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## Distinctive Signs for Collective Use in Latin America: Development Promotion by Valuing Origin and Quality

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**SMART IP FOR LATIN AMERICA (SIPLA)**

COMPARATIVE STUDY

**DISTINCTIVE SIGNS FOR COLLECTIVE USE IN LATIN  
AMERICA:  
DEVELOPMENT PROMOTION BY VALUING ORIGIN AND  
QUALITY**

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## **PRESENTATION**

This comparative study is the result of the research project on ‘Distinctive Signs for Collective Use’ developed under the Smart IP for Latin America Initiative of the Max Planck Institute. The study intends to analyse and compare the protection systems in place in nine countries of Latin America (LA) in terms of the valorisation of origin, know-how, production processes, and traditional knowledge applied to production processes, either through the geographical indication (GI)/designation of origin (DO) system or other protection systems that distinguish and valorise locally-produced products/services through distinctive signs for collective use.

For this purpose, work was carried out with national experts from the selected countries: Argentina (Carol O’ Donnell), Brazil (Suelen Carls and Pedro Henrique D. Batista, both authors of this study), Chile (Carolina Belmar), Colombia (José Luis Londoño), Costa Rica (Leonor Obando), Mexico (Karla Priscilia Juarez Bermudez), Paraguay (Berta Davalos), Peru (Luis Alonso García), and Uruguay (Sofía Ruete), based on questionnaires prepared by the authors according to the research needs, and subsequent information exchanges and specific consultations. The information provided by the national experts includes current legislation, and case law that illustrate the functioning of the respective national systems.

## INTRODUCTION

The protection of geographical indications through intellectual property rights is a relatively new institution. Its mandatory nature in the multilateral context subject to the World Trade Organization (WTO) dispute settlement system derives from the Marrakesh Agreement,<sup>1</sup> which contains the first binding commitments on intellectual property (IP).

The protection required under the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) is defined in two articles.<sup>2</sup> Article 22 covers all products and defines a standardised level of protection. It states that geographical indications must be protected to avoid misleading the public and prevent unfair competition. Article 23 provides a higher level of protection for GIs for wines and spirits: subject to several exceptions, such indications must be protected even if their misuse does not mislead the public. The exceptions are contained in Article 24. The Agreement allows for exceptions such as the case where a name has become a common or 'generic' term, terms constituting grape varieties, homonymy, and the case where a term has already been registered as a trademark.

The section of the TRIPS Agreement dealing with geographical indications represents the delicate balance achieved in the Uruguay Round between different interests. While the negotiations on some TRIPS issues could largely be described as a North-South debate, those on GIs, particularly on wine and spirits, were what was called at the time an 'Old World' versus 'New World' debate, ie between 'Old World' countries (Europe) and 'New World' countries, namely the United States, Australia, Canada, New Zealand, and Latin American (LA) countries. These differences were also largely parallel to those between agricultural product importers and exporters and were linked to the Uruguay Round negotiations on agriculture.<sup>3</sup>

Latin American countries have incorporated the Marrakesh Agreement commitments in their legal system and practice, as provided for in the multilateral agreement.<sup>4</sup> However, it should be noted that the

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<sup>1</sup> The WTO Agreements are the result of the 1986-1994 Uruguay Round negotiations and were signed at the Marrakesh Ministerial Conference in April 1994.

<sup>2</sup> WTO, 'Geographical indications: Background and recent developments' <[www.wto.org/english/tratop\\_e/trips\\_e/gi\\_background\\_e.htm](http://www.wto.org/english/tratop_e/trips_e/gi_background_e.htm)> accessed 28 December 2021.

<sup>3</sup> WTO, 'Guide to the TRIPS Agreement', 1 <[www.wto.org/english/tratop\\_e/trips\\_e/ta\\_docs\\_e/modules4\\_e.pdf](http://www.wto.org/english/tratop_e/trips_e/ta_docs_e/modules4_e.pdf)> accessed 28 December 2021.

<sup>4</sup> WTO TRIPS Agreement, art 1.1: 'Members shall be free to determine the appropriate method of implementing the provisions of this Agreement within their own legal system and practice' <[www.wto.org/english/docs\\_e/legal\\_e/trips\\_e.htm#part1](http://www.wto.org/english/docs_e/legal_e/trips_e.htm#part1)> accessed 28 December 2021.

region's countries already had instruments for the differentiation and valorisation of their products, generally within the trademark system.

Subsequently, the Doha mandate<sup>5</sup> included two issues, both related to the higher level of protection (Article 23): the creation of a multilateral register for wines and spirits, and the extension of the higher level of protection to products other than wines and spirits.

The stagnation of the multilateral negotiations caused the regional agenda through the free trade agreements (FTAs) to incorporate commitments that, in certain cases, go beyond the levels of protection agreed in the TRIPS Agreement, with its implications.<sup>6</sup> In this regard, several countries in the region are parties to FTAs that contain, as will be seen in the comparative study, TRIPS-plus commitments on GIs, which have been incorporated into their respective national legislations.

The implications of the higher IP protection standards contained in the FTAs in terms of the application of the GATT/WTO principles: the most-favoured-nation (MFN) clause (equal treatment for all others) and national treatment (NT)<sup>7</sup> (equal treatment for nationals and foreigners<sup>8</sup>) are an issue of special interest due to their legal effects when implementing the commitments made in those treaties.<sup>9</sup>

This comparative study is the result of the research project of the SIPLA Initiative of the Max Planck Institute 'Distinctive Signs for Collective Use in Latin America'. The study intends to analyse and compare the protection systems in place in nine LA countries in terms of the valorisation of origin, know-how, production processes, and traditional knowledge applied to them, either through the GI/DO system or through other protection systems that distinguish and valorise locally-produced products/services through distinctive signs for collective use. To achieve this objective, work was carried out with national experts from the nine selected countries: Argentina, Brazil, Chile, Colombia, Costa Rica, Mexico, Paraguay, Peru, and Uruguay.

This study is organised into an introduction and four chapters. The first chapter studies national protection systems other than

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<sup>5</sup> WTO, 'Ministerial declaration adopted on 14 November 2001' <[www.wto.org/english/thewto\\_e/minist\\_e/min01\\_e/mindecl\\_e.htm#top](http://www.wto.org/english/thewto_e/minist_e/min01_e/mindecl_e.htm#top)> accessed 28 December 2021.

<sup>6</sup> Henning Grosse Ruse-Khan and others, 'Principles for Intellectual Property Provisions in Bilateral and Regional Agreements' (2013) 44 IIC - International Review of Intellectual Property and Competition Law <<https://link.springer.com/article/10.1007/s40319-013-0119-1>> accessed 28 December 2021.

<sup>7</sup> WTO TRIPS Agreement, art 1 para 3.

<sup>8</sup> *ibid* art 3.

<sup>9</sup> Reto M Hilty and Thomas Jaeger, 'Legal Effects and Policy Considerations for Free Trade Agreements: What Is Wrong with FTAs?' (2015) 24 MPI Studies on Intellectual Property and Competition Law <[www.zora.uzh.ch/id/eprint/117629/](http://www.zora.uzh.ch/id/eprint/117629/)> accessed 28 December 2021.

GIs/DOs. The second chapter describes how the nine countries studied have incorporated TRIPS commitments into their national legislation through the following variables: 1. GI/DO protection systems; 2. application processes for the protection of GIs/DOs; 3. infringements of GI/DO rights; 4. production management and control; and 5. public policy and government assistance. The third chapter focuses on the FTAs signed by the countries under study with other countries or groups of countries that contemplate commitments in GI/DO. Lastly, the final chapter recapitulates the differences and similarities in the national systems analysed, draws preliminary conclusions, and proposes possible lines of research derived from the project.

The comparative analysis identifies specific questions of interest, for example, whether GIs/DOs are the only effective instrument to protect LA products or services, given each country's different social, economic, and productive realities. It is also worth asking whether they are a suitable for adding value to production processes in the region. On the other hand, the question arises as to whether the GI/DO system that prioritises the link with the territory allows for the adequate valorisation of other distinctive elements of LA productions linked not to the territory but to the 'know-how' of the producer's profile, among others.

These and other questions pose a challenge to think of alternatives for the region such as a regional system of mutual recognition of distinctive signs for collective use that, in addition to existing instruments and multilateral commitments, would complement the region's potential and needs from a particular perspective. It would also be very important, with a view to the future, and considering that LA has an undisputed leading role as a food supplier to the world, to provide a 'tailor-made approach for the countries of the region'. Consider the role of distinctive signs in the face of new global challenges: the goals of sustainable development, healthy food, post-pandemic food security: global commitments and measures that transform food systems to eradicate hunger, among others.

## **1. DISTINCTIVE SIGNS OTHER THAN GI'S**

The comparative study of the distinctive quality protection systems in place at the national level was carried out in nine Latin American countries, namely Argentina, Brazil, Chile, Colombia, Costa Rica, Mexico, Paraguay, Peru, and Uruguay. In these and other countries of the region known as 'New World producers', there is a tradition of trademarks to distinguish and enhance the value of products. Therefore, when attempting to study the distinctive signs in force in the region, it is particularly relevant to know the characteristics of the various existing systems, in many cases before incorporating the GI system into

national legislation after signing the Marrakesh Agreement,<sup>10</sup> and, hence, the obligations assumed through the TRIPS Agreement.

The first aspect to be identified and compared between the countries' legislation is the existence of protection systems, other than GIs, to distinguish and add value to local productions. The following is a summary of the main elements in the nine countries' national reports, which show that there are indeed alternative legal instruments to GIs to differentiate and distinguish products and services, generally within the framework of the trademark system.

In **Argentina**, there are distinctive signs other than GIs whose purpose is to promote social and human development policies. Laws, decrees, and resolutions regulate these signs and, inter alia, protect trademarks and collective trademarks, approve distinctive signs that certify certain characteristics, and promote the creation of value addition for the promotion of local industry. The regulations state that differentiation systems other than GIs may be used together with GIs and/or trademarks, provided that the appropriate legal requirements are met to allow their simultaneous use.

It should be made clear that Law 22362/1980<sup>11</sup> as amended by Law 27444/2018<sup>12</sup> regulates the protection of trademarks and designations but not of collective trademarks, which fall within the scope of a special law, as indicated below. It should be noted that Law 22362 establishes that signs that are misleading and/or constitute DO or GI expressly recognised in the country may not be registered as trademarks. In addition, the law on trademarks and designations does not expressly protect certification marks expressly but does not prohibit their registration, either. Therefore, certification marks may be registered as long as their owners establish the conditions for their use. Some of the most outstanding instruments are described below.

The collective trademark (Law 26355/2008<sup>13</sup>) is defined as any sign that distinguishes the products and/or services produced or rendered by the associative forms intended to develop the social economy. It has a specific social purpose since it aims to promote market participation of the social economy's products and services and place them in the formal market. Only groups of producers and/or

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<sup>10</sup> WTO, Marrakesh Agreement Establishing the World Trade Organization <[www.wto.org/english/docs\\_e/legal\\_e/04-wto\\_e.htm](http://www.wto.org/english/docs_e/legal_e/04-wto_e.htm)> accessed 28 December 2021.

<sup>11</sup> Argentina, Law 22362/1980 <<http://servicios.infoleg.gob.ar/infolegInternet/anexos/15000-19999/18803/texact.htm>> accessed 28 December 2021.

<sup>12</sup> Argentina, Law 27444/2018 <<http://servicios.infoleg.gob.ar/infolegInternet/anexos/310000-314999/311587/norma.htm>> accessed 28 December 2021.

<sup>13</sup> Argentina, Law 26355/2008 <<http://servicios.infoleg.gob.ar/infolegInternet/anexos/135000-139999/138933/norma.htm>> accessed 28 December 21.



service providers registered in the National Register of Local Development and Social Economy Actors may be holders of collective marks. The common distinctive sign was approved separately (Resolution 1386/2008<sup>14</sup>) and is the distinct identity for products and services of the social economy.



The seal *Alimentos Argentinos, Una Elección Natural* (Argentine Food, a Natural Choice) (Law 26967/2014<sup>15</sup>) of the Ministry of Agriculture, Livestock and Fisheries aims to foster the differentiation of food products that stand out for their quality, authenticity, and originality.



The objectives of the seal *Producido por la Agricultura Familiar* (Produced by Family Farming) (Resolution 419/2015<sup>16</sup>) and its isologotype are to make the contribution of family farming to food security and sovereignty visible and encourage it, foster and disseminate the quality and originality of family farming products and their social, cultural, and natural conditions of production, processing, transformation, and marketing, grant a special label to family farming products with valuable social, economic, cultural and/or natural attributes.



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<sup>14</sup> Argentina, Resolution 1386/2008  
<<http://servicios.infoleg.gob.ar/infolegInternet/anexos/145000-149999/147411/norma.htm>> accessed 28 December 2021.

<sup>15</sup> Argentina, Law 26967/2014  
<<http://servicios.infoleg.gob.ar/infolegInternet/anexos/230000-234999/234097/norma.htm>> accessed 28 December 2021.

<sup>16</sup> Argentina, Resolution 419/2015  
<<http://servicios.infoleg.gob.ar/infolegInternet/anexos/245000-249999/249099/norma.htm>> accessed 28 December 2021.

The distinctive sign for organic products is an isologotype (Resolution 1291/2012<sup>17</sup>) that distinguishes organic products exclusively.



The Argentine Wine isologotype (Law 26870/2013<sup>18</sup>) declares Argentine wine as a national beverage. Resolution 49/2013 establishes the mandatory inclusion of the isologotype *Vino Argentino, Bebida Nacional* (Argentine Wine, National Beverage) in the labelling of wines and beverages of wine origin. The subsequent Resolution 20/2020<sup>19</sup> of the National Institute of Vitiviniculture establishes that the isologotype or equivalent text must be mentioned on wine labelling.



The objective of the brand *Acuicultura Argentina* (Argentine Aquiculture) and its isologotype (Resolution 7/2015) of the national Ministry of Agriculture, Livestock and Fisheries is to encourage and support the expansion of the sector engaged in cultivating aquatic organisms or aquaculture.



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<sup>17</sup> Argentina, Resolution 1291/2012

<<http://servicios.infoleg.gob.ar/infolegInternet/anexos/205000-209999/206732/norma.htm>> accessed 28 December 2021.

<sup>18</sup> Argentina, Law 26870/2013

<<http://servicios.infoleg.gob.ar/infolegInternet/anexos/215000-219999/218039/norma.htm>> accessed 28 December 2021.

<sup>19</sup> Argentina, Resolution 20/2020

<[www.boletinoficial.gob.ar/detalleAviso/primera/229622/20200521](http://www.boletinoficial.gob.ar/detalleAviso/primera/229622/20200521)> accessed 28 December 2021.

The distinctive sign and official emblem *Industria Argentina* (Made in Argentina) (Resolution 209/2013<sup>20</sup>) are used in developing industrial activities, promotion, organization, and participation in exhibitions, fairs, contests, samples, and missions abroad and within the country.



The nation brand *Argentina* (Decree 460/2021<sup>21</sup> which repealed Decree 191/2018) established the official brand of the Argentine Republic, with a view to the regularisation and standardisation of the national image in the world. The nation brand aims to coordinate its differential factors to position itself more successfully in certain world markets, promoting exports, tourism and investment growth, and disseminating its best attributes such as culture, traditions, science, technological innovation, and sports.



**Brazil** also provides for various distinctive signs other than GIs in its national legislation. Certification marks and collective marks (Law 9279/1996<sup>22</sup>) are available in the industrial property system. The collective mark may be applied by legal entities representing a collective, such as associations of producers and cooperatives. The certification mark certifies the conformity of products and services with certain technical standards. Collective and certification marks can

<sup>20</sup> Argentina, Resolution 209/2013

<[www.argentina.gob.ar/normativa/nacional/resolución-209-2013-221654](http://www.argentina.gob.ar/normativa/nacional/resolución-209-2013-221654)> accessed 28 December 2021.

<sup>21</sup> Argentina, Decree 460/2021

<[www.boletinoficial.gob.ar/detalleAviso/primera/246904/20210715](http://www.boletinoficial.gob.ar/detalleAviso/primera/246904/20210715)> accessed 28 December 2021.

<sup>22</sup> Brazil, Law 9279/1996 <[www.planalto.gov.br/ccivil\\_03/leis/19279.htm](http://www.planalto.gov.br/ccivil_03/leis/19279.htm)> accessed 28 December 2021.

coexist with trademarks and geographical indications since the purpose of each is different.<sup>23</sup>

In addition, there are other instruments outside Law 9279/1996 which help in promotion and differentiation. These are:

The national seal *Agricultura Familiar* (Family Farming) is specially created for Brazilian family farming production. Ordinance 161/2009 of the Ministry of Agriculture, Livestock, and Supply contains the rules for the approval of this seal.<sup>24</sup>



Organic certification has national regulations. There are several laws and regulations applicable to organic production in Brazil. *Centro de Inteligência Orgânica*.<sup>25</sup>



The seal 'Brazil Agro - Good for Nature' promotes Brazilian products abroad.



Other international certifications Rain Forest Alliance, Fair Trade, EUREPGAP, ISO, BomSucro, UTZ, and RTRS.

**Chile** also provides other figures for the protection and differentiation of products and services. Since 2007, the Industrial Property Law 19039<sup>26</sup> recognises collective marks and certification marks. Its recent amendment incorporated by Law 21355, published on 5 July 2021 and effective since 5 January 2022, defines a collective trademark as any sign or combination of signs capable of distinguishing

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<sup>23</sup> In this sense, see eg Patrícia Maria da Silva Barbosa, Lucia Regina Rangel de Moraes Valente Fernandes and Patrícia Pereira Peralta, 'Encontros e desencontros entre indicações geográficas, marcas de certificação e marcas coletivas' in Liane Lage, Eduardo Winter and Patrícia Maria da Silva Barbosa (eds), *As diversas faces da propriedade intelectual* (EdUERJ 2013).

<sup>24</sup> Brazil, Ordinance 161/2019 <[www.in.gov.br/en/web/dou/-/portaria-n-161-de-9-de-agosto-de-2019-210508396](http://www.in.gov.br/en/web/dou/-/portaria-n-161-de-9-de-agosto-de-2019-210508396)> accessed 28 December 2021.

<sup>25</sup> Brazil, Law 10831/2003 <<https://ciorganicos.com.br/organicos/legislacao-de-organicos/>> accessed 28 December 2021.

<sup>26</sup> Chile, Law 19039/1991 <[www.bcn.cl/leychile/navegar?idNorma=30406](http://www.bcn.cl/leychile/navegar?idNorma=30406)> accessed 28 December 2021.

in the market the products or services of an association's members from the products or services of third parties. For this purpose, an association shall be understood as a group of producers, manufacturers, traders, or service providers with legal personality. The collective mark may not be assigned to third parties.



While having rules of use and control<sup>27</sup> in place is not compulsory, if holders accompany applications with them, they will be mandatory for all its members. Non-compliance will enable the others to demand observance or compensation for damages to the non-compliant producer. The holder is the producers' association, and the duration is 10 years renewable.

Certification marks are considered by Chilean legislation as a subspecies of collective marks. Therefore, in addition to sharing the characteristics of collective marks, they are distinctive signs intended to be applied by duly authorised, controlled and certified persons<sup>28</sup> to products to accredit some specific common characteristic(s), some specific components that may be linked to a certain origin or nature of the products. The duration of the trademark is 10 years renewable.



Collective and certification marks only need to have rules of use and control. The rules of use must comply with the following requirements:<sup>29</sup>

- a) Contain the holder's identification data,
- b) Identify the goods or services to be distinguished by the collective mark, or the products and services to be certified,
- c) Indicate the conditions and modalities for the use of the trademark,

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<sup>27</sup> With the reform introduced to Chilean regulations by Law 21355/2021, which will come into force in January 2022, having rules of use and control becomes a requirement to apply for a collective mark or certification mark.

<sup>28</sup> Chile (n 26) s 19 sub-s 5.

<sup>29</sup> Chile, Law 21355/2021, s 23bis.C

<[www.bcn.cl/leychile/navegar?idNorma=1162253&tipoVersion=0](http://www.bcn.cl/leychile/navegar?idNorma=1162253&tipoVersion=0)> accessed 28 December 2021.

- d) Contain the reasons for which the use of the trademark may be prohibited to an association's member, or the person previously authorised in the case of the certification mark,
- e) Contain the other mentions established by the regulations of this law.

The National Institute of Industrial Property may object to the registration of the rules of use or their amendment, as it deems appropriate, at the formal examination stage or the substantive examination stage, if, in its opinion, they infringe legal or regulatory provisions or contain provisions contrary to public order or that may mislead or confuse the consuming public.

Collective and certification marks apply to all goods and services. In practice, both types of marks have been used to protect signs that, in turn, could be GIs conceptually. Therefore, collective marks and certification marks were incorporated in the trademark system as a special type.

However, the regulations do not repeal, and complement, the pre-existing protection systems, under which, before the TRIPS Agreement, special laws and administrative decrees of the Ministry of Agriculture recognised the designations of origin (DOs) for *Pisco* and wines, which are complementary and parallel to the general register of GIs and DOs for products created in 2005.<sup>30</sup>

Finally, through the Institute for Agricultural Development, the Chilean Ministry of Agriculture has registered as a simple trademark the trademark *Manos Campesinas* (Farmer's Hands), which is used as a seal to promote and differentiate family farming in the country.<sup>31</sup>



<sup>30</sup> Law 19996 published in 2005 amended Industrial Property Law 19039 to incorporate the obligations arising from the WTO accession and implemented a general system for the registration of geographical indications and designations of origin for all types of products under the administration of the same authority administering trademarks. However, the authority excluded from the system the previously created DOs for *Pisco* and wines, which are regulated by the Chilean Ministry of Agriculture.

<sup>31</sup> See Chile, 'Sello Manos Campesinas'

<[www.chileagricola.cl/sello-manos-campesinas/](http://www.chileagricola.cl/sello-manos-campesinas/)> accessed 28 December 2021.

In **Colombia**, there are also protection systems other than GIs. They are certification trademarks and collective trademarks. The legal provisions on the *sui generis* system of GI protection, and the registration system of product/service trademarks and certification and protection marks are contained in the same rule, the Andean Community Decision 486 of 2000.<sup>32</sup> The system of collective marks is regulated in Articles 180 to 184, and that of certification marks in Articles 185 to 189, while the *sui generis* system is included in Title XII Articles 201 to 223.

According to Articles 185 and 186 of Decision 486, a certification mark is understood as a sign intended for products or services whose quality or other characteristics have been certified by the mark holder. Likewise, a certification mark may be held by a company, institution under private or public law, or a state, regional or international organisation.

Certification marks may be used in conjunction with a particular product or service mark. The label used as a certification mark will prove that the company's products or services comply with the specific standards required for its use.

The application of one system or the other is optional, ie there is no exclusion, it is sufficient to make the typical adaptation to apply for protection by one system or the other.

However, it is important to emphasise that it is optional but not indistinct, since the *sui generis* system includes, for DO protection, the obligation to demonstrate the causal link or relationship between the quality or characteristic of the product and the territory or the human factor. Therefore, it can be stated that a sign that meets all the conditions to be an DO can also be applied for or protected as a certification mark or collective mark, but not vice versa.

This is why certification marks and collective marks are used to differentiate and identify common characteristics or standards of products or services (DOs do not protect services) that prefer such protection or whose link with the territory may simply be indicative of an origin without the need to tie this origin to a specific quality or characteristic.

One of the major differences lies in applying trademark rules to the *sui generis* system or the certification mark system. In the case of collective or certification marks, it refers to the trademark rules when there is no express rule. Thus, the entire registration procedure and perhaps several grounds for refusal of trademarks can be applied to certification and collective marks. On the other hand, the DO system has its catalog of limits to its protection, including the existence of

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<sup>32</sup> Andean Community Commission, Decision 486/2000: Common Regime on Industrial Property <[www.sice.oas.org/Trade/Junac/Decisiones/dec486si.asp](http://www.sice.oas.org/Trade/Junac/Decisiones/dec486si.asp)> accessed 28 December 2021.

previous trademarks that are reproduced by the DO whose protection is sought. Some examples include:

#### Certification mark



#### Collective mark



In the case of **Costa Rica**, its legislation also provides for protection figures other than GIs: collective marks and certification marks. The Law on Trademarks and Other Distinctive Signs (revised in 2008<sup>33</sup>) establishes the protection of collective marks, certification marks, and GIs, among other legal protection figures. It defines collective trademarks as those in which the holder is a collective entity grouping persons authorised by the holder to use the trademark for a product or service. In the case of certification trademarks, they are applicable to products or services whose characteristics the holder has the power to certify. Trademarks may include national or foreign geographical names, provided that they are sufficiently distinctive, and their use is not likely to create confusion as to the origin, source, and qualities or characteristics of the goods or services for which they are used or to which they are applied. The risk of confusion is presumed to exist when a GI and a trademark are identical and are applicable to the same good or service. In such cases, the first registered sign prevails.

Although the Trademark Law seems to frame the figure of GI and DO for goods, the Regulation of the Provisions Related to Geographical Indications and Designations of Origin, contained in the Law on Trademarks and Other Distinctive Signs, Executive Decree 33743 J-

<sup>33</sup> See Costa Rica, Law 7978/2000

<[www.pgrweb.go.cr/scij/Busqueda/Normativa/Normas/nrm\\_texto\\_completo.aspx?param1=NRTC&nValor1=1&nValor2=45096&nValor3=72368&strTipM=TC](http://www.pgrweb.go.cr/scij/Busqueda/Normativa/Normas/nrm_texto_completo.aspx?param1=NRTC&nValor1=1&nValor2=45096&nValor3=72368&strTipM=TC)> accessed 28 December 2021.



COMEX<sup>34</sup> as amended, considers the possibility that GIs and DOs may be used for both goods and services (see Section 4 of the Regulation).



In the case of **Mexico**, products with a certain quality, reputation, or another characteristic fundamentally attributable to their geographical origin are protectable by figures regulated in the Law,<sup>35</sup> such as collective marks and certification marks.

The registration of a collective trademark is required to distinguish in the market the products or services of associations or societies of producers, manufacturers or traders of products, or service providers, as long as these products or services have quality or characteristics common among them and different from the third parties' products or services.

The members of the association or society holding the collective mark may use the term 'registered collective mark' together with the mark. Collective marks are governed, by the law for trademarks, insofar as there is no special rule.



The certification mark is a sign that distinguishes products and services with qualities or other characteristics certified by its holder, such as: I. The components of the products; II. The conditions under which the products have been produced or the services rendered; III. The quality, processes, or other characteristics of the products or services, and IV.

<sup>34</sup> Costa Rica, Law 33743/2000

<[www.pgrweb.go.cr/scij/Busqueda/Normativa/Normas/nrm\\_texto\\_completo.aspx?param1=NRTC&nValor1=1&nValor2=60074&nValor3=115343&strTipM=TC](http://www.pgrweb.go.cr/scij/Busqueda/Normativa/Normas/nrm_texto_completo.aspx?param1=NRTC&nValor1=1&nValor2=60074&nValor3=115343&strTipM=TC)> accessed 28 December 2021.

<sup>35</sup> Mexico, 'Federal Law on Industrial Property Protection of 2000' <[https://leyes-mx.com/ley\\_federal\\_de\\_proteccion\\_a\\_la\\_propiedad\\_industrial.htm](https://leyes-mx.com/ley_federal_de_proteccion_a_la_propiedad_industrial.htm)> accessed 28 December 2021.

The geographical origin of the products. The certification mark may consist of the name of a geographical area, or a term that contains such name, or another indication known to refer to the mentioned area, which identifies a product as originating from it, when a certain quality, reputation, or another characteristic of the product is fundamentally attributable to its geographical origin. In the case of national geographical indications protected as certification marks, it will be understood that these are assets of the Federation's public power.

When the certification mark is constituted by a national geographical indication, only the following may apply for registration: I. The legal entities directly engaged in the extraction, production, or processing of the product to be covered; II. The chambers or associations of manufacturers or producers linked to the product to be covered by the indication; III. The agencies or entities of the Federal Government, and IV. The governments of the Federation's states in whose territory or geographical area the product to be covered is extracted, produced, or processed.

The application for registration of a certification mark must be accompanied by the rules for its use, indicating: I. the products or services to which the mark will be applied; II. the representation of the mark; III. the technical specifications defining the characteristics of a product or service such as the origin of raw materials, the production conditions, its transformation procedure, its physical, chemical, toxic, bacteriological, or usage characteristics, its composition or labelling; IV. the procedure of verifying the specific characteristics indicated in the previous point; V. the modalities and periodicity with which the quality controls must be exercised on the production of the good in its different stages and its transformation and commercialisation; VI. the regime of sanctions in case of non-compliance with the rules of quality control of the good in its different stages, and in its transformation and commercialisation; VII. the modalities and periodicity with which the quality controls must be exercised on the production of the good in its different stages and its transformation and commercialisation; VIII. the sanctions in case of non-compliance with the rules of use; IX. the indication that the mark may not be licensed; X. the indication on the exercise of the legal actions of protection; XI. if applicable, the degree of consistency between the use rules and the Mexican Official Standards, Mexican Standards, or any other international standards or guidelines.

The holder of a certification mark shall grant authorisation for its use to any person whose product or service complies with the conditions in the rules for its use. Only authorised users may use the term 'registered certification mark' with the certification mark.



The fundamental difference between collective marks and certification marks is that the former can only be used by a specific group of persons or companies such as an association's members, while the certification mark can be used by any individual or legal entity that complies with the rules established by the holder of the mark.

In **Paraguay**, there are also protection systems other than GIs and DOs. In addition to traditional trademarks, there is protection for collective and certification marks as provided for in Law 1294/98 on Trademarks.<sup>36</sup> Collective marks are defined as any sign that distinguishes the origin or any other common characteristic of products or services of different companies that use the mark under the holder's control. In other words, it protects products and services of more than one company using it under the control of its holder. Regarding certification marks, the Law defines them as a sign applied to products or services whose characteristics or quality have been certified by the holder of the mark. Although each mark has specific characteristics, both have the same duration as trademarks, ie 10 years renewable indefinitely.

**Peruvian** legislation provides for differentiation systems other than GIs and DOs, which include collective marks, certification marks, and traditional specialties guaranteed. As in Colombia, Peru's IP rights are regulated by Decision 486 of the Andean Community Commission laying down the Common Regime on Industrial Property, and Legislative Decree 1075/2008<sup>37</sup> as amended by Legislative Decree 1397/2018.<sup>38</sup>

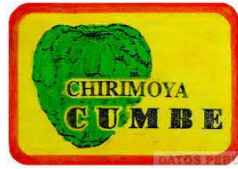
This legislation understands a collective trademark as any sign that distinguishes the origin or any other common characteristic of products or services of different companies using it under a holder's control. Associations of producers, manufacturers, service providers, organisations or groups of persons, legally established, may apply for the registration of a collective trademark to distinguish the products or services of its members in the market. It may be formed by any element

<sup>36</sup> See Paraguay, Law 1294/2012 <[www.bacn.gov.py/leyes-paraguayas/862/demarca](http://www.bacn.gov.py/leyes-paraguayas/862/demarca)> accessed 28 December 2021.

<sup>37</sup> See Peru, Legislative Decree 1075/2008 <[www.indecopi.gob.pe/documents/1902049/3918907/DL+1075.pdf/72df1e73-af31-238d-262e-f997814aadf5](http://www.indecopi.gob.pe/documents/1902049/3918907/DL+1075.pdf/72df1e73-af31-238d-262e-f997814aadf5)> accessed 28 December 2021.

<sup>38</sup> See Peru, Legislative Decree 1397/2018 <[www.indecopi.gob.pe/documents/20791/199826/Decreto+Legislativo+Nº+1397.pdf/9388f7b7-4cbe-439d-f79d-fe11be518fe7](http://www.indecopi.gob.pe/documents/20791/199826/Decreto+Legislativo+Nº+1397.pdf/9388f7b7-4cbe-439d-f79d-fe11be518fe7)> accessed 28 December 2021.

identifying the product to which it is applied as originating from a specific geographical place, when a certain quality, reputation, or another characteristic of the product is fundamentally attributable to its geographical origin.



For its part, a certification mark is defined as a sign intended for products or services whose quality or other characteristics have been certified by the mark holder, which may be a company or institution under private or public law, or a state, regional or international organisation. The application for registration of a certification mark must be accompanied by the rules of mark use indicating the products or services that may be certified by its holder, specify the characteristics guaranteed by the presence of the mark, and describe how control will be exercised.

The certification mark holder may grant authorisation for use to any person whose product or service meets the conditions established in the rules of mark use. A certification mark may consist of any element identifying the product to which it is applied as originating in a specific geographical place, when a certain quality, reputation, or another characteristic of the product is fundamentally attributable to its geographical origin.



Finally, it is very interesting to note that Legislative Decree 1397 incorporates the traditional specialties guaranteed (TSGs)<sup>39</sup> into the national system, which is currently in the process of regulation.<sup>40</sup> Their purpose is to protect traditional recipes, production, or processing

<sup>39</sup> The European Union specifies that traditional specialties guaranteed "[...] make it possible to respond to consumer demand for traditional products with specific characteristics". See European Union Council, Regulation (EC) 509/2006 <<https://eur-lex.europa.eu/legal-content/EN/LSU/?uri=CELEX%3A32006R0509>> accessed 28 December 2021.

