

2009

Lessons Learned from Ethiopia's *Trademarking and Licensing Initiative*: Is the European Union's Position on Geographical Indications Really Beneficial for Developing Nations?

Mary O'Kicki

Follow this and additional works at: <http://lawcommons.luc.edu/lucilr>



Part of the [International Law Commons](#)

Recommended Citation

Mary O'Kicki *Lessons Learned from Ethiopia's Trademarking and Licensing Initiative: Is the European Union's Position on Geographical Indications Really Beneficial for Developing Nations?*, 6 Loy. U. Chi. Int'l L. Rev. 311 (2009).
Available at: <http://lawcommons.luc.edu/lucilr/vol6/iss2/2>

This Feature Article is brought to you for free and open access by LAW eCommons. It has been accepted for inclusion in Loyola University Chicago International Law Review by an authorized administrator of LAW eCommons. For more information, please contact law-library@luc.edu.

LESSONS LEARNED FROM ETHIOPIA'S *TRADEMARKING AND LICENSING INITIATIVE*: IS THE EUROPEAN UNION'S POSITION ON GEOGRAPHICAL INDICATIONS REALLY BENEFICIAL FOR DEVELOPING NATIONS?

Mary O'Kicki[†]

Abstract

This paper examines Ethiopia's *Trademarking and Licensing Initiative*; specifically, Ethiopia's choice to use trademarks and not Geographical Indications ("GIs") to protect its intellectual property rights in its heritage coffees. This paper argues that the European Union's ("EU") proposed greater protection of GIs and request for a multilateral registry of GIs may create a hurdle for developing nations to enter the worldwide market and, quite possibly, force developing nations to rely upon archaic agricultural methods instead of developing new, innovative farming techniques. It also argues that the EU's proposed "claw back" provision is, ultimately, a mechanism to extract a premium for what is, or was, Traditional Knowledge ("TK") of different European cultures and questions the possible consequences if the EU succeeds in its efforts to reclaim words that have become generic.

I. Introduction	312
II. Ethiopia	314
III. Ethiopia's Heritage Coffees	316
IV. Trademarks, Geographical Indications and Traditional Knowledge	318
A. Trademarks	318
B. Geographical Indications (GIs)	320
1. Geographical Indications in the United States	321
2. Geographical Indications in the EU and its member countries	322
3. The TRIPs Agreement and GIs	324
C. Traditional Knowledge (TK)	325
V. Ethiopia's Choice to Trademark its Heritage Coffees	327
VI. Ethiopia's Trademarking and Licensing Initiative	329
VII. Benefits of Trademark versus GI Certification	331
VIII. The World Wide Web: A Valuable Tool	332
IX. What Other Developing Nations Can Learn from Ethiopia	334
X. Conclusion	335

[†] J.D., UCLA School of Law 2008. The author thanks Stephen R. Munzer, Professor of Law, UCLA School of Law, for his support, guidance and instructive comments. The author also thanks the editors and staff of the Loyola University Chicago International Law Review.

I. Introduction

In 2005, the government of the Federal Republic of Ethiopia ("Ethiopia") filed trademark applications with the United States Patent and Trademark Office ("USPTO") for three of Ethiopia's heritage coffees: Harar,¹ Sidamo² and Yirgacheffe.³ The National Coffee Association ("NCA") filed an objection to the trademark contending that Sidamo was a generic term for coffee from the Sidamo region of Ethiopia and therefore did not meet the legal criteria to qualify for trademark registration. The NCA submitted over six hundred documents to support its claim.⁴ Despite the objection, USPTO granted the trademarks.⁵ To date, all twenty-six member countries of the EU have granted Ethiopia trademarks for all three terms and Japan has granted trademarks to Sidamo and Yirgacheffe.⁶

The worldwide filing of trademarks by a country that is still waiting for approval for accession into the World Trade Organization⁷ ("WTO") is both remarkable and noteworthy. Ethiopia's choice to use a trademark instead of a GI to protect its intellectual property rights ("IPRs") in an indigenous crop occurs at a pivotal time in the worldwide debate concerning the most effective way to protect IPRs for goods that are specific to a particular geographic region or locale. In 2003, the EU made an aggressive move to strengthen GI protection provisions in the Trade-Related Aspects of Intellectual Property Rights ("TRIPs") Agreement.⁸ The TRIPs Agreement⁹ is a multilateral agreement that governs the

¹ Ethiopia filed a separate application 'Harrar' which is an alternative spelling of 'Harar.' When the word 'Harar' is used in this paper, it also refers to 'Harrar.' U.S. Trademark Application Serial No. 78,589,319 (filed Mar. 17, 2005), available at <http://tess2.uspto.gov/bin/gate.exe?f=tess&state=jjjrrj.1.1>.

² U.S. Trademark Application Serial No. 78,589,307 (filed Mar. 17, 2005), available at <http://tess2.uspto.gov/bin/gate.exe?f=tess&state=jjjrrj.1.1>.

³ U.S. Trademark Application Serial No. 78,589,325 (filed Mar. 17, 2005), available at <http://tess2.uspto.gov/bin/gate.exe?f=tess&state=jjjrrj.1.1>.

⁴ National Coffee Association of U.S.A., *NCA Statement on Ethiopian Coffee Trademarks*, <http://www.ncausa.org/custom/headlines/headlinedetails.cfm?id=488&returnto=1> (last visited Mar. 15, 2009). The United States Patent and Trademark Office [USPTO] Trademark Document Retrieval database has all six hundred documents. USPTO, TDR Database, <http://tmportal.uspto.gov/external/portal/tow> (search U.S. Trademark Application Serial No. 78,589,307; then open "Administrative Response" dated Aug. 17, 2006).

⁵ U.S. Trademark No. 3,457,979 (filed July 1, 2008); U.S. Trademark No. 3,381,739 (filed Feb. 12, 2008); U.S. Trademark No. 3,126,053 (filed Aug. 8, 2006).

⁶ The trademarks have been registered with the Office for Harmonization in the Internal Market [OAMI] as community trade marks in the European Union. OAMI Trade Mark No. 004348777 (registered Feb. 14, 2006) (Harar); OAMI Trade Mark No. 004348751 (registered Feb. 27, 2008) (Sidamo); OAMI Trade Mark No. 004348744 (registered Feb. 14, 2006) (Yirgacheffe). Japan has also granted registration. Japan Trademark No. 4955560 (registered May 26, 2006) (Yirgacheffe); Japan Trademark No. 4955562 (registered May 26, 2006) (Yirgacheffe in Japanese) Japan Trademark No. 4955561 (registered May 26, 2006) (Sidamo); Japan Trademark No. 4955563 (registered May 26, 2006) (Sidamo in Japanese).

⁷ For example, Ethiopia filed for accession to the WTO in January 2003, almost two years before filing its U.S. trademark applications. The General Council established a Working Party to examine Ethiopia's application on February 10, 2003. The Memorandum on the Foreign Trade Regime was circulated in January 2007. The Working Party met on May 16, 2009. For Ethiopia's current WTO Accession Status, see http://www.wto.org/english/thewto_e/acc_e/a1_ethiopia_e.htm.

⁸ European Commission, External Trade, Trade Issues, *Intellectual Property: Special Names for Special Products*, Jan. 19, 2009, http://ec.europa.eu/trade/issues/sectoral/intell_property/argu_en.htm

availability, scope and use of intellectual property rights for WTO member countries. The EU contends that GIs are the preferred method to protect IPRs in agricultural goods that originate from a specific region.¹⁰ In 2003, the EU requested the development of a multilateral registry for GIs¹¹ and for the extension of the additional legal protections given to GIs for wines and spirits by the TRIPS Agreement to all GIs in the registry.¹²

The most controversial request by EU member countries is for the termination of the use of forty-one names of European-originated foods including, among others, *parmesan*, *Chablis*, and *bologna*, by manufacturers who are not located within the historical regions of origin of these food products.¹³ The “claw back” provision is supported mainly, if not entirely, by the EU¹⁴ and aims to “remove prior trademarks and, if necessary, grant protection for EU GIs that were previously used or have become *generic* so that [EU] GI products can gain market access.”¹⁵ The EU contends that these terms indicate well-established quality goods that are distinctive to their regions of origin.¹⁶ These food terms, the EU argues, are being misused by manufacturers not from the region of origin, including manufacturers in the United States and other countries, who profit by using the original term to identify their product.¹⁷ To provide even greater protection for GIs, in June 2005, the EU requested that the TRIPS Agreement be amended to include a provision that creates a rebuttable presumption that any term included in the multilateral registry of GIs is recognized and protected in all WTO member countries.¹⁸

The United States and other countries do not support the EU’s proposed “clawback” provision and argue that the listed forty-one food terms have become generic because European émigrés used these terms to identify the goods they produced in their new homelands.¹⁹ Therefore, as generic words, the United

(last visited Feb. 25, 2009) [hereinafter *Special Names for Special Products*] (see section titled Why Do Geographical Indications Matter?).

⁹ Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments – Results of the Uruguay Round, 108 Stat. 4809, 1869 U.N.T.S. 299, 33 I.L.M. 1125 (1994) [hereinafter TRIPS Agreement].

¹⁰ See *Special Names for Special Products*, *supra* note 8.

¹¹ *Id.*

¹² *Id.*

¹³ Bruce A. Babcock & Roxanne Clemens, Geographical Indications and Property Rights: Protecting Value-Added Agricultural Products, MATRIC Briefing Paper 04-MBP-7 (May 2004), at 8.

¹⁴ See, e.g., Tegan Brink, *Perspectives on Geographical Indications: Prospects for the Development of the International Legal Framework*, June 2007, http://www.wipo.int/edocs/mdocs/geoind/en/wipo_geo_bei_07/wipo_geo_bei_07_www_81778.pdf (defining “claw back” as “a list of 41 names submitted in the agriculture negotiations that the EC would like to reserve, or claw-back, for the exclusive use of its producers”).

