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THE DEGREE OF LLB.

GEOGRAPHICAL INDICATIONS GLOBALLY AND
THE KENYAN APPROACH.

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AUGUST, 2002
DECLARATION

This dissertation is my original work and has not been presented for a degree in any other university.

Manvinder Sehmi

This dissertation has been submitted with my approval as university supervisor.

Dr Odek.
Acknowledgement.

Life is no easy task neither is a dissertation, gratitude is necessary where it is due- to people who make it easier.

Thanks mum, dad, sister and brother.

Thanks Brazil for jogo bonito and erasing the pain felt in 1998. "Ordem e progresso."

Thanks Wilson.

Thanks to all my colleagues at UON.

Thanks to my supervisor Dr Odek for guiding me in this work.

Thank You above all to the One holding the blue umbrella- GOD, for helping me to achieve more than I had hoped for.
The Name Gain.

It would be risky to swear by the immortal words of Shakespeare:

"what's in name?

a rose by any other name would smell just as sweet",

Yet they call Rounds and take TRIPS all over the world,

They call on experts and on cultures,

They call on a region and its characteristics,

Why? To protect just a name!?

In this politically correct world

One would be damned not to protect just a name,

For the story of 'name' is all about commercial gain.

Tchuch Rivnam.¹

¹ Registration for which is currently being sought.
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ACRONYMS

WTO- THE WORLD TRADE ORGANISATION.
WIPO- WORLD INTELLECTUAL PROPERTY ORGANISATION.
TRIPS- TRADE RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS.
LDC- LEAST DEVELOPED COUNTRIES.

TABLE OF CASES.


3/ Beckett v. Kingston Brothers (Butchers) Ltd.

5/ Parke Davis & Co. Ltd v. Opa Pharmacy Ltd 1961 EA 556

6/ Apollinaris Co.'s T. M. [1891] 2 Ch.186; 8 R.P.C. 137; Apollinaris Appn. [1907] 2Ch. 178; 24 R.P.C.436

7/ National Starch Co.'s Appn. [1908] 2 Ch.698; 25 R.P.C. 802.

8/ Shields Ice and Cold Storage Co.'s appn. [1923]40 R.P.C. 197


11/ Magnolia Metal Co.'s T.M.s [1897] 2 Ch.371 ; 14 R.P.C. 265 & 621.

12/ Sherry Case [1969] RPC 1

13/ California Fig Syrup Co.'s Appn. [1910] 1 Ch. 130; 26 R.P.C. 436,846.
INTRODUCTION

Geographical Indications globally and the Kenyan approach.

1.1 BACKGROUND TO THE STUDY

In general intellectual property rights constitute the legal means to protect certain results of intellectual activity such as inventions, literary and artistic works, as well as symbols, names, expressions and designs used in trade. Intellectual property rights seek to protect the rights of creators and producers of the intellectual products as well as the consumers and civil society in exercise of these rights. This has to be achieved both at a national and international level.

The TRIPS (Trade-Related Aspects of Intellectual Property Rights) Agreement recognizes seven different categories of intellectual property rights namely: copyrights and related rights, trademarks, geographical indications, industrial designs, patents, layout designs of integrated circuits and undisclosed information.
Geographical indications has proved to be quite dodgy, whereas trademarks and patents have a general definition accepted worldwide, in geographical indications there is not a single definition or terminology.

There are at least two other concepts related to the idea of geographical indications namely "indication of source" and "appellation of origin". Both were incorporated in other international treaties before the TRIPS Agreement was adopted, mainly the Paris Convention for the Protection of Industrial Property, hereinafter the Paris Convention, the Madrid Agreement for the repression of False or Deceptive Indications of Source on Goods of 1891, hereinafter the Madrid Convention and the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of 1958, hereinafter the Lisbon Agreement. 1

It is important that the Kenyan legislation appreciates the inherent difficulty in the wide definitions and terminologies. Part of our research will give regard to this. As an introduction geographical indications are defined in Article 22.1 as follows:

"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

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1 Sergio Escudero, "International Protection of Geographical indications and Developing Nations", South Centre/ Centre for International Environmental Law (CIEL), 2001
locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin”

1.2 RESEARCH PROBLEM.

Geographical indications are an important part of intellectual property rights; is the Kenyan legislation is lagging behind in this aspect? What does she need to do in order to make the comprehensive legislation in geographical indications?

1.3 AIMS AND OBJECTIVES

This research aims at bringing out the key issues that need to be taken into consideration in the legislation for geographical indications.

Our research will tend to look at the present Kenyan legislation, and that which is yet to come in force in the form of Geographical Indications Bill of 2001. This will be analyzed with the background of the international conventions and agreements together with the experiences of other countries and their outlook on the shortcomings of the whole regime dealing with intellectual property rights.
This also includes the views and apprehensions presented by the members of the World Trade Organization (WTO) at their meetings.

1.4 RATIONALE

Article 22 of the TRIPS Agreement provides protection for all geographical indications. In this respect the WTO (World Trade Organization) members should provide the legal tools so that the interested parties can prevent the use of any means in the designation or presentation of a good that indicates or suggests that the good originates in a geographical area, other than the true place of origin of the good. They can also prevent any use, which constitutes an unfair competition act, within the meaning of Article 10bis of the Paris Convention.

There is however the additional protection that is given to wine and spirits only under Articles 23.3 and 23.4 of TRIPS. The major wine producing countries are rich industrialized countries with France in the forefront. France knows the importance of foolproof legislation for their wines and in order to achieve that she has managed to guarantee more protection to her products via geographical indications.

Kenya boasts one of the best qualities of tea and coffee in the world. Good legislation is crucial to protect the brand that is Kenyan tea or coffee. One of the most effective ways is geographical indication.
Geographical indications cover a large variety of products and are not limited to foodstuffs only. The Lisbon Agreement according to the Nice Classification Agreement has several registered classes on appellation of origins. To name but a few:

Class 1- chemicals used in industry, science and photography, agriculture and horticulture.

Class 2- Paints, varnishes, lacquers, etc

Class 3- Bleaching preparations and other substances for laundry use.

Class 21- Household or kitchen utensils and containers.

Class 24- Textiles and textile goods.

Class 30- Coffee, tea, sugar, cocoa, rice, tapioca, artificial coffee, etc.

The classes are several and varied, the above merely scratch the surface. TRIPS leave it up to the member countries to give their desired standards to their local legislation. What TRIPS contains is the minimum standards. It is up to Kenya to give protection to her local produce in the international market. For instance having lost the Basmati patent, the Indian government is now moving to protect other Indian products that have a large export market. Kashmiri
carpets, Alphonso mangoes and Darjeeling tea will soon be registered as geographical indications.²

Kenya needs to do the same for her products as well. Hence we find the need to write about the importance of a good legislation for geographical indication.

1.5 LITERATURE REVIEW.


The Paris Convention for the Protection of Industrial Property, 1883.

Madrid Agreement for the repression of False or Deceptive Indications of Source on Goods of 1891.


1.6 METHODOLOGY

The method of data collection will be library based.

The Kenyan legislation concerning geographical indications is non-existent; the *Industrial Property Act of 2001* speaks extensively on patents, and touches on industrial designs but says nothing about geographical indications. This may be attributed to the fact that a *Geographical Indications Bill* exists but this has not so far been tabled in parliament and is far from becoming part of the local legislation. Hence Kenya has no legislation in force that deals exclusively with geographical indications. There is no definition of geographical indications in the current Kenyan legislation, what we do have is a negative definition in Section 12 (1.d) of the *Trademarks Act Chapter 506* that reads as follows:

"(1) In order for a trademark (other than a certification trademark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars-

(d) word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or surname;"
This section suggests that trademarks that have geographical names will not be registrable except upon evidence of its distinctiveness as per Section 12 (1 e):

“(e) any other distinctive mark, but a name, signature or word or words, other than such as fall within the descriptions in paragraphs (a), (b), (c) and (d), shall not be registrable under this paragraph except upon evidence of its distinctiveness.”

The fact that geographical names are excluded from being registered as trademarks goes to show that geographical names are not trademarks and should not be registered as such. Secondly that geographical names are separate with special rights and obligations relating thereto. Hence we can deduce that the reason why geographical names are excluded from registrable trademarks is because special rights are accorded to them under geographical indications, which is a recognised category of intellectual property rights under the TRIPS Agreement.

However Kenya is a signatory to the TRIPS Agreement, which means, that for lack of local legislation, it is to TRIPS that Kenya refers.
Moreover the Kenyan legislation will have to be TRIPS compliant and therefore it is most likely that the local Bill on geographical indications will be laid out according to the provisions in _TRIPS_.

According to the **TRIPS Agreement (1994)**, Section 3, Article 22, geographical indications are:

> "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."

The TRIPS Agreement recognizes six other different categories of intellectual property rights namely copyrights and related rights, trademarks, industrial designs, patents, layout designs of integrated circuits and undisclosed information. Consumers can distinguish products of their preference through two different categories of those intellectual property rights that is trademarks and geographical indications.

Trademarks are expressions such as "Coca Cola", "Marlboro" and "Colgate". All of them distinguish products or services and/ or their
producer or manufacturers or provider. Another phenomenon is to register phrases such as “Life Tastes Good” by Coca Cola. Another interesting trademark is the latest triple striped Colgate with “Germ Defence”. “Germ Defence” is a registered trademark.

Geographical indications are expressions such as “Cognac”, “Pilsen”, “Tequila” and “Champagne”. All of them distinguish the geographical origin of a given product. In the case of tequilla, the sap of some agaves is fermented to obtain an alcoholic drink called pulque, which can be distilled to make a colourless liquor, mescal and tequila. All agaves are called maguey in Mexico. Mescal or mezcal are also registered as geographical indications.

A number of cities have given their names to beer styles. The most famous of these is Pilsen in the Czech republic, whose name (as Pilsener, Pilsner, or Pils) should signify a golden lager with a dry finish. Münchener (from Munich in Bavaria, Germany) signifies a dark brown lager, and Vienna an amber-red lager; Burton ales (from Burton-upon-

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1 This is a region in France.
2 This is a region in Germany.
3 This is a drink that originates from Mexico.
4 This is a region in France.
5 "Agave," Microsoft® Encarta® Encyclopedia 2000. © 1993-1999 Microsoft Corporation. All rights reserved.
Trent in Staffordshire, England. These are more examples of geographical indications.

Trademarks personalize and identify products and services from a specific manufacturer, producer or service provider, in order to differentiate such goods or services. Geographical indications do not identify a producer or manufacturer of a product but its place of origin.

According to Sergio Escudero in his article "International Protection of Geographical Indications and Developing Nations" Trademarks involve human creativity, something novel to distinguish one product or service from another. Geographical indication is an expression that identifies geographically the product's origin. A geographical indication is linked to factors such as topography, human work, climate or other factors independent from human creativity. Hence trademarks tend to put emphasis on the producer whereas geographical indications underline the geographical origin of a product and some derived characteristics.

6"Beer," Microsoft® Encarta® Encyclopedia 2000. © 1993-1999 Microsoft Corporation. All rights reserved.
7 Published by the South Centre/ Centre for International Environment Law (CIEL), 2001.
Geographical indications are used typically on agricultural or related products (such as wines and spirits), but are not necessarily limited to these. A geographical indication may also highlight specific characteristic of a given product due to factors other than the geographical such as human factors. This is the case in the expression “Swiss made” which is a geographical indication.

Swiss made watches, penknives or chocolates are well known and the words “Swiss made” on such products increases their value. Moreover any infringement of these names will result in seizure of the goods purporting to be “Swiss made”, but which in actual fact are not. The penalties vis a vis geographical indications infringement will be discussed in detail in the proceeding chapters.
1.2. OTHER RELATED CONCEPTS

1.2.1 INDICATIONS OF GEOGRAPHICAL ORIGIN.

According to Sergio Escudero (supra) in the case of geographical indications there is no single definition or terminology. Due to the difficulty of having a specific term related to this concept the World Trade Organization (WTO) Secretariat, while summarizing the responses to the protection of geographical indications has invented a new term. This is “indication of geographical origin” and tries to be a common denominator to designate the different expressions used by WTO members to protect the geographical origin of products given that geographical indication has a specific meaning under Article 22.1 of the TRIPS Agreement. Some members criticized this new concept during the April 2001 TRIPS Council meeting. The explanation given by the WTO Secretariat was that this “new concept was introduced for the sole purpose of the summary paper and the reason being that Members used a large variety of terms or expressions to describe their national laws when protecting geographical indications.
In our opinion this new concept only creates more confusion. Since the Secretariat is in a position to control and speak on the matters before them, they should refrain from introducing new concepts and insisted on "geographical indications" as opposed to "indications of geographical origin".

1.2.2. "INDICATION OF SOURCE" & "APPELLATION OF ORIGIN".

Both these concepts namely "indication of source" and "appellation of origin" were incorporated in other international treaties prior to TRIPS namely: The Paris Convention for the Protection of Industrial Property of 1883, hereinafter the Paris Convention and The Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of 1958, hereinafter the Lisbon Agreement and The Madrid Agreement for the Repression of False and Deceptive Indications of Source, hereinafter the Madrid Agreement

8
The broadest concept is "indication of source", which appears in the *Paris Convention* and also the Madrid Agreement, however both of these treaties do not give a definition of the term. Nevertheless Article 10 of the *Paris Convention* dealing with false indications of goods, states in its provisions relating to goods unlawfully bearing a trademark and their seizure.

"(1) The provisions of the preceding Article shall apply in cases of direct or indirect use of a false *indication of the source* of the goods or the identity of the producer, manufacturer, or merchant.

(2) Any producer, manufacturer, or merchant, whether a natural person or a legal entity, engaged in the production or manufacture of or trade in such goods and established either in the locality falsely indicated as the source, or in the region where such locality is situated, or in the country falsely indicated, or in the country where the false *indication of source* is used, shall in any case be deemed an interested party."

Article 1(2) of the *Paris Convention*, in the definition of objects for protection of industrial property, reads as follows:
"The protection of industrial property has as its objects patents, utility models, industrial designs, trademarks, service marks, trade names, indications of source or appellation of origin, and the repression unfair competition."

This might suggest that both expressions be considered synonymous. However, Professor Bodenhausen clarifies the difference between them. He says that appellations of origin are linked to the quality or other characteristics belonging to geographical environment where the product comes from, which is not the case for indications of source. The latter refers to the geographical origin and nothing else.\(^8\)

An appellation of origin requires that the quality of the product is attributable to the geographical origin of the product. This suggests that certain characteristics of that product are exclusively as a result of the geographical origin. The factors contributing to this may be the climate, soil, traditional methods of production or the like. An indication of source merely refers to the origin of the product in question and has been defined as follows:

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"...as an indication referring to a country or to a place therein as being the country or place of origin of a product."\(^9\)

In the above definition there is no requirement concerning a certain quality, reputation, natural or human conditions or other characteristics of the product associated with its geographical origin.

The term "appellations of origin" is defined in Article 2 of the Lisbon Agreement as:

"In this Agreement, 'appellations of origin' mean 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 exclusively or essentially to the geographical environment, including natural and human factors."

According to Sergio Escudero the denomination must in this case correspond to a geographical name (not symbols or other kinds of expression), which serves to designate a product. This means that the product and the geographical name should be the same, such as Bordeaux, Porto or Jerez. Finally, the quality or characteristics of the

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product should be exclusively due to its geographical environment, including natural and human factors. This link may be difficult to prove regarding a specific geographical indication.

The Bangui Agreement of March 1977, defines the term 'appellations of origin' in Article I of Annex VI as follows:

"the geographical denomination of a country, a region or a specific place used to designate a product which originates therein and the characteristic qualities of which are due exclusively or essentially to the geographical environment, including natural factors, human factors or both natural and human factors; a denomination which refers to a specific geographical area for the purpose of certain products, without being the denomination of a country, region or a specific place, also qualifies as such a geographical denomination.'

'Product' is defined as 'any natural, agricultural, handicraft or industrial product'.

The Bangui Agreement does not narrow the definition of appellations of origin merely to a specific geographical indication, as a matter of fact it goes on to say that, denomination which refers to a specific geographical area, without being the denomination of a country, also qualifies as a
geographical denomination. We can infer from this that unlike Sergio Escudero, this Agreement extends appellations of origin to include names that are not geographical denominations as such for example the Taj Mahal to denote an Indian product. See the table below that Escudero has provided:

<table>
<thead>
<tr>
<th>Appellation of origin (AO), According to the Lisbon Agreement.</th>
<th>Geographical indications (GI), According to TRIPS Agreement.</th>
</tr>
</thead>
<tbody>
<tr>
<td>AO designates a product. The product's name is the same as the AO. For instance “Champagne”, “Bordeaux”, etc.</td>
<td>GI identifies a good. This means that a GI could be any expression -not necessarily the name of the place of origin- that could serve the purpose of identifying a given geographical place. For instance the</td>
</tr>
<tr>
<td>AOs are necessarily geographical names of a country, region or locality, such as Porto, Jerez, Tequila.</td>
<td>GIs are any indication pointing to given locality, such as the symbol of the Eiffel Tower to designate famous French products.</td>
</tr>
</tbody>
</table>
AO considers the geographical environment where the product came from, including natural (soil, climate) and human factors.

GI also refers to the reputation of the product.

GIs use a more general concept of “geographical origin.”

GI also covers symbols.

In conclusion we have identified the three main concepts namely geographical indication, appellation of origin and indication of source.

Thus far indication of source has proved to be wider in that it refers to the designation of any country or place from which a product originated, exclusive of reputation or characteristic linked to its geographical origin.

“Appellation of origin” is the most specific concept. In this case the expression that is to be an “appellation of origin”, must correspond to the
designation of any country or place from which a product originated, exclusive of reputation or characteristic linked to its geographical origin.

"Appellation of origin" is the most specific concept. In this case the expression that is to be an “appellation of origin”, must correspond to the name of geographical region, including quality and characteristics which are essentially or exclusively attributable to the geographical origin, including natural and human factors.

Finally the term geographical indication, which is necessarily the name of a geographical place, and which could also be a symbol. A geographical indication is an expression that identifies the product as originating in a territory, region, or locality, where a given quality, or reputation, or other characteristic essentially attributable to the geographical origin. Case in point is the French or Chilean flag associated with quality wines produced in France or Chile.

All appellations of origin are geographical indications, but the reverse is not true. The provisions in the TRIPS Agreement, The Lisbon Agreement
and *The Paris Convention* are not clear on what is to be inferred by the terms such as "given quality", "reputation", and "other characteristics essentially attributable to the geographical origin." This therefore leaves some uncertainty and doubts.
INTERNATIONAL PROTECTION OF GEOGRAPHICAL INDICATIONS
PRIOR TO THE TRIPS AGREEMENT.

2.1. BACKGROUND

Prior to the TRIPS Agreement some international treaties such as the Paris Convention for the Protection of Industrial Property, The Madrid Agreement for the Repression of False and Deceptive Indications of Source on Goods of 1891 and the Lisbon Agreement for the Protection of Appellations of Origin contained provisions on the protection of indications of source and appellations of origin. However the effect of this protection was not as far reaching as it would have been intended. The Paris Convention spoke too generally on this issue and the latter Agreements had limited membership.

Both the Paris Convention and the Lisbon Agreement had a clear influence on the provisions of the TRIPS Agreement in general, but particularly in the case of geographical indications.

Substantive provisions contained in Articles 1 to 12 and 19 of the Paris Convention (1967) were incorporated in the TRIPS Agreement in respect of the
minimum standards concerning the availability, scope, and use of intellectual property, the enforcement of intellectual property rights and related \textit{inter partes} procedures.

This implies that members of the World Trade Organization (WTO) are to comply with the substantive provisions of the relevant articles of the Paris Convention, even if they were not signatories of that Convention. Secondly that all WTO members are bound by the same Act of the Paris Convention (Stockholm Act of 1967). Thirdly that the provisions of the Paris Convention incorporated in the TRIPS Agreement became subject to the WTO dispute settlement.

2.2. THE PARIS CONVENTION.

This was the first treaty that provided a multilateral agreement for the protection of indications of source and appellations of origin. Compared with the protection given by the TRIPS Agreement the protection under the Paris Convention was relatively weaker, nonetheless it was the first international treaty on protecting these categories of intellectual property rights.
Article 1(2) of the Paris Convention includes some indications of source and appellations of origin as subject matter of industrial property protection.

Article 10(1) provides for indications of source the same remedies prescribed in respect of goods unlawfully bearing a trademark or a trade name in case of direct or indirect use of false indication of source of the goods or the identity of the producer, manufacturer, or merchant.

"This means that no indication of source may be used that refers to a geographical area from which the products in question do not originate"

The Convention does not define appellations of origin but in Article 1(2) in defining the scope of protection of industrial property it provides as follows:

"The protection of industrial property has its objects patents, utility models, industrial designs, trademarks, indications of source or appellation of origin, and the repression of unfair competition."

The Convention treats indications of source and appellation of origin as synonymous, however we distinguished the two in chapter one. Indications of source are wider as they refer to the designation of any country or place from which a product originated, exclusive of the reputation or characteristic linked to its geographical origin. Appellation of origin is more specific as it must
correspond to the name of the geographical region, including quality and characteristics exclusively attributable to the geographical origin including natural and human factors.