<sup>40</sup> See Peru, 'Documento de Trabajo Institucional del Indecopi 002/2020: Propuestas del Indecopi para la reglamentación del Régimen de Protección de las Especialidades Tradicionales Garantizadas y del Régimen de las Indicaciones Geográficas' (2020) <[www.gob.pe/institucion/indecopi/informes-publicaciones/1859780-documentos-de-trabajo-para-comentarios](http://www.gob.pe/institucion/indecopi/informes-publicaciones/1859780-documentos-de-trabajo-para-comentarios)> accessed 28 December 2021.

methods corresponding to the traditional practice applicable to a product or food, thus contributing to adding value to traditional products in their marketing, production, or processing and informing consumers of their attributes. It should be noted that the link, more than with the territory, is with a culinary tradition.

The use of TSGs seeks to add value to Peruvian gastronomic products in their marketing, production, or processing. TSGs are signs of quality that guarantee that certain gastronomic preparations have traditionally Peruvian ingredients and/or preparation methods. In other words, through this legal figure, Peru would have effective protection of the knowledge and ingredients that have given identity to Peruvian gastronomy for the first time. For example, typical dishes such as *aji de gallina*, *papa a la huancaína*, *seco de chavelo*, *lomo saltado*, *pachamanca*, or traditional desserts such as *mazamorra morada*, the *King Kong*, *suspiro a la limeña*, could receive TSG treatment and, therefore, be protected and claimed under a *sui generis* regime of industrial property.

However, the right conferred on TSGs does not depend on the origin of a dish but on a recipe or method of production or processing corresponding precisely to a practice considered ‘traditional’. The non-dependence on origin is important in order not to create false expectations as to the content of the new right: the traditional specialties guaranteed are not certificates of origin of a given recipe—even though they may indirectly indicate it—but ensure the traditional character of the recipe or the method used to make it.

As in the rest of the countries analysed, **Uruguay**’s legislation provides protection systems other than GIs/DOs for differentiation and value addition. They are collective marks and certification marks contained in Law 17011/1998 known as the Trademark Law and its Regulatory Decree 34/1999, and Decree 283/93.<sup>41</sup> Under the legislation, a collective mark is defined as a mark used to identify products or services originating from members of an association of producers, industrialists, traders, and service providers to differentiate in the market their products or services from those of third parties. The application for registration must include rules of use indicating the identification data of the applicant association, the persons authorised to use the mark, the association’s membership conditions, the conditions of use of the mark, and the reasons for which the use of the mark may be prohibited to a member of the association.

The figure is governed, by remission, and unless otherwise provided for in the previous chapter, by the other provisions of the

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<sup>41</sup> See in Uruguay, Law 17011/1998 <[www.impo.com.uy/bases/leyes/17011-1998](http://www.impo.com.uy/bases/leyes/17011-1998)> accessed 28 December 2021; Uruguay Decree 34/1999 <[www.impo.com.uy/bases/decretos/34-1999](http://www.impo.com.uy/bases/decretos/34-1999)> accessed 28 December 2021.

Trademark Law. Thus, it is valid for 10 years renewable indefinitely for the same period using a formal request for renewal.

It is possible to register a foreign geographical indication as a collective mark, and, so far, there are several cases in force.

<b><i>PADANO GRANA - CONSORZIO PER LA TUTELA DEL FORMAGGIO GRANA PADANO [IT].</i></b>
<b><i>GP GRANA PADANO - CONSORZIO PER LA TUTELA DEL FORMAGGIO GRANA PADANO [IT].</i></b>
<b><i>SPECK ALTO ADIGE I.G.P. SÜDTIROLER SPECK G.G.A. SÜDTIROL INDICAZIONE GEOGRAFICA PROTETTA GESCHÜTZTE GEOGRAPHISCHE ANGABE - CONSORZIO TUTELA SPECK ALTO ADIGE-SÜDTIROLER SPECK CONSORTIUM [IT].</i></b>
<b><i>PARMA - CONSORZIO DEL PROSCIUTTO DI PARMA [IT].</i></b>
<b><i>CONSORZIO DELL'ASTI D.O.C.G. - CONSORZIO PER LA TUTELA DELL'ASTI [IT].</i></b>
<b><i>SÜDTIROLER APFEL G.G.A. SÜDTIROL - CONSORZIO MELA ALTO ADIGE [IT].</i></b>



Certification and guarantee marks are defined by the Law as the sign that certifies common characteristics, particularly the quality, components, nature, methodology used, and any other data deemed relevant by the holder concerning the products processed or services rendered by persons duly authorised and controlled by the holder. Only a State or parastatal body, competent to carry out quality certification activities on behalf of the State according to its tasks, or a private law entity duly authorised by the competent body may be the holder of a certification or guarantee mark.

These marks may not be used for the products or services of their holders. The law expressly prohibits to register as a guarantee or certification mark a DO, which must be registered under the specific rules in the corresponding Chapter of the Law.

As in the other cases analysed, the application for registration must include rules of use indicating the quality, components, nature, methodology used, and any other data on the products produced or

distributed, or the services rendered, as the holder may deem relevant. The marks may not be transferred to third parties, and their use may not be authorised to those not officially recognised by the holder association. Their registration will have indefinite duration and may be terminated by the cancellation of the registration or by dissolution or disappearance of their holder.



## 2. NATIONAL IMPLEMENTATION OF THE TRIPS COMMITMENTS

### 2.1. GI/DO PROTECTION SYSTEMS

GIs/DOs are generally protected in different countries and regions through a wide variety of systems, often using a combination of two or more systems. As the World Intellectual Property Organization (WIPO) explains, there are different ways of protecting a geographical indication, including the so-called *sui generis* systems (special protection regimes), collective or certification marks, and modalities focused on business practices, including administrative product approval regimes. Such systems have been developed under different legal traditions and in the context of particular historical and economic conditions. National and regional systems of GI protection in different Members include a combination of generally applicable laws on trade practices, particularly against consumer deception and unfair competition, certification or collective mark protection under trademark laws, and a range of *sui generis* systems (ie systems created specifically for one IP category of GI protection).<sup>42</sup>

The comparative study of the national implementation of TRIPS commitments by Argentina, Brazil, Chile, Colombia, Costa Rica, Mexico, Paraguay, Peru, and Uruguay shows that the nine countries under study do not escape the general rule and receive protection through a wide variety of systems and often using a combination of two or more systems. In all cases, their legislation provides for the protection of GIs through *sui generis* systems. By *sui generis*, we mean those systems or regulatory or legal arrangements through which countries have established mechanisms specially designed for the protection of GIs, ie by creating special institutions different from those for trademarks, unfair competition, or consumer protection.

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<sup>42</sup> WTO (n 3) 2.

Consequently, it can be stated that the countries studied have incorporated the GI obligations of the TRIPS Agreement into their national legislation, but they vary in their modality in the respective countries. While regional integration schemes in Latin America could have provided for regulatory harmonisation in this regard, of the countries studied, this is only the case of the Andean Community of Nations (CAN) through Decision 486 of 2000.

The main characteristics in which the nine countries have incorporated TRIPS commitments in GI are detailed below. This is organised by comparing six aspects of priority interest to develop the study.

- a) Characteristics of the GI/DO protection system. Validity of the national system.
- b) Scope of protection. Levels of protection. Products or activities with additional protection.
- c) Crystallisation at the level of registration systems. Products/activities covered.
- d) Ownership of the right. Rights conferred. Time limit.
- e) Limits to the exclusivity of the GI right: trademarks, generics, plant varieties, homonyms.
- f) Use of the terms ‘similar’, ‘type’, ‘class’ in the label.

### 2.1.1. Characteristics of the GI/DO protection system and validity of the national system

After having ratified the TRIPS Agreement, **Argentina** adopted a *sui generis* system for the protection and registration of GIs by enacting two special laws. Law 25163/99<sup>43</sup> establishing the legal regime for the recognition, protection, and registration of geographical names of wines and spirits of a vinous nature, and Law 25380/01<sup>44</sup> laying down the legal regime for indications of source and designations of origin of agri-food products.

<sup>43</sup> See Argentina, Law 25380/2000

<<http://servicios.infoleg.gob.ar/infolegInternet/anexos/65000-69999/65762/texact.htm>> accessed 28 December 2021; Argentina Decree 57/2004

<<http://servicios.infoleg.gob.ar/infolegInternet/anexos/90000-94999/91880/norma.htm>> accessed 28 December 2021.

<sup>44</sup> See Argentina, Law 25380/2000 (n 43); Argentina, Decree 556/2009 <<http://servicios.infoleg.gob.ar/infolegInternet/anexos/150000-154999/153460/norma.htm>> accessed 28 December 2021.



In addition, other rules in the regulatory framework prevent GI/DO misuse or misappropriation: The Paris Convention for the Protection of Intellectual Property, in its version of the Lisbon Act of 1958.<sup>45</sup> The Convention provides for the protection of indications of source or designations of origin and the sanction of unfair competition. In addition, the Union's countries undertake to prohibit the unauthorised use of the Union countries' State emblems when such use is misleading.

However, in Argentina, trademark law prevailed over a geographical name that could be in collision with a GI if the trademark was endowed with other elements that contributed to forming a sign not considered deceptive. This trend is slowly reversing as the GI institute becomes more relevant. In cases where the registration of trademarks composed of foreign geographical names was challenged, the rulings of the Argentine courts—long before the adoption of the special laws—were in favour of the registration of the trademark.<sup>46</sup>

For its part, the Argentine Food Code<sup>47</sup> as amended, in its provisions for food labelling and advertising, establishes that names that may mislead or do not provide truthful information may not be used. However, it stipulates that the names of a geographical place other than the place of production may be used if the expression 'type' is indicated, except for wines and spirits with these characteristics. This exception is in line with TRIPS Agreement Article 23.<sup>48</sup>

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<sup>45</sup> Approved by Argentina through Law 17011/1966. Law 22195/1980 approved the Act adopted in Stockholm (except for Sections 1 to 12, which are governed by the Lisbon Act).

<sup>46</sup> *Société Pommery Greno and others v S.A. Vitivinícola y Comercial Gutiérrez y de la Fuente* [1960] CSJN La Ley online citation 70025858. In this case, in which the validity of the trademark *Mont Reims* for alcoholic beverages was discussed, the Argentine Supreme Court ruled that *Mont Reims* was not a term that had become generally used and that could be misleading over the products' true origin. In particular, the Court held that the inclusion of the term *Industria Argentina* (Made in Argentina) cleared up any confusion.

*Cycles Motor v IKA* [1970] CCCF Chamber II. Ten years after the previous case, the claim seeking a declaration of invalidity of the trademark *Torino* for automobiles was dismissed. Chamber II of the Federal Civil and Commercial Court held that there was no 'characterising coincidence' between automobiles and the Italian town Torino. It also held that the term *Torino* had not become generally used.

*Stabilisierungsfond Für Wein v Bodegas Esmeralda S.A.* [1986] CSJN La Ley online citation AR/JUR/2101/1986. In this case, the registration of the trademark *Kiedrich* for wines was admitted on the grounds that the inclusion of *Industria Argentina* (Made in Argentina) dispelled any confusion about the product's origin.

<sup>47</sup> Argentina, Law 18284/1969 <[www.argentina.gob.ar/normativa/nacional/ley-18284-21841](http://www.argentina.gob.ar/normativa/nacional/ley-18284-21841)> accessed 28 December 2021.

<sup>48</sup> WTO (n 4) art 23 'Additional protection for geographical indications for wines and spirits', para 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

Likewise, the Trademark and Designations Law<sup>49</sup> establishes the prohibition of registering national or foreign DOs as trademarks and prevents the registration of those trademarks that may mislead over the nature, properties, merit, quality, processing techniques, function, price origin, or other characteristics of the products or services to be distinguished. According to the last amendment of the regulatory decree of the Trademark and Designations Law, the referred national or foreign DO includes the geographical indications expressly recognised by the Argentine Republic. As pointed out, the trend is reversing in connection with the prevalence of trademark law in recent years, and there are court decisions in which the GI law prevails over trademark law.<sup>50</sup>

Finally, the rule on Fair Commercial Practices<sup>51</sup> grants protection to DOs, and, therefore, GIs and indications of source, while excluding from protection those which have become the standard term of the product due to their use, which will be free to use. The rule defines unfair competition and includes in the exhaustive list of unfair competition acts the ‘undue exploitation of another’s reputation’, which describes as the performance of acts that take undue advantage of the image, credit, fame, prestige, or business or professional reputation of another person, inducing confusion of one’s own goods, services, activities, distinctive signs, or establishments with those of the other person.

Regarding specific DOs, a national or foreign DO may not be used to identify goods or services not coming from the respective zone, except when it is a DO of widespread use, which will be free to use (ie those which, due to their use, have become the name or type of the goods).

**Brazil** also has a *sui generis* system of protection. GIs are protected within the scope of the Industrial Property Law.<sup>52</sup> According

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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.

<sup>49</sup> Argentina (n 11) v; Argentina (n 12) as amended.

<sup>50</sup> *Peters Hnos. Cía. Com. E Ind. S.A. v Institut National des Appellations D’Origine (INAO)* [2010] CNCCF Chamber I. The National Court of Appeals in Federal Civil and Commercial Matters confirmed the judgement of the lower court and declared the opposition filed by the defendant to the application for a trademark consisting of a foreign DO to be well-founded.

*Establecimiento Humberto Canale S.A. v Munetta, Patricio* upon cease of use of trademarks and damages FGR 11000577/1999. On 9 September 2014, the Federal Court of Appeals of General Roca, Province of Río Negro, annulled the registration of the trademark *Patagonia* in international class 33, which had been originally registered on 12 September 1989 and subsequently renewed. The registration was annulled under Section 3.d of the Trademark Law.

<sup>51</sup> Argentina, Decree 274/2019

<[www.boletinoficial.gob.ar/detalleAviso/primera/205888/20190422](http://www.boletinoficial.gob.ar/detalleAviso/primera/205888/20190422)> accessed 28 December 2021.

<sup>52</sup> Brazil (n 22).

to this Law, the protected GIs differ between the indication of source (*indicação de procedência*) and the DO (*denominação de origem*). The indication of source consists of a geographical name of the country, city, region or locality of its territory, known as the center of extraction, production, or manufacture of certain product or rendering of certain service. The DO consists of a geographical name of the country, city, region or locality of its territory designating a product or service with qualities or characteristics exclusively or essentially resulting from the geographical environment, including natural and human factors. It is interesting to point out that, legally, there is no express requirement of notoriety for the protection of a distinctive sign as a designation of origin. Despite this, a decision of the High Court of Justice (STJ)<sup>53</sup> stated that notoriety is a general requirement to register GIs (although the law does not establish legal requirements for their protection), but did not explain the reasons for this conclusion. As a result, there is no certainty about the interpretation of the law on this point.

**Chile** also has a *sui generis* system of protection since it has established mechanisms particularly designed to protect GIs, ie creating special institutions different from those existing for trademarks, unfair competition, or consumer protection. The country established a register of GIs and DOs with a special procedure and particular actions for their defence. Thus, Chile's Industrial Property Law<sup>54</sup> reform created a special GI register administered by the National Institute of Industrial Property (INAPI). This *sui generis* system also incorporated, in the trademark system, collective marks and certification marks as special types of trademarks. However, it does not repeal and complements the existing protection systems under which the special laws and Ministry of Agriculture's administrative decrees, which recognise the DOs for *Pisco* and wines, are a source of law.

In addition to the GI and DO register, it should be noted that, in the case of Chile, the GIs recognised through free trade agreements are another source of recognition. This implies that foreign GIs protected through lists annexed to FTAs do not need to be included in the register to enjoy protection within the national territory; rather, the source of the right is the agreement itself.

In brief, since 2005 (as previously there were only DOs for wines and spirits), the distinctive signs of all types of products reporting a particular geographical origin and with quality and characteristics mainly resulted from their geographical origin, can choose from a series of intellectual property tools to be protected in Chile, mechanisms that complement each other.

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<sup>53</sup> STJ – Resp 1237752.

<sup>54</sup> Chile, Law 19996/2005 <[www.bcn.cl/leychile/navegar?idNorma=236219](http://www.bcn.cl/leychile/navegar?idNorma=236219)> accessed 28 December 2021.

In addition, and to enforce their rights in the event of an alleged infringement, since 2007, GI holders may also take action under the Unfair Competition Law,<sup>55</sup> even if the GIs have not been recognised in the INAPI register or in the Ministry of Agriculture's administrative decrees.

As for **Colombia**, it can be said that it has a *sui generis* system of protection of geographical indications and a trademark system, as it has a certification and collective mark system that may consist of geographical names. The legal provisions on the *sui generis* system and the registration system for product/service trademarks and certification and collective marks are contained in the Andean Community Decision 486 of 2000. The *sui generis* system comprises DOs and indications of source.<sup>56</sup> The application of one or the other system is optional, ie there is no exclusion, it is enough to make the typical adaptation to apply for protection under one system or the other. However, it should be borne in mind that the *sui generis* system lays down, for DO protection, the obligation to demonstrate the causal link or connection between the quality or characteristic of the product, and the territory or the human factor. Therefore, it can be stated that a sign meeting all the DO conditions can also be applied for or protected as a certification mark or collective mark, but not vice versa.

One of the major differences lies in the application of provisions governing trademarks to the *sui generis* system or the certification mark system. The latter refers to the former when there is no express rule. Thus, while the entire registration procedure and, perhaps, several grounds for trademark refusal can be applied to certification and collective marks, the DO system contains its own catalog of limits to its protection. These limits include the existence of previous trademarks reproduced by the DO whose protection is sought.

As part of the Andean Community like Colombia, **Peru** also has the legal provisions on the *sui generis* system and the system of registration of product/service trademarks, and certification and collective marks contained in Decision 486. At the Community level, they are generically called GIs and include two modalities: DOs and indications of source. Peru has also established GIs as a constituent element of industrial property, pending regulation since 2018.

The system focuses on a right of exclusive use of the DO, and, as a consequence, protection against misuse by third parties that misleads the public over the product's geographical origin or constitutes an infringement of industrial property rights.

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<sup>55</sup> Chile, Law 20169/2007 <[www.bcn.cl/leychile/navegar?idNorma=258377](http://www.bcn.cl/leychile/navegar?idNorma=258377)> accessed 28 December 2021.

<sup>56</sup> Andean Community Commission (n 32) arts 201-223.

The right granted is a collective right whose ownership corresponds to the State. It may delegate certain powers to the organisation, made up of persons engaged in the production of the protected product, such as the Regulatory Councils. The protection applies only to the DO and not to the product or production method.

**Costa Rica** also has a *sui generis* system of protection for GIs. The provisions are contained in the Law of Trademarks and other distinctive signs,<sup>57</sup> including definitions for geographical indications and designations of origin. The Industrial Property Registry maintains a register of GIs and DOs.

**Mexico** also has a *sui generis* system for GI protection. The protection systems established in the Industrial Property Law cover GIs, certification mark, and DOs. National GIs protected as certification marks are assets of the Federation's public power. Current regulations<sup>58</sup> define the DO as the name of a geographical area, a term name containing such name, or another denomination known to refer to such area, which identifies a product as originating in it when the product's quality or characteristics are exclusively or essentially due to the geographical environment, including natural and human factors, and has given the product its reputation. A geographical area is understood to be the whole territory, or a region, locality, or place of a country.

As for DO protection and recognition in Mexico, the above Law establishes clear processes for the protection and recognition of both domestic and foreign designations of origin. Concerning the type of protection, it states that DO and GI protection begins with the declaration issued by the National Institute of Industrial Property.

The recognition of foreign DOs is subject to a differentiated procedure laid down in the Law by which the National Institute of Industrial Property will recognise the DO or GI protected abroad following the international treaties and the Law. The Institute will enter the foreign DO or GI in the register created for such purpose.

**Paraguay** also has a *sui generis* system. Its GI and DO legislation<sup>59</sup> is the guiding framework for this type of intellectual property. The law defines a DO as the name of a country, region, department, district, locality, or specific place which identifies a product as originating in any of them whose quality or characteristics are essentially or exclusively due to the geographical environment in

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<sup>57</sup> For alterations, see Costa Rica, Law 8632/2008  
<[www.pgrweb.go.cr/scij/Busqueda/Normativa/Normas/nrm\\_texto\\_completo.aspx?param1=NRTC&nValor1=1&nValor2=62950&nValor3=72128&strTipM=TC](http://www.pgrweb.go.cr/scij/Busqueda/Normativa/Normas/nrm_texto_completo.aspx?param1=NRTC&nValor1=1&nValor2=62950&nValor3=72128&strTipM=TC)>  
accessed 28 December 2021.

<sup>58</sup> Mexico (n 35).

<sup>59</sup> Paraguay, Law 4923/2013  
<[www.bacn.gov.py/archivos/1138/20141016083513.pdf](http://www.bacn.gov.py/archivos/1138/20141016083513.pdf)> accessed 28 December 2021.

which it is produced, including natural factors and those resulting from human activity.

In turn, the GI refers to the name of a country, region, department, district, locality, or a specific place to identify a product as originating in any of them, when a certain quality, reputation, or other characteristic is essentially attributable to its geographical origin. It is also interesting to note that the abovementioned law considers as DO or GI the traditional designations, whether geographical or not, that designate an agricultural or food product and meet the conditions.

**Uruguay** also has a *sui generis* system. Its Trademark Law<sup>60</sup> regulates indications of source, GIs and DOs, each with its own definition, and establishes that all three are protectable. It defines a GI as that which identifies a product or service as originating in a country, region, or locality, when a certain quality, reputation or other characteristic of the product or service is essentially attributable to its geographical origin. It also states that the indication of source is understood as the use of a geographical name on a product or service that identifies its place of extraction, production, manufacture, or rendering. These will be protected without the need for registration. The use of an indication of source does not preclude its use by other suppliers established in the place, provided it is a bona-fide use and does not generate confusion. A designation of origin is the geographical name of a country, city, region, or locality which designates a product or service with qualities or characteristics exclusively or essentially due to the geographical environment, including natural and human factors.

It creates the GI and DO registers in the National Directorate of Industrial Property, without prejudice to the Register of GIs and DOs of national wine producers in the National Institute of Vitiviniculture. The Law also establishes that the use of a GI, DO or indication of source is limited to producers and service providers established in the geographical location concerned. Granting GIs or DOs is the responsibility of the competent authority, which, in the case of national wine, is the National Institute of Vitiviniculture. For geographical indications and designations of origin, compliance with quality requirements will also be required.

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<sup>60</sup> Uruguay (n 41).

### 2.1.2. Scope and levels of protection, and products or activities with additional protection

After having determined that, in all the countries under study, the obligations established in the TRIPS Agreement were incorporated through a *sui generis* system, with its particularities in each case, the scope and levels of protection that the national systems in place provide for GIs/DOs will now be examined in more detail.

In **Argentina**, *sui generis* laws have adopted the TRIPS Agreement's differentiated standards of protection. The Law relating to agri-food products<sup>61</sup> provides the minimum standard of protection established by TRIPS Article 22 for the GIs of these products, ie it does not confer exclusive rights but does grant protection against unfair competition and consumer deception. The Law protects both GIs and DOs but, in no case, grants exclusive rights.

On the other hand, the Law for wine products and spirits of vinous origin<sup>62</sup> allows for additional protection, ie exclusive rights under TRIPS Article 23. It also recognises different levels of protection depending on the product's link with its geographical origin and the number of stages and requirements in the manufacturing process carried out in the same geographical location. The Law protects indications of source, GIs, and controlled designations of origin (CDOs). As to foreign GIs, the *sui generis* laws establish that they shall be protected as long as they are protected in their country of origin and, for their recognition, their holders must comply with the requirements, conditions, and procedures laid down.

The use of a GI is reserved exclusively for quality wines or spirits of vinous origin. The use of a CDO is reserved exclusively for superior quality wines of selected varieties or spirits of vinous origin produced in a qualitatively differentiated and determined region of the national territory, whose qualities or characteristics are exclusively or essentially due to the geographical origin, including natural and human factors. Both are protected by exclusive rights.

The use of the GI for agricultural products is intended for the product originating in the territory, country, or region associated with a certain quality or other characteristics of the product fundamentally attributable to its geographical origin. The agri-food product eligible for protection by a DO will be the product originating from a region, province, department, locality, area, or zone, of recognised typicity and originality, produced in a specific geographical environment, with qualities that give it a different character from other products of the same origin, even in similar ecological conditions and with similar

<sup>61</sup> Argentina, Law 25380/2000 (n 43) v, Law 25966/04 as amended.

<sup>62</sup> Argentina, Law 25163/1999

<<http://servicios.infoleg.gob.ar/infolegInternet/anexos/60000-64999/60510/norma.htm>> accessed 28 December 2021.

technologies, due to the influence of the natural environment and the work of man.

As for the GI/DO protection provided by the national systems in force, the regulations mentioned above do not cover other products or services. Regarding the scope of the term ‘agricultural’, the Law on agri-food products include agricultural, livestock and fishing products. Therefore, it covers plant and animal fibres (wool, cotton, hides), wood (up to its first processing), and ornamental plants, but not textile handicrafts and derivatives such as clothing.

Regarding the specificities of the scope of protection in each case, the Law on Wines and Beverages of Vinous Origin establishes that the indication of source protects the designation for table wines and regional wines. The GI protects the designation of quality wine or spirits of vinous origin, and the CDO protects the designation of superior quality wines of selected varieties or spirits of vinous origin whose production process, raw materials and bottling are carried out in the protected area. In the case of the GI for wines and spirits of vinous origin, the scope of protection grants exclusivity, as established in Article 23 of the TRIPS Agreement. It should be made clear that the protection by indication of source for table wines is no longer in effect and, therefore, the indication of source is reserved only for regional wines.

The Law on Agricultural Products distinguishes between GIs and DOs. Both are intended for agri-food products in their natural, packaged, or processed state. The GI identifies a product as originating in a country’s territory, region, or locality, when a certain quality or other characteristics of the product are essentially attributable to its geographical origin. Under this Law, the DO is a designation of special character that will be granted when the product originates from a region, province, department, locality, area or zone, of recognised typicity and originality that, produced in a specific geographical environment, develops qualities that give it a different character from other products of the same origin, even in similar ecological conditions and with similar technologies, due to the influence of the natural environment and the work of man. The scope of protection granted by law to GIs and DOs for agricultural products is not exclusive under TRIPS Article 22.

In **Brazil**, the general provisions on GIs are contained in the Industrial Property Law,<sup>63</sup> which does not distinguish between wine products and spirits and the rest of agricultural products. The Law assigns the right of use to holders generically, without determining the specific actions or the exceptions to producers’ and service providers’ exclusive right of use.

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<sup>63</sup> Brazil (n 22).



Brazilian law makes no difference concerning the scope of protection of GIs and DOs. The use of the GI is restricted to producers and service providers established in the defined area. In the case of DOs, these need to comply with quality requirements to exercise the right of use. The scope of protection is not explicit but is determined more specifically in the provisions on GI offences, under which the manufacture, import, export, sale, display or offer for sale, or storage of a product with a false geographical indication is an offence. As will be seen below, the use of modifying terms such as 'kind', 'type', 'style' without indicating the true origin of the product is an infringement. From this, it follows that third parties' use of modifying terms with the indication of the product's true origin is not an infringement. However, it is unclear whether this use, despite not being an infringement, still constitutes a civil violation of GI rights and may be subject to a prohibition of use or compensation. The high courts have not issued any rulings on this matter yet.

As for the GI/DO protection (additional/differentiated or not) provided by the national systems in place, pursuant to the Industrial Property Law, all products and services may be protected by geographical indications (indications of source or designations of origin), provided that the legal requirements for protection are met.

Brazilian law does not make any difference in terms of the scope of protection between the GI-protected products and services.

In **Chile**, as in other countries studied, the incorporation of TRIPS commitments into national legislation maintains the difference in the scope of GI and DO protection recognised for wines and spirits and that for other products, which may be artisanal products, from the sea and are not restricted to agricultural products in the narrow sense of the term. Thus, the Law<sup>64</sup> grants exclusive protection under Article 23 of the TRIPS Agreement in the case of GIs/DOs of wines and spirits. For other types of products, it provides for protection against unfair competition and consumer misleading under the terms established in TRIPS Article 22.

The differentiated level of protection mentioned above result into different procedures and requirements for recognition, since applications for DOs and GIs of agricultural, artisanal or industrial products must be accompanied by well-founded background information proving the link between the product, its quality/characteristic/reputation and its place of origin, a map delimiting the claimed area, and rules of use and control. These supporting documents must be provided by the applicants. Instead, DOs for wines and spirits are recognised ex officio by the agricultural authority, which is responsible for having the background information to justify its decision.

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<sup>64</sup> See Chile (n 26) s 93 on the specific protection in Law 18455/1984.

It should be noted that the different sources of law that grant protection imply specific issues:

- The actions available in the event of infringement, depending on the source or register in which they are recognised: Chilean wine DOs provide for administrative fines to be applied by the agricultural health authority (the Chilean Agricultural and Livestock Service), and DOs registered with INAPI include criminal and civil actions to be brought by their holders before the lower courts;
- Ex officio action by the authorities at the border: The DOs of *Pisco*, Chilean wines and spirits and those derived from free trade agreements are protected ex officio at the border by the Chilean Agricultural and Livestock Service. On the other hand, those recognised by another regulatory source need prior application for protection at the border by their holders, who must obtain a precautionary measure from the lower courts;
- Only DOs for wines and spirits are controlled ex officio by the agricultural authority in the national territory; GIs and DOs for other products must be controlled by their holders, who must bring an action before the lower courts in the event of infringement.

As for the GI/DO protection (additional/differentiated or not) provided by the national systems in place, in Chile, any type of product is protectable by these legal instruments. Thus, artisanal products, products from the sea and agri-food products have been recognised. Services cannot be protected by GIs or DOs.

The specificities of the scope of protection can be deduced from the actions available in case of infringement. Under the DOs of *Pisco* and Chilean wines, administrative fines are applied and border authorities take ex officio actions; on the other hand, DOs registered with the National Institute of Industrial Property (INAPI) provide for certain civil and criminal actions before the lower courts. This is a TRIPS Article 23 plus. Also, GIs derived from FTAs are protected ex officio at the border by the Chilean Agricultural and Livestock Service.

Only the *Pisco*, wine and spirits DOs are controlled ex officio by the agricultural authority in the national territory; GIs and DOs for other agricultural products must be controlled by their holders.

From this, it can be deduced that, while there is specific protection for wines and spirits of wine origin, other non-wine, agricultural products does not have ex officio protection at the border or in the domestic market, and, therefore, the standard of protection is consistent with TRIPS Article 22 to the extent that confusion in the consuming public is proven. Finally, it is impossible to register trademarks that may lead to confusion with respect to DOs. There is a mirror rule that

prevents DO registration when they conflict with previously registered trademarks.<sup>65</sup>

Since **Colombia** and **Peru** are governed by the same Andean Community rule,<sup>66</sup> they use the term ‘geographical indication’ as a genus, which includes DOs and indications of source in the *sui generis* system. There is no GI differentiation like the European one. The indication of source is free to use as long as the product’s true origin is indicated. The DOs can only be used by their beneficiaries and whose products comply with all the conditions established in the protection document.

For the differentiated standards of protection of TRIPS Articles 22 and 23, the Andean Decision incorporates both protection standards with a differentiation, albeit minimal. For DOs of agricultural and artisanal products, and wines and spirits, the Decision<sup>67</sup> establishes a first level of protection applicable to all, which consists of prohibiting use by unauthorised persons if such use causes confusion, even when accompanied by confusing terms such as ‘kind’, ‘type’, ‘style’, ‘imitation’, or the like. Thus, it protects all DOs (agricultural, artisanal, and wines and spirits) against unauthorised and misleading use, which can be interpreted as a TRIPS-plus clause, since it protects them against the use of expressions such as ‘kind’, ‘type’, ‘style’, ‘imitation’, and other similar expressions, if their use causes confusion. For its part, the Decision<sup>68</sup> establishes that the use of DOs related to natural, agricultural, artisanal, or industrial products originating in Member Countries is reserved exclusively for producers, manufacturers and artisans with their production or manufacturing establishments in the locality or region of the Member Country designated or evoked by the DO. Only producers, manufacturers, or artisans authorised to use a registered DO may use the expression ‘designation of origin’ together with it.

The Decision provisions setting forth the trademark-infringing conducts<sup>69</sup> apply to protected DOs. The rule does not refer to misleading or deception, or whether the product actually originates from the place indicated by the DO; it is enough that it causes confusion. Also, the rule includes as a possibility of infringement the use of expressions such as ‘kind’, ‘type’, ‘style’, and ‘imitation’, which is not considered in TRIPS Article 22 for agricultural or artisanal GIs/DOs. The Andean rule condenses in the concept of confusion all the possibilities provided for in Article 22.

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<sup>65</sup> Chile (n 29).

<sup>66</sup> Andean Community Commission (n 32).

<sup>67</sup> *ibid* s 214.