¹⁵ *Special Names for Special Products*, *supra* note 8 (emphasis added).

¹⁶ *Id.*

¹⁷ *Id.*

¹⁸ *Id.*

¹⁹ WTO, TRIPS Geographical Indications: Background and the Current Situation, http://www.wto.org/english/tratop_e/trips_e/gi_background_e.htm (last visited Feb. 23, 2009).

Lessons Learned from Ethiopia

States contends that the EU cannot reclaim them for GI protection. Additionally, the United States does not support the EU's push for stronger protection of GIs under the TRIPs Agreement or the implementation of a mandatory register that creates a rebuttable presumption in favor of the registered term.²⁰ The United States contends that its current intellectual property ("IP") system, which includes GIs as a subset of trademarks, provides sufficient, indeed "TRIPs-plus," protection for agricultural products.²¹ Nations that support the EU's position and favor stronger GI protection include Bulgaria, Kenya, India, Sri Lanka, Switzerland, and Thailand.²² Nations that favor the position of the United States include Argentina, Australia, Canada, Chile, Costa Rica, Guatemala, Japan, Namibia, and Taiwan.²³

Notably, the EU contends that stronger GI protection in the TRIPs agreement will benefit developing countries by enabling them to claim ownership of their native products. "GIs are key to EU and *developing* countries cultural heritage, traditional methods of production and natural resources."²⁴ This claim has not yet been tested. However, an examination of Ethiopia's decision to pursue trademark protection and not seek a GI for its native coffees provides valuable information which can inform the debate regarding the benefits and drawbacks that GI protection can provide to a developing nation.

This paper examines *Ethiopia's Trademarking and Licensing Initiative*, Ethiopia's use of modern day law and technology and what other developing nations that are struggling to comply with the TRIPs Agreement can learn from Ethiopia's innovative strategy. This paper concludes that the EU's proposed greater protection of GIs may create a hurdle for developing nations to enter the worldwide market and, quite possibly, force developing nations to rely upon archaic agricultural methods instead of developing more environmentally friendly or more efficient farming methods. It also concludes that the EU's proposed "claw back" provision is, ultimately, a mechanism to extract a premium for what is, or was, TK of different European cultures and questions the possible consequences if the EU succeeds in its efforts to reclaim food terms that have become generic. Most importantly though, this paper highlights that Ethiopia, a developing nation, is successfully using modern day law and technology to develop an IP system that meets the needs of Ethiopia, allows Ethiopia to claim its place in the worldwide marketplace as well as claim ownership of its culture, heritage and TK.

II. Ethiopia

Ethiopia is a landlocked country located in the northeast corner of Africa with a population of approximately seventy-seven million and a history that dates

²⁰ *Id.*

²¹ USPTO, Geographical Indications, Protection, http://www.uspto.gov/web/offices/dcom/olia/global/ip/gi_protection.htm (last visited Feb. 23, 2009) [hereinafter USPTO, Geographical Indications].

²² Carsten Fink & Keith Maskus, *The Debate on Geographical Indications in the WTO*, in *TRADE, DOHA, AND DEVELOPMENT: A WINDOW INTO THE ISSUES*, 201, 201 (Richard Newfarmer ed., 2006).

²³ *Id.*

²⁴ *Special Names for Special Products*, *supra* note 8 (emphasis added).

Lessons Learned from Ethiopia

back over two thousand years. Unlike other African nations, Ethiopia remains relatively unaffected by colonialism because it was only occupied briefly by the Italians from 1936-1941. Nonetheless, similar to some other African nations, Ethiopia has been plagued by drought, famine, infectious diseases, internal conflict, war and an unstable economy. In 2007, Ethiopia ranked 105th among 108 developing nations for poverty.²⁵

Less than fifteen years ago, Ethiopia moved from a state-run economy to a market economy.²⁶ Agriculture is an essential element of Ethiopia's new market economy, accounting for approximately half of Ethiopia's Gross Domestic Product ("GDP"), sixty percent of its exports, and eighty percent of its total employment.²⁷ The coffee industry is a critical component of Ethiopia's agricultural industry, and thus a critical component of its overall economy. Approximately twenty-five percent of Ethiopians depend on coffee production either directly or indirectly for their livelihood.²⁸ In 2006, Ethiopian coffee exports were 350 million dollars, making Ethiopia the largest producer of coffee in Africa.²⁹

In 1989, the International Coffee Agreement³⁰ collapsed, resulting in a crisis in the coffee industry which continues today due to drought and other factors including internal conflict within nations that produce coffee.³¹ The effect has been a worldwide overproduction of coffee and historically low coffee prices.³² Ethiopia has suffered the greatest losses from the coffee crisis with a drop of forty-two percent in its coffee revenue in a single year and the insolvency of one of its larger state owned plantations.³³ Ethiopia's own problems with drought, disease and war have added to the desperation of its situation.

In 2003, the World Bank conducted a study to assess the impacts of the coffee crisis and to develop strategies to enable countries to recover from it.³⁴ Though the study focused on Central America, many of the recommendations could apply to any coffee producing country. Some of these suggestions include:

²⁵ Human Development Report 2007/2008, http://hdrstats.undp.org/countries/country_fact_sheets/cty_fs_ETH.html (last visited Feb. 23, 2009) (The Human Poverty Index (HPI-1) measures severe deprivation in health by the proportion of people who are not expected to survive age 40. Education is measured by the adult illiteracy rate. And a decent standard of living is measured by the unweighted average of people without access to an improved water source and the proportion of children under age 5 who are underweight for their age).

²⁶ Ministry of Foreign Affairs of Ethiopia, General Profile, Socio Economic Context, http://www.mfa.gov.et/Facts_About_Ethiopia/Facts.php?Page=general_Profile_5.htm (last visited Feb. 23, 2009).

²⁷ Central Intelligence Agency [CIA], World Fact Book, Ethiopia, <https://www.cia.gov/library/publications/the-world-factbook/geos/et.html> (last visited Feb. 23, 2009) [hereinafter World Fact Book].

²⁸ Mekuria et al., Conference on International Agricultural Research for Development, Berlin, Oct. 5-7, 2004, in *The Status of Coffee Production and the Potential for Organic Conversion in Ethiopia*, <http://www.tropentag.de/2004/abstracts/full/293.pdf> (last visited Feb. 25, 2009).

²⁹ World Fact Book, *supra* note 27.

³⁰ International Coffee Agreement, Sept. 16, 1982, T.I.A.S. No. 11095.

³¹ Independent Lens, Black Gold, The Economics of Coffee, <http://www.pbs.org/independentlens/blackgold/economics.html> (last visited Feb. 26, 2009).

³² Mekuria et al., *supra* note 28.

³³ *Id.*

³⁴ Varangis et al., Dealing With the Coffee Crisis in Central America: Impacts and Strategies 42-44 (World Bank Policy Research Working Paper No. 2993), available at <http://ssrn.com/abstract=636355>.

Lessons Learned from Ethiopia

- Work directly with retailers to bypass the traditional trading channels
- Reduce dependence on middlemen
- Seek brand recognition
- Capture product-oriented value markets such as “eco-certified,” “organic,” or “Bird-Friendly®.”
- Incorporate promotional strategies that include participating in the “Cup of Excellence” competition
- Use the internet for more than just traditional marketing including sharing information regarding certification, land use and Geographic Indications of Origin.

Ethiopia started to take all of these steps and several more in 2003, beginning with the formation of the Ethiopian Intellectual Property Office (“EIPO”). One of the first tasks taken by the EIPO was to ascertain and catalog Ethiopia’s intellectual property assets.³⁵ The EIPO identified Ethiopia’s single-origin heritage coffees as one of Ethiopia’s most valuable intellectual property assets as well as one that affected a large sector of its population.³⁶ As noted before, almost a quarter of the nation’s people are involved at some level in the production of Ethiopia’s coffees.³⁷

III. Ethiopia’s Heritage Coffees

Ethiopia is the birthplace of coffee. The word “coffee” is believed to be a derivation of the word *Kafa*, which, loosely translated, means “the land or plant of God.”³⁸ Coffee flavors are complex and varied, containing 700-850 substances that contribute to the flavor of coffee when it’s roasted.³⁹ For more than a hundred years Ethiopia has differentiated its coffee for export based upon the regions in which they are grown and the distinctive flavors of these regional coffees. The flavors of Ethiopia’s coffees are not just a result of the soil and climate of Ethiopia, but also of the cultivation methods developed and used by Ethiopian farmers for many generations. The coffees of Ethiopia are known throughout the world for their excellence. “Ethiopia. . . produces the most varied range of coffee taste experience of any country. . . in the world.”⁴⁰

The Specialty Coffee Association of America (“SCAA”) defines specialty coffees as those that are “made from exceptional beans grown only in ideal coffee-producing climates. They tend to feature distinctive flavors, which are shaped by

³⁵ Ethiopian Coffee Network, About the Trademark and Licensing Initiative, Who is the Ethiopian Intellectual Property Office?, <http://www.ethiopiancoffeenetwork.com/about4.shtml> (last visited Feb. 22, 2009).

³⁶ Ethiopian Coffee Network, About the Trademark and Licensing Initiative, Specialty Market Growth, <http://www.ethiopiancoffeenetwork.com/about2.shtml> (last visited Feb. 22, 2009).

³⁷ T. Mekuria et al., *supra* note 28, at 2.

³⁸ *Id.* at 1.

³⁹ *Id.* at 9.

⁴⁰ KENNETH DAVIDS, HOME COFFEE ROASTING, ROMANCE AND REVIVAL 92 (St. Martin’s Griffin 2003).

