are not involved in the sustenance of the GI scheme through their representation.

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<sup>1020</sup> Interview with Blue Mountain coffee farmer , (September 10, 2013).



In order for Blue Mountain GI to be an asset of development, an integrated, detailed, and development oriented approach is required in its operation. As such, stakeholders from different sectors and groups should be proactively involved in the scheme. As other case studies<sup>1021</sup> have shown, the benefits of an effectively managed GI scheme include, (i) increased remuneration to farmers, (ii) the strengthening of cultural and traditional norms associated with farming/production of the product, (iii) forging strong consumer awareness and demand for the product through brand development, and (iv) improved socio-economic conditions for individuals living either in or outside of the geographical cultivation zone. Development is strongly implicated in these tenets.

I argue that a participatory and effective Blue Mountain GI scheme necessitates the involvement of stakeholders who can initiate, promote and implement policies and ventures geared at sustaining the scheme. Promoting the cultural and aesthetic characteristics of the Blue Mountain region through cultural heritage tourism<sup>1022</sup> initiatives is a measure which should be more extensively and constructively explored by key stakeholders. In identifying these stakeholders, I specifically pinpoint the Ministry of Industry, Investment and Trade, The Jamaica Tourist Board, the Coffee Industry Board and, coffee farmers.

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<sup>1021</sup> Daniele Giovannucci et al, Linking Product and Their Origin, (International Trade Centre Report, 2009); World Intellectual Property Office Symposium , “Establishment of a Geographical Indication System In Indonesia: Case In Coffee, Sofia, (June 10-12, 2009), WIPO/GEO/SOF/09/3 (available online [http://www.wipo.int/edocs/mdocs/geoind/en/wipo\\_geo\\_sof\\_09/wipo\\_geo\\_sof\\_09\\_www\\_124275.pdf](http://www.wipo.int/edocs/mdocs/geoind/en/wipo_geo_sof_09/wipo_geo_sof_09_www_124275.pdf), last accessed February 10, 2016).

<sup>1022</sup> See below for an explanation of this term.

I acknowledge that currently, Blue Mountain tours are active ventures carried out for the purposes of gaining or satisfying tourists' interest in the Blue Mountain region, or to specific coffee plantations in the vicinity. However, an initiative formulated with specific reference to a Blue Mountain coffee GI scheme is more likely to produce development oriented results. It is therefore proposed that coffee tours organized around a Blue Mountain coffee GI theme should be implemented to promote the cultural and aesthetic attributes of the farming region. Furthermore, it is very plausible to develop a positive correlation between coffee tours and consumer's interest in Blue Mountain coffee, therefore influencing consumer demand. Another practical measure is the launch of a more integrated and collaboratively organized coffee festival to be incorporated as an integral part of the scheme. This latter point is discussed later in this chapter.

In the next two paragraphs, I will provide a comparative analysis of case studies from other countries which have established a linkage between tourism and the cultivation of agro-food GIs. I identify GIs linkage with tourism as an additional avenue for catalyzing Blue Mountain coffee as GI asset of development. This is impossible to achieve without a well- defined, collaborative and functional approach which transparently links specific aspects of a well- developed tourism plan with the GI scheme. However, to fully engage with the discussion, I will firstly define the concept of “cultural heritage tourism” and “GI” based tourism.

### **6.3.1. Cultural Heritage Tourism and the Concept of GI based Tourism**

Cultural heritage tourism is defined as traveling for the purpose of experiencing and exploring the landscape, values, lifestyle, traditions and culture of a specific territory.

The culture and traditions of the explored community may include certain traditional practices based on knowledge acquired through generations, such as particular handicraft skills or cultivation practices. The United Nations Educational Scientific and Cultural Organization (UNESCO) Convention Concerning the Protection of the World Cultural and Natural Heritage (The Convention) stipulates that cultural heritage includes, “sites: works of man or the combined works of nature and man, and areas including archaeological sites which are of outstanding universal value from the historical, aesthetic, ethnological or anthropological point of view”.<sup>1023</sup> Cultural heritage may also include natural features. The Convention describes natural features as “consisting of physical and biological formations or groups of such formations, which are of outstanding universal value from the aesthetic or scientific point of view”.<sup>1024</sup>

International trade and development scholar Keith Nurse notes that the Caribbean’s cultural heritage is a salient component of its global creative economy.<sup>1025</sup> Nurse defines the global creative economy as an economy which is involved in the commercialization of its cultural and creative sectors. These industries describe the “economic activities of cultural entrepreneurs...” involved in intellectual property sectors. Although Nurse’s study focuses on the use of the copyright industry to generate and promote creative

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<sup>1023</sup> Convention Concerning the Protection of the World Cultural and Natural Heritage Site, 16 November 1972 (<http://whc.unesco.org/en/conventiontext/>).

<sup>1024</sup> The Convention, *Ibid* Article 2.

<sup>1025</sup> Keith Nurse, “The Creative Sector in CARICOM: The Economic and Trade Policy Dimensions” CARICOM Report, Regional Symposium on Services, 2009. (Available online [http://cms2.caricom.org/documents/13188-concept\\_paper\\_creative\\_sector.pdf](http://cms2.caricom.org/documents/13188-concept_paper_creative_sector.pdf)).

industries in the Caribbean, his overall thesis is applicable to my argument. Specific segments of a Blue Mountain coffee geographical indication initiative can be incorporated into a cultural heritage tourism scheme, capable of producing effective socio-economic results in Jamaican communities. Scholar Walter Jamieson<sup>1026</sup> persuasively argues that cultural heritage tourism provides opportunities for the socio-economic development of communities if integrated strategies are used in the process.

Jamieson notes:

“cultural heritage tourism brings together the accepted practices of research, site development, design, planning, construction, preservation technology, interpretation, visitor services and connects them to the practices of tourism in marketing, research, product development and promotion”.<sup>1027</sup>

Jamieson notes 7 measures that are necessary to facilitate an approach to cultural heritage tourism that produces socio-economic development.<sup>1028</sup> The author also cautions that a primary focus on economic development may threaten the survival or continued existence of the cultural heritage resource. These measures are (i) effective planning and management, (ii) coordination, (iii) cooperation, (iv) impact assessment and monitoring (v) establishment of guidelines for tourism operations, (vi) education and training and (vii) marketing and promotion. In explaining these points, I note the following. Establishing a linkage between the identified cultural or heritage resource with tourism

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<sup>1026</sup> Walter Jamieson, “Cultural Heritage Tourism Planning and Development: Defining the Field and its Challenges” (1988) 30:2 *Ass Preserv Intl* 65.

<sup>1027</sup> *Ibid.*

<sup>1028</sup> Walter Jamieson and Tazim Jamal “Contributions of Tourism to Economic Development” in Chuck Gee & Eduardo Fayos Solo (eds) *International Tourism a Global Perspective* (Madrid: World Tourism Organization, 1997).

involves planning and effective management from all key stakeholders involved in the specific sectors. Strategies cannot be formulated or implemented unilaterally but must have resulted from a collaborative effort from all concerned sectors.

Furthermore, policies should not be used without assessing its impact on the initiative, and on the environment. As Jamieson notes, “the scale and pace of heritage tourism should be compatible with the local and environmental limits” of the region”.<sup>1029</sup> On this basis, a community should be cautious of over-using its cultural heritage resource to the point that it produces marginal or diminishing returns. This is likely to be the result if the sustainable management of cultural resources is not practiced. Sustaining cultural heritage tourism includes active community involvement. However, community involvement cannot be un-organized or ad hoc, but must be based on collaborative policies implemented by the concerned group. Education and training to key stakeholders foster community awareness on the linkages between the community, the cultural/heritage resource and tourism. Finally, it is difficult to attain success without allocating adequate financial and capital resources to the tourism scheme.

### **6.3.2. Geographical Indication Based Tourism**

The potentials of agricultural and food based geographical indications transcend beyond the rights it provides to its property holders. Agricultural and food based geographical indications have been used to engineer developmental strategies both in, and outside of the geographical area of production/cultivation of the product. This approach is referred

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<sup>1029</sup> *Ibid.*

to as the “extended territorial strategy”<sup>1030</sup> associated with commercializing geographical indications.

An extended territorial strategy focuses on the use of the aesthetic features and cultural practices of the geographical indication territory to foster visitor and tourists’ interests in the area. By way of example, Italy’s Lardo di Colonnato geographical indication scheme has incorporated into a tourism strategy in the production activities associated with Lardo (pig fat).<sup>1031</sup> Lardo is stored in marble tubs in caves or cellars for processing. In capitalizing on Lardo production, local authorities embarked on marketing strategies to promote visitor arrival to the area, based on the traditional practices associated with the production of Lardo.<sup>1032</sup> The promotion of the area as a Lardo production zone led to an insurgence in entrepreneurial interest by individuals in the area, as well as those in close proximity to the locality. Residents who had left the community because of economic hardships returned to the community to capitalize from the geographical indication based Lardo scheme. As such, business ventures such as restaurants and guest houses were established, and employment opportunities created.

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<sup>1030</sup> Emilie Vandecandalere, Filippo Arfini, Giovanni Belliti, Andrea Marescotti, *Linking People, Places and Product* (Rome: Food and Agriculture Organization of the United Nations, 2010). [*Linking Places and Product*].

<sup>1031</sup> *Ibid* at 142.

<sup>1032</sup> *Linking Places and Products*; *Tourism Atla*, *supra* note 1032.

Morocco's Argan Oil<sup>1033</sup> has also used its processing techniques and production area to foster interests and tourist arrivals to its Argan production communities.<sup>1034</sup> Argan Oil is registered as a geographical indication in Morocco<sup>1035</sup> and is grown in the Anti-Atlas Mountains of the region. The Moroccan government has developed trails, trip excursions extended tourist stays in Argan communities as business ventures associated with the production of Argan oil.

Vandelcrare et al, in discussing the leverage provided by geographical indication initiatives to tourism, notes the condition precedents that are required to likely produce successful results.<sup>1036</sup> Firstly, local actors must identify with the geographical indication product. On this basis, local actors should have an interest in the product which is either cultural, economically or traditionally based. Secondly, the geographical indication territory must have an aesthetic attribute capable of attracting and sustaining visitors and visitor interests to the area. Thirdly, collaborations between key stakeholders is necessary to ensure that initiatives are representative of the objectives of the ventures. Furthermore, the linkage between the local resource(s) and the product should be easily recognizable by consumers.

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<sup>1033</sup> T.J Lybbert, B.C Barret & H. Narjisse, Commercializing Argan Oil in South Western Morocco: Pitfalls on the Pathway to Sustainable Development, in Stefano Pagiola, Josh Bishop and Sven Wonder (eds) *Buying Biodiversity: Financing Conversation for Sustainable Development* (World Bank Report, 2004).

<sup>1034</sup> *Supra* note 1001 "Vandelcrare, *Linking Places and Products*", at 145.

<sup>1035</sup> Moroccan Association of the Geographical Indication of Argan Oil (Available online AMIGHA, <http://www.regionsmd.com/english/content/amigha.html>, last accessed on September 30, 2016).

<sup>1036</sup> Vandelcrare et al "*Linking Places and Products*", *supra* note 1032.

#### **6.4. Blue Mountain Coffee as an Asset of Development: Benefits**

In the sections below, I discuss identifiable benefits of a Blue Mountain GI scheme.

There is a fundamental caveat to my analysis on this point. In contemplating the use of geographical indications as an asset of development in Jamaica, I acknowledge that without the proactive input of key stakeholders,<sup>1037</sup> reciprocal recognition of geographical indication rights in Blue Mountain coffee's main consumer markets and consistent consumer demand for Blue Mountain coffee, the geographical indication scheme is unlikely to be successful. Therefore, the discussion is formulated on the basis that the recommendations noted in the above segments are implemented.

##### **6.4.1. The Producer Group: Coffee Farmers and Increases in Income**

The specific pricing strategy that is associated with Blue Mountain coffee is outside the scope of this thesis. However, of importance to my arguments is the condition that the price of Blue Mountain coffee remain 'premium' or, there is consistent and growing demand for the product.<sup>1038</sup> Unless future events lead to negative changes in quality, consumer preference and pricing, this point is likely moot. Blue Mountain coffee has been regarded as a premium brand for decades. It has minimum difficulties in exacting a comparatively higher price than other coffee brands for its coffee.<sup>1039</sup>

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<sup>1037</sup> Jamaica's Blue Mountain coffee key stakeholders are, small, medium and large scale farmers, coffee dealers, coffee distributors, consumers, coffee pickers, the Coffee Industry Board, the Jamaica Intellectual Property Office, the Jamaica Tourist Board, the Ministry of Agriculture, and the Ministry of Foreign Affairs and Foreign Trade.

<sup>1038</sup> Gerald J. Tellis, Beyond the Many Faces of price, an integration of pricing strategies" (1986) 50:4 *J Mar.* 146. Hein Jan van Hilten, *The Coffee Exporters Guide*, 3<sup>rd</sup> edition (Geneva: International Trade Center, 2011).

<sup>1039</sup> *Ibid.*



The expense associated with coffee cultivation has affected the ability of small and medium scale coffee farmers to earn a lucrative livelihood from their activities. Accumulatively, the costs of coffee cultivation lessen the amount of remuneration received by coffee farmers.

I argue that the implementation of Blue Mountain geographical indication scheme is likely to reduce the various cost burdens of coffee farming, especially for small and medium sized farmers. There can be increased savings from the purchase of fertilizers and other cultivation materials in bulk. A Blue Mountain coffee GI producer group may reduce the costs of coffee cultivation for farmers by the purchase of cultivation materials in bulk from suppliers. Group membership is not new to Blue Mountain coffee farmers. Over the past few decades, there have been 2 coffee farmer associations formed with the mandate of providing assistance to coffee farmers. The current and single coffee farmer association has a membership of 6000. Of that number, 5000 are Blue Mountain coffee farmers; all of whom are small-scaled farmers. The Board's regular practice is to explore and procure avenues for the purchase of reasonably priced fertilizers for its members.