<sup>68</sup> *ibid* s 212.

<sup>69</sup> *ibid* ss 155-158.

Likewise, as mentioned above, there are specific protection specificities. There is a differentiation between DOs for agricultural and artisanal products and those for wines and spirits. The Andean Decision<sup>70</sup> establishes special protection for the latter and prohibits their use for products not originating in the place indicated by the DO, even when the product's true origin is indicated, or when the DO is used in translation or accompanied by expressions such as 'kind', 'style', 'type', 'imitation', or the like. The rule does not refer to confusion but to the prohibition to use these designations for products not originating from the place indicated by the DO (deception). In other words, the Andean Decision provides exclusive protection following Article 23 of the TRIPS Agreement, of which it is a literal copy. The only difference is that it uses DOs and GIs indistinctly.

Thus, the Decision provides mechanisms to prevent the use or registration as a trademark of a designation for wines and spirits, regardless of whether such use or intended registration as a trademark misleads the public or constitutes an act of unfair competition. It also prohibits the registration of trademarks that reproduce, imitate or contain a protected DO for the same or different products, when their use could pose a risk of confusion or association with the designation, or imply taking unfair advantage of its notoriety.<sup>71</sup>

Regarding the protected subject-matter, under the concept of DO, it is understood that recognition shall be granted only to those products whose characteristics are fundamentally or exclusively due to the geographical environment with its natural and human factors and whose production, processing, and preparation are carried out within the defined geographical area.

The following may not be declared as DOs: a) those that do not conform to the Andean Decision's definition of DO; b) those that are common or generic indications that distinguish the product in question, as considered by experts in the matter and the general public; c) those that are contrary to good customs or the public order; d) those that may mislead the public over the geographical origin, nature, mode of manufacture, or the quality, reputation or other characteristics of the respective products; (e) those that are likely to cause confusion with a trademark applied for registration in good faith, or previously registered in good faith; and f) those that constitute a total or partial reproduction, imitation, translation, transliteration or transcription of a third-party's well-known trademark, regardless of the goods or services to which the sign is applied, when its use is likely to cause a risk of confusion or association with the third party or with the third party's goods or services, an unfair exploitation of the trademark's reputation, or the dilution of its distinctive force or its commercial or advertising value.

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<sup>70</sup> *ibid* s 215.

<sup>71</sup> *ibid* s 135.j.

Finally, it should be noted that Peru is a party to the Lisbon Agreement since 16 May 2005.

Concerning the protection (additional/differentiated or not) provided by the national GI/DO systems in place, in Colombia and Peru, there is no limitation on the protectable products, meaning natural, agricultural, artisanal or industrial products. Agricultural products, agri-food products and non-agricultural artisanal products are protected by DOs. Services are not protected.

There is no standard differentiating the specificities. However, in the case of artisanal products, the common characteristics are not organoleptic but external or of other sensory senses such as texture.

Regarding the scope of protection, Decision 486 provides for the protection of non-wine products following Article 22, with a plus concerning terms such as 'kind', 'type', 'imitation', and other similar terms that cause confusion. For wines and spirits, it grants exclusive protection under Article 23 of the TRIPS Agreement.

**Costa Rica** also has a *sui generis* system of protection. It includes both GIs and DOs. Their definitions are contained in Law 7978/2000 on Trademarks and Other Distinctive Signs as amended, and revised by Law 8632 of 28 March 2008.<sup>72</sup> The Costa Rican Law does not establish different levels of protection for different types of products or services. The level of protection prevents unfair competition and consumer deception. Also, as Costa Rica is a party to the Lisbon Agreement since 30 July 1997, the protection granted to a DO registered under this Agreement is broad and prohibits any usurpation or imitation of the designation, even when the product's true origin is indicated or the designation is used in translation or accompanied by expressions such as 'kind', 'type', 'style', 'imitation', or the like.

The difference between DOs and GIs is that, in the former case, the characteristics must be linked exclusively to the geographical environment, while, in the case of GIs, the rule indicates 'fundamentally'. On a practical level, from the review of Costa Rica's registered DOs, it is concluded that the entire process must be developed in the particular geographical area. Protection in Costa Rica covers goods and services, agricultural and non-agricultural products.

In **Mexico**, GIs are assets of the Federation's public power and are recognised through a declaration of protection issued by the Mexican Institute of Industrial Property. They protect agri-food and manufactured products such as handicrafts and typical beverages. The Mexican *sui generis* system's scope of protection makes no difference between GIs, DOs and certification marks. The protection for these

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<sup>72</sup> For amendments to Law 7978/2000, see Costa Rica (n 57).

types of figures is the same in all cases and applies to all products. The legislation<sup>73</sup> establishes that the DO protection begins with the declaration issued by the Institute. Its illegal use will be punished, including cases where it is accompanied, as we will see below, by expressions such as ‘kind’, ‘type’, ‘style’, ‘imitation’, or the like, provided that they cause confusion in the consumer or imply unfair competition.

Mexico is also a party to the Lisbon Agreement since 25 September 1966. The definition of DO in its legislation is based on the definition established by the Lisbon Agreement. Therefore, as noted for Costa Rica, the content of the protection granted to a DO registered under the Agreement is broad and prohibits any usurpation or imitation of the designation, even when the product’s true origin is indicated or the designation is used in translation or accompanied by expressions such as ‘kind’, ‘type’, ‘style’, ‘imitation’, or the like. Consequently, it confers the right to prevent the marketing of spirits protected by the protected designations, ie the exclusive use and, therefore, the exclusive commercialisation of beverages such as DO-protected *Tequila* and *Mezcal*.

The protection (additional/differentiated or not) provided by the national systems in force in Mexico for GIs/DOs has no specificities by product or by type of protection. There is no difference whatsoever for GI protection as established in the legislation,<sup>74</sup> regardless of the product concerned. The GI applies only to products and, therefore, protects agricultural products, wines, spirits, food, and handicrafts. It does not protect services.

In its law incorporating TRIPS commitments, which was enacted in 2013,<sup>75</sup> **Paraguay** included the concept of GI and introduced the DO as a more specific type of GI. The law establishes the distinction between both and considers as GIs or DOs those traditional designations, geographical or otherwise, of agri-food products meeting the conditions.

Although there are two types of protection, both have the same scope. In other words, both GIs and DOs are intellectual property instruments that protect products linked to their geographical environment, though with different characteristics. In this sense, DOs are a specific type of GI. However, both offer their holders the same protection: exclusive use by the Regulatory Committee and those authorised by the Committee. In this regard, it can be said that the law does not distinguish between wines and spirits and other agricultural products, giving all GIs/DOs the greatest protection provided for in

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<sup>73</sup> Mexico (n 35).

<sup>74</sup> *ibid.*

<sup>75</sup> Paraguay (n 59).

Article 23 of the TRIPS Agreement. The law provides for two stages for the registration of GI/AO.

Considering the protection (additional/differentiated or not) provided for GIs/DOs by the national systems in place in Paraguay, GIs can protect all types of products, including food, beverages, agricultural products, and handicrafts. The law also makes no distinction between types of products. Therefore, the protection for wines and spirits is the same as the protection for artisanal or food products. Paraguay does not have differentiated protection for wines and spirits. The difference between GIs and DOs lies mainly in the fact that, in the latter case, all stages of production in the broad sense, including raw materials, occur in the same place of origin, which is not necessary in the former case. For GIs, only the most important stage of production needs to be linked to the place whose name is applied for.

In **Uruguay**, the level of protection between GIs for wines and spirits, and the rest of GIs for other agricultural products is consistent with TRIPS Articles 22 and 23. The differences based on these Articles remain in full force and effect as long as there is no specific legislation. Law 17011/1998 states that the civil and criminal actions set forth in trademark matters shall be applicable, as appropriate, 'to those who use designations of origin without any right'. For consistency, it has been understood that this reference also applies to geographical indications. Additionally, the legislation in force on consumer protection is fully applicable to this matter.

Concerning GI protection in Uruguay, the law makes no difference, covering both agricultural and other products, and services. The scope of protection between GIs for wines and spirits and GIs for other agricultural products is consistent with TRIPS Articles 22 and 23.

### 2.1.3. Crystallisation at the level of registration systems

This section focuses on the implementation of GI/DO protection through the national registration systems in place.

In **Argentina**, the protection system has national scope, and there are two national registers created by the *sui generis* system in force. The law<sup>76</sup> on the protection of wines and spirits establishes that they shall enjoy right of exclusivity and legal protection in the use of the duly registered indications of source, GIs or CDOs and the right to use the acronyms, logos, tags, and labels authorised by the national authority, which is the Ministry of Agriculture, Livestock and Fisheries (MAGyP) through the National Institute of Vitiviniculture (INV). The law<sup>77</sup>

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<sup>76</sup> Argentina (n 62) s 35.

<sup>77</sup> Argentina, Law 25380/2000 (n 43) s 16.

relating to other agricultural products creates the Register of Indications of Source and Designations of Origin for agri-food products and confers the right to use the GI/DO and the exclusive right to use emblems, distinctive signs, acronyms, logos, tags, and labels authorised by MAGYP. This law has been regulated by Resolution 13/202.<sup>78</sup> The registers are of national scope and provide differentiated protection.

In **Brazil**, the legislation on GIs establishes that the National Institute of Industrial Property (INPI) sets the conditions for GI registration<sup>79</sup> whose scope extends nationwide.. The rule applies to the entire national territory without distinction. Some GI promotion measures such as financial and technical support may be offered at the departmental level, but the level of protection established by the Industrial Property Law is uniform throughout the country. This Law determines that protection extends to the graphic or figurative representation of the GI, and the geographical representation of the country, city, region or locality of its territory whose name is the GI. Brazilian legislation does not grant express additional protection to one or other product.

In **Chile**, the GI protection system also has national scope. The products are recognised by authorities whose decisions have national competence. Thus, DOs recognised by the agricultural authority and INAPI are applicable throughout the Chilean territory.

The national system provides additional protection for wines and spirits of vinous origin under Article 23 of the TRIPS Agreement. Indeed, from the perspective of registration and available actions, GIs and DOs of wines and spirits include the special standard of Article 23, and the law<sup>80</sup> grants exclusive rights to their holders and extends their protection in their translations and transliterations (when applicable), even when the so-called delocalisers are used and despite the fact that the true origin of the product is indicated.

In addition, the Chilean wine DOs<sup>81</sup> and the wine DOs recognised in the FTAs are protected both at the border and within the national territory by the agricultural authority, which controls their proper use with administrative sanctions when non-compliance is observed.

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<sup>78</sup> See in Argentina, Resolution 13/2021

<[www.boletinoficial.gob.ar/detalleAviso/primera/240071/20210126](http://www.boletinoficial.gob.ar/detalleAviso/primera/240071/20210126)> accessed 28 December 2021.

<sup>79</sup> Brazil (n 22) s 182.

<sup>80</sup> Chile (n 26) s 96ff.

<sup>81</sup> Chile, Decree 464/1995

<[www.bcn.cl/leychile/navegar?idNorma=13601&idParte=7149037&idVersion=>](http://www.bcn.cl/leychile/navegar?idNorma=13601&idParte=7149037&idVersion=>)> accessed 28 December 2021.



As can be seen, GI/AO in Chile have three sources of recognition: i. the GI and DO register administered by INAPI;<sup>82</sup> ii. the DOs recognised in the legislation<sup>83</sup> on the production, processing, and marketing of ethyl alcohol, alcoholic beverages, and vinegars, and their implementing regulations; and iii. those incorporated by virtue of the FTAs negotiated by Chile, including the FTA with Canada, and Annex V, Appendix II of the Association Agreement signed between Chile and the European Union on 18 November 2002, effective since 1 February 2003. In this way, a GI/DO is recognised through its incorporation in the register kept by INAPI after a favourable resolution or through the respective Supreme Decree, either of the Ministry of Foreign Affairs (for those incorporated by virtue of international treaties, including FTAs negotiated by Chile) or of the Ministry of Agriculture as promulgated and published in the Official Gazette (for Chilean wine DOs).

Since its inclusion in the register or the publication of its Supreme Decree, the GI/DO will be protected in Chile indefinitely, as long as it observes the law and its rules of use and control or, as the case may be, the Supreme Decree recognising it nationally remains in force. In the case of foreign GIs/DOs, their protection in Chile is conditional on the continuity of their protection in their country of origin.

In **Colombia** and **Peru**, the GI protection system is structured solely at the national level, and they apply only the Andean Intellectual Property Regime.<sup>84</sup> Additional protection is granted to wines and spirits of vinous origin, as provided for in Decision 486<sup>85</sup> following TRIPS Article 23. The rule only refers to DOs of spirits and wines. Member countries shall prohibit the use of a DO identifying wines or spirits for products not originating in the place designated by the DO, even when the product's true origin is indicated or the DO is used in translation or accompanied by expressions such as 'kind', 'type', 'style', 'imitation', or the like. The rule allows the use, not the registration, of third countries' GIs/DOs of wines and spirits if it has been continuous for at least 10 years prior to 15 April 1994.

The Colombian and Peruvian legal systems are structured as follows: a. Andean Community standards, supranational in nature; b. National rules complementing the Andean Community legislation, when allowed by the Andean standard by means of a Decree or single Circular (administrative instructions); c. Standards of the DO regulatory entity.

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<sup>82</sup> Chile (n 26).

<sup>83</sup> Chile, Law 18455/1985 <[www.bcn.cl/leychile/navegar?idNorma=29859](http://www.bcn.cl/leychile/navegar?idNorma=29859)> accessed 28 December 2021.

<sup>84</sup> Andean Community Commission (n 32).

<sup>85</sup> *ibid* s 215.

In both countries, there is a single GI/DO register with no distinction by type of product.

Regarding additional protection for wines and spirits of vinous origin, in Peru, the INDECOPI resolutions related to Champagne and Bourgogne show this broad and special coverage.<sup>86</sup>

The GI and DO protection system in **Costa Rica** is structured at the national level only. There is only one national rule, and a national register. There is no additional protection by type of product or service. The register is the same in all cases. The current law<sup>87</sup> establishes that the Industrial Property Register will keep records of DOs and GIs, and that only producers, manufacturers or artisans authorised to use a registered DO/GI commercially may use, together with it, the expression ‘designation of origin’ or ‘geographical indication’. The registration procedure is regulated by Executive Decree 33743-J-COMEX.

In **Mexico**, the GI protection system has national scope. There is no additional protection by type of product or service. The registration is the same in all cases and the responsibility of the Mexican Institute of Industrial Property. The Institute’s declaration of protection by a DO is made ex officio or at the request of anyone demonstrating a legal interest.

The GI protection system in **Paraguay** is structured at the national level, as the scope of the law<sup>88</sup> in force extends nationwide. Protection is not differentiated by product. There is only one register

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<sup>86</sup> Resolution of the National Institute for the Protection of Competition and Intellectual Property (INDECOPI) no 005063-2019/CSD declared the opposition filed by Comité Interprofessionnel du Vin de Champagne and Institut National de l’Origine et de la Qualité (INAO), of France, to be well-founded and, consequently, denied the registration of the trademark *Shampiña* and the logo, applied for by Richard Pariona De La Cruz, to distinguish alcoholic beverages, except beers, containing fruits (pineapple); fruit extracts with alcohol, in class 33 of the International Classification. The INDECOPI Trademark Office granted a special and extended protection to the DO *Champagne*, considering that the term *Shampiña* affects the protected DO due to its conformation and pronunciation, and, therefore, it cannot be granted as a trademark under the prohibition contained in Article 135(k) of Decision 486.

INDECOPI Resolution no 0597-2016/CSD declared the opposition of Instituto Nacional de l’Origine et de la Qualite (INAO) and Bureau Interprofessionnel des Vins de Bourgogne (BIVB) to be well-founded and resolved to refuse the application for registration of *Mi Borgoñita Tabernero* as a trademark in class 33. The Authority considered that the sign applied for consists of the denomination *Mi Borgoñita Tabernero*, in which it is warned that the term *Borgoñita* will be perceived by the consuming public as the diminutive of the denomination *Borgoña*, which is the Spanish reproduction of the DO *Bourgogne*. The sign applied for is subject to the prohibition of Article 135(k) of Decision 486, and the DO *Bourgogne* (*Borgoña*) is granted a wide and special protection.

<sup>87</sup> Costa Rica (n 33).

<sup>88</sup> Paraguay (n 59).

and it is administered by the National Directorate of Intellectual Property (DINAPI).

It is interesting to note that the law provides for two procedural stages, which grant different protection status according to the stage of the registration procedure. The first stage<sup>89</sup> establishes the recognition. It consists of the preliminary application for recognition of a GI/DO filed by producers carrying out their activities within the area corresponding to the future GI/DO. Then, the conditions under which the GI/DO will be recognised *ex officio* are set together with the procedure to be followed in such cases.

The second stage<sup>90</sup> is when the GI/DO registration actually takes place. The implementing authority, through the Register created for this purpose, records the GI/DO. The registration is valid for ten years and may be extended indefinitely for equal periods.

The GI/DO protection system in **Uruguay** is structured at the national level only. The Register, with national scope, is the same for all GIs/DOs. The law<sup>91</sup> in force created the Register of Designations of Origin at the National Directorate of Industrial Property, without prejudice to the National Institute of Vitiviniculture Register related to national producers' geographical indications and DOs for vitiviniculture products.

While the law does not specifically establish differentiated protection, since Articles 22 and 23 of the TRIPS Agreement are directly applicable, it can be interpreted that protection grants an exclusive right only in the case of wines and spirits.

#### **2.1.4. Rights conferred, ownership, and time limit**

This section studies who can be GI/DO protection right holders in the national systems in place, the rights that such protection confers, and their time limit.

In **Argentina**, the *sui generis* laws establish that the national State is the one who confers on users the right of GI/DO use. The law regulating GIs/DOs of wines and spirits<sup>92</sup> states that the following may apply for GI registration to the implementing authority: a) the implementing authority itself, b) grapegrowers or their representative organisations, c) the producers of wines and spirits of vinous origin, and d) the organisations in charge of promoting or protecting the interests of the persons involved in winemaking. As for CDOs, this law

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<sup>89</sup> *ibid* s 5.

<sup>90</sup> *ibid* s 16.

<sup>91</sup> Uruguay (n 41) s 76.

<sup>92</sup> Argentina (n 62) s 8.

establishes that grapegrowers and winemakers seeking CDO recognition must constitute a Promotion Council, which shall take the steps for CDO recognition and registration with the INV.

Regarding the rights conferred on the holder, the national State, through the INV, confers on users the right to use the geographical or production areas' names used for an indication of source, GI, or CDO. The wines and spirits of vinous origin covered by this law will enjoy: 1) the right of exclusivity and legal protection in the use of the indication of source, GI, or CDO duly registered; 2) the right to use the acronyms, logos, tags, and labels authorised by the law's implementing authority for their identification; 3) the certification of genuineness and guarantee of quality issued by the implementing authority.

The law regulating GIs/DOs of agri-food products<sup>93</sup> states that their recognition and registration may be applied for to the implementing authority by any natural or legal persons engaged in their extraction, production or manufacture in the area concerned, with a proven legitimate interest, ie: 1) natural or legal persons directly engaged in extracting, producing or manufacturing the product in the area concerned, and/or 2) manufacturer chambers or associations provided that they are statutorily authorised. Applications for registration must be filed by a group of producers constituted as a non-profit civil association. However, a single individual or legal entity may apply for registration if the individual or legal entity is the only producer in the area concerned or is the producer with a share of more than 30% in the product's total volume in the area concerned. Other producers in the area who produce under similar conditions to those specified in the respective registration may subsequently apply to join the GI to market their products.

Concerning DOs, the producers seeking recognition must previously constitute a Promotion Council for each DO. The national State through the implementing authority confers on GI/DO users a) the right to use the GI; b) the right to use the DO and the name identifying it, and the exclusive right to use emblems, signs, acronyms, logos, and tags; and c) the control and guarantee of quality specified in the DO registered by the competent authority. In the case of foreign GIs, the holder shall be whoever is the holder in the country of origin. The rights granted do not have a time limit, as long as the conditions under which they were granted are maintained.

According to current **Brazilian** legislation,<sup>94</sup> producers and service providers established in Brazil are the holders of the right to use GIs. In the case of DOs, only those who meet the established quality requirements are entitled to use them. It is important to note that producers and service providers may use GIs even if they are not

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<sup>93</sup> Argentina, Law 25380/2000 (n 43).

<sup>94</sup> Brazil (n 22) s 182.

members of the association, group, or entity responsible for their registration and provided they meet the requirements. The entity authorised for registration acts merely as a procedural substitute for the right holders and, therefore, the effects of the registration are also valid for non-members. For this reason, even interested third parties have legitimacy to apply for a modification in the registration. Thus, not only the entity responsible for the registration may apply for a modification in the delimitation of the geographical area, but also an interested third party if the legal interest is proven and the product or service complies with the conditions justifying the GI recognition.

The general provisions on GIs grant the right of use to their holders in a generic way, without determining specific actions or even exceptions to producers' and service providers' exclusive right of use. Regarding products, through the *a contrario sensu* interpretation of GI infringements, right holders have exclusivity for the manufacture, export, sale, exhibition or offer for sale, and storage. Brazilian law does not establish a time limit for GI protection.

In **Chile**, any person representing a representative group of producers or the authority with competence in the territory from which the GI originates may apply for protection to INAPI. The law<sup>95</sup> establishes that the recognition of a GI/DO shall be made by the registration authority through the incorporation of the GI/DO in a GI/DO register. In this sense, any natural or legal person may apply for GI/DO registration, provided that the person represents a significant group of producers, manufacturers, or artisans, whatever their legal form, whose extraction, production, or processing establishments or premises are located within the delimitation zone established by the GI/DO applied for and comply with the other requirements in the law. National, regional, provincial, or communal authorities may also apply for GI/DO recognition when the GI/DO relate to the territories within their respective competence.

In the GIs recognised in FTAs and the Chilean wine DOs, it is detailed who are the GI/DO beneficiaries or the persons authorised to use them, without mentioning the holders. Regarding the rights conferred, their holders and producers may take action in case of infringements, and those with exclusive rights to use them must ensure that GIs/DOs are respected.<sup>96</sup>

Concerning the right of GI/DO use, the legislation establish that all producers, manufacturers or artisans carrying out their activity within the delimited geographical area, including those who were not among the initial applicants for recognition, shall be entitled to use the GI or DO related to the products specified in the Register, provided that

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<sup>95</sup> Chile, Law 19093/1991, s 94 <[www.bcn.cl/leychile/navegar?idNorma=30460](http://www.bcn.cl/leychile/navegar?idNorma=30460)> accessed 28 December 2021; Chile(n 54).

<sup>96</sup> Chile (n 95) s 104; Chile (n 54).

they comply with the provisions on GI/DO use. Only they may use the expression 'geographical indication' or 'designation of origin', or the initials 'GI' or 'DO', respectively, in the identification of the product. These expressions may be placed on the package, provided that it is one of those that are presented to the consumer sealed in such a way that it is necessary to destroy them to get the product.

The right has no time limit. Therefore, once recognised, GIs registered with INAPI are not subject to the payment of renewal or maintenance fees, whereas GIs recognised by the agricultural authority maintain their protection as long as the promulgating rule recognising them remains in force. Similarly, GIs recognised by FTAs will remain in force as long as the promulgating decrees such treaties are not repealed.

In **Colombia** and **Peru**, the right holder can only be the State. Under the Andean<sup>97</sup> regulations and as interpreted in both countries, the DO holder (owner) is the State. It is neither a private entity nor producers. The latter are the beneficiaries of the DO protection. However, the State can delegate the administration of the DO to producer associations or local authorities.

The declaration of DO protection is made ex officio or at the request of those with a proven legitimate interest, understood as natural or legal persons directly engaged in the extraction, production, or processing of the product(s) to be protected by the designation of origin, and producer associations. The state, departmental, provincial, or municipal authorities shall also be considered interested, when the DO relates to their respective districts.

Regarding the rights conferred on the beneficiaries, DO protection begins with the declaration issued by the national competent office. The use of DOs by unauthorised persons that creates confusion is considered an industrial property right infringement subject to punishment, including those cases where DOs are accompanied by expressions such as 'kind', 'type', 'style', 'imitation', and the like that cause consumer confusion. The national competent office may grant the corresponding use authorisations, which may also be granted by the public or private entities representing the DO beneficiaries as established by national rules.

Any person a) directly engaged in the extraction, production or processing of the products distinguished by a DO, b) carrying out any such activities within the delimited geographical area as specified in the declaration of protection, and c) complying with other requirements set by the national competent offices may apply for authorisation to use the protected DO.

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<sup>97</sup> Andean Commission Community (n 32).

Likewise, the Andean rules establish that the use of DOs for natural, agricultural, artisanal, or industrial products from member countries is reserved exclusively for producers, manufacturers and artisans with their production or manufacturing establishments in the member countries' locality or region designated or evoked by the DO. Only producers, manufacturers, or artisans authorised to use a registered DO may use the expression 'designation of origin' with it. The State's authority to grant the use authorisation may be delegated to public or private entities representing DO beneficiaries as provided for by national legislation.

The DO rights have no time limit, as long as the conditions that gave rise to the protection are maintained. However, the authorisation of DO use granted by the Association is time-limited. The 10-year term established for these authorisations can be extended.

In the case of Peru, the national rules state that the Peruvian State is the holder of the right<sup>98</sup> and expressly provide that the Peruvian State holds the Peruvian DOs and authorisations for their use will be granted.

In **Costa Rica**, the right may be held by a group of producers or a public institution. Under the existing legislation,<sup>99</sup> GIs are protected against direct or indirect commercial use of the denomination for the registered products or services or different products or services, to the extent that such use takes advantage of the GI/DO reputation, usurpation, imitation, or evocation, even if the true origin of the product or service is indicated, or if the GI/DO is translated or accompanied by an explanatory expression such as 'kind', 'type', 'style', 'imitation', or the like.

In addition, the GIs are protected against the use of any type of false or misleading indication concerning the source, origin, nature or essential characteristics of products or services equal to or of the same type as those designated by the GI/DO on the container or packaging, in advertising, or in documents relating to the products or services in question, and the use of packaging whose presentation may cause a risk of confusion or association with the protected GI/DO or take undue advantage of the reputation or prestige. Finally, GIs are protected against any other practice that may mislead consumers over the true origin of the product or service. The rights conferred are not time-limited.

Regarding who may be protection right holders,<sup>100</sup> **Mexico** adopted the criterion followed by the Colombian and Peruvian legislation. Protected GIs/DOs are national assets of the Federation's

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<sup>98</sup> Peru (n 37) s 88.

<sup>99</sup> Costa Rica (n 33) v; Costa Rica, 'Reglamento de Indicaciones Geográficas'.

<sup>100</sup> Mexico (n 35) s 268.

public power and may only be used with the authorisation of the Mexican Institute of Industrial Property.

The Institute is responsible for protecting and defending designations of origin and geographical indications. These powers may be delegated to a third party. In the case of foreign GIs,<sup>101</sup> the powers might be delegated to their holders in their country of origin, since the Institute recognises GIs/DOs protected abroad, under the international treaties and the legislation in force. For this purpose, it creates a register.

The declaration of DO protection may be made ex officio or at the request of any person with a proven legal interest, understood as the individual or legal entity directly engaged in the extraction, production, or processing of the product(s) to be protected by the designation of origin, the manufacturer or producer chambers or associations, and the agencies or entities of the federal government and the Federation's state governments.

The rights granted by the protection to the holder may be inferred from the infringements contained in the rule, including:<sup>102</sup>

- Using a denomination or indication identical or confusingly similar to a protected national or Institute-recognised foreign DO or GI to cover the same or similar products or services;
- Using the translation or transliteration of a protected national or Institute-recognised foreign DO or GI to cover the same or similar products or services;
- Producing, storing, transporting, distributing, or selling products identical or similar to those covered by a protected national or Institute-recognised foreign DO or GI, using any type of indication or element creating consumer confusion as to their origin or quality such as 'kind', 'type', 'style', 'imitation', 'produced in', 'manufactured in', or the like.

The declaration of GI/DO protection will remain valid for the duration of the conditions that gave rise to it. The rights conferred under GI/DO ownership by the Mexican government are not time-limited. However, there is a limit to the authorisation granted by the Institute to interested users, who may use a DO for a ten-year term following the date of the application submission to the Institute, renewable for equal periods. The authorisation of use may be cancelled for various reasons as established in the rule.

In **Paraguay**, under the legislation, it is the Regulatory Committee who may hold the right of use. The rights conferred on the holder are the rights to use and prevent third-party use, the right to use emblems, acronyms, logos, tags, and others referring to the

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<sup>101</sup> *ibid* ss 315-316.

<sup>102</sup> *ibid* s 386.



geographical indication or designation of origin, and the guarantee of quality specified in them. These rights have a time limit. They may be extended indefinitely for 10-year periods, provided that renewal is applied for properly and in due time.

In **Uruguay**, the current legislation does not distinguish who may be the right holder but specify that the use of a GI/DO or indication of source is limited to producers and service providers established in the geographic location concerned.<sup>103</sup>

The rights granted by a registered GI/DO or indication of source to its holder are not expressly determined. The rule states that ‘the registration of a geographical indication or designation of origin does not confer on its holder exclusive rights to those generic or descriptive terms comprising it and shall not prevent bona-fide use of such generic or descriptive terms by third parties’. Under the rules in force,<sup>104</sup> the rights granted are not time-limited.

### **2.1.5. Limits to the exclusivity of the GI right: trademarks, generics, plant varieties, homonyms**

This section focuses on the limits to the exclusivity of the GI/DO protection right in the national systems in force, considering that the countries studied have incorporated the TRIPS commitments into their national legislation since January 2000, having a trademark tradition and a pre-existing right to the legitimate use of generic terms, homonyms and plant varieties authorised by this Agreement.

Article 22.3 of the TRIPS Agreement establishes that a member shall refuse or invalidate the registration of a trademark containing or consisting of a geographical indication with respect to goods not originating in the territory indicated, if the use of the indication in the trademark is liable to misleading over the true place of origin. Additional protection is recognised for wines or spirits.

However, Article 24.5 provides for an exception to this registration prohibition or invalidity for a trademark formed by a GI when the trademark has been applied for or registered in good faith or when the rights to this trademark have been acquired in good faith: a) before the date of application of the TRIPS provisions, or b) before the geographical indication is protected in its country of origin. Likewise, Article 23.3 refers to homonymous terms, Article 24.4 deals with continued use, and Article 24.6 refers to the term customary in common language and to the customary name of a grape variety.

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<sup>103</sup> Uruguay, Law 17011 (n 41) s 77.

<sup>104</sup> Uruguay, Decree 34 (n 41) s 71.

In **Argentina**, under trademark law, geographical names are registrable as trademarks, as long as they are not GIs, indications misleading over the product's true origin, and in common use. However, this criterion has been modified as more protection has been granted to GIs. *Sui generis* laws prohibit the registration of GIs registered as trademarks. The registration of these marks must be prior to the enactment of the special laws, and they must be registered trademarks for the related products subject to protection under the *sui generis* laws. In turn, the *sui generis* laws provide that trademarks may not be registered if they consist of GIs recognised before the application for their registration as trademarks. Therefore, these laws tend to avoid the coexistence between trademarks and GIs.<sup>105</sup>

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<sup>105</sup> As mentioned above, two relevant GI-related rulings were issued based on *sui generis* rules. In *Com. e Ind. S.A. v Institut National des Appellations D'Origine (INAO)*, Chamber I of the National Court of Appeals in Federal Civil and Commercial Matters (CNCCF) confirmed, on 12 August 2010, the judgement of the lower court and declared the opposition filed by the INAO to the application for a trademark consisting of a foreign designation of origin to be well-founded. Peters Hnos. had applied for the registration of the trademark *Martinique* (label) in international class 33 in 2003. The company had acquired the mark *La Martinique* in 1975, and its last registration had expired on 22 September 1996 without being renewed. The new application was opposed by the INAO based on the registration of the DO *Martinique*, officially recognised in France on 5 November 1996.

Peters Hnos. admitted the existence of the registration of the French DO but considered it irrelevant as a basis for the opposition, since it had a constitutional property right over the de facto trademark *Martinique*, which it had used in good faith for decades. According to Peters Hnos., its de facto trademark deserved the protection provided by the National Constitution and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) insofar as this Agreement establishes the exceptions for the prohibition or invalidity of the registration of trademarks consisting of geographical indications (Article 24.5.a-b).

The Chamber considered that the legal framework applied to the conflict, assessed as a whole, did not favour the plaintiff and that the constitutional rights, which are not absolute, needed to be harmonised with the laws regulating their exercise. Therefore, it took into account the above prohibition provided for in the Trademark Law. In addition, it invoked Law 22802 on Fair Trade, which prohibited the use of a national or foreign DO unless it had been registered as a trademark before the Law became effective (1983). The Chamber also found that, since the trademark had not been renewed in due time, its owner had lost its rights under the attributive regime of the law. According to the Court, it was also necessary to take into account the new factual and legal circumstances, for example, the entry into force of the TRIPS Agreement (approved by Law 24425) and the registration of *Martinique* as a DO in France. The Court considered that the evidence produced was not sufficient to prove the use of the trademark, and, therefore, the general principle of the TRIPS Agreement concerning geographical indications for wines or spirits (Art 23.2) had to be applied. In view of the above, the Court held that, as the exceptional situation of the TRIPS (ie observing prior trademark use) had not been proven, Section 3(c) of the Trademark Law, which prohibits the registration of national or foreign DOs as trademarks, must be applied in the spirit of fair trade and good practices between traders and consumers.