Lessons Learned from Ethiopia

the unique characteristics of the soil that produces them.”⁴¹ Specialty coffees command a premium in the retail market—up to three times that of the average roasted coffee.⁴² For example, 100% Kona® and Jamaica Blue Mountain® coffees are SCAA recognized specialty coffees and command some of the highest prices in the coffee retail market. From August to December 2006, 100% Kona® and Jamaica Blue Mountain® roasted coffees sold for \$29.37 and \$43.44 per pound respectively with a return to the producers of up to forty-five percent of their retail prices.⁴³ In contrast, during the same time period, the average retail roasted coffee sold for \$3.17 per pound while the average price for roasted Yirgacheffe and Harar was \$11.45 and \$11.28 per pound⁴⁴ with Ethiopian farmers recouping approximately six percent of the retail price.⁴⁵

The discrepancy between both the retail prices and the amount paid to the producers of specialty coffees compared to the prices of Ethiopian coffees and the amount paid to Ethiopian farmers is because the coffees are sold in two different markets. Most of Ethiopia’s coffees are sold as a commodity and are priced according to the London Exchange. Coffees sold on the commodity market pass through several middlemen before they reach the roaster at the end of the distribution channel. Because they are sold as commodities, the farmers do not have the ability to negotiate the price they receive for their coffees. In contrast, specialty market coffee producers, such as the producers of 100% Kona® and Jamaican Blue Mountain® are able to establish relationships directly with the end distributor or roaster and, therefore, are able to negotiate a higher price for their coffees, resulting in a much higher return for the farmers.⁴⁶ Both 100% Kona® and Jamaica Blue Mountain® are registered certification marks with the USPTO.⁴⁷

Since the 1990s, the sale of specialty coffees has become one of the fastest growing food service markets in the world, netting an estimated \$8.4 billion in the United States in 2002.⁴⁸ In 2004, due to the rapid growth of the specialty coffee industry, the SCAA predicted that a shortage of specialty coffees would

⁴¹ Specialty Coffee Association of America, What is Specialty Coffee?, <http://members.scaa.org/lounge/CoffeeLoungeDocs1/WhatIsSpecialty.aspx> (last visited Mar. 15, 2009).

⁴² Ramona Teuber, *Geographical Indications of Origin as a Tool of Product Differentiation—The Case of Coffee* 640 (2007), <http://ageconsearch.umn.edu/bitstream/7866/1/cp070042.pdf> (Paper presented at the 105th EAAE Seminar, International Marketing and International Trade of Quality Food Products, in Bologna, Italy, Mar. 8-10, 2007).

⁴³ *Id.* at 649.

⁴⁴ *Id.*

⁴⁵ Light Years IP, Ethiopia: Coffee Trademarking and Licensing Project, [http://www.lightyearsip.net/ethiopiacoffee.shtml](http://www.lightyearsip.net/ethiopiacooffee.shtml) (last visited Feb. 22, 2009).

⁴⁶ Lewin et al., *Coffee Markets: New Paradigms in Global Supply and Demand* 98 (World Bank Agric. & Rural Dev. Discussion Paper No. 3), available at http://www.csa-be.org/IMG/pdf_CoffeeMarkets-ArdDp3.pdf.

⁴⁷ “100% Kona Coffee” is registered as Certification Mark No. 2322867 and is owned by the Hawaii Department of Agriculture. “Jamaica Blue Mountain” is registered as Certification Mark No. 1414598 and is owned by Coffee Marks Limited.

⁴⁸ Lewin et al., *supra* note 46, at 100.

occur in the near future and stated that the market for specialty coffees is “far from saturated.”⁴⁹

Because of the distinct flavors of Ethiopia’s coffees as well as their already established reputation as some of the finest coffees in the world, Ethiopia is well-positioned to move its coffees from the commodity market into the specialty coffee market. However, entering the specialty market without a partner in the targeted country or without costly branding and promotional strategies is difficult.⁵⁰ Ethiopia has chosen to confront these difficulties and distinguish its coffees in the marketplace via a trademarking and licensing initiative rather than by seeking GI protection for them.

In light of the EU’s push for stronger protection of GIs, its assertions that GIs are the proper way to protect agricultural goods from a specific region, and its assertion that GI protection will help developing nations, Ethiopia’s decision to seek trademarks and not GIs to differentiate its coffees in the world marketplace warrants examination.

IV. Trademarks, Geographical Indications and Traditional Knowledge

To understand Ethiopia’s strategic decision to trademark several of its heritage coffees and not seek a GI for them requires a basic understanding of several IP concepts including trademarks, GIs and TK; how they are related to each other; and to what extent they are protected under the TRIPs Agreement. Notably, there is no mention of TK in the TRIPs Agreement.⁵¹ Thus, developing nations seeking IP protection for their TK in the international market must find a category of IP that is provided protection in the TRIPs Agreement.

This brief, but important, overview of trademarks, GIs and TK provides an introduction to a few of the intellectual property concepts that governments of developing nations need to understand to be able to assert legal rights in their intellectual property. And, if the nation is a member of the WTO, or is acceding to the WTO, these concepts are ones that the nation’s IP legal framework needs to adequately address and protect to be in compliance with the TRIPs Agreement.⁵²

A. Trademarks

A trademark, as recognized by both the EU and the United States, identifies the source of a product or service and serves to distinguish the product or service from other similar goods or products or services.⁵³ A trademark can be a word such as the recently registered Harar® which identifies coffee grown in Ethiopia of a certain variety and quality. In the United States, a registered trademark can

⁴⁹ *Id.*

⁵⁰ *Id.* at 97.

⁵¹ BERNARD O’CONNOR, THE LAW OF GEOGRAPHICAL INDICATIONS 308 (Cameron May 2004).

⁵² Fink & Maskus, *supra* note 22, at 205.

⁵³ O’CONNOR, *supra* note 51, at 107.

also be a logo, a device, a slogan,⁵⁴ and has been interpreted as including a package design, a personal name a sound, a scent, a color, a shape, a building or a numeral. Some examples of well-known American trademarks include Nike's® famous "swoosh" mark logo that adorns its products; a package design such as the shape of the Coca-Cola® bottle; and the sound of the Yahoo!® yodel. Each member country of the WTO has its own intellectual property system that defines the parameters of a protected trademark. Not all member countries' systems extend trademark protection to sounds and scents as the United States does. The previous three examples of well-known trademarks are owned by companies, but trademarks can also be owned by a government entity, as is Harar®. For example, BE ALL THAT YOU CAN BE® is a registered trademark of the United States Army.⁵⁵

A trademark can last forever if properly registered and monitored over time. The registration of a U.S. trademark can cost as little as \$275 US.⁵⁶ Trademarks, once registered, become the private property of the registering party and can only be used by that party on the goods or services identified in its application.⁵⁷ Because trademarks are private property, they can be sold or licensed to another entity.

Trademarks serve to lead the consumer to the product they seek and help avoid consumer confusion. A trademark itself does not indicate the standards or quality of the *processes* used to manufacture the good. Rather, a trademark attaches to a good or service regardless of either the manufacturing process or the location of the manufacturing process. The value of a trademark is realized by the *quality* of the goods or services itself. Because trademarks serve to distinguish one good from another and are indicators of consumer-perceived quality, they can be extremely valuable rights. However, the value of a trademark diminishes when the quality of the product relative to similar goods or services diminishes. A trademark can become "diluted" by the unauthorized use of the trademark by third parties that make inferior quality goods causing consumers to believe the authentic trademarked product itself has deteriorated. Trademarks owners in the United States must protect their trademark by policing for its unauthorized use and actively enforcing their right to exclude others from using their trademark.⁵⁸

The words "brand" and "trademark" are used interchangeably in the marketing world. However, "trademark" is the legal term that designates the mark or word associated with a product; the word "brand" generally refers to the "successes of a trademark in terms of contribution to market share, sales, profit margins, loy-

⁵⁴ Lanham Act, 15 U.S.C.1127 (2007) ("The term 'trademark' includes any word, name, symbol, or device, or any combination thereof . . .").

⁵⁵ U.S. Trademark Application Serial No. 78,888,832 (abandoned Mar. 9, 2009).

⁵⁶ International Trademark Association [INTA], *Top Ten Reasons Why You Should Care About Trademarks* 28, <http://www.docstoc.com/docs/3283313/Top-Ten-Reasons-Why-You-Should-Care-About-Trademarks.pdf> (last visited Feb. 22, 2009).

⁵⁷ USPTO, *Basic Facts About Trademarks*, http://www.uspto.gov/web/offices/tac/doc/basic/trade_defin.htm (last visited Mar. 15, 2009) [hereinafter *Basic Facts about Trademarks*].

⁵⁸ *Basic Facts About Trademarks*, *supra* note 57.

Lessons Learned from Ethiopia

alty and market awareness.”⁵⁹ Thus, the “brand value” reflects the market value of a trademark and can be one of the most valuable assets a company owns. The brand values of a few, well-known companies are shown in Table 1.

Table 1. Companies and Brand Value (2007)		
<i>Company</i>	<i>Sector</i>	<i>Brand Value (U.S. \$bn)</i>
Coca Cola	Beverages	65.3
McDonald's	Restaurants	29.3
Marlboro	Tobacco	21.3
Google	Internet Services	17.8
Budweiser	Alcohol	11.6
Starbucks	Restaurants	3.6
<i>Source: Interbrand & Business Week (2007)</i> ⁶⁰		

Given the possible market value of a trademark—which is only one intangible asset recognized and protected by IP law—the importance of developing nations cataloging, registering and capitalizing on their intellectual property rights cannot be over-emphasized.