Article 10 does provide the remedies in the case of false indication of source wherein the false indication is described as where the locality of the origin of a product is falsely indicated, or where the country is falsely indicated, which is closest that we come to a definition in this Convention. There is no reference to geographical indication but Article 10 does cover the false use of any name of a country that is not the actual producer of the goods in question. The real and actual source of the goods in question must be indicated.

There is no definition of geographical indications either in the Convention. In chapter one we concluded that a geographical indication is the name of a geographical place and which could also be a symbol. It is an expression that identifies the product as originating in a territory, region or locality, where a given quality or reputation or other characteristic essentially attributable to the geographical origin.

According to the Convention the main remedies for unlawfully bearing an indication of source are seizure of the product upon importation, or at least prohibition of importation, or seizure within the country. According to Article 10(2) of the Paris Convention, any
"Any producer, manufacturer, or merchant whether a natural person or legal entity, engaged in the production or manufacture of or trade in such goods and established either in the locality falsely indicated as the source, or in the region where such locality is situated, or in the country falsely indicated, or in the country where the false indication of source is used, shall in any case be deemed an interested party."

Article 10 of the Paris Convention does not refer to appellations of origin expressly. Nevertheless it should be understood that they are covered by the expression "indication of source" because: the Paris Convention treats both expressions as synonymous and that conceptually speaking, all appellations of origin constitute an indication of source.

Article 11bis of the Paris Convention obliges members to provide protection against unfair competition and contains a non-exhaustive list of some acts, which are to be prohibited. This provision gives the basis for the protection against misleading indications of source, including appellations of origin. The Paris Convention does not provide any remedies in the case of infringement of this provision.
2.3 THE MADRID AGREEMENT.

The Madrid Agreement was adopted in 1891 and revised in Washington (1911), The Hague (1925), London (1934), and Lisbon (1958). It was supplemented by the additional Act of Stockholm (1967), and had a membership of 33 signatory states as of January 5, 2001. In the last 25 years (1975-2000) only five new states became party to the treaty.¹

Unlike the Paris Convention, which is a general treaty providing a range of protection for a broad range of different categories of industrial property rights, the Madrid Agreement provides specific rules for the repression of false and deceptive indications of source.

According to Bauemer,

"Deceptive indications are those which although literally true, may be misleading. For example where two geographical areas, possibly in two different countries, have the same denominations but only one of them has been used so far for the purposes of an indication of source for certain products, and such indication is used for products originating from the other geographical area in a way that the public believes that the product originate from the first area, namely, the area to which the indication of source..."

traditionally referred, then such use is considered as a deceptive use because the public believes that the product originate from the geographical area for which the indication traditionally has been used.”

Article 1(1) of the Madrid Agreement provides that

“All goods bearing a false or deceptive indication by which one of the countries to which this Agreement applies, or a place situated therein, is directly or indirectly indicated as being the country or place of origin shall be seized on importation into any of the said countries.”

The Agreement also establishes rules on how seizure should take place and defines the competent authority to ensure these kinds of measures.

The Madrid Agreement does not add much to the protection already given by the Paris Convention in this respect. Nevertheless, it extends the protection to deceptive indications of source in addition to false indication. It also contains a special provision by which courts of each country can decide what indications of source do not fall within the provisions of the Agreement, because of their generic character; but regional appellations concerning the source of products of the vine are excluded from such reservation.

This provision in Article 4 of the Madrid Agreement could probably be considered the origin of the need for having special protection for certain geographical indications, specially for geographical indication concerning wines and spirits. It is also interesting to note that historically this provision was subject to various efforts to extend the exception for vine products to other products.

Geographical indications could be protected as collective marks, certification marks or guarantee marks.

2.3.1 Certification marks and Collective marks.

Certification marks are marks that indicate that the goods or services on which they are used have specific qualities, which may also include geographical origin. The owner of the certification mark undertakes to certify that the goods or services on which the certification mark is used have those qualities. As a basic rule, the owner of the certification mark does not have the right to use the mark. This principle is also referred to as the “anti-use by owner rule.”

Every producer who complies with standards of production as defined by the owner of the certification mark has the right to use that mark. The owner of the certification mark, who may be a private or public entity, must ensure that

McCarthy, McCarthy on Trademarks and Unfair Competition (fourth edition), page 19-179.
the goods or services on which the certification mark is used possess the certified quality. In order to carry out this certification function in a neutral and impartial manner, the owner of the certification mark has to file, together with the application for the registration of the certification mark, detailed regulations which prescribe, *inter alia*, the characteristics certified by the mark, the authorized users and details concerning the certification and control. As already pointed out, in order to safeguard the objectivity of the owner of the certification mark, he is not allowed to use the certification mark himself. Disregard of that rule regularly leads to the invalidity of the certification mark.

The *Standards Act Chapter 496 of the Laws of Kenya* enforces certification marks in Kenya. Consumers need some form of guarantee about the goods they purchase. This is achieved through the certification of products conforming to a standard and bears a distinctive mark indicating compliance. The Kenya Bureau of Standards (KBS) operates a Certification Scheme, whereby manufacturers producing goods in conformity with Kenya Standards are allowed to carry the KBS mark on the products or packaging. Part III and Section 9 in particular provides for the establishment of standards. This will be discussed in more detail in Chapter 3.

Section 9 of the Standards Act defines a Kenya Standard thus:

"(1) The Council may by notice in the Gazette-
(a) declare any specification or code of practice framed or prepared by the Bureau to be "Kenya Standard;"

Specification in the above section means a description of any commodity by reference to its nature, quality, strength, purity, composition, quantity, dimensions, weight, grade, durability, origin, age or other characteristics, or to any substance or material of or with which, or the manner in which, any commodity may be manufactured, processed, treated, tested or sampled.

Hence the Kenya Standard includes "origin" as a specification of the nature of a product, which brings us back to the protection of geographical indications. Although there is no express legislation on geographical indications in Kenya, indications of source are protected to some extent in the Standards Act.

The protection of a geographical indication in the form of a certification mark is enforced under general trademark law. In principle, the owner of the certification mark initiates an action for infringement of a certification mark.4

For example, this may be the case where the defendant uses a certification mark that certifies a specific geographical origin of goods, for goods not having that geographical origin.

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Collective marks

It has been pointed out that it is difficult to distinguish collective marks from certification marks, and that the difference is one of form rather than one of substance. Collective marks are owned by a collective body such as, for example, a trade association or an association of producers or manufacturers, and serve to indicate that the person who uses the collective mark is a member of that collectivity. Membership in the association that is the owner of the collective mark is, generally speaking, subject to compliance with certain rules, such as the geographical area of production of the goods on which the collective mark is used, or standards of production of such goods. A further difference between the two categories of marks is that the owners of collective marks are regularly not barred from using the mark themselves.

Like in the case of certification marks, the protection of collective marks is enforced under general trademark law. An action for infringement may be brought by the owner of the collective mark, for example in a case, where a collective mark is owned by an association of producers who are entitled to use the collective mark, and the mark is used by a person who is not a member of that association.

McCarthy, page 19-186.
Collective and certification marks are used in order to indicate specific qualities of goods such as their geographical origin. Whereas trademarks consisting of descriptive geographical terms are usually excluded from registration, geographical terms are typically admitted for registration as collective or certification trademarks. As long as collective and certification marks are used in a manner that respects the general regulations governing that use, there is no danger of deception as to the real origin of those goods. Once a geographical indication is protected as a collective or certification mark, that geographical indication can be enforced in accordance with the applicable rules of trademark law.

It appears that it lies within the competence of the applicant for the registration of a certification or collective mark to define, in the regulations which govern the use of those marks, the delimitation of the area of production of the goods on which those marks are used and any applicable standard of production. This definition is part of the specification to be filed together with the application.

With regard to collective and certification marks and also guarantee marks it would imply that an international system of registration such as the *Madrid Agreement Concerning the International Registration of Marks of 1981* and the Protocol relating to the *Madrid Agreement Concerning the International*...

See, for example, WTO document IP/C/W/134.
Registration of Marks of 1989, could serve as appropriate means for the international protection of geographical indications.

24. THE LISBON AGREEMENT AND THE PROTECTION OF APPELLATIONS OF ORIGIN.

This Agreement was concluded in Lisbon in on 31st October 1958. It was revised in Stockholm in 1967 and amended in 1979. Any member of the Paris Convention may accede to the treaty. As of 2002, there are only 20 states party to the Agreement.

There are two basic requirements for an appellation of origin to be protected, in accordance with the terms of this Agreement: (i) the appellation of origin should be protected in its country of origin, and (ii) the appellation of origin should be registered in the International Register of WIPO.

Article 2 of the treaty declares that the purpose of the Lisbon Agreement is to grant protection to a:

"...geographical name of a country, region or locality, which serves to designate a product originating therein, whose quality and characteristics are due exclusively or essentially to the geographical environment, including natural and human factors."
According to the Lisbon Agreement Regulations, applications for the international registration of an appellation of origin is to be addressed to the International Bureau in Geneva by the competent office of the country of whose name, or the country in which is situated the region or locality whose name constitutes an appellation of origin which has given the product its reputation. The competent office acts on behalf of any natural persons, or legal entities, public or private, having a right to use such appellation, according to their domestic law.

The competent office applying for registration may state that it renounces protection in one or some of the countries specified by name, which are party to the Agreement. The International Bureau shall decline any application if it is not in timely possession of all the information required or the competent office making the application has not paid the full amount of the registration fee.

Article 5 of the Regulations of the Lisbon Agreement, the International Register shall indicate, in respect of each appellation of origin, information on the country of origin; the competent office to receive notifications from the International Bureau; the registration date; the owner or owners of the appellation of origin; the appellation of origin itself; the product to which appellation of origin applies; the area in which the product is produced; the
title and date of legislative or administrative provisions or of judicial decisions recognizing the protection in the country of origin, among others.

The International Bureau needs to notify immediately the various members of the Agreement on an application for registration of an appellation of origin being made. Contracting Parties must protect the appellation of origin to which the applicant requested international protection, except if a Contracting Party declares, within a period of one year, that it cannot ensure the protection for a certain application, with indications of the grounds for that. Grounds for refusal are not indicated in the Agreement. Article 5(5) of the Agreement provides that interested parties may resort, in the refusing country, to all judicial and administrative remedies available to nationals of that country. Any competent office could modify, cancel or renounce its register.

The protection given by the treaty shall be ensured against any usurpation or imitation, even if the true origin of the product is indicated or if the appellation is used in a translated form or accompanied by terms such as “kind”, “type”, “imitation”, or the like.

Another effect of the protection given by the Agreement is that once an appellation of origin has been protected in on the signatory state, it cannot be deemed to become generic as long as it maintains the domestic protection in
the country of origin. It has also the effect that if a protected appellation of
origin has already been used by third parties (for instance as a trademark), and
from a date prior to the notification, the competent office of the country, where
the protection was given, shall have the right to grant to such third parties a
period not exceeding two years to terminate such use.

The duration of the protection of an international registration is for as long as it
is maintained protected as an appellation of origin in the country of origin.
There is no requirement for international renewal.

2.4.1. INTERNATIONAL REGISTRATION OF APPELLATION OF ORIGIN
UNDER THE LISBON AGREEMENT.

The Lisbon Agreement binds only a small number of Contracting Parties
specifically with regard to appellations of origin. By 2002, 20 countries of
Africa, Europe and Latin America had acceded to the Agreement. See the table
on the following page-
Table 1
Current status of ratification

Lisbon Agreement (1958), revised at Stockholm (1967), and amended in 1979
(Lisbon Union)

Status on April 15, 2002

<table>
<thead>
<tr>
<th>State</th>
<th>Date on which State became party to the Agreement</th>
<th>Latest Act of the Agreement to which State is party and date on which it became party to Act</th>
</tr>
</thead>
<tbody>
<tr>
<td>Algeria</td>
<td>July 5, 1972</td>
<td>Stockholm, October 31, 1973</td>
</tr>
<tr>
<td>Bulgaria</td>
<td>August 12, 1975</td>
<td>Stockholm, August 12, 1975</td>
</tr>
<tr>
<td>Burkina Faso</td>
<td>September 2, 1975</td>
<td>Stockholm, September 2, 1975</td>
</tr>
<tr>
<td>Conon</td>
<td>November 16, 1977</td>
<td>Stockholm, November 16, 1977</td>
</tr>
<tr>
<td>Cuba</td>
<td>September 25, 1966</td>
<td>Stockholm, April 8, 1975</td>
</tr>
<tr>
<td>Czech Republic</td>
<td>January 1, 1993</td>
<td>Stockholm, January 1, 1993</td>
</tr>
<tr>
<td>France</td>
<td>September 25, 1966</td>
<td>Stockholm, August 12, 1975</td>
</tr>
<tr>
<td>Gabon</td>
<td>June 10, 1975</td>
<td>Stockholm, June 10, 1975</td>
</tr>
<tr>
<td>Haiti</td>
<td>September 25, 1966</td>
<td>Lisbon, September 25, 1966</td>
</tr>
<tr>
<td>Israel</td>
<td>September 25, 1966</td>
<td>Stockholm, October 31, 1973</td>
</tr>
<tr>
<td>Italy</td>
<td>December 29, 1968</td>
<td>Stockholm, April 24, 1977</td>
</tr>
<tr>
<td>Mexico</td>
<td>September 25, 1966</td>
<td>Stockholm, January 26, 2001</td>
</tr>
<tr>
<td>Portugal</td>
<td>September 25, 1966</td>
<td>Stockholm, April 17, 1991</td>
</tr>
<tr>
<td>Republiof Moldova</td>
<td>April 5, 2001</td>
<td>Stockholm, April 5, 2001</td>
</tr>
<tr>
<td>Slovakia</td>
<td>January 1, 1993</td>
<td>Stockholm, January 1, 1993</td>
</tr>
<tr>
<td>Togo</td>
<td>April 30, 1975</td>
<td>Stockholm, April 30, 1975</td>
</tr>
<tr>
<td>Tunisia</td>
<td>October 31, 1973</td>
<td>Stockholm, October 31, 1973</td>
</tr>
<tr>
<td>Yugoslavia</td>
<td>June 1, 1999</td>
<td>Stockholm, June 1, 1999</td>
</tr>
</tbody>
</table>

(Total: 20 States)

Including all Overseas Departments and Territories.
Currently there are 766 registered appellations of origin under the Lisbon Agreement in force, belonging to 12 of the 20 members; the others have so far not registered any appellation of origin. These registrations are highly concentrated in a single country: France, which accounts for 66.3% of all registrations. Only six other member states namely: France, Czech Republic, Bulgaria, Slovak Republic, Hungary and Italy account for 94.3% of such registrations.

See the table below:

Table 2: Appellations of origin under the Lisbon Agreement arranged by country of origin.

<table>
<thead>
<tr>
<th>Country of origin</th>
<th>Number of registrations</th>
<th>Percentage of registrations</th>
</tr>
</thead>
<tbody>
<tr>
<td>France</td>
<td>508</td>
<td>66.3</td>
</tr>
<tr>
<td>Czech Rep.</td>
<td>73</td>
<td>9.5</td>
</tr>
<tr>
<td>Bulgaria</td>
<td>49</td>
<td>6.4</td>
</tr>
<tr>
<td>Slovak Rep.</td>
<td>38</td>
<td>5.0</td>
</tr>
<tr>
<td>Hungary</td>
<td>28</td>
<td>3.7</td>
</tr>
</tbody>
</table>
It can be seen that the bulk of the registrations belong to the European members notably the EU countries.

A staggering 84.1% of the protected products in this case correspond to only four different categories of products namely wines, spirits, cheese, tobacco and cigarettes. Appellations of origin for wines and spirits account for 70.9% of all internationals registration in force, as shown in the last column below of Table 3.

**Table 3: Protected products under the Lisbon Agreement**

<table>
<thead>
<tr>
<th>Country</th>
<th>Count</th>
<th>Percentage</th>
</tr>
</thead>
<tbody>
<tr>
<td>Italy</td>
<td>26</td>
<td>3.4</td>
</tr>
<tr>
<td>Cuba</td>
<td>18</td>
<td>2.3</td>
</tr>
<tr>
<td>Algeria</td>
<td>7</td>
<td>0.9</td>
</tr>
<tr>
<td>Tunisia</td>
<td>7</td>
<td>0.9</td>
</tr>
<tr>
<td>Portugal</td>
<td>6</td>
<td>0.8</td>
</tr>
<tr>
<td>Mexico</td>
<td>5</td>
<td>0.7</td>
</tr>
<tr>
<td>Israel</td>
<td>1</td>
<td>0.1</td>
</tr>
<tr>
<td>TOTAL</td>
<td>766</td>
<td>100</td>
</tr>
</tbody>
</table>

Source: WIPO statistics on appellations of origin under the Lisbon Agreement.
<table>
<thead>
<tr>
<th>Product</th>
<th>Number of registrations</th>
<th>%age of registration</th>
</tr>
</thead>
<tbody>
<tr>
<td>Wines</td>
<td>470</td>
<td>61.4</td>
</tr>
<tr>
<td>Spirits</td>
<td>73</td>
<td>9.5</td>
</tr>
<tr>
<td>Agricultural Product</td>
<td>51</td>
<td>6.7</td>
</tr>
<tr>
<td>Cheese</td>
<td>50</td>
<td>6.5</td>
</tr>
<tr>
<td>Ornamental Product</td>
<td>33</td>
<td>4.3</td>
</tr>
<tr>
<td>Tobacco &amp; Cigarettes</td>
<td>33</td>
<td>4.3</td>
</tr>
<tr>
<td>Miscellaneous</td>
<td>25</td>
<td>3.3</td>
</tr>
<tr>
<td>Mineral Water</td>
<td>17</td>
<td>2.2</td>
</tr>
<tr>
<td>Beer &amp; Malt</td>
<td>14</td>
<td>1.8</td>
</tr>
<tr>
<td>TOTAL</td>
<td>766</td>
<td>100</td>
</tr>
</tbody>
</table>

Source: WIPO statistics on appellations of origin under the Lisbon Agreement.

Escudero points out a very salient aspect of the registrations of appellations of origin, that is, the high proportion of registrations of appellations of origin for the same type of product, but at the same time belonging to the same country, as will be shown in Table 4 below. This seems to suggest a specialization of certain countries in a specific sector of products protected under an appellation of origin. For instance 81% of all registered appellations of origin for wines...
belong to France and 100% of all registered appellations of origin for tobacco and cigarettes, belong to Cuba.

Table 4: Proportion of appellations of origin (AO) registered for certain products belonging to the same country

<table>
<thead>
<tr>
<th>Product</th>
<th>Highest proportion of registered AO corresponding to</th>
<th>Proportion in response to all AO registered for such product (%)</th>
</tr>
</thead>
<tbody>
<tr>
<td>Wine</td>
<td>France</td>
<td>81</td>
</tr>
<tr>
<td>Spirits</td>
<td>France</td>
<td>82</td>
</tr>
<tr>
<td>Cheeses</td>
<td>France</td>
<td>74</td>
</tr>
<tr>
<td>Mineral water</td>
<td>Czech rep.</td>
<td>82</td>
</tr>
<tr>
<td>Beer &amp; malt</td>
<td>Czech rep.</td>
<td>93</td>
</tr>
<tr>
<td>Cigarettes</td>
<td>Cuba</td>
<td>100</td>
</tr>
<tr>
<td>Ornamental products</td>
<td>Czech Rep.</td>
<td>65</td>
</tr>
</tbody>
</table>

Source: WIPO statistics on appellations of origin under the Lisbon Agreement.
In conclusion it is noteworthy that the Lisbon Agreement has both developed and developing countries as its signatories. However, the presence of Francophone African countries suggests that it is more popular with the Francophone countries than the common law countries in the rest of Africa. In order to corroborate this conclusion we prepared the following table using the data in Tables 1 and 2.

<table>
<thead>
<tr>
<th>African member states</th>
<th>Total number of registrations</th>
</tr>
</thead>
<tbody>
<tr>
<td>Algeria</td>
<td>7</td>
</tr>
<tr>
<td>Burkina Faso</td>
<td>0</td>
</tr>
<tr>
<td>Congo</td>
<td>0</td>
</tr>
<tr>
<td>Gabon</td>
<td>0</td>
</tr>
<tr>
<td>Togo</td>
<td>0</td>
</tr>
<tr>
<td>Tunisia</td>
<td>7</td>
</tr>
</tbody>
</table>

As can be noted the seven African member states are all francophone countries. Further not all the Contracting Parties have so far registered appellations of origin. 12 countries, which are two-thirds of its membership, account for only about 3% of the registrations currently in force. Seven members have not yet
registered any appellation of origin. Six European countries together account for 95% of the registrations, mainly France, Czech Republic, Slovak Republic, Bulgaria, Hungary and Italy. Moreover three EU countries accounts for 70.5% of all registrations.

It was also observable that countries that are known to specialize in a particular product, have amassed registrations for those appellations of origin. For instance the largest number of registration of appellations of origin for wines and spirits belongs to France at 81% and 82% respectively. On appellations of origin regarding cheeses, 74% of them belong to France again. On the other hand, Cuba famous for its Havana cigars holds the total registration for tobacco and cigarettes, while the Czech Republic records 82% of the registrations for mineral water and 93% of appellations of origin for beer.