Another interesting case is the *G Gorgonzola* trademark application. In *Consorzio per la tutela del formaggio Gorgonzola v USDEC* upon cease of opposition to trademark registration, the National Court in Federal Civil and Commercial Matters no 4 issued, on 2 March 2021, a judgement declaring the opposition filed by the USDEC to the

However, an issue that made overlapping GIs and trademarks possible was an INV rule<sup>106</sup> under which it prepared the basic list of geographical areas and production areas that, due to their aptitude for grape production, could claim access to a CDO or GI. These designated areas included geographical names previously registered as trademarks.<sup>107</sup> However, the list did not contain recognised GIs but areas that could obtain such recognition, which, in some cases, has been granted later and, in others, has not been granted yet.

Regarding the conflict between a trademark registered before or after the GI, specifically, the law relating to wines and spirits provides that registered trademarks identifying products of grape and wine origin may not be registered as indications of source, GIs or CDOs. For its part, the law related to agri-food products provides that trademarks in force registered in good faith or where the rights to the trademark have been acquired through bona-fide use 1) before 1 January 2000 or 2) before the GI and/or DO was protected in the country of origin may not be registered as GIs and/or DOs. The legislation does not regulate GI and trademark coexistence unless there is express authorisation from the trademark holder.

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application for registration of the trademark *G Gorgonzola* in class 29 to be well-founded. On 2 December 2015, the plaintiff applied for the registration of the trademark *G Gorgonzola* (logo) to distinguish ‘meat, fish, poultry and game meat, meat extract; preserved, frozen, dried, and cooked fruits, vegetables, and legumes; jellies, jams, fruit sauces; eggs, milk and dairy products, except cheese; gorgonzola cheese, edible oils and fats’ in class 29. This application was opposed by the United States Dairy Export Council (USDEC), considering that the mark applied for is a DO and, as a denomination not registrable as a trademark, fell within the prohibition of Section 2 of the Trademark Law 22362. The Court rejected the claim, and the opposition filed by the USDEC was upheld. The judgement was appealed and is not final.

<sup>106</sup> Argentina, Resolution C. 23/1999

<[www.argentina.gob.ar/normativa/nacional/resolución-23-1999-61728/texto](http://www.argentina.gob.ar/normativa/nacional/resolución-23-1999-61728/texto)>  
accessed 28 December 2021.

<sup>107</sup> The INV has issued subsequent resolutions to prohibit the use of GIs registered as trademarks before their registration as GIs. An example is *Cafayate*, which was already registered as a trademark by the time it was recognised as a GI. First, the INV recognised the GI *Cafayate*. Then, its Resolution 8/2005 established that only the expression *Valle de Cafayate* would be authorised for use and protection as a GI and prohibited the use of *Cafayate* as long as the registered trademark was in force.

As for generic terms, the Argentine Food Code (CAA) includes numerous foreign designations of origin that are generic terms defining foods.<sup>108</sup> The rules referred to wines and spirits<sup>109</sup> state that generic names of goods, understood as those names that, due to their use, have become the common name of the goods by which the general public identifies them in the country of origin, may not be registered as indications of source, GIs, or CDOs. The rule related to agri-food products<sup>110</sup> establishes that the generic names of agri-food products may not be registered as GIs and/or DOs.

Concerning the overlap of rights between trademarks and GIs, **Brazilian** law<sup>111</sup> provides that a GI, its imitation or a sign that may falsely induce a GI may not be registered as a trademark. This is the only provision that deals with the relationship between the two systems of protection and considers the application and registration of trademarks after a specific GI. However, it should be noted that GI registration in Brazil is purely declaratory in nature, and, therefore, the INPI or the competent courts may consider, for analysing registrability, unregistered GIs that meet the requirements of a GI or DO.

If the INPI registers as a trademark a GI or its imitation that may cause confusion, the competent court may declare the registration null and void. The general GI provisions do not regulate the overlap of trademark and GI rights expressly. The geographical name that does not constitute an indication of source or DO may be a characteristic element of a trademark for a product or service, as long as it does not indicate a false origin. Therefore, it is not an overlapping rule but an express permission for the registration and use of geographical names as trademarks when they do not constitute GIs or false indications of origin. In the high courts, there is no case law on the conflict between a GI and an earlier trademark that comprises a GI or imitates it in a way that causes confusion.

Regarding the conflict between a GI and the later trademark (applied for registration or already registered), it is noteworthy that the few cases decided<sup>112</sup> do not refer to registered DOs or indications of

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<sup>108</sup> Dairy foods: cheeses *Petit Suisse, Neufchatel, Fontainebleau, Mascarpone, Mozzarella, Danbo, Pategrás, Gouda, Cheddar, Fynbo, Prato, Tybo, Camembert, Cuartirolo, Brie, Limburgo, Gruyere, Emmenthal, Tilsit, Romadur, Fontina, Colonia, Cacciocavallo, Parmesano, Reggiano, Reggianito, Sbrinz, Romano, Sardo, Provolone.*

Alcoholic beverages: *Aquavit, Ginebra, Gin, London Dry Gin, Corn (Korn), Steinhaeger, Arrak, Vodka, Tiquira, Tequila, Caña, Aguardiente or Brandy, Kirsch, Cherry Brandy, Calvados, Questch, Jurubeba, Cachaca, Caninha, Ron-Rhum-Rum, Pisco, Grapa-Grappa or Bacjaceira, Pastis, Coñac or Cognac.*

<sup>109</sup> Argentina (n 62) s 32.

<sup>110</sup> Argentina, Law 25380/2000 (n 43) s 25.

<sup>111</sup> Brazil (n 22) s 124 sub-s IX.

<sup>112</sup> The High Court of Justice (STJ) decided that the designation *Bordeaux* for food and buffet services, which includes offering wine to customers, is unregistrable as a

source, so it is somewhat difficult to determine whether it is a conflict involving a de facto GI (unregistered) or a mere false GI.

There is no special provision on the coexistence or conflict between a GI and an earlier or later trademark. Nor is there a legal provision or case law of the high courts addressing the overlap between GIs and other rights (varietal, homonyms, company names). The few related decisions generally consider the guarantee of the consumer's interest in the argument on the possibility or impossibility of registering trademarks that include an indication of origin or false indication of origin,<sup>113</sup> but does not oppose the rights granted by the GIs themselves.

As for generic terms, when the geographical name has been commonly used to designate a product or service, it will not be considered a GI. Regarding whether GIs can become generic names, although there is no case law or express legal provision on the subject, the legislation<sup>114</sup> establishes that 'when the geographical name has been commonly used to designate a product or service, it will not be considered a GI', which allows to understand that this possibility exists, mainly in view of the fact that the registration is merely of a declaratory nature. To date, no administrative authority or competent court has recognised a GI as generic.

Special mention should be made of Law 7678/1988, the Wine Act. The rule excludes the terms 'champagna', 'cognac' and 'brandy' in product labelling from the prohibition of geographical designations or technical indications not corresponding to the true origin and meaning of the expressions used on the labels of wines or derivatives, since they are commonly used throughout the national territory.

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trademark since the French region of Bordeaux is known for its wines, which could cause confusion as to the product's origin and constitute unfair competition due to possible free-riding (REsp 1165655 - Sole-Member Decision).

The Federal Regional Court of the 2nd Region (TRF-2), the second-instance body responsible for judging appeals against INPI's decisions on registration, ruled that a trademark containing the term *Paris* is unregistrable for cosmetics since the French capital is known for large perfume stores (Civil Appeal 0163710-42.2014.4.02.5101). Similarly, the term *Modena* is unregistrable for automobile services since the Italian city of Modena is known worldwide for the production of automobiles (Civil Appeal 0019709-86.1999.4.02.5101).

The term *Loch Ness* is also unregistrable as a trademark for services related to alcoholic beverages, as it is close to the term *Loch Ness* (Loch Ness), known as a tourist site in Scotland, a major producer of whisky (Civil Appeal 0021709-12.1994.4.02.0000).

However, the trademark *Viana do Castelo* is registrable for wines. Although the city of Viana do Castelo is in the well-known Vinho Verde region of Portugal, it does not have any notoriety or even its own wine production, excluding any impediment to registration (Civil Appeal 0007994-29.1996.4.02.0000).

<sup>113</sup> STJ: REsp 1165655, REsp 1092676. TRF-2: Civil Appeal 0539629-42.2006.4.02.5101, Civil Appeal 0007994-29.1996.4.02.0000).

<sup>114</sup> Brazil (n 22) s 180.

The recognition of this ‘current use throughout the national territory’ could indicate the generic nature of the terms. However, though still in force, the Law of 1988 predates the Industrial Property Law, and this rule only refers to product labelling but not to GIs per se. Perhaps, for this reason, this Law has not been an obstacle to the INPI’s registration of *Champagne* (GI 201102) and *Cognac* (GI 980001) as DOs, which are still valid today. It should also be noted that there are slight phonetic and written differences between these registered DOs and those considered in current use by the Wine Act, although the relevance of these small differences for attributing generic character to the terms is questionable. In any case, from the legal point of view, the role of the Wine Act in determining the generic character of the above-mentioned GIs is unclear.

Regarding the overlap of GIs with trademarks, the **Chilean** legislation<sup>115</sup> on trademark registration prohibitions seems to give the recognised GI preeminence, if the later trademark could lead to confusion. However, when the legislation<sup>116</sup> considers the possible coexistence of trademarks with GIs, it relativises the alleged preeminence of GIs over trademarks seemingly derived absolutely from reading the trademark registration prohibition. It expressly provides that, when the coexistence between trademarks and GIs or DOs, or of the latter among themselves, is considered possible under this Law or the international treaties ratified by Chile, the final decision will determine the conditions under which GIs, DOs or trademarks must be used to avoid consumer misleading or confusion.

It should also be noted that the *sui generis* system incorporated collective marks and certification marks as a special type of marks in the trademark system. However, it does not repeal and complements the existing protection systems, which recognises the DOs for *Pisco* and wines through special laws and administrative decrees of the Ministry of Agriculture.

In the case law, there are outstanding cases like GI *Turrón de Alicante*, DO *Aceite de Oliva del Valle del Huasco*, and DO *Chacolí*.<sup>117</sup>

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<sup>115</sup> Chile (n 26) s 20.j.

<sup>116</sup> *ibid* s 96bis.A.

<sup>117</sup> In the first case, the administrative authority determined ex officio the coexistence of the DO with the earlier trademark *Alicante* and established the conditions to avoid confusion in their use. On the other hand, in the case of the DO *Valle del Huasco*, the holder of the trademark *Huasco* filed an opposition to the registration, and the case was confirmed by the high court. Both cases can be consulted in the Chilean trademark database by entering in the application descriptor the number 938693 for *Alicante* and the number 1032192 for *Aceite de Oliva del Valle del Huasco*:

<https://ion.inapi.cl/Marca/BuscarMarca.aspx>. The lower court ruling in the *Huasco* case can be downloaded at <https://ion.inapi.cl/Pdf/Fallo.aspx?s=1032192>. In addition, the case of the DO *Chacolí* can be mentioned which has been used in Chile since colonial times and was repealed because of the recognition of *Xacoli* in Spain.

As a result of Chile's negotiation with the European Union (EU), several trademarks were cancelled, as coexistence with the EU-recognised GIs was not accepted. However, other trademarks similar to the European GIs were maintained, as in the case of *Concha y Toro*, which conflicts with the GI *Toro*.

There is no legislation regarding overlapping with other rights such as plant varieties, and company names, but there are rules on generics. This legislation prohibits the GI registration of common or generic terms that distinguish the product concerned, understood as those considered as such by those skilled in the art or the general public. It expressly excludes terms recognised as GIs or DOs under the international treaties ratified by Chile. As for homonymous expressions, it allows their coexistence when the authority considers that it is possible. In this case, the favourable resolution will set their conditions of use to avoid consumer misleading or confusion.

The possibility of protected GIs becoming generic<sup>118</sup> expressions is not considered. Concerning the Chilean genericity recognition of a name, the DO *Parmesano Reggiano* was recognised as a whole, but the segment *parmesano* was considered a generic expression.<sup>119</sup>

In **Colombia** and **Peru**, the relationship between GIs/DOs and trademarks is governed by the Andean Community rules,<sup>120</sup> which establish that DO protection cannot be recognised when the DO is likely to cause confusion with a trademark applied for or registered in good faith, or with a well-known trademark. Designations of origin do not prevail over trademarks. There is no coexistence of trademarks with

<sup>118</sup> However, the reform to the Chilean industrial property law, Law 21355 published on 5 July 2021 to become effective on 5 January 2022, contains the action of cancellation of a DO when it becomes generic.

<sup>119</sup> The INAPI Resolution that finally granted recognition in Chile states in its recitals: 6. That the designation of origin applied for consists of two terms: *Parmigiano* and *Reggiano*, and not of the term *Parmesan* in isolation, which is a generic term or commonly used in Chile to identify certain types of cheese used by different competitors in the market, according to the report of the Ministry of Agriculture. In fact, the report states that, at national level, several companies such as Colún, Soprole, Quillayes, La Vaquita (Lactalia Group), Lácteos del Maule, Los Tilos, Líder, have been found to label their products with the term *Parmesan*, a long-standing expression nationwide with significant volumes of sales, used to identify a type of hard cheese. 7. That adding *Reggiano* to the element *Parmigiano* in the designation of origin applied for gives rise to an independent sign with its own physiognomy, which will allow the consuming public to differentiate and recognise the sign applied for in connection with the generic term *Parmesan*.

That, in view of the foregoing, the substantive observation notified is reconsidered since the DO *Parmigiano Reggiano* is not affected by the prohibition of recognition of Section 95.d of Law 19039.

<sup>120</sup> Andean Community Commission (n 32) art 202; Andean Community Commission, Decision 689/2008: Adjustment of Some Articles in Decision 486, art 1 <[www.comunidadandina.org/DocOficialesFiles/Gacetitas/Gace1646.pdf](http://www.comunidadandina.org/DocOficialesFiles/Gacetitas/Gace1646.pdf)> accessed 28 December 2021.

DOs, in case the latter apply for protection (administrative act) after the registration of trademarks (pre-existence of trademarks).

Well-known trademarks may prevail over DOs to the extent that it is demonstrated that, before the declaration of GI protection, the trademark was well known in the territory in which the protection is sought. Designations of origin as distinctive signs may also be considered as well-known distinctive signs. Trademarks contravening DOs or GIs may not be registered, either.<sup>121</sup>

In turn, the Andean legislation<sup>122</sup> establishes that the member countries, through their internal regulations, will be empowered to develop and deepen the provision making it impossible to declare the protection of a DO when it may cause confusion with a trademark applied for or registered in good faith, or with a well-known trademark. Colombia then stated at the national level<sup>123</sup> that, in addition to the events provided for in the Andean rule,<sup>124</sup> the protection of a DO may not be declared or recognised when it may cause confusion with a trademark applied for or registered in good faith, or with a well-known trademark.

The legislation governing DO protection in Peru is based on Article 23 of the TRIPS Agreement, which grants additional protection to GIs/DOs of wines and spirits. Thus, the law lays down mechanisms to prevent the use or registration as a trademark of a designation for wines and spirits, regardless of whether such use or intended registration as a trademark misleads the public or constitutes unfair competition.

Regarding the coexistence between GIs negotiated in FTAs and existing trademarks, the Treaty negotiated with Europe states that DO protection may be denied due to the existence of a registered trademark. This was included in the Andean rules<sup>125</sup> and the Colombian legislation.<sup>126</sup> In Colombia, there is no coexistence between trademarks and DOs, since it would be theoretically impossible except in the case of a second meaning. There is no national legislation or case law in Peru on the coexistence of trademarks. However, there are prejudicial interpretations of the Andean Court.

As for the commitments made by Colombia and Peru in the FTAs, the treaty negotiated with the United States of America (USA) provides that protection or recognition of a geographical indication shall be

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<sup>121</sup> Andean Community Commission (n 32) art 135.

<sup>122</sup> Andean Community Commission (n 120).

<sup>123</sup> Colombia, Decree 729/2012

<[www.suin-juriscol.gov.co/viewDocument.asp?ruta=Decretos/1154787](http://www.suin-juriscol.gov.co/viewDocument.asp?ruta=Decretos/1154787)> accessed 28 December 2021.

<sup>124</sup> Andean Community Commission (n 32) art 202.

<sup>125</sup> Andean Community Commission (n 120).

<sup>126</sup> Colombia (n 123).



denied if it may cause confusion with a trademark, subject-matter of a bona-fide application pending or registration, or confusion with an existing trademark.

Under the Treaty negotiated with the EU, trademarks conflicting with the Lists of GIs protected as from the entry into force of the FTA for identical or similar products will be refused or invalidated, provided that the application for trademark registration is filed after the date of the application for GI protection in its territory. It is also established that no Party shall protect a GI when, in the light of the reputation of a trademark or its character as a well-known trademark, protection may mislead consumers over the product's true identity.

Regarding the overlap of GIs with other rights, the Andean legislation,<sup>127</sup> though not directly referred to homonymy, state that Member Countries may not prevent the continued and similar use of another country's DO identifying wines or spirits in relation to products or services, by any of their nationals who have used the DO continuously for the same or related products or services in the territory of the respective Member Country for at least 10 years before 15 April 1994 or in good faith before this date.

Analysing the generic terms, the Andean rule<sup>128</sup> establishes that those common or generic indications to distinguish the product concerned, understood as those considered as such by both those skilled in the art and the general public, may not be declared as DOs.

Protected GIs shall not be considered common or generic to distinguish the product they designate, as long as such protection subsists in the country of origin. Protected national GIs may become generic, but foreign GIs protected by recognition may not. However, in Colombia and Peru, there are no GIs recognised as generic by the legislation, an administrative authority, or a competent court.

As for the overlap of rights between trademarks and GIs in **Costa Rica**, it is not possible to register a GI as a trademark,<sup>129</sup> except in those cases where trademarks may refer to geographical names that are sufficiently distinctive and their use does not cause confusion as to the product's origin, source, and qualities or characteristics.

There is no legislation concerning the overlap of rights with other rights, such as plant varieties, and company names. Concerning generic terms, the rules<sup>130</sup> provide that a GI or DO may be registered together with the generic name, but the protection does not extend to the generic

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<sup>127</sup> Andean Community Commission (n 32) art 215.

<sup>128</sup> *ibid* art 201.

<sup>129</sup> Costa Rica (n 33) s 7 sub-s 1.

<sup>130</sup> *ibid* s 75.

name or expression. Additionally,<sup>131</sup> the registration shall indicate if the protection is granted on all or part of the words and defines as generic name the denomination of a product or service when considered as such by those knowledgeable about the product or service and the general public in Costa Rica. Terms protected by GIs may not become generic. There are no GIs in the country that have been recognised as generic by the legislation, an administrative authority, or a competent court.

In **Mexico**, there is no specific provision regarding the overlap between trademark and GI rights, or regarding the conflict between GIs and other rights, such as plant varieties, homonyms, and others. However, there are provisions on GIs/DOs that indirectly establish certain parameters on the matter. A trademark or GI may not be protected if it is identical or confusingly similar to an application for trademark registration or commercial notice previously filed and pending, or to a trademark or commercial notice registered and in force, for the same or similar products or services. Neither may that constituting or containing the designation of a protected plant variety or animal breed.

In Mexico, the new law for the protection of industrial property contains provisions on generic names. It<sup>132</sup> establishes that the common or generic name of a product may be included as an element of a DO or GI. Notwithstanding the above, the common or generic name shall be considered, in all cases, free to use. It also<sup>133</sup> lays down that the technical, generic or commonly used name of the products to be protected, and the name which, in common parlance or in commercial practices, has become a usual or generic element of the products may not be protected as a DO or GI.

Likewise, the registration of a trademark shall be cancelled if its holder has caused or tolerated its transformation into a generic denomination of one or several products or services for which it was registered, in such a way that, in commercial circles and in general use by the public, the trademark has lost its distinctive character as a means of distinguishing the product or service to which it applies.

In **Paraguay**, rules concerning the overlap of rights between trademarks and GIs determine that both rights may not coexist as a trademark and a GI. As for trademarks registered before GIs, the current legislation establishes that GIs/DOs are not eligible for registration when they are current trademarks registered in good faith or when the trademark's rights have been acquired through bona-fide use before the GI and/or DO was protected in the country of origin. Subsequently, they may not be registered as trademarks. There is no related case law in

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<sup>131</sup> Costa Rica, Decree 33743/2007 COMEX-J s 13  
<<https://leap.unep.org/countries/cr/national-legislation/decreto-no-33743-comex-j-reglamento-de-las-disposiciones>> accessed 28 December 2021.

<sup>132</sup> Mexico (n 35) s 270.

<sup>133</sup> *ibid* s 271 sub-s II.

Paraguay, and no legislation provides for the coexistence between GIs and trademarks. Also, no legislation or case law refers to the overlap of GI rights and other rights such as plant varieties, and homonyms.

Regarding generic names, the Law on Geographical Indications and Designations of Origin<sup>134</sup> establishes that generic names of products, understood as those that, though referring to the products' place or region of production, due to their use, have become the products' common name with which the public in the Republic of Paraguay identifies them. Under the Paraguayan legislation, a protected GI may not become generic, and no GI has been declared as generic by the legislation, an administrative authority, or a competent court.

In **Uruguay**, the Trademark Law<sup>135</sup> provides that neither DOs nor GIs may be registered as trademarks, which, if applicable, will result in absolute nullity (the trademark registration may be annulled). There is no case law dealing with these issues in depth, and no specific legislation regulates the coexistence between GIs and trademarks.

Regarding the overlap between GI rights and other rights, although there is no specific provision, the Trademark Law lays down that 'any use of geographical indications constituting unfair competition or confusingly similar to others registered or in the process of registration is prohibited'.

As for generic terms, it establishes that 'the registration of a GI or DO does not confer on its holder exclusive rights to those generic or descriptive terms comprising it and shall not prevent bona-fide use of such generic or descriptive terms by third parties'.<sup>136</sup> There is no express provision on whether protected GIs can become generic terms, and no cases of recognition as generic were reported at the judicial or administrative level.

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<sup>134</sup> Paraguay (n 59) s 23.

<sup>135</sup> Uruguay (n 41).

<sup>136</sup> *ibid* s 77 sub-s 4.

### 2.1.6. Use of terms such as ‘similar’, ‘type’, and ‘kind’ on labels. Informational use of a protected GI

This section deals with the use of ‘similar’, ‘type’, and ‘kind’, and the possibility of using GIs/DOs for informational purposes. It should be noted that Article 23.1 of the TRIPS Agreement on wines and spirits provides greater protection than for other agricultural products, by preventing the use of these expressions on the labels of these products.<sup>137</sup>

In **Argentina**, the use of the terms ‘similar’, ‘type’, and ‘class’ on the label is prohibited by *sui generis* laws. The law regulating GIs/DOs of wines and spirits<sup>138</sup> establishes that the use of registered indications of source, GIs and CDOs is prohibited when there is usurpation, imitation, or evocation, even if the true origin is indicated, accompanied by qualifications such as ‘class’, ‘kind’, ‘type’, ‘style’, or the like, or their translation.

In turn, the law regulating agri-food products<sup>139</sup> states that the implementing authority may impose sanctions on natural or legal persons not under the legal system of GI protection, when it verifies the misuse of protected geographical names on labels or tags, or in commercial documentation, or product advertising, even if they are preceded by the terms ‘kind’, ‘type’, ‘style’, ‘imitation’, or a similar expression that may cause consumer confusion in relation to a GI or DO.

In the same sense as *sui generis* laws, the Argentine Food Code establishes that packaged foods shall not be described or presented with a label that uses words, signs, denominations, symbols, emblems, illustrations, or other graphic representations that may make such information false, incorrect, insufficient, or may mislead, confuse, or deceive the consumer about the food’s true nature, composition, origin, type, quality, quantity, shelf life, yield, or manner of use.

However, it provides that, when food is produced with technologies from different geographical locations to obtain food with sensory characteristics similar or close to those typical of certain recognised areas, the denomination of the food must include the expression ‘type’ with letters equally sized, prominent, and visible to those corresponding to the denomination approved under the current

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<sup>137</sup> ‘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’.

<sup>138</sup> Argentina (n 62) s 34.

<sup>139</sup> Argentina, Law 25380/2000 (n 43) s 43.

legislation in the country of consumption. This is because the GI/DO of non-wine agricultural products does not have exclusive protection (under Article 22 of the TRIPS Agreement). In any case, if this use could mislead the consumer over a product's true origin, such use would be punishable.

Finally, the rules expressly prohibit the use of the expression 'type' to designate wines and spirits with these characteristics because the protection of GIs for wines and spirits does grant exclusive rights under TRIPS Article 23.1, which prevents the use of expressions such as 'type', 'similar', 'kind', 'type', and 'style'.

The use of a protected GI for wines or spirits of vinous origin for informational purposes is not allowed without holding the right to use it, to avoid any misuse that could mislead or deceive the consumer. The use of GIs in the identification of wines and spirits of vinous origin requires explicit authorisation.

Likewise, the use of GIs/DOs of agri-food products is prohibited a) for agri-food products that do not originate from the geographical areas specified in the corresponding registration, and are of the same class; b) as a commercial designation of products similar to those registered as geographical indication or designation of origin to take advantage of their reputation; c) when it implies a false or misleading indication, trick, or deception related to the origin, source, nature or essential characteristics of products other than the original and protected ones; d) in case of any other practice that may mislead consumers over a product's true origin and/or differentiating qualities, implying unfair competition. The above prohibitions shall apply to geographical indications and/or designations of origin used on containers, labels, packaging, or in advertising, or documents related to the product concerned.<sup>140</sup>

In the case of **Brazil**,<sup>141</sup> terms such as 'class' and 'similar' do not constitute a criminal violation, provided that the product's true origin is indicated. However, it is not clear whether this use, though not a criminal violation, could serve as a basis for a civil remedy action, giving rise to a prohibition of use or compensation for the violation of rights to geographical indications. The high courts have not ruled on any case on this issue yet. There is no regulation distinction between different products or services in terms of modification.

No Brazilian legislation or high courts' case law specifically refers to whether the use of a GI for informational purposes is allowed without the holder's consent. However, considering that the use of rectifying terms by third parties with the indication of the product's true

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<sup>140</sup> *ibid.*

<sup>141</sup> Brazil (n 22) s 193.

origin is possible, other forms of use for informational purposes may be recognised.

The **Chilean** legislation does not allow expressions such as ‘similar’, ‘type’, and ‘class’ when they refer to GIs of wines and spirits. It is a regulation that refers not only to use on labels but also to other uses such as advertising, and commercial documentation.

The rules<sup>142</sup> establish that civil actions related to the right to use a registered GI or DO, and those aimed at preventing their illegal use shall be brought before the lower courts. In the case of registered GIs or DOs identifying wines and spirits, civil actions shall be brought when a GI or DO is used without holding the right to use it, or in translation, or when it is accompanied by terms such as ‘class’, ‘type’, ‘style’, ‘imitation’, or the like, and even when the product’s true origin is indicated.

The use of the GI/DO is allowed for informational purposes, even without the holder’s consent. The Unfair Competition Law 20169<sup>143</sup> allows the informational use of distinctive signs as long as they do not undermine its reputation in the market and the comparison of goods is truthful and demonstrable.

In the case of **Colombia** and **Peru**, the Andean legislation<sup>144</sup> establishes that Member Countries shall prohibit the use of a designation of origin identifying wines or spirits for wines or spirits not originating in the place designated by the designation of origin in question, even when the product’s true origin is indicated or the geographical indication is used in translation or accompanied by expressions such as ‘class’, ‘type’, ‘style’, ‘imitation’, or the like.

In Colombia, although reference is made to authorised uses, the rules provide that the indications of origin may not be understood as informational uses, since the origin has ceased to be information and has become a distinctive feature. The use of such indications by unauthorised persons that creates confusion shall be considered an infringement of IP rights, subject to punishment, including cases where they are accompanied by indications such as ‘kind’, ‘type’, ‘imitation’, and other similar indications that create consumer confusion. In Peru, the informational use of DOs is not authorised, either.

In **Costa Rica**, the legislation does not allow the use of an indication that may cause error or confusion about the geographical origin of products in advertising or commercial documentation related to the sale, exhibition or offer of the products or services, without making a distinction by type of product or service. The use of

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<sup>142</sup> Chile (n 26) s 104.

<sup>143</sup> See Chile (n 55) s 5.c and e for the interpretation in the opposite sense.

<sup>144</sup> Andean Community Commission (n 32) art 215.

expressions such as ‘class’, ‘type’, ‘style’, ‘imitation’, or the like is also not allowed in trademark registration.

In the case of GIs protected under the Central American Association Agreement with the EU (CAAEC), it is possible to use such references for terms used in good faith before the entry into force of the Agreement, ie 1 October 2013. A GI may only be used with the holder’s consent. Their use for informational purposes is not permitted.

The **Mexican** legislation<sup>145</sup> states that the illegal use of the protected designation of origin or geographical indication shall be punished, including cases in which it is accompanied by expressions such as ‘kind’, ‘type’, ‘style’, ‘imitation’, ‘produced in’, ‘manufactured in’, or other similar expressions that create consumer confusion or imply unfair competition. Its prohibition of use is reinforced<sup>146</sup> by the prohibition to produce, store, transport, distribute, or sell products identical or similar to those covered by a protected national or Institute-recognised foreign designation of origin or geographical indication, using any type of indication or element such as ‘kind’, ‘type’, ‘style’, ‘imitation’, ‘produced in’, ‘manufactured in’, or the like that creates consumer confusion about its origin or quality. Although Mexican law does not provide for the informational use of a protected GI, it depends on the specific case.

In **Paraguay**, the use of terms such as ‘similar’, ‘type’, or ‘kind’ is not allowed without distinguishing by type of product or service. The Paraguayan legislation does not provide for the use of a protected GI for informational purposes.

In **Uruguay**, there is no explicit provision on the use of terms such as ‘like’, ‘type’, and ‘kind’ on labels. Notwithstanding this, since the level of protection between the GIs of wines and spirits and the GIs of other agricultural products is consistent with TRIPS Articles 22 and 23, the Articles of the TRIPS Agreement are fully applicable in this respect, as well.

Regarding the informational use of a protected GI, in the case of wines, the national legislations<sup>147</sup> establishes that, when the label refers to a geographical indication, region of origin, or designation of origin, the product must have a certification issued by the competent control body or entity, proving the right to use the designation.

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<sup>145</sup> Mexico (n 35) s 304.

<sup>146</sup> *ibid* s 386 para XXXII.

<sup>147</sup> Uruguay, Decree 283/1993 s 15 <[www.impo.com.uy/bases/decretos/283-1993](http://www.impo.com.uy/bases/decretos/283-1993)> accessed 28 December 2021.

## 2.2. APPLICATION PROCESSES FOR GI PROTECTION

A relevant aspect of GI protection is the application process, generally present in the rules guaranteeing the protection of these intangibles. When protection does not automatically stem from international law or treaties, in general, it results from the registration of GIs. In countries where registration constitutes a right, the application process is an essential precondition for protection. Nevertheless, even in countries where registration has a purely declaratory effect, its effects can provide legal certainty and the ability to receive certain incentives necessary for the GI to achieve its objectives. This section makes a comparative analysis among the application processes for GI protection in the countries studied.

### 2.2.1. Application requirements, competent authority for the analysis, and certificate holders

All the countries in the study lay down rules for the formal registration of GIs. In **Argentina**, the registration process guarantees the protection of a GI by means of an administrative act issued by the implementing authority, MAGYP, through the corresponding bodies of the *sui generis* laws.

The law regulating the protection of GIs for wines and spirits establishes that, in addition to the possibility of ex officio recognition and registration of GIs by the implementing authority, grapegrowers or their representative organisations, producers of wines and spirits of vinous origin, and the organisations responsible for promoting or protecting the interests of persons involved in winemaking may apply for recognition. This law stipulates that those seeking recognition of a CDO shall constitute a Promotion Council, in charge of drawing up its draft internal regulations and carrying out the studies and technical reports for CDO recognition. Holders of foreign GIs may apply for recognition in Argentina if they comply with the legal requirements.

The system for agri-food products is voluntary and open. The law establishes that the determination and registration of GIs for these products may be applied for to the implementing authority by any natural or legal person engaged in the extraction, production, or manufacture of these products in the area concerned, with a proven legitimate interest.

Applications for registration must be made by a producer group, associated in fact or formally constituted as a non-profit civil association. However, a single individual or legal entity may apply for registration if the individual or legal entity is the only producer of the product to be protected by the GI in the area concerned or is the producer with a share of more than 30% in the total volume of



production. In both cases, the specifications must be replicable by other producers in the area, who may subsequently apply to join the GI to market their products.