A diversified<sup>1040</sup> Blue Mountain coffee GI producer group may also benefit from increased remuneration to individual farmers. The caveat to this point is noted. Jamaica's Coffee Industry Board's current restrictions create a greater potential for coffee dealers to immediately profit from a GI scheme than for a small-scale coffee farmer. Coffee

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<sup>1040</sup> I use the term "diversified" to refer to a membership base of key stake holders, that is, small, medium and large scale Blue Mountain coffee farmers as well as government stakeholders.

dealers produce or have the capacity of producing at least 6000 boxes of cherry beans per year. Coffee dealers are also registered to cultivate coffee and licensed to use the “Blue Mountain” coffee mark on their processed coffee. Based on their volume of production it is more likely for coffee dealers to incur the profit gains from a Blue Mountain coffee GI scheme.

However, there are 2 fundamental points integral to promoting the interests of the small and medium scale farmers in a Blue Mountain coffee geographical indication scheme. Firstly, reduction in cultivation costs through economies of scale lessens their expenses, and is likely to increase available funds for personal use and for re-investment in the farm.

Secondly, as stakeholders with proprietorship rights in Blue Mountain coffee, small and medium scale coffee farmers would be in a stronger position to bargain for better prices for its cherry beans from coffee works (coffee processors) entities. Collaborative work within the producer group and with other key stakeholders on marketing, best cultivation practices, farm management practices and price negotiation with Jamaica’s major consumer markets should enable small and medium scale farmers to earn more per box for its cherry beans. This point acknowledges the fact that low consumer demand, and more favorable pricing from competitors may affect actual price paid to coffee farmers.<sup>1041</sup>

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<sup>1041</sup> Coffee Prices - Statistics, International Coffee Organization, ([http://www.ico.org/coffee\\_prices.asp](http://www.ico.org/coffee_prices.asp))

However, historically Blue Mountain coffee has managed to maintain a premium price for its product in its main international consumer markets, notwithstanding fluctuations in demand.<sup>1042</sup> Furthermore despite its comparatively high price, emerging interest and consumption of Blue Mountain coffee in China, and increasing demand in the United States are indicative of a reasonably secure price frame.

It is envisaged that collaborated efforts from a diversified producer group will engineer growth oriented strategies for coffee farmers. This includes providing farming opportunities for coffee farmers who had abandoned their farms because of financial difficulties. Among this group of coffee farmers are many females who are unable to subsist on coffee cultivation as a means of livelihood.

#### **6.4.2. Social Programs: Community Development Ventures.**

A Blue Mountain coffee GI scheme may also facilitate the implementation of social programs and infrastructure in and around the farming communities of the Blue Mountain region. I define social programs as initiatives undertaken by the government, members of civil society or other non-governmental bodies for the benefit of a community or specific group of individuals in society. There is direct developmental implication from these initiatives, if effectively undertaken. Columbia's coffee Café de Columbia is an example of a GI scheme with an active and effective producer

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<sup>1042</sup> Eleven Most expensive coffee in the world, 24 Seven Report, April 26<sup>th</sup> 2010, (<http://24sevenpost.com/cuisine/10-expensive-coffees-world/>); World Intellectual Property Office, "In Search of a Perfect Cup" (<http://www.wipo.int/ipadvantage/en/details.jsp?id=2612>).

organization which has implemented social programs to benefit small-scale coffee farmers.

The Colombian Coffee Growers Federation (FNC) represents over five hundred thousand small coffee growers in Columbia.<sup>1043</sup> The federation has organized and implemented various social ventures and programs geared at advancing the socio-economic interests of its members. The FNC's motto "first the coffee grower, then the rest", informs the structuring of social policies for rural coffee farming communities. By way of example, the mandate of its 2008-2012 strategic plan was to establish value added services for coffee farmers.<sup>1044</sup> Educational initiatives such as the establishment of schools, training programs ventures and grants for the social infrastructural development of coffee communities are examples of ventures undertaken by the FNC. The federation includes international organizations in its social program initiatives. Arguably, this may compromise program choices, depending on the extent of involvement by the specific international organization.

I argue that a Blue Mountain coffee producer group which collectively, has a shared objective in the promotion of the socio-economic interest of its members can impact developmental improvements in farming and neighboring communities. Although the surrounding areas of the Blue Mountains are not heavily populated, there are residential

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<sup>1043</sup> Columbia Coffee Growers Federation website (Available online, <http://www.federaciondecafeteros.org>, last accessed September 30, 2016)

<sup>1044</sup> *Ibid.* Sustainability that Matters, Columbia Coffee Growers Federation.

communities located on the outskirts of the farming areas. Infrastructural development in the form of better roads, upgraded school buildings and educational training are avenues of assistance which can be provided, if adequate remuneration is generated by the producer group.

However, there needs to be an identifiable, strong and sustainable community interest in supporting the Blue Mountain coffee geographical indication linkage. The interest needs to extend to all key stakeholders. In order to initiate community ventures and to ensure their success, Blue Mountain coffee key stakeholders should have an interest in the social, economic and cultural progression of the surrounding communities.

An elite focused producer group is likely to be unwilling to extend financial resources beyond their own farming/production needs. Medium and large scale Blue Mountain coffee farmers have minimal interest in joining the current coffee farmer association as they assume there are no benefits from its membership. As such, the interest in assisting less advantaged Blue Mountain coffee farmers is lacking or not apparent. However, I argue that lack of interest by more elite coffee farmers can be mitigated by a re-orientation of the norms associated with commercialization of intellectual property as an asset. As such, elite and small-scale coffee farmers can be trained and encouraged (through seminars, conferences, workshops, targeted inclusive advertisements, grants) on

conceptualizing geographical indications as a collective based intellectual property, which, if effectively managed<sup>1045</sup> is also a social good, and an asset of development.

### **6.4.3. Extended Employment Opportunities**

The involvement of individuals from neighboring communities in tourism based coffee trails through the Blue Mountain areas is likely to provide employment opportunities for residents of these communities. Furthermore, entrepreneurial endeavors directly or indirectly related to Blue Mountain coffee trails are feasible ventures which residents of neighboring communities can engage in. In this context, I am proposing the establishment of fruit and vegetable roadside stalls, restaurants, gift shops selling locally designed items, coffee houses selling coffee and coffee based pastries as examples of business ventures which locals can engineer as extended territorial strategies.

My analysis does not infer that there are no challenges associated with the proposed Blue Mountain geographical indication scheme and specifically, with its conceptualization as a socially inclusive domestic intellectual property asset that can be positively implicated in development policy. The most significant challenges which may reduce or obliterate the intended overall effects of a Blue Mountain GI scheme are critically discussed in the section below.

### **6.5. Blue Mountain coffee as a GI Asset of Development: Challenges**

Conceptualizing Blue Mountain coffee as an intellectual property asset of development includes a practical assessment of issues and conditions that may lessen the significance

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<sup>1045</sup> The reference to “effectively managed” does not infer that GI is primarily concerned with management. I have mentioned throughout the thesis that the international legal status of GIs is integral to this discourse.

of its intended benefits or potential. An analysis and evaluation of field interviews reveal that lack of cohesion and support within certain key stakeholder groups may affect the viability of the Blue Mountain geographical indication scheme. I use the term viability to refer to the prospects and ability of a registered Blue Mountain coffee to effect changes in the socio-economic narrative of specific key stakeholders, by conceptualizing the registered coffee as an asset of development. Secondly, negligible accomplishments result from un-cooperative groups, in which there is a preference for entrepreneurial independence, and elite based favoritism. I will explain these two points.

The producer organization is integral to the formation and sustenance of a Blue Mountain GI scheme. There is evidence of unwillingness amongst some coffee farmers to join or partner in farmers' association. Medium and large scale Blue Mountain coffee farmers prefer to conduct their farming business on their own, without any entrepreneurial support from a coffee farmer's association. I make this point based on interview responses from field research.

Despite the existence of a coffee farmers' association to represent the interest of all Blue Mountain coffee farmers, its membership is limited to small-scale coffee farmers. If this observation is used to inform the prospective composition of a Blue Mountain coffee GI producer group, it is problematic on two grounds. Firstly, the producer organization may become predominately represented by elite coffee farmers and coffee dealers, advertently stifling the ability of small sized coffee farmers to join and participate in the organization. This is more likely to occur if there are barriers to entry in the

organizations' membership through exorbitant membership fees, partisanship politics and/or elite favoritism. I define partisanship politics as policies and strategies driven and adopted based on an individual or group's political affiliation with a specific political party in society. It is not the intention of this thesis to extensively articulate on Jamaica's political narrative, or to use theoretical approaches to critique the country's political culture.<sup>1046</sup> However, I will briefly discuss the following point in an effort to explain the relevance of Jamaica's political culture to the operation of certain government programs and initiatives.

All the small-scaled farmers who were interviewed pointed out that they do not receive adequate assistance from the government to assist with farming difficulties. Small farmers in the study agreed on the lack of government support in the purchase of fertilizer, in the clearing of coffee fields after storms and hurricanes, and in providing general financial assistance during difficult periods. An elderly female farmer showed no reluctance in asserting that 'politics' accounts for the government's lack of interest in assisting poor coffee farmers. There are historical incidences of preferential treatment in government assistance to individuals and communities based on their political and social affiliations to national and local governments in Jamaica.<sup>1047</sup>

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<sup>1046</sup> Political culture refers to a particular set of orientations, beliefs, customs and pre-conceptions which are shared by members of society, and gives meaning to their political process as well as the underlying assumptions that govern their political behaviour and public policies: Lawrence Alford Powell et al, *Probing Jamaica's Political Culture – Main Trends in the July-August 2006 Leadership and Governance survey*, Centre for Leadership and Governance, University of the West Indies, Mona Jamaica.

<sup>1047</sup> Crichlow, "*Negotiating Caribbean Freedom*", *supra* note 93.



Another issue that is significantly implicated in this analysis is the prevalence of classism in Jamaica.<sup>1048</sup> As a means of social stratification, classism may act as a barrier or challenge to the accessibility of scarce but desirable economic and capital resources.<sup>1049</sup> If party patronage and classism influence how resources and benefits are allocated, or distributed within the producer organization, the GI scheme is unlikely to be successful. In this context, this critique acknowledges that such resources would be predominately distributed to specific individuals or interest networks within the producer group.

There is documented evidence of this practice occurring in a similar context. Crichlow, in her research on the politics of farming and development in Jamaica, critiqued that the failure of a prominent agricultural development program targeting small farmers in the 1980's was based on political and social class favoritism.<sup>1050</sup> These points illustrate that programs whether government or privately operated, are less likely to be successful without collaboration among all key stakeholders. Furthermore, program participants must undertake initiatives and implement policies that transcend beyond political and social class lines. This is not impossible. Collaboration and cohesion among key stakeholders in the producer group should mitigate the deleterious effects of party patronage and classism, if practiced by the group.

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<sup>1048</sup> *Supra* note 113, Scott "Criticism after Third Worldity". In this context, I define classism as differential treatment to individuals in Jamaica based on social class. This differential treatment may be by persons of the same class to each other or a class which such persons perceive to be of the same class. The definition also applies to differential treatment by members of a same social class to another less advantaged class.

<sup>1049</sup> Crichlow, "*Negotiating Caribbean Freedom*", *supra* note 93.

<sup>1050</sup> *Ibid.*

## **6.6. Further Assessment: Blue Mountain coffee as a Registered Geographical Indication**

A Blue Mountain coffee geographical indication scheme has potentials which can effect changes commensurate with envisioning intellectual property as an asset of development. It is apparent that there are challenges which may affect the success of the geographical indication strategy. Domestically, the following are essential as indicators. The success of the scheme is measured by its ability to provide employment and additional employment for ancillary coffee workers (such as coffee bean pickers); increase income for small and medium sized coffee farmers; and the provision of entrepreneurial opportunities for individuals in and around Blue Mountain coffee farming communities. Collaboration among key stakeholders is essential.

Based on my field research, I conclude that the most significant challenge is the formation and functioning of an inclusive and participatory producer group. Possible impediments to inclusiveness are, (i) exorbitant membership fees, (ii) overly bureaucratic government regulation and/policies as requirements for joining, and (iii) policies which favor the proliferation of elite interest and/or advancement of party patronage among key stakeholders. I use the term inclusiveness to refer to the degree of representation and membership by small-scale coffee farmers in the producer group.

The singular comparable agricultural organization that is relatively similar to the producer group is Jamaica's Coffee Growers' Association. I make this point because the primary objective of the Coffee Growers' Association is the advancement of small coffee

farmers' interest. This objective is integral to the success of a Blue Mountain coffee producer group.

If the operation of the Coffee Growers' Association is used as a comparative base from which to evaluate the prospects of success of a Blue Mountain producer group, the following are notable points. Transparency and accountability in the administration of the producer group are essential to its success. A clear mandate of the producer group must be implemented. Furthermore, all members should comply with the group's mandate and regulations (inclusive of the code of practice). On-going communication between coffee farmers and the Coffee Board pertaining to the management of the Blue Mountain geographical indication designation must be facilitated in the producer group. Dialogue on farming practices and farm management issues should be facilitated within the producer group, to the extent that it enables the resolution of challenges encountered by coffee farmers.

### **6.7. Summary**

There is no inherent developmental catalyst in geographical indications. The case study illustrates that to be envisaged as an asset of development, the attributes which differentiate geographical indications from other forms of intellectual property must be fostered by linkages with specific 'enabling' factors. Therefore, Blue Mountain coffee is viable as an intellectual property asset of development, if appropriate transparency and accountability framework are implemented and practiced by key stakeholders. This necessitates transparency in the distribution of resources, in decision making amongst

key stakeholders, and in pursuing collaborative initiatives in a Blue Mountain coffee geographical indication producer group.

As indicated in the Blue Mountain coffee research, increases in income through collaborative efforts and entrepreneurial activities are feasible outcomes which are tangentially aligned with conceptualizing GIs as assets of development. This point acknowledges social class and political favoritism issues which are likely to act as challenges to the functioning of a Blue Mountain coffee GI scheme.

