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# CETA and the Future of Geographical Indications Protection in Canada

Bassem Awad and Marsha S. Cadogan

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Bassem, a specialist in IP law, has served as a judge at the Appeal Court in Egypt and Abu Dhabi in the United Arab Emirates. He has also been working for several years as a consultant for the African Union on IP topics. He is a head tutor for the Academy of the World Intellectual Property Organization and an instructor with the Institute for Training and Technical Co-operation at the World Trade Organization. He teaches advanced courses on IP rights at the Western University Faculty of Law.

Bassem holds Ph.D. and LL.M. degrees in IP from the University of Montpellier in France, and an LL.M. in international business law from L'Université Paris 1 Panthéon-Sorbonne. His research interests include copyright law, patent law, comparative IP and the management of IP rights.

Marsha S. Cadogan is a post-doctoral fellow with CIGI's ILRP. Her research at CIGI is focused on the interrelationship between geographical indications (GIs) and trademark laws, as well as the global implications of GIs in preferential free trade agreements.

Marsha's broader research interests are in IP rights and international trade, IP rights and innovation, and international law and development in a global context. Marsha's expertise is multi-jurisdictional and includes the IP jurisdictions of the European Union, the United States, Switzerland, Japan, Canada and the Caribbean.

Prior to becoming a post-doctoral fellow, Marsha contributed to CIGI's ILRP as a research assistant, co-planning workshops and writing her forthcoming paper on influencing the global state of play through GIs. Marsha taught legal research and writing at Osgoode Hall Law School, York University, for several years before joining the ILRP. She has a bachelor of science, economics and management from the University of the West Indies (Jamaica), an LL.B. from Kings College at the University of London (England) and an LL.M. and a Ph.D. in IP rights law from Osgoode Hall Law School. Marsha is a member of the board for Canada's International Law Association and is also a barrister and solicitor with the Law Society of Upper Canada.

# About the International Law Research Program

The International Law Research Program (ILRP) at CIGI is an integrated multidisciplinary research program that provides leading academics, government and private sector legal experts, as well as students from Canada and abroad, with the opportunity to contribute to advancements in international law.

The ILRP strives to be the world's leading international law research program, with recognized impact on how international law is brought to bear on significant global issues. The program's mission is to connect knowledge, policy and practice to build the international law framework — the globalized rule of law — to support international governance of the future. Its founding belief is that better international governance, including a strengthened international law framework, can improve the lives of people everywhere, increase prosperity, ensure global sustainability, address inequality, safeguard human rights and promote a more secure world.

The ILRP focuses on the areas of international law that are most important to global innovation, prosperity and sustainability: international economic law, international intellectual property law and international environmental law. In its research, the ILRP is attentive to the emerging interactions between international and transnational law, Indigenous law and constitutional law.

# Acronyms and Abbreviations

| | |
|---|---|
| CETA | Comprehensive Economic and Trade Agreement |
| GIs | geographical indications |
| IP | intellectual property |
| NAFTA | North American Free Trade Agreement |
| TPP | Trans-Pacific Partnership Agreement |
| TRIPS | Trade-Related Aspects of Intellectual Property Rights |
| TTIP | Transatlantic Trade and Investment Partnership |
| WIPO | World Intellectual Property Organization |
| WTO | World Trade Organization |

# Executive Summary

In recent years, preferential trade agreements have had a major impact on the direction of rules in the domestic intellectual property (IP) landscape. Contestation over the legal recognition of geographical indications (GIs) has been at the centre of discussion among global IP players. A GI is a sign that indicates a product is from a specific geographic area, which may be a country, a region or a locality, and that the product has distinct qualities, a reputation or characteristics that are directly traceable to its geographic origin. This paper provides a brief history of the international legal recognition of GIs, discusses the rationale for the protection of GIs and critically analyzes the treatment of GIs in two significant preferential trade agreements involving Canada, the Comprehensive Economic and Trade Agreement (CETA) and the now-halted Trans-Pacific Partnership Agreement (TPP), which may constitute the foundations of a renegotiated North American Free Trade Agreement (NAFTA). The paper argues that although GIs are soon to be protected in Canada under proposed amendments to the Trade-marks Act (Bill C-30), there are still gaps in the legislation that may affect the ability of foreign and domestic GI rights holders to register their products. The proposed changes to the Trade-marks Act will enact CETA's provisions on GIs and trademarks into domestic law. However, much of the agreement favours European-based GIs and provides fewer benefits for domestic rights holders.

# Introduction

The law of GIs is contentious and, yet, appealing to jurisdictions that have an interest in protecting place-based goods beyond the traditional forms of IP protection.[1] A GI is a sign that indicates a product is from a specific geographic area and that there are distinct qualities, a reputation or characteristics about the product that are directly traceable to its geographic origin.[2] Examples of GIs include basmati for certain aromatic rice from India and Pakistan; Tuscany for olive oil produced in a specific area of Italy; Habana for tobaccos from Havana, Cuba; and Kobe for beef from Japan. The concept of a GI as an IP right is derived from the strong relationship between the product's characteristics and its place of origin. The law associated with GIs is related to the product-place concept, but is separate, as it either justifies the use of legal means of protecting place-based products or seeks to reduce the recognition of such rights. Some jurisdictions have used the law to protect place-based products, while other jurisdictions seek to reduce the recognition of the law to prevent its expansiveness. The commercial appeal of a GI is in the ability to differentiate GI-designated products from the products of competitors through place-based branding. Product differentiation also enables consumers to make informed product choices based on production practices and quality standards, attributes that are highly regarded in the production of GI goods. GI products undergo quality certification procedures and are subjected to sustainability measures that include environmental, socio-economic and innovation practices.[3]

This paper discusses the international dimensions of GIs, specifically non-wine and spirit indications. This is a developing area of law for both emerging economies and developed countries, such as Canada, but is resisted by the United States, an

1 Tesh Dagne, "Beyond Economic Considerations: (Re)Conceptualizing Geographical Indications for Protecting Traditional Agricultural Products" (2015) 46:6 Intl Rev Intell Prop Comp L 682; Angela Treagar et al, "Regional Foods and Rural Development" (2007) 23:1 J Rural Stud 12; JS Canada & A Vazquez, "Quality Certification, Institutions, and Innovation in Local Agro-food Systems" (2005) 21 J Rural Stud 475.