It is important to note that *sui generis* laws refer to the process of GI recognition, registration, and protection. When the registration of a GI is applied for, the GI will be recognised and registered. Consequently, as stated by the legislation, a foreign GI protected in its country of origin may be registered. In this case, the holder may apply for recognition or registration<sup>148</sup> in Argentina, if the holder meets the legal requirements applicable to Argentine nationals and submits proof of registration in the country of origin.

The conditions are the same for DOs. The difference is that the interested parties may previously constitute a Promotion Council, in charge of drawing up the DO's draft internal regulations and dealing with the corresponding studies and technical reports. These Councils are made up exclusively of natural and legal persons engaged in the extraction, production, conditioning, processing, or marketing of the products covered by the DO in the area concerned. The DO Councils will be legally organised in open non-profit civil associations.

The applicant for registration must comply with certain formal requirements to obtain protection,<sup>149</sup> including submitting the documentation of the producers applying for recognition of an indication of source or GI in triplicate. For a CDO, they must also submit information about the Promotion Council.

The law on wines and spirits stipulates which documentation shall be submitted depending on whether the application is for the registration of an indication of source, GI, or CDO. A list of vineyards and establishments located in the area according to the INV Register and a map of the indication of source applied for shall be provided in the case of an indication of source. For a CDO, the following<sup>150</sup> shall be submitted with the application for registration: a list of the vineyards and establishments located in the area concerned according to the INV Register; details of the reports, background information, and studies; draft internal regulations of the CDO requested.

For other agri-food products, Regulatory Decree 556/2009 as amended by MAGYP Resolution 13/2021 establishes the requirements that the applicant for the registration of a GI shall meet and the

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<sup>148</sup> The *sui generis* laws mention the terms 'recognition', 'adoption', 'protection', registration to refer to the stages of the process to obtain GI registration. There are no differences in the type of process or granting, except for those depending on whether GIs are foreign or local.

<sup>149</sup> In the Annexes to Regulatory Decree 57/2004 of the Wine Law, the requirements are established according to whether it is an indication of source, GI, or CDO.

<sup>150</sup> In Annex I.C of Regulatory Decree 57/2004.

application forms for recognition, registration, and protection of a GI or DO. The competent authority for the application analysis and the GI registration process for wines and spirits of vinous origin is the INV. This registration procedure consists of the following steps: submission of the application with the appropriate documentation, and payment of the fee.<sup>151</sup>

As for the GI registration process for agri-food products, the Secretariat of Food, Bioeconomy and Regional Development under the Ministry of Agriculture, Livestock and Fisheries established<sup>152</sup> that the Directorate of Value Addition and Quality Management of the Secretariat shall oversee the Register of Geographical Indications and Designations of Origin of Agri Agri-Food Products. The rules lay down the functions to be performed by the agency in relation to the Register and approves the application forms for the recognition, registration, and protection of DOs and GIs, and the Resolution approves an ‘Application Guide’, the ‘Model Provincial Guarantee’, and the ‘Glossary of Terms’ to agree on an unambiguous interpretation of the scope of the requirements and matters to be met.

The process of registering a GI or DO of an agri-food product begins with the submission of the Application for Diagnosis to the competent authority.<sup>153</sup> Once it is approved, the documentation must be submitted according to the Registration Form. This procedure includes

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<sup>151</sup> In addition, Section 10 of Law 25163/1999 establishes that, if the initial filing requirements are fulfilled, the implementing authority shall publish the notice with the application for one day in the Official Gazette and in a newspaper of wide circulation in the geographical area of origin, at the applicant’s expense. In turn, Section 12 states that, once the GI registration is granted, the resolution shall be published in the Official Gazette for one day, and the National Directorate of Industrial Property (currently, the INPI) and another national and/or international organisations as appropriate shall be notified.

As for CDOs, Section 23 provides that, ex officio or at the request of a party, if it is considered that a requirement has not been met, the applicant shall be notified to correct the irregularities within 15 days after notification. If the defects are corrected, the proceeding shall continue. Furthermore, Section 25 establishes that, if it is found that the filing requirements have been met, the implementing authority shall publish the notice with the application for one day in the Official Gazette and in a newspaper of wide circulation in the geographical area of origin, at the applicant’s expense. If there are no objections or if the objections that may arise are resolved, once the CDO registration is granted, the resolution shall be published in the Official Gazette for one day, and the INPI and another national and/or international organisation as appropriate shall be notified (following Section 28).

<sup>152</sup> Argentina (n 78).

<sup>153</sup> Section 1 of Resolution 13/2021 provides that the Directorate of Value Addition and Quality Management of the SECRETARIAT OF FOOD, BIOECONOMICS, AND REGIONAL DEVELOPMENT of the MINISTRY OF AGRICULTURE, LIVESTOCK, AND FISHERIES, or the one that replaces or substitutes it in the future, shall perform the functions of the Register of Indications of Source and Designations of Origin for Agri-Food Products referred to in Section 16 of Law 25380 as amended by Law 25966 and Section 16 of the Annex to Decree 555/2009 of 15 May 2009.

submitting documents pursuant to the rules,<sup>154</sup> evaluating the legal requirements, technical analysis of the GI/DO application, checking the existence of previous trademarks in force with the National Institute of Industrial Property (INPI), publication in the Official Gazette and local newspapers, pre-recognition verification audit, drawing up the file, forwarding the file to the National Advisory Commission, and, finally, submitting the file for recognition.

The registration process for GIs is also provided for in the **Brazilian** legislation.<sup>155</sup> The National Institute of Industrial Property (INPI) is responsible for processing and granting registration by issuing the registration certificate.

In Brazil, associations, institutes, and legal entities representing the community entitled to the exclusive use of the geographical name and established in its territory may apply for GI registration as attorneys in fact for the procedure. A single individual or legal entity may also apply for registration if the individual or legal entity is the sole producer or service provider entitled to the exclusive use of the geographical name. All persons may be represented by an agent, and a valid power of attorney must be submitted. In the case of a foreign applicant, the holder of the registration already recognised in the country of origin must apply for registration in Brazil. The foreign applicant must establish and maintain an attorney duly licensed and domiciled in Brazil, with powers to represent him administratively and judicially, including the power to receive notifications.

The requirements to be met by the applicant include the proof of legitimacy, through bylaws, minutes, personal documents of the legal representatives, and the statement that the producers or service providers and other operators are established in the area concerned. In addition, the following must be submitted to apply for the registration of indications of source and DOs:<sup>156</sup> the application form, the technical specifications (specification sheet), including the description of the control mechanism for the use of the GI, the power of attorney, if necessary, the proof of fee payment, the official instrument delimiting the geographical area concerned, and, if applicable, the graphic or figurative representation of the GI. The description of the process of product extraction, production, or manufacture or service provision, through which the geographical name became known, and the documents proving that the geographical name is known as such must also be submitted to apply for an indication of source. For a DO, the description of the product's or service's qualities or characteristics exclusively or essentially due to the geographical environment, including natural and human factors, and the process of obtaining the product or providing the service must also be submitted together with

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<sup>154</sup> Argentina, Law 25380/2000 (n 43).

<sup>155</sup> Brazil, Normative Instruction 95/2018; Brazil, Resolution PR 55/2013.

<sup>156</sup> Brazil, Normative Instruction 95/2018 (n 155) n s 7.

documents proving the influence of the geographical environment on the qualities or characteristics.

The INPI is the body responsible for analysing GI registration applications and reviewing and deciding administrative appeals filed against its decisions. The process to apply for GI registration in Brazil starts with the application. First, the INPI verifies whether the application complies with the formal requirements, and, if necessary, one or more requests are made to the applicant to complete the initial application. If the requests are not answered, the application is filed. If they are answered, the application is published for comments by third parties, and then the applicant may need to submit clarifications. In the next step, the merits of the application are examined, and a decision is taken on the registration of the GI. Appeals may be lodged against the decision. If no appeals are filed, the procedure ends. If appeals are filed, the arguments are analysed to decide whether to confirm or change the registration decision. It is also possible to make modifications after the registration has been granted.

In **Chile**, a registration process is necessary to guarantee the protection of a GI. The formal act by which protection is granted is the resolution issued by the National Institute of Industrial Property (INAPI) that provides a registration number. In addition, GIs and DOs recognised in FTAs are protected since the promulgation of the treaty by means of a decree, after being approved by the Congress.

Any natural or legal person and the local authorities of the area for which protection is claimed may apply for registration to INAPI. In this case, the applicant completes a standard form in which the person applying and his/her position, if an authority, must be identified. The applicant must describe the sign to be recognised, whose representation may be denominative, figurative or a combination of both, detail the product(s) for which recognition is sought and its(their) location in the Nice classification, name the author of the technical study supporting the product-sign-place of origin linkage, and accompany a map delimiting the geographical area claimed, and the rules of use and control to sustain the examination of merits. In the case of a foreign GI, the applicant must indicate if it has been recognised in any treaty in force with Chile, since, for those not covered by an FTA, the documentation proving the protection in their country of origin must be presented.

Finally, by application of the general rules of procedure, when acting through an agent or representative, the power of attorney authorising such intermediary to act on behalf of the holders before the registration authority must be attached. In the case of agricultural products, during the process and before the pronouncement on the existence of any registration impediment derived from the application of any legal prohibition, a report must be requested from the Ministry

of Agriculture. This report is binding. Therefore, if it is negative, INAPI must reject the application.

The process of GI registration application in Chile is subject to a procedure similar to that of trademark registration, with seven mandatory basic stages for agricultural products and six for other cases. If applicable, this is followed by publication in the Official Gazette, examination of the merits, possible opposition, final decision, payment of the final fee, and registration.

In **Colombia**, a registration process is also necessary to ensure the protection of a GI. The formal act by which protection is granted is the administrative act issued by the Industrial Property Office.

It is important to note that the so-called *de facto* protection exists in two scenarios. First, in relation to the unfair competition action, even without the DO protection granted. Second, through the denial of trademarks that describe the origin of the product or are misleading as to it. In the case of foreign GIs, there is also protection by preventing their registration as a trademark by a third party.

Anyone who has or proves to have a legitimate interest,<sup>157</sup> including producers, processors, their representative associations, national or territorial public entities, may apply for protection of the right through registration. However, the DO applicant must not be confused with the DO administrator. To administer a DO, one must have administrative and financial capacity, and impartiality in the procedures of authorisation and control of use.<sup>158</sup>

At the Andean Community level, the following must be submitted for the application: the personal details of the applicants and proof of their legitimate interest, the denomination sought to be protected and the product to which it refers, the delimitation of the geographical area, and the description of the qualities, reputation, or other essential characteristics of the product designated by the DO sought to be protected. In addition, the national regulation<sup>159</sup> requires the submission of various documents related to the applicant, including the bylaws of the applicant's legal entity and its main amendments, and any document demonstrating the legitimacy to represent the interests of the producer

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<sup>157</sup> To do so, the interested parties must demonstrate that they are directly engaged in the extraction, production, and processing of the product(s) to be covered by the designation of origin, under Article 203 of Decision 486/2000.

<sup>158</sup> Since it is a collective right, the holder is the Colombian State, headed by the SIC, but it may delegate the 'administration' of the designation of origin to public or private entities representing the persons engaged in the extraction, production, or processing of the products identified with the DO.

<sup>159</sup> The current legislation on distinctive signs is contained in Decision 486/2000 of the Andean Community Commission, a rule applicable to all its member countries. On this matter, the Decision has been implemented nationally in the Colombian Regulatory Decree 3081/2005, Resolution 57530/2012, and the Sole Circular with a user guide on how industrial property procedures should be carried out.

group. If the applicant is a state, departmental, or municipal authority, it must also submit, for demonstrating legitimate interest, various documents, including information on the existence of a producer association and the resource capacity of the GI to be used after registration. If the applicant is a natural or legal person different from a producer association and has a legitimate interest to apply for the declaration of DO protection, in addition to submitting the ordinary documents, the applicant must demonstrate that those involved in the production chain will use the GI. In any case, the delegation of the power to authorise the use may only be granted to entities with recognised legal status, regardless of their legal or associative form.

The Industrial Property Office of the Bureau of Industry and Trade is the competent authority that carries out the application analysis and the GI registration process. It may consult public entities or technical institutions with expertise in the product to verify that the product's qualities or the area are indeed those claimed in the application. The registration application process includes a formal examination stage. Afterwards, there is a deadline for opposition, a stage in which the authority may issue official letters or make technical verification visits and document them. Their reports will be considered in the merit examination stage.

In **Costa Rica**, a registration process is also necessary to ensure the protection of a GI. The formal acts by which protection is granted are a resolution issued by the Industrial Property Registry and a registration title.

The right to apply for protection is guaranteed to an authority, an entity grouping and representing the collective, a producer acting on behalf of the sector, or several producers, manufacturers, or artisans with their establishment in the geographical area to which the application corresponds, and provided that their activity is linked to the product or service identified with the GI or DO according to the specification sheet.<sup>160</sup>

The application for registration must include<sup>161</sup> the applicants' personal and contact information, the place where the establishment is located, and the GI or DO to be protected. Together with the application for registration, it is necessary to submit the applicants' legal status and the specification sheet<sup>162</sup> with information about the protected goods or

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<sup>160</sup> See Costa Rica, Regulation 33743/2007 of Law 7978/2000 s 4 <[www.registronacional.go.cr/propiedad\\_industrial/documentos/pi\\_normativa/decretos/reglamento\\_denominaciones\\_origen.pdf](http://www.registronacional.go.cr/propiedad_industrial/documentos/pi_normativa/decretos/reglamento_denominaciones_origen.pdf)> accessed 28 December 2021.

<sup>161</sup> See Costa Rica, Regulation 30223-J of Law 7978/2000 ss 3 and 76 <[www.registronacional.go.cr/propiedad\\_industrial/documentos/pi\\_normativa/decretos/Reglamento\\_a\\_la\\_Ley\\_de\\_marcas\\_y\\_otros\\_signos\\_distintivos\\_1.pdf](http://www.registronacional.go.cr/propiedad_industrial/documentos/pi_normativa/decretos/Reglamento_a_la_Ley_de_marcas_y_otros_signos_distintivos_1.pdf)> accessed 28 December 2021.

<sup>162</sup> See Costa Rica (n 160) s 6.a-e.

services, their special characteristics, the maps delimiting the area, the description of the production, processing or extraction processes, the applicable controls, the technical studies and analyses demonstrating the distinctiveness of the product, and the description of the traceability systems.<sup>163</sup>

The Industrial Property Registry is the competent authority that analyses the application and carries out the GI registration process.<sup>164</sup> The process consists of a formal examination, followed by a space for publication and oppositions, the substantive examination, and, finally, the registration. Once the formal examination period is over, a legal notice is published in the Official Gazette three consecutive times for third parties to file oppositions within two months after the first notice. If any, it is resolved first by the same body and then by the Administrative Registration Court. If the opposition is rejected, the procedure continues in the Industrial Property Registry.

During the process, the Industrial Property Registry may request the opinion of experts, who must deliver a technical report within three months. In the case of composite GIs, the resolution granting the registration will indicate which the generic term is, if any. In the case of foreign GIs, substantive studies are not necessary since the proof of registration in the country of origin is available.

In **Mexico**, the law<sup>165</sup> also establishes the GI registration process, whose protection is formalised with the publication of its declaration in the Official Gazette.<sup>166</sup> In the case of a GI, protection by registration may be applied for by individuals or legal entities, including chambers or associations, provided that any of these are directly involved in the production chain. Protection may also be applied for by agencies or entities of the Federal Government, and the Federation's state governments.

Regarding the documentation, in the case of national GIs, it is necessary to submit, together with the application for registration and the supporting documents: the applicant's personal and contact details and the legal nature, the detailed description of the product, its characteristics and production process, and the specification if the application is for a GI or DO. It must also indicate the official rules regulating the product, the general rules of production, and the delimited area in which the different stages of production take place, in the case of a GI. For DOs, the presentation must include a detailed indication of the links between the denomination, the product, the

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<sup>163</sup> *ibid* s 4; Costa Rica (n 161) ss 76(e) and 82bis.

<sup>164</sup> The different phases of the registration application process are regulated by Executive Decree 33743-J.COMEX and the Law 7478/2000 on Trademarks and Other Distinctive Signs.

<sup>165</sup> Mexico (n 35).

<sup>166</sup> *ibid* s 288.

territory, and the natural or human factors, the technical study, proof of fee payment, and any other document considered relevant.

In the case of foreign GIs, the Mexican Institute of Industrial Property (IMPI) recognises DOs or GIs protected abroad under international treaties and the law.<sup>167</sup>

The necessary documentation to accompany the application for the recognition of foreign GIs protected in the country of origin is the original holder, the applicant's name, nationality and domicile, proof of protection at origin, indication of the product that is the subject-matter of the application and the geographical area, translation into Spanish or transliteration into the modern international Latin alphabet of the protected DO or GI, and proof of fee payment.<sup>168</sup>

The IMPI Trademark Division is the competent authority for the application analysis and GI registration process in Mexico.<sup>169</sup> When the documents submitted meet the legal form requirements, the Institute will publish in the Official Gazette a summary of the main details of the application. If the IMPI grants the protection applied for, the declaration of protection will be published in the Official Gazette, including the information that identifies the GI or DO. If the IMPI denies protection, it will communicate it in writing to the applicant and the opponents, with the reasons and legal grounds for the decision. The procedure for analysing a foreign application is very similar, and, once protection is granted, the translation into Spanish or the transliteration into the modern international Latin alphabet of the protected DO or GI is also published.

In **Paraguay**, the protection granted by the law,<sup>170</sup> as mentioned previously, occurs in two stages. The first is the preliminary recognition. It is a protection for preventive purposes<sup>171</sup> only, and, therefore, in fact, it is only after registration that the protection becomes

<sup>167</sup> *ibid* ss 315-327.

<sup>168</sup> A designation or indication subject to any of the impediments referred to in the IPL (Section 168) shall not be entered in the register of designations of origin or geographical indications protected abroad.

<sup>169</sup> For the procedure for domestic GIs, see Mexico (n 35) ss 156-165bis.13.

<sup>170</sup> Paraguay (n 59).

<sup>171</sup> To understand the particularities of the Paraguayan procedure, see Section 3 of Decree 1286 regulating Law 4923/2013 on Geographical Indications and Designations of Origin:

8. Preliminary protection: that granted as from the preliminary recognition of a GI/DO, which implies protection against misuse of the GI/DO. 9. Recognition: declaration of the implementing authority under which a product is distinguished among others of the same class due to its characteristics and qualities, for the sole purpose of its preliminary protection. 10. Registration: act constituting the right of a GI/DO, issued by the implementing authority, which grants full legal effects from its resolution.

For more details, see Paraguay, Decree 1286/2019 <<https://py.vlex.com/vid/decreto-no-1286-reglamenta-768766301>> accessed 28 December 2021.



effective against third parties. The National Directorate of Intellectual Property (DINAPI) through its Directorate of Geographical Indications and Designations of Origin is the competent authority for the application analysis and GI registration process.

The Regulatory Committee, which administers<sup>172</sup> the GI or DO, is authorised to apply for the protection of the right through registration. It must comply with the formal requirements, including the submission of a technical study, a document with the product's name and description, labelling rules, and a description of the link of the product with the geographical environment or the geographical origin.

The registration application process has three distinct stages: the filing of the application, the correction of the application, and the publication of the registration.<sup>173</sup> In the first stage, the Regulatory Committee will submit the application for registration, and the formal requirements will be verified. If something is found inconsistent with the requirements, the applicant will be granted a term to correct it. Afterwards, the contents of the application will be published for one day in the Official Gazette and a newspaper of wide national circulation at the applicant's expense. If any of the requirements have not been met, the applicant will be notified and granted a term to correct the irregularities. If the applicant does not respond, the registration will be denied. If the defects are corrected, the process will continue. In the third stage, once the GI or DO registration is obtained, the resolution will be published in the Official Gazette and a newspaper of wide national circulation for one day and communicated to DINAPI and any other national and/or international organisation required.

The declaration of protection is the formal act by which protection is granted to a GI in **Peru**.<sup>174</sup> Natural or legal persons directly engaged in the extraction, production, or processing of the product(s) to be protected by the designation of origin, and producer associations may apply for protection of the right through registration. State, departmental, provincial, or municipal authorities shall also be considered interested, when DOs of their respective districts are involved.

The application for the declaration of DO protection must be made in writing to the competent national office, in addition to the formal data, the DO to which the application relates, the delimited geographical area, the products designated by the designation of origin, and providing a summary of the qualities, reputation or other essential characteristics of the products designated by the DO. Finally, it is necessary to submit documentation supporting the above requirements.

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<sup>172</sup> See Paraguay (n 59) s 18.

<sup>173</sup> *ibid* c IV.

<sup>174</sup> Peru (n 37) s 90. The declaration of DO protection shall be published only once in the Official Gazette.

The Directorate of Distinctive Signs of the National Institute for the Protection of Competition and Intellectual Property (INDECOPI) is the competent authority for the application analysis and GI registration procedure. Within 30 days from the admission of the application, compliance with the formal requirements is verified, followed by the formal examination procedure, if applicable.

As in other countries, the application for authorisation of use must contain and be accompanied by the personal data of the persons involved in the application, the power of attorney granting legal representation, and proof of fee payment. In addition, the DO the application must be accompanied by certification of the geographical delimitation by an authorised body and certification of the characteristics of the product and factors linking it to the protected geographical area. In some cases, certification of compliance with the corresponding Peruvian technical standard may be required.

The legislation specially considers those cases where the production and processing of the product to be distinguished with a DO do not take place in the same geographical area. In this case, the applicant must verify that both areas (raw material production and product processing) are authorised and included in the declaration of DO protection.<sup>175</sup>

In **Uruguay**, the Resolution of the National Directorate of Industrial Property grants the registration. The application for DO registration may be made by one or more producers, manufacturers, artisans, or service providers established in the region or locality to which the use of the DO corresponds, or at the request of a competent authority with a legitimate interest, established in the respective territory.

Foreign producers and the competent public authorities of foreign countries may apply to register a foreign DO they hold, following the international treaties signed by the Republic of Uruguay. The National Institute of Vitiviniculture (INAVI)<sup>176</sup> is competent in terms of GIs for domestic wines. In all other cases of GIs/DOs, the procedure takes place at the National Directorate of Industrial Property of the Ministry of Industry, Energy and Mining.

In addition to the application form, proof of production consistency issued by INAVI for domestic wines is required to apply for national DOs. For foreign DOs protected in their countries of origin,

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<sup>175</sup> Andean Community Commission (n 32); Peru (n 37); Peru, Law 28331/2004 <<https://docs.peru.justia.com/federales/leyes/28331-aug-13-2004.pdf>> accessed 28 December 2021.

<sup>176</sup> Uruguay, Law 17011/1998 (n 41) s 77.

this circumstance must be proved in the application form, without prejudice to the specific rules for the wine industry.

The registration application process in Uruguay<sup>177</sup> consists of filing the application and supporting documentation, form control, and the publication in the Industrial Property Bulletin only once, opening the opposition period. In case of opposition from third parties with a direct, personal, and legitimate interest or from the Institute itself for non-compliance with the legal requirements, the applicant will be notified for a period of thirty calendar days, peremptory and non-extendable, as provided for in the trademark rules. If there are elements requiring proof, the procedure will be opened for its processing within a term of sixty calendar days, peremptory and non-extendable. Once the evidence has been produced, the parties will be given notice for a period of 10 working days, peremptory and non-extendable, and then a final decision will be taken granting total or partial registration or denying it. The registration is published in the Industrial Property Bulletin.

### 2.2.2. Character of the administrative act with respect to the holder of the right

As effects, the registration of geographical indications in **Argentina, Chile, Colombia, Costa Rica, Paraguay, and Uruguay** constitutes rights. Instead, in **Brazil, Mexico, and Peru**, registration has only a declaratory effect.

### 2.2.3. Opposition process

The laws of all the countries under study provide for the process of third-party opposition to the application for registration. In **Argentina, Colombia, Costa Rica, Mexico, Paraguay, Peru, and Uruguay**, a legitimate interest is needed. In the case of **Brazil and Chile**, in theory, any person may file an opposition.

In **Argentina**, the law regulating GI protection for wines and spirits states that any natural or legal person with a legitimate interest may file an opposition against the registration applied for, if the person considers that the applicant has not met any of the established requirements. The opposition must be well-grounded and presented in writing within 30 days following the publication. The same applies to GI protection for food products in the case of a DO. Oppositions may refer either to the conditions of the DO or to a possible conflict with

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<sup>177</sup> Uruguay, Decree 34/1999 (n 41).

registered trademarks or if the relevant indication is identical to generic terms used to denominate goods or services in Argentina.<sup>178</sup>

Regarding the effects and processing of an opposition, the *sui generis* legislation establishes the rules: the applicant will have 30 days to answer, limit the scope of the application, or withdraw it. If the opposition is answered or if the term expires without a statement, in the case of a GI for wines and spirits, the National Council will forward the file to the implementing authority for its resolution. The rules also provide that the implementing authority may depart from the National Council's opinion for justified reasons to issue the corresponding resolution. Against the resolution of the implementing authority, a claim may be filed before the corresponding Federal Court for Contentious Administrative Matters under Section 27 of the Decree regulating the Wine Law. In the case of GIs for agri-food products, the National Register of Geographical Indications and Designations of Origin for Agri-Food Products will resolve the objection and end the administrative procedure.

In **Colombia**, oppositions must be filed by persons with a legitimate interest within 30 working days following the publication of the application for declaration or recognition. They can only be based on the grounds for DO refusal contained in the law.<sup>179</sup> Thus, it is possible to oppose when a DO for which protection is sought does not comply with the legal definition, is a generic indication, is contrary to good customs or public order, is misleading, or is the same or similar to a trademark applied for or registered by a third party. In **Peru**, opposition to the application for registration may be filed by third parties after the publication of the application in the Official Gazette. The process, in general, follows the same process as in Colombia since both countries are governed by the decisions of the Andean Community.

In **Costa Rica**, any person with a legitimate interest may file an opposition to the registration of a GI or DO.<sup>180</sup> The two-month period following the publication of the first notice is the longest of the terms established to file an opposition in the countries under study, together with the Mexican one. The opposition has suspensive effects since it is not possible to continue the process until the opposition is resolved at the administrative level.

In **Mexico**, the IMPI will grant a non-extendable two-month term from the date of publication in the Official Gazette for any third party with a justified interest to oppose to the application for a declaration of

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<sup>178</sup> Argentina, Decree 556/2009 (n 44) s 19.

<sup>179</sup> Andean Community Commission (n 32) art 202; Andean Community Commission (n 120).

<sup>180</sup> Pursuant to Costa Rica (n 131); Costa Rica (n 33).

protection, make observations or objections, and produce the evidence supporting the petition. In this case, all kinds of evidence will be admitted except for confessional and testimonial evidence, unless the testimony or confession is contained in a document, and those contrary to morals and law.<sup>181</sup>

The opposition must be filed in writing, accompanied by the respective evidence and proof of fee payment. The IMPI will notify the applicant of the oppositions received and grant a non-extendable two-month term from the effective date of the notification for the applicant to answer in writing as deemed appropriate in relation to the opposition, observations or objections filed and, if applicable, furnish evidence.

In **Paraguay**, in addition to the pre-payment of the fee, the opposition must contain the justification of legitimate interest and the opponent's claim that one of the legal requirements has not been duly met. The opposition must be filed in writing and well-grounded within 30 days from the date of publication. Considering that the opposition suspends the process, once the notice of the opposition has been answered, the applicant must make any corrections. If no correction is made or the notice is not answered, the application for registration will be rejected.

In **Uruguay**, any person with a direct, personal, and legitimate interest<sup>182</sup> may file an opposition to the application for registration within 30 calendar days from the day following the publication of the application in the Industrial Property Bulletin.<sup>183</sup> The opposition begins a contentious administrative proceeding with possible submission of evidence, if applicable, and ends with the granting or refusal of the registration.<sup>184</sup>

In **Brazil**, the legislation also provides for the process of third-party opposition to the registration application. The opposition must be filed within a maximum 60-day period from the publication of the application. However, there is no reference to the formal requirements, and only a form is available.

In **Chile**, the issue is treated more broadly, both regarding who may object and the time limit. Thus, any person may oppose a GI application published.<sup>185</sup> Procedural practice has determined that the opponent does not need to prove a direct interest in the matter. The filing must meet all the requirements applicable to a lawsuit in **Chile**, including that it must be formalised by an attorney licenced in the

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<sup>181</sup> Mexico (n 35) s 165bis. It is also possible to file an opposition to the application for GI registration.

<sup>182</sup> Uruguay, Law 17011/1998 (n 41) s 20 with reference to the trademark regime.

<sup>183</sup> *ibid* s 23 with reference to the trademark regime.

<sup>184</sup> For further details, see Section 69 of the Regulatory Decree.

<sup>185</sup> Chile (n 26) s 5.

country within forty-five days from the publication of the application in the Chilean Official Gazette.<sup>186</sup>

The opposition determines that the administrative procedure becomes a contentious proceeding, in which the INAPI acts as a lower court in a trial that follows the procedural rules of a civil summary proceeding and in which the case is generally received as evidence. All types of evidence are admitted except testimonial evidence, and the court assesses them according to the rules of sound criticism.<sup>187, 188</sup>

#### 2.2.4. Modification of the specification sheet

All the countries under study allow to make modifications to the specification sheet, ie to update the production rules.

In **Argentina**, the *sui generis* laws allow the modification of the specification sheet after protection has been granted, under certain assumptions. The legislation on wine GIs establishes the possibility of changing the rules of control of a GI to those of a CDO, provided that the GI has achieved notoriety in the domestic and/or foreign market, public recognition, and production occurs under strict quality control. As for agri-food products, the regulations establish that the DO Council may propose modifying the registration when the original conditions of any or all of the production factors have changed. This proposal must be approved and registered by the implementing authority. In addition, petitions may be submitted for new producers to be included in the area, provided that the differential qualities or typicity justifying the initial granting of the GI are respected.

In **Brazil**, the specification sheet may be modified twenty-four months after the date of registration. Such changes may relate to the geographical name, the delimitation of the geographical area, the rules of production, and the type of GI (indication of source or DO). In no case may they refer to the characteristic elements justifying the GI, under penalty of rejection of the modification request.

The possible changes and their timing are much broader in **Chile** and **Peru** than in Brazil. For example, in Chile, all kinds of amendments may be made to the specification sheet both during the registration process and once the GI has been registered. However, in the latter case,

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<sup>186</sup> For further details, see Section 254 of the Code of Civil Procedure. Also, it must be sponsored by an attorney licenced in Chile, under the last paragraph of Section 5 of Law 19039.

<sup>187</sup> Chile (n 26) s 16.

<sup>188</sup> In the case of GIs for wines and spirits, an opposition procedure is not explicitly included; however, in practice, Chile's agricultural authority has applied the general rules on transparency of the government agencies' acts.

amendments are subject to the registration procedure, where applicable.<sup>189</sup> In the case of minor formal changes such as a data update, a simple writing is sufficient, but, in the case of other significant formal modifications, they must be submitted to the procedure of marginal annotations in the record. Peruvian law establishes that the declaration of DO protection may be modified at any time when any of the elements of protection change. The modification will be subject to the procedure foreseen for the declaration of protection, as applicable.

In **Uruguay** and **Mexico**, although it is possible to modify the specifications submitted after protection has been granted, the applicable rules are not detailed. Thus, in **Uruguay**, information on the amendments that may be introduced and the legal conditions for their acceptance are not specified in the legislation in force. In **Mexico**, in the case of national GIs, the terms of the declaration of protection may be modified at any time ex officio or at the request of an interested party. An example is the case of the *Mezcal* DO<sup>190</sup> whose resolution to modify the General Declaration of Protection included other municipalities in the production area.<sup>191</sup> As in Brazil, in Mexico, the modification follows the same procedure foreseen for the declaration of protection.<sup>192</sup>

In **Colombia**, the specification sheet submitted after protection has been granted can be amended. In principle, it is possible to introduce any type of amendment<sup>193</sup> such as the geographical area, products, and qualities. However, the limit is in the prohibitions of protection contained in the law,<sup>194</sup> namely, deception, non-compliance with the definition, and genericity.

The Regulatory Council in **Costa Rica** and the Regulatory Committee in **Paraguay** are responsible for petitions to modify the specification sheet. In principle, the Registry may be requested to modify the specification sheet and rules of use. If the Registry considers that the changes may affect the essential characteristics and the form of production, it may request the preparation of a technical study. In Paraguay, after notification to all registered producers and those authorised to use the GI or DO, the modification of the Register may be

<sup>189</sup> According to Chile (n 26) s 100.

<sup>190</sup> See IMPI, ‘Conoce las modificaciones a la Declaración General de Protección a la Denominación de Origen “Mezcal”’ (2018) IMPI Blog <[www.gob.mx/impi/articulos/conoce-las-modificaciones-a-la-declaracion-general-de-proteccion-a-la-denominacion-de-origen-mezcal?idiom=es](http://www.gob.mx/impi/articulos/conoce-las-modificaciones-a-la-declaracion-general-de-proteccion-a-la-denominacion-de-origen-mezcal?idiom=es)> accessed 28 December 2021.