No single factor enables agricultural and food based geographical indications to be envisaged as assets of development. It is a conglomeration of the factors identified earlier in this thesis which produces a framework conducive for growth. In re-capping, GIs are an asset of development if the following factors exist, and are operative. Firstly, reciprocal recognition of GIs in the domestic country's main international consumer markets is highly desirable. Secondly, consistent or an increasing consumer demand (internationally or regionally) for the GI agri-product is required. Thirdly, the presence of a collaborative, goal oriented and inclusive producer group which is dual focused in its objectives. Although primacy in safeguarding against infringement is warranted, it should not be subordinated to advancing small farmers' interests in increasing income from the commercialization of the geographical indication product. This is the dual focus of the producer group: protecting the geographical indication designation, and ensuring sufficient socio-economic returns, and the safeguard of cultural practices of key stakeholders.

The fourth factor involves sustaining the linkage between the geographical indication product with its territory, and maintaining the connection between the geographical indication legislation and the specific product. This entails maintaining community support in the- product, a measure which is more probable to succeed if there are extra-territorial ventures connected with the product's commercialization.

Regional and international commercialization of the product is essential in the conceptual and practical positioning of geographical indication as an asset of development. Geographical indication administrators should caution against registration of products which, though its features meet the requirements of a geographical indication, offer little or no practical benefits to its right holders without significant allocation of resources.<sup>1051</sup> This implicates small Third World countries such as Jamaica, in which scarce financial and capital resources influence socio-economic conditions, and hegemonic dynamics influence the application of its international law obligations. It is highly improbable for an agricultural and food based geographical indication that is not sold regionally or internationally, and which is farmed on an informal basis, to obtain benefits from a geographical indication scheme.

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<sup>1051</sup> I had started a research on positioning Jamaica's Lucea yam as a geographical indication, but realized later that it would be too much of a voluminous study to focus on two products in this thesis. The lesson learned from the study is that agricultural and food based geographical indications are not tenable as an intellectual property asset solely on the basis of farmer interest in the product – steady and increasing consumer demand in international markets is important – this is lacking from Lucea yams' current commercial position, as it is only sold domestically due to lack of demand and a very short shelf life.

Chapter 7's theoretical focus is on Jamaica's involvement internationally, with trade partners, applicable treaties and with international organizations in promoting recognition of *sui-generis* geographical indications legislation, and in transforming the international intellectual property narrative, generally. As such, the focus of my arguments move from the local, to critically analyze global legal norms and international legal developments which either constrain, or foster the recognition of *sui-generis* based agricultural and food based geographical indications.

## **Chapter Seven: Jamaica's Engagement with the International as Counter-Hegemony in Global Intellectual Property Rights Regime**

### **7. Introduction**

Chapter six assessed the feasibility of registering and envisioning Blue Mountain coffee as a geographical indication asset of development for Jamaica. The chapter focused on domestic issues and domestic key stakeholders which either constrain, or enable a workable environment for the attainment of favorable results in geographical indication usages. As I had concluded, collaborative planning amongst all key stakeholders, transparency and accountability in the administration of the GI scheme, and a non-elitist approach to producer group membership are issues which need to be addressed. These concerns must also be continually assessed upon implementation of the GI scheme to ensure efficiency in its governance.

Chapter seven engages in a critical discussion of Jamaica's involvement in international geographical indications negotiations and international intellectual property right negotiations related to GIs generally. The registration of agricultural and food based products as geographical indications is insufficient to practically produce development-oriented results. Domestic and international legal issues are integral to envisioning geographical indications as an intellectual property asset of development for Jamaica.

The international intellectual property right fora are not without vocal representation from Jamaica. However, the following observations are crucial to an understanding of

Jamaica's perspective on geographical indications, and its stance on aspects of international intellectual property rights law which may implicate geographical indications, such as trademarks. In discussing these points, my arguments are based on a TWAIL perspective of international law.

The commerciality of geographical indications is important, but so too should be its potential of improving the socio-economic welfare of the marginalized in Jamaican communities. I will explain this point, but will first explain the term "commerciality" as used in this context. The term 'commerciality' to refer to the market penetration potentials of agricultural and food based geographical indications, and therefore the product's capability to attain greater preferences and market share in the consumer market. The European Union and more particularly Switzerland have marketed geographical indications to Jamaica (and the Caribbean) as an intellectual property which can recognize proprietary rights in specific origin-based goods. Jamaica is particularly interested in intellectual property that can recognize, maintain and enhance linkages between its products and their origin, and which are likely to reduce infringements in international jurisdictions. It is against this background that Jamaica's involvement in international GI negotiations, multilateral and bilateral trade and intellectual property agreements, and in IP negotiations are analyzed in this chapter.

The chapter is divided into three parts with associated sub-sections. The first section critically discusses Jamaica's non-participation in revisions to the Lisbon Agreement, and identifies this as a missed opportunity in engaging with the IP global order.



The second section engages in an analysis of Jamaica's involvement in international intellectual property proceedings. The specific reference is to its contributions to proposed amendments to *Article 6ter* of the *Paris Convention*, concerning the legal protection of country names as trademarks.

The third section of the chapter critiques Jamaica's participation in selected international intellectual rights proceedings. The section argues that while there is a commendable change to its customarily passive stance, the country has not attained a counterhegemonic status in global GIs and IP epistemic communities.

There is an observable similarity between Jamaica and African intellectual property narrative. The influences of foreign interest and local elites in creating a domestic intellectual property culture which epitomizes the protection of foreign interest, and the proliferation of transnational capital classes in the local, at the expense of the promotion of local intellectual property is a dynamic and repressive one. As Mgbeoji insightfully notes concerning the African IP debacle,

“While African countries have invested in establishing IPR regimes, there is little evidence that the investments made in the IPR administration have impacted the economic and technological development of African states. Africa remains a net importer of foreign technology. African arts, cultural heritage and other forms of intellectual property continue to suffer exploitation in the hands of foreign actors...Perhaps most problematic is Africa's minimal intellectual and policy contributions to the pressing issues in current IP regimes. The issue of traditional knowledge in the context of IPR is troubling. Although Africa's wealth in biological resources and traditional knowledge make the application of IPR to these resources an important issue for discussion and resolution, there is little push by policy

makers and African IPR practitioners and administrators to articulate responsive and workable IPR policies.<sup>1052</sup>

Mgbeoji further notes that there is an overwhelming interest by African practitioners in attending Geneva based IP forums, for the sole purpose of claiming an association with epistemic IP communities of the north. However, there is no interest beyond protecting the proprietary interest of African practitioner's foreign clients, which works to reify global capitalism in Africa's local.

There are differences between the Caribbean and African regions' intellectual property outlook as well. The Caribbean does not engage in international intellectual property forums to the same extent as the African region. Secondly, Jamaica may implement law and policy directives claiming to address local innovation in intellectual property rights, without much substantive result.

The ratification of the European Partnership – Cariforum Agreement between the European Union and CARICOM was the main catalyst to Jamaica's enactment of its geographical indication legislation. Since the enactment of its legislation, the country's involvement in international geographical indication negotiations has been at a minimal, compared to participation from other Third World countries and regions in such

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<sup>1052</sup> Ikechi Mgbeoji, *The Comprador Complex: Africa's IPR Elite Neo-colonialism and the Enduring Control of African IPR Agenda by External Interests*, *Osgoode Legal Studies Research Paper* No. 22/2014 at 323.

negotiations.<sup>1053</sup> This point does not imply that there is no interest by Jamaica in advancing an international *sui-generis* system for food based geographical indications. However, based on a review and analyses of World Intellectual Property Office working papers, Jamaican intellectual property reports, and interview with Jamaican government representatives, there is a lack of constructive interest and participation in international geographical indications negotiations from Jamaica. I explain this point in the sections below by critically analyzing two international negotiations platforms.

The first international negotiation concern revisions to the *Lisbon Agreement* on the international recognition and registration of geographical indications. *The Geneva Act of the Lisbon Agreement* was signed by the 28 member Lisbon Union on May 21, 2015. The arguments discussed below pertain to proposed revisions leading up to this agreement. My analysis is limited to the geographical indication issues raised in the *Lisbon Agreement*, as appellations of origin, though similar to GIs, are not the focus of my thesis.

The second international negotiation is that involved in the World Intellectual Property Office's Standing Committee on the Law of Trademarks, Industrial Design and Geographical Indications.

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<sup>1053</sup> In the African Caribbean and Pacific Group of Countries, African countries were prolific in opposition representations to the European Union in its ACP-EC Partnership Agreements concerning intellectual property rights issues. This is discussed in Chapter 4.

### **7.1. The Lisbon Agreement Negotiations and Jamaica**

In chapter 3, I critiqued the substantive provisions of the revised Lisbon Agreement as an example of a change in the epistemology in the contested paradigm concerning the international law of geographical indications. As such, chapter 3's discussion of the Lisbon Agreement analytically dissected the proposed provisions insofar as they implicate agricultural and food based geographical indications in the Third world, generally.

This section of the chapter will engage with a discussion on the current state of negotiations in the *Lisbon Agreement*, the effects of Jamaica and the Caribbean's non-representation in the Lisbon Union and its negotiation proceedings, and the likely impact of Jamaica and the Caribbean's non-membership in the Lisbon Agreement on any future quest to develop a successful GI scheme domestically.

Jamaica is not a signatory to the Lisbon Agreement. Its non-membership in the Lisbon Agreement is not surprising, as in its historical state, the Lisbon Agreement was concerned with the protection of appellations of origins. Appellations of origins, though similar to geographical indications, are not formally recognized as a form of domestic intellectual property right in Jamaica. Jamaica's historical non-interest in the Lisbon Agreement can be understood from this perspective.

However, revisions to the Lisbon Agreement now make specific reference to, and have incorporated ambitious and favorable provisions concerning non-wine and spirit based geographical indications. Although I discussed the revisions in Chapter 4, I will refer to

them in this section, but more so to argue that Jamaica should have submitted proposals in the negotiations (as an observer), and to make a case for its membership to the Lisbon Union.

The amended *Lisbon Agreement* includes in its provisions, (i) the specific recognition of geographical indications, (ii) extensive protection of geographical indications among member countries through international registration and their reciprocal recognition amongst members of the Lisbon Union and, (iii) provides counteractive provisions on possible conflicts between trademarks and geographical indications in member countries.

The Lisbon Agreement extends protection to each member country that is a contracting party to the Agreement. Ambitiously stated in the Agreement is the provision that members may provide more extensive protection of geographical indications, than the Agreement stipulates. This point explicitly provides an avenue for even greater recognition of geographical indications amongst contracting parties, but most importantly, not lesser than that stipulated in the Agreement. I will briefly provide an overview of the extent of protection and recognition which the Lisbon Agreement proposes for geographical indications.

The Agreement prioritizes the importance of geographical indications and appellations of origin over confusing or similar trademarks. Applicants requesting registration of a trademark that contains reference to a registered geographical indication, or is the same as a registered geographical indication must be refused registration or be invalidated. In

such instances, the legal justification for the refusal of registration of a trademark or its invalidation must be on the basis of one or more of the following justifications: Firstly, the trademark's invalidation may be on grounds of use of geographical indication mark in a manner falsely suggesting that the product originates in a specific geographic territory. Secondly, the revised Lisbon Agreement also invalidates or refuses the registration of trademarks which are suggestive of a connection between the goods and that of the geographical indication registered product, and are likely to damaging its interest or reputation.<sup>1054</sup>

The Agreement marks a significant milestone in European countries quest to trump trade partners' move to qualify or limit the recognition of geographical indications by claims of "generic-ness".<sup>1055</sup> Geographical indications which have been registered under the Lisbon Agreement cannot become generic if they remain protected in the country of origin. It has much to offer to the establishment and advancement of Jamaica's geographical indication legislation. Furthermore, I maintain that in promoting Jamaican geographical indications as intellectual property assets, membership to the Agreement is beneficial in the following two areas. The potential of Jamaica building networks within the Lisbon Union to further promote and advance its agricultural and food based geographical indication interests is a significant possibility. Relevant as well, is the

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<sup>1054</sup> *Ibid.*, Article 11.1(a)ii.

<sup>1055</sup> Among the significant contenders is the United States who opposes indefinite and unqualified protection to geographical indications based on generic-ness (among other factors). Generic names cannot be registered as trademarks as they are common names associated with the description of a product or service.

following point: opportunities for influencing the norm setting agenda associated with geographical indications are more available to small developing countries like Jamaica,<sup>1056</sup> the more active their engagement in international proceedings. I will engage with this line of discussion from a theoretical yet practical perspective, by using TWAIL perspectives on international law as well as constructivist tenets.

My engagement with constructivist scholarship below is to bring to the fore the following arguments. It is possible to influence the trajectory of geographical indications laws through active involvement with what I refer to as “GI epistemic communities”. I define GI epistemic communities as organizations, treaty memberships, bodies, associations, groups of government coalitions who, through their norms, practices and interactions define the nature and scope of policies and rules related to geographical indications.

Furthermore, GI epistemic communities also shape the paradigm of the international law of geographical indications by transcending applicable rules and policies of the most influential community members into the practice of domestic law. I contend that this practice either reinforces or facilitates paradigmatic shifts in rules related to agricultural and food based geographical indications. The section below critically re-focuses on particular aspects of the two theories discussed in Chapter 2, as a means of extensively engaging in my arguments on Jamaica’s stance in international GI negotiations.

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<sup>1056</sup> On the vulnerability of Jamaica and the Caribbean’s economy in the era of neo-colonialism, see: Ronald Ramkisson, “Explaining Differences in Economic Performances in Caribbean Economies”, Conference Paper – Small Island Economies in An Era of Globalization, Harvard University, May 2002.

## **7.2. Towards Reforming Jamaica's Involvement in International Geographical Indication Negotiations.**

Generally, although intellectual property right policies, laws and regulations have been the subject of discussions and even mild interrogation in the Caribbean, there is an absence internationally of a strong proactive voice on its applicability and effects in the region.<sup>1057</sup>

The revised Lisbon Agreement and World Intellectual Property Office's Standing Committee on the Laws of Trademark, Geographical Indications and Industrial Design are two legal norm setting platforms which I have identified as integral in my analysis. I have concluded that Jamaica has displayed and continues to display commendable and notable interest in its WIPO Standing Committee involvement, using the proceedings to promote the protection of the country name "Jamaica" under the *Paris Convention*. However, there is no identifiable or pronounced representation made by Jamaica on advanced and reciprocal protection of geographical indications in these proceedings.