2 *Agreement on Trade-Related Aspects of Intellectual Property Rights*, 15 April 1994, 1869 UNTS 299, 33 ILM 1197, art 22.1 [*TRIPS* Agreement]; Treagar et al, *supra* note 1. Canada & Vazquez, *supra* note 1. Marsha A Echols, "The Geographical Indications Disputes at the WTO" in *Geographical Indications for Food Products, International Legal and Regulatory Perspectives* (Alphen aan den Rijn, Netherlands: Kluwer Law International, 2008).

3 As an example, EU Common Agricultural Policy Reform 2014–2020 buttresses GI industries by providing financial aid, training and innovation programs to farmers and restructuring measures to enhance the competitiveness of GI and appellation of origin industries. EC, "Overview of CAP Reform 2014–2010" (2013) European Union Agricultural Policy Perspectives Brief No 5 [EC, "Overview"], online: <http://ec.europa.eu/agriculture/sites/agriculture/files/policy-perspectives/policy-briefs/05_en.pdf>.

influential player in the global IP order.[4] In situating the discussion, this paper provides an historical overview of the development of GI rules from a national rule on product quality to a regional European regulation governing product innovations and economic development, a multilateral standard of protection and the current trends of inclusion in preferential free trade agreements. The twenty-first century has witnessed developments in GI rules in the World Trade Organization (WTO) and, more recently, by preferential free trade agreements that have either led to their recognition in domestic jurisdictions or have led to moves to stymie jurisdictions' interests in the legislation.

While acknowledging that the TPP[5] may not go forward in its original form or with its original parties, the paper discusses the TPP's provisions regarding GIs and related provisions to illustrate the restrictive approach that the United States, as a global IP player, and other countries might adopt regarding GI-designated products. It is highly possible that, in the future, the parties to preferential trade agreements, led by the United States (such as in a renegotiated NAFTA[6]), may continue to try to restrict the recognition of GIs. Another recent important development is the amendment of an international IP instrument, the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (Lisbon Agreement), which is administered by the World Intellectual Property Organization (WIPO), to recognize broad-based rights for GIs.[7] Prior to these amendments to the Lisbon Agreement in May 2015,[8] the international treaty represented a commitment among 28 member countries to provide legal recognition for appellations of origin among member countries. Now expanded to include GIs,[9] the Lisbon Agreement presents an appealing opportunity for countries that have an interest in GIs, but a contentious horizon for countries opposed to advancements in GI rights. Following the discussion of the history of and rationale for the legal recognition of GIs, the paper critically examines Canada's legal approach to place-oriented products under the Trade-marks Act[10] and potential conflicts of its legislation with CETA's[11] GI obligations. The proposed changes to the Trade-marks Act will bring into force in Canada the protection of EU-based GIs and make possible the registration of qualified domestic products as GIs.

4 Two other countries that oppose enhanced protection for GIs, although not to the same extent as the United States, are Australia and New Zealand. The United States is a notable opponent to GI extensions and was influential in the framing of the TPP's restrictive rules on GIs. Laura Puccio, "EU-US Negotiations on TTIP: A Survey of Current Issues" In-Depth Analysis, European Parliamentary Research Service, June 2015, Document number PE 586.606; Valdim Mandrov, *European Union Law on Indications of Geographical Origin* (New York, NY: Springer, 2014); Justin Malbon et al, *The WTO Agreement on Trade Related Aspects of Intellectual Property Rights: A Commentary* (Cheltenham, UK: Elgar Publishing, 2014) 327–82.

5 *TPP*, 4 February 2016, online: Global Affairs Canada <www.international.gc.ca/trade-agreements-accords-commerciaux/agr-acc/tpp-ptp/text-texte/toc-tdm.aspx?lang=eng>.

6 *North American Free Trade Agreement Between the Government of Canada, the Government of Mexico and the Government of the United States*, 17 December 1992, Can TS 1994 No 2, 32 ILM 289, 605 (entered into force 1 January 1994) [*NAFTA*].

7 *Lisbon Agreement*, 31 October 1958, online: WIPO <www.wipo.int/lisbon/en/legal_texts/lisbon_agreement.html>, provides protection for appellations of origin, that is, 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 geographic environment, including natural and human factors" (article 2).While the entire production of an appellation of origin product takes place within a specific territory, products that have at least one production step taking place within a specified territorial zone can be classified as GIs.

8 *Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications*, as adopted on 20 May 2015, WIPO [*Geneva Act*].

9 *Ibid*, art 6: "Upon receipt of an application for the international registration of an appellation of origin or a geographical indication in due form, as specified in the Regulations, the International Bureau shall register the geographical indication, in the International Register." Note *ibid*, art 8, which states that the duration of the international registration of a geographical indication is indefinite: "International registrations shall be valid indefinitely, on the understanding that the protection of a registered appellation of origin or geographical indication shall no longer be required if the denomination constituting the appellation of origin, or the indication constituting the geographical indication, is no longer protected in the Contracting Party of Origin."

10 RSC 1985, c T-13.

11 *Comprehensive Economic and Trade Agreement between Canada, of the one part, and the European Union [and its Member States...]*, 29 February 2016 [*CETA*], online: <http://trade.ec.europa.eu/doclib/docs/2016/february/tradoc_154329.pdf>.

# History of and Rationale for the Protection of GIs

While the concept of multilateral protection of GIs emerged from the negotiations for the TRIPS Agreement,[12] the GIs originated in France as a form of IP to prevent the usurpation of the reputations of French wines in consumer markets and to promote quality standards in wine production.[13]

A number of early treaties had varying levels of protection for place-based goods. The Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods,[14] a treaty that France negotiated in 1891, contains safeguards against the use of false or deceptive indications of source from member countries. The term "GI" is derived from the law related to appellations of origin. With its initial emergence in the French Law of 1 August 1905,[15] the law related to appellations of origin was later amended in 1919 and 1935 to ensure that products complied with specific technical standards. No definition was provided for appellations of origin until 1966, when further amendments to the French law defined 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."[16] The Paris Convention for the Protection of Industrial Property (Paris Convention) was the first international treaty to protect appellations of origin by treating infringements as acts of unfair competition.[17]

In the mid-twentieth century, another international treaty, the Lisbon Agreement, was established solely for the purpose of protecting appellations of origin. The Lisbon Agreement provided reciprocal recognition of appellations of origin to its 11 initial contracting parties.[18] Beginning in the mid 1970s and as a result of pressure from European countries, WIPO started negotiations on increasing the level of protection for appellations of origins. The process was duplicative of similar proceedings ongoing in the Paris Union and was aborted by 1980.