The implications are that the African countries still have a long way to go. There is the need to take advantage of the Lisbon Agreement since in the absence of local legislation one can protect a geographical indication using their membership. Tunisia and Algeria are the only African countries to register appellations of origin. The lack of local legislation should not be a hindrance to protecting potential geographical indication.
South Africa is a relative newcomer to the world of large scale wine production - most wine shops only began to see wines from South Africa after their conversion to a multiracial democracy. Almost all wineries are located in the south-western corner of South Africa, near Cape Town. The more well known include Swartland to its north, Paarl to its north-east, and Stellenbosch to its immediate east. Unlike many countries where wine regions are scattered and separated by wide areas of land, in South Africa they literally touch each other, forming a jigsaw of appellations immediately surrounding the city. The exceptions are the Orange River Valley and Douglas, further to the north. Most South African wines aren't labelled by region, but rather by grape variety and style, the grape itself, and the reputation of the winery that made the wine.

South Africa is the seventh largest wine producer has several quality wines to its name, but the protection given to geographical indications from European countries is bone of contention. South Africa has been producing “Porto”, “Sherry” and “Grappa” for centuries but can no longer use these terms as the Europeans protect them through appellations of origin. Porto is Portuguese whereas sherry comes from Jerez in Spain are protected under the WTO
All 15 EU member states are wine producers making the wine industry a powerful both politically and commercially.

South Africa has registered its famous wines as trademarks and not geographical indications. Some examples include Nederburg, which is the name of the Estate where this particular wine is produced and another is Western Cape, which is indicative of the geographical region where this drink is produced. Rustenberg is the name of another estate that produces wines however at the time of writing this dissertation, we could not verify whether it is registered as a trademark. According to the Article “EU signs accord to import duty free wine from South Africa”, local businesses are worried that in the follow-up negotiations EU negotiators will try to expand the range of terms banned from their products. They are also critical of government negotiators for giving more ground on trademarks than the WTO demands. The article goes on to say that whereas the international trading system protects trademarks recognised after 1995, South Africa has agreed to negotiate on trademarks registered before then. Therefore an estate like Nederburg risks losing its trademark because the name is similar to the German registered trademark, Niede Berg. "It's potentially a detrimental thing, because without trademarks, we cannot market our wines. There is monetary value in a name," says Willie de Klerk, the director of trade policy at KWV firm.
The article also points out that the European wines and spirits industries want to extend the ambit of intellectual property to include what they term "traditional expression" like chardonnay, sauvignon blanc, rose and others to protect their products. "These traditional expressions are part of the culture of the wines," says an EU negotiator. He says the soil, the climate and the grape variety are all intrinsically linked to form a unique product. More difficult negotiations are in the pipeline as the European Union tries to secure TRIPS commitments from South Africa.

South African negotiator Tshediso Matona said the trade-offs on 10 names were made in the national interest and that talks with the European Union were always tough. "It was necessary to conclude the whole agreement and it was made in the national interest," he said. EU ambassador to South Africa Michael Lake said the name changes South Africa agreed to, were a quid pro quo for greater market access. South Africa exports 80 percent of its wine to Europe and 42 million litres a year will now be duty free. A 15 million Euro (17.5 U.S. dollars) grant would help the industry make changes to ensure it was even more competitive - South Africa is the world's seventh largest producer of wine.\(^\text{10}\)

\(^{10}\) EU signs accord to import duty free wine from South Africa.© Woza Internet (Pty) Ltd.
Lake said the wine and spirits accord needs to be viewed in conjunction with the overarching trade, development and co-operation agreement, signed in 2000. This bilateral trade agreement had seen the trade surplus between South Africa and Europe shoot up drastically in South Africa's favour. "The trade surpluses in South Africa's favour grew from R6 billion Rand (528 U.S. dollars) in 1999 to R17 billion (1.5 million U.S. dollars) in 2000 to R25 billion (2.2 billion U.S. dollars) in the first 10 months of last year," said Lake.\(^{11}\)

According to Graham Howe,\(^{12}\) the protection of traditional expressions in wines through geographical indications is spelling more controversy. He says:

"The implementation of the new rules and regulations is likely to stir more controversy. You see, 'Western Cape' was omitted from the list of geographical indications specified in an annex to the EU/SA Wine and Spirit Agreement ... 'through a clerical error' admits the Department of Agriculture. They are 'taking the necessary steps to rectify the omission through the formal channels.' Wines bearing the indication 'Western Cape' have been allowed in Europe for many years - and the agreement already provides for its use as a wine growing region or sub-region of origin for wines originating in South Africa. The Western Cape was simply missing in action on the Brussels register.

\(^{11}\)EU signs accord to import duty free wine from South Africa. Supra.
\(^{12}\)Graham Howe, Cape© and Copyright wars, 04 July 2002.
Bergsig Estate of Worcester was forced to recall a consignment of 300 cases of Cape port destined for the UK market earlier this year. Marketing manager Deirdre Labuschagne, says they were one of the first Cape producers to phase out the use of the term port. Having complied with the EU regulations, they were then informed that they were not allowed to sell ruby, vintage and late bottled vintage on the UK shelf - or even use the word Cape on their new label. She complains, ‘we wanted to be one of the first with the new product on the export market - the new packaging cost us a lot of money. Port is a small part of our exports but it is very frustrating knocking our heads against a wall.’

...One step forward, two steps backwards. It's all very confusing. Tony Mossop, chairman of the SA Port Producers Association (SAPPA), reckons the use of Western Cape on wine labels is ‘a storm in a tea-cup’ compared to the threatened ban on the use of terms such as tawny and late bottled vintage on Cape port products.

He comments, ‘we have to persuade the EU that we make port wines in the same traditional styles. We need a professional lobbyist in Brussels - and we need a new generic name for ‘port’ from Australia and South Africa. We intend continuing the use of all these terms indefinitely until the EU withdraws its ridiculous restrictions.’ In the meantime, SAPPA warns it is reserving its position on its prior agreement to phase out the word ‘port’ because of the new restrictions on the use of descriptive terms such as vintage and ruby. It's not over yet.”
The above excerpt clearly shows the annoyance of the South Africans who have been at the wine business for centuries as well. For years, the bureaucrats of Brussels have been compiling a world register of wine terms specifying geographical origin, wine styles, alcohol strength, vintage, wine variety and vineyard name. This defeats the work done by the South African, who when it comes to tending to the viticulture spend equally on terms of finance and expertise. See for instance in the above example where Cape Port from the Bergsig Estate was sent back to South Africa causing undue inconvenience to the producers who had spent heavily on new packaging. The use of the word Cape is no longer open to South Africans regardless of whether they associate it with Cape town or not. Indeed the debate is raging on and it is far from over.

France has the bulk of registrations for wines and cheeses. These were fundamentally cottage industries. The skill to produce French wine has been mastered by the French over centuries. The reason why geographical indications can prove to be a gold mine is that agricultural products are afforded unique protection. For instance coffee is grown in Brazil, India, Sri Lanka, Colombia, Uganda and so on. There can be overproduction and this has happened in the past. Should Kenya register its arabica coffee as a
A geographical indication, it will set her coffee apart from the rest and hopefully secure a ready market coffee from Kenya.

The tables above also serve as a reminder that commercially, geographical indications can prove to be gold mine. A registered geographical indication affords the product a level of protection not available to other similar products. Hence coffee may be grown the world over, but once people know and associate a certain quality to a registered variety, they will always demand that quality. In this way one guarantees a market for their produce for as opposed to any brand of coffee available in the shops' shelves, the consumer will look for that certain brand from a specific geographical area to which a given quality or characteristic is attributable, possibly arabica coffee from Kenya! This may further enhance the popularity of Kenyan coffee and increase its sale in the international market, which can only serve to better the economy at home. The Americas, where arabica coffee is grown, produce approximately two thirds of the world's supply.¹³ This implies that Kenya needs to be swift in the registration of her coffee since arabica is grown in South and Central America. The eventual registration will obviously distinguish between the

Kenyan registration and the Latin American one since the registration will be the geographical name of the region in Kenya where the registered variety of coffee was actually grown. However there is no harm in capturing the market and let the quality of the product speak for itself. This is exactly what France, Cuba and the Czech Republic have done, as seen from table 4 above, they have registered appellations of origin in their area of specialization giving the consumer the impression that they are the undisputed masters in that area. Hence French wine and Cuban cigars will always get the thumbs up if there was a choice between them and similar products of any other country. We are not attributing their popularity entirely to the fact that they are protected as appellations of origin, however their protection does suggest that these products hold such esteem and regard that there is need to protect it. It shows that the product is worth something more than similar products of other geographical areas, hence the protection.

We need this kind of legislation to protect the arabica flavour of coffee and sell it to the rest of the world. Currently there is no such legislation because the current Geographical Indications Bill of 2001, which should on the most part be a domestication of the TRIPS 1994 Agreement, has still not been tabled in parliament. Moreover we are not members of the Lisbon Agreement.
The kind of products for which geographical indication is sought is certainly not limited to agricultural goods, the door is wide open. Kenya has several semi precious stones that can be made into ornamental wear and even this may afford protection as a geographical indication. All that is needed is good administration and legislation coupled with innovation.

2.5. BILATERAL AND PLURILATERAL AGREEMENTS.

According to S. Escudero, bilateral and plurilateral including regional agreements may also serve the purpose of protecting geographical indications internationally. A number of countries have already entered this type of agreement.

These agreements can adopt the very specific treaty referring only to geographical indications by listing them; such as the agreement adopted by Germany and France in 1960 for the protection of indications of source, appellations of origin and other geographical indications. In this case also a reference should also be made to the agreement between Australia and the United States of 1994, relating to the reciprocal protection of wine names and
related provisions, which is similar to that agreed between the European Union (EU) and Hungary in 1992, on trade in wines.

In 1994 Australia and the EU negotiated a bilateral trade in wine agreement, where protection for geographical indication and traditional expressions were included. It also included the phasing out of European wine names used by Australian wine makers that have entered into generic common use. The Agreement also provided for mutual recognition of ecological practices of each Party and improved European market access conditions for Australian products, by removing a number of technical barriers to trade between both Parties.¹⁴

In 1997 the EU and Mexico agreed on a mutual recognition and protection of designations for spirits (including wine spirit), which had the purpose of regulating the description, labelling, presentation and packaging of this kind of product. According to the Agreement, the 206 EU names protected in Mexico may not be used otherwise than under the conditions laid down in the laws and regulations of Mexico and were reserved exclusively to spirits originating in the EU to which they applied. The two protected Mexican names in the EU

¹ Sergio Escudero, supra p.II.5
may not be used otherwise than under the conditions laid down in the laws and regulations of Mexico and were reserved exclusively to spirits originating in that country to which they applied.\textsuperscript{15}

Escudero goes on to say that after more than three years of tough negotiations with South Africa (the first one with a developing country), the decision was taken at a summit of EU leaders held in Berlin in March 1999. The final Agreement was signed at Pretoria in October 1999. This free trade agreement covers industrial and agricultural good worth 16 billion Euros.\textsuperscript{16}

One of the key issues in the negotiations between the EU and South Africa, was the demand of some EU countries, led by France, Portugal and Spain, to phase out the use of terms such as “Oporto” or “Porto” (Portugal) and “Sherry” or “Jerez” (Spain) and the so called “traditional expressions” for wines such as “\textit{regional wines} or “\textit{vin de pays}”. Under the final accord South Africa agreed to phase out – within five years – the use of the terms “Porto” and “Sherry” for its exports to most parts of the world, and within eight years for exports to its neighbouring states (mainly Angola and Mozambique). For purposes of the domestic market the phase out period was twelve years and the use of new

\textsuperscript{1} Sergio Escudero, supra. PII.5
\textsuperscript{2} Sergio Escudero. Supra p. II.5
geographical indications should be negotiated after that period. South Africa agreed to use the terms "Tawny" and "Ruby" instead of "Sherry" and "Porto", respectively.

The Bangui agreement of 1977 relating to the creation of the African Intellectual Property Organization includes regional protection for different categories of intellectual property rights including appellations of origin.

In the last decade it has also become practice to incorporate provisions for the protection of specific geographical indications in some free trade agreements, such as the case of the North American free Trade Agreement (NAFTA) between USA, Mexico and Canada (1992) and the free trade agreement between Mexico and Chile (1998).

Finally regional and bilateral agreements, which provide protection to geographical indications, are notified to the TRIPS Council according to Article 4(d) of the TRIPS Agreement.
"With regard to the protection of intellectual property, any advantage, favour, privilege or immunity granted by a Member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other Members. Exempted from this obligation are any advantage, favour, privilege or immunity accorded by a Member:

...(d) deriving from international agreements related to the protection of intellectual property which entered into force prior to the entry into force of the WTO Agreement, provided that such agreements are notified to the Council for TRIPS and do not constitute an arbitrary or unjustifiable discrimination against nationals of other Members."
3.1. INTRODUCTION.

The TRIPS Agreement is today the most comprehensive multilateral agreement on intellectual property—copyright and related rights, trademarks, geographical indications including appellations of origin, industrial designs, patents including plant variety protection, layout designs of integrated circuits and undisclosed information including trade secrets.

In respect of the main areas of intellectual property covered by TRIPS Agreement, the agreement sets out the minimum standards of protection to be provided by the Members. The main elements of protection are defined—namely, the subject matter to be protected, the rights conferred and the permissible exceptions to those rights and the minimum duration of protection. The agreements sets these standards by requiring that the substantive obligations of the most recent versions of the main conventions of the World Intellectual Property Organisation (WIPO), the Paris Convention and the Berne Convention must be complied with.
The protection provided under the TRIPS Agreement has to be available to all the right holders from WTO members without discrimination to their nationality. The Agreement also specifies in some detail the procedures and remedies that must be available to the right holders to effectively enforce their rights with the assistance of judicial or other competent authorities. Disputes between WTO Members are referred to the Dispute Settlement Body established in Annex 2 of the TRIPS Agreement.

The various rights and obligations contained in the TRIPS Agreement apply equally to all members, except for the developing countries that had a transitional period until 2000, within which to comply with the Agreement and the least developed have until 2006.

In respect of geographical indications, the TRIPS Agreement reflects a very sensitive compromise in an area that was one of the most difficult to negotiate during the Uruguay Round. This sensitivity could be attributed inter alia, to the apparent growth in recognition of the commercial significance of geographical indications, in particular with respect to
agricultural and food products, for exporting countries that may rely upon the added value that geographical indications may bestow.¹

"As a result of the negotiations in the Uruguay round, trade in agricultural products is meant to come under the discipline of a rule-based system and a consequence thereof is believed to be that this might encourage moves towards added value in agricultural production and exports, since market shares will be increasingly determined by basic competitiveness rather than the ability and inclination to subsidize. Consequently, investments for the developments of quality products like high-value consumer-ready food preparations and other food and drink items might increase. At the same time, however, the demands for protection against misappropriation of the names or trademarks under which these products are marketed will be stronger as well as demands for the protection of other forms of intellectual property. In the Uruguay Round, the existence of such a connection has been recognized and, especially in the area of geographical indications, a link was made by some delegations between the negotiation of obligations in respect of trade in agricultural products and the negotiation of obligations to provide protection for geographical indications in the context of the TRIPS Agreement": Matthijs Geuze, "Protection of Geographical Indications under the TRIPS Agreement and Related Work

¹ Dariel De Sousa, “Protection of geographical indications under the TRIPS Agreement and related work of the World Trade Organisation” in Symposium on the International Protection of Geographical Indications, WIPO/GEO/MVD/01/2.

3.2 GEOGRAPHICAL INDICATIONS – SECTION 3 OF TRIPS.

Section 3 of TRIPS 1994 concerns with following categories of issues:

1/ Definition and scope of geographical indications.

2/ Minimum standards and common protection provided for geographical indications corresponding to all kinds of products.

3/ Additional protection for geographical indications for wines and spirits.

4/ Negotiation and review of Section 3 on geographical indications.

5/ Exceptions to the protection of geographical indications.

3.2.1. DEFINITION AND SCOPE OF GEOGRAPHICAL INDICATIONS

In Section 3, Article 22.1 of TRIPS, geographical indications are defined as:

"Geographical indications are, for the purposes of this Agreement, indications which identify a good as originating in the territory of a Member¹, or a region or

² See footnote 1 in Dariel DeSousa’s article. Supra.
³ Member of the World trade Organisation
locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.”

This definition is apparently based on the definition of appellation of origin in Article 2 of the Lisbon Agreement. However, it deviates from Article 2 of the Lisbon Agreement in some respects. Article 21.1 of the TRIPS Agreement defines geographical indications as “indications which identify a good [...]” whereas Article 2 of the Lisbon Agreement defines appellations of origin as “the geographical name of a country, region, or locality, which serves to designate a product [...]” 4 Article 2 of the Lisbon Agreement would not cover signs other than geographical names, for example a non-geographical name or an emblem. However, they would fall into the category of signs that could constitute geographical indications under the TRIPS Agreement. Furthermore, the Lisbon Agreement requires that the quality and the characteristics of the product in question be due exclusively, or essentially, to the geographical environment, including natural and human factors. The TRIPS Agreement covers goods that have a given quality, reputation or other characteristic that is essentially attributable to their geographical origin. It is generally understood that goods which have “merely” a certain reputation, but not a specific quality being due to their place of origin, are

4 Emphasis added.
not covered by the definition of appellation of origin as provided by the Lisbon Agreement.

According to TRIPS a geographical indication need only be an indication and not necessarily the name of a geographical place on earth. Thus the Eiffel Tower on a French product may operate as a geographical indication but not an appellation of origin under the Lisbon Agreement. This also indicates that the goods to be protected must originate in the territory, region or locality to which it is associated. This means that licenses for the use of geographical indications cannot be protected under TRIPS.

We find it appropriate to reiterate the comparisons between geographical indications, indications of source and appellations of origin. Indication of source is the broadest since it comprises both geographical indications and appellations of origin. Indications of source require that the product originate in a certain geographical area. Thus there are indications of source that are covered by the definition of geographical indications in the TRIPS Agreement, namely those whose use on products does not imply a quality, reputation or characteristic of those products. Geographical indications are more broadly defined than appellations of
origin, since all of the latter can be geographical indications but not all geographical indications can be appellations of origin.

One needs to be weary of the fact that appellations of origin, indications of source and geographical indications are used in different international instruments. Rights and obligations that flow from those instruments will vary and exist only in relation to the "geographical indication" that is being referred to in the instrument.

3.2.2. MINIMUM STANDARDS AND COMMON PROTECTION

Article 22 of TRIPS provides protection for all geographical indications. In this respect, WTO Members should provide the legal tools so that interested parties can prevent the use of any means in the designation or presentation of a good that indicates or suggests it originates in a certain area, other than the true geographical origin of the good. They can also prevent any use that constitutes an unfair competition act, within the meaning of Article 10bis of the Paris Convention. See Article 22 (2) below.
“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).”

The Article does not provide the kinds of legal means; this is left to the Members themselves.

The use of the geographical indication must be such that it is false as to the origin of the good and this falsity must be one that misleads the public. Therefore according to Article 22 the use of a geographical indication that does not mislead the public should not be considered an infringement of TRIPS.

Article 22 (2b) goes on to say that where the use of a geographical indication constitutes an act of unfair competition, then the same should be as within the meaning in Article 10bis of the Paris Convention.
Stemming from this, it means that if the act of unfair competition falls within domestic legislation then this would not be an unfair act of competition unless the act constitutes an unfair act within Article 10bis.

Hence no other meaning of “act of unfair competition” is permissible except for under Article 10bis; not even domestic legislation.

Article 22 (3) reads as follows:

“3. A Member shall, ex officio if its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in that Member is of such a nature as to mislead the public as to the true place of origin.”

With regard to trademarks the article provides that where a trademark contains or consists of a geographical indication with respect to goods not originating in the territory indicated, then the Member may refuse or invalidate the registration of that trademark, but only if the use of the geographical indication in that trademark misleads the public as to the true origin of the product. A case in point is:
The “Spanish Champagne” case [(1961) R.P.C 116 at p. 127; (1960) R.P.C. 16 at p.17, line 50.] where a number of champagne producers sued in respect of the sale of Spanish sparkling wine as “Spanish Champagne,” an injunction was granted restraining the defendants from passing off “as wine produced in the district of France known as the Champagne District, wine not so produced by advertising, offering for sale or selling the same as Spanish champagne or under any other name or description that includes the name champagne.”

Another case in point is from the European Court of Justice- **Consorzio per la tutela del formaggio Gorgonzola v Käserei Champignon**

Hofmeister GmbH & Co. KG and Eduard Bracharz GmbH the defendants sold a registered designation of origin for cheese as per the **Stresa Convention** (International Convention for the use of designations of origin and names of cheeses) of 1951. The cheese was registered as ‘Gorgonzola’ and sold as ‘Cambozola’. The question was if the use of the name ‘Cambozola’ might be deemed to erode the protected designation of origin ‘Gorgonzola’, the plaintiffs applied for an order prohibiting the marketing in Austria of a blue cheese under the designation ‘Cambozola’

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5 Case C-87/97 (reference for a preliminary ruling from the Handelsgericht Wien (Austria) ): Judgment of the Court of 4 March 1999, Case-Law Of The Court Of Justice Of The European Communities.

and requiring cancellation of the 'Cambozola' trade mark. It was held that the use of a name such as 'Cambozola' may therefore be deemed, for the purposes of Article 13(1)(b) of that regulation, to evoke the protected designation of origin 'Gorgonzola', irrespective of the fact that the packaging indicates the product's true origin. Section 13(1)(b) provides that 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;"

It was further held that it is for the national court to decide whether, on the facts, the conditions laid down in Article 14(2) of Regulation No 2081/92 (see below) to allow use of an earlier trade mark to continue notwithstanding the registration of the protected designation of origin 'Gorgonzola', having regard in particular to the law in force at the time of registration of the trade mark, in order to determine whether such registration could have been made in good faith, on the basis that use of a name such as 'Cambozola' does not, per se, constitute an attempt to deceive the consumer. Please note that Article 13 and 14 referred to in this case are of Council Regulation (EEC) No 1981/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ L 208, p. 1). They lay down
the conditions for the continuing use of a trademark, which may be incompatible with a designation of origin in respect of which an application for registration has been lodged after the trademark was registered.