I argue that TWAIL-ians should analyze critique and advocate for legal reforms in international law, based on the particular contestation of local community groups, bodies and domestic government engagement or disengagement in international activities such

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<sup>1057</sup> My point herein does not negate the substantial and noteworthy contribution of Professor Keith Nurse in engaging in intense debates and research on the benefits of copyright policies to the creative sector in the Caribbean. *Creative Economies in the Caribbean*.



as trade agreements and negotiations.<sup>1058</sup> This argument aligns with one of TWAIL's foundational objectives in augmenting an international law which is not oppressive, but is emancipatory in its approach,<sup>1059</sup> and its practical application in the Third World.<sup>1060</sup>

The rules relating to geographical indications are contentious, based on inconsistency and non-reciprocity of such laws across jurisdictions. Issues related to the recognition and enforcement of agricultural and food based geographical indication laws are not restricted to Third World relevance.

There are also differences in perspectives and recognition of agricultural and food based geographical indications between the European Union, United States and Canada. The United States has adamantly debated that such recognition is unnecessary.<sup>1061</sup> I have further argued in Chapter 4, that the United States' refusal to recognize GIs is an economic and political decision, based on an imperialistic competitive drive to protect

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<sup>1058</sup> See Makau Mutua whose convincing arguments on the objectives and need for a constructive critique on international law effectively states the rationale for TWAIL scholarship. Makua Mutua, "What is TWAIL", Proceedings of the 94<sup>th</sup> Annual Meeting: International Law In Ferment: A New Vision for Theory and Practice" (April 5-8, 2000).

<sup>1059</sup> *Supra note 187*, Anghie & Chimni, "Third World Approaches to International Law"; Antony Anghie, "The Evolution of International Law: Colonial and Postcolonial realities" (2006) 27 *Third World Q* 739.

<sup>1060</sup> I discussed the United States' position on non-wine and spirit geographical indications in chapter 4 and in this chapter. It is interesting however that Canada has agreed to extend geographical indication protection to more than 170 specified European Union geographical indication products under the Canada-European Comprehensive Economic and Trade Agreement (the specified foods include cheeses, olive oil and fresh and processed fruit and nuts).

<sup>1061</sup> For a discussion of this point, see chapter 4.

the rights of its trademark holders.<sup>1062</sup> In a recent letter to the Director General of the World Intellectual Property Office,<sup>1063</sup> the United States' Congress intimate its strong disapproval to the draft Lisbon agreement proposed enhancement of GI rights, noting:

“...the particular agreement will not provide adequate protection for users of common or generic names, or prior trademarks holders around the world. Without these safeguards, companies in the United States and elsewhere could see their sales opportunities and intellectual property right eroded in various markets around the world. This is already occurring in many countries where U.S companies face geographical indications legislation that threaten to internationally block their use of common food names and negatively impact existing protections for their common trademarks”.<sup>1064</sup>

The letter clearly indicates the United States' unwillingness to recognize non wine and food GIs as distinct forms of intellectual property.<sup>1065</sup> In the European Union, GIs are distinctly accorded an enhanced recognition under the European Economic Community Regulation 2081/92. There is no *sui generis* legislation in common-law Canada for agricultural and food based geographical indications, such rights are recognized as certification marks under the country's Trade Mark Act.<sup>1066</sup>

A TWAIL understanding of laws pertaining to geographical indications brings to the fore the following critical arguments. The recognition of food and other forms of non-wine

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<sup>1062</sup> *Ibid.*

<sup>1063</sup> Congress Of The United States', Letter to Director General of The World Intellectual Property Office, Francis Gurry, February 12, 2015.

<sup>1064</sup> *Ibid*, p. I.

<sup>1065</sup> See also World Intellectual Property Office, Working Group on the Development of The Lisbon System, Eighth session, Geneva, April 4, 2014. Document number: LI/WG/DEV/8/7.PROV.

<sup>1066</sup> *Trade marks Act*, RSC 1985, c T-13, sec 23.

and spirit products as GI registrable and protectable creates a reformist opportunity for the international law of GIs. Therefore, TWAIL is supportive of transforming the imperialistic rules, policies and regulations governing the politics of geographical indications recognition, to one which is counter-hegemonic. On this basis, TWAIL supports a transformative intellectual property rights law, which is inclusively representational of the intellectual property interest of Third World peoples.

A central issue which this discussion evokes is how is a reformist approach to the laws of geographical indication to be practiced or attained? Constructivists pinpoint the essential effects of interaction amongst epistemic communities in forging power networks and ultimately, in proliferating norms and policies associated with a specific agenda. A TWAIL constructivist themed reform of Jamaica's current stance in international negotiations concerning geographical indications asserts the following propositions. Geographical indications need to be envisaged as more than a tool which requires legal protection of the registered product as a means of safeguarding against infringement. I am not downplaying the importance of militating against geographical indication infringements.

However, an over-centered focus on infringement without balancing other essential aspects of geographical indication administration, likely means that the developmental tenets of geographical indications will not be fully explored. Therefore, practically, a reformist TWAIL strategy for Jamaica's geographical indications narrative requires a focus beyond an attestation of the legality of the product itself, to a focus on the human

capital behind the product. As such, Jamaica's keen focus on promoting geographical indications as a safeguard against infringement runs the risk of creating a normative conceptualization of GIs as rights which are to be protected, but not locally harnessed. In the foreign based imperialistic nature of traditional forms of intellectual property rights in Jamaica, the representation of the "local" was minimal in the domestic applicability of these rights. Therefore, it is not sufficient to register qualified food based products as geographical indications, strategic development based plans and strategic alliances with regional and international networks need to be forged, if Jamaica is to effectively re-orientate its IP narrative.

Jamaica's non-participation in revisions (as an observer) to the Lisbon Agreement was therefore a lamentable state of play. Non-member status in the Lisbon Union did not preclude World Trade Organization members from making submissions on the proposed changes to the Agreement.<sup>1067</sup> Active involvement in critical and influential forums is

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<sup>1067</sup> By way of example, the United States made its opposition well known to the *Lisbon Union* prior to the proceedings. Letter to Director General of World Intellectual Property Office from the Congress of the United States, dated February 12, 2015 (<http://www.ip-watch.org/weblog/wp-content/uploads/2015/02/Senate-House-Committee-Leaders-WIPO-Lisbon-Feb-2015.pdf>); World Intellectual Property Rights Office, Standing Committee on Law of Trademarks, Industrial Design and Geographical Indications, "Proposals by the Delegation of the United States", 31st Session, Geneva, March 17-21 2014, SCT 31/17;(Available online at, [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_31/sct\\_31\\_7.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_31/sct_31_7.pdf), last accessed September 30, 2016). WIPO Standing Committee on the Law of Trademarks, Industrial Design and Geographical Indications, Proposal by the Delegation of the United States, 31st Session, Geneva March 17-21, 2014. (Available online, [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_31/sct\\_31\\_7.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_31/sct_31_7.pdf), last accessed September 30, 2016); See also submissions by the United States Patent and Trademark Office, January 2010, (Available online <http://www.wipo.int/export/sites/www/lisbon/en/submissions/pdf/usa.pdf>); Submissions by other groups including Japan, Canada, Argentina and Singapore along with the United states: Preparatory Committee of the Diplomatic Conference for the Adoption of A Revised Lisbon Agreement on Appellations of Origin and Geographical Indications, World Intellectual Property Report, October 30 & 31, 2014 (Available online at [http://www.wipo.int/edocs/mdocs/mdocs/en/li\\_r\\_pm/li\\_r\\_pm\\_5\\_rev\\_2.pdf](http://www.wipo.int/edocs/mdocs/mdocs/en/li_r_pm/li_r_pm_5_rev_2.pdf), last accessed September 30, 2016).

imperative coalition strategies<sup>1068</sup> for negotiating and rule setting legal platforms. I further make the point that assertive engagement in geographical indications or intellectual property forums which are ostensibly not envisaged as norm setting spaces, may create opportunities for favorable legal outcomes. Epistemic GI and intellectual property communities are power networks which must either be aligned with, or aggressively engaged with, to attain reciprocal recognition of rights. These communities are also socio-legal avenues for creating international rules which are conducive to the local interpretation and applicability of agricultural and food based geographical indication laws.

Normatively, representations and perspectives on the scope and extent of trademark protection in light of broad-based rights for geographical indications, is a topical subject matter which Jamaica must engage in if it endeavors to re-orientate its intellectual property narrative. By adopting a proactive approach in international geographical indications negotiations especially in matters related to the supremacy of trademarks over GIs, Jamaica may achieve the following two re-orientations in its narrative.

Firstly, and as I will discuss in the next section, the country has made various protestations on the mis-use of its name on products which are not Jamaican in origin.

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<sup>1068</sup> Peter Yu, Building Intellectual Property Coalition for Development (*Centre for International Governance Innovation*, Working Paper Series No. 37). Chidi Oguanaman, *Intellectual Property in Global Governance: A Development Question*, (London: Routledge, 2012).

These legal protestations have been made in a trademark rights oriented forum.<sup>1069</sup> I emphasize the point that paradigmatic shifts in intellectual property laws are hardly likely without strategic government and non-governmental alliances, proactive regional and international representations, and a commitment by the body seeking the change to strategically position its domestic resources to engage with the epistemic global. As such, the Lisbon negotiations could have been used as a forum for advancing support for the curtailment of trademark rights in instances of conflict with registered geographical indications, caused by using the country name ‘Jamaica’.

The second point is related to my first argument above, but is noteworthy to explain. A significant portion of Jamaica’s trademark law narrative is based on the protection of foreign based rights.<sup>1070</sup> I identify the Lisbon Agreement negotiations as one of the main epistemic communities for the advancement of broad-based rights associated with geographical indications. Therefore, this forum presented Jamaica with an opportunity to identify enforceable points of demarcation between the protection of a largely foreign based trademark rights platform and the enhanced legal status of GIs, as envisaged by the revised *Lisbon Agreement*.

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<sup>1069</sup> WIPO’s Standing Committee on the Laws of Trademarks, Industrial Design and Geographical Indications has been used by Jamaica as a forum to demand an amendment to Article 6ter of the Paris Convention. If amended, the Paris Convention would recognize the country names, translations and transliterations thereof, as legally protected trademarks.

<sup>1070</sup> World Intellectual Property Office, Trademark Statistics for Jamaica, 1999-2013( Available online, [http://www.wipo.int/ipstats/en/statistics/country\\_profile/profile.jsp?code=JM](http://www.wipo.int/ipstats/en/statistics/country_profile/profile.jsp?code=JM), last accessed March 24, 2015).

A participatory approach to attempts at transformative changes in the international law of GIs is required by Third World countries. It is highly improbable that Jamaica will attain Anghie's<sup>1071</sup> emancipatory tenets of international law without proactive international and regional engagement in GI networks. An explanation for the lack of active participation may pertain to the cost of engagement in international negotiations.<sup>1072</sup> This is a valid and justifiable point. However, the importance of geographical indications as an asset of development warrants the allocation of resources towards constructive regional and international interactions on GI issues.

Jamaica has used the World Intellectual Property Office's forum to advance arguments for the legal protection of country names against mis-use by unauthorized users.<sup>1073</sup> The lamentable observation concerning Jamaica's representation is that it has not actively used the forum for submissions related to the reciprocal recognition of agricultural and food based geographical indications. This legal network is comprised of representatives from some of Jamaica's major consumer market for some of its most internationally well-known products (inclusive of Jamaica's Blue Mountain coffee).<sup>1074</sup>

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<sup>1071</sup> Anthony Anghie, 'The Grotius Lecture: International Law in a Time of Change' (2011) 26 *Amer Univ Int'l L Rev* 1315.

<sup>1072</sup> Interviews, Jamaica Intellectual Property Office Representative (September 4, 2013).

<sup>1073</sup> Standing Committee on the Law of Trademarks, Industrial Design and Geographical Indication, 32<sup>nd</sup> session, (Available online at, [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_32/sct\\_32\\_2.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_32/sct_32_2.pdf)).

<sup>1074</sup> Countries such as China, and the United States of America are members of this group.

Section 8.3 engages in a discussion on two dialogically different IP themes, but themes that are not mutually exclusive of each other, based on current uncertainties in the law governing agricultural and food based geographical indications.

The unwillingness of the United States (one of Jamaica's major international consumer markets) to reciprocally recognize agricultural and food based geographical indications as legal forms of intellectual property, potentially places Jamaica in a vulnerable, yet opportune position. A TWAIL themed understanding of Jamaica's IP plight posits that, in efforts to disengage with its imperialistic effects, reforming the Euro-centricity in law is just as important as aggressively highlighting law's flaw. On this basis, the country has used WIPO's international forum to augment its opposition to the use of the name 'Jamaica' on products which do not originate in Jamaica.

Furthermore, by proposing the protection of country names under the *Paris Convention*, Jamaica is implicitly paving alternate ways of protecting forms of geographical indications, (a) whose registered names include the name 'Jamaica' and, (b) which are not recognized as geographical indications in a particular jurisdiction.

### **7.3. Jamaica: Productive Engagement in International Intellectual Property Spaces**

An understanding of Jamaica's ability and probability of impacting international geographical indications and intellectual property laws, require a critical analysis of the



behavior of domestic institutional and non-institutional actors,<sup>1075</sup> and the interaction of these bodies with key regional and international actors. Actors' identities and interests on intellectual property issues<sup>1076</sup> are formed by collective and strategic interactions amongst states, regional and international organizations. By way of example, I argue that the agenda of WIPO's various standing committees is set by members of the coalition who are the most proactive, assertive and influential in advancing their ideas and interests as relevant issues. I refer to such modes of representations as "productive engagements" because they produce results, or create opportunities for favorable policy changes in IP.

