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No Logo: Nike, Labor Rights, Trademark Law, and The Trans-Pacific Partnership, Submission to the Senate Foreign Affairs, Trade, and References Committee

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THE SENATE FOREIGN AFFAIRS, DEFENCE AND TRADE
REFERENCES COMMITTEE

NO LOGO: NIKE, LABOR RIGHTS, TRADE MARK LAW,
AND THE TRANS-PACIFIC PARTNERSHIP

Adbusters, Corporate America Flag

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Executive Summary

This submission provides a critical analysis of the treatment of trade mark law in Chapter 18 of the Intellectual Property Chapter of the Trans-Pacific Partnership. Through a discussion of the topic, this submission also considers issues in respect of Labour Rights under Chapter 19 of the Trans-Pacific Partnership. First, the submission considers President Barack Obama’s pitch for the Trans-Pacific Partnership at Nike Headquarters. It examines the criticism of his position by fair trade activists, unions, and culture-jammers. Second, it evaluates the provisions on trade mark law in the Trans-Pacific Partnership. Special attention is paid to the treatment of well-known marks. Third, this submission considers the provisions on counterfeiting in the Trans-Pacific Partnership – which build upon the Anti-Counterfeiting Trade Agreement. Fourth, this submission examines the text on Internet Domain Names and cybersquatting. Finally, it looks at the treatment of trade mark law and geographical indications.

Recommendation 1

The Anti-Counterfeiting Trade Agreement 2011 was rejected because it failed to provide appropriate safeguards in respect of human rights, consumer protection, competition, privacy laws, and access to justice and rule of law.

Recommendation 2

The Trans-Pacific Partnership seeks to implement measures relating to trade mark law and related rights, counterfeiting, and border measures, which were previously rejected with the Anti-Counterfeiting Trade Agreement.
Recommendation 3

In terms of its philosophical approach, the *Trans-Pacific Partnership* boosts the rights of trade mark owners. There is little emphasis upon other public policy concerns such as freedom of speech, consumer rights, and competition policy.

Recommendation 4

The *Trans-Pacific Partnership* seeks to boost the substantive and procedural rights of trade mark holders – particularly well-known and famous trade mark holders.

Recommendation 5

The *Trans-Pacific Partnership* also expands the range of civil remedies and criminal offences in respect of trade mark law – particularly with respect to wilful trademark counterfeiting.
Recommendation 6

The *Trans-Pacific Partnership* also expands the range of border measures in respect of trade mark law.

Recommendation 7

The *Trans-Pacific Partnership* also contains provisions on Internet Domain Names and cybersquatting. Such measures are superfluous – given the existing range of national and international measures and institutions in respect of Internet Domain Names and cybersquatting. Such regional provisions further complicate the regulation of Internet Domain Names, internationally.
Recommendation 8

The *Trans-Pacific Partnership* contains extensive provisions in respect of trade mark law and geographical indications. The international agreement favours the vision of the United States Trade Representative. The European Union has preferred an expansionist vision of geographical indications. Given its position in between the United States and the European Union, Australia will be very much caught in the middle of such tensions in current and future trade negotiations on geographical indications.

Recommendation 9

The *Trans-Pacific Partnership* also raises concerns about trade mark owners invoking the investor-state dispute settlement regime in respect of disputes about labelling (for instance, in respect of tobacco, food and alcohol).

Recommendation 10

Overall, the *Trans-Pacific Partnership* lacks balance in the field of trade mark law and related rights. The agreement boosts the intellectual property rights, investor rights, and labor interests of well-known multinational companies. The international treaty, though, fails to properly provide countervailing protection for consumer rights, competition policy, and labor standards.
Recommendation 11

Furthermore, the *Trans-Pacific Partnership* will result in greater fragmentation of international regulation and governance of trademark law and related rights. The regional agreement will dilute the key role of international organisations such as the World Intellectual Property Organization, the World Trade Organization, and ICANN.

Recommendation 12

The *Trans-Pacific Partnership* has only a weak Labour Chapter. As a result, there has been significant concern about how the Pacific Rim agreement will affect jobs, wages, labor standards and conditions. There has been a particular worry about whether the *Trans-Pacific Partnership* will encourage greater out-sourcing by multinational companies.
Biography

Dr Matthew Rimmer is a Professor in Intellectual Property and Innovation Law at the Faculty of Law, at the Queensland University of Technology (QUT). He is a leader of the QUT Intellectual Property and Innovation Law research program, and a member of the QUT Digital Media Research Centre (QUT DMRC) the QUT Australian Centre for Health Law Research (QUT ACHLR), and the QUT International Law and Global Governance Research Program. Rimmer has published widely on copyright law and information technology, patent law and biotechnology, access to medicines, plain packaging of tobacco products, intellectual property and climate change, and Indigenous Intellectual Property. He is currently working on research on intellectual property, the creative industries, and 3D printing; intellectual property and public health; and intellectual property and trade, looking at the Trans-Pacific Partnership, the Trans-Atlantic Trade and Investment Partnership, and the Trade in Services Agreement. His work is archived at SSRN Abstracts and Bepress Selected Works.

Dr Matthew Rimmer holds a BA (Hons) and a University Medal in literature (1995), and a LLB (Hons) (1997) from the Australian National University. He received a PhD in law from the University of New South Wales for his dissertation on The Pirate Bazaar: The Social Life of Copyright Law (1998-2001). Dr Matthew Rimmer was a lecturer, senior lecturer, and an associate professor at the ANU College of Law, and a research fellow and an associate director of the Australian Centre for Intellectual Property in Agriculture (ACIPA) (2001 to 2015). He was an Australian Research Council Future Fellow, working on Intellectual Property and Climate Change from 2011 to 2015. He was a member of the ANU Climate Change Institute.
Rimmer is the author of *Digital Copyright and the Consumer Revolution: Hands off my iPod* (Edward Elgar, 2007). With a focus on recent US copyright law, the book charts the consumer rebellion against the *Sonny Bono Copyright Term Extension Act 1998* (US) and the *Digital Millennium Copyright Act 1998* (US). Rimmer explores the significance of key judicial rulings and considers legal controversies over new technologies, such as the iPod, TiVo, Sony Playstation II, Google Book Search, and peer-to-peer networks. The book also highlights cultural developments, such as the emergence of digital sampling and mash-ups, the construction of the BBC Creative Archive, and the evolution of the Creative Commons. Rimmer has also participated in a number of policy debates over Film Directors’ copyright, the *Australia-United States Free Trade Agreement 2004*, the *Copyright Amendment Act 2006* (Cth), the *Anti-Counterfeiting Trade Agreement 2011*, and the *Trans-Pacific Partnership*. He has been an advocate for Fair IT Pricing in Australia.

Rimmer is the author of *Intellectual Property and Biotechnology: Biological Inventions* (Edward Elgar, 2008). This book documents and evaluates the dramatic expansion of intellectual property law to accommodate various forms of biotechnology from micro-organisms, plants, and animals to human genes and stem cells. It makes a unique theoretical contribution to the controversial public debate over the commercialisation of biological inventions. Rimmer also edited the thematic issue of Law in Context, entitled *Patent Law and Biological Inventions* (Federation Press, 2006). Rimmer was also a chief investigator in an Australian Research Council Discovery Project, “Gene Patents In Australia: Options For Reform” (2003-2005), an Australian Research Council Linkage Grant, “The Protection of Botanical Inventions” (2003), and an Australian Research Council Discovery Project, “Promoting Plant Innovation in Australia” (2009-2011). Rimmer has participated in inquiries into plant breeders’ rights, gene patents, and access to genetic resources.
Rimmer is a co-editor of a collection on access to medicines entitled *Incentives for Global Public Health: Patent Law and Access to Essential Medicines* (Cambridge University Press, 2010) with Professor Kim Rubenstein and Professor Thomas Pogge. The work considers the intersection between international law, public law, and intellectual property law, and highlights a number of new policy alternatives – such as medical innovation prizes, the Health Impact Fund, patent pools, open source drug discovery, and the philanthropic work of the (Red) Campaign, the Gates Foundation, and the Clinton Foundation. Rimmer is also a co-editor of *Intellectual Property and Emerging Technologies: The New Biology* (Edward Elgar, 2012).

Rimmer is a researcher and commentator on the topic of intellectual property, public health, and tobacco control. He has undertaken research on trade mark law and the plain packaging of tobacco products, and given evidence to an Australian parliamentary inquiry on the topic.

Rimmer is the author of a monograph, *Intellectual Property and Climate Change: Inventing Clean Technologies* (Edward Elgar, September 2011). This book charts the patent landscapes and legal conflicts emerging in a range of fields of innovation – including renewable forms of energy, such as solar power, wind power, and geothermal energy; as well as biofuels, green chemistry, green vehicles, energy efficiency, and smart grids. As well as reviewing key international treaties, this book provides a detailed analysis of current trends in patent policy and administration in key nation states, and offers clear recommendations for law reform. It considers such options as technology transfer, compulsory licensing, public sector licensing, and patent pools; and analyses the development of Climate Innovation Centres, the Eco-Patent Commons, and environmental prizes, such as the L-Prize, the H-Prize, and the X-Prizes.
Rimmer is currently working on a manuscript, looking at green branding, trade mark law, and environmental activism.

Rimmer has also a research interest in intellectual property and traditional knowledge. He has written about the misappropriation of Indigenous art, the right of resale, Indigenous performers’ rights, authenticity marks, biopiracy, and population genetics. Rimmer is the editor of the collection, *Indigenous Intellectual Property: A Handbook of Contemporary Research* (Edward Elgar, 2015).
No Logo: Nike, Labor Rights, Trade Mark Law, 
and The Trans-Pacific Partnership

Matthew Rimmer

Introduction

The Trans-Pacific Partnership is a sweeping trade agreement, spanning the Pacific Rim, and covering an array of topics, including intellectual property.\(^1\) There has been much analysis of the intellectual property chapter of the Trans-Pacific Partnership – both in terms of the leaked versions of draft text, and the final version published after the Atlanta talks in 2015. Julian Assange, WikiLeaks’ Editor-in-Chief, observed:

> The selective secrecy surrounding the TPP negotiations, which has let in a few cashed-up megacorps but excluded everyone else, reveals a telling fear of public scrutiny. By publishing this text we allow the public to engage in issues that will have such a fundamental impact on their lives.\(^2\)

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Critical attention has focused upon the lack of transparency surrounding the agreement, copyright law and the digital economy; patent law, pharmaceutical drugs, and data protection; and the criminal procedures and penalties for trade secrets. The topic of trade mark law and related rights, such as internet domain names and geographical indications, deserves greater analysis.