'With due regard for Community law, use of a trade mark corresponding to one of the situations referred to in Article 13 which was registered in good faith before the date on which application for registration of a designation of origin or geographical indication was lodged may continue notwithstanding the registration of a designation of origin or geographical indication, where there are no grounds for invalidity or revocation of the trade mark as provided respectively by Article 3(1)(c) and (g) and Article 12(2)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks.'

In implementing Section 3 of the Agreement, Members should not diminish the protection that was already afforded to geographical indications in that Member country prior to the date of entry into force of the TRIPS Agreement. (See Article 24.3 under part 3.2.5.)

In accordance with Article 24.9 of TRIPS, there is no need to protect geographical indications that are no longer protected in their country of
origin or have fallen into disuse in their country. This is the golden rule for the protection of any geographical indication. Thus protection is dependent on continuous domestic protection.

3.2.3. ADDITIONAL PROTECTION FOR GEOGRAPHICAL INDICATIONS FOR WINES AND SPIRITS.

"Article 23 - Additional Protection for Geographical Indications - for Wines and Spirits

1. Each Member shall provide the legal means for interested parties to prevent use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like."[4]

Article 23 provides a more stern and absolute form of protection in relation to geographical indications for wines and spirits. Pursuant to the

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[4] Notwithstanding the first sentence of Article 42, Members may, with respect to these obligations, instead provide for enforcement by administrative action.
above article parties may protect the geographical indication identifying wines and spirits not originating in the place indicated by the geographical indication in question. This applies even where the use of such geographical indication does not mislead the public; where the use might not amount to an act of unfair competition; where the true origin might be indicated; or where the geographical indication might be accompanied by expressions such as “kind”, “type”, “style”, “imitation” or the like.

“2. The registration of a trademark for wines which contains or consists of a geographical indication identifying wines or for spirits which contains or consists of a geographical indication identifying spirits shall be refused or invalidated, ex officio if a Member's legislation so permits or at the request of an interested party, with respect to such wines or spirits not having this origin.”

The above subsection allows refusal or invalidation of registration of a trademark for wines and spirits that contains or consists of a geographical indication identifying wines or spirits at the request of an interested party.
Article 23.4 below calls negotiations between Members to increase the protection for individual geographical indications for wines alone. Article 23.3 and 23.4 provide further protection to wines alone and not spirits.

"3. In the case of homonymous geographical indications for wines, protection shall be accorded to each indication, subject to the provisions of paragraph 4 of Article 22. Each Member shall determine the practical conditions under which the homonymous indications in question will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled.

4. In order to facilitate the protection of geographical indications for wines, negotiations shall be undertaken in the Council for TRIPS concerning the establishment of a multilateral system of notification and registration of geographical indications for wines eligible for protection in those Members participating in the system."

3.2.4. HISTORIC BACKGROUND TO WINE PROTECTION.

With regard to appellations of origin the system to protect them was developed out of a need to remedy against the fraudulent commercial practices involving the origin of agricultural products particularly
products of the vine. From the beginning of the 13th century, the wines of Bordeaux (an area under the English crown from 1152 to 1435) were commonly shipped to England and the low countries of Holland and Belgium. By the 14th century wines from Spain and Portugal were widely exported, drinking habits were largely governed by the changing fashions at court, political relations with wine producing countries, and changing rates of excise and duties. During the 18th century heavy duties on French wines and an English alliance with Portugal led to a sharp increase in English consumption of Portuguese wine. For convenience in commerce the Bordeaux merchants classified their red wines as early as 1725. In 1855, such classification, based on the market price for each wine received official recognition. Until 1986 this 1885 classification stood with only one significant change.8

Fraudulent practices are as old as the trade itself, they occurred increasingly when there was a shortage of supply of certain products, such as was the case in 19th century when phylloxera destroyed many European vineyards.9

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9 Girardeau (WIPO Publication No. 764), page 70.
In Morocco at the Marrakesh Ministerial Meeting, Article 23 of the TRIPS Agreement was part of the single undertaking adopted at that meeting. Over time this has become a contentious issue. The question is can this additional protection be labelled as a simple North South or rich poor divide or is there more to this argument. Those for the additional protection claim that this was a valid discussion negotiated at the Uruguay Round and consequently added to the TRIPS Agreement. Those who oppose the argument say that it discriminates against other products and there is no valid reason to refuse the extension of that protection to all kinds of geographical indications.

We observe that the wine producing countries have been at this for centuries. A lot of care is taken in wine production. Designations of geographical origin (such as France's Appellation d'Origine Contrôlée, or AOC, or AC, system) are based on soil type, climate factors, grape varieties, and local winemaking traditions. This appellation contrôlée or quality control law is now the model for similar legislation in other

\[10\] "Wine," Microsoft® Encarta® Encyclopedia 2000. © 1993-1999 Microsoft Corporation. All rights reserved.
countries.\textsuperscript{11} Countries like USA, Spain and Italy are also major producers of wine. Countries from the southern hemisphere include South Africa, Argentina which is the sixth largest producer, Australia and Chile which is a huge exporter compared to the other South American nation of Argentina where consumption is mainly at home.\textsuperscript{12}

Hence we have both rich and poor nations that produce wine and therefore one cannot label this as a North South divide. However it has to be acknowledged and we observe that wine is an expensive beverage and wine production is also an expensive task. There is demand for wine and the consumers usually are the upper classes in our socially stratified society. Having said that it is also true that wine has a guaranteed clientele, as it is a cultural aspect of European life. Through colonization, settlement and influence the wine culture has spread all over the world. The same could be argued for tea and coffee, but the end product is not as pricey as the wines, hence the additional protection. This could be the rationale behind the additional protection to wines: the fact that protection for it has been sought since 1725 (see above) and that wine is a dear commodity.

\textsuperscript{12} Microsoft Encarta (supra)
According to Dariel De Sousa\textsuperscript{13} Argentina, Australia, Canada, Chile, Guatemala, New Zealand, Paraguay and the United States oppose the extension of additional protection to products other than wines or spirits. They see the extension of Article 23.1 to products other than wines and spirits as going beyond the mandate in Article 24.1 below, and could only be negotiated in the context of a new Round. In their view, the negotiating mandate in Article 24.1 (below) concerns only “individual geographical indication”, not whole product areas, focusing on those geographical indication in respect of which a country applying an exception under Article 24, for the purpose of exploring the scope of discontinuing the application of the exception with regard to a particular geographical indication.

“1. Members agree to enter into negotiations aimed at increasing the protection of individual geographical indications under Article 23. The provisions of paragraphs 4 through 8 below shall not be used by a Member to refuse to conduct negotiations or to conclude bilateral or multilateral agreements. In the context of such negotiations, Members shall be willing to consider the continued applicability of these provisions to individual geographical indications whose use was the subject of such negotiations.”

Further, they:

\textsuperscript{13} Dariel De Sousa supra. P.8
(a) point to the legal and administrative costs associated with extending the scope of Article 23.1;

(b) argue that there is no evidence of failure of Article 22 to protect geographical indications for products other than wines and spirits and that, similarly, there is no evidence to indicate whether extending the scope of Article 23.1 to products other than wine and spirits would result in more effective protection than is already afforded to those products under Article 22;

(c) suggest that additional protection could close-off of future market access opportunities for emerging industries and result in uncertainty concerning the continued use in existing markets;

(d) argue that consumer confusion would be caused through the disappearance of terms customarily used to identify products which will, in turn, increase search and transaction costs for consumers and potentially prices as well.

Advocates of this view argue that differential treatment as between wines and spirits on the one hand and other products on the other is justified since the additional level of protection provided under Article 23 is the
result of a negotiating compromise reached in the broader context of the Uruguay Round negotiations.

This brings us to the argument of those against additional protection for wines. They say that equal protection should be afforded to all geographical indication.

In September 2000, a paper\(^{14}\) was submitted to the TRIPS Council by Bulgaria, the Czech Republic, Iceland, India, Liechtenstein, Slovenia, Sri Lanka, Switzerland and Turkey concerning the issue of the extension of the additional protection under Article 23 of the Agreement to products other than wines and spirits.

These countries favour extension of the protection currently accorded to geographical indications for wines and spirits under Article 23 of the TRIPS Agreement to other products. Other proponents of this position include Cuba, Egypt, Georgia, Hungary, Kenya, the Kyrgyz Republic, Moldova, Mauritius, Nigeria, Pakistan and Venezuela.\(^{15}\) These Members have pointed out that the WTO Membership already agreed at the Singapore Ministerial Conference that proposals on the scope of the

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\(^{14}\) IP/C/W/204/Rev.1.  
\(^{15}\) IP/C/W/247/Rev.1.
product coverage under Article 23 of the Agreement are allowed and take the view that Article 24.1 provides an avenue for such proposals. They consider that negotiations in relation to this item is built into the TRIPS Agreement and to reinforce their demands, they have linked progress or the lack thereof to other built-in agenda items of WTO Agreements, in particular, those relating to liberalisation of trade in agricultural products. They argue, among other things, that:

(a) additional protection of geographical indications for all products adds value for exports because it increases the chances of market access for such goods;

(b) without the additional protection, free-riding is possible and there is a risk that geographical indications will become generic over time;

(c) the test contained in Article 22, which currently applies to products other than wines and spirits leads to legal uncertainty in the enforcement of protection for geographical indications;

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16 In its 1996 annual report, the TRIPS Council listed Article 24.1, under which Members agree to enter into negotiations aimed at increasing the protection of individual geographical indications under Article 23, as one of the built-in agenda items of the TRIPS Agreement.

17 In particular, it is argued that pursuant to the test contained in Article 22 to which products other than wines and spirits are subject, a producer may use a geographical indication for his product, even if it does not originate in the relevant territory provided that the product’s true origin is indicated on the label. Thus, it is argued, a producer can profit from the use of a “famous” geographical indication by arguing that the consumer has not been misled.

18 It is argued in this respect that since Article 22 does not prevent the use of geographical indications in translation or accompanied by expressions such as “style”, “type”, “kind”, “imitation” or the like, over time, geographical indications may become generic terms.
(d) Article 22 places a costly burden of proof on the producer entitled to use a geographical indication to show that the public has been misled, or that there has been an act of unfair competition.

Advocates of this view have also argued that there is no justification for the differential treatment between, on the one hand, wines and spirits and, on the other hand, other products.

This is a valid argument as in doing so the TRIPS Agreement is guilty of double standards. It protects the geographical indication for wines even where the public is NOT misled, yet the false use of a geographical indication for any other product is not protected unless the public has been misled.

In our opinion this can only be attributed to the commercial significance of wine. The whole WTO setup has liberalization and free trade economies as its major concern; globalization with all its inherent difficulties has the effect of further establishing the established and giving little leeway to the least developed and developing countries. The

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19 The supporters of this argument state that the interpretation by national authorities of what constitutes “misleading the public” differs from country to country. This will lead to inconsistent decisions and legal uncertainty regarding the protection granted to geographical indications and its enforcement at the international level.
additional protection for wines has been given mainly due to the commercial success and the apparent ready clientele.

3.2.5. Homonymous geographical indication

We now look at the case of homonymous geographical indications for wines as per Article 23.3 above. The dictionary meaning of the word homonym is a word that is spelt or pronounced in the same way as one or more other words but has a different meaning.

In the case of homonymous geographical indications (that is, different geographical indications which consist of or contain the same identifier), protection must be accorded to each homonymous indication.\textsuperscript{20} For instance “Rioja” is the name of a wine produced in the wine producing regions of La Rioja in both Spain and Argentina. This is a result of Europeans settling in new found lands and taking their skills of wine growing and the like to those countries. The similarity in names has led to confusion as in the case of “La Rioja” above.

The Agreement contains a specific rule concerning homonymous geographical indications for wines. In the case of homonymous geographical indications for wines...
geographical indications, protection could be claimed for one against the use of the other(s) (there may be more than two) with the possible result that neither or none of them could be used. Therefore, the Agreement lays down a rule that each WTO Member has to apply in respect of such geographical indications.\footnote{Subject to the exceptions provisions of Article 24.}

Thus, in each of the Members in which homonymous geographical indications exist, practical conditions must be determined to differentiate the homonymous indications. This can be by taking into account the need to ensure equitable treatment of the relevant producers, and to ensure that consumers are not misled.

However, if use of one of the homonymous geographical indications in a given WTO Member would falsely represent to the public in that Member that the products in question originate in the territory of another of the homonymous geographical indications, the beneficiaries of the geographical indication of the products to which the public in that Member will thus link the other geographical indication used must be entitled to prevent use of this other homonymous identifier. This is provided for in Article 22.4 of TRIPS as follows:
“4. The protection under paragraphs 1, 2 and 3 shall be applicable against a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory.”

The TRIPS Agreement therefore provides protection to homonymous geographical indications for wines in Article 22.3 subject to Article 22.4. According to Sergio Escudero, this does not constitute additional protection. He says that two homonymous indications could coexist and protection should be granted to each of the indications, according to practical conditions determined by each WTO Member. The obligation to protect homonymous geographical indication is only provided for wines. For other products only a single protection should be considered.

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3.3. NEGOTIATION AND REVIEW OF SECTION 3 ON GEOGRAPHICAL INDICATIONS.

Article 24 provides that Members agree to enter into negotiations aimed at increasing the protection to individual geographical indication under Article 23. It is argued that individual geographical indication only applies to wines and spirits, however other Members see the provision as extending to additional protection for geographical indication for wines and spirits to all kinds of products.

The same article 24 calls upon the Council for TRIPS to keep under review the application of the provisions of Section 3 of the Agreement, indicating that the first of such reviews shall take place within two years of the entry into force of the WTO Agreement. Any matter affecting the compliance with the obligations under the provisions of the Agreement may be drawn to the attention of the Council with any Member in respect of that matter.
3.4. EXCEPTIONS TO THE PROTECTION OF GEOGRAPHICAL INDICATIONS.

Article 24 contains a number of exceptions regarding the protection of geographical indications. Three main exceptions are of particular relevance to the additional protection of geographical indications for wines and spirits.

Firstly Article 24.3 provides that a Member is not allowed to diminish the protection of geographical indications that existed in that Member immediately prior to the entry into force of the WTO Agreement. The TRIPS Agreement should not be seen as granting absolute protection to geographical indications; it allows Members to increase protection for geographical indications. TRIPS in essence provides the minimum standards of protection. See Article 24.3 below:

"3. In implementing this Section, a Member shall not diminish the protection of geographical indications that existed in that Member immediately prior to the date of entry into force of the WTO Agreement."
Secondly Article 24.4 provides that a Member will not be prevented from using a geographical indication for wines and spirits that was used 10 years prior to the Uruguay Round (15th April 1994) and in good faith, where the indication has not become generic and a preexisting trademark right does not exist. Such a member may continue to use that geographical indication for a similar use. Dariel De Sousa\textsuperscript{23} says that “similar use” has been taken to mean that the subsequent use must be similar in scale and nature. See Article 24.4:

"4. Nothing in this Section shall require a Member to prevent continued and similar use of a particular geographical indication of another Member identifying wines or spirits in connection with goods or services by any of its nationals or domiciliaries who have used that geographical indication in a continuous manner with regard to the same or related goods or services in the territory of that Member either (a) for at least 10 years preceding 15 April 1994 or (b) in good faith preceding that date."

\textsuperscript{23} Dariel De Sousa, “Protection of geographical indications under the TRIPS Agreement and related work of the World Trade Organisation” in Symposium on the International Protection of Geographical Indications, WIPO/GEO/MVD/01/2.
Article 24.5 deals with the situation where a trademark that is identical to a geographical indication was registered and or acquired in good faith prior to the date of application of the provisions of TRIPS or prior to the protection of the geographical indication in its country of origin.

Measures adopted to implement Section 3 of Part II shall not prejudice the eligibility for or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with or similar to a geographical indication. See Article 24.5 below:

"5. Where a trademark has been applied for or registered in good faith, or where rights to a trademark have been acquired through use in good faith either:

(a) before the date of application of these provisions in that Member as defined in Part VI; or

(b) before the geographical indication is protected in its country of origin;

measures adopted to implement this Section shall not prejudice eligibility for or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication."
Lastly a Member state is not obliged to protect a geographical indication in cases where the geographical indication has become the generic name in a country for the products in question or for a grape variety. See Article 24.6 below:

"6. 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 customary in common language as the common name for such goods or services in the territory of that Member. 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 products of the vine for which the relevant indication is identical with the customary name of a grape variety existing in the territory of that Member as of the date of entry into force of the WTO Agreement."

In conclusion it must be said that TRIPS is the only Agreement with the largest signatory membership regarding geographical indications and provides a wide coverage as well. Section 3 was enacted only after complex and difficult negotiations and even described as sensitive.

The provisions on geographical indications cover all products, wines and spirits, and gives added protection to wines alone. The Agreement as it
stands grants stronger and special protection to wines compared to other products.

There is possibility for change through the negotiating and review process.
4.1. INTRODUCTION.

In this chapter we intend to look at what the implications are of the TRIPS Agreement on the Kenyan legislation. We also intend to look at what the Kenyan legislation can learn or improve on what is provided in the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of 1958, hereinafter the Lisbon Agreement, and the Madrid Agreement for the Repression of False and Deceptive Indications of Source on Goods of 1891, hereinafter the Madrid Agreement.

We intend to look at the following aspects in the proposed Kenyan Legislation in the form of the Geographical indications Bill, to which we do not have access, but we will look at what can be described as the main aspects of this legislation. We will source information about the main aspects from what we have already looked at in the preceding chapters with special regard to TRIPS, and where necessary The Lisbon Agreement and The Madrid Agreement.

We have identified the following main aspects relating to legislation for geographical indications:
1/ The meaning and definition of geographical indications.

2/ The procedures applied in the recognition of geographical indications both new and old.

3/ Persons who are entitled to use a protected geographical indication and the procedures to obtain such entitlement; the duration of protection of geographical indications; cancellation or forfeiture; and monitoring the use thereof.

4/ The protection available for the unauthorized use of such geographical indications to those who are not within the geographical area and to those authorised users who are not using the indication properly.

5/ The enforcement procedures.

6/ the relationship of trademarks, including protection provided to prevent the registration as trademarks of signs containing or consisting of geographical indications.
If we assume that the definition in the Geographical Indications Bill will be the replica of that in the TRIPS Agreement of 1994 then we may be looking at the following definition of geographical indications as per Article 23(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."

The term indication of source is used in the Paris Convention for the Protection of Industrial Property of 1883 and in the Madrid Agreement. There is no definition of indications of source in the aforementioned treaties, but Article 1(1) of the Madrid Agreement contains language which clarifies the meaning of the term. The Article reads as follows:

"All goods bearing a false or deceptive indication by which one of the countries to which this Agreement applies, or a place situated therein, is directly or indirectly indicated as being the country or place of origin shall be seized on importation into any of the said countries."

Therefore an indication of source can be referred to a country or a place therein and because of which it only relates to the geographical origin of a
product and not to any other kind of origin, for instance an emblem or famous landmark of a country. This definition also does not imply any special quality or characteristics of the product on which the indication of source is used. Examples include the mention of the source on the product—“Made in Kenya”.

The term appellation of origin is defined in the Lisbon Agreement, and could be said to be the forerunner of the current definition of “geographical indications” in TRIPS. It incorporates the quality and characteristics attributable to a geographical region examples include “Jaffa” oranges and “Noix de Grenoble” for nuts. Article 2(1) of the Agreement defines appellations of origin as follows:

“Appellation of origin” means 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 exclusively or essentially to the geographical environment, including natural and human factors.”

We conclude that the definition given to geographical indications in Article 22.1 of TRIPS is an all encompassing definition that does not protract the definition to the names of geographical region alone. It also covers signs other than names such as emblems unlike the appellations of origin definition in the
Lisbon Agreement that only covers the geographical names. Moreover the
Lisbon Agreement requires that quality **and** characteristics in question be due
exclusively or essentially, to the geographical environment, including
natural and human factor. The TRIPS Agreement covers goods that have a
given quality or characteristic or other reputation that is essentially
attributable to the geographical origin. It is generally understood that goods
that have “merely” a certain reputation, but not a specific quality being due to
the place of origin are not covered by the definition of appellations of origin as
in the Lisbon Agreement.