Under Article 15 of the TRIPs Agreement “any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings shall be capable of constituting a trademark.”⁶¹ Within the EU, an entity can register a trademark with all member countries in the EU at once via the European Community’s uniform system of registration.⁶²

B. Geographical Indications (GIs)

A GI is a word or symbol that indicates the region of origin of a specific good or service and signifies some standard of quality associated with the good or service. GIs can include certification marks, designated geographical indications, protected designations of origin, protected geographical indications and appellations of origin.⁶³ Each member country of the WTO maintains its own IP system which defines the breadth and scope of protection afforded to GIs within its own nation.⁶⁴ GI protection within individual nations is granted to a wide variety of

⁵⁹ *The Role of Trademarks in Marketing*, Feb. 2002 WIPO MAG. 10, available at http://www.wipo.int/sme/en/documents/wipo_magazine/02_2002.pdf.

⁶⁰ INTERBRAND & BUSINESSWEEK, BEST GLOBAL BRANDS 2007 13-16 (2007), http://www.ourfishbowl.com/images/surveys/Interbrand_BGB_2007.pdf.

⁶¹ TRIPS Agreement, *supra* note 9, art. 15.

⁶² O’CONNOR, *supra* note 51, at 109.

⁶³ TRIPS Agreement, *supra* note 9, art. 22.1.

⁶⁴ *Id.* art. 22.2.

products including agricultural goods and non-foodstuff items including crystal,⁶⁵ watches and many others. However, EU's GI regulations govern only products for human consumption and foodstuffs.⁶⁶ This paper discusses GIs that are, or can be, afforded legal protection under the TRIPs Agreement.

1. *Geographical Indications in the United States*

In the United States, GIs are a subset of trademarks.⁶⁷ Like trademarks, GIs identify the source of the good or service, indicate the quality of the good or service and are a valuable, intangible asset of the owner of the GI. The United States has recognized GIs since 1946.⁶⁸ The U.S. system provides GI protection via a certification mark that is registered with the USPTO. A certification mark indicates that the goods or services bearing the mark meet standards of quality as determined by a third party, such as a trade group, and not the manufacturer itself.⁶⁹ Not all certification marks are GIs since an association with a geographical locale is not necessary to qualify for a certification mark. Rather, the mark indicates that the manufacturer adhered to third party standards when producing the product.

Certification marks tend to be owned by a collective group such as a trade group or a government entity—including state agricultural agencies—who establish the standards and criteria that a product must meet to bear the organization's certification mark. For example, IDAHO PREFERRED is a certification mark owned by the Idaho State Department of Agriculture⁷⁰ that, "as used by persons authorized by the certifier, certifies that the food and agricultural products, excluding potatoes and potato products, provided are grown, raised or processed in the State of Idaho."⁷¹ IDAHO POTATOES GROWN IN IDAHO is a certification mark owned by the State of Idaho Potato Commission that "certifies the regional origin of potatoes grown in the State of Idaho and certifies that those potatoes conform to grade, size, weight, color, shape, cleanliness, variety, internal defect, external defect, maturity and residue level standards promulgated by the certifier."⁷² Certification marks can be the registered words themselves or an

⁶⁵ "For example, 'Bohemia' is recognized as a geographical indication in many countries for specific products made in the Czech Republic, in particular crystal ware." WTO, *About Geographical Indications*, http://www.wipo.int/geo_indications/en/about.html (last visited Mar. 9, 2009).

⁶⁶ European Commission, Directorate-General for Agriculture, *Food Quality Policy in the European, Protection of Geographical Indications, Designations of Origin and Certificates of Special Character for Agricultural Foodstuffs* 8 (Working Document of the Comm'n Services, Aug. 2004), available at http://ec.europa.eu/agriculture/publi/gi/broch_en.pdf.

⁶⁷ USPTO, *GEOGRAPHICAL INDICATION PROTECTION IN THE UNITED STATES* 1 (2005), http://www.uspto.gov/web/offices/dcom/olia/globalip/pdf/gi_system.pdf.

⁶⁸ USPTO, *Geographical Indications*, *supra* note 21.

⁶⁹ *Id.*

⁷⁰ U.S. Trademark No. 3,107,838 (filed June 29, 2004), available at <http://tess2.uspto.gov/bin/showfield?f=doc&state=4007:5b9367.3.1>.

⁷¹ *Id.* (see the Goods and Services description).

⁷² U.S. Trademark No. 2,914,309 (filed Dec.28, 2004), available at <http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=76542380>.

associated 'mark' or graphic to indicate the good. The United States offers the same level of GI protection for foreign products that qualify for a certification mark and are registered with the USPTO.⁷³ For example, ROQUEFORT is a USPTO registered certification mark owned by the Community of Roquefort, The Municipality of France that is used "to indicate the that the [product] has been manufactured from sheep's milk only, and has been cured in the natural caves of the community of Roquefort, France."⁷⁴

Though certification marks are a subset of trademarks, there are several notable differences between a trademark and a U.S. certification mark. First, a U.S. certification mark is not used by a manufacturer itself, but is used by a third party to indicate some attribute or quality of the goods.⁷⁵ Second, and importantly, unlike trademarks, a U.S. certification mark has a limited right to exclude.⁷⁶ Trademark owners are *required* to exclude every other entity from using their trademark to prevent it from becoming diluted or generic. In contrast, a U.S. certification mark owner cannot exclude manufacturers that meet the standards and criteria as defined by the registered certification mark.⁷⁷ To benefit from the goodwill or value associated with a U.S. certification mark, a producer must meet the requirements established by the U.S. certification mark owner. The U.S. system of certification marks allows opportunities for new producers to enter the "club" associated with a particular certification mark. Such a certification mark can be a very valuable IPR. A study found that consumers would be willing to pay sixty percent more for a wine labeled "Napa Valley" versus a wine labeled "California."⁷⁸ Though this is only one study, it nonetheless demonstrates the possible value of a certification mark.

2. *Geographical Indications in the EU and its member countries*

GI protection is a core element of the EU's trade and agricultural policy: "GIs constitute the main pillar of the EU's quality policy on agricultural products."⁷⁹ Because of the variations in the legally recognized definitions of the term "appellation of origin" and other GIs among EU member countries, in 1992, the EU enacted Regulation 2081/92.⁸⁰ This regulation established a single system for the registry of GIs for some products intended for human consumption and certain foodstuffs, but not all.⁸¹ The EU's system provides protection for two categories

⁷³ GEOGRAPHICAL INDICATION PROTECTION IN THE UNITED STATES, *supra* note 67, at 1.

⁷⁴ U.S. Trademark No. 0571798 (filed Feb.13, 1952), *available at* <http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=71624872>.

⁷⁵ GEOGRAPHICAL INDICATION PROTECTION IN THE UNITED STATES, *supra* note 67, at 3.

⁷⁶ *Id.*

⁷⁷ USPTO, Geographical Indications, *supra* note 21.

⁷⁸ Fink & Maskus, *supra* note 22, at 203.

⁷⁹ *Special Names for Special Products*, *supra* note 8, at 2.

⁸⁰ Council Regulation 2081/92, 1992 O.J. (L 208/1).

⁸¹ *Food Quality Policy in the European, Protection of Geographical Indications, Designations of Origin and Certificates of Special Character for Agricultural Foodstuffs*, *supra* note 66, at 4.

of GIs: Protected Designation of Origin (“PDO”) and Protected Geographical Indications (“PGI”).⁸²

A PDO refers to goods that originate within a region, place or country, and whose characteristics and quality are specifically linked to the geographic environment of that region.⁸³ To qualify for a PDO, the production, processing and preparation of the product must take place in a defined geographical area.⁸⁴ Thus, a PDO product is one that is tied both to the land via production and to the people who process and prepare the good. Notably, the EU places a high value on the human skill associated with the preparation of a good. For example, in 2003 the Court of Justice of the European Communities ruled that PROSCIUTTO DI PARMA (English equivalent is Parma Ham) is a PDO and thus all aspects of its production, including the slicing of the ham, must occur in the Province of Parma, Italy and under the supervision of the Consorzio del Prosciutto di Parma.⁸⁵

To qualify for PGI protection, the geographic link to a particular region needs to occur at only “one of the three stages of production, processing, or preparation” of the product.⁸⁶ Because only one of the three stages needs to occur within the designated region, PGIs are not as closely tied to the land as PDOs. Beef from Scotland provides a sound example of the important differences between a PDO and a PGI. The term SCOTCH BEEF is registered as a PGI with the EU.⁸⁷ Only cattle that have been “born and raised on assured Scottish farms and then slaughtered at approved Scottish slaughterhouses in Scotland” can be labeled as SCOTCH BEEF.⁸⁸ The flavor and quality of SCOTCH BEEF, therefore, is attributable to “the specific quality, reputation or other characteristic [of Scotland].”⁸⁹ However, the quality and flavor of ORKNEY BEEF has been determined to be “essentially due to the area [Orkney, Scotland]” and therefore qualifies for PDO protection.⁹⁰

Several European nations including France, Portugal, Spain, Italy and Switzerland provide protection for other GIs, including appellations of origin.⁹¹ The recognition of this GI has a long history in several of these nations, particularly

⁸² *Id.* at 6-7.

⁸³ *Id.* at 6.

⁸⁴ *Id.*

⁸⁵ O’CONNOR, *supra* note 51, at 134.

⁸⁶ *Food Quality Policy in the European, Protection of Geographical Indications, Designations of Origin and Certificates of Special Character for Agricultural Foodstuffs*, *supra* note 66, at 14.

⁸⁷ Application for Registration, National File No, PGI/00311, available at www.land.gov.sk/politikakvality/download.php?250 (last visited Mar. 15, 2006).

⁸⁸ Quality Meats of Scotland, Ensuring Quality, <http://www.chefsguidetoscotchbeef.org/plate/ensuring-quality.html> (last visited Feb. 22, 2009).