The final Intellectual Property text of the *Trans-Pacific Partnership* reveals a concerted effort to protect the rights and remedies of trade mark owners. The secret agreement is intent upon protecting famous, well known brands. The *Trans-Pacific Partnership* is a trade deal designed to protect global brands—such as sporting brands like Nike; the information technology trade marks of Apple, Microsoft, IBM, and Google; the logos of Big Food such as McDonalds, and Big Soda, like Pepsi and Coca-Cola.

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Much of the discredited *Anti-Counterfeiting Trade Agreement* has been revived in the trademark provisions of the *Trans-Pacific Partnership*.\(^7\) The deal seeks to expand the rights and remedies of trade mark owners to address counterfeiting and domain name cybersquatting. There has been some alarm about the outlandish role of the *Trans-Pacific Partnership* in the regulation of Internet governance. There has also been fierce debate over the relationship between trade mark law and geographical indications. The European Union has been concerned about the approach taken in the *Trans-Pacific Partnership*.

The No Logo movement has been concerned about the *Trans-Pacific Partnership*, and its impact upon intellectual property, fair trade, and labor rights. The trade mark sections of the *Trans-Pacific Partnership* lacks sufficient safeguards for the public interest in freedom of speech, cultural criticism, and competition.

In her classic 1999 text, *No Logo: Taking Aim at the Brand Bullies*, the Canadian writer Naomi Klein warned of the rise of big brands with the expansion of protection for well-known and famous trade marks.\(^8\) She observed:

> Since many of today’s best-known manufacturers no longer produce products and advertise them, but rather buy products and “brand” them, these companies are forever on the prowl for creative new ways to build and strengthen their brand images. Manufacturing products may require drills, furnaces, hammers and the like, but creating a brand calls for a completely different set of tools and materials. It

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\(^7\) *Anti-Counterfeiting Trade Agreement* 2011, [2011] ATNIF 22, not yet in force.

requires an endless parade of brand extensions, continuously renewed imagery for marketing and, most of all, fresh new spaces to disseminate the brand’s idea of itself.⁹

She focused upon the push to expand the reach of brands, with globalisation and the development of international trade agreements. Klein that ‘this corporate obsession with brand identity is waging a war on public and individual space: on public institutions such as schools, on youthful identities, on the concept of nationality and on the possibilities for unmarketed space.’¹⁰

Klein explored the growing opposition among culture jammers to corporate rules. She explained the title of her best-selling book: ‘The book is hinged on a simple hypothesis: that as more people discover the brand-name secrets of the global logo web, their outrage will fuel the next big political movement, a vast wave of opposition squarely targeting transnational corporations, particularly those with very high name-brand recognition’.¹¹ Klein charted the counter-attacks by culture-jammers, Adbusters, and the fair trade movement such trade marks. In the Tenth edition of the book, Klein reflected that the techniques of branding had thrived and adapted.¹²

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⁹ Ibid.
¹⁰ Ibid.
¹¹ Ibid.
In retrospect, *No Logo* is prophetic about the corporate efforts to expand the protection in respect of trade mark law, and the associated rights and remedies, particularly through international trade agreements—such as the *Trans-Pacific Partnership*.

This paper provides a critical analysis of the *Trans-Pacific Partnership*, and its treatment of trade mark law. It analyses both draft texts of the trade agreement, as well as the final version of the international trade agreement. This analysis has a number of parts. First, it considers President Barack Obama’s pitch for the *Trans-Pacific Partnership* at Nike Headquarters. It examines the criticism of his position by fair trade activists, unions, and culture-jammers. Second, it evaluates the provisions on trade mark law in the *Trans-Pacific Partnership*. Special attention is paid to the treatment of well-known marks. Third, it considers the provisions on counterfeiting in the *Trans-Pacific Partnership*. There are certainly echoes of the *Anti-Counterfeiting Trade Agreement*. Fourth, it examines the text on Internet Domain Names and cybersquatting. Finally, it looks at the treatment of trade mark law and geographical indications. There is also a brief mention of the growing tensions between trade mark holders and public health advocates—particularly around tobacco control and plain packaging of tobacco products, alcohol regulation, and food nutrition.

1. **Just Do It - Nike**

On the 8th May 2015, President Barack Obama made a pitch for the *Trans-Pacific Partnership* at Nike Inc. Headquarters in Oregon, telling the corporate audience, ‘Just Do It’. 13 Well known trade mark holder Nike has been a prominent supporter of the Pacific Rim trade agreement.

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13 President Barack Obama, ‘Remarks by the President on Trade at Nike, Inc., Beaverton, Oregon’, 8 May 2015, [https://www.whitehouse.gov/the-press-office/2015/05/08/remarks-president-trade](https://www.whitehouse.gov/the-press-office/2015/05/08/remarks-president-trade)
Nonetheless, fair trade, civil society, and labor rights groups protested outside the Nike event, complaining that the *Trans-Pacific Partnership* would expand corporate rights, but undermine labor rights.

President Barack Obama provides a positive case for the need to pass the *Trans-Pacific Partnership*:

So the *Trans-Pacific Partnership* that we’re working on, it’s the biggest trade deal that we’re working on right now - has to do with the Asia Pacific region. And it reflects our values in ways that, frankly, some previous trade agreements did not. It’s the highest-standard, most progressive trade deal in history. It’s got strong, enforceable provisions for workers, preventing things like child labor. It’s got strong, enforceable provisions on the environment, helping us to do things that haven’t been done before, to prevent wildlife trafficking, or deforestation, or dealing with our oceans. And these are enforceable in the agreement.\(^{14}\)

Somewhat defensively, President Barack Obama also engages in a pre-emptive rebuttal of the critics of the *Trans-Pacific Partnership*. He disputes that the agreement suffers from the flaws of its predecessor – the *North American Free Trade Agreement* 1994. Obama denies that the agreement would undermine public regulation in respect of, for instance, food safety, worker safety, even financial regulations. He alleged of his critics: ‘They’re making this stuff up.’\(^{15}\) President Barack Obama also sought to shore up his support amongst Congressional Democrats who had broken away from the rest of the party to support his efforts to fast-track the *Trans-Pacific Partnership*.

\(^{14}\) Ibid.

\(^{15}\) Ibid.
President Barack Obama boosted his host, Nike Inc., saying that ‘it is great to be at the world headquarters of such an iconic company - a company that helps athletes succeed from the individual to the world stage.’\textsuperscript{16} He discussed the role of Nike Inc.:

Nike operates in the Pacific region, so they understand the competitive pressures they're under. Nike has factories all around the world. And let’s face it, Mark I think doesn't mind me saying it that some of these countries, they don't have the standards for wages and labor conditions that we have here.\textsuperscript{17}

Obama argued, contentiously, that the \textit{Trans-Pacific Partnership} would lift labor rights and standards in Vietnam: ‘So when you look at a country like Vietnam, under this agreement, Vietnam would actually, for the first time, have to raise its labor standards.’\textsuperscript{18} He noted that ‘It doesn’t mean that suddenly working conditions in Vietnam will be like they are here at Nike. Or here in Portland right away’.\textsuperscript{19} This is an optimistic reading of the Labor Rights Chapter of the \textit{Trans-Pacific Partnership}. Labor law scholars at Melbourne Law School have questioned whether the agreement will translate into effective labor standards in countries like Vietnam.\textsuperscript{20}

\begin{footnotes}
\item[Ibid.]\textsuperscript{16}
\item[Ibid.]\textsuperscript{17}
\item[Ibid.]\textsuperscript{18}
\item[Ibid.]\textsuperscript{19}
\end{footnotes}
Obama asserted that ‘outsourcing is already giving way to insourcing’.21 In his view, ‘Companies are starting to move back here to do more advanced manufacturing, and this is a trend we expect to continue’.22 He observed that ‘Nike announced that, with the Trans-Pacific Partnership, it will make new investments in advanced manufacturing -- not overseas, but right here in the United States’.23 He insisted that ‘far more Nike products would be made in the U.S.A’ and that ‘means thousands of new jobs in manufacturing and engineering and design at Nike facilities across the country, and potentially tens of thousands of new jobs along Nike’s supply chain here at home.’24 Nike is an unusual case study to use for American jobs – given that it has faced significant criticism in respect of its outsourcing of factories and jobs over the years.

Curiously, for the venue of the multinational Nike Inc. Headquarters, President Barack Obama argued that the agreement would be also of benefit to small business. He observed: ‘Sometimes when we talk about trade, we think of Nike, or we think of Boeing, or we think of G.E. -- we think about these big multinational companies’.25 Obama argued that ‘those small business leaders came here today because they understood that these markets outside the United States will help them grow, and will help them hire more folks -- just as all the suppliers to Nike or Boeing or G.E. or any of these other companies understand this is going to be critical to their

22 Ibid.
23 Ibid.
24 Ibid.
25 Ibid.
growth and their ability to create new jobs.' 26 Looking at the text of the Trans-Pacific Partnership, such a faith seems misplaced. Clearly, the final agreement is geared towards the interests of multinational big business players, with the expertise and the reach to make the most of trade agreements. 27

Framing the Trans-Pacific Partnership in terms of a nationalistic discourse, President Barack Obama ended on a patriotic note:

Because, Nike, we do not just have the best athletes in the world. We also have the best workers in the world. We also have the best businesses in the world. And when the playing field is level, nobody beats the United States of America. Nobody beats the United States of America. 28

In the conclusion to his speech, President Barack Obama even quoted the Nike catchphrase: ‘Just do it, everybody.’ 29

His enthusiasm for the Trans-Pacific Partnership was not matched outside the venue of his presentation at Beaverton, Oregon.