We insist that the definition of geographical indications in the TRIPS
Agreement is best as it has a wider coverage. The Lisbon Agreement requires
that some quality and characteristic be due exclusively or essentially to a
region which implies that in any product both **quality** and **characteristic** must
be proved to be of value, and only this would allow the registration thereof as
an appellation of origin. Quality alone or a characteristic alone will not suffice.
This closes the door on the number of registrations in agricultural products
since most can only boast of either one or the other. For example in Kenya
coffee is sold under the Nescafe brand and Dormans Coffee. The Kenya
Bureau of Standards passes both and we may conclude that quality wise the
two are similar; a regulatory body passes both. The two may however differ in
their tastes which we refer to as the “characteristic” under the definitions in
both the Lisbon Agreement and TRIPS. Under the hypothetical scenario above if Dorman wanted to register its coffee as a geographical indication of the region where it is grown, then in order to satisfy the definition of appellations of origin under the Lisbon Agreement it would have to prove that the intended registration possesses both quality and characteristics attributable to that specific region. Under the definition in TRIPS on the other hand Dormans need only show that their coffee has a certain quality or characteristic or reputation attributable to that region and not necessarily all three of them. This may result in the registration of more geographical indications than appellations of origin.

Kenya is a self confessed agricultural nation, the dream to become industrialised by 2020 is not progressing at rate which will see us achieve that goal in some 17 years. If we can create an environment that allows for the recognition of the quality of both our tea and coffee, in this case their registration as geographical indications, may fetch higher prices for our produce in the wealthier Western markets. This is by selling a name rather than the product. Western nations have done it and we should do the same. Sell the name of a region and make the consumer pay for that name. This could lift the country from the economic gloom. One may argue that other countries may take advantage and sell the same product at a lower price; but by putting lower priced brands on the market this problem may be solved.
The target being all types of consumers that is, the wealthy and the not so.

Hence the geographical indications definition in TRIPS is preferable.

4.3. THE PROCEDURES FOR THE RECOGNITION OF GEOGRAPHICAL INDICATIONS BOTH NEW & OLD.

Fraudulent practices are as old as the trade itself, they occurred increasingly when there was a shortage of supply of certain products, such as was the case in 19th century when *phylloxera* destroyed many European vineyards.\(^1\) As mentioned in chapter three the French had already sought to protect their wine as early as 1885.

Appellations of origin are titles of protection for geographical indications. The recognition of a protected appellation is usually based on a legislative or administrative act, such as law or decree. This act is at the conclusion of an administrative procedure involving representatives of the producers concerned and the administration, as a result of this procedure, the protected appellation of origin is recognized, and the product or products on which it is

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\(^1\) Girardeau (WIPO Publication No. 764), page 70.
used, the geographical area of production and the conditions of use are defined.2

Unauthorized use of a protected appellation of origin constitutes an offence and engages the criminal and civil responsibility of the person who has made such use. Proceedings are usually instigated by public law bodies, such as fair trading bodies, authorities entrusted with the administration of protected appellations of origin or consumer protection bodies. Often, authorities competent for the enforcement of fiscal laws play an important role in prosecuting the fraudulent use of protected appellations of origin.3

Registered geographical indications are titles of protection that are very similar to appellations of origin, differences as to the scope of protection and applicable procedure may exist depending on the national laws of those countries that apply that kind of protection. Thus, the protection of a registered geographical indication depends on the registration of that particular geographical indication, whereas registration of an appellation of origin usually is subject to the adoption of a specific law or decree. The decision to register geographical indications may be an administrative decision, for example a determination of a committee, rather than an executive

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2 Symposium on the International Protection of Geographical Indications, *Introduction to Geographical Indications and Recent International Developments in WIPO*, Montevideo, 2001, page 7-WIPO/GEO/MVD/01/1

3 Supra- WIPO/ GEO/ MVD/ 01/1. Page 7.
Kenya has never registered any geographical indications nor do we have any legislation relating thereto hence the idea of recognition of geographical indications that were already registered does not arise. However she will have to recognise the internationally registered geographical indications in accordance with the principle of *pacta sunt servanda*. This is an absolute postulate of the international legal system and manifests itself in one way or another in international law. States are bound to carry out the obligations that they have assumed by treaty. Since Kenya is a member of the WTO and a signatory of TRIPS then it must recognise the geographical indications that have been registered in the rest of the Members of the WTO.

In addition Kenya has not so far experienced any problems with homonymous names with regard to geographical indications. The Latin European and Latin American nations have this problem due their common Latin roots and the similarity in language and products. For instance the issue of La Rioja which is a wine producing area in both Spain and Argentina. This problem can only solved by countries engaging in bilateral or multilateral agreements in order

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4 Vienna Convention on Treaties, 3rd recital of preamble (affirming that the principle of free consent, good faith and *pact sunt servanda* are universally recognised.) and Art 26 that all treaties are binding on the parties thereto, and must be performed by them in good faith.
to solve the problem. According to Federico Mekis⁵, from the Asociación de Viñas in Chile, the only legally recognized Chilean geographical indications are “pisco,” “pajarete” and “vino asoleado.” They are reserved for certain alcoholic beverages produced and bottled in particular areas of the country. Of the Chilean geographical denominations referred to above, “pisco” is the only one that is challenged by another country. “Pisco” is a legally recognized geographical indication in Chile, and any conflict existing with the equivalent Peruvian denomination should be settled by appropriate negotiations within the framework of the rights and obligations laid down in international law.

We must keep abreast of any developments in this area of recognition of homonymous geographical indications as we may find ourselves in the same situation as other neighbouring countries develop their own geographical indications, these may conflict with ours due to the similarity in the languages.

**Conclusion**

Kenya may adopt the legal protection for the geographical indications that involves the registration of a geographical indication by an administrative

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decision through a committee so that that committee can comprise of individuals best suited to determine what qualifies as a geographical indication and what steps need to be taken to ensure that the product does indeed live up to the expectations. This may include persons in the committee who can certify that a product from a particular region is indeed capable of being registered as a geographical indication and ways of ensuring the products' quality, reputation or characteristic. This may include verifying the quality or type of seeds, the type of soil for cultivation and methods of processing.

4.4. PERSONS ENTITLED TO USE A PROTECTED GEOGRAPHICAL INDICATION AND THE PROCEDURES TO THEREOF.

In this section we also intend to look at the duration of protection of geographical indications; cancellation or forfeiture; and monitoring the use thereof.
Persons Entitled

The persons entitled to use the geographical indications are the eventual right holders, which may be legal persons in the country of origin. In the International scene under the TRIPS Agreement the rights holder is referred to as the Member since the "person" referred to is the member country and not an association or federation.⁶

The Lisbon Agreement is more elaborate on the persons who are entitled to obtaining registration which in this case is for appellations of origin. Article 5 paragraph 1 provides as follows:

"(1) The registration of appellations of origin shall be effected at the International Bureau, at the request of the Offices of the countries of the Special Union, in the name of any natural persons or legal entities, public or private, having, according to their national legislation, a right to use such appellations."

The Lisbon Agreement provides that a right holder may be any natural person or legal entity, public or private. However the definitions of what may constitute the entity is left to the national legislations. It has been suggested in the Geographical Indications Bill that the only people allowed to use

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⁶ An exception exists in Part III of TRIPS where the term "right holder" includes federations and associations having legal standing to assert such rights.
geographical indications are the producers who carry out the production of the registered geographical indication in the specified geographical origin.\(^7\)

In any case the natural person or legal entity who is entitled to use the geographical indication must be able to verify that they are indeed the registered right holders as there is the possibility that infringing parties may take advantage of their proximity to a registered geographical location and pass off goods as being the genuine item. There needs to be a system in place through which one can verify the rights holder. This can be done through the issuing of licences and certificates that verify the authenticity. There needs to be a system that is recognized internationally, so that the country of importation knows exactly how to verify the genuineness of the goods or in extreme cases whom to contact in the exporting country to verify the goods.

**Procedures For the Registration of Geographical Indications**

The TRIPS Agreement does not lay down procedures for the registration of geographical indications; the Lisbon Agreement on the other hand has a more elaborate system. If the law were to be enacted in Kenya, we contend that the

\(^7\) Intellectual Property Law, class notes, 2002. (Instructor Dr Mbote)
registration system under the Lisbon Agreement should be considered. It elaborates on a system of application that the Kenyan legislation may adopt. In the List of Rules under the Regulations under the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, Rule 1 provides the following for application:

**Rule 1**

**Form and Contents of the Application**

(1) Applications for the international registration of an appellation of origin shall be addressed to the International Bureau of the World Intellectual Property Organization in Geneva, Switzerland (hereinafter referred to as "the International Bureau" and "the Organization" respectively), by the competent Office of the country of origin as defined in Article 2 of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (hereinafter referred to as "the Agreement").

(2) The application shall be drawn up in French on the form supplied by the International Bureau; it shall be dated and signed by the Office making the application and shall contain the following indications:

(i) the country making the application;

(ii) the Office competent to receive notifications from the International Bureau;
(iii) the owner or owners of the appellation of origin;

(iv) the appellation of origin whose registration is requested;

(v) the product to which the appellation applies;

(vi) the area in which the product is produced;

(vii) the title and date of legislative or administrative provisions or of judicial decisions recognizing protection in the country making the application.

The above Rule covers the aspects involved in the registration of an appellation of origin; a similar system may be employed for geographical indications under the proposed Geographical Indications Bill. The Rule covers the name of the geographical indications, its owners, the Body or Office responsible for it in the country of origin, the area that the indication covers and the product to which the application applies. The Rule is formulated for an international agreement therefore some changes will be necessary to adopt it in a domestic setting. The Rule talks of international registration, which in the Kenyan context would mean that the registering office would be KIPO-Kenya Industry Property Office.
We see that the procedures of recognition need to encompass the provisions in
the Lisbon Agreement as it provides the main aspects of the registration and
application of the geographical indications for the recognition thereof.

4.4.1. Duration, Cancellation or Forfeiture

The TRIPS Agreement does not provide the duration for geographical
indications. In Article 24 paragraph 9 there is the provision that where
geographical indications are ceased to be protected in their country of origin,
or which have fallen into disuse in that country, then there is no obligation to
protect them under the TRIPS Agreement.

The Lisbon Agreement provides for the cancellation of appellations of origin
and or their modification in Rule 5(1) of the Agreement. See below:

(1) Any Office which has applied for international registration may at any time
request the International Bureau to cancel that registration, notify the latter that it
renounces protection in one or some of the countries, specified by name, which are
party to the Agreement or request it to modify the indications referred to in Rule
4(2)(ii), (viii), (ix) and (x). Likewise, any Office which has made a declaration under
Article 5(3) of the Agreement or granted a period under Article 5(6) of the Agreement
may at any time request a modification of the indications referred to in Rule 4(2)(xi) and (xii).

Where the appellations of origin are to be modified then the same must be registered afresh. Rule 5-sub rule 4

(4) Modifications relating to the country of origin, the owners, the appellation of origin or the product to which it applies shall necessitate a new international registration.

Both TRIPS and Lisbon Agreement do not give duration for the validity of a geographical indication; this is left to the national legislations. The geographical indications are registered for a period of time and are renewable which suggests that they can last forever.

Cancellation and duration provisions in the Kenyan legislation should be clear. The Lisbon Agreement provides extensively on the cancellation and modification and could serve as a reference to the proposed Bill.
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)."

Article 22.2 (b) above provides in addition that legal means must be provided to prevent the use of geographical indication which constitutes an act of unfair competition within Article 10bis of the Paris Convention which is worded as follows:

"any act of competition contrary to honest practices in industrial or commercial matters", in particular:

"All acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial and commercial activities, of a competitor;

"False allegations in the course of trade of such a nature as to discredit the establishment, the goods or the industrial and commercial activities, of a competitor;

- "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 quality of the goods."

The Lisbon Agreement provides the following in Article 3:
"Protection shall be ensured against any usurpation or imitation, even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as "kind," "type," "make," "imitation," or the like."

In Article 4 it includes that the protection provided to appellations of origin under the Paris Convention and the Madrid Agreement:

"The provisions of this Agreement shall in no way exclude the protection already granted to appellations of origin in each of the countries of the Special Union by virtue of other international instruments, such as the Paris Convention of March 20, 1883, for the Protection of Industrial Property and its subsequent revisions, and the Madrid Agreement of April 14, 1891, for the Repression of False or Deceptive Indications of Source on Goods and its subsequent revisions, or by virtue of national legislation or court decisions."

The agreements can only provide the general standard of protection, how a country goes about doing this will depend on its national legislation. The TRIPS Agreement which is of greater concern to us, cannot possibly provide in what manner the Members should protect the geographical indication since protection is largely an issue of consumer protection, false trade practices and an act of unfair competition. It only provides additional protection to wines
and spirits in that infringement of a geographical indication may be deemed even where the public has not been misled.\(^8\)

### 4.5.2. Existing Approaches for the Protection of Geographical Indications

In the *Introduction to Geographical indications and Recent International Developments in WIPO\(^9\)* it is provided that the protection of geographical indications on the national and regional levels is characterized by the existence of a variety of different legal concepts. Those concepts were developed in accordance with different national legal traditions and within a framework of specific historical and economic conditions. These differences have a direct bearing on important questions such as condition of protection, entitlement to use and scope of protection. The document provides in the following paragraphs, the main existing concepts of protection: Unfair competition and passing off, protected appellations of origin and registered geographical indications, collective and certification trademarks, and administrative schemes of protection. Given the large variety in national laws

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\(^8\) Article 23 para1-1. Each Member shall provide the legal means for interested parties to prevent use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like.

\(^9\) Supra, page 4.
and regulations concerned with the protection of geographical indications, a division into four different categories is necessarily artificial and may not precisely reflect the situation in every Member State. It is therefore possible that a mechanism of protection exists in a Member State that does not necessarily fall into any of those four categories as defined.

Furthermore, the document alerts one that the mechanisms described do not necessarily apply on an exclusive basis. On the contrary, cumulative application of different means of protection is very common. Cumulative protection of geographical indications under different systems of protection is accentuated by the existence of different means of protection for different categories of products.

4.5.3. Unfair Competition and passing off

Unfair competition

Unfair competition may be defined as per the Paris Convention for the Protection of Industrial Property of 1967 in Article 10bis as any act of competition contrary to honest practices in industrial or commercial matters.

At the national level protection against unfair competition has developed differently in different countries. However there is the common objective to provide those in trade with an effective remedy against unlawful and
dishonest business practices of their competitors. A determination of whether a given commercial act is contrary to honest practices in industrial or commercial matters will have to be made in application of national laws for the protection of unfair competition. However, it is accepted that commercial practices which are misleading, or are likely to mislead the public with respect to an enterprise or its activities, in particular, the geographical origin of products offered by such enterprise, constitute an act of unfair competition.\textsuperscript{10}

The current Kenyan legislation does not provide for geographical indications and their protection. The closest that the legislation comes is in the form of the \textbf{Trade Descriptions Act} which is a very comprehensive piece of legislation dealing with common commercial malpractices in the sale of goods and services.

Section 3 of the Act prohibits the false trade description of goods and provides thus:

"any person who in the course of trade or business

(a) applies a false trade description to any goods or

(b) supplies or offers to supply any goods to which a false trade description is applied

shall be guilty of an offence subject to the provisions of the Act."

\textsuperscript{10} See Article 4(2)(iv) of the WIPO Model Provisions on Protection Against Unfair Competition (WIPO Pub. No.832), and TRIPS Article 22.2(b).
The Act protects both consumers and traders alike by making it an offence to mislead consumers and to carry out misleading practices. The two major offences are applying a false trade description and supplying or offering to supply in the course of trade or business any goods to which a false trade description is applied.

Under the Act in Section 8 a trade description is defined as a direct or indirect indication of any of certain specified matters, our concern are the following:

Section 8(1 h) provides that a trade description includes the direct or indirect indication of the place or date of manufacture, production, processing or reconditioning. A description such as Norfolk King Turkey and Havana cigars appears to fall under this section. A case in point is:

*Beckett v. Kingston Brothers (Butchers) Ltd.*

The defendant sold a turkey labeled “Norfolk King Turkey” to the plaintiff. The turkey was as a matter of fact from Denmark. This was held to be an offence under Section 2 of the English Trade Descriptions Act which is Section 8 of the Kenyan Trade Descriptions Act.

By extension we can say that this section does cover geographical indications as it includes the “place of manufacture” as the trade description and any falsity thereto would be an offence. The section does not expressly provide for geographical indication and does not require that certain characteristics be
attributable to that region; it does however protect “indications of source”
according to the definition we accorded to it in the previous pages.11

In section 10(1 a) the term “applies” is given a wider meaning:

“Any person applies a trade description to goods if he

(a) affixes or annexes it to or in any manner marks or incorporates it with (i) the
goods themselves or

(ii) anything in, on or with which the goods are supplied or

(b) places the goods in, on or with anything to which the trade description has been
affixed, annexed to, marked on or incorporated or places any such thing with the goods
or

(c) uses the trade description in any manner likely to be taken as referring to the

This provision covers markings on the goods themselves example labeling;
markings on anything in which the goods are supplied example packaging;
markings on anything in which the goods are placed for example display units.

11 Therefore an indication of source can be referred to a country or a place- the geographical
origin of a product and not to any other kind of origin, for instance an emblem or famous
landmark of a country. This definition also does not imply any special quality or characteristics of
the product on which the indication of source is used. Examples include the mention of the source
on the product- “Made in Kenya”.

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and vending machines. The first two are of concern to us so where the label says that a product is "Swiss made" when in actual fact it is not then one can invoke the provisions of the **Trade Descriptions Act**.

Under our current set of laws we contend that the **Trade Descriptions Act** provides the best protection of indications of source even though there is no express provision for it. However the wordings and provisions of the Act are supportive of protection indications of source. Geographical indications can also be covered by the Act since a geographical indication in its name refers to the geographical origin, it indicates the source of that geographical indication, we can therefore implicitly apply the provisions of the Act to protect it.

In order to prevent the unauthorized use of a geographical indication on the basis of an action against unfair competition, a plaintiff must regularly show that the use of the geographical indication in question by an unauthorized party is misleading and, as the case may be, that damages or a likelihood of damages result from such use. Such an action can only be successful if the geographical indication in question has acquired distinctiveness; in other words, if the relevant public associates goods sold under that geographical indication with a distinct geographical origin and/or certain qualities or reputation.
Specific statutory provisions can supplement the protection of geographical indications. According to Introduction to Geographical indications and Recent International Developments in WIPO, sections 126 to 129 of the German Trademarks Act of 1994 provides for the protection of unregistered geographical indications. Under these provisions, natural and legal persons having the right to use a given unregistered geographical indication are entitled to request courts to prevent use of that geographical indication by unauthorized parties and, as the case may be, to accord damages for such use. Sections 126 to 129 of the German Trademarks Act of 1994 are based on principles developed by the courts in applying the law against unfair competition in order to prevent unauthorized use of geographical indications, if such use would be misleading or would take unfair advantage of the reputation of a geographical indication.

**Passing off**

In the Kenyan setting “passing off” is covered under the law of tort and is based entirely on the common law. In the case of trademark infringement passing off is usually the claim that the aggrieved party pleads.

Supra page 5.
The action arose in the 19th Century and depends upon the simple principle that a man is not to sell his gods or his services under the pretence that they are those of another man. It has five elements: (a) a misrepresentation, (b) made by a trader in the course of business, (c) to prospective customers of his or ultimate consumers of goods and services supplied by him, (d) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence) and (e) which causes or threatens actual damage to a business or goodwill of the trader by whom the action is brought.

In countries that follow the common law tradition, the action of passing off is often considered as the basis of protection against dishonest business competitors. The passing off action can be described as a legal remedy for cases in which the goods or services of one person are represented as being those of somebody else. What is common to these cases is that the plaintiff loses customers because the defendant led them to believe that they were buying the plaintiff’s goods, when they actually obtained the goods of the defendant.

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13 Spalding and Bros v. A.W.Gamage Ltd. (1915) 84 L.J. Ch. 449 at 450, per Lord Parker.
The action arose in the 19th Century and depends upon the simple principle that a man is not to sell his gods or his services under the pretence that they are those of another man. It has five elements: (a) a misrepresentation, (b) made by a trader in the course of business, (c) to prospective customers of his or ultimate consumer s of goods and services supplied by him, (d) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence) and (e) which causes or threatens actual damage to a business or goodwill of the trader by whom the action is brought.

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13 Spalding and Bros v. A.W.Gamage Ltd. (1915) 84 LJ. Ch. 449 at 450, per Lord Parker.
Very broadly speaking, in order to prevent the unauthorized use of a geographical indication through a successful action for passing off, a plaintiff must establish that goodwill or reputation is attached to the goods on which the geographical indication is regularly used and which are supplied by him, that the defendant misrepresents to the public that the goods offered by him originate from the plaintiff and that he is likely to suffer damage from such a misrepresentation.

Conclusion

The proposed bill may incorporate in its provisions that the remedy for unfair competition and passing off are available where there is infringement of a registered geographical indication; otherwise through the reception clause in the Judicature Act of Kenya section 3 which adopts the common law and the doctrines of equity *inter alia* as within the jurisdiction of the High Court of Kenya.

National laws on the protection against unfair competition, passing off and unregistered geographical indications provide a course of action for traders against competitors who perform commercial acts which are considered to be
contrary to honest business practices. With respect to geographical indications, it can be said that protection against unfair competition serves to protect traders and producers from the unauthorized use of geographical indications by third parties rather than creating individual property rights in them.

Another important characteristics of the protection of geographical indications under the law against unfair competition is that important determinations, such as the area of production, standards of production and the circle of producers who are entitled to use a given geographical indication, are made by the courts in the course of legal proceedings. Protection accorded to geographical indications following a lawsuit based on passing off or unfair competition is only effective between the parties of the proceedings. The entitlement to protection of a given geographical indication must be demonstrated every time enforcement of the protection of that geographical indication is sought.