Conflicts between countries over the extent of protection accorded to place-based goods were evident as early as the 1970s in WIPO and Paris Union debates concerning appellations of origin.[19] In the Paris Union debates, negotiations to increase protection levels for appellations of origin included the suggestion of an allowance for developing countries to reserve rights in 200 product names by providing notification to the International Bureau of WIPO.[20] It was suggested that the products would be protected for 20 years within Paris Union member states.[21] Over time, the proposed number of names that developing countries could reserve was reduced from 200 to 10. Paris Union negotiations were unsuccessful; a uniform consensus on rules governing place-based goods was never reached.

The 1990s pre-TRIPS era once again saw debates regarding the protection of appellations of origin surfacing in WIPO debates with no success.[22] The term "geographical indication" was adopted in the

12 *TRIPS* Agreement, *supra* note 2.

13 J Thomas McCarthy & Veronica Colby Devitt, "Protection of Geographical Denominations, Domestic and International" (1979) 69 TMR 16. Dev Gangjee, *Relocating the Law of Geographical Indications* (Cambridge, UK: Cambridge University Press, 2012).

14 14 April 1891, online: WIPO <www.wipo.int/treaties/en/text.jsp?file_id=286779>.

15 JO, 5 August 1905.

16 WIPO, "Industrial Property: Monthly Review of the United International Bureaux for the Protection of Intellectual Property" (October 1966) at 231, online: <www.wipo.int/edocs/pubdocs/en/intproperty/120/wipo_pub_120_1966_10.pdf>.

17 *Paris Convention*, 14 July 1967, 828 UNTS 305, 21 UST 1583, art 1(2) (entered into force 26 April 1970), online: WIPO <www.wipo.int/wipolex/en/treaties/text.jsp?file_id=287556>. See Carlos M Correa, *Trade Related Aspects of Intellectual Property Rights: A Commentary on the TRIPS Agreement* (New York, NY: Oxford University Press, 2007) at 209–17.

18 *Lisbon Agreement*, *supra* note 7. Countries that signed the agreement in the 1960s and 1970s were Algeria, Bulgaria, Burkina Faso, Congo, Cuba, France, Gabon, Hungary, Italy and Tunisia. The Lisbon Agreement was, and still is, limited in its functionality by low membership numbers. The Lisbon Agreement was amended over time to include a definition for appellations of origin and to a provide wider scope of protection.

19 WIPO, Committee of Experts on the International Protection of Geographical Indications, First Session, "The Need for a New Treaty and Its Possible Contents" (1990) Memorandum Prepared by the International Bureau, GEO/CE/1/2 [Committee of Experts, First Session], online: <www.wipo.int/mdocsarchives/GEO_CE_I/GEO_CE_I_2_E.pdf>.

20 WIPO, Committee of Experts on the International Protection of Appellations of Origins and Indications of Source, Second Session, "Revision of the Lisbon Agreement or Conclusion of a New Treaty" (1975) Report Prepared by the International Bureau, TAO/II/3, online: <www.wipo.int/mdocsarchives/TAO_II_75/TAO_II_3_E.pdf>.

21 *Ibid*. WIPO, Diplomatic Conference for the Revision of the Paris Convention, PR/DC/51. See also WIPO, Diplomatic Conference for the Revision of the Paris Convention, Second Session, "Observations from Organizations on the Basic Proposals" (1981) PR/DC/7, online: <www.wipo.int/mdocsarchives/PR_DC_1%20to%2020_1980/PR_DC_7%20Add%209_E.pdf>.

22 Committee of Experts, First Session, *supra* note 19.

TRIPS Agreement to represent appellations of origin and indications of source.[23] The TRIPS Agreement creates a two-tiered system of protection for GIs based on the nature of the product that is protected.[24] Wine and spirit GIs are favoured in the TRIPS Agreement and are protected against wide-ranging infringements in WTO-member countries.[25]

The TRIPS Agreement stipulates a lower standard of protection for GIs that are neither wine nor spirits products. As such, agricultural, food-based, forestry, fisheries and crafted products[26] may be recognized as GIs, but are only protected against infringements in two circumstances. First, WTO members are tasked with implementing procedures to prevent acts of unfair competition against non-wine and spirit forms of GIs.[27] Second, member states should ensure that non-GI products are not suggestive of a geographic area in a manner that misleads the public regarding the area of the products' true origin.[28] The minimum standard of protection for non-wine and spirit GIs results in various legal means of safeguarding GIs internationally.[29] Examples of non-wine and spirit GIs include diverse products such as Moroccan oil, which is produced from the Argan tree in Morocco;[30] Colombia's coffee, Café de Colombia, which is grown and produced in specific areas of Colombia; feta cheese from Greece; and Parma ham from Italy.

# The Development of Legal Protection for GIs around the World

Under the TRIPS Agreement, wine and spirit GIs are extensively protected against wide-ranging infringements. However, the international community is deeply divided over the appropriate level of GI protection for agricultural, food-based, forestry, fisheries and crafted products. The European Union considers the non-wine and spirit forms of GIs as one of Europe's greatest assets that should receive extensive protection. The United States is generally opposed to strengthening GIs beyond the minimum TRIPS Agreement standards, claiming substantial relabelling costs and fallouts with its trademark industry as the main deterrents.[31]

The conflicts of interest between the European Union and the United States was obvious in the Doha Round of trade negotiations among the WTO members and subsequent efforts to globally increase standards of protection for non-wine and spirit GIs. Responses to the European Union's quest for recognition and protection of those GIs was met by strong opposition from the United States.[32] The United States is strongly opposed to higher standards of protection for non-wine and spirit GIs, as they are seen as a fundamental threat to the United States' vibrant trademark industry.[33] The difference in legal outlook on GIs between the European Union and the United States was well illustrated in the failed Doha Round negotiations, in the GI provisions of the TPP and in recent negotiations regarding the Transatlantic Trade and Investment Partnership (TTIP)[34] agreement.

At the Doha Round, the European Union was dissatisfied with the level of WTO protection

23 An indication of source is a product designation that indicates by illustration or display (on the product) the source of the goods. Therefore, all registered trademarks are indications of source as they indicate, by branding, the source of the good.