The issue which I address in this section pertains to Jamaica's interaction with the international intellectual property networks and concerns the following. Firstly, to what extent has Jamaica's representation on the protection of country names in WIPO's standing committee facilitated a perspective of the country as a transformative agent of IP reform? A TWAIL<sup>1077</sup> understanding of geographical indications in the Third World explicates the following observation. Third World communities must identify opportune

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<sup>1075</sup> Institutional actors include government agencies such as its Ministry of Foreign Affairs and Trade, Tourism Ministry, Ministry of Agriculture, the Jamaica Intellectual Property Office and Jamaica's Rural Agricultural Development Agency. Non-institutional actors include influential interest groups such as farmers' associations and powerful non-governmental groups.

<sup>1076</sup> Alexander Wendt, *Social Theory of International Politics*, (Cambridge: Cambridge University Press, 1999); Peter Yu, *Intellectual Property Geographies*, (2014) 6:1 *WIPO J* 1. Yu argues that spatial, cultural, legal and geographic differences in international IP jurisdictions, and communities are complexes in attaining a socio-economically sound results from the commercialization of intellectual property.

<sup>1077</sup> Amar Bhatia, *The South of the North – Building on Critical Approaches to International Law with Lessons from the Fourth World*, (2012) 14:1 *Oregon Rev of Intl L* 131.

areas of domestic development<sup>1078</sup> that are possible within the terrain of GI laws. Secondly, a reformist legal strategy must be used in international engagements to assertively and aggressively negotiate favorable rules in the application of GI laws in the major international consumer markets of Third World countries.

The section below engages in a critique of Jamaica's submissions to WIPO's Standing Committee, proposing an amendment to *Article 6ter* of The Paris Convention, to allow for the legal protection of country names as trademarks.

### **7.3.1. Representations on The Protection of Country Names under Article 6ter of the Paris Convention in WIPO's Standing Committee.**

International intellectual property rights law does not uniformly recognize the name of a country as a separate form of protection on the basis of origination of a product in a specific country. As such, a product which uses or makes reference to the name Jamaica as a part of its name or trademark, may not be legally prevented from doing so, on the basis that the product's origin is not Jamaica. In some jurisdictions, a country's name may be protected on the basis of non-distinctiveness, descriptive, misleading or incorrect trademarks.<sup>1079</sup>

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<sup>1078</sup> In this sentence, I use the term development in a broad and general context, to mean growth or gains attained through the association or usage of specific laws.

<sup>1079</sup> Japan, Norway, Chile are examples of such jurisdictions. In other jurisdictions, a country name can be registered as a trademark except on the basis of prior registration of a similar name, which may therefore cause confusion to the public. An example of a jurisdiction that uses this approach is the United States, the Dominican Republic and Finland: WIPO Standing Committee on the Law of Trademark, Industrial Design and Geographical Indications, (SCT/24/6 February 14, 2011), 24<sup>th</sup> Session, November 1 to 4, 2010 (Available online, [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_24/sct\\_24\\_6.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_24/sct_24_6.pdf), last accessed September 30, 2016).

There is a form of relatedness in this legal phenomenon with the scope of geographical indications. However, and most importantly, they remain two separate issues because of the basic legal meaning of “geographical indications”, as defined under *TRIPS*. As surmised in *Article 22.2 of TRIPS*,<sup>1080</sup> there must be particular human and/or natural factors essentially attributable to the product and its territory or geographical origin, thereby justifying the registration of the product as a geographical indication. As such, not all products are registrable as geographical indications.

In an effort to protect its country name against mis-use or conflicting uses, Jamaica has been assertive in its written submissions to the Standing Committee<sup>1081</sup> on the enactment of revisions to *Article 6ter of the Paris Convention*. Article 6ter protects armorial bearings, flags, state emblems, official signs, and warranty of a Member state by preventing their usage by un-authorized and non-territorial users as trademarks.<sup>1082</sup>

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<sup>1080</sup> Article 22.2. Trade Related Aspects of Intellectual Property.

<sup>1081</sup> WIPO Standing Committee on the Laws of Trademark, Industrial Design and Geographical Indications (source); Standing Committee on the Laws of Trademark, Industrial Design and Geographical Indications, (Available online, [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_27/sct\\_27\\_6.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_27/sct_27_6.pdf)).

<sup>1082</sup> Article 6ter, *Paris Convention* (a) The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.

(b) The provisions of subparagraph (a), above, shall apply equally to armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organizations of which one or more countries of the Union are members, with the exception of armorial bearings, flags, other emblems, abbreviations, and names, that are already the subject of international agreements in force, intended to ensure their protection.

*Article 6ter* also protects the names and abbreviations of intergovernmental organizations from use as trademarks by un-authorized users, and non-owners of such trademarks.<sup>1083</sup>

Calls for the protection of country names under the Paris Convention are not new.<sup>1084</sup> The first submission was made over thirty years ago, but was opposed by many of the contracting parties to the Paris Union.<sup>1085</sup>

Jamaica proposes the extension of protection provided by *Article 6ter* of the Paris Convention to country names, and the translations, and transliteration of country names.

Jamaica has argued that the lack of uniformity or consistency in the international protection of country names has adverse effects on its socio-economic wellbeing.<sup>1086</sup> It has asserted that the mis-use of its country name with un-authorized products has led to

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(c) No country of the Union shall be required to apply the provisions of subparagraph (b), above, to the prejudice of the owners of rights acquired in good faith before the entry into force, in that country, of this Convention. The countries of the Union shall not be required to apply the said provisions when the use or registration referred to in subparagraph (a), above, is not of such a nature as to suggest to the public that a connection exists between the organization concerned and the armorial bearings, flags, emblems, abbreviations, and names, or if such use or registration is probably not of such a nature as to mislead the public as to the existence of a connection between the user and the organization.

<sup>1083</sup> The Paris Convention was amended in 1958 (Revision Conference of the Lisbon Convention) to extend protection to the protection of names and abbreviations of intergovernmental organizations. WIPO, Standing Committee on Law of Trademarks, Industrial Design and Geographical Indications, Article 6ter of the Paris Convention: Legal and Administrative Aspects, 15<sup>th</sup> Session November 28 to December 02, 2005; (available online [http://www.wipo.int/meetings/en/doc\\_details.jsp?doc\\_id=52129](http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=52129), last accessed January 19, 2015).

<sup>1084</sup> *Ibid.*

<sup>1085</sup> Frank Fougere, “Protection of Country Names” Ananda Intellectual Property Office, Thailand -WIPO Summer School on International Property, May 2013. (Available online, [http://www.ananda-ip.com/files/WIPO-BKKTH-May2013-Protection\\_of\\_Country\\_Names.pdf](http://www.ananda-ip.com/files/WIPO-BKKTH-May2013-Protection_of_Country_Names.pdf), last accessed September 30, 2016).

<sup>1086</sup> *Ibid.*

commercial loss in the marketability of its own products. Jamaica has also made extensive arguments on the dilution of its name as a brand with products which do not originate in Jamaica.<sup>1087</sup> These submissions have been supported by a number of countries, including those from the Caribbean and international jurisdictions.<sup>1088</sup> However, notable opposition has been made by the United States against the recognition of country names as a distinct protective IP right.

For the purposes of my discussion with this issue, the focal point pertains to whether Jamaica's engagement in WIPO's forum on the protection of country names is indicative of a paradigmatic shift in an otherwise passive stance on intellectual property issues. I have concluded that Jamaica's involvement in this forum signifies a commendable move, and a proactive participatory approach in its international intellectual property negotiations. However, because a proactive stance is not observable in other salient GI forums, it would not be accurate to make a definitive statement affirming a general assertiveness in international intellectual property negotiations.

I will detail and critically explain the most controversially suggested amendments to the Paris Convention which Jamaica proposes as means of protecting its country name against mis-use. The objective of my engagement with this specific issue is not to

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<sup>1087</sup> *Ibid.*

<sup>1088</sup> Countries which support the protection of country names include, Antigua and Barbuda and Barbados. Japan has pointed out that specific provisions in its Trademark Act protect against the use of a country's name unless the product originates in the concerned country. Japan is one of Jamaica's major consumer market for its Blue Mountain coffee.

provide general or a critical review of the suggested amendments per se. However, I intend to evaluate and determine the ability of Jamaica to proactively engage the international IP community into action. As such, my critique will focus on evaluating whether Jamaica is influential in international negotiations and policy reformations in this forum. In the sub-sections below, 2 of the proposed amendments are discussed.

#### **7.3.1.1. Domain Name Registration – Protection Against Registration of Country Names.**

As the recent Amazon legal debacle<sup>1089</sup> illustrates, contentions over the registration of country names as domain names are not restricted to protestations from Jamaica. I will briefly provide an overview of the Amazon case, as a means of bringing to the fore the issues which are usually of concern in these cases.

The e-commerce business had filed an application for the registration of generic top level domain names, inclusive of the name “amazon”. The application was objected to by several Latin American countries<sup>1090</sup> whose land space contain portions of the well-known geographic territory, the Amazon.<sup>1091</sup> The objection was based on an explicit conflict of names with the geographic territory. Various submissions were made to the

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<sup>1089</sup> ICANN - Amazon, May 2014. See: Approved Resolutions, Meeting of the New Gtld Program Resolution Committee. (Available online, <https://www.icann.org/resources/board-material/resolutions-new-gtld-2014-05-14-en#2.a>, last accessed September 30, 2016).

<sup>1090</sup> These countries are Bolivia, Brazil, Columbia, Ecuador, Guyana, Peru, Suriname and Venezuela.

<sup>1091</sup> The Amazon is the largest rain forest in the world, known for its biodiversity and spans across eight countries: French Guinea, Suriname, Brazil, Guyana, Peru, Ecuador, Bolivia, Venezuela and Columbia.

Internet Corporation for Assigned Names and Numbers (ICANN)<sup>1092</sup> Dispute Resolution Committee by interested parties in the matter. Based on the advice of its Governmental Advisory Committee (GAC),<sup>1093</sup> ICANN ruled that the domain name registration could not proceed. ICANN opined that the grant of an exclusive domain name registration to Amazon would adversely affect the ability of the geographic territory of the Amazon to promote and protect its interests. It further ruled that the grant of the domain name would prevent the usage of the concerned name in promoting the Amazon region through webpages.<sup>1094</sup>

The Amazon ruling brings to the fore an interesting and salient observation on the effects of powerful epistemic communities on the creation and proliferation of legal rules through shared understandings and the practice of legality.<sup>1095</sup> The Government Advisory Committee of ICANN exercised significant influence in the choice of decision adopted

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<sup>1092</sup> The Internet Corporation for Assigned Names and Numbers is a non-profit organization that develops rules for the governance of the internet, including internet identifiers ([www.icann.org](http://www.icann.org)).

<sup>1093</sup> According to its website, the Governmental Advisory Committee (GAC) “provides advice to ICANN on issues of public policy, and especially where there may be an interaction between ICANN’s activities or policies and national laws or international agreements. The GAC usually meets three times a year in conjunction with ICANN meetings, where it discusses issues with the ICANN Board and other ICANN Supporting Organisations, Advisory Committees and other groups” (Available online at <https://gacweb.icann.org/display/gacweb/Governmental+Advisory+Committee>, last accessed September 30, 2016).

<sup>1094</sup> *Supra* note 1089.

<sup>1095</sup> Through their interactions with constructivism, Brunee and Toope have brilliantly coined and articulated on the term “the practice of legality” in international law. The practice of legality is built on the creation of norms by epistemic communities, which are accepted and reified by dominant actors internationally, and are accepted in the mainstream arena of domestic and international law as a legal norm. Jutta Brunnee and Stephen J. Toope, “The Rule of Law in an Agnostic World: The Prohibition on the Use of Force and Humanitarian Exceptions”, Wouter Werner et al., eds., *Koskenniemi and his Critics* (Cambridge: Cambridge University Press, 2015). (Available at SSRN: <http://ssrn.com/abstract=2547022>, last accessed September 30, 2016).

by ICANN. Although I will not extensively focus on this issue, it is integral to my thesis to make the following points.

The Governmental Advisory Committee is comprised of representatives from various countries, most of whom are from the developing world.<sup>1096</sup> It can be reasonably concluded that the dominant interests of chair members and representatives become institutionalized as agendas and perspectives which are to be adapted as forming the mandate and general perspective of GAC. As noted above, the Governmental Advisory Committee's public policy recommendation to ICANN's Dispute Resolution Committee was that the domain name registration of the e-commerce business Amazon, would detrimentally affect the public interest of the geographic region of Amazon.

It is of course advantageous that the intellectual property underdog in this case (the Amazon region), won the dispute between the parties. Importantly, I also argue that the governance and operation model of ICANN facilitated the decision-making process, and the resolution reached. The Internet Corporation for Assigned Names and Numbers gives significant consideration to the policy recommendations of GAC; this is a part of its mandate.<sup>1097</sup> Therefore, the decision-making procedure in the Internet Corporation for Assigned Names and Numbers was beneficial in the resolution of the dispute in favor of the Amazon region. The case provides a contextual background of the concerns Jamaica

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<sup>1096</sup> The current chair of GAC is from Switzerland. The Vice chairs are from Australia, Trinidad and Tobago, Argentina, Spain, Namibia, Thailand and Turkey, *supra* note 1093.

<sup>1097</sup> *Supra* note 1060.



raises, and those which it seeks to address through its suggested protection of country names against domain name registrations.

In its efforts to garner the inclusion of a legal restriction on the use of country names by un-authorized entities as domain names on the internet, Jamaica has specified the following measures in its submission to the World Intellectual Property Office's Standing Committee. These measures were not originally drafted by Jamaica, but were part of recommendations made at WIPO's Joint Recommendations Concerning Provisions on the Protection of Well-Known Marks.<sup>1098</sup> The provision stipulates that a domain name conflicts with a country name if it is, (i) in an abbreviated form, (ii) is a reproduction, imitation, translation or transliteration of the country name, or, (iii) is registered or used in bad faith.<sup>1099</sup>

According to the provision, a domain name which is used to falsely indicate a connection between the business and the Member state is also conflicting, and impermissible as a registered domain name. A domain name which is likely to impair or dilute the distinctive character and/or brand associated with the Member states' country name is also conflicting. Also noted is a prohibition on the use of domain names which, if

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<sup>1098</sup> WIPO's Committee on Joint Recommendations Concerning Provisions on the Protection of Well-Known Marks met in 1999 to discuss changes to the Paris Convention concerning the protection of well-known Marks. Jamaica's submissions on restrictions to domain names amended these provisions to make them applicable and relevant to the protection of country names. Discussed above. SCT 3/8. (Available online [www.wipo.int/edocs/mdocs/sct/en/sct\\_3/sct\\_3\\_8.doc](http://www.wipo.int/edocs/mdocs/sct/en/sct_3/sct_3_8.doc)).