The question that remains is whether this can be of practical use in a developing country. The emphasis should therefore be on the consumers, are they discerning enough to want only the best and the most genuine article or are they simply content that the item is available. The problem is not peculiar to all developing countries but the issue is there. Is the Kenyan consumer
satisfied with only the best or will a cheaper substitute suffice. This is beyond the scope of this dissertation however considering the harsh economic times we can safely assume that in the majority of cases the cheaper substitute is sought.

Secondly Kenyans as consumers are not vocal in their demands for instance the price of bread goes up and there is disappointment but not public outcry, unnecessary taxes are placed on mobile calls and we accept that. Is such a society going to take advantages of the remedies provided by in civil law? This can be achieved where the Kenya Consumers Organisation maintains a constant flow of information to administrators in government and the private sector to enable consumer protection achieve a stronghold in our society. In addition to this the consumer should be made aware of his rights. This may be the best way to promote a desire for the best quality in the goods we as consumers purchase and to turn to the law when there is abuse of the consumer rights.

Possibly the most effective approach to protection of geographical indications in developing countries is through the use of criminal law which will leave it up to the authorities to deal with wrongful use of a geographical indications. Kenya for instance is not a litigious society, moreover advocates fees can be out of reach for the mwananchi who is the potential or eventual consumer.
Section 7 of the Trade Descriptions Act Chapter 505 of the Laws of Kenya makes it an offence where a false trade description is applied to any of the goods outside Kenya and the false indication, or one of the false indications, given, or likely to be taken as given, thereby is an indication of the place of manufacture, production, processing or reconditioning of the goods or any part thereof, the importation of the goods shall be prohibited and any person or persons handling or dealing with the goods shall be guilty of an offence.

4.5.4. Protected appellations of origin and Registered geographical indications

Protected appellations of origin

As already mentioned in part 4.2 above according to Introduction to Geographical indications and Recent International Developments in WIPO\textsuperscript{16} the recognition of a protected appellation of origin is usually based on a legislative or administrative act, such as a law or a decree. This act is at the conclusion of an administrative procedure involving representatives of the producers concerned and the administration. As a result of this procedure, the protected appellation is recognized, and the product or products on which

\textsuperscript{16} Supra page 7.
it is used, the geographical area of production and the conditions of use are defined. Unauthorized use of a protected appellation of origin constitutes an offence and engages the criminal and civil responsibility of the person who has made such use. Proceedings are usually instigated by public law bodies, such as fair trading bodies, authorities entrusted with the administration of protected appellations of origin or consumer protection bodies. Often, authorities competent for the enforcement of fiscal laws play an important role in prosecuting the fraudulent use of protected appellations of origin.

Registered geographical indications

Registered geographical indications are similar to protected appellations of origin; differences emerge as to the scope of protection and the procedure applicable thereto in the national laws of the different countries. Introduction to Geographical indications and Recent International Developments in WIPO sums the difference in that the protection of geographical indications may be an administrative decision, rather than an executive which permits the registration of the geographical indications whereas the protection of appellations of origin is subject to the adoption of a specific law or decree.

In conclusion the most important specific feature that is common to protected appellations of origin and registered geographical indications appears to be
that their legal protection is based on an act of public law (law, decree, ordinance) which stands at the conclusion of an administrative procedure. Through this administrative procedure, important parameters such as the demarcation of the area of production and production standards are defined. Those parameters are applied by law enforcement agencies, either under civil or under criminal law, when determining whether a given protected appellation of origin or registered geographical indication is used without authorization or in a manner contrary to the prescribed mode of use.

In Kenya we do not have any registered geographical indications or protected appellations of origin. However the Geographical Indications Bill is to provide for registration of geographical indications and the procedure related thereto. We envisage that once the system for registration is in place then any infringement of such registered geographical indication will result in civil and or criminal liability.

4.5.5.Certification and Collective marks

We have already defined collective and certification marks in Chapter 2 but we will reiterate the same. Certification marks are marks which indicate that the goods or services on which they are used have specific qualities, which may also include geographical origin. The owner of the certification mark
undertakes to certify that the goods or services on which the certification mark is used have those qualities. The owner of the certification does not have the right to use that mark. This is also referred to as the "anti-use by owner rule."\textsuperscript{17}

According to McCarthy it is difficult to point out a difference, which is one of form rather than substance. Collective marks are owned by a collective body such as a trade association or an association of producers and manufacturers, and serve to indicate that a person who uses that collective mark is a member of that collectivity. Membership in the association is subject to compliance with certain rules such as geographical area of production of the goods on which the collective mark is used, or standards production of such goods. A further difference between the two categories is that the owners of collective marks are regularly not barred from using the mark themselves.

In the case of certification marks and collective marks their protection is enforced under general trademark law. An action for infringement may be brought by the owner of the collective mark, for example in a case, where a collective mark is owned by an association of producers who are entitled to use the collective mark, and the mark is used by a person who is not a member of that association.

\textsuperscript{17} McCarthy, McCarthy on Trademarks and Unfair Competition (4th Edition), page 19-179.
Collective and certification marks are used in order to indicate specific qualities of goods such as their geographical origin. Whereas trademarks consisting of descriptive geographical terms are usually excluded from registration, geographical terms are typically admitted for registration as collective or certification trademarks. As long as collective and certification marks are used in a manner that respects the general regulations governing that use, there is no danger of deception as to the real origin of those goods.\textsuperscript{18}

Once a geographical indication is protected as a collective or certification mark, that geographical indication can be enforced in accordance with the applicable rules of trademark law.

It appears that it lies within the competence of the applicant for the registration of a certification or collective mark to define, in the regulations which govern the use of those marks, the delimitation of the area of production of the goods on which those marks are used and any applicable standard of production. This definition is part of the specification to be filed together with the application.

The \textbf{Standards Act Chapter 496 of the Laws of Kenya} enforces certification marks in Kenya. Consumers need some form of guarantee about the goods

\textsuperscript{18} See, for example, WTO document IP/C/W/134.
they purchase. This is achieved through the certification of products conforming to a standard and bears a distinctive mark indicating compliance.

The Kenya Bureau of Standards (KBS) operates a Certification Scheme, whereby manufacturers producing goods in conformity with Kenya Standards are allowed to carry the KBS mark on the products or packaging. Part III and Section 9 in particular provides for the establishment of standards.

Section 9 of the Standards Act defines a Kenya Standard thus:

"(1) The Council may by notice in the Gazette-

(a) declare any specification or code of practice framed or prepared by the Bureau to be Kenya Standard;"

Specification in the above section means a description of any commodity by reference to its nature, quality, strength, purity, composition, quantity, dimensions, weight, grade, durability, origin, age or other characteristics, or to any substance or material of or with which, or the manner in which, any commodity may be manufactured, processed, treated, tested or sampled.

Hence the Kenya Standard includes "origin" as a specification of the nature of a product, which brings us back to the protection of geographical indications.
Although there is no express legislation on geographical indications in Kenya, indications of source are protected to some extent in the Standards Act.

4.5.6. Administrative schemes for protection

Where geographical indications are used on goods the marketing of which is subject to an administrative approval procedure, this procedure may be applied also for controlling the use of geographical indications applied to those goods. The example that comes readily to mind is wines and spirits, the sale of which is regulated in many countries.

Under an administrative approval procedure for product labels, the authority entrusted with the administration of that scheme controls whether the product for which marketing authorization is sought complies with relevant legal requirements, including the permitted use of a geographical indication on the label of the product. If the requirements for approval are not met, for example, because the use of a given geographical indication on a specific product is not permitted, marketing approval is not granted and, consequently, the geographical indication cannot be used.
4.5.7. Conclusion

Administrative schemes of label control are a means of ensuring fair trade and consumer protection. Depending on the national system that is in place in a given country, the objective of fair trade and consumer protection may be followed by different legal instruments, such as unfair competition acts, fair trading acts or marketing acts for certain products laying down standards of product presentation and marketing. The latter two examples have in common that, as far as geographical indications are concerned, they do not enable the holders of the collective goodwill attached to a geographical indication to take individual action in order to protect that goodwill. Rather, they provide for an administrative mechanism aiming at preventing misleading use of geographical indications on products. Where such misleading use occurs despite the administrative procedures to be followed, usually criminal sanctions will apply.

In Kenya we have identified the Trade Descriptions Act and the common law in the specific area of torts that operate as the administrative scheme for protection.

Turning to another the question whether appellations of origin are the best way to protect all tradable goods. The answer is to the negative since
On the other hand trademarks allow the protection of good as well as services, see the definition in TRIPS Article 15 (Section 2) under the heading **Protectable Subject Matter** below:

"1. Any sign, or any combination of signs, capable of distinguishing the **goods or services** of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant **goods or services**, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible."

Services can be protected through the use of service marks which are defined as marks identifying the source of a service. Most of the law on trademarks is the same for service marks. In most cases services are deemed fall under trademarks and therefore registrable as such, for instance William M. Landes and Richard Posner in a simplistic way describe trademarks as a word, symbol, or other signifier to distinguish a good or service produced by one firm from the goods or services of other firms. The TRIPS Agreement does not distinguish the two either. See article 15 above where again the protectable matter under Trademarks includes both goods and **services**.

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Trademarks and service marks are distinct in whether the mark is used with goods or services. The manner of fixing the mark is of significance in seeking registration. There is some difference on how the mark is associated with the goods or services. Goods commonly have labels, where services have no place to put a label. For nearly all other practical purposes trademarks and service marks are treated the same. For example "XEROX" is the name of a company; it is also used as a trademark pertaining to printers; and "XEROX" is also used to identify certain services provided by the company. (The ® symbol signifies that a trademark or service mark is registered with the U.S. Patent and Trademark Office. The use of TM or SM signifies a mark intended to be a trademark or service mark. Holiday Inn® is a registered service of Six Continents Hotel Inc. If a service shows consistent quality, the customer can notice that and select the service again. That is the rationale behind registering service marks.

Trademarks ("TM") and service marks ("SM"), are commonly referred to as "marks"; they are the names, words, logos, or designs that indicate origin of a good or service. Specifically, trademarks go with goods (articles for sale, etc.) and service marks go with services (consulting, managing, etc.). The marks are
valuable as they let people know who or what provides a good or service. As the mark is used, goodwill develops with the mark and increasing the mark's value. For example, COCA-COLA® is a long held mark indicating the source of a particular cola soda. The mark is extremely valuable because of its wide recognition and the goodwill it has developed over time. The owners of COCA-COLA® are able to profitably license the mark for selling items beyond soda, such as shirts and glasses, as a result.\(^\text{21}\)

The registration of service marks is the same as for trademarks.

### 4.6. ENFORCEMENT PROCEDURES

The enforcement procedures under the TRIPS Agreement are contained in Part III. We will base this part on the provisions in the TRIPS Agreement and provide analysis to what is provided in TRIPS. The enforcement procedures in TRIPS apply generally to intellectual property rights and not to geographical indications in particular. We will be analysing Part III giving regard to what is best suited in the Kenyan context. Part III is further divided into 5 sections namely:

- Section 1: General Obligations

\(^{21}\) D J Meinke, Trademarks, Servicemarks and Webpages, Peterson, Uxa and Stout, Irvine, California.
4.6.1. General Obligations

Article 41

"1. Members shall ensure that enforcement procedures as specified in this Part are available under their law so as to permit effective action against any act of infringement of intellectual property rights covered by this Agreement, including expeditious remedies to prevent infringements and remedies which constitute a deterrent to further infringements. These procedures shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse."

This section requires expeditious remedies in case of infringement of the law which the enforcement procedures must incorporate in their laws. These laws must be deterrent in nature to safeguard the law.

The following paragraphs contain general principles, whose aim is to guarantee due process. Paragraph 2 deals with procedures of enforcement that
should not be costly but fair and equitable. Paragraph 3 requires that decisions be written and well reasoned and based upon the evidence and merits of the case. Paragraph 4 provides that parties to a proceeding shall have an opportunity to review by a judicial authority of final administrative decisions with regard to the Member’s law concerning the importance of the case. However there is no obligation to provide an opportunity for review where there is an acquittal in a criminal case. See below:

“2. Procedures concerning the enforcement of intellectual property rights shall be fair and equitable. They shall not be unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays.

3. Decisions on the merits of a case shall preferably be in writing and reasoned. They shall be made available at least to the parties to the proceeding without undue delay. Decisions on the merits of a case shall be based only on evidence in respect of which parties were offered the opportunity to be heard.

4. Parties to a proceeding shall have an opportunity for review by a judicial authority of final administrative decisions and, subject to jurisdictional provisions in a Member’s law concerning the importance of a case, of at least the legal aspects of initial judicial decisions on the merits of a case. However, there shall be no obligation to provide an opportunity for review of acquittals in criminal cases”.

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According to paragraph 5, it is understood that the provisions on enforcement do not create any obligation to put in place a judicial system for the enforcement of intellectual property rights distinct from that for the enforcement of law in general, nor does it affect the capacity of Members to enforce their law in general. In addition, it is stated that nothing in these provisions creates any obligation with respect to the distribution of resources as between enforcement of intellectual property rights and the enforcement of law in general. However, a number of countries have found it helpful to establish special enforcement units that pool together required experience needed to effectively fight against counterfeiting and piracy. Moreover, some countries have centralized certain types of intellectual property issues in one or a limited number of courts in order to ensure the availability of necessary expertise.

“5. It is understood that this Part does not create any obligation to put in place a judicial system for the enforcement of intellectual property rights distinct from that for the enforcement of law in general, nor does it affect the capacity of Members to enforce their law in general. Nothing in this Part creates any obligation with respect to the distribution of resources as between enforcement of intellectual property rights and the enforcement of law in general.”
Article 42 - Fair and Equitable Procedures

"Members shall make available to right holders⁴ civil judicial procedures concerning the enforcement of any intellectual property right covered by this Agreement. Defendants shall have the right to written notice which is timely and contains sufficient detail, including the basis of the claims. Parties shall be allowed to be represented by independent legal counsel, and procedures shall not impose overly burdensome requirements concerning mandatory personal appearances. All parties to such procedures shall be duly entitled to substantiate their claims and to present all relevant evidence. The procedure shall provide a means to identify and protect confidential information, unless this would be contrary to existing constitutional requirements."

Article 42 contains certain principles aimed at ensuring due process. Defendants are entitled to written notice which is timely and contains sufficient details of the claims. Parties must be allowed to be represented by independent legal counsel, and procedures may not impose overly burdensome requirements concerning mandatory personal appearances. All

⁴For the purpose of this Part, the term "right holder" includes federations and associations having legal standing to assert such rights.
parties are entitled to substantiate their claims and to present all relevant evidence, while confidential information must be identified and protected.

*Article 43 – Evidence*

Article 43 provides on how rules of evidence should be applied in certain situations. Where vital evidence is in the possession of the opposing party, the court is empowered provided certain conditions are met that the evidence be produced. The court is also allowed to make a reasonable decision where a party is impeding the procedure relating to access to evidence. See below:

"1. The judicial authorities shall have the authority, where a party has presented reasonably available evidence sufficient to support its claims and has specified evidence relevant to substantiation of its claims which lies in the control of the opposing party, to order that this evidence be produced by the opposing party, subject in appropriate cases to conditions which ensure the protection of confidential information.

2. In cases in which a party to a proceeding voluntarily and without good reason refuses access to, or otherwise does not provide necessary information within a reasonable period, or significantly impedes a procedure relating to an enforcement action, a Member may accord judicial authorities the authority to make preliminary
and final determinations, affirmative or negative, on the basis of the information presented to them, including the complaint or the allegation presented by the party adversely affected by the denial of access to information, subject to providing the parties an opportunity to be heard on the allegations or evidence."

**Article 44 – Injunctions**

This article allows the courts to issue orders of injunctions to prohibit infringement of a mark including the possible importation of such infringing goods from entering the domestic market. Members are not obliged to issue injunctions where a party has acted in good faith.

1. The judicial authorities shall have the authority to order a party to desist from an infringement, inter alia to prevent the entry into the channels of commerce in their jurisdiction of imported goods that involve the infringement of an intellectual property right, immediately after customs clearance of such goods. Members are not obliged to accord such authority in respect of protected subject matter acquired or ordered by a person prior to knowing or having reasonable grounds to know that dealing in such subject matter would entail the infringement of an intellectual property right.

Article 45 empowers the courts to award damages where the right holder has suffered due to the infringer's act on the subject of intellectual property rights.
The court is also empowered to order the payment of expenses such as attorney fees.

"1. The judicial authorities shall have the authority to order the infringer to pay the right holder damages adequate to compensate for the injury the right holder has suffered because of an infringement of that person's intellectual property right by an infringer who knowingly, or with reasonable grounds to know, engaged in infringing activity.

2. The judicial authorities shall also have the authority to order the infringer to pay the right holder expenses, which may include appropriate attorney's fees. In appropriate cases, Members may authorize the judicial authorities to order recovery of profits and/or payment of pre-established damages even where the infringer did not knowingly, or with reasonable grounds to know, engage in infringing activity."

Article 46 requires that the judicial authorities must have the authority to order infringing goods to be disposed of outside the channels of commerce, or, where constitutionally possible, destroyed. Similarly, it must be possible to dispose of materials and instruments predominantly used in the production of the infringing goods. In considering such requests, the courts must take into account proportionality between the seriousness of the infringement and the remedies ordered as well as the interests of third parties. In respect of counterfeit trademark goods, it is clarified that the simple removal of the trademark unlawfully affixed shall not be sufficient, other than in exceptional
cases, to permit release of the goods into the channels of commerce. This article seeks to create an effective deterrent to infringement.

Article 47 provides that the judicial authorities of the Member shall have authority to order the infringing party to inform the right holder of a third party involved in the infringement. This however depends on the seriousness of the offence.

The Section contains certain safeguards against abuse of enforcement procedures. Article 48 provides that the judicial authorities must have the authority to order the applicant who has abused enforcement procedures to pay an adequate compensation to the defendant who has been wrongfully enjoined or restrained to cover both the injury suffered and expenses. Such expenses may include appropriate attorney’s fees. Public authorities and officials are exempted from liability to appropriate remedial measures only where actions are taken or intended in good faith in the course of the administration of that law.

Article 49 provides that, to the extent that any civil remedy can be ordered as a result of administrative procedures on the merits of a case, such procedures shall conform to principles equivalent in substance to those set forth in the Section.
Although the following case does not refer to geographical indications but deals with trademarks it aids in showing how the above procedures are applied on local cases.


In 1928 the plaintiff company registered in Uganda a trademark for safety matches bearing the design of a sailing ship. Thereafter the plaintiff’s company’s matches bearing their trademark and the trade name “The Ship” marked on the label of the boxes were distributed and sold in Uganda through its agents there. In 1950, without objection from the plaintiffs the second defendant company registered in Kenya a trademark for safety matches bearing the design of a steamship and in 1961 the first defendant company under licence from the second defendant company started to market and manufacture matches in East Africa (EA) under that trademark and the trade name “The Steamship” on the labels. The plaintiff sued the defendants claiming an injunction restraining them from infringing their trademark and passing off the goods as those of the plaintiff’s. It was common ground that plaintiff’s matches were manufactured in Sweden and imported, while those of defendants were manufactured in Kenya and that the words “Made in Sweden” and “Made in Kenya” were prominently printed on their respective labels. The plaintiffs submitted that the words “The Ship” had acquired a
secondary meaning denoting only the matches of the plaintiff, and that “The Steamship” matches had been introduced by the defendant to cause confusion in the products and that the trademark was calculated to deceive and cause confusion or defraud. The defendants denied this and contended that their labels were distinctly and differently marked from the plaintiff’s and the only common feature was the design of a ship, on water. In evidence a witness for the plaintiff stated that at each shop that he visited and asked for “the Ship” matches he was invariably sold “The Steamship” matches. Among the witnesses for the defendants were eight small shopkeepers engaged in retail trade who testified that none of their customers had been confused or deceived.

It was held that the it had not been proved that the term “The Ship” had acquired a secondary or special meaning so as to denote or to be descriptive only of the goods of the plaintiff in Uganda.

Secondly the two labels were completely different as to their get up and lay out generally and no person looking at the box of matches bearing the defendant’s label could be led to believe that it was similar to that of the plaintiff’s company whether placed side by side or not; accordingly there had been no infringement of the plaintiff’s trademark.

Thirdly the use of the defendant’s of their trademark in connection with their safety matches did not imply any misrepresentation that the matches sold by
the defendant were the goods of the plaintiff, or that it was calculated to deceive anyone. The action was thereby dismissed.

As can be seen the evidence in the above case was carefully weighed to determine whether the two items could possibly deceive a customer and witnesses from both sides were examined. There is need for proper evaluation of evidence since a lot is at stake; should the defendant company have been found guilty of passing off, then they would have incurred huge financial losses in trying to change the trade name and a new get up.

Case 2

Parke Davis & Co. Ltd v. Opa Pharmacy Ltd 1961 EA 556

The appellant had sold for 28 years in EA tubes of ointment packed in distinctive cartons under the registered trade name “Capsolin”. In 1955, the respondent company began to sell similar ointment under a registered name “Capsopa”. In 1959 the appellant company sued claiming an injunction to restrain the respondent from passing off its product as that of the appellant company and damages or an account of profits made. The trial judge dismissed the suit finding inter alia that there was no evidence of confusion among the public despite the concurrent sale of the two products and that “capsopa” was not likely to be confused with “capsolin”. On appeal it was held that since the first two syllables in the trade name used by each of the parties were identical and there were some resemblances in the containers
here was a real probability of confusion and appellant company was entitled to an injunction. There was also evidence that a substantial part of the respondent's company sales might have resulted from causes other than deception and bearing in mind the delay before the action was taken the appellant company was only entitled to nominal damages. Both the appeal and injunction were allowed.