24 See Lisa P Lukose, "Rationale and Prospects of the Protection of Geographical Indication: An Inquiry" (2007) 12 J Intell Prop Rts 217; David Vivas-Eugui & Christophe Spennemann, "The Treatment of Geographical Indications in Recent WTO Discussions and in Regional and Bilateral Agreements" (2006), online: International Centre for Trade and Sustainable Development <www.ictsd.org/downloads/2009/01/gis20dv2020cs20rev2020sa20dialogue-pdf.pdf>.

25 *TRIPS* Agreement, *supra* note 2, art 23.

26 Referred to in this paper as non-wine and spirit forms of GIs.

27 *TRIPS* Agreement, *supra* note 2, art 22.2.

28 *Ibid*, art 22.1.

29 Michael Blakeney, ed, *Geographical Indications*, vol 1 (Cheltenham, UK: Edward Elgar Publishing, 2015).

30 The Argan is a famous tree that grows only in the semi-desert Sous Valley of southwest Morocco and the Algerian region of Tindouf in the western Mediterranean region. The Argan tree lives up to 150 to 200 years and acts as a foundation species for more than 1,200 other species of plants and animals in the ecoregion.

31 See Christine Haight Farley, "Conflict between US Law and International Treaties concerning Geographical Indications" (2000) 22 Whittier L Rev 73.

32 Echols, *supra* note 2.

33 Puccio, *supra* note 4.

34 Online: European Commission <http://ec.europa.eu/trade/policy/in-focus/ttip/>.

available for non-wine and spirit GIs.[35] Its proposals during the Doha Round of negotiations on the expansion of GI rights were all geared toward achieving safeguards for GIs similar to those provided by article 23.1 of the TRIPS Agreement, a provision that deals with wine and spirit GIs.[36] In a situation that was similar to the pre-TRIPS Agreement negotiations on GIs that ended in an impasse, after four years, the Doha Round parties were unable to reach a consensus on the expansion of GI rights.

Conflicting paradigms on GIs have also surfaced in TTIP negotiations, a forum in which the European Union seeks to safeguard its GIs, much to the discontent of the United States.[37] With the two parties having divergent views on the precise legal significance of GIs, it is unlikely that they will reach a consensus on GIs. The difference in the two approaches can be summarized by the fact that the European Union prefers *sui generis* protection for GIs, while the US approach is founded on traditional notions of trademark law, which limits the protection accorded to GI-based products. The EU approach to GIs is laid out in an expansive regulation that has been amended three times in the past century to make the provisions more amenable to product quality, revenue generation, international market penetration strategies and territorial development.[38]

The lack of consistency in international perspectives on GIs leads to conflicting approaches on GI protection between jurisdictions. The European Union and the United States turned toward bilateral or plurilateral agreements with several countries to promote their different approaches to the protection of GIs. The European Union is the largest producer of GI products, with more than 1,500 registered within the European Union, representing an industry worth more than €15 billion.[39] The European Union has a multi-pronged approach to GIs that includes a commercial strategy directly connected with an agricultural and rural development strategy. The protection of farmer/producer interests and community branding through GIs are two significant objectives of the European Union's GI policy.

The protection of GIs in the European Union is governed by *sui generis* legislation, EU Regulation 1151/2012.[40] The regulation protects agricultural and food-based GIs on a more substantial level than that mandated by TRIPS Agreement article 22.1.[41] Competitors cannot use registered names directly or indirectly in commerce, or in ways that exploit the reputation of the protected names. Unlike in the United States and Canada, where trademarks are not immune from generic claims, registered GIs cannot become generic.[42]

Registered names are protected against misuse and evocation, notwithstanding that the true origin of the product is indicated on its labelling. The regulation prohibits the use of GIs on products when the GIs are accompanied by the words "type," "as produced in," "method," "imitation" or similar connotations, including the use of the name as an ingredient.[43] A registered GI is also protected against false or misleading indications of

35 Michael Blakeney, "The Protection of Geographical Indications After Doha: Quo Vadis?" (2006) 9 J Intl Econ L 575.

36 WTO, *Geographical Indications: Communication from the European Communities* (2005) General Council Trade Negotiations Committee, Council for Trade Related Aspects of Intellectual Property Rights Special Session, WTO Doc WT/GC/W/547.

37 Tim Maler, "Farm Council: Both sides unhappy with state of TTIP talks, claims Vilsack", *Agra Europe* (16 June 2014), online: <www.agra-net.com/agra/agra-europe/policy-and-legislation/trade-policy/farm-council-both-sides-unhappy-with-state-of-ttip-talks-claims-vilsack-443239.htm>; K William Watson, "Geographical Indications in TTIP: an impossible task", *CATO Online Forum* (October 2015), online: CATO Institute <www.cato.org/publications/cato-online-forum/geographical-indications-ttip-impossible-task>.

38 Gail Evans, "The Simplification and Codification of European Legislation for the Protection of Geographical Indications", in Christopher Geiger, *Constructing European Intellectual Property: Achievements and New Perspectives* (Cheltenham, UK: Edward Elgar Publishing, 2013); EC, "Overview", *supra* note 3.

39 EC, "Value of production of agricultural products and foodstuffs, wines, aromatized wines and spirits protected by a geographical indication" (2012), online: <http://ec.europa.eu/agriculture/external-studies/2012/value-gi/final-report_en.pdf>.

40 EC, *Commission Regulation (EC) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs*, [2012] OJ, L 343/1, arts 5(1), 5(2) [*Regulation 1151/2012*]. The regulation applies to GIs and protected designations of origin. The significant difference between a designation of origin and a GI is in the specification of locations concerning the production and processing area. There is no requirement for the GI to be produced and processed in the defined geographical area. It is sufficient for the product to be produced, processed or prepared in the geographical area. On this basis, products that are cultivated in the geographical zone and processed outside of this area are still registrable as GIs.

41 *Ibid*, art 13(2). Note that although GIs cannot become generic, generic names cannot be registered as GIs.

42 See *Trade-marks Act*, *supra* note 10, ss 11.18(1), 11.18(3), 11.18(4) on genericity and exceptions to genericity for specific named spirits. Also see *Trademark Act of 1946*, Pub L No 79-489, 60 Stat 431, ss 14, 15 [*Lanham Act*] on cancellation of registration on grounds of genericity.