<sup>1099</sup> WIPO Standing Committee on the Law of Trademarks, Industrial Design and Geographical Indications, 31<sup>st</sup> session, March 17-21, 2014, Article 5 – Conflicting Domain names.

registered or used, takes unfair advantage of the distinct character, reputation and/or nation brand of the Member country's name.

Similar to other suggested amendments to *Article 6ter*, restrictions on domain name registrations on the basis of the need to protect country names are not without opposition from certain Member states. I will discuss these opposing arguments cumulatively towards the end of this section.

### **7.3.1.2. Conflicting Marks – Protection Against the Un-Authorized Use of Country Names on Products**

There is an absence of uniformity in international trademark jurisdictions on the extent of protection against registration of country names on products which do not originate in the specified territory. Notwithstanding this, there is a noticeable level of sensitivity (although varied) on the issue in some jurisdictions.<sup>1100</sup> The substantial amount of publicity<sup>1101</sup> resulting from the dissemination of Jamaica's arguments on legally safeguarding country names against un-authorized trademark usage is remarkable.

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<sup>1100</sup> A WIPO conducted survey in November 2010 indicated that 42% of its members recognized country names as a basis for the non-registration of a product which is not associated with its country of origin. In several of the jurisdictions which do protect country names against registration, its members assert that if there is a finding of misleading or confusion of the public, the product is ineligible of registration. Standing Committee on The Law of Trademarks, Industrial Design and Geographical Indications, Revised Draft Reference Document on the Protection of Country Names against Registration and Use as Trademarks, Third Session, Geneva, Switzerland, 2013. Switzerland, Trinidad and Tobago, Monaco and Italy are among the countries that agree with Jamaica's position.

<sup>1101</sup> LexProtector, Protection of Country Names: Pursued by Caribbean Country Delegates ([www.lexprotector.com/blog/index.php/2012/09/21/protection-of-...](http://www.lexprotector.com/blog/index.php/2012/09/21/protection-of-...)), September 2012; IP Watch, Protection of Country Names Inspires Delegates..., September 20, 2012 (Available online at IP Watch: <http://www.ip-watch.org/2012/09/20/wipo-protection-of-country-names-inspires-delegates-designs-conference-elusive>, last accessed September 30, 2016); Catherine Saez, Can or Should Governments Own Their Country Names, IP Watch, March 20, 2014 (Available online at IP Watch: <http://www.ip-watch.org/2014/03/20/wipo-debate-can-or-should-governments-own-their-country-domain-names/>, last accessed September 30, 2016).

Negotiations in the Standing Committee on this matter are on-going, and are expected to conclude with a resolution in 2015. The intensity of opposition against recognition of country names under the Paris Convention, especially by the United States, brings me to the practical realization that it is possible that no material changes may ensue. This would be unfortunate. However, it would not diminish the important role which Jamaica has played in raising global awareness on this matter, especially amongst the intellectual property right communities.

The subsequent paragraphs in this section will discuss Jamaica's proposed provisions on the protection against registration of country names on the basis of conflicting marks.

The proposed revision on conflicting marks to the *Paris Convention* stipulates that product names which are identical to the names of countries, but are not directly from these countries or associated with them, are invalid as registered names of products.<sup>1102</sup> This provision, if implemented, would prevent the registration of goods and/or services which use or intend to use the name of country as, or as a part of the name of a product or service.<sup>1103</sup> Although there are differences in the treatment of country names as trademarks in international jurisdictions, the actual use of a country name as the name of

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<sup>1102</sup> WIPO, Standing Committee on Law of Trademarks, Industrial Designs and Geographical Indications, Revised Proposals by the Delegation of Jamaica, September 24, 2014 SCT/32/4.

<sup>1103</sup> *Ibid.*

product may be invalidated on grounds of descriptiveness or deception with origin in many jurisdictions.<sup>1104</sup>

Furthermore, if the law of the state permits, the concerned third party member state may oppose the registration on the basis that the product either contains a reference to its name, or is using its name on the product.<sup>1105</sup> The provision also proposes that a competent authority may, on its own initiative, oppose the registration of a product or service on the same grounds as the third party member state.<sup>1106</sup> This opposition would suffice to invalidate the registration of the protected name with the product or service. Competent authority is defined in the proposed revision as an administrative, judicial or quasi-judicial body that is responsible for determining if a mark conflicts with a country name.<sup>1107</sup>

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<sup>1104</sup> Greece, China, Japan, Barbados, Jamaica, Antigua and Barbuda are examples of countries which may refuse the registration of a trademark if the product's name is found to be descriptive or deceptive on the grounds of being identical with the name of a country. WIPO, Standing Committee on the Law of Trademarks, Industrial Design and Geographical Indications, Study on the Protection of Country Names, Twenty Nine Session, Geneva May 27-31, 2013 (available online, [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_29/sct\\_29\\_5.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_29/sct_29_5.pdf)).

<sup>1105</sup> Article 3 (2), Conflicting Marks, *supra* note 1102.

<sup>1106</sup> Article 3(3b), Conflicting Marks, Invalidation Procedures, *supra* note 1102.

<sup>1107</sup> *Ibid.*

### **7.3.1.3. Assessing Jamaica's Arguments *vis a vis* Counterarguments from Member States**

It is apparent that the proposed amendments are beneficial provisions to Jamaica, as essential elements of nation branding strategies.<sup>1108</sup> The debacle of a Jamaican couple who farm and manufacture almond oil labelled as “Jamaican Almond Oil”, but who are being sued by an American company over the use of the name, clearly indicates that there is a problem.<sup>1109</sup>

The actual proposition of these amendments by Jamaica illustrates that the country has taken steps toward a counterhegemonic approach in IP negotiations. This is a commendable position, and is a practical illustration of the TWAIL objective of assertiveness in international law, in practice. As I have argued in previous chapters of this thesis, such an approach is usually not practiced by Jamaica, and the Caribbean in general. I have intentionally identified this trajectory as a movement towards a counterhegemonic status in intellectual property negotiations and strategizing, as opposed to an attained counter hegemonic status. This specific approach by Jamaica is not significantly noticeable in other areas of its international IP negotiations or, in IP rule settings.

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<sup>1108</sup> Nadia Kaneva makes a critically important point in arguing that nation branding is both a cultural and political concept in which a states' conceptualization of “branding” influences its practical application, and the states' approach to branding policies. Nadia Kaneva, “Nation Branding: Toward an Agenda for Critical Research”, (2011) 5 *Intl J of Communication* 117.

<sup>1109</sup> Claudia Gardner, “Exploiting Brand Jamaica” *Jamaica Gleaner*, September 14, 2014 (Available online at Jamaica Gleaner, <http://jamaica-gleaner.com/gleaner/20140914/lead/lead8.html>, last accessed September 30, 2016).

The most dominant opposing arguments have been made by the United States, who forcefully opine that there is no rational basis for the legal protection of country names. Interestingly, the United States envisages Jamaica's propositions as an unnecessary and unwarranted obligation upon member states' governments to engage in the litigation of its country's name. There is an adamant refusal to recognize brand ownership by any entity other than corporations, individuals, and other organizations.

The arguments expressed by the United States infer that it views Jamaica's propositions as an intrusion on its own ability and capacity to make an independent choice on the matter. According to arguments posited by the United States and South Africa, Jamaica's proposed revisions are mandatory, and provide no avenues for a discretionary approach by a member state. As such, both countries envisage that member states are obligated to protect, and administer the protection of a country's name against infringement.

A critical review of the United States' position on international IP issues leads me to make the following argument. Although the United States has a strong inclination for robust safeguards of its IP in international jurisdictions,<sup>1110</sup> this deliberate strategy is based on the protection of its domestic IP industries. Furthermore, instances of an imperialistic paradigm<sup>1111</sup> in the politics that drives United States' intellectual property

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<sup>1110</sup> United States' Special 301 Report years 1998-2014 (Available online [www.keionline/ustor/special301](http://www.keionline/ustor/special301)); Debora Halbert, *The State of Copyright, The Complex Relationship of Cultural Creation in a Globalized World* (New York: Routledge, 2014) at 29-45.

<sup>1111</sup> Prabhaskhar Singh, Macbeth's Three Witches: Capitalism, Common Good and International Law, (2012) 14 *Ore Rev Intl L* 47; B.S Chimni, Capitalism, Imperialism and International Law, (2012) 14 *Ore Rev Intl L* 17 [Chimni, "*Capitalism, Imperialism and International Law*"].

policies in the Third World is illustrated by its demands for more stringent rules in the governance of IP in these countries.

Concern over the impact of the suggested amendments on the rights of United States' trademark owners is a pivotal factor in its opposition to Jamaica's propositions. I also argue that the vulnerable geo-political position of Jamaica compared to the United States' stalwartness in trade related international negotiations negatively affects Jamaica's ability to influence United States' policies. My use of the term geo-political refers to the capacity of Jamaica to globally influence and be influenced by laws, rules, policies, and the politics of other states based on its Third World status, its economy, colonial history and political affiliations. Historically, this status has seen Jamaica being a repository for the intellectual property right policies of bourgeois imperialist states,<sup>1112</sup> rather than a provider of such policies to the international fora.<sup>1113</sup> As such, I argue that it is not surprising that the United States is not receptive to Jamaica's proposals.

The United States disengagement with Antigua and Barbuda over the latter's right to use cross retaliation measures against the United States',<sup>1114</sup> illustrates with precision its outlook on substantive IP engagement with Caribbean Third World countries. The

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<sup>1112</sup> *Ibid*, Chimni "Capitalism, Imperialism and International Law"; B.S. Chimni, Prolegomano to a Class Approach to International Law (2010) 21:1 *Euro J of Intl L* 57.

<sup>1113</sup> This is discussed in Chapter 3 of this thesis.

<sup>1114</sup> United States – Measures Affecting the Cross-Border Supply of Gambling and Betting Services, "Communication from Antigua" WT/2685/26, World Trade Organization, April 25 2013.

subject matter of the Antigua-United States IP controversy is outside the purview of the thesis. However, it is mentioned as the United States has refused to comply with the World Trade Organization's Dispute Settlement ruling<sup>1115</sup> which held that it wrongly blocked Antigua's online gambling internet site. The ruling entitles Antigua to impose cross retaliation measures against the United States as a form of sanction, pursuant to *Article 22.7* of WTO's rules governing dispute settlement.<sup>1116</sup> Although Antigua has asserted that the sanction will take the form of the non-protection of US \$21million worth of United States' intellectual property rights in its country, it has not imposed this sanction.<sup>1117</sup>

This controversy is an instructive example of the United States' perspective and approach in dealing with attempts by most Caribbean countries to assert a proactive stance in intellectual property norm setting forums. Therefore, opposing arguments asserted by the United States against the protection of country names under the Paris Union is illustrative of a continued imperialistic paradigm concerning the formulation of IP policies with Caribbean countries.

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<sup>1115</sup> *Ibid.*

<sup>1116</sup> World Trade Organization, *Article 22.7 of Understanding of Rules and Procedures Governing the Settlement of Disputes; United States – Measures Affecting the Cross-Border Supply of Gambling and Betting Services*, “Recourse by Antigua and Barbuda to Article 22.7 of the DSU, December 13, 2012 WT285/25.

<sup>1117</sup> *Ibid.*



Opposing arguments have also been advanced on the proposed non-use of transliterations and translations associated with a country's name.<sup>1118</sup> An instructive example of this follows. If enacted as a part of the revision to Article 6ter, it would be impermissible for a product which does not originate in Jamaica to use the French translation of Jamaica, "Jamaïque" as a trademark. The objective of the proposed draft amendment is to prevent the un-authorized usage of the name of a country, even if such a word, though spelt differently, has the same meaning as the country's name. Jamaica's original submissions, as well as subsequent submissions up to September 2014<sup>1119</sup> had included a provision for the invalidity of trademarks which have the same pronunciation as the name of a country. However, refusal amongst other member states with the expansiveness of the provision<sup>1120</sup> led Jamaica to revise its proposition to exclude the reference to the pronunciation of a country's name.

Jamaica's propositions are extensive, and if enacted as amendments to the Paris Convention, changes on certain levels the international terrain of what qualifies for trademark registration amongst members of the Paris Union. The major counter

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<sup>1118</sup> WIPO, Submission of Australia on the Draft Recommendation Concerning the Protection of Country Names, Australia submission, July 2014 (Available online, <http://www.wipo.int/export/sites/www/sct/en/comments/pdf/sct32/australia.pdf>, last accessed September 30, 2016). [WIPO, "Australia"]

<sup>1119</sup> WIPO, Submission by the Delegation of Jamaica, Standing Committee on the Law of Trademarks, Industrial Design and Geographical Indications, Thirty First session, Geneva; March 17-21 2014 (Available online at WIPO, [http://www.wipo.int/edocs/mdocs/sct/en/sct\\_31/sct\\_31\\_5.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_31/sct_31_5.pdf), last accessed September 30, 2016).

<sup>1120</sup> WIPO, Australia; Department of International Cooperation State Administration for Industry and Commerce, Comments by China on the Protection of Country Names, July 03, 2014, (Available online at WIPO, <http://www.wipo.int/export/sites/www/sct/en/comments/pdf/sct32/china.pdf>, last accessed September 30, 2016).

argument pertains to the responsibility of each government body to ensure that country names are not used on products, and opposition to the extent of coverage to transliterations and translations of country names as trademarks.

Notwithstanding these arguments, the intense debate over the legal protection of country names has publicized the issue to the international fora. I argue that this has facilitated an outlook of the brand “Jamaica” from a different perspective in international jurisdiction – a perspective which illustrates that Jamaica is cognizant of the value of its name as a brand, and has a keen interest in protecting it. The issue is not only central to Jamaica, as I have previously noted. Jamaica’s suggested amendments to the *Paris Convention* are also supported by some of its regional CARICOM<sup>1121</sup> members such as Antigua and Barbuda, and Barbados<sup>1122</sup> who have each made contributory pro-arguments on the issue.