⁸⁹ *Id.* (see the chart by Department for Environment, Food and Rural Affairs (DEFRA) for the UK explaining the PGI distinction).

⁹⁰ *Id.* (emphasis added).

⁹¹ Appellation systems including: Appellation d’origine contrôlée (AOC) in France; Denominazione di origine controllata (DOC) used in Italy; Denominação de Origem Controlada (DOC) used in Portugal, and Denominación de Origen (DO) system used in Spain.

in France. Appellations of origin refer to the “geographical name of a country, region or locality, which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors.”⁹² Because appellations of origin relate to the quality and characteristics of a product, they are protected as GIs under international treaties including the TRIPs Agreement.⁹³ Some examples of well-known European appellations of origin include SWISS-MADE to identify watches, WATERFORD to identify crystal and CHAMPAGNE to identify a sweet, sparkling wine from France. Many agricultural products that are protected as appellations of origin in their native country are also registered as a PDO or a PGI with the EU. For example, PROSCIUTTO DI PARMA is protected as an appellation of origin under Italian law⁹⁴ and is also registered with the EU as a PDO.⁹⁵ The same is true for ROQUEFORT which was first registered as an appellation of origin in 1925 in France⁹⁶ and is now an EU recognized PDO.

3. *The TRIPs Agreement and GIs*

Article 22.1 of the TRIPs Agreement defines a GI as “indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographic origin.”⁹⁷ This broad definition incorporates many of the different permutations of GIs that are legally recognized by WTO member countries and could include all of the previously discussed forms of GIs. The TRIPs Agreement requires that all WTO members provide a minimum level of protection for IPRs including the legal means for a member country to assert and enforce its legal rights of its IPRs.⁹⁸

For products other than wines and spirits, a GI may be used on a product label provided it does not cause consumer confusion concerning the origin of the product. For example, the mark ROQUEFORT indicates that the cheese was made from sheep’s milk and cured in Roquefort, France, in accordance with their traditional and established standards. However, under the TRIPs Agreement, manufacturers in other parts of the world may produce cheeses that are similar to ROQUEFORT if they correctly label them to ensure that there is no consumer confusion over the origin of the cheeses.⁹⁹ For example, “Roquefort-style cheese

⁹² O’CONNOR, *supra* note 51, at 25; *see also* TRIPs Agreement, *supra* note 9, art. 22.

⁹³ O’CONNOR, *supra* note 51, at 24.

⁹⁴ PAOLO GARZOTTI & ELISABETH CAVARERO, REPORT TO THE TRADE BARRIERS REGULATION COMMITTEE: TBR PROCEEDINGS CONCERNING CANADIAN PRACTICES AFFECTING COMMUNITY EXPORTS OF PROSCIUTTO DI PARMA 10 (1999), <http://trade.ec.europa.eu/doclib/html/112191.htm>.

⁹⁵ Commission Regulation 102/2008, 2008 O.J. (L 31/29) (EC).

⁹⁶ O’CONNOR, *supra* note 51, at 167.

⁹⁷ TRIPs Agreement, *supra* note 9, art. 22.1.

⁹⁸ TRIPs Agreement, *supra* note 9, art. 43.

⁹⁹ *See generally*, TRIPs Agreement, *supra* note 9, art. 22.

made in Australia” or “Cheese made using Roquefort-like methods” are acceptable labels.

The TRIPs Agreement provides *additional* protection for wines and spirits. Under Article 23.1 of the TRIPs Agreement, only producers of CHAMPAGNE from the Champagne region of France can use the term CHAMPAGNE to identify their products.¹⁰⁰ “Champagne-like” or “in the style of Champagne” or “produced by the Champagne method” are all prohibited product designations under the TRIPs Agreement. The EU would like the additional protection afforded to wines and spirits to be granted to all registered GIs.¹⁰¹ Thus, product designations such as “Roquefort-like cheese made in Australia” would no longer be permitted if the EU succeeds in its efforts.

The strong legal protection afforded wine and spirit GIs under the TRIPs Agreement is essentially the same legal protection that a trademark provides. That is, just as only the Ethiopian government has the legal right to use the word Harar® on its coffees, only producers who meet the criteria to call their beverage CHAMPAGNE can label it as such. Because the word Harar® is a registered trademark, “Harar-like” or “in the style of Harar” are unacceptable uses of the word.

This brief introduction to two intellectual property concepts, how they differ in the United States, European Nations and the EU exemplifies the complexities of international IP law. For many developing nations, the concept of “intangible assets” is new. Therefore, understanding, developing and implementing an IP system that is in compliance with the TRIPs Agreement could be challenging, if not daunting. Though the concepts of trademark and geographical indications may be relatively new to a developing nation, the concept of TK is not.

C. Traditional Knowledge (TK)

One of the biggest challenges facing international intellectual property law is to identify a means to adequately protect TK, specifically, the TK of developing countries. As stated previously, there is no mention of TK in the TRIPs Agreement.¹⁰² Thus, countries seeking IP protection for their TK in the international market must fit it into a category of IP that is currently protected under the TRIPs Agreement. Because GIs are “not intended to reward innovation, but rather to reward members of an established group or community adhering to traditional practices belonging to the culture of that community or group,”¹⁰³ it is understandable that some developing nations would embrace the GI system as a means to protect their TK. The World Intellectual Property Organization (“WIPO”) defines TK as:

¹⁰⁰ TRIPs Agreement, *supra* note 9, art. 23.1.

¹⁰¹ See, e.g., Communication from the European Communities–Geographical Indications, TN/IP/W/11, (June 14, 2005) (“[A] proposal for amending Section 3 of the TRIPs Agreement with a view to extending the regime of protection today available for geographical indications on wines and spirits to geographical indications on all products.”).

¹⁰² O’CONNOR, *supra* note 51, at 380.

¹⁰³ *Id.* at 374.

Lessons Learned from Ethiopia

tradition-based literary, artistic or scientific works; performances; inventions; scientific discoveries; designs; marks, names and symbols; undisclosed information; and all other tradition-based innovations and creations resulting from intellectual activity in the industrial, scientific, literary or artistic fields. . . . Categories of traditional knowledge could include: agricultural knowledge; scientific knowledge; technical knowledge; ecological knowledge; medicinal knowledge, including related medicines and remedies; biodiversity-related knowledge. . . .¹⁰⁴

This broad definition highlights one important aspect of TK that illustrates its intersection with European GIs: TK, like European GIs, is tradition-based. However, the WIPO definition does not provide any clarity regarding the community that can claim IP rights associated with a tradition-based practice. A more succinct definition of TK is: “the information that people in a given community, based on experience and adaptation to a local culture and environment, have developed over time, and continue to use.”¹⁰⁵

This definition provides more guidance in defining the boundaries of TK. It also more clearly illustrates the overlap of European GIs and TK. A closer inspection of the GI for CHAMPAGNE exemplifies the intersection of European GIs and TK. As early as the medieval times, the winemakers in the Champagne region of France became known for the sparkling, sweet wine they produced.¹⁰⁶ Over time, the *people of that region continued to use the information* of their ancestors *to adapt to the local culture and environment*.¹⁰⁷ The CHAMPAGNE that is produced today is similar to the CHAMPAGNE that was produced in the late 1800s.¹⁰⁸ Thus, CHAMPAGNE is the TK of people from the Champagne region of France. The continued reputation for excellence of the flavor and quality of this sparkling, sweet wine firmly established its position in the marketplace over time. The producers of CHAMPAGNE today, who use methods that were developed by their ancestors, benefit from the TK of their community. Thus, EU GIs are a means to protect the TK of different European cultures as well as reward the people who live within the region and continue to use the TK.

The appellation of origin SWISS-MADE for watches provides a sound illustration that EU GIs are protection of the TK of past generations. To qualify to be labeled a SWISS-MADE watch, both the assembly on the motor and on the watch itself needs to be done in Switzerland, but only fifty percent of the compo-

¹⁰⁴ See WIPO, Glossary of Definitions, <http://www.wipo.int/tk/en/glossary/> (last visited Mar. 15, 2009).

¹⁰⁵ STEPHEN HANSEN & JUSTIN VANFLEET, TRADITIONAL KNOWLEDGE AND INTELLECTUAL PROPERTY: A HANDBOOK ON THE ISSUES AND OPTIONS FOR TRADITIONAL KNOWLEDGE HOLDERS IN PROTECTING THEIR INTELLECTUAL PROPERTY AND MAINTAINING BIOLOGICAL DIVERSITY 2 (Am. Ass’n Advancement Sci. 2003).

¹⁰⁶ Wine and Wines, Everything About Wine, <http://www.wineandwines.com/perso-22918.htm> (last visited May 1, 2009).

¹⁰⁷ The history of Champagne illustrated through the language of WIPO’s definition of TK.

¹⁰⁸ History of Wine and Champagne, <http://www.openthatabottlenight.com/open-that-bottle-night-history.shtml> (last visited May 1, 2009) (“The designation Brut Champagne, the modern Champagne, was created for the British in 1876.”).

nents need to be manufactured in Switzerland.¹⁰⁹ Thus, much of the production of the watches can be performed outside of Switzerland and still qualify to be labeled as SWISS-MADE. Unlike an agricultural crop, the components of a watch are in no way connected to the soil or climate of Switzerland. If “geography is the heart”¹¹⁰ of GIs, it is difficult to discern how the appellation of origin SWISS-MADE qualifies for GI protection. The GI SWISS-MADE for watches can readily be seen to be a reward to the native people of Switzerland for their technological contributions to the development of fine watches.

Understandably, many producers would like GI protection for their products. Numerous studies show that consumers are willing to pay a premium for a good that is certified as originating from a particular region.¹¹¹ The amount of the premium that a consumer is willing to pay is dependent upon many factors including the good itself and the market for the good.¹¹² A 1999 survey conducted by the EU showed “that forty percent of consumers were willing to pay a ten percent premium for origin-guaranteed products.”¹¹³ The study did not focus on a specific product, but rather, generally, what a consumer would be willing to pay for a good if he or she was assured of the origin of the good. Thus, GIs are internationally recognized as valuable IPRs.