43 *Regulation 1151/2012*, *supra* note 40, art 13.

its origin, "nature or essential qualities,"[44] as well as packaging or labelling that denotes misleading information about its origin or essential qualities. The legal perspective of non-wine and spirit GIs as having distinct rights with their own rationale for protection is an ideology that has informed the European Union's position on GIs internationally, in WIPO forums, in WTO proceedings and in the provisions of preferential trade agreements.[45]

There are no provisions in CETA that oblige Canada to adopt a *sui generis* approach to GIs. However, the agreement shows clear signs of a strong relationship with the European Union's regulation on GIs, in the context of CETA's protection of specific European products in Canada. The provisions in CETA that relate to GIs accomplish what the European Union was unable to gain as leverage in the failed Doha Round negotiations — the protection of the European Union's proprietary interests in unique place-based goods in overseas markets. Article 20.16 of CETA refers specifically to agricultural and food-based products as GIs, thereby paving the way for higher standards of protection for non-wine and spirit products in Canada.[46] The provisions following article 20.16 of CETA ensure that the designations cannot be used by competitors on similarly named products or on products that are not from the European Union. Notwithstanding a product's origin in the European Union, products that are not manufactured in accordance with the regulation's product specifications cannot use GI designations.

On the other side of the spectrum, the United States' approach to GIs is based on traditional notions of trademark law. GIs are accorded limited protection as certification marks or collective marks under the Lanham Act,[47] the Tariff Act of 1930 and under common law.[48] A certification mark certifies that a product or service is produced or performed based on specific quality, manufacture or accuracy standards. The owner of a certification mark may not use the mark, but may license others to use the mark in affiliation with their products. Herein lies a significant difference between GIs and certification marks. GIs may be owned by a group of producers or by the state. In both forms of ownership conferred by GI rights, style of ownership does not preclude commercialization and use of the right by its owners. Collective marks are owned by a group and serve as an indication that the product originates from the group's association. While some jurisdictions recognize collective marks as GIs, GIs are not collective marks, as there is no inherent requirement for the product to meet specific definitional characterstics to be qualified as a GI.

Certification and collective marks have the same jurisprudential safeguards as trademarks, primarily because their provisions form part of the Lanham Act.[49] By way of section 526(e) of the Tariff Act, the importation of counterfeit products registered as certification marks is explicitly prohibited as a violation of the act. The importation of counterfeit certification mark products is a violation of the customs laws, and such products are subject to seizure.[50] The provision applies to certification marks that have been used without authorization to falsely denote a product's affiliation with a brand.

The US approach was reflected in the GI provisions of the TPP. The US-led agreement illustrates the position that the United States asserted in the failed Doha Round negotiations concerning enhanced protection for non-wine and spirit GIs.[51] The GI provisions in the TPP indicated that no preferential treatment could be accorded to such rights vis-à-vis trademark rights. The agreement did not curtail

44 *Ibid*, art 13(1)(c).

45 See Geoffrey Garrett & Barry Weingast, "Ideas, Interest and Institutions: Constructing the EC's Internal Market" in Judith Goldstein & Robert Keohane, eds, *Ideas and Foreign Policy* (Ithaca, NY: Cornell University Press, 1993); GE Evans, "The Comparative Advantages of Geographical Indications and Community Trademarks for the Marketing of Agricultural Products in the European Union" (2010) 41:6 Intl Rev Intell Prop Comp L 645; Insight Consulting, "Geograhical Indications and TRIPS: 10 Years Later: A Roadmap for EU GI holders to get Protection in other WTO Countries", online: <http://trade.ec.europa.eu/doclib/docs/2007/june/tradoc_135088.pdf>.

46 *CETA*, *supra* note 11, art 20.16: "geographical indication means an indication which identifies an agricultural product or foodstuff as originating in the territory of a Party, or a region or locality in that territory, where a given quality, reputation or other characteristic of the product is essentially attributable to its geographical origin."

47 *Lanham Act*, *supra* note 42.

48 *Tariff Act of 1930*, 19 USC 4, s 526(e) [*Tariff Act*]. See also *Institut National Des Appellations d'Origine v Brown-Forman Corp* 47 USPQ (2d) 1875, 1998 WL 650076 (TTAB 1998).

49 *Levy v Kosher Overseers Assoc of America*, 104 F (3d) 38 (2d Cir 1997).

50 *Tariff Act*, *supra* note 48.

51 WTO, *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* (18 May 2005) General Council Trade Negotiations Committee, Compilations of Issues Raised and Views Expressed, Note By the Secretariat, WT Doc WT/GC/W/546.

or prevent trademark registrations from being invalidated for claims of similarity or for containing references to GIs. The defunct agreement would have restricted the proliferation of GIs, requiring the refusal of GI registration if the indication was likely to cause confusion with pre-existing trademarks.

In the United States, there has been a long practice of conflating certification marks with GIs, recognizing no difference between the two forms of IP.[52] In this context, the TPP was no different, illustrating the strong position of the United States in the negotiation and drafting of the agreement. The choice of resorting to the domain of certification marks and trademarks for the protection of GIs is noticeable in the agreement. The text stipulated that certification marks were acceptable means of protecting GIs, a reflection of the United States' views on GIs.[53] Even established GIs were not safe, but could be cancelled or invalidated by registered trademark owners on grounds of confusion.[54] The TPP further limited the recognition of GI rights by requiring that rights could be cancelled or repealed if the grounds for protection in a member country no longer existed — this was a significant blow to the proliferation of GI rights internationally.[55] TPP-member countries such as Canada, Japan, Peru, Singapore and Vietnam would have been required to position domestic GI rules in an unambiguous and workable format that was reconcilable with TPP GI rules.

The draft TPP rules jeopardized recent gains made under the Lisbon Agreement concerning non-wine and spirit GIs. The Lisbon Agreement was not listed or treated in the TPP as an international agreement that its negotiating members should ratify or to which they could accede,[56] which would have provided a minimal shield for countries with a *sui generis* GI framework.[57] A jurisdiction that is inclined to join the Lisbon Agreement[58] for the protection of GI rights may find that its rights can be toppled, if successfully opposed by a contracting party to the TPP. The non-inclusion of the Lisbon Agreement as an instrumental part of the TPP is more of a political move by the United States, which has publicly voiced its disagreement with the enhanced levels of protection for GIs offered by the revised Lisbon Agreement.[59] As such, in terms of the success rates of GI schemes, a domestic GI strategy focused on creative and innovative approaches to non-wine and spirit products may be frustrated by the restrictive GI provisions of the TPP.