The resulting contestations in the international IP fora from Jamaica’s arguments facilitate discussions on the debate’s effect on the country’s historical position as a passive repository of foreign IP laws and policies. I use the term passive repository to refer to the complacent role, and state of play which characterizes its approach to the

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<sup>1121</sup> CARICOM, The Caribbean Common Market, the regional body collectively representing the Caribbean in trade negotiations. As noted elsewhere in this thesis, there are 14 members of CARICOM all of which are countries in the Caribbean. These countries are Antigua and Barbuda, The Bahamas, Barbados, Belize, Dominica, Grenada, Guyana, Haiti, Jamaica, Monserrat, St. Lucia, St. Kitts and Nevis, St. Vincent and The Grenadines, Suriname and Trinidad and Tobago.

<sup>1122</sup> WIPO, Report – Standing Committee, Standing Committee on the Law of Trademarks, Industrial Design and Geographical Indications, 23<sup>rd</sup> Session, Geneva June 30 – July 2, 2010, SCT/23/7, Barbados’s arguments - para 99-108.

enactment, and enforcement of imperialistic IP laws. These laws are representationally skewed towards the protection of core based interests.<sup>1123</sup>

By reference to the interactions between Jamaica and the international IP community, the next section critiques whether Jamaica has attained a counterhegemonic status in the international law of intellectual property. I address this issue with specific reference to international geographical indication negotiations, domestic usage of geographical indication laws, involvement in international intellectual property norm setting forums, and the hegemon's perception of Jamaica's contribution to policy discussions. I have discussed these specific issues above, and will evaluate and critique the sufficiency of such participation or non-participation in identifying Jamaica as a proactive member of the international epistemic geographical indications community.

#### **7.4. Intellectual Property Counter-hegemony and Jamaica through GIs – International Interactions and Involvement**

Power imbalances between the core and the periphery, legal and capital constraints, an under-use of domestic intellectual property resources, and mis-directed intellectual property strategizing are serious shortfalls to Jamaica re-positioning its narrative through agricultural and food based geographical indications. However, envisioning favorable

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<sup>1123</sup> I made these arguments in Chapters 2 and 3; These points are also explicitly made, and inferred in Jamaica's submission to WIPO concerning the legal protection of country names, as an integral element in its nation brand development strategy: Report By Jamaica, Cases and Case Studies relevant to the Protection of Names of States and Information on our Nation Branding Strategy and Related Problems encountered in Implementation – "Limitations of Existing Intellectual Property System" at 29.

changes in intellectual property laws call for effective strategizing,<sup>1124</sup> and assertive engagements with key players in concerned epistemic communities. Constructive engagements by the Third World with the imperialistic nature of international law,<sup>1125</sup> demands targeting loopholes, and identifying other areas for strategic intervention in the operation of the law, for achievable reform. Furthermore, strategic coalition with key international actors is important as a means of forging, and advancing Jamaica's geographical indication policy perspectives. Jamaica's space in the international intellectual property order must elevate above its historical status of plunder<sup>1126</sup> and subordination to the rules of the west<sup>1127</sup> As asserted by Chimni,<sup>1128</sup> although the composition of imperialist states, and players have changed in the 21st century to include capitalist actors from the Third World, there is an urgent recognized need to engage with the international legal order.

As a means of identifying and illustrating the role and level of engagement by Jamaica in the international law of IP, I referred throughout this chapter to two international IP

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<sup>1124</sup> Obiora Okafor, Praxis and The International (Human Rights) Law Scholar: Towards the Intensification of Third World Dramaturgy, Keynote Address, TWAIL CAIRO conference, February 22, 2015.

<sup>1125</sup> Antony Anghie, The Evolution of International Law: Colonial and Postcolonial realities" (2006) 27:5 *Third World Quar* 739; Makua Matua, What is TWAIL?, Proceedings of the 94<sup>th</sup> Annual American International Law Association Meeting, "International Law in Ferment: A New Vision For Theory and Practice" April 5-8, 2000.

<sup>1126</sup> See Christopher Weeramantry, A Response to In the Wake of Empire, (1999) 14:6 *Am Univ Intl L* 1515. Weeramantry writes on the imbalances in international law and its effects on its application in the Third World.

<sup>1127</sup> On this point, see Chapter One on the foreign oriented base of Jamaica's intellectual property rights laws and policies.

<sup>1128</sup> Chimni, "*Capitalism, Imperialism and International Law*", *supra* note 1112.

debate forums. These forums are norm setting social structures,<sup>1129</sup> and have the capability of shaping and transforming ideas, influencing policy choices, and formulating laws and legal rules.<sup>1130</sup> The importance of forums such as WIPO's Standing Committees and the Lisbon Union negotiating body to the global IP community is illustrated in the influence of these bodies in setting debatable IP agendas. Through interaction and strategic alliances within these dominant groups, legal IP rules are either changed or reinforced into the global IP order, and become institutionalized as laws and practices.

Jamaica used none of these two international IP forums to advance the international reciprocal legal recognition of non-wine and spirit GIs. I argue that this is regrettable, and substantially irreconcilable with the proactive stance it has taken on negotiations concerning amendments to Article 6ter of the *Paris Convention*.<sup>1131</sup> Constructive

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<sup>1129</sup> WIPO has its origins in the Paris Convention of 1883 and the Berne Convention on for Literary Works in 1886. The organization was established to act as an international bureau or secretariat of the two treaties. In 1970 WIPO became a specialized governing intellectual property agency of the United Nations. There are various Standing Committees in WIPO, all formulated on the agency's mandate to promote the protection of IP globally, and to ensure administrative cooperation amongst IP Unions. The agency promotes norm setting agenda for all forms of IP, as instructively indicated by its registration system for the Madrid Protocol, Copyright and Patent rules in the Patent Cooperation Treaty and the Berne Convention for the Protection of Literary and Artistic works. See, Christopher May, "World Intellectual Property Rights Organization, Resurgence and the Development Agenda" (Taylor Francis Group: 2007); Ruth Okediji, "The WIPO-WTO Relations and the Future of Global Intellectual Property Norms" (2008) 39:1 *N YB of Intl L* 69.

<sup>1130</sup> David H. Bearce & Stacy Bondanella, Intergovernmental Organizations, Socialization, and Member State Interest Convergence. (2007) 61:4 *Intl O* 703. The authors 'empirical research illustrate that intergovernmental organizations are instrumental in the international socialization of norms, and that interactions between intergovernmental organizations and member states lead to a convergence of member states' interests.

<sup>1131</sup> See section immediately above, for a discussion on proposed changes to Article 6ter of the *Paris Convention* by Jamaica. Jamaica has also been active in supporting the recognition of traditional knowledge and traditional cultural expressions as instrumental intellectual property forms for the protection of domestic resources and talent, including its reggae music. See Government of Jamaica,

engagements with the global intellectual property community, and with trade partners on negotiating reciprocity in geographical indications recognition are integral enabling factors in envisaging geographical indications as an IP asset of development.

It is notable and commendable that there is a bilateral agreement between Jamaica and Switzerland for the legal recognition of geographical indications in both countries.<sup>1132</sup>

This is not surprising as Switzerland was instrumental in the enactment of Jamaica's GI legislation, providing technical assistance to Jamaica's intellectual property office in the formulation of the legislation and its regulation.<sup>1133</sup>

The bilateral geographical indication agreement enables the protection of Swiss GI products in Jamaica, and registered Jamaican geographical indication products in Switzerland.<sup>1134</sup> Switzerland clearly benefits from this agreement as it is the only contracting party to the agreement that has registered geographical indication products. I also assert that the agreement was negotiated and ratified as a means of protecting Swiss' GI brands in Jamaica. Under the agreement, a disproportionately more significant number of Swiss GIs are accorded protection compared to Jamaican products

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Jamaica Intellectual Property Office, Traditional Knowledge, Traditional Cultural Expressions and Genetic Resources, online at <http://www.jipo.gov.jm/node/90>).

<sup>1132</sup> Agreement on the Mutual Recognition and Protection of Geographical Indications between Jamaica and Switzerland (online, <http://www.admin.ch/opc/fr/classified-compilation/20132547/index.html>, last accessed January 17, 2015).

<sup>1133</sup> *Ibid.* The agreement itemizes 154 geographical indications Swiss products which are to be protected as GIs in Jamaica.

<sup>1134</sup> *Supra*, note 1084.

recognizable as geographical indications in Switzerland. I therefore exclude the bilateral geographical indication agreement between Switzerland and Jamaica as an indication of proactive negotiation, as it transpired from Switzerland's technical assistance involvement to Jamaica's geographical indication legislation.

Undoubtedly, a salient IP issue has been brought to the fore front of the global IP community by debates concerning the legal protection of country names against unauthorized commercial uses. This level of assertive IP negotiating stance is a first for Jamaica. Therefore, it represents a paradigmatic shift in an otherwise passive negotiating position. The interesting observation about this issue is that it reinforces arguments which I had previously made on the commercial motives influencing Jamaica's international IP engagements. An amendment to *Article 6ter* is a furtherance of trademark holders' rights. A perception of the rights to be protected as broad-based collective rights, and the development-oriented capabilities of geographical indications, would aggressively stimulate Jamaica's involvement in international GI negotiations, and norm setting forums. A re-orientation on the value of geographical indications amongst all key domestic stakeholders is required to change this historical trajectory.

Jamaica's limited but productive engagement with the international IP order is indicative of a progress which needs to be consistently practiced if it is to be sustained, and produce results. IP's epistemic communities are the bases for rule and policy formulations in the global IP narrative. Notwithstanding the ultimate outcome of Jamaica's proposals on amendments to *Article 6ter* of the *Paris Convention*, I argue these developments have

elevated its recognition, and negotiating position in WIPO. It is highly probable that should this pattern of dynamism in international engagements be continued by Jamaica, the country is more likely to attain a counterhegemonic stance amongst epistemic IP communities.<sup>1135</sup>

One of the imperative questions which this chapter sought to conduct a reasoned analysis of, is the effect of Jamaica's participation in the international IP community on re-positioning the country's passive status in rule making IP platforms. This analysis is necessary. Based on the current inconsistencies in the international law of GIs, countries with interest in advancing its legal reciprocity must approach the issue as a rule changing agenda, which demands a proactive stance on problematic issues. Jamaica needs to conceptualize agricultural and food based geographical indications as an IP asset of development, incapable of producing results unless there are international engagements with global intellectual property networks. The issue must first be recognized as an 'issue'. I argue that this has not been done. The emancipatory capabilities of GIs for Jamaica may not ensue if this paradigm continues. As such, the country runs the risk of continuing a trajectory of acting as a receptacle of GI laws which are unable to procure developmental oriented benefits.

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<sup>1135</sup> I refer to epistemic IP communities as influential networks in which legal rules and policy choices pertaining to intellectual property are formulated by dominant actors, and become institutionalized as norms and adapted as such globally. Example, I argue that the European Union IP body is an epistemic community. The standard form of its IP provisions are included in its Economic Partnership Agreement with the Caribbean. With specific reference to geographical indication legislation, these have been enacted in many Caribbean countries based on the EU model. As discussed in this chapter, World Intellectual Property Office Standing Committee is another instructive example of an IP epistemic community.



## 7.5. Chapter Summary

The chapter brings to the fore the salient concern of the level of Third World engagement with the core in fostering perspectives of geographical indications which are representational of Third World interests. The domestic registration of geographical indications is unable to advance or sustain its status as an IP asset of development. The lack of a consistent approach internationally in the protection and enforcement of geographical indications provide opportunities for two (2) areas of action.

Firstly, the current contentions on the international legal recognition of geographical indications can be used as an opportunity for countries to strategically target international consumer markets which reciprocally recognize GIs. This approach is more likely to be feasible for agricultural and food based geographical indications that are newly introduced into the consumer markets. Established products may have attained commercial presence in a consumer market in which there are difficulties in gaining similar and consistent consumer demands elsewhere. This is the problem with Jamaica's Blue Mountain coffee. Japan is the major consumer market for Jamaica's Blue Mountain coffee. Despite Japan's recent implementation of a *sui-generis* system for the protection of geographical indications, Jamaica is unable to utilize the legislation as there is no domestic registration of Blue Mountain coffee in Jamaica. Furthermore, it is commercially imprudent to switch focus to a jurisdiction which legally recognizes GIs solely on the basis of legal reciprocity; consumer demand must be present.

Secondly, the status of the international law of geographical indications should be used as an opportunity to reform the law through engagement with trade partners, treaties, and in global intellectual property right forums.

## **Chapter Eight: Summary and Recommendations**

### **8. Introduction**

In chapter 7, I conducted a critical analysis of Jamaica's engagement in international intellectual property forums and networks, and suggested that the country should proactively interact with international intellectual property communities.

Chapter 8 is a summary of the main arguments evoked in the thesis, and makes policy recommendations on Jamaica's approach in interacting with sectors and jurisdictions which recognize geographical indications as certification or collective marks. The chapter also discusses that Jamaica and the Caribbean should be cautious in its intellectual property alliances with the European Union and other intellectual property imperial powers, to prevent an overshadowing of its own GI policy by that of more dominant international actors. In furtherance of this point, I also suggest that a more proactive role should be played by CARICOM,<sup>1136</sup> in building a strong regional intellectual property body that aligns its focus with representing each member country's geographical indications and related interests.