The Oregon Fair Trade Campaign organised protests outside Nike. 30 The group complained: ‘Today, less than 1% of the 1 million workers producing Nike products are in the U.S.’ The

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26 Ibid.
27 Ibid.
28 Ibid.
29 Ibid.
Oregon Fair Trade Campaign noted: ‘In fact, Phil Knight, the founder of Nike, even wrote his graduate school thesis on a business model based on low-wage foreign labor.’\(^3\) The civil society organisation observed that ‘Hundreds of thousands of jobs producing Nike goods are already located in Vietnam, where the minimum wage is less than 60 cents an hour’.\(^2\) In its view: ‘The TPP makes it easier for other employers to move jobs there, and not just in the shoes-and-apparel industry, but in everything from high-tech manufacturing to computer programming’.\(^3\) The Oregon Fair Trade Campaign maintained: ‘Nike is a perfect example of our lost jobs and low-wage future under the TPP.’\(^4\)

A key player in the debate over trade, Public Citizen published a press release, questioning the assertions of President Barack Obama in his Nike speech.\(^5\) Lori Wallach commented:

> The Trans-Pacific Partnership (TPP) would make it easier to offshore American jobs and push down our wages by throwing Americans into competition with Vietnamese workers who make less than 60 cents an hour has nothing to do with past NAFTA experiences but rather what is in the TPP text. Despite the extreme secrecy, because of leaks, we know that the TPP has an even expanded version of the NAFTA provisions that incentivize job offshoring and it has only the Bush-era labor and environmental standards that have failed to improve conditions.\(^6\)

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\(^1\) Ibid.
\(^2\) Ibid.
\(^3\) Ibid.
\(^4\) Ibid.
\(^6\) Ibid.
Lori Wallach commented: ‘It is ridiculous that somehow the TPP would raise wages in Vietnam so as to create new consumers for U.S. exports or, given the record under past pacts with the same labor standards, that Vietnam would face penalties, much less be thrown out of TPP, for continuing business as usual.’\textsuperscript{37} She added: ‘When President Obama said those concerned about the TPP rolling back food safety, environmental or financial regulation “are making stuff up” and no trade agreement can do that, I wondered why he did not know that already has happened repeatedly.’\textsuperscript{38}

Presidential candidate Senator Bernie Sanders published a press release, ‘Just Don’t Do It.’\textsuperscript{39} Citing Nike’s low wages for foreign workers, he said that President Obama should have cancelled the meeting with Nike Inc. His press release noted that ‘Nike has taken advantage of free-trade agreements – similar to proposed new pact which Obama is touting – to offshore tens of thousands of American jobs to Vietnam and other low-wage countries.’\textsuperscript{40} Bernie Sanders complained: ‘Nike epitomizes why disastrous unfettered free-trade policies during the past four decades have failed American workers, eroded our manufacturing base and increased income and wealth inequality in this country.’\textsuperscript{41} He elaborated:

\begin{itemize}
\item[37] Ibid.
\item[38] Ibid.
\item[40] Ibid.
\item[41] Ibid.
\end{itemize}
It is no secret why Nike is supporting the Trans-Pacific Partnership. This would increase the profits of Nike … but do nothing to encourage Nike to create one manufacturing job in this country. It would simply make Nike more money and increase the compensation packages of its executives.  

Bernie Sanders that lamented that the United States had lost 60,000 factories since 2001. His press release lamented: ‘When Nike was founded in 1964, just 4 percent of footwear sold in the United States was imported’. He noted: ‘Today, that number has soared to 98 percent and Nike, like many other shoe companies, produces all of its products overseas.’ In his view, Sanders insisted that the United States Congress should reject the free-trade agreement and instead develop policies that promote jobs in the United States.

Robert Reich, the former Labor Secretary from Bill Clinton’s administration, was also critical of President Barack Obama’s Nike Pitch. He observed that ‘Nike isn’t the solution to the problem of stagnant wages in America.’ In his, ‘Nike is the problem.’ Reich observed:

Americans made only 1 percent of the value of Nike products that generated Nike’s $27.8 billion revenue last year. And Nike is moving ever more of its production abroad. Last year, a third of Nike’s remaining 13,922 American production workers were laid off. Most of Nike’s products are made by 990,000 workers in low-wage countries whose abysmal working conditions have made Nike a symbol of global sweatshop labor. As wages have risen in China, Nike has switched most of its production to Vietnam

42 Ibid.
43 Ibid.
44 Ibid.
46 Ibid.
47 Ibid.
where wages are less than 60 cents an hour. Almost 340,000 workers cut and assemble Nike products there.\textsuperscript{48}

Robert Reich concludes: ‘In other words, Nike is a global corporation with no particularly loyalty or connection to the United States.’\textsuperscript{49} He observed that ‘Nike may be the perfect example of life under TPP, but that is not a future many Americans would choose.’\textsuperscript{50} Robert Reich has elaborated upon his larger thesis in his book, \textit{Saving Capitalism: For the Many, Not the Few}.\textsuperscript{51}

The \textit{Huffington Post} reported critically on the visit to Nike – noting ‘Tone-Deaf Move: Obama Trip has Trade Deal Skeptics Scratching Their Heads.’\textsuperscript{52} It noted that the Institute for Global Labour and Human Rights, a U.S.-based factory watchdog, issued a report entitled "A Race to the Bottom: Trans-Pacific Partnership and Nike in Vietnam."\textsuperscript{53} David Jamieson observed: ‘The report chastised Nike for not helping to ensure the rights of Vietnamese workers to bargain

\textsuperscript{48} Ibid.
\textsuperscript{49} Ibid.
\textsuperscript{50} Ibid.
\textsuperscript{52} Dave Jamieson, ‘Obama's Scheduled Visit To Nike Has Trade Deal Skeptics Scratching Their Heads’, \textit{The Huffington Post}, 7 May 2015, \url{http://www.huffingtonpost.com.au/entry/obama-tpp-nike_n_7223256.html?ncid=tweetlnkushpmg00000067&section=australia}
collectively, and for what it deemed "subsistence" wages in its contracted factories.’\textsuperscript{54} The report's author, Charles Kernaghan, commented: ‘The fact that President Obama would actually go forward with this and be at the side of Nike just doesn't make any sense whatsoever.’\textsuperscript{55}

Evan Greer, an internet activist from Fight for the Future, suggested that the President’s appearance at Nike suggested that Obama lacked a sense of irony.\textsuperscript{56} Greer suggested that the event highlighted the lack of transparency around the negotiations:

Nike’s CEO, Mark Parker, says his company has been “working closely with the US government” to get the TPP deal passed. Today, when President Obama speaks at Nike HQ, there will be a protest outside. The protesters on the security perimeter won’t have access to the TPP text, or to the millions of dollars that companies are spending to lobby for Fast Tracking the global deal, but at least they’ll have an intact sense of irony, which is more than I can say for our nation’s president.\textsuperscript{57}

The closed corporate proceedings underlined the lack of open democratic negotiations in respect of the agreement.

\textsuperscript{54} Dave Jamieson, ‘Obama's Scheduled Visit To Nike Has Trade Deal Skeptics Scratching Their Heads’, \textit{The Huffington Post}, 7 May 2015, \url{http://www.huffingtonpost.com.au/entry/obama-tpp-nike_n_7223256.html?ncid=tweetlnkushpmg00000067&section=australia}

\textsuperscript{55} Ibid.

\textsuperscript{56} Evan Greer, ‘The Trans-Pacific Partnership Suggests Obama has no Sense of Irony’, \textit{The Guardian}, 8 May 2015, \url{http://www.theguardian.com/media-network/2015/may/08/trans-pacific-partnership-obama-irony?CMP=share_btw_tw}

\textsuperscript{57} Ibid.
It was striking that the discussion of Nike omitted a discussion of its reliance upon intellectual property. Nike has extensively relied upon trade mark law to protect its reputation and its identity. Nike has also deployed trade mark dilution laws – for instance, it objected that ‘Just Jesu It’ blurred its famous mark, ‘Just Do It’.\textsuperscript{58} Other forms of intellectual property have been important as well. Of late, Nike has aggressively defended its intellectual property in respect of the Jumpman logo (copyright), its knitted running shoe (patent), and its trade secrets.\textsuperscript{59}

2. Logorama: Trade Marks

We live in an empire of signs and brands and logos. This is well captured by Logorama, a 16-minute French animated film written and directed by H5/François Alaux, Hervé de Crécy and Ludovic Houplain, and produced by Autour de Minuit.\textsuperscript{60} This award-winning film provides a surreal vision of world made up entirely of well known and famous trade marks.\textsuperscript{61}

Rochelle Cooper Dreyfuss has highlighted the evolution of trade mark law, and its underlying theoretical frameworks and philosophical underpinnings.\textsuperscript{62} She comments:


\textsuperscript{60} Logorama, http://www.youtube.com/watch?v=cgrHFEVJY4w

\textsuperscript{61} Logorama won an Oscar for Best Short Film in Animation at the 2010 USA Academy Awards, as well as a range of other prizes http://www.imdb.com/title/tt1563725/awards

\textsuperscript{62} Rochelle Cooper Dreyfuss “Expressive Genericity: Trademarks as Language in the Pepsi Generation” (1989-1990) 65 Notre Dame Law Review 397-422; and Rochelle Cooper Dreyfuss “Reconciling Trademark
Trademarks have come a long way. Originating in the stratified economy of the middle ages as a marketing tool of the merchant class, these symbols have passed into popular culture. During the journey, ideograms that once functioned solely as signals denoting the source, origin, and quality of goods, have become products in their own right, valued as indicators of the status, preferences, and aspirations of those who use them. Some trademarks have worked their way into the English language; others provide bases for vibrant, evocative metaphors. In a sense, trademarks are the emerging lingua franca: with a sufficient command of these terms, one can make oneself understood the world over, and in the process, enjoy the comforts of home.63

Rochelle Cooper Dreyfuss has stressed how trade mark law has increasingly been used and deployed to protect corporate reputation and image.

Graeme Dinwoodie and Mark Janis have commented about the evolution and transformation of trade mark law:

Trademark law has maintained its grasp on tradition, but much has changed in the past half-century: the consumer economy has become globalized, making international trademark negotiations more significant; image has become pervasive in popular culture; intellectual property has emerged as among the most vital of private assets; and the range of symbols that might function as marks has expanded to

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include additional non-verbal indicia. Firms now use trademarks – their own and those of their competitors – in new and varying ways, reflecting a greater diversity in consumer perceptions. Along many dimensions, the story of trademarks is becoming richer, and correspondingly, trademark law is becoming more subtle and complex.

By and large, there is significant consensus in respect of the trade mark provisions of the Trans-Pacific Partnership.