<sup>191</sup> For all cases of modifications, see IMPI, ‘Declaraciones Generales de Protección de Denominaciones de Origen’ (2020) Blog del IMPI <[www.gob.mx/impi/acciones-y-programas/declaraciones-generales-de-proteccion-de-denominaciones-de-origen](http://www.gob.mx/impi/acciones-y-programas/declaraciones-generales-de-proteccion-de-denominaciones-de-origen)> accessed 28 December 2021.

<sup>192</sup> Mexico (n 35) s 297.

<sup>193</sup> Related to Andean Community Commission (n 32) art 204.

<sup>194</sup> Andean Community Commission (n 32) art 203.

proposed when there have been changes in the original conditions, either in one or all the factors of production. This proposal must be approved, registered, and published by the implementing authority.<sup>195</sup> However, Paraguayan law also allows a user or any person justifying a legitimate interest to request a modification of the registration. In this case, the Regulatory Committee must be given notice to exercise its right of defence.

### 2.2.5. Remedies against denial of protection

If the application for registration is rejected and protection is consequently denied, it is possible to file remedies in any of the countries under study.

In **Argentina**, the appeal procedure against a denial is not expressly established in the *sui generis* laws. However, if the rejection is based on the special assumptions provided for in those laws, the decisions may be appealed directly before the courts. Otherwise, the National Law on Administrative Procedures (no 19549) is applied supplementarily. Under this Law, once the administrative remedy has been exhausted, a judicial appeal may be lodged.

Regarding the competent court, the wine GI rules provide for the possibility of bringing an appeal before the appropriate Federal Court for Contentious Administrative Matters against the resolution of an opposition filed in the CDO registration process. In addition, it establishes that the National Law on Administrative Procedures (no 19549), the Trademark Law, and the Law on Fair Trade (no 22802 as replaced by Emergency Decree 274/2019) will be supplementary rules of application.

The implementing authority has the power to summon the applicant to correct any irregularities in the application for CDO registration. If the applicant does not respond the notification within fifteen days or does not comply with the requirements, the registration will be denied. However, if the defects are corrected, the process will continue. The remedies before the Administration laid down in the National Law on Administrative Procedures should be applied supplementarily as appropriate. For agri-food products, this Law is applied in addition to the Regulations on Administrative Procedures,<sup>196</sup> if applicable.

In **Brazil**, it is possible to file administrative and judicial remedies. In the first case, the INPI is competent to resolve the remedy, and the decision that determines the final filing of the GI application

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<sup>195</sup> Paraguay (n 59) ss 28-29.

<sup>196</sup> For details, see the 1991 consolidated text of Decree 1752/72.



cannot be appealed. At the judicial level, the federal court is competent to hear the appeals against the INPI's final decisions as permitted by law. The term for bringing an appeal before the court is five years after the publication of the decision in the Industrial Property Journal (RPI, the INPI Official Gazette), and the ordinary procedure provided for in the Brazilian Code of Civil Procedure is followed. In industrial property matters, the judicial process does not depend on the exhaustion of the administrative remedies. The computation of the time limit for a judicial appeal begins at the same time as for the administrative remedy since they are autonomous proceedings.<sup>197</sup>

In **Chile**, there is a specialised administrative court empowered to review all INAPI decisions as a high court. Therefore, it is competent to hear appeals against INAPI's decisions on GI registration.

By reference of the GI rules to the trademark regulation, the appeal procedure for this type of distinctive signs is applicable to GIs. Thus, the applicant has fifteen days to appeal before the INAPI, which must forward the file to the Industrial Property Court. Lodging this appeal suspends the effects of the decision of the lower court.<sup>198</sup>

This collegiate body must hear any appeal against INAPI's decisions. According to the general rules in the Chilean Code of Civil Procedure,<sup>199</sup> the intervening party(ies) is(are) entitled to submit new information until the high court hears the case. To participate in the hearing, the intervening party(ies) only need(s) to notify in writing of such intention and, in any case, must be represented by an attorney. If the decision of the high court is considered contrary to law, it may be reviewed by the Supreme Court of Chile by means of an appeal for reversal on the merits. Finally, during the proceedings before the INAPI, the decisions of the registration authority may be subject to a motion for reconsideration, so that it may be reviewed by the same authority that made the decision. This motion can be filed within a five-day term from the date of notification of the resolution appealed.

In **Colombia**, if the application for registration is rejected and, consequently, the protection is denied, it is possible to bring a motion for reconsideration and an appeal proceeding before the same

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<sup>197</sup> On the subject, see, for example, Luiz Guilherme de A V. Loureiro, *A lei de propriedade industrial comentada* (Lejus 1999).

See also: High Court of Justice. Fourth class. Special Appeal (REsp) no 1284939 RJ 2011 / 0233137-4. Rapporteur Judge: Marco Buzzi. Published in the Electronic Journal of Justice (DJE) on 16 November 2017.

Federal Regional Court of the Second Region. Sixth Class. Appeal in writ of mandamus (AMS) n. 14751 96.02.01665-5. Rapporteur: 2nd Instance Judge Franca Neto. Judged on 4 June 2002. Published in the Electronic Journal of Justice (DJE) on 30 August 2002.

<sup>198</sup> See Chile (n 26) s 17bis.A-B.

<sup>199</sup> Law 19039 regulates the appeal, and the provisions of the Code of Civil Procedure apply supplementarily.

administrative entity and an invalidation action (Jurisdictional Control) before the State Council. In **Mexico**, the superior authority of the authority that issued the act, and the judicial and administrative courts through the constitutional remedy or nullity action are the competent bodies for these remedies.

In **Costa Rica**, it is also possible to file a remedy. In administrative proceedings, the same Registry and Administrative Registration Court that hears the remedy is competent to hear the appeal. In the judicial venue, the Civil Contentious Administrative Court of Finance has jurisdiction for these matters. The ordinary administrative remedies of revocation<sup>200</sup> and appeal<sup>201</sup> may be filed against the decision of the Registry. The former must be filed against the resolutions issued by the Registry within three business days and the latter against the Registry's final resolutions within five business days after their notification. The motion for revocation is heard by the Registry, while the appeal is heard by the Administrative Registration Court. This Court hears the appeals against the resolutions of the Registry. The latter is a body of maximum deconcentration, attached to the Ministry of Justice and Peace, with instrumental legal status. It hears appeals against the acts and final resolutions of the Registries that make up the National Registry and appeals against the remedies filed against these Registries' acts. Its resolutions are not subject to further appeal and exhaust the administrative proceeding.<sup>202</sup>

In **Paraguay**, a motion for reconsideration may be filed before the same authority, and contentious administrative actions may be brought before the Audit Court of the Judiciary. At the administrative level, the motion for reconsideration is filed within three days of the rejection resolution before the authority that issued it, and the provisions of the administrative legislation are applied supplementarily. In the judicial sphere, the decision will be notified to the applicant and the opponent, as the case may be, and a contentious administrative action may be brought before the Audit Court of the Judiciary within 18 days following the date of notification of the rejection resolution.

In **Peru**, the Intellectual Property Chamber of the INDECOPI Court is competent to hear appeals, which are regulated by a Legislative Decree.<sup>203</sup> These remedies include motions for reconsideration and appeals, and do not apply in cases of infringement actions. A motion for reconsideration may be filed against the resolutions issued by the competent Directorates within fifteen days following their notification. It must be accompanied by new evidence. Additionally, an appeal may

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<sup>200</sup> See Costa Rica (n 160) s 20 quarter; Costa Rica (n 161) s 64.

<sup>201</sup> See Costa Rica (n 161) s 65.

<sup>202</sup> See Sections 25 and 30 of the Law on Procedures for the Enforcement of Intellectual Property Rights (Law 8039).

<sup>203</sup> See Legislative Decree 1033 and Legislative Decree 1075.

be lodged only against the competent Directorates' resolutions that exhaust the proceeding, within fifteen days following their notification.<sup>204</sup> If the interested party chooses to resort to civil proceedings, the provisions in the special legislation shall apply.

In **Uruguay**, the resolution may be challenged by filing an administrative remedy.<sup>205</sup> In this case, a motion for revocation<sup>206</sup> may be filed and, subsidiarily, a hierarchical appeal<sup>207</sup> may be lodged before the superior body. They are materially filed before the Directorate that issued the challenged resolution. Administrative resolutions may be challenged in Uruguay through administrative channels. Recourse to the courts would correspond in any case for an eventual claim for damages caused by the resolution in question.

The motion for revocation seeks review of the decision by the National Directorate of Industrial Property (DNPI), while the hierarchical appeal will eventually be lodged to the Ministry of Industry for review of the proceedings. The term for filing the appeal is ten calendar days from the date of notification.<sup>208</sup>

The resolution of the motion for revocation or the hierarchical appeal will confirm, modify, or revoke the challenged act in whole or in part. When it is considered that there was a formal defect, the intervening body may validate the challenged act by correcting the defects that invalidated it.<sup>209</sup>

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<sup>204</sup> The only remedy that may be filed during the infringement proceeding is the appeal, which may only be filed against the resolution terminating the proceeding, the resolution imposing fines, the resolution ordering a precautionary measure, the acts that determine the impossibility of continuing the proceeding, and those that may cause defencelessness. The term to file the appeal in actions for infringement is five (5) working days. Appeals must be sustained before the same authority that issued the resolution, with the presentation of new documents, with a different interpretation of the evidence produced or with questions of pure law.

<sup>205</sup> Regulated by Section 317 and related sections of the Constitution of the Republic, Section 4 and related sections of Law 15869, Section 41 of Law 17292, and Section 155 of Decree 500/991.

<sup>206</sup> In the case of a motion for revocation, as of the day following the date on which the motion was filed.

<sup>207</sup> In the case of the subsidiary hierarchical appeal or appeal for annulment, from one hundred and fifty days from the day following the date on which the appeals were filed, or from the day following the date on which the express decision resolving the appeal for revocation was notified.

<sup>208</sup> Uruguay, Decree 500/1991 s 155 <[www.impo.com.uy/bases/decretos/500-1991](http://www.impo.com.uy/bases/decretos/500-1991)> accessed 28 December 2021.

<sup>209</sup> *ibid* s 165.

### 2.2.6. Deadlines and procedure

In **Argentina**, the term to obtain the registration of a GI for wines and spirits of vinous origin is approximately eighteen months and for a GI for agri-food products less than a year. To reach a decision within these deadlines, it is necessary that the studies and analysis of the geographical area and others have been carried out before the submission and that the process does not present any obstacles.

In **Chile**, the average times vary depending on whether the GI to be recognised is for an agricultural product or another product. In the first case, the average term is eighteen months, including a report issued by the Ministry of Agriculture, which has one hundred and twenty days to issue its opinion. The recognition of a GI for artisanal, maritime, or other non-agricultural products may take nine months.

The average time from the beginning of the protection application process to the authority's decision is approximately eight months in **Colombia**, between eight and ten months in **Costa Rica**, and between four and six months in **Peru**. In **Paraguay** and **Uruguay**, it is not possible to establish this period. In the case of Paraguay, the rules are very recent. The recognition of a foreign GI does not take more than thirty days, but the registration of a domestic GI is more complex and implementing the procedure takes longer. It is not possible to establish the duration of the GI recognition process in **Brazil**. The fastest case took less than a year, while the longest took more than six years.

### 2.2.7. Other forms of granting protection

In **Costa Rica**, **Mexico**, **Paraguay**, **Peru**, and **Argentina**, there are no forms of granting protection other than the application procedure described above. However, if the EU-MERCOSUR Agreement is ratified, this situation could change in Argentina and Paraguay.

The exceptions exist in **Chile**, **Colombia**, **Uruguay**, and **Brazil**. Almost all the FTAs negotiated by Chile since 2000 have recognised foreign GIs under the legal coverage of these agreements.<sup>210</sup> In addition, Chilean wine DOs are recognised by the Ministry of Agriculture.

In **Colombia**, Decision 486 provides for the recognition of Andean designations of origin and foreign DOs when so established by an international treaty. However, nothing in any treaty implies that the inclusion of DOs in the list automatically grants them protection. In these cases, it is necessary to issue an administrative act similar to the application for registration described above.

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<sup>210</sup> More details on the treatment of GIs in these treaties can be found in the specific section on international treaties below.

In **Uruguay**, there are situations in which a GI is protected directly through a treaty. Although the **Mexico-Uruguay** FTA and the **Uruguay-Chile** FTA do not consist of a mutual exchange of GI lists for protection, they guarantee the protection of certain GIs without the need for the ordinary registration procedure.

In **Brazil**, the terms *cachaça*, *Brasil*, and *cachaça do Brasil* are defined by Decree<sup>211</sup> as geographical indications. The GIs containing such terms follow particularities in the registration procedure, as regulated by the INPI.<sup>212</sup> Furthermore, the protection of *Tequila* and *Pisco* as GIs is also not subject to the registration procedure, since it was guaranteed in the international agreements signed with **Mexico** and **Chile**, respectively.

### 2.3. INFRINGEMENTS TO THE GI LAW

Identifying cases of infringement of GI rights and the measures and actions available for holders to exercise their rights is important in determining the scope of GI protection and the extent to which these rights can be enforced in the countries analysed. The comparison of these aspects is the subject of this section.

#### 2.3.1. Acts constituting an infringement of the GI law

Some countries list GI infringements exhaustively and others do not. **Paraguay, Peru, Uruguay, and Argentina** make up the second group. Thus, the laws list certain acts that constitute an infringement of GI rights, but other acts not expressly described may constitute an infringement of the holders' rights. In addition to this similarity, each country has its own characteristics.

In **Uruguay**, the infringement of GI rights occurs whenever there is unauthorised exploitation or when the use is made with the intention of causing harm. Therefore, redress may be sought through civil and

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<sup>211</sup> Brazil, Decree 4062/2001  
[www.gov.br/agricultura/pt-br/assuntos/inspecao/produtos-vegetal/legislacao-1/biblioteca-de-normas-vinhos-e-bebidas/decreto-no-4-062-de-21-de-dezembro-de-2001.pdf/view](http://www.gov.br/agricultura/pt-br/assuntos/inspecao/produtos-vegetal/legislacao-1/biblioteca-de-normas-vinhos-e-bebidas/decreto-no-4-062-de-21-de-dezembro-de-2001.pdf/view) accessed 28 December 2021.

<sup>212</sup> Brazil, Normative Instruction 68/2017  
[www.gov.br/inpi/pt-br/servicos/indicacoes-geograficas/arquivos/legislacao-ig/in682017alterada.pdf](http://www.gov.br/inpi/pt-br/servicos/indicacoes-geograficas/arquivos/legislacao-ig/in682017alterada.pdf) accessed 28 December 2021.

criminal lawsuits<sup>213</sup> and under the Consumer Protection Law and the Competition Law as applicable.<sup>214</sup>

In **Paraguay**, there is a distinction between faults, infractions, and contraventions according to the type of act committed against the GI/DO legislation and its regulations, and the resolutions of the Regulatory Committee by natural or legal persons, users of the system, or those registered in the Regulatory Committee's registers.

**Peru** states that the use by unauthorised persons that causes confusion constitutes an infringement of industrial property rights, including GIs/DOs, even if they are accompanied by terms such as 'kind', 'type', 'imitation', and the like that create consumer confusion. However, in Peru it is also possible to have recourse to the provisions on trademarks for the defence of GIs/DOs, whenever misuse of an identical or similar indication, or its modification or deletion occurs without consent for commercial purposes.

Provisions very similar to the Peruvian ones apply in **Argentina**, when one of these infringements is committed by natural or legal persons not registered in the system of the law regulating wines and spirits.<sup>215</sup> The implementing authority may impose penalties in case of (i) misuse of a DO, indication of source, or GI, (ii) use that may lead to error or confusion as to the nature or origin of the products, and (iii) improper use that may cause consumer confusion as to the origin of the products, even if preceded by the rectifying terms. In turn, the law regulating the protection of agri-food products<sup>216</sup> establishes that the existence of a right of use to a GI/DO implies that other external producers may not market their merchandise in such a way as to mislead or deceive consumers and allows the holder of the respective registration to institute administrative and judicial actions.

These laws provide an illustrative list of acts that constitute an infringement of GI/DO rights. Both for wines and spirits of vinous origin and for agri-food products, misuse of a GI, use that may mislead consumers or imply unfair competition, taking advantage of its reputation, usurpation, imitation, or evocation, even if the true origin is indicated, accompanied by qualifications or their translation, are punishable. These laws stipulate that the violations of the law by users of the system shall be classified for punishing purposes into (a) faults; (b) infractions in the production and/or processing of products; and (c)

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<sup>213</sup> Uruguay, Law 17011/1998 (n 41) ss 81-89.

<sup>214</sup> *ibid* s 77; Uruguay, Law 17250/2000 <[www.impo.com.uy/bases/leyes/17250-2000](http://www.impo.com.uy/bases/leyes/17250-2000)> accessed 28 December 2021; Uruguay, Law 18159/2007 <[www.impo.com.uy/bases/leyes/18159-2007/17](http://www.impo.com.uy/bases/leyes/18159-2007/17)> accessed 28 December 2021.

<sup>215</sup> Argentina (n 62).

<sup>216</sup> Argentina, Law 25380/2000 (n 43).

infractions concerning misuse of geographical names,<sup>217</sup> also referred to as contraventions.

In turn, the law regulating the protection of agricultural and food products establishes that the existence of a right to use a GI/AO implies that other external producers may not market their merchandise in a way that may mislead or deceive consumers, conferring administrative and judicial<sup>218219</sup> actions on the holder of the respective registration. In addition, the provisions of the Emergency Decree (DNU) of 2019 on Fair Trade are applicable to domestic and foreign DOs. This rule also regulates unfair competition and advertising issues and provides an exhaustive list of infringement cases.<sup>220</sup>

In **Brazil**, the law<sup>221</sup> lists the acts that constitute GI/DO infringement in the criminal provisions related to geographical and other indications. The manufacture and any subsequent act in the chain of production and sale of products with a false geographical indication are prohibited. The use of equivalent qualifying terms, without prejudice to the product's true origin, is also prohibited. The third case prohibits the use of trade names, distinctive signs, and other commercial expressions that indicate a source other than the real one. Either case is punishable by imprisonment of 1 (one) to 3 (three) months or a fine. However, it is not clear whether other acts such as the use of terms that mislead as to the product's true origin, though not constituting a criminal offence, constitute a civil violation of GI/DO rights. For this reason, there is no legal certainty as to whether the list of criminal offences is exhaustive or merely illustrative. Moreover, unfair competition acts may constitute GI/DO infringement, even if they are not listed in the above provisions.

The other countries analysed establish violations of GI law exhaustively. In **Chile**, misuse of a GI for commercial purposes is punished with fines for fiscal benefit whose importance is defined by

<sup>217</sup> In turn, Section 44 of the Decree regulating Law 25163 establishes that, in the event of infringements that could be punished within the framework of Law 14878 (General Wine Law of 6 November 1959) and the rules of Law 25163, the infringements shall be unified, and the highest sanction foreseen shall be applied.

<sup>218</sup> However, if in the investigation initiated ex officio or by complaint, a **producer located in the geographical area proves that he complies with the conditions** of production, manufacture and/or specifications, he **is entitled to use the geographical indication**. In this case, no infringement shall be deemed to exist, without prejudice to any recommendations made for the registration of producers and products under the geographical indication in question.

<sup>219</sup> In the case of appellations of origin, the use of logos, emblems, labels and other identifying elements by individuals or legal entities that do not belong to the respective Appellation of Origin Council may constitute the infringement described in Section 43 of Law No. 25,380.

<sup>220</sup> Section 9 of the DNU defines unfair competition as 'any act or omission that, by improper means, is objectively apt to affect the competitive position of a person or the proper functioning of the competitive process'.

<sup>221</sup> Brazil (n 22).

the judge. Such use is strictly established as the improper use of a GI/DO, and the simulation or use of a non-registered, expired, or cancelled GI/DO. The Chilean system also offers the possibility of bringing civil actions against unfair competition within a one-year limitation period, and actions for damages caused by the act within a four-year limitation period, according to the Civil Code.<sup>222</sup>

**Colombia** also provides for an exhaustive list of acts constituting GI infringement under the Andean rules.<sup>223</sup> Misuse of GIs that causes confusion is punishable, even if expressions such as ‘genus’, ‘type’, ‘imitation’, and the like that create consumer confusion are present. The use of a DO for wines or spirits originating in a different place is punishable even when the product’s true origin is indicated, although the translation or qualifying expressions are used. In the case of indications of source, they may not be used in trade when they imply a false or misleading indication as to their origin or could mislead the public over the origin, provenance, quality, or any other characteristic of the product or service.

**Costa Rican** law<sup>224</sup> establishes that the fraudulent use of a GI/DO is an infringement punishable by a fine or imprisonment. In addition, it prohibits acts of competition contrary to morality and good business practices generally accepted in the market system that cause effective damage or proven threat of damage, when it is resorted to imitation, reproduction, substitution, or undue alienation of designations of origin for goods or services owned by third parties.<sup>225</sup>

Under **Mexican** law,<sup>226</sup> administrative infringements of a protected national or recognised foreign GI/DO include (i) unauthorised use, (ii) use of an identical or confusingly similar indication, (iii) use of translation or transliteration to cover the same or similar products, and (iv) the production and any subsequent act in the productive and commercial chain of identical or similar products, using any type of indication or element that creates consumer confusion as to their origin or quality, such as qualifying terms.

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<sup>222</sup> If the trial punishes one of these actions for being unfair, the law indicates that the courts must refer the background information to the Office of the National Economic Prosecutor, which has the power to request the Court for the Protection of Free Competition to apply a fine ranging from US\$145 to US\$72,000.

<sup>223</sup> Andean Community Commission (n 32).

<sup>224</sup> Costa Rica (n 98).

<sup>225</sup> Costa Rica, Law 7472/1994 s 17

<[www.pgrweb.go.cr/scij/Busqueda/Normativa/Normas/nrm\\_texto\\_completo.aspx?nValor1=1&nValor2=26481](http://www.pgrweb.go.cr/scij/Busqueda/Normativa/Normas/nrm_texto_completo.aspx?nValor1=1&nValor2=26481)> accessed 28 December 2021.

<sup>226</sup> Mexico (n 35).



### 2.3.2. Injunctive relief for infringement of GI law

Except for **Paraguay**, in all the countries considered in the comparative study, it is possible to obtain a precautionary measure in response to an actual or imminent infringement of a GI/DO. Its requirements are described in a very similar way and include the need to demonstrate the plausibility of the right invoked, and the danger of damage in the delay or risk to the useful outcome of the process. In **Costa Rica** and **Chile**, the decision-making body may require reasonable security or a sufficient bond to protect the defendant and prevent abuses, provided that it does not unreasonably dissuade the power to resort to such procedures.

The grounds for applying for injunctive relief may differ. For example, in **Argentina**, the basis is the TRIPS Agreement and the rule on fair trade.<sup>227</sup> The merits of the dispute rest on an independent action. It must be brought within ten days after the injunction is issued or when the twenty days (20) have expired. When the mediation procedure has been initiated, the term will restart after the expiration of the twenty-day period from the date on which the mediator issues the minutes with his/her signature certified by the Ministry of Justice, Security and Human Rights, stating that no agreement was reached or that the mediation could not be carried out due to any of the authorised causes. In these cases, the Federal Courts of the place of the event or the defendant's domicile, at the plaintiff's<sup>228</sup> choice, are competent.

In **Brazil**, the injunctive relief may be granted at any time when the requirements are met. Afterwards, if the proposed injunction has a preparatory nature (and not satisfactory), there is a 30-day period to propose the main action, whose trial is within the competence of state judges, provided that there is a particular interest. In **Uruguay**, the action may be initiated at any stage of the case or even before and is under the jurisdiction of the Civil Courts, with national jurisdiction.

In **Chile**, an injunction is admitted before the legal proceedings only in exceptional cases. The applicant must file its claim within ten days and request that the injunctive relief be maintained. This term may be extended at the request of a party and for good cause. In any case, the lower courts are competent to hear and rule on injunctions, which are the general ones for any civil action.

In **Costa Rica**, when injunctions are adopted as preparatory measures, the complaint or claim related to the infringement process must be filed within one month after the notification of the resolution accepting the measure. The civil or criminal courts have jurisdiction. In

<sup>227</sup> See Emergency Decree 274/2019 at

<[www.boletinoficial.gob.ar/detalleAviso/primera/205888/20190422](http://www.boletinoficial.gob.ar/detalleAviso/primera/205888/20190422)>

<sup>228</sup> Pursuant to Section 5.4 of the National Code of Civil and Commercial Procedure.

administrative proceedings, the General Directorate of Customs is competent to apply border measures.

The lower and higher administrative bodies of INDECOPI in **Peru** are competent to adopt injunctions. In **Colombia** and **Mexico**, although injunctive relief may be used in case of GI/DO infringement, there are no details about the procedure.<sup>229</sup> At least in Colombia, the General Procedural Code is applied in these cases regarding the adoption and practice of injunctions.

### 2.3.3. Action for damages in case of infringement of GI/DO law

In addition to injunctive relief, it is possible to bring an action for damages in the event of an infringement of the rights conferred by a GI in all the countries analysed. Strictly speaking, a GI right infringement that causes damages to the GI holder would constitute a case of tort liability and, therefore, would generate a duty of reparation on the part of the person who caused such damages. Consequently, this happens whenever a person causes damage to another person by an unlawful act and is obliged to repair it.

In **Argentina** and **Brazil**, the legal basis of the action would be the general civil liability regime of the Argentine Civil and Commercial Code and the Brazilian Civil Code, respectively. In the Argentine case, the action for damages must be initiated within three years from the unlawful harmful event, and the Civil and Commercial Courts of the place of the event or of the defendant's domicile, at the plaintiff's choice, have jurisdiction. Under the Brazilian system, the GI infringement may be configured by voluntary action or omission, negligence, or recklessness. The damage to be repaired may be material or exclusively moral. Acts performed in self-defence or in the regular exercise of a recognised right, and those performed to eliminate an imminent danger, when necessary and essential, are not considered unlawful and, therefore, do not entail a duty of compensation. The law<sup>230</sup> determines that the action prescribes in five years from the violation of the right, and the state judges have competence over this matter, provided that there is a particular interest.

Under **Colombian** law, for an action for damages, jurisdiction is vested in the Civil Judge or the Division of Jurisdictional Matters of the Bureau of Industry and Trade, which acts as judge in cases of industrial property infringement. The action must be initiated within two years after the damaged party becomes aware of the harmful event or, in any case, five years after the infringement was committed for the last time.

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<sup>229</sup> Andean Community Commission (n 32) art 245.

<sup>230</sup> Brazil (n 22).

The **Chilean** system establishes that the lower courts are competent to hear actions for damages, which have a limitation period of five years from the harmful event. The term to initiate the action in **Uruguay** is four years from the originating event or one year after the holder of the right becomes aware of it. In both cases, the Civil Courts of First Instance are competent.

In **Peru**, once the administrative authority resolves that there is infringement, a judicial civil action may be brought to claim for damages. This action can be initiated once the administrative procedure before INDECOPI is concluded and falls under the jurisdiction of the Civil Judge.

The possibility to bring actions for damages is also guaranteed in **Costa Rica**.<sup>231</sup> The ordinary procedures established in the Code of Civil Procedure apply in this case. Actions to claim for damages in this venue are subject to a 10-year limitation period.<sup>232</sup> In **Mexico**, the IMPI Divisional Directorate for the Protection of Intellectual Property is the body responsible for analysing these actions.

Although there is no possibility to apply for an injunction in **Paraguay**, it is possible to bring an action for damages. However, even in this case, the Paraguayan system has peculiarities, since this action can be initiated within the framework of a criminal proceeding referred to the violation of the law or autonomously through an ordinary civil proceeding. After the criminal proceedings have been concluded, in case of conviction, the Code of Criminal Procedure provides for compensation for damages through the procedure for the reparation of damages. In this case, the competent judge is the one who issued the sentence. Another option in Paraguay is the ordinary proceeding of compensation for damages for tort liability in the civil and commercial jurisdiction. Under the legislation, it is possible to claim compensation for damages caused by an act. In the case of an ordinary civil proceeding, the action for damages must be initiated within a maximum of two years.

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<sup>231</sup> For further details, see Sections 38 and 40 of the Law on Intellectual Property Rights Enforcement Procedures.

<sup>232</sup> For further details, see Section 818 of the Civil Code and Section 108 of the Code of Civil Procedure.

## 2.4. PRODUCTION CONTROL AND MANAGEMENT

The countries analysed have certain differences in their national legislation regarding the control of the production of products using GIs/DOs.

### 2.4.1. Production control systems

In **Argentina**, there are differences in the production control system, depending on whether the products are regulated by the law for agri-food products or the law for wine products and spirits of vinous origin. In any case, both laws establish certain minimum parameters. The law on wine products and spirits of vinous origin requires a Promotion Council, tasked with creating, for each CDO, rules stipulating control procedures.<sup>233</sup> In addition, there are differences depending on whether it is a GI or DO, with the possibility of internal, external or self-control.

The law on agri-food products<sup>234</sup> establishes that the functions of the DO Councils include (a) guiding, supervising, and controlling the production, processing, and quality of the products covered by the DO; (b) determining and imposing sanctions on members who violate the internal rules of the DO Council; (c) reporting law violations to the implementing authority, and/or bringing any action aimed at preserving its DO.

For wines, the legislation establishes that CDOs are subject to internal control by their respective Promotion Council. In the case of GIs, the National Institute of Vitiviniculture carries out regular inspections to verify compliance with legal requirements.

For agri-food products, the legislation also provides for internal control, although external control may be designated. The DO Council must approve the protected product's production and quality protocol, which will be the basic instrument for the control, by the Council and the competent public authorities, of compliance with the conditions of production, extraction, processing, packaging, and marketing. It must designate those responsible for monitoring compliance, who must be technical managers (specialised university professionals) or an external certification body. It must carry out quality controls as frequently as it deems convenient to verify that the products comply with the quality protocol, and technical and handicraft standards duly registered. On the other hand, the Council must submit to the implementing authority an annual sworn statement on the estimated marketable volume of

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<sup>233</sup> See Argentina (n 62). The Regulatory Decree stipulates that, when regulating the control procedures, they must establish limits for the components of the protected wines and analytical parameters that are deemed interesting for their characterisation (s 20 sub-s h).

<sup>234</sup> Argentina (n 43).

products covered during the period. The DO Council must carry out controls to verify that the products comply with the production protocol.

Regarding GIs of agri-food products, the guidelines on GIs/DOs governed by the Secretariat of Food and Bioeconomy regulations (version 2018) state that the control of the GI shall be the responsibility of a qualified professional or appropriate body. Even if external and private control is chosen, the control by the implementing authority shall be public.

As for control-related costs, in the case of public control, the special laws provide that the costs of the implementing authority for its functions shall be covered with its own resources, contributions, fines, and fees. We understand that this refers to its control function. In turn, they stipulate that the DO Councils, in charge of control, shall operate with resources from the collection of control instruments, contributions, fines, and any other resources it establishes.

As for the practical application of the control, there are different rules depending on the type of GI. For example, in the case of wine GIs/DOs, the control can be done on site through sample inspection. The National Institute of Vitiviniculture will coordinate the control and verification by inspecting, analysing, and tasting wines and spirits of vinous origin subject to this regime. It will also control and verify, in vineyards, wineries, and other establishments, the production and processing conditions established in the relevant regulations and complementary rules for each case.

Concerning agri-food products, all controls ensure consumer protection to guarantee observance of the DO and the approved production, manufacturing, or quality protocols. The implementing authority is responsible for registering inspectors authorised for the GI control and surveillance system. These inspectors may be public officials of the National Public Administration or its decentralised agencies, the provinces, or the Autonomous City of Buenos Aires, provided that they have signed agreements for such purposes and have received specific training.

The **Brazilian** national GI system does not establish the forms of control. The existence of external control exercised by third parties is not a precondition for registration. For both indications of source and DOs, the law requires a control structure over the producers or service providers entitled to use the GIs. The Regulatory Council is the body responsible for monitoring the control procedures and defining issues like the control frequency under the specification sheet.

The INPI is not involved in any aspect of control only in verifying the existence of control mechanisms and systems. There is no public control (in the sense that it is offered by the government) to ensure compliance with the specification sheet. Regulatory agencies only

control general health and safety standards. Therefore, if producers decide to have external control, it will always be carried out by a private agency and its costs will be borne by them.

The same happens in **Mexico**, where the government is not responsible for the costs associated with production control. Therefore, if producers choose external control, it will be private, and its system will be designed and executed by them. As in Brazil and Mexico, in **Colombia**, producers may choose self-, internal, or external control, depending on the type of product. However, unlike Brazil, where the INPI only verifies the existence of control mechanisms, Colombian producers present the control mechanism, and the authority must review it and confirm if it is effective to ensure product quality and impartiality.

Similar to what happens in Argentina, control in **Chile** can be materialised in different ways and depends on whether the GI is for wines and spirits, or other types of products. In the case of GIs registered with the INAPI, producers are free to establish their control mechanisms. Thus, the system privately established in the respective rules of use and control will determine its forms more precisely. However, in the case of DOs for Chilean wines and *Pisco*, the control mechanisms are established in Supreme Decrees 78, 464, and 521 of the Ministry of Agriculture.