Again it can be seen that injunctions are granted where the wrongful party is passing off its goods as those of the plaintiff's, provided that they can show this in the suit.

4.6.3. Provisional Measures

Article 50

What Article 41 provides is that the judicial authorities must put in place enforcement procedures to permit effective action against infringements and must include expeditious remedies. As these judicial procedures may take a while the situation on the ground can be very different. Goods can be imported that infringe a registered mark a geographical indication in our case; time is of the essence in such a scenario. Those goods need to be stopped from entering the market. In such a case Article 50 comes to assist, the right holder to stop an alleged infringement immediately. These are the provisional
measures. It requires each country to ensure that its judicial authorities have the authority to order prompt and provisional measures. Such measures must be available in respect of any intellectual property right.

Provisional measures have to be available in two situations namely: (a) where they are needed to prevent an infringement from occurring, and to prevent them from entering into the channels of commerce. This includes preventing goods from being dispersed into domestic distribution channels immediately after clearance at the customs and (b) where such measures are needed to preserve the relevant evidence in regard to the alleged infringement. See Article 50(1):

"1. The judicial authorities shall have the authority to order prompt and effective provisional measures:

(a) to prevent an infringement of any intellectual property right from occurring, and in particular to prevent the entry into the channels of commerce in their jurisdiction of goods, including imported goods immediately after customs clearance;

(b) to preserve relevant evidence in regard to the alleged infringement."

Effective use of provisional measures may require that action be taken without giving prior notice to the other side. Therefore the judicial authorities must have the authority to adopt provisional measures inaudita altera parte –
without prior hearing of the other side, where appropriate, in particular where any delay is likely to cause irreparable harm to the right holder, or where there is a demonstrable risk of evidence being destroyed. See paragraph 2 below:

"2. The judicial authorities shall have the authority to adopt provisional measures inaudita altera parte where appropriate, in particular where any delay is likely to cause irreparable harm to the right holder, or where there is a demonstrable risk of evidence being destroyed."

The courts may require the applicant to provide any reasonably available evidence to that he is the right holder and that his right is being infringed or that the infringement is imminent.

"3. The judicial authorities shall have the authority to require the applicant to provide any reasonably available evidence in order to satisfy themselves with a sufficient degree of certainty that the applicant is the right holder and that the applicant's right is being infringed or that such infringement is imminent, and to order the applicant to provide a security or equivalent assurance sufficient to protect the defendant and to prevent abuse."

The applicant may also be required to supply information necessary for the identification of the goods (paragraph 5). Where provisional measures have been adopted inaudita altera parte, the parties affected must be given notice,
immediately after the execution of the measures at the latest. The defendant has a right to review with a view to deciding, within a reasonable period after the notification of the measures, whether these measures shall be modified, revoked or confirmed (paragraph 4).

Paragraph 6 allows the defendant to have the provisional measures in paragraphs 1 and 2 to be revoked or ceased without prejudice to paragraph 4, where the applicant fails to initiate proceedings leading to a decision on the merits of the case within a reasonable period to be determined by the judicial authorities. In the absence of such a determination, this period may not exceed 20 working days or 31 calendar days, whichever is longer. Paragraph 7 empowers the judicial authorities to provide the defendant appropriate compensation for any injury caused by the measures where (a) the provisional measures are revoked, (b) where they lapse due to any act or omission by the applicant or (c) where they found there has been no infringement or threat thereof of an intellectual property right. Both these paragraphs contain safeguards against abuse of such measures. See below:

"6. Without prejudice to paragraph 4, provisional measures taken on the basis of paragraphs 1 and 2 shall, upon request by the defendant, be revoked or otherwise cease to have effect, if proceedings leading to a decision on the merits of the case are not initiated within a reasonable period, to be determined by the judicial authority
ordering the measures where a Member's law so permits or, in the absence of such a
determination, not to exceed 20 working days or 31 calendar days, whichever is the longer.

7. Where the provisional measures are revoked or where they lapse due to any act or
omission by the applicant, or where it is subsequently found that there has been no
infringement or threat of infringement of an intellectual property right, the judicial
authorities shall have the authority to order the applicant, upon request of the
defendant, to provide the defendant appropriate compensation for any injury caused
by these measures."

Paragraph 8 extends these measures to apply to administrative procedures to
the extent that any provisional measure thereto will conform to the Section (3).
4.6.4. Special Requirements Related to Border Measures.

Articles 51-60.

The emphasis in the enforcement part of the TRIPS Agreement is on internal enforcement mechanisms, which, if effective, would enable infringing activity to be stopped at the source, the point of production. Where possible, this is both a more efficient way of enforcing intellectual property rights and less liable to give rise to risks of discrimination against imports than special border measures. However, the Agreement recognizes that such enforcement at source will not always be possible and that in any event not all countries are Members of the TRIPS Agreement. The Agreement therefore also recognizes the importance of border enforcement procedures that will enable right holders to obtain the cooperation of customs administrations to prevent the release of infringing imports into free circulation. The special requirements related to border measures are contained in Section 4 of the enforcement Part of the Agreement.

According to Article 51 of the Agreement, the goods that must be subject to border enforcement procedures must include at least counterfeit trademark and pirated copyright goods that are being presented for importation. The Article leaves flexibility to Member governments on whether to include imports of goods that involve other infringements of intellectual property rights. Members are also free to determine whether to apply these procedures
to parallel imports. This is confirmed in footnote 13 to the Article, according to which it is understood that there shall be no obligation to apply such procedures to imports of goods put on the market in another country by or with the consent of the right holder. In accordance with Article 60, Members may exclude from the application of these procedures de minimis imports, i.e. small quantities of goods of a non-commercial nature contained in travellers’ personal luggage or sent in small consignments. Article 51 leaves it to Members to decide whether to apply corresponding procedures to the suspension by customs authorities of infringing goods destined for exportation from their territories, or to goods in transit.

The basic mechanism required by the Agreement is that each Member must designate a “competent authority”, to which applications by right holders for customs action shall be lodged (Article 51). The competent authority could be the customs authorities, a court, or some other administrative or judicial body. The right holder lodging an application to the competent authority shall be required to provide adequate evidence of a prima facie infringement of his intellectual property right and to supply a sufficiently detailed description of the goods to make them readily recognizable by the customs authorities. The competent authorities shall then inform the applicant whether the application has been accepted and, if so, for what period, and give the necessary directions to customs officers (Article 52). After this, it is the responsibility of
the applicant to initiate proceedings leading to a decision on the merits of the case. The Agreement requires a system to be put in place under which action will be taken on the basis of an application from a right holder, but leaves it to Members to determine whether they require competent authorities to act upon their own initiative. Article 58 contains certain additional provisions applicable to such ex officio action.

The provisions on border measures require the taking of what are essentially provisional measures against imports of infringing goods. Many of the same types of safeguards against abuse as appear in Article 50 on provisional judicial measures are provided for. The competent authority may require the applicant to provide a security or equivalent assurance sufficient to protect the defendant and the competent authorities and to prevent abuse. However, such security or equivalent assurance may not be such as to unreasonably deter recourse to these procedures (Article 53.1). The importer and the applicant must be promptly notified of the detention of goods (Article 54). If the right holder fails to initiate proceedings leading to a decision on the merits of a case within ten working days, the goods shall normally be released (Article 55). Where goods involve the alleged infringement of industrial designs, patents, layout-designs or undisclosed information, the importer must be entitled to obtain their release on the posting of a security sufficient to protect the right holder from any infringement, even if proceedings leading to
a decision on the merits have been initiated (Article 53.2). Once judicial proceedings on the merits of a case have been initiated, the judicial authority may continue the suspension of the release of goods in accordance with a provisional judicial measure. In that case, the provisions on provisional measures in Article 50 shall be applied. The applicant may be required to pay appropriate compensation to persons whose interests have been adversely affected by the wrongful detention of goods or through detention of goods released pursuant to the failure of the applicant to initiate in time proceedings leading to a decision on the merits of the case (Article 56).

The competent authorities must be able to give the right holder sufficient opportunity to have any goods detained by the customs authorities inspected in order to substantiate his or her claims. Where goods have been found infringing because of a decision on the merits, the Agreement leaves it to Members whether to enable the right holder to be informed of other persons in the distribution channel so that appropriate action could also be taken against them (Article 57).

In regard to remedies, the competent authorities must have the power to order the destruction or disposal outside the channels of commerce of infringing goods in such a manner as to avoid any harm to the right holder. The principles contained in Article 46 on civil remedies, such as the need for
proportionality, apply also to border measures. In regard to counterfeit trademark goods, the authorities may not allow the re-exportation of the infringing goods in an unaltered state or subject them to a different customs procedure, other than in exceptional circumstances. These remedies are without prejudice to other rights of action open to the right holder, such as to obtain damages through civil litigation, and are also subject to the right of the defendant to seek review by a judicial authority (Article 59).

4.6.5. Criminal procedures (Article 60)

The fifth and final section in the enforcement chapter of the TRIPS Agreement deals with criminal procedures. According to Article 61, provision must be made for these to be applied at least in cases of wilful trademark counterfeiting or copyright piracy on a commercial scale. The Agreement leaves it to Members to decide whether to provide for criminal procedures and penalties to be applied in other cases of infringement of intellectual property rights, in particular where they are committed wilfully and on a commercial scale.

Sanctions must include imprisonment and/or monetary fines sufficient to provide a deterrent, consistent with the level of penalties applied for crimes of a corresponding gravity. Criminal remedies in appropriate cases must also
include seizure, forfeiture and destruction of the infringing goods and of materials and instruments used to produce them.

4.7. THE KENYAN POSITION.

We safely conclude that what has been provided in Part III are the basic enforcement procedures that the Kenyan legislation provides in both civil and criminal law. Part III requirements are what might be described as upholding the essentials of natural justice. It talks of the requirement of competent judicial authorities; it calls for a fair and equitable procedure via providing notice of hearing to parties to the suit; representation by counsel; production of evidence is closely regulated to prevent injustice to either party.

Article 44 requires that the judicial authorities have the authority to prevent infringement through injunctions that the Kenyan law provides for. Order XXXIX r.2 of the Civil Procedure Act, Chapter 21 of the Laws of Kenya provides:

“(1) in any suit for restraining the defendant from committing a breach of contract or other injury of any kind, whether compensation is claimed in the suit or not, the plaintiff may, at any time after the commencement of the suit, and either before or after judgement, apply to the court for a temporary injunction to restrain the
defendant from committing the breach of contract or injury complained of, or any
injury of a kind arising out of the same contract or relating to the same property or
right."

Part III also provides that there be appropriate damages paid to the deserving
party, which includes the defendant if proved he was not in the wrong
(Article 48). The provisional measures in Section 3 of Part III seek to provide
prompt measures which a mentioned above can be sought through
injunctions. One can achieve this efficiency through an ex parte injunction
available to a party before the hearing of a suit. Order XXXIX r.3 of the Civil
Procedure Act provides:

"(1) Where the court is satisfied for reasons to be recorded that the object of granting
the injunction would be defeated by delay, it may hear the application ex parte. "

The above is a reflection of Article 50 paragraph 2 that the judicial authority
shall have authority to adopt provisional measures inaudita altera parte
where appropriate and where delay is likely to cause irreparable damage or
harm. Inaudita altera parte means without prior hearing of the other side.

Border measures are to prevent the entry of infringing goods at the starting
point, which may be at the customs clearance. For this purpose TRIPS requires
that there be a competent authority in place, which could be the customs authorities, courts or some other administrative or judicial body. The practical effect is that all afore mentioned authorities work hand in hand in our judicial set-up. For example the Imports, Exports and Essential Supplies Act Chapter 502 of the Laws of Kenya provides in Section 4(1) that:

"Whenever from time to time it appears to the Minister, after consultation with such persons as appear to the Minister to represent commercial and industrial interests in Kenya, to be necessary in the public interest, or for the observance or performance by the Government of any of its obligations in respect of external affair, so to do, he may by order either prohibit absolutely or restrict, by means of such conditions and limitations as may be specified in the order, the exportation or importation of all or any specified goods or class or description of goods, either generally or to or from any specified country or place or to or from any specified person or class of persons."

This section may operate to prevent the entry of prohibited goods, that could be goods that are infringing on a registered geographical indication. The commercial and industrial interests may be due to the intellectual property rights that are held in the product. The section also allows the specification of the description of the goods and their origin.

Section 5 of the same Act provides that where the exportation or importation of any goods is prohibited or restricted, either generally or to or from any
country or place or to any person or class of persons, by an order made under Section 4, any person who exports or imports or attempts to export or import any such goods in contravention of the provisions of the order otherwise than under the authority of an export licence authorizing such import shall be guilty of an offence and liable to a fine not exceeding one hundred thousand shillings or to imprisonment for a period not exceeding 3 years or both.

This section spells a criminal sanction in case of non-compliance. Chapter 502 deals with the case where there is reasonable ground to believe that an offence has been committed in respect of goods on premises. In such a case Section 15 allows the Director or Deputy director or any police officer above the rank of an Inspector to enter the premises without a search warrant where the obtainment of such warrant may cause delay. He may then proceed to inspect the goods and any document related thereto. This can be seen as a practical result of the provisional and border measures in Part III of TRIPS.

In conclusion we can say that Kenya has in place laws that have the practical result of protecting goods of a legal nature. We may have veered of the subject of geographical indications in the enforcement procedures, but these procedures apply to all categories of intellectual property including geographical indications. Similarly the goods referred to in Chapter 502 may be products on which a registered geographical indication has been infringed.
4.8. THE RELATIONSHIP OF TRADEMARKS, (including protection provided to prevent the registration as trademarks of signs containing or consisting of geographical indications.)

Generally, the trademarks that consist of or contain a geographical indication cannot be protected if the use of such a trademark would mislead the public as to the true origin of the product. Normally national laws exclude geographical terms from registration as a trademark, because it must not be descriptive or deceptive; the same is provided in the TRIPS Agreement in Article 22.3.

"3. A Member shall, ex officio if its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in that Member is of such a nature as to mislead the public as to the true place of origin."

Hence where a trademark is such that it may mislead the public as to the true origin of the goods, then WTO Members shall invalidate any such registration. This means that where the public is not misled then this provision does not apply.
As mentioned in Chapter One trademarks are expressions that distinguish products and services and or their producer, manufacturer or provider, for example “Coca Cola” and “Marlboro”. Geographical indications on the other hand are expressions that distinguish the geographical origin of a given product for example “Tequila” or “Champagne”.

In the development of a trademark human creativity is involved which distinguishes that product from any other. Geographical indications involve factors such as topography, human work, climate which are independent from human creativity.

**4.6.1. Trademarks & Geographical Names**

According to Kerly\(^{22}\) a word is not debarred from registration as a distinctive word merely because it is geographical and so cannot be registered. Some geographical names can be inherently adapted to distinguish the goods of particular traders: but only if it can be predicted that they are such names as it would never occur to any other trader in such goods to use. At the other extreme the name of a major industrial or city will be totally unregistrable in respect of any goods as “Yorkshire” for copper piping and “Liverpool” for

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electric cables. In between come the marks calling for more or less evidence that they are distinctive in fact. Kerly provides the following illustrations.

[a] “Apollinaris,” being the name of a spring from which mineral waters called by that name came, was held under the 1883 Act to be geographical, but was held registrable under the Act of 1905 as a distinctive word.23

[b] In the “California Syrup of Figs” case, the Court of Appeal held that a prima facie case of identification of the words with the goods of the applicants had been made out, and that the registration of them would not give a monopoly of the use of the word “California” and the applicant was allowed to proceed: California Fig Syrup Co.’s Appn. [1910] 1 Ch. 130; 26 R.P.C. 436,846.

c] “Oswego” for corn flour, that the word being the name of a place in the United States where the applicants had their factories24 as well as the name of their goods; and “Tyne Brand” for canned fish, fish pastes and meat pasts have all been held as distinctive.25

It may tip the balance that the applicant can show that he has a natural or legal monopoly of the production of the goods concerned in the place concerned, but that alone will not make a geographical name registrable without substantial evidence of distinctiveness.

23 Apollinaris Co.’s T. M. [1891] 2 Ch.186; 8 R.P.C. 137; Apollinaris Appn. [1907] 2Ch. 178; 24 R.P.C.436
24 National Starch Co.’s Appn. {1908} 2 Ch.698; 25 R.P.C. 802.
In *Boots Pure Drug Co. Ltd*\(^{26}\) the trademark "Livron" (a medicine compounded of liver and iron), registered for tonic medicines, was expunged from the Register. All members of the court holding that as "Livron" was a town of some importance in France and that it was not proved to be adapted to distinguish the proprietor's goods. In addition there was already another manufacturer of similar goods at Livron and registration would be contrary to the Act. This was held to be a misleading geographical term as it was deceptive as implying connection with the opponents' works at Livron in France.

Kerly\(^{27}\) adds that where a trade name is geographically descriptive, a special order has sometimes been made in order to avoid any interference with the honest and proper use of them by persons other than the owner of the trade name. Similar orders have been made where a name is not a trade name, but its use by a defendant is deceptive in the sense that the public might be misled into buying the substitute for the genuine article. For instance in the "Spanish Champagne" case, where a number of champagne produced sued in respect of the sale of Sparkling wine as "Spanish Champagne", an injunction was granted restraining the defendants from passing off " as and for wine produced in the district of France known as the Champagne District wine not

\(^{26}\) T.M.[1937] 54 R.P.C. 327
\(^{27}\) Supra. Page 402
so produced by advertising, offering for sale or selling the same as Spanish champagne or under any other name or description that includes the name Champagne". [1961] RPC 116 p. 127; [1960] RPC 16 p. 17 LINE 50.

Injunction was also granted in the "sherry" case restraining the plaintiffs (who had been sued on a counterclaim) "from using in the course of trade the word 'sherry' in connection with any wine not being wine coming from the Jerez district of Spain, otherwise than a part of one or more of the phrases 'British Sherry', 'English Sherry', 'South African Sherry', 'Cyprus Sherry', 'Australian Sherry' and 'Empire Sherry.'" The excepted phrases would not have been permitted if there had not been acquiescence: [1969] RPC 1 at p. 32. Both the 'Sherry' and 'Champagne' were followed by the "Whiskey" case, John Walker and Sons Ltd. v. Henry Ost Ltd [1970] RPC 489.

Kerly concludes by saying that the above cases tend to fall in two categories: 
[a] where the defendant has made a misleading use of a geographical appellation [b] where the allegation is that, although as a geographical appellation the expression complained of may have been accurately used, its use is calculated to represent that the goods are the plaintiff's. To succeed under the former head, it is enough for the plaintiff to prove:

[1] that he produces the substance in a given place;
[2] that no one else produces the substance in that place;
[3] that the defendant is selling the substance with the name of that place as a
description and

[4] that there is likely to be deception of the public.

To succeed under the second head, the plaintiff must prove that the
appellation in dispute has ceased to have a purely descriptive meaning as in
the “Stone Ales” case,28 where although the right of the appellant to state that
his beer was brewed at Stone was recognised, it was held to be subject to an
obligation not to do so in any manner calculated to cause the appellant’s beer
to be passed off as that of the respondents, which was commonly known as
“Stone Ale”. If as required by the rule laid down in the authorities, the
plaintiff proves that an apparently descriptive word which he claims to
appropriate has ceased to have purely descriptive meaning, it is difficult to
imagine how the defendant can be truthfully using the word with that
meaning.

Conclusion.

The differences between geographical indications and trademarks are that the
former are geographical expressions such as “champagne” which is a type of
wine from a district in France known as “Champagne”. The latter are
expressions that distinguish goods and services such as “Coca Cola” or

“Softa”. In instances where a trademark is a geographical name, then evidence must be provided that shows that the name is distinctive to render it registrable. This leaves the question how strong must the evidence be to render it registrable.

According to Kerly,29 the words “geographical name” are not equivalent to the “name of any place,” and an ordinary English word does not become a geographical name simply because some place on the earth’s surface has been called by it. In the “Magnolia” case30 decided under the 1888 Act, it appeared that in the United States, whence a metal had been imported, there were several places known by the name “Magnolia,” but it did not appear that the goods had any connection with that place. Rigby L.J. said:

“It is no doubt shown by the evidence, that there are no places in the United States, called by the name “Magnolia,” and if geographical name in Section 64(1) (e) were equivalent to the name of any place, ‘Magnolia’ as the name of places mentioned in the evidence, would fall within the exception, but in our judgement, the phrase “geographical name” in Section 64 (1) (e) ought not, in general, to receive so wide an interpretation. It must, we think, in the absence of special circumstances, be interpreted so as to be in accordance, in some degree, with the general and popular meaning of the words, and a word does not become a geographical name simply because some place on the earth’s surface has been called by it. For example we agree

29 Supra. P.117.
30 Magnolia Metal Co.’s T.M.s [1897] 2 Ch.371 ; 14 R.P.C. 265 & 621.
with Mr Justice Kekewich that the word "Monkey" is not proved to be a geographical name by showing merely that a small and by no means generally known island has been called by that name, if, indeed, in its primary and obvious meaning, the word has reference to a locality, as the word "Melrose" in Van Duzer's case, or the word "Eboli" in Sir Titus Salt & Co.'s case (from which Mr justice Chitty declined to distinguish the derivative 'Eboline'), may well be a geographical name within the meaning of the subsection. Even when the primary significations not geographical, if the name is really local (however little known the locality may be), and the name is given because of the connection of the article with the locality, whether that be real or imputed only by those who give the name, it may well be a geographical name within the subsection. An instance of this is to be found in the case of the word 'Apollinaris', given to the water from the spring known as the Apollinaris Spring. So, if 'Magnolia' had been the name of a place where the metal was manufactured, we should have by no means inclined to say that it would not be a geographical name when applied to the article manufactured in the place having the name."