In the 2014 Special 301 report, the United States Trade Representative discussed its vision in respect of trade mark law:

 Trademarks help consumers distinguish a company’s products and services from competing products and services, and thereby serve a critical source identification role. The goodwill represented in a company’s trademarks is often one of the company’s most valuable business assets. However, in numerous countries legal and procedural obstacles exist to securing and enforcing trademark rights. Additionally, many countries lack transparency and consistency in administrative registration procedures. In other countries, governments often do not provide the full range of internationally-recognized trademark protections. For example, dozens of countries do not offer a certification mark system for use by foreign or domestic industries. The lack of a certification mark system can make it more difficult to secure protection for products with a quality or characteristic that consumers associate with the product’s geographic origin.64

The United States Government has been keen to address perceived legal and procedural obstacles to enforcing trade mark rights in the Pacific Rim.

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64 United States Trade Representative, Special 301 Report, 2014, https://ustr.gov/sites/default/files/USTR%202014%20Special%20301%20Report%20to%20Congress%20FINAL.pdf
In its 2015 Special 301 Report, the United States Trade Representative expressed concerns about the protection of trade marks.\textsuperscript{65}

The International Trademark Association (INTA) has lobbied strongly for an expansion of trade mark rights in the \textit{Trans-Pacific Partnership}.\textsuperscript{66} INTA has emphasized that ‘TPP participants should join the Singapore Treaty on the Law of Trademarks and the Madrid Protocol.’\textsuperscript{67} Moreover, INTA has maintained that ‘The TPP Agreement should extract and emphasize the key components of these treaties, namely.’\textsuperscript{68} The International Trademark Association (INTA) has also demanded that the \textit{Trans-Pacific Partnership} address provide ‘statutory protection for well-known marks and dilution protection for famous marks.’\textsuperscript{69}

It is striking that a number of the supporters and sponsors of the \textit{Trans-Pacific Partnership} have been holders of well-known trade marks and famous global brands.

\textbf{i. Clothing, Fashion, and Retail}

\textsuperscript{65} United States Trade Representative, \textit{Special 301 Report}, 2015, 12, 13

\textsuperscript{66} International Trademark Association, ‘Trademarks and the Trans-Pacific Partnership’ (2013) 68 (2)

\textsuperscript{67} Ibid.

\textsuperscript{68} Ibid.

\textsuperscript{69} Ibid.
Nike applauded ‘the Obama Administration and Ambassador Froman for successfully concluding country negotiations on the historic Trans-Pacific Partnership (TPP).’Nike explained that it supported the ‘TPP because it will allow us to innovate, expand our business and drive economic growth.’ In its view, ‘Open trade enables US companies to compete and consumers to win.’

The clothing retailer Gap Inc. endorsed the Trans-Pacific Partnership. Sonia Syngal had a rosy view of the agreement: ‘We look forward to supporting an agreement that will bring significant value for American families, provide meaningful benefits for our industry and our workers, raise labor and environmental standards for millions of people across the Asia-Pacific region, and begin to level the playing field with our international competitors.’ Gap Inc. is a global retailer offering clothing, accessories, and personal care products for men, women, and children under the Gap, Banana Republic, Old Navy, Athleta, and Intermix brands.

Brian Cornell, the Chairman and CEO of Target, commented: ‘Trade agreements drive America’s economic growth and help companies like Target offer quality, affordable products

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71 Ibid.

72 Ibid.


74 Ibid.
to our guests.’ He maintained: ‘We look forward to supporting a high-standard, ambitious TPP agreement that is good for our guests, employees, and the communities where we do business.’

Scott Price – the CEO of Walmart Asia – welcomed the agreement: ‘We believe this historic agreement will reduce the cost of goods and increase choice for our customers in the Asia-Pacific and the United States, and we look forward to reviewing the details of the agreement.’

The National Retail Federation in the United States was pleased by the conclusion of the *Trans-Pacific Partnership Agreement*. The group said: ‘International trade supports millions of jobs in the retail industry, and that number will only grow with passage of TPP.’ The American Apparel and Footwear Association was also pleased by the agreement.

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76 Ibid.


79 Ibid.

Amongst these bland expressions of support, there was opposition, though, from the clothing company, Patagonia. Rose Marcario, the President and CEO of Patagonia, Inc., and Patagonia Works, wrote an oped about the regime.\textsuperscript{81} She lamented that the agreement ‘advances the interests of big business at the expense of the environment, workers, communities, and small business.’\textsuperscript{82} Rose Marcario commented:

Why would Patagonia oppose a trade deal that likely would benefit our bottom line? Because beyond being in business to make money, we’re a mission-driven company working to use business to inspire and implement solutions to the environmental crisis. We also seek to promote better, safer and healthier living and working conditions for the people who make our clothing and gear. And we want to see full transparency in the workings of business and government. We see none of those things in the Trans-Pacific Partnership.

Rose Marcario explained: ‘At Patagonia, we design and market clothing, gear and food, relying heavily on the expertise of trusted partners to produce them’.\textsuperscript{83} She noted: ‘We also partner with NGOs and individuals in the environmental, conservation, wildlife, labor and agriculture communities who study agreements like the TPP to measure their effects on the greater good.’\textsuperscript{84} The company shared the concerns of such civil society members.\textsuperscript{85}

\textbf{ii. Food and Beverages}

\begin{footnotesize}
\begin{itemize}
\item \textsuperscript{82} Ibid.
\item \textsuperscript{83} Ibid.
\item \textsuperscript{84} Ibid.
\item \textsuperscript{85} Ibid.
\end{itemize}
\end{footnotesize}
Coca-Cola has been a key supporter of the *Trans-Pacific Partnership*.\(^86\) Kraft and Mars have also championed the deal.\(^87\)

There has been disquiet amongst public health advocates about the involvement of the food and beverages industry in the formulation of the agreement.

**iii. Information technology**

In terms of valuable global brands, BrandZ rated a number of technology brands as the most valuable global brands. Apple was rated 1\(^{st}\); Google 2\(^{nd}\); Microsoft 3\(^{rd}\); IBM 4\(^{th}\). Telecom providers AT&T and Verizon were rated 6\(^{th}\) and 7\(^{th}\). Tencent was 11\(^{th}\); Facebook was 12\(^{th}\), Alibaba was 13\(^{th}\), Amazon.com was 14\(^{th}\), and China Mobile was 15\(^{th}\). The entertainment company Disney was 19\(^{th}\). So, in this context, it is striking that firms within the fields of information technology, electronic commerce, and telecommunications would benefit particularly from stronger protection for well-known trade marks.

In the information technology sector, a number of companies have lent their support to the *Trans-Pacific Partnership*. The Internet Association has come out in support of the *Trans-

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Internet Association President and CEO Michael Beckerman commented:

The Internet industry is encouraged that the TPP recognizes the Internet as an essential American export, and supports the agreement’s passage… [T]he TPP promotes a more inclusive trade economy by supporting the ability of small businesses to use the Internet to serve customers and users in key markets. It will be critical that the TPP is implemented in a way that supports the Internet economy. The Internet industry is committed to working with U.S. trade officials and Congress to ensure that future trade negotiations build upon this framework and reflect the priorities of all stakeholders, including a rapidly growing Internet sector.

The Internet Association included such high-profile members of the digital economy – as Airbnb, Amazon, Coinbase, Doordash, Dropbox, eBay, Etsy, Expedia, Facebook, FanDuel, Google, Groupon, Handy, IAC, Intuit, LinkedIn, Lyft, Monster, Netflix, Pandora, PayPal, Pinterest, Practice Fusion, Rackspace Hosting, Reddit, Salesforce, Snapchat, Spotify, SurveyMonkey, TenX, TransferWise, TripAdvisor, Turo, Twitter, Uber, Yahoo!, Yelp, Zenefits, and Zynga. Many of the companies affiliated with the Internet Association have high profile brands.

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89 Ibid.
Fight for the Future was highly critical of this endorsement of the *Trans-Pacific Partnership* by the Internet Association.\(^90\) The campaign director Evan Geer commented: ‘This is when we find out which tech companies really support their users’ basic rights and which ones are only pretending to.’\(^91\) He stressed: ‘The TPP is an anti-user, anti-Internet agreement’.\(^92\) Geer noted: ‘It was negotiated in almost complete secrecy by corporate lobbyists and government bureaucrats—including the ones who pushed Internet censorship bills like SOPA.’\(^93\) He commented: ‘The TPP exports the worst parts of the United States’ broken [Intellectual Property] system without ensuring protections for freedom of expression, innovation, and human rights.’\(^94\) Geer concluded: ‘It’s great for incumbent monopolies, but terrible for individual Internet users, startups, and the tech community as a whole.’\(^95\) He observed: Secretive trade agreements are unacceptable venues for making policy that affects billions of Internet users.’\(^96\) In his view, ‘The customers of these companies expect and deserve better.’\(^97\)

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\(^91\) Ibid.

\(^92\) Ibid.

\(^93\) Ibid.

\(^94\) Ibid.

\(^95\) Ibid.

\(^96\) Ibid.

\(^97\) Ibid.
Google has lent its support to the *Trans-Pacific Partnership*. Kent Walker of Google maintains: ‘In terms of substance, we believe that future trade agreements can do even more to build a modern pro-innovation, pro-Internet trade agenda.’ He insists: ‘We hope that the TPP can be a positive force and an important counterweight to restrictive Internet policies around the world.’ Google maintains: ‘Like many other tech companies, we look forward to seeing the agreement approved and implemented in a way that promotes a free and open Internet across the Pacific region.’

iv. Biotechnology

In its Special 2015 report, the United States Trade Representative highlighted its concern about counterfeit pharmaceutical drugs:

> The manufacture and distribution of pharmaceutical products bearing counterfeit trademarks is a growing problem that has important consequences for consumer health and safety. Such trademark counterfeiting is a contributing dimension of the larger problem of the proliferation of substandard, unsafe medicines. The United States notes its particular concern with the proliferation of counterfeit pharmaceuticals that are manufactured, sold, and distributed in trading partners such as Brazil, China, India, Indonesia, Lebanon, Peru, and Russia.


99 Ibid.

100 Ibid.

101 Ibid.

The *Trans-Pacific Partnership* text highlights divisions over the types of signs registrable as trademarks. Article QQ.C.1 of the draft text provides ‘No Party may require, as a condition of registration, that a sign be visually perceptible, nor may a Party deny registration of a trademark solely on the ground that the sign of which it is composed is a sound.’ However, Vietnam, Brunei, Canada and Japan opposed the inclusion of scent as a non-traditional sign to be protected under trademark law. The countries agreed that ‘A Party may require a concise and accurate description, or graphical representation, or both, as applicable, of the trademark.’