The premium that consumers are willing to pay for a GI designated product, just like the premium consumers are willing to pay for goods identified by a trademark, is due to the established reputation of the product. In the EU, GIs are a reward for tradition-based practices that produce high quality products such as CHAMPAGNE, or, as in Switzerland’s case, a culture’s technological contribution to a particular field. Thus, GIs would appear to be the likely choice for a developing nation to use to protect its TK.

V. Ethiopia’s Choice to Trademark its Heritage Coffees

Ethiopia’s heritage coffees are excellent examples of agricultural crops that appear to meet the criteria to be a protected GI under both the U.S. system of certification marks and the EU’s system of PGIs and PDOs. The flavors of the coffee are “essentially attributable to the area” where the coffee is grown. Certainly, the “specific quality, reputation or other characteristic is attributable to the area.” Also, Ethiopia’s coffee farming is TK of Ethiopians. Ethiopians have

¹⁰⁹ Federation of the Swiss Watch Industry, A General Overview, <http://www.fhs.ch/en/swissm.php> (last visited Mar. 15, 2009).

¹¹⁰ Dwijen Rangnekar, Int’l Centre for Trade & Sustainable Dev. [ICTSD], The Socio-Economics of Geographical Indications 2 (2004), available at www.iprsonline.org/unctadictsd/docs/CS_Rangnekar2.pdf.

¹¹¹ Why do Geographical Indications matter to us?, EU News, July 30, 2003, <http://trade.ec.europa.eu/doclib/html/113900.htm> (“French GI cheeses are sold at a premium of 2 euro. Italian “Toscano” oil is sold at a premium of 20% since it has been registered as a GI in 1998.”).

¹¹² RANGNEKAR, *supra* note 110, at 33. The difference in premiums paid for origin-based goods is dependent upon numerous factors including the product and the market. *Id.* The example provided serves to illustrate that consumers are willing to pay some premium for GI designated goods. It is not presented as an accurate representation of what consumers would pay for every GI designated good.

¹¹³ Fink & Maskus, *supra* note 22, at 203.

Lessons Learned from Ethiopia

been growing and exporting their coffees for over a hundred years. The flavors of the coffees reflect not just the soils and climate of Ethiopia, but also the agricultural methods used by the people. In some instances, families have been farming the same plot of land for generations.¹¹⁴ Because Ethiopian coffee farmers are an identifiable group of *people in a given community* who have used and *continue to use information that is based on experience and adaptation to a local culture and environment*, coffee farming in Ethiopia is TK that is indigenous to the people who live there.

Additionally, Ethiopia's coffees are already well-established in the marketplace as some of the finest coffees in the world.¹¹⁵ Thus, it is a developing country that is uniquely positioned to fully reap the benefits of GI protection for their distinctive heritage crops. However, developing nations have an additional barrier to overcome in order to receive the benefits of GI certification: they need the resources to develop and implement a GI certification program. Notably, Article 24.9 of the TRIPs Agreement states that "[t]here shall be no obligation under this Agreement to protect geographical indications which are not . . . protected in their country of origin."¹¹⁶ Thus, a country claiming protection for a GI in WTO member countries must first provide protection for the GI in its country of origin—only then is GI protection reciprocally available.

At this time, the development and implementation of an internal GI system for Ethiopia's heritage coffees would be extremely difficult, if not impossible, given Ethiopia's limited resources. "[N]inety-five percent of the coffee is produced by two million subsistence-level farmers."¹¹⁷ Therefore, identifying all of the coffee farmers, creating internal certification standards, and then implementing and monitoring the standards would be an extremely resource intensive endeavor.

Seeking a trademark instead of a GI for a regional crop is an innovative strategy and perhaps the only viable one if Ethiopia wants to compete in the international marketplace today. Instead of developing a GI system for its heritage crops, Ethiopia chose to focus its resources on developing its crops, its products' reputations, and building partnerships with coffee distributors. Trademark protection can protect Ethiopia's IPRs for its coffees today and, if necessary, Ethiopia can develop a sophisticated GI system at some point in the future that is tailored to meet its own needs.

Both the United States and the EU GI systems developed from their respective IP needs that arose and evolved over time. Their systems reflect the culture, form of government and economic policies of their nations. Ethiopia's IP sys-

¹¹⁴ BLACK GOLD: WAKE UP AND SMELL THE COFFEE (Speak It Films, Fulcrum Productions 2004).

¹¹⁵ *Safeguarding biodiversity in Ethiopia's coffee forests: Opportunities and challenges related to intellectual property rights*, ICTSD, MAY 2008, <http://ictsd.net/i/news/bioresreview/12089/> ("Ethiopia is considered the birthplace of coffee. Coffee arabica, the aromatic and mild species of coffee used to produce the highest quality—and priciest—blends originated in the highland rainforests of south-western Ethiopia.").

¹¹⁶ TRIPs Agreement, *supra* note 9, art. 24.9.

¹¹⁷ Stephan Faris, *Starbucks vs. Ethiopia*, FORTUNE, Feb. 26, 2007, available at http://money.cnn.com/magazines/fortune/fortune_archive/2007/03/05/8401343/index.htm (quote of Ron Layton, Founder and Chief Executive, Light Years IP).

Lessons Learned from Ethiopia

tem, as well as the IP system of other developing nations, needs to be developed to fit its own unique needs.

Ethiopia may also have learned a valuable lesson from Indonesia regarding the importance of claiming IPRs in one's indigenous crops without seeking GI certification. As of November 2005, no products in Indonesia were protected by GIs because the Indonesian government was still completing its rules to implement an internal GI registration system as required by the TRIPs Agreement. Toraja is a region of Indonesia where the Toraja, a distinct ethnic culture, reside and grow coffee. Its coffee was first exported to Japan in 1934.¹¹⁸ In 1977, a Japanese company registered the word Toraja in association with the Toraja coffee it distributed.¹¹⁹ Now the word Toraja does not belong to the people of Toraja and it is the Japanese distribution company that benefits from the goodwill generated by the coffee of Toraja, not the people of Toraja themselves.¹²⁰ Although Indonesia began its implementation of an internal GI registration system in 2002, the first Indonesian GI was not registered until December 5, 2008 for Kintamani Bali arabica coffee.¹²¹

VI. Ethiopia's Trademarking and Licensing Initiative

In 2004, the EIPO launched its Trademarking and Licensing Initiative ("Initiative") to gain worldwide recognition of the value of Ethiopia's coffees, to create greater demand for its coffees and to recoup more of the retail value of the coffees for its farmers. The Initiative received preliminary funding from the United Kingdom's Department for International Development and continues to receive the assistance of a non-profit IP organization and the *pro bono* legal services of a top Washington, D.C. based law firm.¹²² The Initiative has already shown to be successful. Since 2007, more than sixty companies have signed licensing agreements with Ethiopia.¹²³

The Initiative is being implemented in phases. During the first phase, Ethiopia will seek to obtain trademarks worldwide for twelve of its heritage coffees and to obtain licensing agreements directly with retailers to sell these coffees. Harar®, Yirgacheffe® and Sidamo® are the first three coffees Ethiopia will trademark.¹²⁴ Ethiopia's move to trademark its coffees in March 2005 took some enterprises—

¹¹⁸ Surip Mawardi, *Geographical Indication Application in Indonesia: Opportunities and Challenges* (2005), http://www.ecapproject.org/fileadmin/ecapII/pdf/en/activities/national/indonesia/gi_dec05_2/SuriMawardi_GI_PROMOTING_.pdf.

¹¹⁹ *Id.*

¹²⁰ *Id.*

¹²¹ WIPO, Worldwide Symposium on Geographical Indications: Establishment of Geographical Indication Protection System in Indonesia, Case in Coffee, ¶¶ 3-4, WIPO/GEO/SOF/09/3 (June 11, 2009).

¹²² The EIPO receives consulting services from LightYears IP, a non-profit organization "dedicated to alleviating poverty by assisting developing country producers gain ownership of their Intellectual Property" and legal services from the Washington, D.C. office of Arnold & Porter, LLP. Light Years IP, <http://www.lightyearsip.net/aboutus.shtml> (last visited Feb. 14, 2009).

¹²³ Ethiopian Coffee Network Homepage, <http://www.ethiopiancoffeenetwork.com/> (last visited Mar. 15, 2009).

¹²⁴ Faris, *supra* note 117.

Lessons Learned from Ethiopia

including Starbucks, the NCA and the SCAA—by surprise.¹²⁵ In 2004, Starbucks applied for trademark registration of, “Shirkinia Sun-Dried Sidamo.”¹²⁶ This coffee blend was produced as part of Starbucks’ Black Apron Exclusives¹²⁷ line of limited edition coffees. The coffee was priced at \$26 per pound and released for purchase in October 2005.¹²⁸

Ethiopia requested that Starbucks withdraw its trademark application to allow its own trademark application to move forward.¹²⁹ Starbucks’ initial response to Ethiopia was that Starbucks believed a certification mark or a GI was a more appropriate designation for Ethiopia’s heritage coffees because a GI would establish standards and guarantee the quality of the coffees.¹³⁰ Ethiopia responded that the form of intellectual property it would seek for its heritage coffees was Ethiopia’s decision to make, not Starbucks.¹³¹ Starbucks withdrew its application for “Shirkinia Sun-Dried Sidamo” stating it was a limited edition coffee, but the dispute did not end there.