In circumstances in which a TPP-member country protected GIs through an international agreement, that protection could not be guaranteed as the right could possibly be cancelled.[60] The favourable position of wine and spirit GIs is highlighted in the TPP. Wine and spirit GIs could not be opposed or cancelled based on the likelihood of confusion with a pre-existing, good faith, pending trademark application from a member country. Similarly, wine and spirit GIs cannot be cancelled based on the likelihood of confusion with an existing trademark acquired under the law of a member country.

52 *Black Hills Jewelry Manufacturing Co v Labelle's*, 489 F Supp 754 (DSD 1980); *Community of Roquefort v William Faehndrich, Inc*, 303 F (2d) 494 (2d Cir 1962).

53 *TPP*, *supra* note 5, art 18.19.

54 *Ibid*, art 18.32(3).

55 *Ibid*, art 18.32.

56 *Ibid*, art 18.7, online: United States Trade Representative <https://ustr.gov/sites/default/files/TPP-Final-Text-Intellectual-Property.pdf>.

57 See also *ibid*, art 18.36.

58 *Geneva Act*, *supra* note 8.

59 United States, "U.S. Statement on the Adoption of the Lisbon Agreement As delivered by Ambassador Pamela Hamamoto, at the World Intellectual Property Organization (WIPO) Diplomatic Conference for the Adoption of a New Act of the Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration" (20 May 2015), online: <https://geneva.usmission.gov/2015/05/20/u-s-statement-on-the-adoption-of-the-geneva-act-of-the-lisbon-agreement/>.

60 *TPP*, *supra* note 5, art 18.36(3): "For the purposes of this Article, a Party shall not preclude the possibility that the protection or recognition of a geographical indication could cease."

# CETA and its Implications for the Protection of GIs in Canada

Canadian courts have been cautious in carving out spaces for the use of place-based names on grounds of nondescriptiveness and nondistinctiveness in local consumer markets. *Parma* and *MC Imports*[61] are two cases that illustrate the approach of Canadian courts to actions by foreign producers to invalidate Canadian product-name trademarks that are similar or identical to geographic names of foreign products. Absent a finding of distinctiveness, names that are clearly descriptive or deceptively misdescriptive are unregistrable as trademarks.[62] Distinctiveness can save an otherwise unregistrable mark from invalidation. Marks that have acquired distinctiveness through prior use as of the date of the application for registration are saved from invalidation as trademarks.[63] A finding of nondistinctiveness in a descriptive mark means that the mark lacks secondary meaning in its consumer market. A finding of secondary meaning in a trademark means that there is a particular feature about the mark that raises its otherwise non-distinguishable character to a level of distinctiveness among consumers. Therefore, consumers are able to differentiate the product by some characteristic other than merely its name.

*MC Imports* dealt with the claim of a Philippines-based company to invalidate the trademark of a Canada-based company that used a product name that contained terms identical to its own product's name. Both companies sold shrimp sauce in Canada. MC Imports, the Philippines-based company, labelled its shrimp sauce as "Lingayen," while AFOD Ltd., the Canadian distributing company based in British Columbia, labelled its product as "Napasarap Lingayen style shrimp paste."[64] The Trade-marks Act does not prevent producers from using terms such as "style," "like" and "imitation" on products, if these terms are not part of the trademark associated with the product. The claim was unsuccessful.

MC Imports had been using the trademark Lingayen on its product in Canada since 2003. Lingayen is also the name of a place in the Philippines. Although the court took judicial notice of the territorial significance of the name, it prevented MC Imports from further use of the name in Canada to sell its products. MC Imports' use of Lingayen as a trademark was held to be clearly descriptive and therefore not valid as a trademark in Canada. Marks that are clearly descriptive are not registrable as trademarks as they only describe a feature of the product, while not distinguishing the product from other products.[65] *MC Imports* is a precedent for the treatment of place-based goods in Canada. Without the presence of secondary meaning to give rise to some form of distinguishing feature about the product, geographic names are statutorily and judicially regarded as clearly descriptive, and therefore unregistrable as marks. If there were no proposed changes to the Trade-marks Act, this line of judicial reasoning would restrict the registration of GI products in Canada on two grounds. First, there would be no legal grounds preventing a product that did not originate in a specified territory from using the geographic name of the territory on its labelling. Second, GIs would have no monopoly on geographic product names unless some other form of international agreement protected the name from use.[66]

Maple Leaf Foods' litigation with an Italian firm over the use of the name "Parma" is noteworthy as it illustrates the effect that CETA will have on established trademark products. The litigation between Maple Leaf Foods and Consorzio of Italy stretched over two decades and involved the

61 *Maple Leaf Foods Inc v Consorzio Del Prosciutto Di Parma*, 2012 FC 416 [*Parma*]; *MC Imports Inc v AFOD Ltd*, 2016 FCA 60 [*MC Imports*].

62 *Trade-marks Act*, *supra* note 10, s 12(1)(b).

63 *Alberta Distillers Ltd v Highwood Distillers Ltd*, [1993] FCJ No 655 (TD).

64 The Canadian producer MC Imports had previously initiated an application in the Federal Court, which was dismissed on similar reasons as those proclaimed by the Federal Court of Appeal.

65 *Proctor & Gamble Inc v Tex-Pro Western Ltd*, [1992] TMOB No 150.

66 As an example, under Article 6ter of the Paris Convention, *supra* note 17, armorial bearings, flags and state emblems cannot be used as trademarks, unless authorized by the member country. Switzerland uses an adaptation of its national flag unto a shield as its coat of arms. The coat of arms is displayed on specific Swiss products as a means of identifying the source of the goods; it functions as a trademark. However, no other entity or country can use the coat of arms on their products. On an international level, there are ongoing talks in WIPO fora to protect country names from commercial usage by non-authorized persons; these debates impact the legal significance of GIs. WIPO, Standing Committee on the Law of Trademarks, Industrial Design and Geographical Indications, "Protection of Geographical Indications and Country Names in the Domain Name System" (23 March 2015) SCT31/8 Rev 5, online: <www.wipo.int/edocs/mdocs/sct/en/sct_35/sct_31_8_rev_5.pdf>.

right to use "Parma" and "Prosciutto di Parma" on processed meat products.[67] The case illustrates the difficulty that the two parties had in battling over market access and brand dominance in Canada and cautions that a consistent and balanced approach in setting limits for foreign GIs in Canada is needed. Maple Leaf Foods' success in using Parma as a trademark in Canada stems from the established use of the mark locally, the distinctiveness of the mark and the inability of Consorzio producers to establish a public authority[68] basis for usage of "Prosciutto di Parma." CETA presents an interesting concession on this whole issue. The agreement lists "Prosciutto di Parma" as a name — for a product class of dry-cured meat from Italy — that cannot be used by any other producer in Canada.[69] In practical terms, CETA's position on Parma ham is opportune for Italy and the European Union, as it will likely facilitate ease of market access for the product in Canadian markets. In effect, this may secure victory in the long-contested name dispute between Maple Leaf Foods and Consorzio. However, it may lead to significant legal, commercial and economic repercussions for Maple Leaf Foods' Parma products.