In the final text, Article 18.18 details the Types of Signs Registrable as Trademarks:

No Party shall require, as a condition of registration, that a sign be visually perceptible, nor shall a Party deny registration of a trademark only on the ground that the sign of which it is composed is a sound. Additionally, each Party shall make best efforts to register scent marks. A Party may require a concise and accurate description, or graphical representation, or both, as applicable, of the trademark.

Article 18.19 of the final text deals with Collective and Certification Marks:

Each Party shall provide that trademarks include collective marks and certification marks. A Party is not obligated to treat certification marks as a separate category in its law, provided that those marks are

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103  WikiLeaks, ‘Updated Secret Trans-Pacific Partnership (TPP) – IP Chapter (Second Publication)’

[https://www.wikileaks.org/tpp-ip2/](https://www.wikileaks.org/tpp-ip2/)

104  Ibid.

protected. Each Party shall also provide that signs that may serve as geographical indications are capable of protection under its trademark system. 106

Article 18.20 of the final text addressed ‘the Use of Identical or Similar Signs’:

Each Party shall provide that the owner of a registered trademark has the exclusive right to prevent third parties that do not have the owner’s consent from using in the course of trade identical or similar signs, including subsequent geographical indications,[11],[12] for goods or services that are related to those goods or services in respect of which the owner’s trademark is registered, where such use would result in a likelihood of confusion. In the case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.107

Article QQ.C.4 of the draft text provided that ‘Each Party may provide limited exceptions to the rights conferred by a trademark, such as fair use of descriptive terms, provided that such exceptions take account of the legitimate interest of the owner of the trademark and of third parties.’ 108 Article 18.21 of the final text of the Trans-Pacific Partnership deals with trademark exceptions: ‘A Party may provide limited exceptions to the rights conferred by a trademark, such as fair use of descriptive terms, provided that those exceptions take account of the legitimate interest of the owner of the trademark and of third parties.’ 109

The Electronic Frontier Foundation has highlighted a number of instances of abuse of trade mark rights to suppress political speech and cultural criticism. In a 2014 dispute, the civil society organisation has insisted that trade mark rights should not trump free speech.\(^{110}\) Famously, the Electronic Frontier Foundation defended The Yes Men against an intellectual property law suit by the United States Chamber of Commerce.\(^{111}\)

The United States has sought to provide protection for the public interest under trade mark law, through a liberal application of the First Amendment, and the use of the doctrine of fair use in respect of trade mark dilution. There should be scope for broad exceptions under trade mark law in the *Trans-Pacific Partnership*.

Article QQ.C.5 of the draft text provided for the protection of well-known trade marks.\(^{112}\) The clause stresses: ‘No Party may require as a condition for determining that a trademark is well-known that the trademark has been registered in the Party or in another jurisdiction, included on a list of well-known trademarks, or given prior recognition as a well-known trademark.’\(^{113}\) The Article provides:

> ‘Article 6bis of the Paris Convention for the Protection of Industrial Property (1967) shall apply, mutatis mutandis, to goods or services that are not identical or similar to those identified by a well-known

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\(^{111}\) The Yes Men vs The US Chamber of Commerce [http://www.youtube.com/watch?v=flsNwClU1dI](http://www.youtube.com/watch?v=flsNwClU1dI)

\(^{112}\) WikiLeaks, ‘Updated Secret Trans-Pacific Partnership (TPP) – IP Chapter (Second Publication)’ [https://www.wikileaks.org/tpp-ip2/](https://www.wikileaks.org/tpp-ip2/)

\(^{113}\) Ibid.
trademark, whether registered or not, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the trademark, and provided that the interests of the owner of the trademark are likely to be damaged by such use."114

The Article notes: ‘Each Party recognizes the importance of the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks (1999) as adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of WIPO.’115 The Article emphasizes: ‘Each Party shall provide for appropriate measures to refuse the application or cancel the registration and prohibit the use of a trademark that is identical or similar to a well-known trademark, for identical or similar goods or services, if the use of that trademark is likely to cause confusion with the prior well known trademark.’116 Moreover, A Party may also provide such measures inter alia in cases in which the subsequent trademark: is likely to deceive or risk associating the trademark with the owner of the well-known trademark, or constitutes unfair exploitation of the reputation of the well-known trademark.’117

Article 18.22 of the final text provides for extensive text on ‘Well-Known Trademarks’:

1. No Party shall require as a condition for determining that a trademark is well-known that the trademark has been registered in the Party or in another jurisdiction, included on a list of well-known trademarks, or given prior recognition as a well-known trademark.

114 Ibid.
115 Ibid.
116 Ibid.
117 Ibid.
2. Article 6bis of the Paris Convention shall apply, mutatis mutandis, to goods or services that are not identical or similar to those identified by a well-known trademark,[13] whether registered or not, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the trademark, and provided that the interests of the owner of the trademark are likely to be damaged by such use.


4. Each Party shall provide for appropriate measures to refuse the application or cancel the registration and prohibit the use of a trademark that is identical or similar to a well-known trademark,[14] for identical or similar goods or services, if the use of that trademark is likely to cause confusion with the prior well-known trademark. A Party may also provide such measures including in cases in which the subsequent trademark is likely to deceive. 118

Part of the attraction of the Trans-Pacific Partnership for big multinational companies is the extensive recognition of well-known and famous trade marks.

Article 18.23 of the final text considers ‘Procedural Aspects of Examination, Opposition and Cancellation.’ 119 Article 18.24 provides for an ‘Electronic Trademarks System’ – ‘Each Party shall provide: (a) a system for the electronic application for, and maintenance of, trademarks;


and (b) a publicly available electronic information system, including an online database, of trademark applications and of registered trademarks.\(^{120}\)

Article 18.25 considers the ‘Classification of Goods and Services.\(^{121}\) Article 18.26 provides for the Term of Protection for Trademarks: ‘Each Party shall provide that initial registration and each renewal of registration of a trademark is for a term of no less than 10 years.’\(^{122}\)

Article QQ.C.10 of the draft text provided: ‘No Party may require recordal of trademark licenses: to establish the validity of the license; as a condition for any right that a licensee may have under that Party’s law to join infringement proceedings initiated by the holder, or to obtain by way of civil infringement proceedings damages resulting from an infringement of the trademark which is subject to the license]; or as a condition for use of a trademark by a licensee, to be deemed to constitute use by the holder in proceedings relating to the acquisition, maintenance and enforcement of trademarks].’\(^{123}\) Vietnam, Mexico, Chile, Brunei, and Malaysia opposed a large part of this text.\(^{124}\) Nonetheless, in the final text, Article 18.27 deals with ‘Non-Recordal of a Licence’ and provides ‘No Party shall require recordal of trademark licences: (a) to establish the validity of the licence; or (b) as a condition for use of a trademark

\(^{120}\) Article 18.24 of the Trans-Pacific Partnership 2015 https://ustr.gov/trade-agreements/free-trade-agreements/trans-pacific-partnership/pp-full-text


\(^{123}\) WikiLeaks, ‘Updated Secret Trans-Pacific Partnership (TPP) – IP Chapter (Second Publication)’ https://www.wikileaks.org/pp-ip2/

\(^{124}\) Ibid.
by a licensee to be deemed to constitute use by the holder in a proceeding that relates to the acquisition, maintenance or enforcement of trademarks.\textsuperscript{125}

Notably, in Australia, the Productivity Commission has been investigating Australia’s intellectual property arrangements.\textsuperscript{126} The Productivity Commission has a number of pertinent recommendations in respect of domestic law reform of intellectual property, and Australia’s approach to treaty-making in the field. The Productivity Commission noted that there were competing agendas in play:

\begin{quote}
The economic rationale for trade marks and GIs rests heavily on reducing search costs for consumers, which in turn provides an incentive for firms to invest in branding and reputation. The rationale may also, in some cases, extend to encouraging further innovation, but the evidence here is mixed. Trade marks and GIs can also be used for anticompetitive rather than informational purposes. Thus an effective trade mark system is one that maximises the flow of information and innovation, and minimises the scope for anticompetitive conduct. Such a balance would focus more strongly on the quality of trade marks and GIs granted rather than the quantity of such rights, and would also take account of alternatives to these forms of IP rights.\textsuperscript{127}
\end{quote}

The Productivity Commission is particularly concerned about addressing the problems of cluttering and confusion on the trade mark register. Accordingly, the Productivity Commission highlighted the need for quality trade marks and geographical indications in terms of the

\begin{footnotesize}
\begin{itemize}
\item[125] Article 18.27 of the \textit{Trans-Pacific Partnership} 2015 \url{https://ustr.gov/trade-agreements/free-trade-agreements/trans-pacific-partnership/tpp-full-text}
\item[127] Ibid, 331-332.
\end{itemize}
\end{footnotesize}
registration system. The Productivity Commission has made a number of recommendations, and information requests in the fields of trade mark law, and geographical indications.

Professor Michael Geist was critical that the *Trans-Pacific Partnership* would displace domestic Canadian policy processes in respect of trade mark law.\(^{128}\) He noted: ‘The Canadian government’s summary on the issue once again understates the significance of the changes with assurances that the TPP is “in line with Canada’s existing regime” and “supports Canada’s progress to accede to the Madrid Protocol and Nice Agreement.”’\(^{129}\) Geist commented:

> The reality is that government recently passed a massive overhaul of trademark law with little consultation or debate in anticipation of the TPP requirements. In fact, government negotiators opposed some of the trademark requirements in the TPP until very late in the negotiations (including some of the Nice Agreement provisions) recognizing that it was not consistent with Canadian law at the time. The planned Canadian changes are not expected to come into force until 2018 at the earliest. Yet even when they do, trademark experts believe that Canadian law will still not be consistent with the TPP.\(^{130}\)

Geist expressed concerns that Canadian law did not address the requirements in the *Trans-Pacific Partnership* in respect of a number of areas of trademark law. He noted: ‘TPP does appear to require the attention of Parliament in respect of well-known trademarks, country

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\(^{129}\) Ibid.