Two weeks prior to Starbucks’ withdrawal of its application, the NCA filed a letter of opposition with the USPTO claiming that the word “Sidamo” was a generic word for coffee from a particular region in Ethiopia and thus not entitled to trademark registration. The NCA filed over six hundred pieces of evidence to support its claim.¹³² Sidamo was initially denied trademark registration based upon this evidence.¹³³ Ethiopia appealed the decision. The dispute was resolved in Ethiopia’s favor, but not before the controversy received worldwide publicity.¹³⁴

¹²⁵ *Id.*

¹²⁶ U.S. Trademark Application Serial No. 78,589,307 (filed Mar. 17, 2005), *available at* <http://tess2.uspto.gov/bin/gate.exe?f=tess&state=jjjrrj.1.1> (“Sidamo”); U.S. Trademark Application Serial No. 78,431,410 (abandoned July 8, 2006), *available at* <http://www.uspto.gov/main/trademarks.htm> (“Shirkinia Sun-dried Sidamo”).

¹²⁷ Starbucks Coffee Co. Canada Homepage, Starbucks Black Apron Exclusives, http://www.starbucks.ca/en-ca/_Worlds+Best+Coffee/Black+Apron+Exclusives.htm (last visited Feb.13, 2009).

¹²⁸ Press Release, Starbucks Corporation, Savor Shirkinia Sun-Dried Sidamo Exclusively at Starbucks; Taking a Risk, Starbucks Helps Create New Coffee, Potential New Revenue Stream for Farmers (Oct. 3, 2005), http://www.csrwire.com/press/press_release/24558-Savor-Shirkinia-Sun-Dried-Sidamo-Exclusively-at-Starbucks-Taking-a-Risk-Starbucks-Helps-Creat-New-Coffee-Potential-New-Revenue-Stream-for-Farmers.

¹²⁹ Faris, *supra* note 117.

¹³⁰ *Id.*

¹³¹ Letter from Getachew Mengiste, Dir. Gen. Eth. Intellectual Prop. Office, to Jim Donalds, Starbucks Chief Executive (Nov. 3, 2006) (responding to Starbucks’ assertion that certification marks were Ethiopia’s best form of protection, Director General of the Ethiopian Intellectual Property Office, Getachew Mengiste, asserts that trademark protection “would strengthen the position of farmers, enabling them to get a reasonable return for their product”) (on file with Loyola Chicago International Law Review).

¹³² National Coffee Association, *supra* note 4.

¹³³ USPTO, TDR Database, <http://tportal.uspto.gov/external/portal/tow> (search U.S. Trademark Application Serial No. 78,589,307; then open “Administrative Response” dated Aug. 17, 2006).

¹³⁴ Numerous articles regarding the controversy were printed in newspapers internationally and can be found on the internet. *See, e.g.,* Faris, *supra* note 117; Acey, *supra* note 131.

VII. Benefits of Trademarks versus GIs

Ethiopia can derive many benefits from trademark that would not have been available had Ethiopia chosen to pursue GI certification for its heritage coffees. As stated, GIs require a country to have an internal registration and certification process which is resource intensive and virtually impossible for nations with very little infrastructure to develop. Thus, GI certification and registration rewards developed nations that already have established—over many decades—IP systems and infrastructures that can support GI certification systems. It burdens less developed countries by requiring them to expend valuable resources to create a GI system just to be able to enter the international marketplace and, possibly, even just to lay claim to their own TK. The nations that will benefit the most from the EU's proposal for a mandatory multilateral registry of GIs are the nations that have spent years developing, implementing and perfecting their GI legal regimes to meet their needs. Many developing nations have yet to adequately catalog their IP assets. Requiring developing nations to spend resources to create a system to identify standards to ensure the quality of their products will only create another hurdle for them to enter the marketplace.

By seeking a trademark and not a certification mark, Ethiopia not only avoided incurring the costs to establish and implement a GI system, but also enabled itself to honor its culture while moving towards the future. GIs are not just tied to a region, but also to the methods and practices used to produce a product. Therefore, GIs could potentially leave developing nations “in the past” forcing them to rely upon archaic methods of production instead of developing new, more efficient or environmentally-friendly technologies.

The words Harar, Sidamo and Yirgacheffe are unique to Ethiopia. By trademarking these words, Ethiopia ensured that they will always be associated with Ethiopia and its coffees. Because the value of Ethiopia's trademarks will depend solely upon the quality of its coffees and not on its production process, Ethiopia can explore alternative agricultural and processing methods without seeking or approving amendments to standards described in its internal GI certification standards. For example, Ethiopia can seek to have some of its crops certified as organic or Bird-Friendly®. Bird-Friendly® identifies organic certified coffee grown on farms with a shade cover that provides substantial habitat for migratory and resident birds in tropical landscapes.”¹³⁵ Shade-grown coffee plantations provide habitat not just for migratory birds but also for insects, mammals and other inhabitants of forests.¹³⁶ In February 2008, the Anifilo Specialty Coffee Enterprise in Ethiopia became the first coffee farm in Africa to be certified by the Smithsonian Migratory Bird Center as Bird-Friendly®.¹³⁷ The article

¹³⁵ Smithsonian Nat'l Zoological Park Homepage, Bird Friendly® Coffee Program History and Quick Facts, <http://nationalzoo.si.edu/ConservationAndScience/MigratoryBirds/Coffee/history.cfm> (last visited Feb. 13, 2009).

¹³⁶ *Id.*

¹³⁷ Smithsonian Nat'l Zoological Park Homepage, Bird Friendly® Coffee: Back to Origin, http://nationalzoo.si.edu/ConservationAndScience/MigratoryBirds/Coffee/Bird_Friendly/ethiopia_certification.cfm (last visited Feb. 13, 2009).

Lessons Learned from Ethiopia

announcing the certification was placed prominently on the Bird-Friendly® web page and provided a link to where one could find and buy Bird Friendly® coffees, including the coffees from Anifilo. Bird Friendly® is a registered certification mark with the USPTO.¹³⁸ Certification marks such as Bird-Friendly® can add value to Ethiopia's coffees by offering consumers the opportunity to purchase a product that reflects their values—whether they are about the environment or fair labor practices. They can also provide additional advertising for the products they certify.

In 2004, a study conducted by the Institute of Organic Agriculture at the University of Bonn concluded that “Ethiopia has the potential to produce certified high quality organic coffee due to favorable growing conditions and the high diversity of genetic resources” and that Ethiopian “coffee farmers [are] in a position to pioneer certified organic crop production.”¹³⁹ Thus, Ethiopia is uniquely positioned to produce certified organic coffee—a growing niche market.

Obtaining trademarks has provided Ethiopia with strong IPRs in its heritage coffees and enabled it to keep the flexibility to continue to add value to its crops via international certification marks such as Bird-Friendly® while Ethiopian farmers continue to develop their agricultural practices. GI certification at this point, might well have left Ethiopia stuck in the past instead of moving towards the future.

VIII. The Internet: A Valuable Tool

Ethiopia has wisely made use of the internet and other modern day technologies to advertise its coffees, garner support for its cause, and inform the world about the poverty and plight of its farmers. Innovatively, Ethiopia is also effectively using the internet to create a licensing network with distributors of its coffees. This innovative approach to marketing and licensing shows how a developing nation can use today's technology to build relationships with the end users of its goods.

The EIPO established a separate website, the Ethiopian Coffee Network, specifically for the Initiative.¹⁴⁰ On the website, one can find information about the Initiative, press releases and information on how an individual can help support the Initiative. More than 100,000 people around the world have joined in the effort to spread the word about Ethiopian coffees and support the Initiative.¹⁴¹ Thus, the Initiative has created a grassroots movement to garner support for Ethiopia, as well as its coffees, farmers and viewpoints. The Initiative invites people to join its “network” or “partnership,” and thereby emphasizes that Ethiopia is seeking to collaborate with all people in the distribution channel, including con-

¹³⁸ U.S. Trademark No. 3,092,532 (registered May 16, 2006), available at <http://tess2.uspto.gov/bin/showfield?f=doc&state=4008:the24t.2.1>.

¹³⁹ Mekuria et al., *supra* note 28, at 5.

¹⁴⁰ See generally Ethiopian Coffee Network, <http://www.ethiopiancoffeenetwork.com> (last visited Feb. 14, 2009).

¹⁴¹ *Id.*

Lessons Learned from Ethiopia

sumers. Ethiopia's partnership approach will help to create goodwill—the crucial element to increase the brand value of an entity's trademark.

This grassroots approach to garner support for its Initiative appears, so far, to be successful. When Starbucks did not sign a licensing agreement with Ethiopia within a reasonable timeframe, as determined by Ethiopia and its supporters which include Oxfam America, Oxfam America took action. Oxfam created a "Starbucks Day of Action Toolkit" and posted it on its website.¹⁴² The toolkit consisted of three pieces of paper including instructions for the day of protest and a petition to show support for Ethiopia. Oxfam initiated a campaign for supporters to download the toolkit and chose December 17, 2006 for consumers to "take action." On "Starbucks Action Day," the supporter (or protester, depending on one's viewpoint) entered a Starbucks' store, asked for a cup of Ethiopian coffee and then gave the store manager a petition and asked the manager to show his or her support for Ethiopia and sign the petition.¹⁴³ Oxfam declared the day a huge success with thousands of activists participating and showing their support for Ethiopia's Initiative.¹⁴⁴

Yet another innovative way the Initiative is using the internet is to secure licenses with coffee retailers. The Ethiopian Coffee Network's standard trademark licensing agreement is posted in Adobe format on its website. *All visitors* to the website—not just coffee house owners or coffee distributors—are encouraged to read the document, download it, print it, hand it to their local coffee shop and inform the owner that if he or she is selling Harar®, Sidamo® or Yirgacheffe® then he or she needs to sign the agreement and mail it or fax it to one of the contacts listed. Or the visitor can inform Ethiopia about where he or she saw their coffees being sold and let Ethiopia contact the coffee shop directly.