Consequently, for GIs registered with the INAPI, internal and/or self-control is basically used, whereas in the case of GIs for *Pisco* and wines, control and inspection are external and public since they have been assigned to the Agricultural and Livestock Service (SAG) of Chile. Control by the SAG can be carried out personally or through private certifying companies, to which the Service delegates its powers as permitted by law. The costs are covered entirely by the national authority and are not shared by the inspected parties; however, when the SAG delegates its authority, the private companies may charge for this service. In the case of GIs registered with the INAPI, control is internal and will depend on the regulation of producers under the respective rules of control and use, which must precisely address the way to fund these control and inspection procedures.

In **Brazil** and **Colombia**, there is no public control over production since the choice for one or the other control system is free. There is no variation between the types of GI (indications of source and DOs), and there is no regulation established by law. Producers can determine their control system. The Regulatory Council is responsible for certifying that the GI is used by those legally entitled to it and following the rules of use (specification sheet).

In a very general way, **Mexico** is another case where the choice of the control system is left to producers. Therefore, self-control is a possibility. In **Costa Rica**, the legal system regulating GIs does not

require producers to adopt a certain type of control system. The law does not provide additional information on the subject, either.

In **Paraguay**, the rules are very clear regarding production controls on GIs. Producers can determine their system. In addition, as in other cases, the law mentions that the control of production is one of the functions of the Regulatory Committee, as in Argentina. Regarding production controls on GIs in **Peru**, internal control is the form established by the system. In practice, as long as the Regulatory Council is not created for each DO, the INDECOPI Directorate of Distinctive Signs carries out the control work. The DO Regulatory Councils are responsible for the entire process and control of production, among other functions.

**Costa Rica** and **Uruguay** do not expressly regulate the control system. The Uruguayan legislation makes no mention of production control, while Costa Rica only deals with the subject indirectly. The Costa Rican law defines control as a ‘set of internal rules that regulate the requirements, rights, obligations, control mechanisms, procedures, and sanctions of the subjects that will use the geographical indication or designation of origin’. As in Brazil, it also establishes that the Regulatory Council is responsible for implementing and monitoring all control activities, based on the specification sheet. In Uruguay, a very peculiar situation occurs as compared with the other countries under study. The national system does not establish the need to carry out production controls on GIs, and, consequently, there are no GI controls other than the general regulatory ones specific to the sector’s activity. For example, by law, a cheese GI must observe the regulatory controls related to cheese production such as sanitary and safety measures. The same applies to any type of product.

In **Paraguay**, the system is somewhat different. The law provides for self-control as a duty of the Regulatory Committee, which exercises internal control. The DINAPI has the function of supervising compliance with the production and processing conditions established in the rules of each GI/DO and overseeing the control exercised by the Regulatory Committees as a sort of external control. Therefore, the external control is public. In this case, the associated costs are covered by the national authority with the annual budgetary provisions allocated to it.

#### 2.4.2. Inspections

There are also differences between the countries under study regarding the inspections carried out on production, ie the way in which control is done in practical terms. In some cases, the law states how to carry out inspections and, in others, the organisation is left to producers. There are even cases such as **Paraguay**, where the organisation, types, and

frequency of inspections are not regulated, and no manual of good practices is available. In this sense, the national system in **Uruguay** does not provide for the need to carry out specific inspections in the production processes of goods or services protected by GIs.

In **Colombia**, the way the control is carried out, ie the choice of the type of inspections to be used (which depends on the type of products), is also decided by producers. Therefore, the periodicity depends on the model adopted by the Association in charge of administering the DO. Most of the models adopted in Colombia relate to ISO product quality standards with first-, second- or third-party certification, and random inspections.

In **Brazil, Costa Rica, Mexico, Peru, and Chile**, there are no legal requirements regarding the frequency, or the way inspections must be carried out since it depends on the type of product and the specific needs. Therefore, producers are free to organise the control as they see fit, and the description of its practical implementation will be made explicit in the rules of use.

The issue is a bit more complex in **Argentina**, where both *sui generis* laws establish quite specific rules for performing the control, differing between GIs and DOs. In practice, in the case of wine GIs, the requirements must be complied with on the dates, conditions and forms established by the National Institute of Vitiviniculture. Also, the legislation establishes that the CDO shall be subject to internal control by the Promotion Council of the respective CDO. In the case of GIs, the National Institute of Vitiviniculture is in charge of carrying out regular inspections to verify compliance with the legal requirements.

As for the DO, it will depend on what is stipulated in its rules. In addition, the legislation lays down the GI users' obligation to comply with the presentation of sworn statements and information related to the registration for an effective control of the system. For DOs of agri-food products, the Council must submit an annual sworn statement to the implementing authority, with the estimated marketable volume of the products covered for the period. It must also keep statistics and DO production reports permanently updated, which requires producer cooperation.

### 2.4.3. Duty to cooperate

The producers' duty of cooperation regarding the performance of inspections, as well as the regulatory obligation to do so are an important issue. In **Argentina**, due to the control tasks of the DO Council, a higher level of producer cooperation is required to carry out a proper inspection. In the **Colombian** system, the existence of such a duty depends on the control model adopted by producers. In **Brazil** and



**Peru**, there is no legal obligation of producer cooperation in inspections and control, but, in practice, such cooperation can be observed. In **Mexico**, the law does not provide for such a duty, and the matter is left to the discretion of producers. However, the issue is viewed differently in **Chile**, where producers are obliged to cooperate. If they fail to do so, they may be subject to administrative fines, searches of their facilities, and even closure of their establishments in the case of DOs for *Pisco* and Chilean wines. This is not the case for the other DOs recognised in Chile since the duty of producer cooperation is governed by the respective rules of use and control agreed.

## 2.5. PUBLIC POLICIES AND GOVERNMENT ASSISTANCE

When referring to GIs in Latin America, the context usually involves mostly small producers who consequently need government support, either in the form of technical or financial assistance, for the success of a GI recognition project, and its sustainability in the future once protection is granted. This section incorporates some considerations on this issue in the countries under study.

In **Argentina**, the situation is very peculiar. In view of the different rules applicable to GIs, there are also specificities in relation to support programmes. Recently, Resolution 91/2021-APN-MAGYP creating the Programme to Promote the Development of Regional Economies (IDER) has been issued. Under the Secretariat of Food, Bioeconomy and Regional Development of the Ministry of Agriculture, Livestock and Fisheries, the Programme is mainly intended to promote actions aimed at improving the socioeconomic, productive, trade, and financial conditions of regional economies, within a framework of sustainable development with social and territorial equity. The Programme provides funds to implement specific policies related to eligible regional value chains, especially aimed at financing, co-financing and making direct non-refundable contributions for, among others, ‘the promotion of access to tools for differentiation and tangible and intangible value addition to obtain the different seals of certification, designation of origin, geographical identification, organic Argentina, Argentine food, and others in coordination with the relevant areas’, as provided for in Section 6.k of Resolution 91/2021.

Beyond this Resolution, there are no other rules providing for financial assistance. However, producers do have technical and legal assistance, which in principle could be requested before filing the application for GI recognition. Administrative and legal assistance related to GI protection for wines and spirits of vinous origin can be obtained from the technical administrative body of the National Institute of Vitiviniculture, because actions of this nature are within its competence. According to the regulations, the Institute’s Department of Origin Protection can offer support to prepare regulatory projects, and

carry out studies, analyses, and evaluations necessary to conceptualise the expression that will designate the defined area proposed by the applicants,<sup>235</sup> among others.<sup>236</sup> The Institute's technical assistance consists of analysing what is presented by the interested party, performing the technical control, and studying the background information presented.

Regarding GIs for agri-food products, the implementing authority offers online training and technical assistance (such as a virtual course for GIs and DOs). The objective of these initiatives is to promote the dissemination of geographical indications and contribute to searching for national agri-food products that can be evaluated for GI protection. Additionally, legal assistance is provided.<sup>237</sup>

In **Brazil**, the support system is organised as follows. First, federal government support is provided by the Ministry of Agriculture, Livestock and Supply (MAPA) especially for GIs originating in agriculture. The Coordinating Unit of Geographical Indications for Agricultural Products (CIG/MAPA) identifies and maps potential products or regions and supports the processes of chain organisation and registration of Brazilian geographical indications and collective trademarks. Financial assistance, when available, is indirect since there is no transfer of funds to producers. The CIG has its own budget for developing its activities. It centralises the management of resources and allocates them to technical contracts once the applications for support are approved. Assistance is tied to specific purposes, and its provider will be defined according to the needs of the approved project. When MAPA employees are technically qualified to provide the assistance, they do so; otherwise, an outsourcing contract is awarded.

Like MAPA, the National Institute of Industrial Property (INPI) has national coverage, and actions focused on dissemination, clarification, and training in GIs. This body develops several promotion and awareness actions in collaboration with institutions such as CNI,<sup>238</sup> SEBRAE, and MAPA/CIG, but financial assistance is still not possible.

In the federal sphere, there are also the agencies of the Brazilian Micro and Small Enterprise Support Service (SEBRAE).<sup>239</sup> SEBRAE's actions are national and provincial and are divided into five general

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<sup>235</sup> In practice, the National Council for Designations of Origin has not been created yet.

<sup>236</sup> For more information, see

<[www.argentina.gob.ar/sites/default/files/departamento.pdf](http://www.argentina.gob.ar/sites/default/files/departamento.pdf)>

<sup>237</sup> Section 5 of Decree 1341/16 of 2 January 2017 can also be considered an incentive since it establishes that those producers with a DO or GI for agri-food products (regulated by the LAA) will be entitled to an additional 0.5% export refund, non-cumulative among them. The implementing authority of Law 25380/2000 would carry out the same activity.

<sup>238</sup> National Industrial Confederation.

<sup>239</sup> Prof. Jean-Louis Le Guerrerou assisted in obtaining information on Brazil.

axes: i) intellectual property (GI registration, and IP discussion); ii) governance; iii) technological innovation, and traceability and control; iv) market; and v) communication. Each axis develops different actions. The financial management of their implementation is carried out by the local SEBRAE office. Assistance is granted after the approval of a proposal/project or as a result of SEBRAE's work to identify possible GIs.<sup>240</sup> It is, therefore, linked to specific purposes. As a rule, technical assistance is provided only by consultants previously linked to SEBRAE. Within this operational logic, producers do not manage resources. The consultants or, in exceptional cases, external contractors are responsible for accountability. In this case, there is financial participation of the producers.

In addition to the above possibilities, some support actions are offered by federal agencies (eg EMBRAPA) but developed by local offices. There is also exclusive assistance from provincial agencies and several Brazilian provinces, such as EPAGRI<sup>241</sup> in Santa Catarina or EMATER<sup>242</sup> in Rio Grande do Sul (both related to agricultural research and extension).

In **Chile**, several programmes support small producers. One is the seal of origin *Sello de Origen*, a government initiative that seeks to bring together the efforts of the various public funds to protect Chile's traditional products and strengthen the rural environment with distinction and preservation tools like GIs and DO. The public funds are defined from regional funds, which are allocated by local administrations. No fixed rules establish when producers may apply for aid, but, in practice, two different moments are targeted: when obtaining the product's recognition and protection as a GI, and when strengthening the management and positioning of the products and their communities once registration is obtained.

In addition, the Ministry of Agriculture launched the programme *Manos Campesinas*, a seal that guarantees that a product has been produced by Chilean small producers and encourages local development. Those with access to this seal can, in turn, access this type of specialised stores located throughout Chile, which are financed by the Ministry of Agriculture, for the purposes of their initial authorisation.<sup>243</sup>

**Uruguay, Colombia, and Costa Rica** have established and institutionalised programmes to support producers interested in GIs. In the case of **Colombia**, *Artesanías de Colombia* is an institution focused on non-agricultural GIs. In **Costa Rica**, the National Registry offers technical assistance, and the various agricultural development

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<sup>240</sup> There may be specific calls for project support.

<sup>241</sup> Santa Catarina Agricultural Research and Rural Extension Company.

<sup>242</sup> Federal District Technical Assistance and Rural Extension Company.

<sup>243</sup> See more at <[www.manoscampesinas.cl/](http://www.manoscampesinas.cl/)>

programmes also provide support to producers, who can use these programmes to develop GI recognition projects. **Uruguay** grants partial exemptions on registration fees.

In addition to evaluating applications for protection, the IMPI in **Mexico** provides technical advice to producers, who may apply for it at any time. To fulfil its functions of dissemination, counselling, and provision of services to the public on industrial property matters, the IMPI offers various GI courses and workshops.

Under the internal regulations of the National Directorate, **Paraguay** has a plan for the promotion of GIs and DOs. It consists of offering workshops at the production place, in addition to technical assistance to prepare orders and documents. The GI/DO Directorate of DINAPI, together with the General Directorate of Industrial Property, also offers the opportunity for training, which must be provided before granting protection.

In **Peru**, INDECOPI employees offer basic and initial assistance for the recognition of GIs/DOs, and the design of the Regulatory Council. The application can be made at any time (before, during or after protection is granted) and does not need to have specific purposes.

### 3. INTERNATIONAL TREATIES: GI COMMITMENTS

Regarding the GI commitments made in international agreements, it is verified that, except for the Paris Convention (1883) and the TRIPS Agreement (1994), to which all the countries under study are signatories, there is no coordination or similar criteria for the ratification of multilateral agreements on the subject. Only **Brazil** has signed the Madrid Agreement (1891). **Costa Rica, Mexico, and Peru** are the only signatories of the Lisbon Agreement (1958), and only **Peru** has signed its Geneva Act (2015). Table 1 below summarises the status of ratification of multilateral treaties in relation to the countries covered in this study.

**Table 1 - Multilateral Agreements**

<b>Paris Convention</b>	<b>Madrid Agreement</b>	<b>Lisbon Agreement</b>	<b>TRIPS Agreement</b>	<b>Geneva Act of the Lisbon Agreement</b>
Argentina			Argentina	
Brasil	Brasil		Brasil	
Chile			Chile	
Colombia			Colombia	
Costa Rica		Costa Rica	Costa Rica	
Mexico		Mexico	Mexico	
Paraguay			Paraguay	
Peru		Peru	Peru	Peru
Uruguay			Uruguay	

### 3.1. MULTILATERAL AGREEMENTS RATIFIED BY EACH COUNTRY UNDER STUDY

This section follows a particular logic since the agreements signed by more than one country often overlap, especially in the case of economic blocs.

**Mercosur**, a bloc formed by Argentina, Brazil, Paraguay, and Uruguay, has signed six FTAs between 1996 and 2017, but only three include commitments on intellectual property, and none include GI commitments, as shown in Table 2.

**Table 2 - FTAs signed by Mercosur**

<b>Year</b>	<b>FTA</b>	<b>Provisions relevant to the study</b>	<b>Legal provision</b>
1996	Mercosur–Chile	IP in general	Art 43
2005	Mercosur–Peru	IP in general	Art 32
2017	Mercosur–Colombia	IP in general	Art 31
1996	Mercosur–Bolivia	None	N/A
2007	Mercosur–Israel	None	N/A
2010	Mercosur–Egypt	None	N/A

As for the Mercosur countries, although **Argentina** has not signed any FTAs, it did sign in 2015 a bilateral trade facilitation agreement with **Chile**, which, though relatively new, does not include commitments on

intellectual property or GIs. **Brazil and Paraguay** have not signed any FTAs. Although **Uruguay** has not signed any FTAs either, it did sign a bilateral treaty with **Mexico** in 2003. The treaty laid down rules on the protection of GIs in general and, specifically, stated that: ‘6. Uruguay shall recognise the designations of origin *Tequila* and *Mezcal* for their exclusive use in goods originating in Mexico, provided that they are manufactured and certified in Mexico following the Mexican laws, regulations, and standards applicable to such goods’. Finally, **Chile** presents many FTAs signed between 1996 and 2017, as observed in Table 3 below.

**Table 3 - FTAs signed by Chile**

Year	FTA	Provisions relevant to the study	Legal provision
1996	Chile–Canada	Specific GIs	Art C-11 / Annex C-11
1998	Chile–Mexico	Specific GIs	Arts 15-24 / Annex 15-24
2003	Chile–South Korea	Specific GIs	Art 16.14 / Annexes 16.4.3, 16.4.4, and 16.4.5
2005	Chile–New Zealand, Singapore, and Brunei Darussalam	Specific GIs	Art 10.5 / Annex 10
2009	Chile–Turkey	Specific GIs	Art 36
2011	Chile–Vietnam	Specific GIs	Art 3.10
2013	Chile–Thailand	Specific GIs	Art 11.9 / Annex 11.9
2014	Chile–Hong Kong	Specific GIs	Art 3.10 / Annex 3.10
2017	Chile–Indonesia	Specific GIs	Art 3.10 / Annexes 3.10-A and 3.10-B
1999	Chile–Central America	GIs in general	Art 3.12
2002	Chile–EU	Specific GIs	Art 32 / Annex V and VI
2003	Chile–USA	Specific GIs	Art 17.4 / Art 3.15
2006	Chile–Panama	GIs in general	Art 3.11
2007	Chile–Japan	Specific GIs	Art 163 / Annex 15

2009	Chile–Australia	Specific GIs	Art 17.17 / Supplementary Charter on Intellectual Property on Wines
2005	Chile–China	Specific GI	Art 10 /Annex 2B
2006	Chile–Colombia	None	N/A
2006	Chile–Peru	None	N/A
2010	Chile–Malaysia	Specific IGs	Art 3.13
2018	Chile–Uruguay	Specific IGs	Art 10.11 /Annex 10.11

Two of the FTAs signed by **Chile** have no provisions on IP rights. Other two include at least a general mention of GIs in the IP provisions, and sixteen treat GIs independently. As for GIs whose protection has been negotiated in the agreements, the **Chile–Canada** FTA<sup>244</sup> signed in 1996, for example, presents a list of GIs subject to protection in the respective countries.

The FTA signed between **Chile** and **Mexico** in 1998 established the protection of the Mexican GIs *Tequila* and *Mezcal* for their exclusive use in products originating in Mexico. On the other hand, Mexico undertook to ensure the protection of *Pisco*, *Pajarete*, and *Vino Asoleado*, for their exclusive use in products originating in Chile, and those wines with Chilean designation of origin to be determined by a bipartite commission.<sup>245</sup> Thus, the two countries made the commitment not to allow the import, manufacture, or sale of products under the referred GIs that are not from the region of origin declared.

In the **Chile–South Korea** FTA, protection was granted to GIs as shown in Table 4. This protection implies the prohibition of the import, manufacture, or sale of products under the referred GIs but not from the region of origin.

<sup>244</sup> Annex C-11: Geographical indications. As indicated in Annex C-11 and considering the TRIPS Agreement, the Parties shall protect geographical indications for the products specified in this Annex.

<sup>245</sup> The foregoing is without prejudice to the *Pisco*-related rights that Mexico may recognise exclusively for Peru, in addition to Chile.

**Table 4 - GIs protected under the Chile–South Korea FTA**

<b>Chile</b> Annex 16.4.4	<i>Pisco</i> (for wine and spirits) <i>Pajarete</i> (for wine and spirits) <i>Vino Asoleado</i> (for wine)
<b>Chile</b> (Wines) Annex 16.4.5	<p><b>Viticole region of Atacama</b></p> <ul style="list-style-type: none"> <li>- Subregion: <i>Valle de Copiapó</i></li> <li>- Subregion: <i>Valle del Huasco</i></li> </ul> <p><b>Viticole region of Coquimbo</b></p> <ul style="list-style-type: none"> <li>- Subregion: <i>Valle del Elqui</i></li> <li>- Subregion: <i>Valle del Limarí</i></li> <li>- Subregion: <i>Valle del Choapa</i></li> </ul> <p><b>Viticole region of Aconcagua</b></p> <ul style="list-style-type: none"> <li>- Subregion: <i>Valle de Aconcagua</i></li> <li>- Subregion: <i>Valle de Casablanca</i></li> </ul> <p><b>Viticole region of Valle Central</b></p> <ul style="list-style-type: none"> <li>- Subregion: <i>Valle del Maipo</i></li> <li>- Subregion: <i>Valle del Rapel</i></li> <li>Zone: <i>Valle de Cachapoal</i></li> <li>Zone: <i>Valle de Colchagua</i></li> <li>- Subregion: <i>Valle de Curicó</i></li> <li>Zone: <i>Valle del Teno</i></li> <li>Zone: <i>Valle del Lontué</i></li> <li>- Subregion: <i>Valle del Maule</i></li> <li>Zone: <i>Valle del Claro</i></li> <li>Zone: <i>Valle del Loncomilla</i></li> <li>Zone: <i>Valle del Tutuvén</i></li> </ul> <p><b>Viticole region of the South/Sur</b></p> <ul style="list-style-type: none"> <li>- Subregion: <i>Valle del Itata</i></li> <li>- Subregion: <i>Valle del Bío-Bío</i></li> </ul>
<b>Korea</b> Annex 16.4.3	Korean <i>Ginseng</i> (related to ginseng) Korean <i>Kimchi</i> (related to kimchi) <i>Boseong</i> (related to tea)

The **Chile–New Zealand, Singapore, and Brunei Darussalam** FTA signed in 2005 contains commitments to protect Chilean GIs. *Pisco* as a spirit is one of them, in addition to a long list of GIs of Chilean wines.<sup>246</sup> The **Chile–Turkey** FTA entered into force that same year. It guaranteed the protection of the *Pisco* and *Raki* GIs in the respective territories that signed the treaty.

Article 3.10.2 of the **Chile–Vietnam** FTA states that ‘Viet Nam recognizes *Pisco*, accompanied by an indication of Chile such as

<sup>246</sup> You can access the text at  
<[www.sice.oas.org/Trade/CHL\\_Asia\\_e/TransPacific\\_text\\_e.asp](http://www.sice.oas.org/Trade/CHL_Asia_e/TransPacific_text_e.asp)>



Chilean, Chile, etc.’ Furthermore, it emphasizes that the recognition ‘(...) shall not prejudice the rights that Viet Nam has recognized, in addition to Chile, to Peru with respect to Pisco’. In the **Chile–Thailand** FTA,<sup>247</sup> the recognition of GIs involves a list that, on the Chilean side, focuses on wines, spirits, agriculture, and fishing products and, on the Thai side, includes rice, vegetables and fruits, food, wines, silk and textiles, and handicrafts.

Finally, the **Chile–Hong Kong** FTA covers the protection of the GIs listed in Annex 3.10,<sup>248</sup> featuring only Chilean GIs, including many wines, *Pisco* as a spirit, and agricultural and fishing products.

**Colombia** signed eight FTAs between 1994 and 2013, as shown in Table 5.

**Table 5 - FTAs signed by Colombia**

<b>Year</b>	<b>FTA</b>	<b>Provisions relevant to the study</b>	<b>Legal provision</b>
2007	Colombia–Northern Triangle	Specific GIs	Art 16-38 / Annex 3-16
2012	Colombia and Peru–EU	Specific GIs	Arts 207-214 / Annex XIII
2013	Colombia–Costa Rica	Specific GIs	Chapter 9 / Annex 9-A
1994	Colombia–Mexico	GIs in general	Art 18-16
2006	Colombia–USA	GIs in general	Art 16.3
2008	Colombia–EFTA	GIs in general	Art 6.7
2013	Colombia–Korea	GIs in general	Chapter 15
2008	Colombia–Canada	None	N/A

The FTA signed with **Canada** in 2008 has no IP provisions. The **Colombia–Korea** FTA of 2013 has only generic IP provisions but no reference to GIs. The FTAs signed by **Colombia** with **Mexico** (1994), the **USA** (2006) and the **European Free Trade Association (EFTA)**<sup>249</sup>

<sup>247</sup> You can access the text at [www.sice.oas.org/Trade/CHL\\_THA\\_Final/Annex\\_11.9\\_e.pdf](http://www.sice.oas.org/Trade/CHL_THA_Final/Annex_11.9_e.pdf)

<sup>248</sup> You can access the text at [www.sice.oas.org/Trade/CHL\\_HKG\\_FTA/Index\\_PDF\\_e.asp](http://www.sice.oas.org/Trade/CHL_HKG_FTA/Index_PDF_e.asp)

<sup>249</sup> You can access the text at [www.efta.int/about-efta/european-free-trade-association](http://www.efta.int/about-efta/european-free-trade-association)

in 2008) only mention GIs without establishing any protection standards.

The **Colombia–Northern Triangle** FTA<sup>250</sup> offers relevant GI provisions and states in Annex 3-16 that:

El Salvador, Guatemala, and Honduras shall recognise *tequila* and *mezcal* as distinctive products of Mexico for purposes of standards and labelling. Accordingly, El Salvador, Guatemala and Honduras shall not permit the sale of any product as *tequila* or *mezcal* unless it has been produced in Mexico in accordance with their laws and regulations regarding the production of *tequila* and *mezcal*.

**Colombia and Peru** signed an FTA with the **European Union** (EU). The list of GIs exchanged and presented in Annex XIII<sup>251</sup> is long, and mostly contains EU GIs. For Colombia and Peru, the number of GIs is smaller, as shown in Table 6.

**Table 6 - Colombian and Peruvian GIs protected by the Colombia and Peru–European Union FTA**

<b>Colombia</b> (Appendix 1, letter a)	<i>Cholupa del Huila</i> (fruit)
<b>Colombia</b> (Appendix 2, letter a)	<i>Guacamayas</i> (handicrafts)
<b>Peru</b> (Appendix 1, letter c)	<i>Maíz Blanco Gigante Cusco</i> (vegetable) <i>Pallar de Ica</i> (vegetable) <i>Pisco</i> (spirits)
<b>Peru</b> (Appendix 2, letter b)	<i>Chulucanas</i> (pottery)

<sup>250</sup> The Northern Triangle of Central America is the name given to Guatemala, Honduras, and El Salvador.

<sup>251</sup> You can access the text at [www.acuerdoscomerciales.gob.pe/En\\_Vigencia/Union\\_Europea/Documentos/ingles\\_2012\\_06/anexo\\_XIII.pdf](http://www.acuerdoscomerciales.gob.pe/En_Vigencia/Union_Europea/Documentos/ingles_2012_06/anexo_XIII.pdf)

It should be noted that the list has two appendices: the first refers to agri-food products, wines, spirits, and aromatised wines, while the second includes other products. Regarding these GIs, Article 207 provides that:

- (d) geographical indications for products other than agricultural foodstuffs products, wines, spirit drinks or aromatised wines listed in Appendix 1 of Annex XIII (Lists of Geographical Indications) may be protected according to the laws and regulations applicable in each Party.<sup>252</sup>

Finally, it is appropriate to comment on the FTA signed between two countries under study: the **Colombia–Costa Rica** FTA. Through this Agreement, the parties shall ensure, in their national legislations, adequate and effective means to protect geographical indications, including designations of origin. As part of the Agreement, Annex 9-A presents the GIs subject to protection, as listed in Table 7.

**Table 7 - GIs protected by the Colombia–Costa Rica FTA**

<b>Colombia</b> (Section a)	<i>Cestería en Rollo de Guacamayas</i> <i>Cerámica Artesanal de Ráquira Colombia</i> <i>Tejeduría San Jacinto</i> <i>Sombrero Aguadeño</i> <i>Mopa Mopa Barniz de Pasto</i> <i>Tejeduría Wayuu</i> <i>Tejeduría Zenú</i> <i>Sombreros de Sandoná</i> <i>Cerámica del Carmen de Viboral</i> <i>Queso del Caquetá</i> <i>Queso Paipa</i> <i>Café de Colombia</i> <i>Café de Nariño</i> <i>Café de Cauca</i> <i>Bizcocho de Achira del Huila</i> <i>Cholupa del Huila</i> <i>Clavel de Colombia</i> <i>Rosa de Colombia</i> <i>Crisantemo de Colombia</i>
<b>Costa Rica</b> (Section b)	<i>Banano de Costa Rica (GI)</i> <i>Café de Costa Rica (GI)</i>

<sup>252</sup> You can access the text at [www.acuerdoscomerciales.gob.pe/En\\_Vigencia/Union\\_Europea/Documentos/ingles\\_2012\\_06/07\\_titulo\\_VII.pdf](http://www.acuerdoscomerciales.gob.pe/En_Vigencia/Union_Europea/Documentos/ingles_2012_06/07_titulo_VII.pdf)

The FTAs signed by Costa Rica both individually and jointly, as part of the Central American countries, are shown in Table 8 below. In total, there are twelve FTAs, two of which deal with intellectual property in general terms. Five others mention GIs in general terms, and five contain specific provisions on GIs. One of these, the **Costa Rica–Colombia** FTA, was discussed above together with the other FTAs to which Colombia is a signatory.

**Table 8 - FTAs signed by Costa Rica**

<b>Year</b>	<b>FTA</b>	<b>Provisions relevant to the study</b>	<b>Legal provision</b>
2011	Central America–Mexico	Specific GIs	Arts 16.19 and 16.20 / Annexes 16.19(a) and 16.19(b)
2012	Central America–EU	Specific GIs	I Section C - Arts 242-250 / Annex XVII
2010	Costa Rica–China	Specific GIs	Art 116 / Annexes 9 and 10
2011	Costa Rica–Peru	Specific GIs	Art 9.4 / Annex 9.4
2013	Costa Rica–Colombia	Specific GIs	Chapter 9 / Annex 9-A
1999	Central America–Chile	GIs in general	Art 3.12
2001	Costa Rica–Canada	GIs in general	Art III.9
2002	Central America–Panama	GIs in general	Art 3.12
2004	Central America–USA–Dominican Republic	GIs in general	Art 15.3
2010	Costa Rica–Singapore	GIs in general	Art 13.5
1998	Central America–Dominican Republic	IP in general	Arts 14.1 and 14.2
2013	Central America–EFTA	IP in general	Art 6.1

Article 3.12 of the **Central America–Chile** FTA provides that each Party shall recognise and protect the GIs and DOs of another Party and

shall not allow the import, manufacture, or sale of a good that uses a geographical indication or designation of origin protected in another Party, unless it has been produced and certified in that Party under its legislation applicable to that good.

The **Central America–Mexico** FTA<sup>253</sup> incorporates a short list of GIs,<sup>254</sup> including only *Banano de Costa Rica* for this country. However, the Agreement has a special provision concerning Mexico which states that the Parties not granting protection to geographical indications and designations of origin through the Lisbon Agreement recognise *Tequila* and *Mezcal* as distinctive products of Mexico for the purposes of standards and labelling. Likewise, Article 16.19.2 provides that:

Any Party granting protection to geographical indications and designations of origin in Annexes 16.19(a) and 16.19(b) through the Lisbon Agreement shall maintain that protection. These geographical indications and designations of origin shall also enjoy the protection provided for in Article 16.20.3. The protection granted under this paragraph shall extend to geographical indications and designations of origin that, after the entry into force of this Agreement, are protected through the Lisbon Agreement by the Parties or in accordance with the domestic law and procedures of the other Party.

This implies that, while only *Banano de Costa Rica* is listed because it was the only GI registered in Costa Rica at the time of signing the Agreement, those subsequently registered are also considered covered.

In the **Central America–European Union** Association Agreement signed in 2012, the provisions are among the most complete of all the FTAs under analysis. Annex XVII contains the GIs to be protected following the procedure of the parties; once protected, they are included in Annex XVIII. Under Resolution 5/2014, the EU–Central America Association Council defined the GIs to be incorporated in the Annex, since the EU GIs are protected in Central America and the Central American ones in the European Union. For Costa Rica, *Banano de Costa Rica* and *Café de Costa Rica* are included.

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<sup>253</sup> You can access the text at

<[www.sice.oas.org/Trade/CACM\\_MEX\\_FTA/Text\\_s.asp#Secci%C3%B3nIndicacionesGeogr%C3%A1ficasyDenominacionesdeOrigen](http://www.sice.oas.org/Trade/CACM_MEX_FTA/Text_s.asp#Secci%C3%B3nIndicacionesGeogr%C3%A1ficasyDenominacionesdeOrigen)>

<sup>254</sup> The text can be accessed at

<[www.sice.oas.org/Trade/CACM\\_MEX\\_FTA/Annexes/01\\_Anexo%2016.19%20\(a\)%20Indicaciones%20geograficas%20y%20denominaciones%20de%20origen%20de%20Centroamerica.pdf](http://www.sice.oas.org/Trade/CACM_MEX_FTA/Annexes/01_Anexo%2016.19%20(a)%20Indicaciones%20geograficas%20y%20denominaciones%20de%20origen%20de%20Centroamerica.pdf)> and

<[www.sice.oas.org/Trade/CACM\\_MEX\\_FTA/Annexes/02\\_Anexo%2016.19%20\(b\)%20Indicaciones%20geograficas%20y%20denominaciones%20de%20origen%20de%20de%20Mexico.pdf](http://www.sice.oas.org/Trade/CACM_MEX_FTA/Annexes/02_Anexo%2016.19%20(b)%20Indicaciones%20geograficas%20y%20denominaciones%20de%20origen%20de%20de%20Mexico.pdf)>

The **Costa Rica–China** FTA contains a list of twenty-three GIs from China and ten from Costa Rica<sup>255</sup> to be protected: *Banano de Costa Rica* (banana of Costa Rica), *Café de Costa Rica* (coffee of Costa Rica), *Guanacaste Madera* (wood), *Orosi* (coffee), *Tres Ríos* (coffee), *Turrialba* (coffee), *Valle Occidental* (coffee), *Brunca* (coffee), *Valle Central* (coffee), and *Guanacaste* (coffee).