I began the research with the objective of identifying workable intellectual property frameworks and policy for Third World countries such as Jamaica and other territories in

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<sup>1136</sup> The Caribbean Community, a regional body for trade and the advancement of specific social and economic issues amongst 15 Caribbean countries. These 15 Caribbean countries are Jamaica, Barbados, Bahamas, St. Kitts and Nevis, Antigua and Barbuda, Dominica, Trinidad and Tobago, St. Vincent and the Grenadines, Haiti, Montserrat, Belize and Suriname.

the Caribbean region. Agricultural and food based geographical indications are positioned throughout the thesis as a counter-hegemonic form of intellectual property for Jamaica and the Caribbean. The Caribbean region is rich in agricultural resources, as well as the by-products of these resources. Instructive examples of the Caribbean region's agricultural resources include St. Vincent and the Grenadines nutmeg, and Guyana's Demerara sugar, both of which are well-known throughout the Caribbean and beyond.<sup>1137</sup>

At the risk of launching into the impossible task for a thesis because of the breadth and differences in meaning and implications, I sought to limit but espouse the general problem with the dominant forms of intellectual property right in Jamaica. This exposition was necessary to illustrate the politics behind the conception of intellectual property right, the actors which create and influence these interests, and the resulting issues it produces for Jamaica.

I have argued that a geographical indication is not a legislation that is capable of effecting favorable changes in the politics of intellectual property for the Caribbean without incorporating an IP approach that envisages agricultural and food based GIs as assets. As TWAIL emphasizes, a participatory approach to international law by Third World peoples is more likely to effect changes in representational interests. To envision

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<sup>1137</sup> Caribbean Agri-Business, (Available online at AgriCarib,<http://www.agricarib.org/primary-dropdown/other-condiments-and-spices>); Ravi Dev, "Geographical Indications and Demerara Sugar" Kaieteur News, (Available online at, <http://www.kaieteurnews.com/2013/06/30/geographical-indications-and-demerara-sugar/>).

this approach as workable development policy, implicates specific local and international ‘enabling’ factors which I discussed throughout the chapters.

The following factors are included in this approach, (i) growing and sustained interest by dominant stakeholders in the continued production of the agricultural and food based product. The Blue Mountain coffee case study illustrates that there is government interest in sustaining the brand, but there is insufficient interest in changing from a “brand development” approach to a ‘people development approach; (ii) effective governance of GI producer groups, allowing for transparency in decision making, and in the administration of geographical indication schemes; (iii) involvement of grass roots representation in producer groups. A content analysis of the Blue Mountain coffee case study indicates that a viable GI scheme must include active involvement by small farmers and under- employed or un- employed women, who reside in, or within close proximity to cultivation zones that can benefit from the program through entrepreneurial tourist related ventures, (iv) legal reciprocity in agricultural and food based geographical indications recognition, (v) more meaningful local and regional engagements in international intellectual property forums (vi) commercial growth strategies that focus on increasing market share in consumer jurisdictions (vii) a government body that works together with the producer group in identifying and developing new (GI protected) markets as a growth strategies, and (viii) a vibrant and responsive legal infrastructure that is willing and has the capacity to deal with infringements and promotion of GI brands. In Jamaica, financial resources are not readily available for most projects.

Jamaica's budget is heavily constrained by a large external debt burden. This debt burden has limited, either by choice or of necessity, amounts allocated in protecting the Blue Mountain coffee trademark in international jurisdictions. Jamaica's outlook on intellectual property needs to change to an appreciation of how a broad-based approach to fostering lucrative and potentially lucrative GI based schemes may be cataclysmic to socio-economic gains for many key stakeholders.

I also argued in Chapter 7 that strategic alliances with international intellectual property networks are salient to changing the domestic relevance and benefits of GIs to Jamaica and the Caribbean.

The rest of this chapter deals with a policy approach that I identify as essential points of engagement in successfully positioning geographical indications as intellectual property assets for Jamaican peoples, and as such as development policy. This also brings to the fore a focus on exploiting GIs internationally, and using legal based 'swot analysis' to influence commercial practices, legal frameworks and approaches to local geographical governance.

### **8.1. Choosing Geographical Indication Pathways: Plan and Action in Geographical Indication Strategizing.**

The Blue Mountain coffee research illustrated that not all products should be registered as geographical indications. It is imprudent to register an agricultural and food based product as a geographical indication without any or very minute prospects of Jamaican and Caribbean peoples benefiting from the affiliation of the product with intellectual property. I argue that an analysis of the strengths, weaknesses, opportunities and threats

of each product's viability as a GI should be an integral first step approach to the workability of each program. Such an approach must involve critical evaluations of which stakeholders are implicated in the registration, operation and development of the product. The goal must be to involve as many marginalized key stakeholders as possible in the geographical indications scheme, through a participatory oriented producer group.

Geographical indications producer groups should not be stagnant bodies resistant to prudent policy choices or administrative changes. If amendments facilitate greater opportunities of socio-economic gains for small farmers and other key stakeholders implicated in the production and commercialization of the product, policy adoption is to be encouraged. Plans which lessen cultivation costs and increase international market penetration opportunities are examples of strategic choices built on small farmer development; these represent sound GI pathway choices.

Local elite representation in businesses and business development plans is very popular in Jamaica. This paradigm is unable to support the propositions which I have made throughout the thesis concerning geographical indication strategizing. It is recommended that grass root representation in any geographical indication producer group be encouraged. This is more likely to influence actor identities and interests that influence power imbalances in the uses (and non-use) of intellectual property right. I acknowledge that there are complex social, economic and political dynamics in the composition and interaction of Jamaican peoples that may not be amenable to a more bottom up approach to GI asset management. However, greater and meaningful government and/or interest

groups involvement in publicizing the broad-based advantages of local agri and food based GIs may assist in counteracting this issue. Seminars, training and workshop sessions to farmers and other key stakeholders is an avenue for building interests and involvement by a wider cross section of actors in geographical indication schemes.

## **8.2. Opportunity for CARICOM<sup>1138</sup> to promote a Regional Geographical Indication Alliance**

The CARICOM Secretariat has several objectives, two of which I identify as impetus for regional engagement with agricultural and food based geographical indications on an international level. The expansion of trade and economic relations with third states, and enhancing the competitiveness of Caribbean countries are two of CARICOMs' objectives.

Coordinating geographical indication rules and policies in each Caribbean country to build uniformity in the region's approach to agricultural and food based GIs is a sound policy measure. As such, exchanging ideas on approaches to GI schemes, and experiences in international trademark and geographical indication jurisdictions can be envisaged as learning points for each member state in engagements with international actors.

I argue that a Caribbean regional geographical indication alliance is also likely to lessen each country's failures in geographical indication schemes. Caribbean alliance through CARICOM is also helpful in international treaty negotiations as it creates more

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substantial bargaining leverages in intellectual property right forums. This is less likely to ensue if a small island state negotiates on its own for enhanced geographical indication rights. The place for and role of Cuba, as a Caribbean country with emerging interest to the west must also be critically analyzed in CARICOM, in the context of geographical indications and intellectual property right generally. This point is beyond the scope of this chapter and the thesis, but is notable. Cuba is the only Caribbean country that is a member of the *Lisbon Agreement*. It is likely that the Lisbon Agreement's recent recognition of geographical indications as protectable rights will increase Caribbean countries interest in joining the treaty.

In the final section of this summary and policy based chapter of the thesis, I suggest practical approaches for Jamaica and the Caribbean in engaging with jurisdictions that do not protect agricultural and food based geographical indications as distinct rights.

### **8.3. Countering the Non-Recognition of Agricultural and Food-based Geographical Indications in International Jurisdictions.**

In chapters 3 and 4, I discussed the unwillingness of the United States to recognize enhanced rights for agricultural and food based geographical indications. The United States is a growing consumer market for Jamaica's Blue Mountain coffee. In the United States, protection is extended to geographical indications through its trademark laws, common law or tariff provisions. In creating linkages between geographical indications and development, a critical legal question is how best to frame legal and market approaches in the commercialization of geographical indication products in non-reciprocal countries. I recommend two approaches which I discuss below.

Investment in a legal infrastructure which prioritizes the development of local forms of intellectual property right is beneficial for Jamaica. Fostering community knowledge on geographical indications is important, as well as its impact and affiliation with agricultural development. Critical cultural and scientific queries on domestic products that are protectable, and building awareness and understanding of Jamaica's geographical indications law are vital steps in this approach. The type of knowledge that is disseminated about geographical indications is important, as a strong focus on brand development may encourage more elite representation, and lessen the ability of marginalized key stakeholders in participating in a GI scheme. Government should also identify and apply best approaches in aligning geographical development strategies with the United Nations Sustainable Development Goals (SDG). An approach that engages with how best to develop GIs by using SDG targets related to the promotion of economic growth, full and productive employment should be explored.

Furthermore, a counter hegemonic approach to intellectual property right in Third World countries includes a commitment to proactive defences of geographical indications in international jurisdiction. I acknowledge that this is challenging for Jamaica because of its economic constraints. However, I suggest that Jamaica should focus on forging strong legal defences against infringements of key geographical indications that are either established or, has strong prospects of becoming established in major international markets.

Therefore, my argument suggests a selective approach to infringement challenges in consumer markets. This approach is especially important in mitigating infringements in the United States. A Blue Mountain coffee IP strategy for the United States should be cognizant of the limitations of Jamaica's domestic GI protection in protecting the product on a similar intellectual property level in this jurisdiction. The quality, pricing and international popularity of Blue Mountain coffee are indicators which should inform Jamaica's approach in using financial resources in defence of the trademark in the United States.

In chapter 6, I addressed the benefits of a representative producer group. I also discussed the benefits of a participatory GI scheme in which stakeholder involvement is grouped focused, and geared towards broad based socio-economic gains for a wide cross section of stakeholders. I now implicate the Jamaican diaspora into the policy recommendation as a group which should be targeted in identifying geographical indication infringements in international markets. Jamaica now recognizes its diaspora community as an important part of its development based on their economic contributions to its economy.<sup>1139</sup> The country had its 6<sup>th</sup> biennial diaspora conference in June 2015.<sup>1140</sup> Campaigns which focus on the diaspora's identification and reporting of infringement in the United States and

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<sup>1139</sup> Keith Nurse & Claremont Kirton, Caribbean Entrepreneurship Diasporic Analytic Report, UWI, 2014 (Available online, [https://www.academia.edu/12370251/Caribbean\\_Diasporic\\_Entrepreneurship](https://www.academia.edu/12370251/Caribbean_Diasporic_Entrepreneurship), last accessed September 30, 2016).

<sup>1140</sup> Jamaica Diaspora Conference (Available online at: <http://jamaicadiasporaconnect.com/conference/6th-biennial-diaspora-conference-2015>, last accessed September 30, 2016).

other international jurisdictions, is a cost saving mechanism that can be incorporated into Jamaica's international GI policy.<sup>1141</sup>

### **8.1. Conclusion – Further Research**

The thesis sought to critically analyze global imperial influences in, and opportunities for a functional approach to intellectual property rights in Jamaica and the Caribbean. Further research needs to be done on the actual impact and contribution of geographical indications to different sectors of communities and industries in the Caribbean region. This is impossible without medium to long term usage of the legislation in domestic Caribbean jurisdictions. My contribution to the field is only a starting point on an 'emancipatory' quest to attain counter hegemony in Jamaica, and the Caribbean's region intellectual property narrative. I emphasize a critical point, that Jamaica must focus squarely on effective use of its GI legislation, to prevent the systemic usage of its legislation for the advancement of western imperial and local elite proprietary rights.

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<sup>1141</sup> Prakash Shah writes an interesting article on the diaspora as legal actors and the implications of this notion for the state. Although the article is focused on criminal and civil matters, it is not logically remote to extend this reasoning to the involvement of Third World diaspora in IP infringement allegations against their home countries brands. In this reasoning, I argue that the diaspora should be incentivized to report suspicious use of GI and trademarked brands which may be classified as acts of infringements against the brands. Prakash Shah, "Diasporas as Legal Actors: Implications for Established Legal Boundaries" (2005) 5:2 *Non-State Actors & Intl L*153.

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## **Appendix A – Interview Guide**

### **Blue Mountain Coffee Farmers**

- i. Are there challenges associated with coffee cultivation? If so, what type of challenges do you experience in getting your crop to the market?
- ii. Do you receive sufficient income from your Blue Mountain coffee farming activities?
- iii. How would you describe your socio-economic position now compared to when you started in the industry?
- iv. Is technical and financial help important in Blue Mountain coffee cultivation?
- v. How would you describe your relationship with the Coffee Industry Board?
- vi. Are you a member of a coffee farmers' association?
- vii. What experiences have you had in dealings with a coffee farmers' association?
- viii. Are you familiar with geographical indications?
- iv. How do you obtain fertilizers for your crop?
- x. What is the size of your coffee holdings?
- xi. If the current problems with coffee farming persist, will you continue cultivating Blue Mountain coffee?
- xii. Are there any infrastructural challenges in transporting coffee to processing plants?

**B. Coffee Industry Board:**

- i. What process is involved in the certification of Blue Mountain Coffee?
- ii. What type of licensing procedures are required for farmers interested in selling coffee as coffee dealers?
- iii. Is advisory assistance provided to Blue Mountain coffee farmers?
- iv. What types of pre-and post- harvest assistance is provided to Blue Mountain Coffee farmers?
- v. How are certification procedures developed?
- vi. Does the Board have interest in geographical indications?
- vii. What types of legal challenges exist in maintaining Blue Mountain Coffee as a distinct brand?
- viii. What is the contribution of Blue Mountain coffee to Jamaica's Gross Domestic Product?

**C. Jamaica Intellectual Property Office:**

- i. What type of procedures were involved in identifying Blue Mountain coffee as GI registrable?
- ii. Is the Jamaica Intellectual Property Office involved in international and/or regional/bilateral negotiations, conferences and seminars related to geographical indications?



- iii. Do you have knowledge of the interest and willingness of potential ‘producer groups’ in participating in a geographical indication scheme?
- iv. Would the GI scheme to be managed by the government, or by designated a producer group?
- v. Will there be a separate intellectual property department responsible for registration, monitoring and regulation of Blue Mountain coffee including defending infringement in foreign markets, or would this remain under the jurisdiction of the Coffee Industry Board?

**Government Officials**

- i. Is Jamaica involved in negotiations of bilateral/regional free trade agreements and bilateral IP treaties with any country or region?
- ii. What was the nature of Jamaica’s involvement in the Doha Round of negotiations concerning enhanced protection for geographical indications?
- iii. Is the Caribbean involved in any international intellectual property proceedings (including negotiations) pertaining to the safeguard of geographical indication rights?