\(^{130}\) Ibid.
names, geographical indications and collective marks.’\textsuperscript{131} Geist insisted: ‘It is imperative that Parliament allow for timely and open consultation on any prospective legislative change.’\textsuperscript{132}

The Supreme Court of Canada has also been critical of efforts to over-extend protection of well-known marks in disputes over Barbie and French Champagne.\textsuperscript{133}

3. **Counterfeiting**

The United States Trade Representative has been deeply disturbed by the perceived problem of trademark counterfeiting. In the 2014 Special 301 report, the United States Trade Representative commented:

The problems of trademark counterfeiting and copyright piracy continue on a global scale and involve mass production and sales of a vast array of fake goods, including counterfeit semiconductors, medicines, health care products, food and beverages, automobile parts, such as air bags, aircraft parts, apparel and footwear, toothpaste, toys, shampoos, razors, electronics, batteries, chemicals, sporting goods, motion pictures, and music.

Consumers, legitimate producers, and governments are harmed by rampant trademark counterfeiting and copyright piracy. Consumers may be harmed by fraudulent and potentially dangerous counterfeit products, including medicines, auto and airplane parts, and semiconductors. Producers face the risk of diminished profits and loss of reputation when consumers purchase fake products, and governments may lose tax revenue and find it more difficult to attract investment. Infringers generally

\textsuperscript{131} Ibid.

\textsuperscript{132} Ibid.

pay no taxes or duties, and often disregard basic standards for worker health and safety and product quality and performance.\textsuperscript{134}

(The United States Trade Representative’s conflation of trademark counterfeiting and copyright piracy is quite confusing—given that they are different disciplines in intellectual property, and not necessarily analogous). The United States said that it ‘continues to urge trading partners to undertake more effective criminal and border enforcement to stop the manufacture, import, export, transit, and distribution of pirated and counterfeit goods.’ The United States Trade Representative emphasized that it ‘engages extensively with its trading partners through bilateral consultations, trade agreements, and international organizations, to ensure that penalties are deterrent, and include significant monetary fines and meaningful sentences of imprisonment.’\textsuperscript{135}

In its 2015 Special 301 Report, the United States Trade Representative warned of the dangers of trade mark counterfeiting, using similar language:

The problems of trademark counterfeiting and copyright piracy continue on a global scale and involve the mass production and sale of a vast array of fake goods and a range of copyright protected content pirated in various forms. Counterfeited goods include semiconductors and other electronics, chemicals, automotive and aircraft parts, medicines, food and beverages, household consumer products, personal care products, apparel and footwear, toys, and sporting goods.

Consumers, legitimate producers, and governments are harmed by trademark counterfeiting and copyright piracy. Consumers may be harmed by fraudulent and potentially dangerous counterfeit products, particularly medicines, automotive and airplane parts, and food and beverages that may not be

\textsuperscript{134} Ibid.
\textsuperscript{135} Ibid.
subjected to the rigorous “good manufacturing practices” used for legitimate products. Producers and their employees face diminished revenue and investment incentives, an adverse employment impact, and loss of reputation when consumers purchase fake products. Governments may lose tax revenue and find it more difficult to attract investment because infringers generally do not pay taxes or appropriate duties, and often disregard product quality and performance.136

The report expressed particular concern about trademark counterfeiting in countries such as India, Indonesia, and China.

The Anti-Counterfeiting Trade Agreement 2012 contained a number of measures designed to address trademark counterfeiting.137 There was uproar amongst civil society groups in the European Union, North America, Australia, and New Zealand about the proposed agreement. After much criticism from the European Parliament, and the Australian Joint Standing Committee on Treaties, the Anti-Counterfeiting Trade Agreement 2012 collapsed.138

The Zombie Agreement has refused to die; and has been reanimated in new forms in the Trans-Pacific Partnership. The International Trademark Association (INTA) has also demanded that the Trans-Pacific Partnership address ‘enhancing protection against counterfeiting (tougher penalties; simplified damages calculation; landlord liability; online sales)’, ‘Providing for

seizure of goods in transit’; and ‘Offering trademark owners greater access to information about counterfeiteers that is held by customs and other agencies.’

The draft *Trans-Pacific Partnership* featured a number of clauses on trademark counterfeiting. Article QQ.H.4 dealt with civil procedures and remedies. The article states: ‘Each Party shall provide that in civil judicial proceedings its judicial authorities have at least the infringer to pay the right holder damages adequate to compensate for the injury the right holder has suffered because of an infringement of that person’s intellectual property right by an infringer who knowingly, or with reasonable grounds to know, engaged in infringing activity.’ The article provides: ‘At least in cases of copyright or related rights infringement and trademark counterfeiting, each Party shall provide that, in civil judicial proceedings, its judicial authorities have the authority to order the infringer, at least as described in paragraph 2, to pay the right holder the infringer’s profits that are attributable to the infringement.’ The article also proposes: ‘In civil judicial proceedings, with respect to trademark counterfeiting, each Party [US propose: shall] [NZ/JP/MX/AU/BN/MY propose: may] also establish or maintain a system that provides for one or more of the following: pre-established damages, which shall be available upon the election of the right holder; or additional damages.’

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141 Ibid.

142 Ibid.

143 Ibid.
Article QQ.H.5 deals with provisional measures, including seizure: ‘In civil judicial proceedings concerning copyright or related rights infringement and trademark counterfeiting, each Party shall provide that its judicial authorities shall have the authority to order the seizure or other taking into custody of suspected infringing goods, material and implements relevant to the infringement, and, at least for trademark counterfeiting, documentary evidence relevant to the infringement.’ 144

In Article QQ.H.6, there are extensive special requirements related to border measures and customs measures. 145

Article QQ.H.7 addresses criminal procedures and remedies for trademark counterfeiting and copyright piracy: ‘Each Party shall provide for criminal procedures and penalties to be applied at least in cases of willful trademark counterfeiting or copyright or related rights piracy on a commercial scale.’ 146

The final Section I of the Intellectual Property Chapter of the Trans-Pacific Partnership deals with Enforcement of Intellectual Property:

144 WikiLeaks, ‘Updated Secret Trans-Pacific Partnership (TPP) – IP Chapter (Second Publication)’
https://www.wikileaks.org/tpp-ip2/

145 WikiLeaks, ‘Updated Secret Trans-Pacific Partnership (TPP) – IP Chapter (Second Publication)’
https://www.wikileaks.org/tpp-ip2/

146 WikiLeaks, ‘Updated Secret Trans-Pacific Partnership (TPP) – IP Chapter (Second Publication)’
https://www.wikileaks.org/tpp-ip2/
Article 18.71 of the Trans-Pacific Partnership deals with general obligations in respect of intellectual property enforcement:

1. Each Party shall ensure that enforcement procedures as specified in this Section are available under its law[100] so as to permit effective action against any act of infringement of intellectual property rights covered by this Chapter, including expeditious remedies to prevent infringements and remedies that constitute a deterrent to future infringements.[101] These procedures shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.

2. Each Party confirms that the enforcement procedures set forth in Article 18.74 (Civil and Administrative Procedures and Remedies), Article 18.75 (Provisional Measures) and Article 18.77 (Criminal Procedures and Penalties) shall be available to the same extent with respect to acts of trademark infringement, as well as copyright or related rights infringement, in the digital environment.

3. Each Party shall ensure that its procedures concerning the enforcement of intellectual property rights are fair and equitable. These procedures shall not be unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays.

4. This Section does not create any obligation:

(a) to put in place a judicial system for the enforcement of intellectual property rights distinct from that for the enforcement of law in general, nor does it affect the capacity of each Party to enforce its law in general; or

(b) with respect to the distribution of resources as between the enforcement of intellectual property rights and the enforcement of law in general.

5. In implementing the provisions of this Section in its intellectual property system, each Party shall take into account the need for proportionality between the seriousness of the infringement of the
intellectual property right and the applicable remedies and penalties, as well as the interests of third parties.\textsuperscript{147}

Article 18.72 deals with presumptions about intellectual property:

1. In civil, criminal and, if applicable, administrative proceedings involving copyright or related rights, each Party shall provide for a presumption\textsuperscript{[102]} that, in the absence of proof to the contrary:
   (a) the person whose name is indicated in the usual manner\textsuperscript{[103]} as the author, performer or producer of the work, performance or phonogram, or if applicable the publisher, is the designated right holder in that work, performance or phonogram; and
   (b) the copyright or related right subsists in such subject matter.
2. In connection with the commencement of a civil, administrative or criminal enforcement proceeding involving a registered trademark that has been substantively examined by its competent authority, each Party shall provide that the trademark be considered prima facie valid.
3. In connection with the commencement of a civil or administrative enforcement proceeding involving a patent that has been substantively examined and granted\textsuperscript{[104]} by the competent authority of a Party, that Party shall provide that each claim in the patent be considered prima facie to satisfy the applicable criteria of patentability in the territory of the Party.\textsuperscript{[105],[106]}\textsuperscript{148}

Article 18.73 concerns ‘Enforcement Practices with Respect to Intellectual Property Rights’:

1. Each Party shall provide that final judicial decisions and administrative rulings of general application pertaining to the enforcement of intellectual property rights:

\textsuperscript{147} Article 18.71 of the \textit{Trans-Pacific Partnership} 2015 \url{https://ustr.gov/trade-agreements/free-trade-agreements/trans-pacific-partnership/pp-full-text}

\textsuperscript{148} Article 18.72 of the \textit{Trans-Pacific Partnership} 2015 \url{https://ustr.gov/trade-agreements/free-trade-agreements/trans-pacific-partnership/pp-full-text}
(a) preferably are in writing and state any relevant findings of fact and the reasoning or the legal basis on which the decisions and rulings are based; and
(b) are published\[107\] or, if publication is not practicable, otherwise made available to the public in a national language in such a manner as to enable interested persons and Parties to become acquainted with them.

2. Each Party recognises the importance of collecting and analysing statistical data and other relevant information concerning infringements of intellectual property rights as well as collecting information on best practices to prevent and combat infringements.

3. Each Party shall publish or otherwise make available to the public information on its efforts to provide effective enforcement of intellectual property rights in its civil, administrative and criminal systems, such as statistical information that the Party may collect for such purposes.\[149\]

Article 18.74 deals with Civil and Administrative Procedures and Remedies:

1. Each Party shall make available to right holders civil judicial procedures concerning the enforcement of any intellectual property right covered in this Chapter.[108]

2. Each Party shall provide that its judicial authorities have the authority to order injunctive relief that conforms to Article 44 of the TRIPS Agreement, including to prevent goods that involve the infringement of an intellectual property right under the law of the Party providing that relief from entering into the channels of commerce.