Since there was no connection of the goods with the place called "Magnolia" the same could not be registered as trademark. Further the geographical origin of a place must be of some importance in relation to the product as in the "Monkey island" illustration; similarly importance was accorded to the geographical name "Livron" in the Boots Pure Drug Company case as a result of the French registration. In the "California Syrup of Figs" case
above, it was held that the registration would not result in the monopoly of the word or geographical name of ‘California’; further a prima facie case of identification of the words with the goods of the applicants had been made.

What would eventually be registered as a trademark if it has a geographical name would therefore depend on the individual cases and the evidence presented; there is one constant however, if the geographical name is such that that geographical area is where a given quality, reputation or other characteristic of the good is essentially attributable to that geographical area, then that would be deemed a geographical indication. For a trademark, which has a geographical name, the evidence must show the distinctive nature of the name.
CONCLUSIONS & RECOMMENDATIONS

CHAPTER BY CHAPTER ANALYSIS

Chapter One

In Chapter One we looked at the various definitions of geographical indications. We were able to identify the following:

[a] Geographical indications as per the TRIPS Agreement and whose definition is broad enough to include symbol and emblems. They are not restrictive in the sense that they do not define a geographical indication as a "name" but as an "indication" which identifies a good as originating in the territory where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.

[b] Appellations of origin as found in The Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of 1958 in Article 2 where an appellation of origin was limited to mean the geographical name of a country, region or locality to which the quality and characteristics are attributable. In this case the denomination must correspond to a geographical name, and not to symbols and the like. We also gave its definition as per the Bangui Agreement of 1977 where appellations of origin were defined as the geographical denomination where denomination is a specific geographical area. Again the appellation of origin definition is restricted to a geographical area.
Indications of source which are the broadest in this category but which have no definitions in *The Paris Convention for the Protection of Industrial Property of 1883*, and the *Madrid Agreement For The Repression Of False And Deceptive Indications Of Sources*, wherein they are referred to. In the Paris Convention the indications of source are considered synonymous, but Professor Bodenhausen distinguishes the two in that appellations of origin are linked to the quality and other characteristics of a geographical environment whereas the other refers to the geographical origin and nothing else. An example is “Made in Kenya.”

Finally we looked at “indications of geographical origin” which the WTO Secretariat invented as a denominator to designate the different expressions used by the WTO Members, which move has been criticized. We also concluded that the expression was creating confusion and that the Secretariat was in a position to insist on the term geographical indications and should have done so.

We can only draw conclusions from Chapter One, with only one recommendation that the word geographical indications should encouraged over the rest as it is wider in scope.

Chapter Two
In this chapter we looked at the international protection prior to the TRIPS Agreement. We looked at several Agreements and Conventions:

[a] The Paris Convention was the first multilateral agreement for the protection of indication of sources and appellations of origin. It contained no definitions but provided protection under Article 10 (2).

[b] The Madrid Agreement which unlike the Paris Convention is not a general treaty providing a range of protection for different categories of industrial property. It is specific and provides rules for repression of false and deceptive indications of sources. It provides rules on how seizure should take place and defines the competent authority to carry out these measures. This agreement can be seen in article 4 to be the precursor to the additional protection afforded to wines. It contains a special provision that allows courts of countries to decide which indications of source do not fall within the Agreement due to their generic character.

c] We also identified the protection that can be given to geographical indications through certification marks and collective marks which are used to indicate specific qualities of goods such as their geographical origin. Once a geographical indication is protected as a collective or certification mark, that geographical indication can be enforced in accordance with the applicable rules of trademark law.

d] The Lisbon Agreement was found to be the most comprehensive agreement prior to TRIPS for the protection of appellations of origin. The
Lisbon Agreement required that two conditions be fulfilled for an appellation of origin to be protected: (a) the appellations of origin should be protected in its country of origin, and (b) the appellations of origin should be registered in the International Register of WIPO.

It gives details on what information is necessary in its Rules under the Regulations of The Lisbon Agreement and can reject an application that does not follow those Rules. We gave the tables of the member countries highlighting that francophone Africa dominated the list if African nations. We also saw that France dominates the registrations of wines, as does Cuba in cigarettes, from which we concluded that countries that specialize in a particular product had the highest registrations in that product. We also saw that from the five African member states only two- Tunisia and Algeria have registrations. The other three Gabon, Congo and Burkina Faso have not registered any appellation of origin. South Africa has registered its wine as trademarks and negotiated on the use of names with EU but there is an ongoing debate as to whether the implications of that accord are negative or positive. It seems the Europeans will stop at nothing to protect traditional expressions in the wine trade, and this is unfair on those producers like South Africa who have used those names over centuries.
[e] Bilateral and plurilateral agreements have also served to protect geographical indications. For example Germany and France adopted an agreement in 1960 for the protection of indications of source, appellations of origin and other geographical indications. Chile has made bilateral free trade agreements with Mexico to recognise “tequila” and “mezcal” and with Canada for “Canadian Whiskey”. Finally regional and bilateral agreements, which provide protection to geographical indications, are notified to the TRIPS Council according to Article 4(d) of the TRIPS Agreement.

In this Chapter we would like to recommend that the bilateral and plurilateral agreements seem to have achieved their fair share of success if we are to go by the examples given in the Chapter itself. Indeed even the TRIPS Agreement recommends in Article 23.3 that where there are two homonymous indications practical conditions must be determined to differentiate them. For example the agreement entered between Chile and Peru. Hence countries should make use of these plurilateral and bilateral agreements when in dispute about the geographical indications registrations. Certification marks can also prove to be useful especially where there is no legislation on geographical indications. This is because they are covered under the Trademark Law and enforced.

hereunder. This may prove valuable to Kenya, which does not so far have comprehensive legislation for geographical indications.

Chapter Three

The Trips Agreement and Geographical Indications.

[a] **Meanings and definitions** were looked at in detail, where we concluded that geographical indication within the meaning of the Agreement need only be an indication and not necessarily the name of a geographical place on earth.

[b] **Minimum standards and common protection to all products:** We looked at the provisions of TRIPS in relation to the requirement (Article 22(2)) that Members should provide the legal means for interested parties to protect geographical indications and to any act that would constitute an act of unfair competition under the *Paris Convention*. We saw the relation of trademarks to geographical indications and that a Member may invalidate a trademark that misleads the public.

[c] **Additional Protection For Wines** has been a very thorny issue was looked at in detail. We saw that TRIPS provides additional protection to wine in Article 23, which provides where there is an infringement of a registered geographical indications, a Member may prevent the same even where the
public is not misled. We attributed this to the fact that the wine business is a commercial success and that countries like France have perfected the art of winemaking over centuries and were the first country to protect a produce that emanates form a particular geographical area. This they did through the *Appellation d'Origine Controlee* or *AOC*, or *AC*, system. We analysed whether this is a rich versus poor; we also asserted that the WTO system does little to develop the internal capacities of the Least Developed Countries or LDCs due to the promotion of globalisation on their end. We posed the question if this kind of protection will be available to LDCs when their own registered geographical indications turn out to be a commercial success as the wine business. At this juncture we would like to point to the fact that in Chapter three we said that developing countries are also wine producers namely Chile, Argentina and South Africa but it should be known that the aforementioned are not among the LDCs. We also said that one cannot label the opponents and proponents of the additional protection of wines as a North-South divide. All countries whether rich or poor have a say in the additional protection to wines and spirits and this has been a very sensitive issue.

According to Dariel DeSousa\(^2\) in September 2000, a paper\(^3\) was submitted to the TRIPS Council by Bulgaria, the Czech Republic, Iceland, India, Liechtenstein, Slovenia, Sri Lanka, Switzerland and Turkey concerning the

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\(^3\) IP/C/W/204/Rev.1.
issue of the extension of the additional protection under Article 23 of the Agreement to products other than wines and spirits.

These countries favour extension of the protection currently accorded to geographical indications for wines and spirits under Article 23 of the TRIPS Agreement to other products. Other proponents of this position include Cuba, Egypt, Georgia, Hungary, Kenya, the Kyrgyz Republic, Moldova, Mauritius, Nigeria, Pakistan and Venezuela. These Members have pointed out that the WTO Membership already agreed at the Singapore Ministerial Conference that proposals on the scope of the product coverage under Article 23 of the Agreement are allowed and take the view that Article 24.1 provides an avenue for such proposals. They consider that negotiations in relation to this item is built into the TRIPS Agreement and to reinforce their demands, they have linked progress or the lack thereof to other built-in agenda items of WTO Agreements, in particular, those relating to liberalisation of trade in agricultural products. They argue, among other things, that:

(a) additional protection of geographical indications for all products adds value for exports because it increases the chances of market access for such goods;

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4 IP/C/W/247/Rev.1.
5 In its 1996 annual report, the TRIPS Council listed Article 24.1, under which Members agree to enter into negotiations aimed at increasing the protection of individual geographical indications under Article 23, as one of the built-in agenda items of the TRIPS Agreement.
(b) without the additional protection, free-riding is possible\(^6\) and there is a risk that geographical indications will become generic over time;\(^7\)

(c) the test contained in Article 22, which currently applies to products other than wines and spirits leads to legal uncertainty in the enforcement of protection for geographical indications;\(^8\)

(d) Article 22 places a costly burden of proof on the producer entitled to use a geographical indication to show that the public has been misled, or that there has been an act of unfair competition.

Advocates of this view have also argued that there is no justification for the differential treatment between, on the one hand, wines and spirits and, on the other hand, other products.

Another position is advocated by, in particular, Argentina, Australia, Canada, Chile, Guatemala, New Zealand, Paraguay and the United States.\(^9\)

These Members oppose the extension of additional protection to products

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\(^6\) In particular, it is argued that pursuant to the test contained in Article 22 to which products other than wines and spirits are subject, a producer may use a geographical indication for his product, even if it does not originate in the relevant territory provided that the product’s true origin is indicated on the label. Thus, it is argued, a producer can profit from the use of a “famous” geographical indication by arguing that the consumer has not been misled.

\(^7\) It is argued in this respect that since Article 22 does not prevent the use of geographical indications in translation or accompanied by expressions such as “style”, “type”, “kind”, “imitation” or the like, over time, geographical indications may become generic terms.

\(^8\) The supporters of this argument state that the interpretation by national authorities of what constitutes “misleading the public” differs from country to country. This will lead to inconsistent decisions and legal uncertainty regarding the protection granted to geographical indications and its enforcement at the international level.

\(^9\) IP/C/W/289.
other than wines and spirits. In their view, extension of the scope of Article 23.1 to products other than wines and spirits goes beyond the mandate contained in Article 24.1 and could only be negotiated in the context of a new Round. In their view, the negotiating mandate in Article 24.1 concerns only "individual geographical indications", not whole product areas, focusing on those geographical indications in respect of which a country is applying an exception under Article 24, for the purpose of exploring the scope of discontinuing the application of the exception with regard to a particular geographical indication.10

The arguments on both sides are valid but no one can deny that the current position of the TRIPS on additional protection to wines and spirits is discriminatory. In our opinion there is nothing wrong in additional protection to wines and spirits; but putting such a requirement in a worldwide Agreement like TRIPS puts unnecessary burden on the LDCs. Additional protection of wines and spirits, can be achieved by the producers thereof, to enter into bilateral and multilateral agreements with other countries and leaving it up to them if they can provide that additional protection; or otherwise the parties can come to some compromise or consensus.

10 See, for example, IP/C/M/29, paragraphs 93 and 96.
Homonymous geographical indications where the geographical indications consist of the same identifier as is the case in countries which have common linguistic roots. One cannot change the language of a country just to comply with what might be an infringement of a homonymous geographical indication. Therefore TRIPS provides what we refer to as a sound option, it provides that in each of the Members in which homonymous indications exist, practical conditions must be determined to differentiate the homonymous indications. These practical conditions can be quite daunting, see below what F. Mekis says in his document:

“In all of this there is undoubtedly a serious lack of realism. Chile is a Spanish-speaking country and it cannot, even if it wanted to, change the unchangeable: our language is also a Latin one, and that accounts for the correspondence of expressions and denominations, not only with Spain of course, but also with Portugal, France or Italy. In our opinion it is a very different matter when Europe goes into this business with English-speaking countries such as the United States of America, Australia or indeed South Africa, as while none of the countries constituting the United Kingdom have ever been wine producers, it does so on behalf of European countries with high levels of wine production. Obviously the degree of similarity in expressions and denominations is going to be very high on the one case and very low in the other. The reason for this is clear: a large proportion of the inhabitants of South America came mainly from Spain and Portugal, but there are also some, indeed many, from Italy and

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11 Appellations of origin- Position of Chile’s Vineyards in the Concert of the New World and in relation to the negotiations with the EU., Montevideo, 2001, WIPO Publication- WIPO/ GEO/ MVDI 01114. P.6
France. So the negotiations cannot take place with one of the parties disregarding the cultural origins of the other as if those elements did not form part of the very essence of the other party’s identity, something that no person can justly pretend to ignore.”

We could not have said it better than Mekis. Homonymy is a serious issue in the realm of geographical indications; we propose that the names could remain the same but one could add the flag of a country to show the actual origin of the product.

[e] Negotiations and Review of TRIPS is provided in Article 24 to keep under review the application of the provisions of Section 3 (which provides requirement on geographical indications).

[f] Exceptions to the protection of geographical indications under Article 24 was looked at which provides inter alia that a Member is not allowed to diminish the protection of geographical indications that existed in that Member prior to the entry into force of the WTO Agreement. It is added that the WTO Agreement should not be seen as the absolute protection available to geographical indications but the minimum standards of protection. It does seem difficult to imagine how a country can be disallowed from diminishing its own protection of geographical indications, unless a country affected by the diminishment forwards a complaint to the Dispute Settlement Body or DSB, formed under Annex 2 of TRIPS 1994, Article 1. in any case the addition
of this requirement is necessary to prevent the prejudicing the rights that other Members held in respect to the legislation prior to the diminishing thereof.

In conclusion we said that TRIPS is the only agreement with the largest signatory membership regarding geographical indications and provides wide coverage. In this regard whatever changes are made to this Agreement will necessarily have implications on several fronts. As a result, Kenya as a Member should and must take a keen interest in the amendments and development of TRIPS.

Chapter Four.

In this Chapter we looked at the Kenyan position in respect to geographical indications which in fact was not as comprehensive as we had hoped because currently Kenya has no legislation dealing with geographical indications and has so far not registered any geographical indications. We did however propose what that legislation should contain. Currently the Geographical Indications Bill has not yet been tabled in parliament. We looked at the provisions in TRIPS, Lisbon Agreement, Paris Convention and Madrid Agreement. We summarized our work under the following headings.

[a] Meanings and definitions of Geographical indications under which accepted that the definition in the TRIPS is broad enough as mentioned at the beginning of this Chapter.
[b] The procedures applied in the recognition of geographical indications where we spanned the history of marking origins on French wine. We looked at the two existing approaches in the recognition of geographical indications. In the case of appellations of origin it is the adoption of a specific decree or law whereas in the case of geographical indications it is its registration which is an administrative decision.

c) Persons entitled and the procedure of registration under which we contended that since the TRIPS Agreement does not have the method of registration of geographical indications, that we should look at the Lisbon Agreement which is more elaborate in this respect.

e) Protection available in the unauthorised use of geographical indications where we looked at the general protection provided under TRIPS in Article 22.2, Article 10bis of the Paris Convention and Article 3 of the Lisbon Agreement. Under the existing approaches the following were named: Unfair competition and passing off, protected appellations of origin and registered geographical indications, collective and certification trademarks, and administrative schemes of protection. Are these relevant to LDCs? If we are to use the passing off action as per the Law of Torts then the avenue is open to individuals such as importers to seek damages in case of infringement of goods. In the case of unfair competition the Trade Descriptions Act Chapter 505, permits criminal action to be taken against a person who applies a false trade description. See Section 7 below:
"Where a false trade description is applied to any goods outside Kenya and the false indication, or one of the false indications, given, or likely to be given, thereby is an indication of the place of manufacture, production, processing or reconditioning of the goods or any part thereof, the importation of the goods shall be prohibited and any person or persons handling or dealing in such goods shall be guilty of an offence."

The certification and collective marks are covered by the Standards Act Chapter 496, enabling the authorities to prevent the entry of goods that infringe a registered indication.

Although Kenya does not have any registered geographical indications it is expected that it recognise geographical indications or appellations of origin registered by other jurisdictions. Kenya is therefore under obligation not to allow the entry of "pirated goods" into its port of entry. Here the customs authorities are expected to be vigilant regarding the entry of such goods.

We may have looked at registered geographical indications and protected appellations of origin, but for adequate protection to be afforded thereto there is need for "administrative schemes of protection such as approval procedure for product labels and so on. There needs to be vigilance on the part of the administrative authorities for this to work efficiently."
Enforcement measures included Part III of TRIPS which is further subdivided into 5 sections namely: General Obligations, Civil and Administrative Procedures and Remedies, Provisional Measures, Special Requirement Related To Border Measures and Criminal Procedures. Relating thereto we looked at how the Civil Procedure Act assists in providing ex parte hearings where time is of the essence. We also looked at the Imports, Exports and Essential Supplies Act Chapter 502 to determine what provisions Kenyan legislation in relation to prohibition of infringing goods into the local market at the source of entry into the country.

Trademarks and geographical indications was also looked at in detail where we provided case law in order to determine when a trademark consisting of a geographical name cannot be registered.

RECOMMENDATIONS.

Having given an overview of what has been covered in the preceding chapters we find it necessary to recommend that the Geographical Indications Bill should be tabled as soon as is practicable in parliament. We are an economy based on agriculture, a large part of the industrial sector is the secondary stage of the agricultural sector for example food processing, leather factories and textile factories. The rest of our industrial sector is not able to find the expertise or the financial resources to enable the patenting of new invention.
Yet in spite of this we have extensive law on patents one just needs to look at the **Industrial Property Act of 2001**, and wherein there is no mention of geographical indications. The innovation that we need may be found in agriculture; but the law needs to recognise this by providing incentive through registered geographical indications. Incentive provided through the financial gains to be obtained by selling a product that is unique to certain geographical area. Our law, in the form of Intellectual Property Law, needs to provide the safety and incentive to producers through recognition of their rights, vested in the agricultural commodities they may produce, emanating from certain areas.

Geographical indications are important to us as an agricultural economy for now all we have is the best quality coffee. Countries such as India are seeking the registration of *Darjeeling Tea* as a geographical indication thanks to the [Indian Geographical Indications Act](https://indiangeographicindications.com) cleared by their parliament in 1999.\(^\text{12}\)

In South America, Panama under the [Speciality Coffee Association of Panama or SCAP](https://specialitycoffeeassociation.org) seeks to introduce appellations of origin for its coffee. This

is according to a Press Release\textsuperscript{13} by the **Boot Coffee Consulting and Training**, this press release provides *inter alia* that:

"Panama is at the forefront of the specialty market movement to create an "Appellations of Origins" for coffee production. Like wine, coffee beans develop unique characteristics depending on growing region and altitude. With funding from the Inter-American Development Bank, the Specialty Coffee Association of Panama (SCAP) has contracted Boot Coffee Consulting to create a coffee quality assurance program.

This program will identify unique growing regions and create an appellation of origin system to designate and track the coffee growing areas of Panama. The appellation system will also work in conjunction with the development of standardized processing techniques for harvesting, transporting, milling and warehousing. A certification program will be created to administer the preservation of adopted standards, including Region Certification and ongoing Quality Certification.

With certified quality, the coffee growers of Panama will differentiate their coffee from the commodity coffee market."

Panama in recognising the importance of coffee and is going to put in place a system that will protect a registered variety of coffee from planting, harvesting

\textsuperscript{13} Press Release, Panamanian Specialty Coffee Growers Unite to Strengthen their commitment to Quality, Panama 2000. This statement was found in the internet site-www.bootcoffee.com
processing up until the marketing level to ensure that the registered geographical indication of that particular coffee is protected. There are other coffee producing nations such as Brazil, Colombia, Sri Lanka, Tanzania to name a few, that may join the quest to seek registration for their brands.

Kenya needs the legislation to support its endeavour to register her coffee as a geographical indication. Moreover the geographical indications are unlimited, one may seek them for other products such as mineral water, tea, fruits such as mangoes, textile material, meat, fish, poultry and game- the list is endless. In the Nice Classification Agreement appellations of origin may registered under several classes and these classes are not restricted to agricultural goods for instance paints, hand tools and building materials.

The existence of well researched legislation relating to geographical indications is a definite plus to our legislation, who knows once people are aware that one can register an indication where some kind of quality or characteristic of the product is attributable to a specific region, may spur the much needed innovation we seek.
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