Wherever you are in the world, please write and tell us about coffee products that you have seen on your local coffee shop or supermarket shelves which especially feature one of these three coffees.

The information we need to know is:

- The brand name of the product
 - The name of the coffee company that produces the product
 - Where you saw it - the name of the retailer chain or shop
 - What price and currency per oz/lb or kilo was it on sale for
- Once you have gathered this information, please send it to:
licensing@ethiopiancoffeenetwork.com¹⁴⁵

This unique approach to obtain licenses for its coffees capitalizes on the energy and political sensibilities of people who are committed to fair trade initia-

¹⁴² Oxfam America, Starbucks Day of Action Toolkit (2006), http://www.oxfamamerica.org/whatwedo/campaigns/coffee/starbucks/news_publications/dayofactiontoolkit/sbux_dayofactiontoolkit.

¹⁴³ *Id.*

¹⁴⁴ Oxfam America, Starbucks Day of Action: Results, <http://www.oxfamamerica.org/whatwedo/campaigns/coffee/starbucks/dayofaction> (last visited Mar. 10, 2009).

¹⁴⁵ Ethiopian Coffee Network, Trademark & Licensing Initiative, <http://www.ethiopiancoffeenetwork.com/about8.shtml> (last visited Mar. 10, 2009).

tives. These people are tapped into the internet culture, have the time, and are willing to make the effort to ensure their local coffee house, if it is selling any of Ethiopia's coffees, has the appropriate license to do so. Importantly, these coffee consumers are also helping Ethiopia to comply with the requirements of trademark use including policing and enforcing how its trademarks are used.

The licensing agreement—available for the United States, Canada, EU/UK and Australia—sets out standard terms for use of the trademarks.¹⁴⁶ The agreement is for a period of five years, does not require payment of royalty of any kind during that time, but does require the licensee to abide by several requirements.¹⁴⁷ Of course, one requirement is that the licensee will only use the trademarks to identify coffees that are 100% Harar®, Sidamo® or Yirgacheffe®.¹⁴⁸ Also, the licensee agrees to not use the marks on any coffee blends the retailer sells unless Ethiopia has granted permission to do so.¹⁴⁹ This condition ensures that Ethiopia's coffees will remain distinctive in flavor and taste.

Additionally, the licensee accepts the burden to comply with all relevant local laws regarding advertising and display of the trademarks.¹⁵⁰ The licensee also agrees to cooperate with Ethiopia in defending and protecting the trademarks against infringement by other users.¹⁵¹ This affirmative duty on the licensee's part to defend the trademarks is noteworthy because it helps to shift or share the burden of enforcement of the trademarks solely from Ethiopia to the licensees as well. The rationale for licensees to accept this obligation is that the coffees for which they have licenses will only retain their value if use of the trademarks is properly enforced. Finally, the licensee agrees to share with Ethiopia sales information and other information as Ethiopia may reasonably request.¹⁵² This provision is an inventive method for Ethiopia to gather important data regarding the sales and pricing of its products so that Ethiopia will be better able to estimate the value of its coffees in the marketplace.

IX. What Other Developing Nations Can Learn from Ethiopia

It is too early to determine if Ethiopia's Initiative will succeed in the long term. For now, Ethiopia's coffees are being heralded as some of the best in the world. Ethiopia was the portrait country for the SCAA's 20th Annual Conference & Exhibition which took place in May 2008 in Minneapolis, Minnesota.¹⁵³

¹⁴⁶ Ethiopian Coffee Network, Trademark and License Agreements, <http://www.ethiopiancoffee-network.com/licensing3.shtml> (last visited Apr. 1, 2009).

¹⁴⁷ *Id.*

¹⁴⁸ *Id.*

¹⁴⁹ *Id.*

¹⁵⁰ *Id.*

¹⁵¹ *Id.*

¹⁵² *Id.*

¹⁵³ Press Release, Specialty Coffee Association of America, Specialty Coffee Association of America Previews 20th Annual Conference & Exhibition (Dec. 10, 2007), http://www.scaa.org/press_article.asp?article_id=124379074.

If Ethiopia can provide high quality coffees and find a market that is willing to pay for its premium coffees, its Initiative may provide the returns Ethiopia seeks.

Regardless of the success of the Initiative, it will provide other developing nations with valuable information that may aid them as they develop their own IP systems. Notably, the EIPO was established in 2003—just six years ago. As stated, one of the first tasks taken by the EIPO was to determine and catalog Ethiopia's IP assets. From this assessment, EIPO moved forward with the assistance of a non-profit consulting firm and the legal aid from a premium law firm to advise them. Most importantly, Ethiopia is designing its IP system to specifically meet the political, economic and cultural needs of its people. For example, all land in Ethiopia is owned by the government. Thus, the government has primary control over how the land is used. Therefore, an IP scheme that first focused on land-use, specifically, agricultural crops, was one that was within the government's control. Other tradition-based practices including medicinal therapies and how Ethiopia can protect IPRs in them will be addressed in the future.¹⁵⁴

Whether asserting a trademark in indigenous TK is the best strategy for another developing nation depends on that nation's infrastructure including its form of government, property ownership scheme, its IP assets, and the financial, legal and marketing support it has or can obtain. What the Ethiopian Trademark and Licensing Initiative has shown is that with the proper support, a developing nation that has yet to become a member of the WTO can compete in the worldwide marketplace. In June 2007, after much discussion, Starbucks signed a licensing agreement with Ethiopia.¹⁵⁵ In December 2007, Starbucks announced that the company will open a Starbucks Farmer Support Center in Addis Ababa.¹⁵⁶ The Support Center will provide resources to coffee communities throughout Ethiopia to improve coffee quality and increase the number of farmers who participate in Starbucks' sustainable coffee buying guidelines. Perhaps the call for "Free trade, not aid," should be changed to "Free trade and some legal aid."

X. Conclusion

Ethiopia's Trademarking and Licensing Initiative provides credible evidence that a developing nation can claim its place in the world marketplace as well as claim ownership of its culture, heritage and TK without claiming a GI. It thus calls into doubt the EU's assertion that stronger GI protection will benefit developing nations. Stronger GI protection very well could benefit developing nations in the future, but implementing a complex IP system that incorporates GI standards and certification criteria would likely command more resources than many developing nations can afford. Thus, a mandatory multilateral registry will cre-

¹⁵⁴ Podcast 58-Yirgacheffe, Sidamo, Harrar. . . oh my!, <http://www.portafilter.net/2006/12/podcast-58-yirgacheffe-sidamo-harrar-oh.html> (last visited March 10, 2009).

¹⁵⁵ *Ethiopia and Starbucks Reach Coffee Agreement*, ICTSD, July 6, 2009, <http://ictsd.net/i/news/biores/9121/>.

¹⁵⁶ Press Release, Light Years IP, Ethiopian Prime Minister & Starbucks Chairman Discuss Ways to Support Ethiopian Coffee Industry (Dec. 3, 2007), <http://www.csrwire.com/PressReleasePrint.php?id=10270>.

ate a hurdle for developing nations to enter the world market because of the costs and infrastructure needed to comply with such a system. For Ethiopia, GI certification at this time was not a possibility. If Starbucks had successfully registered its trademark for “Shirkinia Sun-Dried Sidamo,” the word “Sidamo” may have been lost to the people of Ethiopia in the same way the word “Toraja” was lost to the people of Toraja.

The EU’s call for stronger GI protection, upon closer inspection, is clearly self-serving. It will be years before developing nations can benefit from stronger GI protection because it will take years for many developing nations to catalog their IP assets and create an IP system that fits both their needs and meets the requirements of the TRIPs Agreement. Meanwhile, the EU’s TK is protected by its current GI system—a system that took many decades to develop and is still being developed. The EU’s proposed “claw back” provision appears to be a mechanism to extract a premium for TK word terms that have entered the public domain.

Though the dispute regarding the “claw back” provision seems to be predominantly between the EU and the United States, the result could have a long-standing impact. If the EU is successful in its quest to reclaim its TK word terms and invalidate trademarks and trade names that incorporate words that originated in the EU, it is undeniable that it will have an impact on the U.S. agricultural industry. But it is also possible that through creative marketing and advertising of the new word terms U.S. producers use to identify foods once associated with the foods’ countries of origin, the United States will be able to minimize the impact. The likely result will not be that the demand for FETA will be greater in America in ten years, but rather that the next generation of Americans will not know what FETA is to ask for it by name.

If producers in the EU are unable to capitalize on the goodwill associated with being the “original” or the “authentic” producer of a particular product, or by distinguishing themselves in the marketplace by the quality of their products, removing the name of the product from public use and thus public knowledge does not appear to be a sound marketing strategy. Another way for EU producers to view the labels “Roquefort-style” on American or Australian manufactured cheese is to see them as free advertising for the “original” Roquefort cheese. If “Roquefort-style” did not exist, would consumers know to look for or ask for the original Roquefort cheese? Perhaps instead of requesting the “claw back” of these generic food terms, a better strategy would be to request that every product labeled made “in the style of” or “like” an EU PDO or PGI agricultural product should be required to clearly state on its label the origin of the food product. Thus, if a consumer wants to seek the “original” or “authentic” version of the product, he or she will know what to ask for.

An issue of greater concern though regards the precedent the “claw back” provision could establish for the future. Many developing nations were colonized by nations in the EU. An audit of both company names and products manufactured in the EU would invariably show that some of the trademarked company names and goods are word terms from cultures outside of the EU. If the EU can reclaim word terms that have become generic and have been incorpo-

Lessons Learned from Ethiopia

rated into trade names and products of nations outside of its boundaries, what possible rationale could the EU present for not allowing other nations to reclaim their indigenous word terms at some time in the future as well?