3. Each Party shall provide[109] that, in civil judicial proceedings, its judicial authorities have the authority at least to order the infringer to pay the right holder damages adequate to compensate for the injury the right holder has suffered because of an infringement of that person’s intellectual property right by an infringer who knowingly, or with reasonable grounds to know, engaged in infringing activity.

4. In determining the amount of damages under paragraph 3, each Party’s judicial authorities shall have the authority to consider, among other things, any legitimate measure of value the right holder submits,
which may include lost profits, the value of the infringed goods or services measured by the market price, or the suggested retail price.

5. At least in cases of copyright or related rights infringement and trademark counterfeiting, each Party shall provide that, in civil judicial proceedings, its judicial authorities have the authority to order the infringer, at least in cases described in paragraph 3, to pay the right holder the infringer’s profits that are attributable to the infringement.[110]

6. In civil judicial proceedings with respect to the infringement of copyright or related rights protecting works, phonograms or performances, each Party shall establish or maintain a system that provides for one or more of the following:

(a) pre-established damages, which shall be available on the election of the right holder; or

(b) additional damages.[111]

7. In civil judicial proceedings with respect to trademark counterfeiting, each Party shall also establish or maintain a system that provides for one or more of the following:

(a) pre-established damages, which shall be available on the election of the right holder; or

(b) additional damages.[112]

8. Pre-established damages under paragraphs 6 and 7 shall be set out in an amount that would be sufficient to compensate the right holder for the harm caused by the infringement, and with a view to deterring future infringements.

9. In awarding additional damages under paragraphs 6 and 7, judicial authorities shall have the authority to award such additional damages as they consider appropriate, having regard to all relevant matters, including the nature of the infringing conduct and the need to deter similar infringements in the future.

10. Each Party shall provide that its judicial authorities, if appropriate, have the authority to order, at the conclusion of civil judicial proceedings concerning infringement of at least copyright or related rights, patents and trademarks, that the prevailing party be awarded payment by the losing party of court costs or fees and appropriate attorney’s fees, or any other expenses as provided for under the Party’s law.

11. If a Party’s judicial or other authorities appoint a technical or other expert in a civil proceeding concerning the enforcement of an intellectual property right and require that the parties to the proceeding pay the costs of that expert, that Party should seek to ensure that those costs are reasonable
and related appropriately, among other things, to the quantity and nature of work to be performed and
do not unreasonably deter recourse to such proceedings.

12. Each Party shall provide that in civil judicial proceedings:
(a) at least with respect to pirated copyright goods and counterfeit trademark goods, its judicial
authorities have the authority, at the right holder’s request, to order that the infringing goods be
destroyed, except in exceptional circumstances, without compensation of any sort;
(b) its judicial authorities have the authority to order that materials and implements that have been used
in the manufacture or creation of the infringing goods be, without undue delay and without
compensation of any sort, destroyed or disposed of outside the channels of commerce in such a manner
as to minimise the risk of further infringement; and
(c) in regard to counterfeit trademark goods, the simple removal of the trademark unlawfully affixed is
not sufficient, other than in exceptional circumstances, to permit the release of goods into the channels
of commerce.

13. Without prejudice to its law governing privilege, the protection of confidentiality of information
sources or the processing of personal data, each Party shall provide that, in civil judicial proceedings
concerning the enforcement of an intellectual property right, its judicial authorities have the authority,
on a justified request of the right holder, to order the infringer or, in the alternative, the alleged infringer
to provide to the right holder or to the judicial authorities, at least for the purpose of collecting evidence,
relevant information as provided for in its applicable laws and regulations that the infringer or alleged
infringer possesses or controls. The information may include information regarding any person
involved in any aspect of the infringement or alleged infringement and the means of production or the
channels of distribution of the infringing or allegedly infringing goods or services, including the
identification of third persons alleged to be involved in the production and distribution of the goods or
services and of their channels of distribution.

14. Each Party shall provide that in relation to a civil judicial proceeding concerning the enforcement
of an intellectual property right, its judicial or other authorities have the authority to impose sanctions
on a party, counsel, experts or other persons subject to the court’s jurisdiction for violation of judicial
orders concerning the protection of confidential information produced or exchanged in that proceeding.

15. Each Party shall ensure that its judicial authorities have the authority to order a party at whose
request measures were taken and that has abused enforcement procedures with regard to intellectual
property rights, including trademarks, geographical indications, patents, copyright and related rights and industrial designs, to provide to a party wrongfully enjoined or restrained adequate compensation for the injury suffered because of that abuse. The judicial authorities shall also have the authority to order the applicant to pay the defendant expenses, which may include appropriate attorney’s fees.

16. To the extent that any civil remedy can be ordered as a result of administrative procedures on the merits of a case, each Party shall provide that those procedures conform to principles equivalent in substance to those set out in this Article.

17. In civil judicial proceedings concerning the acts described in Article 18.68 (TPMs) and Article 18.69 (RMI):

(a) each Party shall provide that its judicial authorities have the authority at least to:[113]

(i) impose provisional measures, including seizure or other taking into custody of devices and products suspected of being involved in the prohibited activity;

(ii) order the type of damages available for copyright infringement, as provided under its law in accordance with this Article;[114]

(iii) order court costs, fees or expenses as provided for under paragraph 10; and

(iv) order the destruction of devices and products found to be involved in the prohibited activity; and

(b) a Party may provide that damages shall not be available against a non-profit library, archive, educational institution, museum or public non-commercial broadcasting entity, if it sustains the burden of proving that it was not aware or had no reason to believe that its acts constituted a prohibited activity.150

Article 18.75 considers Provisional Measures:

1. Each Party’s authorities shall act on a request for relief in respect of an intellectual property right inaudita altera parte expeditiously in accordance with that Party’s judicial rules.

2. Each Party shall provide that its judicial authorities have the authority to require the applicant for a provisional measure in respect of an intellectual property right to provide any reasonably available

evidence in order to satisfy the judicial authority, with a sufficient degree of certainty, that the
applicant’s right is being infringed or that the infringement is imminent, and to order the applicant to
provide security or equivalent assurance set at a level sufficient to protect the defendant and to prevent
abuse. Such security or equivalent assurance shall not unreasonably deter recourse to those procedures.
3. In civil judicial proceedings concerning copyright or related rights infringement and trademark
counterfeiting, each Party shall provide that its judicial authorities have the authority to order the
seizure or other taking into custody of suspected infringing goods, materials and implements relevant
to the infringement, and, at least for trademark counterfeiting, documentary evidence relevant to the
infringement.151

Article 18.76 provides for ‘Special Requirements related to Border Measures’ -

1. Each Party shall provide for applications to suspend the release of, or to detain, any suspected
counterfeit or confusingly similar trademark or pirated copyright goods that are imported into the
territory of the Party.[115]
2. Each Party shall provide that any right holder initiating procedures for its competent authorities[116]
to suspend release of suspected counterfeit or confusingly similar trademark or pirated copyright goods
into free circulation is required to provide adequate evidence to satisfy the competent authorities that,
under the law of the Party providing the procedures, there is prima facie an infringement of the right
holder’s intellectual property right and to supply sufficient information that may reasonably be expected
to be within the right holder’s knowledge to make the suspect goods reasonably recognisable by its
competent authorities. The requirement to provide that information shall not unreasonably deter
recourse to these procedures.
3. Each Party shall provide that its competent authorities have the authority to require a right holder
initiating procedures to suspend the release of suspected counterfeit or confusingly similar trademark
or pirated copyright goods, to provide a reasonable security or equivalent assurance sufficient to protect
the defendant and the competent authorities and to prevent abuse. Each Party shall provide that such

security or equivalent assurance does not unreasonably deter recourse to these procedures. A Party may provide that the security may be in the form of a bond conditioned to hold the defendant harmless from any loss or damage resulting from any suspension of the release of goods in the event the competent authorities determine that the article is not an infringing good.

4. Without prejudice to a Party’s law pertaining to privacy or the confidentiality of information:
   (a) if a Party’s competent authorities have detained or suspended the release of goods that are suspected of being counterfeit trademark or pirated copyright goods, that Party may provide that its competent authorities have the authority to inform the right holder without undue delay of the names and addresses of the consignor, exporter, consignee or importer; a description of the goods; the quantity of the goods; and, if known, the country of origin of the goods;[117] or
   (b) if a Party does not provide its competent authority with the authority referred to in subparagraph (a) when suspect goods are detained or suspended from release, it shall provide, at least in cases of imported goods, its competent authorities with the authority to provide the information specified in subparagraph (a) to the right holder normally within 30 working days of the seizure or determination that the goods are counterfeit trademark goods or pirated copyright goods.

5. Each Party shall provide that its competent authorities may initiate border measures ex officio[118] with respect to goods under customs control[119] that are:
   (a) imported;
   (b) destined for export;[120] or
   (c) in transit,[121],[122]

and that are suspected of being counterfeit trademark goods or pirated copyright goods.

6. Each Party shall adopt or maintain a procedure by which its competent authorities may determine within a reasonable period of time after the initiation of the procedures described in paragraph 1, paragraph 5(a), paragraph 5(b) and, if applicable, paragraph 5(c), whether the suspect goods infringe an intellectual property right.[123] If a Party provides administrative procedures for the determination of an infringement, it may also provide its authorities with the authority to impose administrative penalties or sanctions, which may include fines or the seizure of the infringing goods following a determination that the goods are infringing.

7. Each Party shall provide that its competent authorities have the authority to order the destruction of goods following a determination that the goods are infringing. In cases in which the goods are not
destroyed, each Party shall ensure that, except in exceptional circumstances, the goods are disposed of outside the channels of commerce in such a manner as to avoid any harm to the right holder. In regard to counterfeit trademark goods, the simple removal of the trademark unlawfully affixed shall not be sufficient, other than in exceptional cases, to permit the release of the goods into the channels of commerce.

8. If a Party establishes or assesses, in connection with the procedures described in this Article, an application fee, storage fee or destruction fee, that fee shall not be set at an amount that unreasonably deters recourse to these procedures.