The **Costa Rica–Peru** FTA lists only the *Banano de Costa Rica* for Costa Rica,<sup>256</sup> as it was the only GI registered in Costa Rica when the FTA was signed with Peru. In the case of Peru, there are seven GIs: *Pisco* (DO), *Maíz Blanco Gigante Cusco* (DO), *Chulucanas* (DO), *Pallar de Ica* (DO), *Café Villa Rica* (DO), *Loche de Lambayeque* (DO), *Café Machu Picchu-Huadquiña* (DO).

As for **Mexico**, there are nine FTAs in total, as shown in Table 9, of which four deal specifically with GIs. The **Mexico–Uruguay** and **Mexico–Central America** FTAs are mentioned above.

**Table 9 - FTAs signed by Mexico**

Year	FTA	Provisions relevant to the study	Legal provision
2003	Mexico–Uruguay	Specific GIs	Arts 15-22 / Annex <i>Tequila</i> and <i>Mezcal</i>
2000	Mexico–Israel	Specific GIs	Art 2.05 / Annex 2.05 ( <i>Tequila</i> and <i>Mezcal</i> )
2004	Mexico–Japan	Specific GIs	Art 8 / Annex 3
2011	Mexico–Central America	Specific GIs	Arts 16.19 and 16.20 / Annexes 16.19(a) and 16.19(b)
2004	Mexico–Panama	GIs in general	Arts 15.4 -15.7
2000	Mexico–EFTA	IP in general	Art 69
1997	Mexico–EU	IP in general	Art 12
2010	Mexico–Bolivia	None	N/A
2005	Mexico–Peru	None	N/A

<sup>255</sup> The text can be accessed at [www.sice.oas.org/Trade/CRI\\_CHN\\_FTA/Texts\\_Apr2010\\_s/Anx\\_9\\_CHN\\_Indic\\_Geo.pdf](http://www.sice.oas.org/Trade/CRI_CHN_FTA/Texts_Apr2010_s/Anx_9_CHN_Indic_Geo.pdf) and

[www.sice.oas.org/Trade/CRI\\_CHN\\_FTA/Texts\\_Apr2010\\_e/Annx\\_10\\_en.pdf](http://www.sice.oas.org/Trade/CRI_CHN_FTA/Texts_Apr2010_e/Annx_10_en.pdf) >

<sup>256</sup> You can access the text at

[www.sice.oas.org/Trade/CRI\\_PER\\_FTA\\_s/Text\\_CRI\\_PER\\_s.asp#a94](http://www.sice.oas.org/Trade/CRI_PER_FTA_s/Text_CRI_PER_s.asp#a94)>

In the **Mexico–Israel** FTA, Annex 2.05 contains a clause that states:

Israel shall recognize Tequila and Mezcal as geographical indications or appellations of origin of Mexico in respect to beverages. Therefore, Israel, in accordance with its legislation, shall ensure Mexico the legal means to enforce those rights against any import, manufacture or sale of any beverage, as Tequila or Mezcal, that is not manufactured in accordance with the Mexican laws and regulations applicable to those geographical indications or appellations of origin.

In the **Mexico–Japan** FTA, the list is not very long. Annex 3 informs that the protection is intended, in the case of Japan, for the GIs *Iki*, *Kuma*, and *Ryukyu* as specified in accordance with the existing laws and regulations of Japan. For **Mexico**, the Annex refers to the GIs *Tequila* and *Mezcal* as specified in accordance with the existing laws and regulations of Mexico.

**Peru** has signed fifteen FTAs between 2005 and 2015. Four do not include intellectual property rules. One deals with intellectual property in general. Two address GIs in general, and eight have provisions supplemented by GI listings, as observed in Table 10.

**Table 10 - FTAs signed by Peru**

Year	FTA	Provisions relevant to the study	Legal provision
2008	Peru–Canada	Specific GIs	Art 212 / Annex 212
2009	Peru–China	Specific GIs	Art 16 / Annex X
2010	Peru–Korea	Specific GIs	Art 17.6 / Annex 17A
2001	Peru–Costa Rica		Art 9.4 / Annex 9.4
2011	Peru–Japan	Specific GIs	Art 177 / Annex 10
2011	Peru–Panama	Specific GIs	Art 9.4 / Annex 9.4
2012	Peru and Colombia–EU	Specific GIs	Arts 207-214 / Annex XIII
2015	Peru–Honduras	Specific GIs	Art 9.4 / Annex 9.4
2006	Peru–USA	GIs in general	Art 16.3
2008	Peru–EFTA	GIs in general	Art 6.7
2005	Peru–Mercosur	IP in general	Art 32
2005	Peru–Mexico	None	N/A
2006	Peru–Chile	None	N/A
2008	Peru–Singapore	None	N/A
2008	Peru–Thailand	None	N/A

The **Peru–Costa Rica** and **Peru and Colombia–European Union** FTAs are discussed above. In the **Peru–Canada** FTA, in addition to the Canadian GI, only *Pisco* is listed as a Peruvian GI to be recognised and protected in Canada.<sup>257</sup> In the **Peru–China** FTA, Peru has indicated four GIs: *Pisco Perú*, *Cerámica de Chulucanas*, *Maíz Blanco Gigante Cusco*, and *Pallar de Ica*.<sup>258</sup> The **Peru–Korea** FTA, signed in 2010, shows a great disparity between Korea’s list, with eighty-two GIs, and Peru’s list, with only four GIs<sup>259</sup> (the same as in the FTA with China).

The **Peru–Japan** FTA only covers GIs for wines and spirits. Therefore, it only lists *Pisco* for Peru and, on the Japanese side, *Iki*, *Kuma*, *Ryukyu*, and *Satsuma* for spirits.<sup>260</sup> In the **Peru–Panama** FTA, seven GIs are listed for Peru: *Pisco* (DO), *Maíz Blanco Gigante Cusco* (DO), *Chulucanas* (DO), *Pallar de Ica* (DO), *Café Villa Rica* (DO), *Loche de Lambayeque* (DO), and *Café Machu Picchu-Huadquiña* (DO). Panama has one GI in its list: *SECO* (indication of source). Finally, the **Peru–Honduras** FTA presents the seven Peruvian GIs (in the FTA with Panama) and includes one more: *Maca Junín-Pasco* (DO). Honduras has only coffees in its list of six GIs.<sup>261</sup>

### 3.2. FREE TRADE AGREEMENTS UNDER NEGOTIATION OR ABOUT TO BECOME EFFECTIVE

As a supplement to the information on free trade agreements or bilateral agreements to which at least one of the countries studied is a party, Table 11 below presents the agreements under negotiation, or already concluded but not yet in force.

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<sup>257</sup> You can access the text at

<[www.sice.oas.org/Trade/CAN\\_PER/CAN\\_PER\\_e/CAN\\_PER\\_text\\_e.asp](http://www.sice.oas.org/Trade/CAN_PER/CAN_PER_e/CAN_PER_text_e.asp)>

<sup>258</sup> You can access the text at

<[www.sice.oas.org/Trade/PER\\_CHN/PER\\_CHN\\_e/Anx10.pdf](http://www.sice.oas.org/Trade/PER_CHN/PER_CHN_e/Anx10.pdf)>

<sup>259</sup> You can access the text at

<[www.sice.oas.org/tpd/per\\_kor/per\\_kor\\_texts\\_e/17\\_KPFTA\\_IP.pdf](http://www.sice.oas.org/tpd/per_kor/per_kor_texts_e/17_KPFTA_IP.pdf)>

<sup>260</sup> You can access the text at

<[www.sice.oas.org/Trade/PER\\_JPN/EPA\\_Texts/ENG/C11a\\_Geo\\_e.pdf](http://www.sice.oas.org/Trade/PER_JPN/EPA_Texts/ENG/C11a_Geo_e.pdf)>

<sup>261</sup> You can access the text at

<[www.sice.oas.org/Trade/CACM\\_PER/HND\\_PER/Capitulo\\_9\\_propiedad\\_intelectual\\_s.pdf](http://www.sice.oas.org/Trade/CACM_PER/HND_PER/Capitulo_9_propiedad_intelectual_s.pdf)>



**Table 11 - Other Agreements (under negotiation or about to become effective)**

<b>Concluded (C) Under negotiation (UN)</b>	<b>Agreement</b>
<b>2016 (C)</b>	Mexico–Brazil
<b>2018 (C)</b>	Brazil–Chile
<b>2019 (C)</b>	Mercosur–European Union
<b>2017 (C)</b>	Mexico–European Union
<b>2017 (UN)</b>	Mercosur–EFTA
<b>2018 (UN)</b>	Pacific Alliance–New Zealand <sup>262</sup>
<b>2019 (UN)</b>	Chile–European Union

In 2019, the **European Union and Mercosur** reached an ‘agreement in principle’ after more than 20 years of negotiations as part of a broader Association Agreement between the two integrated spaces. The Agreement, in addition to reducing import tariffs and addressing trade issues, includes chapters on other disciplines to ensure market access for the Parties.

As far as intellectual property rights are concerned, it refers to all the IP categories covered by Sections 1 to 7 of Part II of the TRIPS Agreement and to copyrights and related rights, trademarks, designs and patents, geographical indications, plant varieties, trade secrets, and undisclosed information. It is also stated that the protection of intellectual property rights includes protection against unfair competition under Article 10 of the Paris Convention for the Protection of Industrial Property and the signatories’ adherence to the minimum standards as established in the TRIPS Agreement. Regarding GIs, standards are established for the protection of reciprocally recognised GIs in Annex B, including 350 indications of the EU and 250 of Mercosur.

Another treaty under negotiation is the **Mercosur–EFTA** agreement. As in the FTA with the EU, within the framework of this FTA, tariff reductions and trade disciplines have been negotiated and there are IP-related rules, including specific provisions on GI protection standards. The Parties also recognise each other’s GI lists. According to the notes by the EFTA Secretariat, GI recognition will be part of the intellectual property chapter. The Agreement is likely to involve an exchange of lists, as Liechtenstein, Switzerland and Mercosur have agreed to include lists of GIs to be protected in the Agreement. Further details on the intellectual property chapter and the GI protection in the

<sup>262</sup> The Pacific Alliance is a Latin American trade bloc formed by Chile, Colombia, Mexico, and Peru.

Agreement are not yet available. In conclusion, both agreements aim to protect GIs between the respective Parties after their eventual signature and ratification.

The update of the **Mexico–European Union Agreement**<sup>263</sup> states that the EU shall receive exclusive GI protection for products not included in the original Agreement, such as Parma ham and balsamic vinegar from Modena. The new agreement is intended to prohibit the marketing of 340 GIs from the EU in the territory of Mexico. This will give these products a level of protection similar to that which they have in the EU. These products are additional to the EU geographical indications for wines and spirits already protected in Mexico.

In the case of the negotiations between the **Pacific Alliance (Chile, Peru, Colombia, and Mexico)** and **New Zealand**, there is no GI information available in the agreement. It is generally known that IP-specific proposals will reflect the current national policies and legislative environments, taking into account the need to maintain adequate flexibility to ensure that these environments remain properly calibrated over time for a small net importer of intellectual property seeking to encourage innovation and creativity.<sup>264</sup>

The update of the **Chile–EU Agreement**<sup>265</sup> under negotiation aims to modernise the existing agreement that does not address some aspects of trade and investment, non-tariff restrictions, certain GIs, and the contribution to sustainable development. The modernised EU–Chile Association Agreement is expected to include the protection and recognition of GIs for agricultural products other than wines and spirits, not included in the original agreement.

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<sup>263</sup> European Commission, ‘Acuerdo comercial UE-México’ (2018) <[https://trade.ec.europa.eu/doclib/docs/2018/april/tradoc\\_156755.pdf](https://trade.ec.europa.eu/doclib/docs/2018/april/tradoc_156755.pdf)> accessed 28 December 2021.

<sup>264</sup> You can access the text at <[www.mfat.govt.nz/en/trade/free-trade-agreements/agreements-under-negotiation/new-zealand-pacific-alliance-free-trade-agreement/what-we-are-negotiating/#intellectualproperty](http://www.mfat.govt.nz/en/trade/free-trade-agreements/agreements-under-negotiation/new-zealand-pacific-alliance-free-trade-agreement/what-we-are-negotiating/#intellectualproperty)>

<sup>265</sup> You can access the text at <[www.consilium.europa.eu/en/press/press-releases/2018/01/22/eu-chile-association-agreement-negotiating-directives-made-public/](http://www.consilium.europa.eu/en/press/press-releases/2018/01/22/eu-chile-association-agreement-negotiating-directives-made-public/)>

### 3.4. BILATERAL AGREEMENTS

The objective of the **Mexico–Brazil** Agreement<sup>266</sup> is the mutual protection of *Cachaça* and *Tequila* as GIs in the respective countries. In addition, **Brazil** is negotiating trade agreements on a bilateral or regional basis with several countries. There is no information on their negotiated content.

Those with accessible content include the following referring to GIs. In the **Brazil–Chile** Agreement, the countries undertake to ensure in their legal order ‘adequate and effective means to protect geographical indications for any product, consistently with the TRIPS Agreement’ (Article 19.5.2). Countries must provide the means for any person (including natural persons) to apply for protection of geographical indications (Article 19.5.3). When a GI is homonymous with the geographical designation located outside the territory of the Parties, each Party may allow its use to describe and present wines, spirits, or aromatised drinks of the geographical area to which it refers, if it has been traditionally and consistently used, its use for these purposes is regulated by the country of origin, and the homonymous indication concerned is not misrepresented to consumers as originating in the Party concerned (Article 19.5.4). In addition, Chile protects *Cachaça* as a Brazilian geographical indication, and Brazil protects *Pisco* as a Chilean geographical indication under the homonymy provisions in the TRIPS Agreement. This is without prejudice to the recognition that Brazil, in addition to Chile, could grant exclusively to Peru for *Pisco* (Article 19.5.5).

The TRIPS-plus level of protection (standards beyond the minimum standards of the TRIPS Agreement) has been incorporated in many FTAs. Such a demand, in some cases, may be a ‘trade-off’ for better market access conditions and may limit the governments’ ability to use the TRIPS flexibilities. TRIPS-plus initiatives on GIs by ‘GI-friendly’ countries are no longer limited to the multilateral negotiations under the WTO Doha mandate, which expect to extend the higher level of GI protection granted to wines and spirits to other agri-food products, and the adoption of an international register of geographical indications with legal effects in participating and non-participating countries.

These initiatives have become a demand in bilateral and bi-regional trade negotiations. The TRIPS-plus commitments include invalidating trademarks in favour of GI protection, abandoning terms that have become generic in common language, prohibiting the use of terms that are plant varieties, and the ex officio border control of products possibly infringing a GI by national customs. Some examples

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<sup>266</sup> You can access the text at

<[www.gob.mx/cms/uploads/attachment/file/122431/acuerdo\\_mexico\\_brasil\\_para\\_el\\_reconocimiento\\_mutuo\\_del\\_tequila\\_y\\_la\\_cachaza.PDF](http://www.gob.mx/cms/uploads/attachment/file/122431/acuerdo_mexico_brasil_para_el_reconocimiento_mutuo_del_tequila_y_la_cachaza.PDF)>

of TRIPS-plus commitments through FTAs are the 1997 EU–Mexico Agreement<sup>267</sup> and the EU–Chile Agreement.<sup>268</sup>

### 3.4. NATIONAL-LEVEL STUDIES ON THE INCIDENCE OF ADOPTING GI SYSTEMS

Although GI protection systems have been implemented in the nine countries participating in this study since January 2000, when the TRIPS Agreement entered into force for developing countries, regarding the existence of studies, statistics, or any other source of written knowledge on GIs, it was only possible to locate specific information on **Brazil**. For the rest of the countries under study, no studies, statistics on the trade evolution of GI-related products, or comparative studies have been identified to evaluate the context prior to the inclusion of GI rights in the national legislation, and the current situation. In **Peru**, statistical information for the *Pisco DO*<sup>269</sup> can be found on the GI website, and there is no information available for the other DOs.

In connection with **Brazil**, two relevant studies were found to verify the evolution of products linked to geographical indications. They cover the trade and social evolution of these products, and the first study also includes the environmental evolution in the production region. This study, called ‘*Metodologia de Avaliação de Impactos Econômicos, Sociais e Ambientais para Indicações Geográficas - O Caso do Vale dos Vinhedos*’,<sup>270</sup> consists of a proposal for a GI impact assessment methodology based on the geographical indication *Vale dos Vinhedos* for wines, which was the first Brazilian GI registered (in 2002 as an indication of source and in 2012 as a designation of origin<sup>271</sup>).

The study used the following indicators: a) economic indicators: income (profit), property size, sales evolution, market share growth, land price evolution, average production price evolution, labour force profile evolution, credit access, property structure evolution, investments made to improve production quality,

<sup>267</sup> In 1997, Mexico and the EU signed an Agreement on Designations for Spirit Drinks under which both parties agreed to grant protection to the DOs for certain spirits such as *Tequila* and *Mezcal*, Whisky, Grappa, and Cognac.

<sup>268</sup> Section 6 of the 2002 Agreement has established an Association between the EC and Chile for trade in spirits and aromatised drinks. The Agreement contains provisions on geographical indications and specifies the names for their protection.

<sup>269</sup> CONAPISCO, <<https://conapisco.org.pe/>> accessed 28 December 2021.

<sup>270</sup> Loiva Maria Ribeiro de Mello and others, ‘Metodologia de avaliação de impactos econômicos, sociais e ambientais para indicações geográficas: o caso do Vale dos Vinhedos’ (2014) Embrapa Uva e Vinho <[www.embrapa.br/busca-de-publicacoes/-/publicacao/1003871/metodologia-de-avaliacao-de-impactos-economicos-sociais-e-ambientais-para-indicacoes-geograficas-o-caso-do-vale-dos-vinhedos](http://www.embrapa.br/busca-de-publicacoes/-/publicacao/1003871/metodologia-de-avaliacao-de-impactos-economicos-sociais-e-ambientais-para-indicacoes-geograficas-o-caso-do-vale-dos-vinhedos)> accessed 28 December 2021.

<sup>271</sup> This is no longer possible.

production/productivity growth, tourism increase, benefit for the regional economy, growth in employment and collective infrastructure conditions; b) social indicators: opportunity for qualified local employment, access to education for people working or living in the productive unit, multifunctionality in rural areas, motivation in production, access to utility services for managers and employees, local amenities and equipment, place of residence of producers and housing improvement, population changes, tourism profile, preservation of historical and cultural heritage, evolution of education and training programmes, local associations related to GIs or created after the establishment of GIs, linkages between different actors, main benefits of the linkage between GI actors and the dynamics of the network of actors; c) environmental indicators: land occupation, water use for consumption and production, pesticide use evolution, organic fertilizer use evolution, chemical fertilizer use evolution, and the practice of agrochemical application.

Despite recognising that the absence of quantitative data for the period before the establishment of the GI (which were only estimated or considered based on the subjective memory of specific individuals) reduces the precision and reliability of the results, the study concludes that ‘there are no substantial or objectively relevant impacts justifying the direct causal relationship between the creation of the *Vale dos Vinhedos* GI and territorial control’. Development in Vale dos Vinhedos during the 10 years analysed (2001-2010) was not related to the indication of source. In view of this, the authors suggest adopting coordinated public policies for the development of the GI together with territorial development.

The second study, entitled ‘*Indicações Geográficas e Desenvolvimento Local no Brasil: Estudo de Casos*’,<sup>272</sup> analyses the socioeconomic development of the regions in the case of three geographical indications: *Vale dos Vinhedos* for wines, *Cerrado Mineiro Region* for coffee (first as an indication of origin, then converted into a designation of origin), and *Paraty* for cachaca (designation of origin). Despite noting a growth in tourism activities indirectly related to the GIs in Vale dos Vinhedos and Paraty, the study concludes that the impact of the GIs on the respective local economies, each for its own reasons, is low and has little influence on the labour market. The authors point out that, in the three cases studied, there are coordination failures between the primary and secondary levels related to the productive sectors of the products distinguished by the GIs. As in the previous study, they conclude that the lack of coordinated public or

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<sup>272</sup> Luiz Claudio de Oliveira Dupim and Lia Hasenclever, ‘Indicações Geográficas e Desenvolvimento Local no Brasil: Estudo de Casos’ in Liliana Locatelli (ed), *Indicacoes Geográficas - Desafios e Perspectivas nos 20 anos da Lei de Propriedade Industrial* (2016).

sectoral policies related to GIs hinders the achievement of the intended objectives.

The authors consider that the GI system in Brazil is immature because GI experiences are recent. They also find that knowledge about collective intellectual property is reduced and incomplete since there is no coordinated structure for valuing GIs. This study used the following indicators: a) economy: local production, increased demand, greater financial profitability; b) employment: creation of direct and indirect jobs, reduced rural exodus; c) culture and quality: preservation of know-how, improved quality of life; d) governance: regional cooperation, strengthening of local institutions, greater coordination among economic actors.

Although the two studies above are relevant, there is no comparative study between the context before the inclusion of national legislation and the current situation. Both studies indicate great difficulties in obtaining empirical data, mainly for the period before the respective GIs' registration. In the first study, for example, the data were expressly estimated or based on the subjective memory of the persons involved. Therefore, there are reasons to doubt whether there is sufficient information in Brazil to conduct a comprehensive study on the social and economic effects of introducing the GI in the legal system. It is also uncertain whether it would be possible to obtain relevant data to satisfy the indicators in specific regions affected by a GI. The answer would depend on a case-by-case analysis.

In any case, more significant results could certainly be obtained if the studies were to consider not just GIs/DOs but all distinctive signs for collective use capable of differentiating production and adding value at origin.

#### **4. ELEMENTS EMERGING FROM THE COMPARISON OF THE NATIONAL REPORTS**

As seen in section 3, the commitments established in the TRIPS Agreement and international treaties have been incorporated by the countries into their national legislation. Under the TRIPS Agreement, countries are free to establish the appropriate method for implementing these commitments within the framework of their own legal system and practice.<sup>273</sup> In this regard, the national system organisation in the Latin American countries shows legislative differences and similarities among those countries. Likewise, signing FTAs containing GI commitments leads to adapting the national legislation for their

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<sup>273</sup> WTO (n 4) art 1.

incorporation, which also gives rise to differences and similarities among the countries under study.

The following are some aspects of the national legislation comparison that are interesting as preliminary identification of coincidences with a view to possible regional coordination/ cooperation in this area.

In the case of food and considering the undisputed leading role that Latin America plays as a supplier to the world, it makes special sense to consider a regional approach to the role of distinctive signs of quality in the face of the new global challenges:<sup>274</sup> the goals of sustainable development, healthy food, food security, and food system transformation to eradicate hunger, among others.

#### 4.1. DISTINCTIVE SIGNS OTHER THAN GI'S/DO'S

In all the countries under study, there are distinctive signs that constitute differentiation systems other than GIs and DOs. Priority was given to collective marks and certification marks. Seals, signs, isologues, emblems were also identified, and, in Peru, there is the figure of traditional expressions guaranteed (TEGs).

In certain cases, those distinctive signs are linked to the trademark system, which is not unusual since, before the TRIPS Agreement made GI protection mandatory, Latin American countries mostly differentiated their products through the trademark system or derived forms of protection. It is also observed that, in most countries studied, distinctive signs protect not only goods but also services.

It is interesting to note that distinctive signs differentiate not only by territory but also, in certain cases, by producer, production process, or traditional practice contained in the product or service.

#### 4.2. INCORPORATION OF TRIPS COMMITMENTS INTO NATIONAL LEGISLATION

As can be seen from the national reports, the countries studied have incorporated the GI-related obligations of the TRIPS Agreement (Articles 22 and 23) by adopting a *sui generis* system, creating specific legislation for the protection of GIs and DOs, and establishing procedures for the recognition of rights and registers for their protection. It also follows that national systems and registers coexist with trademark protection systems and that there is a regulated

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<sup>274</sup> United Nations, 'The Impact of COVID-19 on Food Security and Nutrition' (2000) <<https://data.unicef.org/resources/jme-report-2020/>> accessed 28 December 2021.

coexistence of the protection provided by both systems, with some country-to-country variations.

Regarding regional law as an instrument of harmonisation between the different Latin American countries that form regional integration schemes, we noted that only the Andean Community (CAN)<sup>275</sup> has a regional rule that incorporates TRIPS obligations in this area and, therefore, creates uniform rules for all its member countries. Other regional integration schemes like the Southern Common Market (MERCOSUR),<sup>276</sup> the Latin American Integration Association (ALADI),<sup>277</sup> and the Central American Integration System (SICA)<sup>278</sup> do not have harmonised regulations in this area.

On the other hand, it is observed that some countries in the region that have signed free trade agreements with other regions or countries outside the region recognise these treaties as a source of law. Therefore, the GIs/DOs recognised through them are not always incorporated into the existing national registers but are regulated under the legal umbrella of their respective FTA. For example, GIs and DOs recognised by Chile in free trade agreements and bilateral agreements are not necessarily part of the Chilean national register. These agreements recognise foreign GIs or DOs, and the effective protection depends on the agreement itself and the domestic laws in force. Thus, if the foreign products are not included in the INAPI register, they will be protected by administrative actions such as border control of labelling by the SAG (Agriculture and Livestock Service). In other cases, it will be the treaty itself that establishes the conditions of use of the GI and DO which it recognises.

It should also be noted that several countries in the region have incorporated the TRIPS commitments at the national level, maintaining the differentiation in the levels of protection established in Articles 22 and 23. However, as a result of signing FTAs or international treaties like the Lisbon Agreement, some countries have tended to unify the level of protection, granting exclusivity not only to wine products and spirits but also to the rest of the products.

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<sup>275</sup> Comunidad Andina de Naciones, CAN Portal <[www.comunidadandina.org/notas-de-prensa/wagner-afirma-que-la-integracion-debe-ser-un-proceso-eminente-participativo/](http://www.comunidadandina.org/notas-de-prensa/wagner-afirma-que-la-integracion-debe-ser-un-proceso-eminente-participativo/)> accessed 28 December 2021.

<sup>276</sup> Mercado Común del Sur, MERCOSUR Portal <[www.mercosur.int/documentos-y-normativa/normativa/](http://www.mercosur.int/documentos-y-normativa/normativa/)> accessed 28 December 2021.

<sup>277</sup> Asociación Latino Americana de Integración, ALADI Portal <[www.aladi.org/sitioaladi/](http://www.aladi.org/sitioaladi/)> accessed 28 December 2021.

<sup>278</sup> Sistema de la Integración Centroamericana, SICA Portal <[www.sica.int/sgsica/inicio](http://www.sica.int/sgsica/inicio)> accessed 28 December 2021.



As for the scope of protection, it can be observed that, in some countries, protection covers not only agricultural products but also non-agricultural and artisanal products. Some countries under study also include services, as is the case of Uruguay, Brazil, and Costa Rica.

In general, in addition to the GI regulated by the TRIPS Agreement, the countries incorporate in their legislation the figures of the DO and the indication of source, and it is observed that only GIs and DOs are eligible for protection, whose level is linked to the type of product. This differentiation points mainly to the different requirements for recognition.

When considering the crystallisation of protection at the level of registration systems, it is found that, in all the countries studied, registration is structured nationwide, and the protection granted has national scope. In some cases, such as Argentina and Chile, the registration systems as an implementing authority are different for wines and spirits of vinous origin, and other agricultural products, differentiating the level of protection granted to them. In all other countries, registration is the same, although some countries have no differentiated levels of protection by product (eg Brazil) and others do (eg Uruguay). Some countries explicitly recognise as a source of law the GI/DO recognised through free trade agreements (eg Chile).

When analysing the ownership of the right, and the rights conferred, it is interesting to note that entities and producers may be holders of the right in almost all countries, whereas, in some others (including Mexico, Colombia, and Peru), the right is owned by the National State, which assigns use to individuals. In these cases, a distinction is drawn from foreign GIs/DOs, whose ownership is determined by their country of origin.

As for the term of protection, in the countries covered by this study, there is no time limit on the ownership of the right conferred by a GI/DO, but there is a time limit on the authorisation for use. Regarding the limits to GI/DO rights, the overlap of trademark rights with those arising from GIs/DOs is not possible. Almost all countries have express regulations preventing the registration of a GI/DO if there is a previous trademark, and vice versa. Trademark coexistence with GIs/DOs is not provided for in any legislation studied, except for Chile's.

In addition, several legislations (Chile, Colombia, Peru, and Mexico), contain an exception concerning the rights arising from GIs/DOs recognised by FTAs and the existing trademark rights. In this sense, cases were identified in which existing trademarks have been cancelled under FTAs for conflicting with the FTA-recognised GIs/DOs. In other cases, coexistence has been agreed, even though it is not provided for in the respective countries' national legislation. Interesting examples include the Latin American GIs *Café de Colombia*, *Pisco* (Peru), and *Tequila* (Mexico), which succeeded in

preventing trademarks from being granted by the European Union Intellectual Property Office (EUIPO).

A remarkable case is the conflict over *Manchego* cheese in the FTA negotiations between the EU and Mexico. Although it is not a conflict between a trademark and a GI but between a generic term and a GI, it generated much discussion. Farmers in central Spain make *Manchego* cheese from sheep milk under the protection of the EU's GI system. In Mexico, dairy producers make their own cheese and use the generic term *manchego*. This cheese is very different in its components and cheaper because it is made from cow milk. Finally, after lengthy negotiations, the agreement allows the continued use of the term *manchego* for Mexican producers, as long as the label clearly specifies the product's origin and ingredients.

All the countries studied have express rules on the impossibility of protecting a GI/DO when it is a generic term in their territory. However, also in this case, there is the FTA protection exception, under which a foreign GI/DO may be protected through an FTA, even if it is a generic term in the country concerned.

In several countries analysed, the use of terms such as 'similar', 'type', or 'class' is not permitted for wine products and spirits. In other cases, the legislation is silent on the matter, and it must be inferred from the regulatory framework whether their use is possible. The impact of the FTA commitments is also crucial here. Finally, in general, the legislation of the countries studied does not allow the use of a protected GI for information purposes.

## 5. PROPOSED LINES OF RESEARCH

From the elements identified in this comparative study, at least two lines of work emerge, which could become lines of research to be developed in the future based on the development of appropriate research questions and analysis methodologies.

- The first line of work would propose to address the universe of existing distinctive signs for collective use in Latin America from the dynamic, comprehensive, and inclusive view of the existing and future instruments that could strengthen the range of local development promotion tools, valuing origin and quality, and considering the particularities of the LA region.

This line of work could lead to:

- 1- **Mutual recognition system for distinctive signs in LA:** This line of research examines the relevance of adopting a regional system of mutual recognition of distinctive signs for collective use existing in LA countries, facilitating the protection of those products and services in all the countries participating in the system.
- 2- **Distinctive signs and differentiated needs:** This line of research considers the instruments in each country studied, and other options available in comparative law, and analyses their eligibility *vis-à-vis* the characteristics of the producer groups, the type of products/services to be valued, the associated traditional knowledge and customs, the characteristic production processes, the available genetic resources, among other specificities of the diverse LA regions.

This line could inquire into the relevance of strengthening instruments whose differentiation does not lie in the link to the terroir (those that identify a product or service as originating in a particular place) but in the particular characteristics of the production processes (eg organic production) or the actors in these processes (eg rural women).

- The second line of work relates to the system of geographical indications from the perspective of their incorporation into the national legislation of Latin American countries, and would have, in principle, two possible lines of research:

- 1- **The incorporation of TRIPS protection standards in LA:** This line of research analyses how LA countries have been incorporating TRIPS obligations into their domestic legislation, which has not been uniform. It would also be interesting to study the advantages and disadvantages of harmonising/coordinating criteria at the regional/sub-regional level.
- 2- **The incorporation of FTA commitments in LA:** This line of research analyses how LA countries have been incorporating the obligations derived from the commitments made in the FTAs they signed, which has not been uniform, either. This line would make it possible to examine the legal impact of the FTA commitments on the different countries and country groups in the region. It would also make it possible to study how the protection standards in force for local producers in the domestic legislation have been made compatible with the FTA protection given to foreign producers, and how the most-favoured nation clause (MFN clause) has played a role, through the application of TRIPS Article 4, in relation to such greater protection.

In summary, considering the diversity of productive regions and the disparity in the development needs of countries, regions, and producers

in Latin America, the protection instruments for goods and services, derived from adopting multilateral or regional commitments, must promote development and, concurrently, rooting and welfare adapted to each circumstance. A legal instrument of protection that is useful in some cases may be inadequate to stimulate productive capacity in others.

It is important to identify, adapt and create (if necessary) differentiation instruments that take into account the levels of development, provide differentiated and flexible protection, and adapt to the needs of each region and each producer group. In other words, the appropriate protection instrument must be a 'tailor-made suit' that values and enhances the available resources and meets the needs of each region and country.

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