A significant accomplishment of the GI provisions for EU producers is the restriction on the use of GI names, along with connotations such as "kind," "style," "imitation," "type" or the like.[70] This represents a clawback of the EU GI names. A clawback of GI names is a retraction of identical product names used in the course of trade that are not authorized by the original right holder of the GI.[71]

In CETA, a few well-known product names can still be commercially used on products in Canada, if they are distinguishable by the qualifiers "imitation," "style," "kind" or the like. According to CETA, products that are not GIs may use the names Asiago, fontina, Gorgonzola, Münster and feta if accompanied by the qualifiers "imitation," "style," "kind" or the like.[72] The product names "Jambon de Bayonne" and "Beaufort" can be used on products, if they are used for classes of dry-cured meat and cheese that were in commercial use in 2003 or before.[73] Further, "Nurnberger Bratwurste" can be used in product classes of "fresh, frozen and processed meats" on products that were in commercial use on or before October 18, 2008.[74]

CETA mandates specific border measures for IP goods that use, without authorization, a GI that is identical to the registered designation protected under the agreement.[75] The objective of GI stipulations on border measures is to promote and safeguard the market penetration of EU products into the Canadian market, an initiative that the European Union has campaigned for in its own domestic market.[76] As an example, Canada's GI obligations would not prevent the import or export of cheese labelled "feta-style" into or out of the Canadian consumer market. The other extreme is that the European Union, or an interested party, may request the non-release of products that contain an indication identical to a protected GI. For example, "Danablu" cheese is given a clawback status in the agreement.[77] In the context of CETA, cheese labelled Danablu from a non-European territory, or that is not produced in conformity with EU product specifications regarding Danablu cheese production,[78] is to be detained by customs and cannot enter Canada's commercial market. Similarly, Canadian producers are prevented from using Danablu as labelling on cheese, notwithstanding the use of terms such as "kind," "imitation," "style" or the like. The above is just one example of the practical workings of the EU–Canada GI agreement, pursuant to CETA.

The effect is a clawback of product names that the European Union had long campaigned for in

67 *Parma*, *supra* note 61; *Maple Leaf Foods Inc v Consorzio del Prosciutto di Parma*, 2012 TMOB 249; *Consorzio del Prosciutto di Parma v Maple Leaf Meats Inc*, [2001] 2 FCR 536, 2001 CanLII 22030 (TD).

68 *You In — Canadian Athletes Fund Corporation v Canadian Olympic Committee*, 2007 FC 406, referenced in *Parma*, *supra* note 61. Section 9(1)(n) of the Trade-marks Act, *supra* note 10, prohibits emblems or marks of public authorities in Canada from usage as trademarks. Consorzio's action to advance its position in Canada as public authority, thereby preventing the use of Parma by Canadian producers, failed as the provision only applies to Canadian public authorities.

69 *CETA*, *supra* note 11, Annex 20A, Part A — Geographical Indications Identifying a Product Originating in the European Union.

70 *Ibid*, art 20.19(3).

71 Daniela Benaventa, "The Economics of Claw-back" in *The Economics of Geographical Indications* (Geneva, Switzerland: Graduate Institute Publications, 2013) c 4.

72 *CETA*, *supra* note 11, art 20.21(1).

73 *Ibid*, art 20.21(3).

74 *Ibid*, art 20.21(4).

75 *Ibid*, art 20.43(1).

76 See *Regulation 1151/2012*, *supra* note 40; Insight Consulting, *supra* note 45.

77 *CETA*, *supra* note 11, Annex 20-A.

78 *Ibid*, art 20.19(2)(a)(ii).

the failed Doha Round. This results in statutory and judicial restraint on the application of trademark law to GIs, as clawed back names are outside the purview of actions, unless the names are no longer protected in the home territory or have fallen into disuse.[79]

Another indication that Canada fared better than many other jurisdictions with similar agreements with the European Union[80] is that there is nothing in the agreement that prevents a product from using translations of protected GIs that are customary in common language as a common name for a product.[81] In other words, after ratification of CETA, EU GI products protected under the agreement that, when translated, are common names for types of products in Canada are still valid as trademarks. The areas of potential conflict concern products that are using variations of the names on products, such as "like," "style," "imitation," "kind" and other wordings that are suggestive of a link or affiliation with the country of origin, but are in fact false associations.

Of greater concern are implications of the reserved names for registered and prospective trademark owners who may have used such names or contemplate the use of these names. Contestations between EU-based GI owners and Canadian companies with products in similar classes over the right to use conflicting names is a likely result of this stipulation. This point is relevant despite the inclusion of article 20.21(5) in the agreement,[82] under which trademarks used, applied for or registered in good faith prior to the enforcement of CETA may coexist with EU-based GIs. The extent of relabelling that may need to be undertaken by Canadian producers or importers of GI-protected products is not yet evident. It is economically and legally sound for producers to be aware of the potential restrictions posed by the safeguard of specified EU product names in domestic jurisdictions. The EU–Canada GI agreement presents an opportunity for Canada to take a bold position to advance GIs, amid moves by other trade partners, such as the United States, to curtail the advancement of such rights.

Canada's recognition of EU-based GIs is not yet in force. Canada has also introduced amendments to its Trade-marks Act in an attempt to bridge gaps that may prevent the recognition of rights under CETA. Amendments to the Trade-marks Act and the adoption of CETA into Canadian law under Bill C-30 are currently going through the final stages of the legislative process before being passed into domestic law.[83] The amendments to the Trade-marks Act in the bill codify Canada's GI commitments under CETA. *Sui generis* legislation for the protection of GIs is not contemplated by the bill. Rather, the bill makes changes to the Trade-marks Act that allow qualified agricultural and food-based products to be registered and protected as GIs.[84]

The proposed amendments facilitate the recognition of both domestic and international GIs in Canada, if the products meet the criteria for registration.[85] The draft legislation's attempt to strike a balance between trademarks and GIs may leave GIs from less established international markets out in the cold. Conflicts between trademarks and GIs are the primary reason for resistance to the enactment or recognition of GI laws internationally. Bill C-30 stipulates that when considering the confusion between a trademark and a GI, the grounds for opposition of a GI include the length of time it has been used as an indication and the degree of resemblance with the trademark.[86] Further considerations that the registrar or the

79 GI names that have fallen into disuse in the country of origin can be cancelled as protected names. *Ibid*, art 20.22(1).

80 Examples include the EU–Ukraine Association Agreement and the EU–ACP–Cariforum Partnership Agreement. The latter agreement is signed between the European Union and 79 countries in Africa, the Caribbean and the Pacific regions.

81 *CETA*, *supra* note 11, art 20.21(7).

82 *Ibid*, art 20.21(5).

83 Bill C-30, *An Act to implement the Comprehensive Economic and Trade Agreement between Canada and the European Union and its Member States and to provide for certain other measures*, 1st Sess, 42nd Parl, 2015 [Bill C-30], online: <www.parl.gc.ca/LEGISinfo/BillDetails.aspx?billId=8549249&View=6>.

84 *Ibid*, Summary: "Part 2 amends certain Acts to bring them into conformity with Canada's obligations under the Agreement and to make other modifications. In addition to making the customary amendments that are made to certain Acts when implementing such agreements, Part 2 amends the Trade-marks Act to, among other things, (i) protect EU geographical indications found in Annex 20-A of the Agreement, (ii) provide a mechanism to protect other geographical indications with respect to agricultural products and foods, (iii) provide for new grounds of opposition, a process for cancellation, exceptions for prior use for certain indications, for acquired rights and for certain terms considered to be generic, and (iv) transfer the protection of the Korean geographical indications listed in the Canada–Korea Economic Growth and Prosperity Act into the Trade-marks Act."

85 *Ibid*, s 61.

86 *Ibid*.

Federal Court[87] shall consider include the degree of distinctiveness of the trademark, the length of time it has been used and the nature of the goods with which it is associated.[88] These provisions are in line with the decision in *MC Imports*, in which the court held that the foreign producer could no longer use the geographic origin as a product name in Canada, based on the existing use of the name by a Canadian producer. In effect, the proposed amendments provide insufficient safeguards for foreign GIs that are not on the list of GIs protected under CETA. Meanwhile, Canadian producers that anticipate registering GIs will need to be mindful that name similarities with pre-existing trademarks may prevent the registration of GI products.

## The Road Ahead for Canada

Amendments to Canada's Trade-marks Act may provide innovative means for entrepreneurs to commercialize their products using GI platforms. In this context, Canadian producers will have access to a system of tools that can be effective protection for brand development and increases in product revenue. As GIs are also nation-branding tools, the legislation provides an opportunity for policy makers to work with entrepreneurs in developing connections between places, products and local Canadian culture.

At the same time, the use of a domestic GI scheme to counter imbalances in foreign GI protection cannot support the Canadian economy if there are no identified products that fit the definitional parameters of GIs, or if there is no targeted need for the legislation. There are specific, well-established domestic industries that will need to re-engineer product development strategies to comply with CETA's GI rules. For the immediate term, this may include relabelling products to meet CETA commitments. The task is not without legal and economic costs that may affect businesses and consumer pricing negatively. The probability of upward price adjustments to reflect changes in production costs is not remote. Although changes to the Trade-marks Act will allow Canadian producers to register GI products, the clawback of EU GI product names means that EU producers are provided with higher levels of protection under the agreement.[89] This scenario has significant implications for the ability of many Canadian producers to access domestic markets on the same basis as the producers of similarly protected EU products.

The use of border measures to prevent the export and import of products with names that are similar to CETA-protected GIs may be susceptible to legal challenges in courts and under dispute resolution measures in other preferential trade agreements. Canada is a party not only to CETA, but also to NAFTA. The framing of the US-led TPP GI provisions was a backlash to the growth of EU-based preferential free trade agreements that promote high standards of protection for GIs. As such, it is possible that, in NAFTA renegotiations, the United States will continue to object to GI protections by challenging EU clawbacks as contraventions of international law rules on national treatment.[90] The United States' policy on GIs is to curtail the expansion of non-wine and spirit GI rights internationally as they are perceived as a threat to its established trademark industries.

CETA will enable Canada to offer legal protection for GIs, inclusive of agricultural products and foodstuffs. However, the amendments to the Trade-marks Act need to be representative of the interests of Canadian producers. As the Trade-marks Act is federal legislation, all provinces will need to ensure that GI rules are applied in a manner that is consistent with the legislation.

87 Either the registrar, in an examination, or the Federal Court, in a judicial decision, shall resolve confusion between GIs and trademarks. *Ibid*.

88 *Ibid*.

89 *CETA*, *supra* note 11, Annex 20-A, Part A lists 173 EU GIs that must be protected in Canada. However, Annex 20-A, Part B does not yet include any Canadian products. The parties may add products to the list, or remove products from the list if they are no longer protected as GIs in the place of origin. Products can also be removed from the list if the GI designation is no longer being used; *ibid*, art 20.22, Amendments to Annex 20-A.

90 National treatment is one of the fundamental principles in the international conventions protecting IP. It means that imported and locally produced goods should be treated equally.

Canada's ability to work effectively with domestic stakeholders to use GI laws will ultimately determine whether Canada, like the European Union, can become a dominant player in the global GI industry. Countries that have done well with GIs by positioning these proprietary rights as valuable domestic forms of IP have used *sui generis* legislation to protect and enforce them. The European Union, India, Japan and Switzerland are examples of countries whose economies have benefited from a *sui generis* approach to GI protection. This approach is missing from the proposed amendments to the Trade-marks Act.

As they stand, GI-related amendments to the Trade-marks Act favour selected EU GI products; Canadian interests are not yet well represented in this framework. The changes are therefore insufficient to effect full-scale domestic engagement with GIs. This paper recommends that Canada consider these issues in the implementation of GI rules under the Trade-marks Act.

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