9. This Article also shall apply to goods of a commercial nature sent in small consignments. A Party may exclude from the application of this Article small quantities of goods of a non-commercial nature contained in travellers’ personal luggage.[124][152]

Article 18.77 of the agreement deals with Criminal Procedures and Penalties – focusing in particular on wilful trademark counterfeiting:

1. Each Party shall provide for criminal procedures and penalties to be applied at least in cases of wilful trademark counterfeiting or copyright or related rights piracy on a commercial scale. In respect of wilful copyright or related rights piracy, “on a commercial scale” includes at least:
   (a) acts carried out for commercial advantage or financial gain; and
   (b) significant acts, not carried out for commercial advantage or financial gain, that have a substantial prejudicial impact on the interests of the copyright or related rights holder in relation to the marketplace.[125],[126]

2. Each Party shall treat wilful importation or exportation of counterfeit trademark goods or pirated copyright goods on a commercial scale as unlawful activities subject to criminal penalties.[127]

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3. Each Party shall provide for criminal procedures and penalties to be applied in cases of wilful importation[128] and domestic use, in the course of trade and on a commercial scale, of a label or packaging:[129]

(a) to which a trademark has been applied without authorisation that is identical to, or cannot be distinguished from, a trademark registered in its territory; and

(b) that is intended to be used in the course of trade on goods or in relation to services that are identical to goods or services for which that trademark is registered.

4. Recognising the need to address the unauthorised copying[130] of a cinematographic work from a performance in a movie theatre that causes significant harm to a right holder in the market for that work, and recognising the need to deter such harm, each Party shall adopt or maintain measures, which shall at a minimum include, but need not be limited to, appropriate criminal procedures and penalties.

5. With respect to the offences for which this Article requires a Party to provide for criminal procedures and penalties, each Party shall ensure that criminal liability for aiding and abetting is available under its law.

6. With respect to the offences described in paragraphs 1 through 5, each Party shall provide the following:

(a) Penalties that include sentences of imprisonment as well as monetary fines sufficiently high to provide a deterrent to future acts of infringement, consistent with the level of penalties applied for crimes of a corresponding gravity.[131]

(b) Its judicial authorities have the authority, in determining penalties, to account for the seriousness of the circumstances, which may include circumstances that involve threats to, or effects on, health or safety.[132]

(c) Its judicial or other competent authorities have the authority to order the seizure of suspected counterfeit trademark goods or pirated copyright goods, any related materials and implements used in the commission of the alleged offence, documentary evidence relevant to the alleged offence and assets derived from, or obtained through the alleged infringing activity. If a Party requires identification of items subject to seizure as a prerequisite for issuing a judicial order referred to in this subparagraph, that Party shall not require the items to be described in greater detail than necessary to identify them for the purpose of seizure.
(d) Its judicial authorities have the authority to order the forfeiture, at least for serious offences, of any assets derived from or obtained through the infringing activity.

(e) Its judicial authorities have the authority to order the forfeiture or destruction of:

(i) all counterfeit trademark goods or pirated copyright goods;

(ii) materials and implements that have been predominantly used in the creation of pirated copyright goods or counterfeit trademark goods; and

(iii) any other labels or packaging to which a counterfeit trademark has been applied and that have been used in the commission of the offence.

In cases in which counterfeit trademark goods and pirated copyright goods are not destroyed, the judicial or other competent authorities shall ensure that, except in exceptional circumstances, those goods are disposed of outside the channels of commerce in such a manner as to avoid causing any harm to the right holder. Each Party shall further provide that forfeiture or destruction under this subparagraph and subparagraph (c) shall occur without compensation of any kind to the defendant.

(f) Its judicial or other competent authorities have the authority to release or, in the alternative, provide access to, goods, material, implements, and other evidence held by the relevant authority to a right holder for civil infringement proceedings.

(g) Its competent authorities may act upon their own initiative to initiate legal action without the need for a formal complaint by a third person or right holder.

7. With respect to the offences described in paragraphs 1 through 5, a Party may provide that its judicial authorities have the authority to order the seizure or forfeiture of assets, or alternatively, a fine, the value of which corresponds to the assets derived from, or obtained directly or indirectly through, the infringing activity.

The Federal Government will have to play a significant role in enforcement in respect of wilful trademark counterfeiting.

There has also been concern about how trade mark law has been applied in respect of intermediaries such as eBay.\footnote{Jennifer Macey, ‘Luxury Brands Sue eBay’, The World Today, ABC Radio National, 1 July 2008, http://www.abc.net.au/worldtoday/content/2008/s2290973.htm and Matthew Rimmer, ”Breakfast at Tiffany’s”: eBay Inc., Trademark Law, and Counterfeiting’, (2011) 21 (1) Journal of Law, Information, and Science 128-166.} Given such risks, it is curious that eBay has been supporting the \textit{Trans-Pacific Partnership}. The CEO Devin Wenig has lobbied members of Congress to advocate policies to help break down trade barriers.\footnote{Devin Wenig, ‘eBay CEO on Technology, Policy, and the Issues Shaping the Next 20 Years’, eBay Mainstreet, 28 April 2016, http://www.ebaymainstreet.com/news-events/ebay-ceo-devin-wenig-speaks-small-business-owners} He has observed that ‘it is remarkable to me that we are having a debate about free trade.’\footnote{Ibid.} He commented: ‘The world’s most innovative, productive, and efficient economy is debating whether to self select out of 90% of the world’s markets.’\footnote{Ibid.} Wenig observed: ‘In some ways the Internet was tailor-made for the American economy - a low cost and friction-free distribution highway for ideas, innovation and products.’\footnote{Ibid.} He argued: ‘Closing markets off may feel safe, but it is not the way to create economic or physical security in the long term.’\footnote{Ibid.}

Given the controversy over the \textit{Anti-Counterfeiting Trade Agreement} 2012, it is disturbing that similar measures are pushed forward in the \textit{Trans-Pacific Partnership}. Notably, the United States Trade Representative has failed to ameliorate the harsh proposals, with safeguards and protections for privacy, free speech, fair use, and competition. As James Love has noted, ‘While pushing for radical expansions of the global standards for intellectual property rights,
Ambassador Froman is also trying to narrow or eliminate the safeguards found in other intellectual property right agreements.160

Michael Geist was concerned that the United States Trade Representative was seeking to reverse Bill C-8 through the Trans-Pacific Partnership, and mandate in-transit seizures.161 He noted that there was a side-letter on this issue:

The U.S. is requiring Canada to provide a report card every six months on its customs activities, meet on the issue whenever the U.S. demands, and face the possibility of a dispute settlement complaint for failing to comply with these rules. While some might view this as a modest requirement, the U.S. does not require similar reports from anyone else.162

Citing the concerns of former Research in Motion CEO Jim Balsillie, Geist feared: ‘Canada is once again bullied into complying with U.S. demands on intellectual property laws and enforcement.’163

4. Internet Domain Names and Cybersquatting

162 Ibid.
163 Ibid.
In the 2014 Special 301 report, the United States Trade Representative discussed its vision in respect of trademark law: and Internet Domain Names:

Another area of concern for trademark holders is the protection of their trademarks against unauthorized uses under top level domain extensions. U.S. rights holders face significant trademark infringement and loss of valuable Internet traffic because of such uses. A related and growing concern is that certain country code top level domain names (ccTLD) lack transparent and predictable uniform domain name dispute resolution policies (UDRPs). Effective UDRPs should assist in the quick and efficient resolution of these disputes. The United States encourages its trading partners to provide procedures that allow for the protection of trademarks used in domain names, and to ensure that dispute resolution procedures are available to prevent the misuse of trademarks.\(^{164}\)

To this end, the United States Trade Representative has been lobbying for the text on the topic in the *Trans-Pacific Partnership*.

In its 2016 Special 301 Report, the United States Trade Representative highlighted ‘Trademark Protection Challenges in Country Code Top-Level Domain Names.’\(^{165}\) The report commented:

Trademark holders continue to face challenges in protecting their trademarks against unauthorized uses in country code top-level domain names (ccTLDs). U.S. right holders face significant trademark infringement and loss of valuable Internet traffic because of such uses, and it is important for countries to provide for appropriate remedies in their legal systems to address this issue. Many ccTLDs have policies that prohibit cybersquatting; require that the domain name have a nexus to the relevant country


(e.g., citizenship or residency, a registered office, or a bona fide presence); require the registrant to provide true and complete contact information; and make such registration information publicly available or cooperate with brand owners whose trade-marks are being infringed. The ccTLDs in China, Denmark, Germany, The Netherlands, Spain, Sweden, and Switzerland have been identified by right holders as ineffective or uncooperative. A related and growing concern is that some ccTLDs lack transparent and predictable domain name dispute resolution policies. Such effective policies should assist in the quick and efficient resolution of trademark infringement-related domain name disputes. The United States encourages its trading partners to provide procedures that allow for the protection of trademarks used in domain names and to ensure that dispute resolution procedures are available to prevent the misuse of trademarks.166

There seems to be a loss of faith in the international system for regulating Internet Domain Names.

The Trans-Pacific Partnership also puts forward text on domain name cybersquatting—even though there is already domestic laws addressing such issues (such as the Clinton era laws on cybersquatting), and the international arbitration system for domain names.

In respect of the previous leaked text, Susan Chalmers has made the point that there will be a conflict of regimes in respect of Internet Domain Names: ‘Subjugating a ccTLD to a plurilateral trade agreement is problematic’.167 She observed: ‘As a matter of principle, ccTLDs should decide themselves what their policies are and have the flexibility to determine how and when those policies should be modified, in a regulatory environment marked by fluidity that allows

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166 Ibid., 18-19.

individual ccTLDs to respond best to the needs of their particular community."\(^{168}\) Susan Chalmers fears: ‘The ccTLD’s policy development autonomy could be lost as it is directed, through legislation or otherwise, to revise its policies into harmony with the TPP.’\(^{169}\)

Article QQ.C.12 of the leaked text of the *Trans-Pacific Partnership* addressed the topic of domain name squatting thus:

In connection with each Party’s system for the management of its country-code top-level domain (ccTLD) domain names, the following shall be available:

(a) an appropriate procedure for the settlement of disputes, based on, or modeled along the same lines as, the principles established in the Uniform Domain-Name Dispute-Resolution Policy, or that is: (i) designed to resolve disputes expeditiously and at low cost, (ii) fair and equitable, (iii) not overly burdensome, and (iv) does not preclude resort to court litigation; and

(b) online public access to a reliable and accurate database of contact information concerning domain-name registrants;

(c) in accordance with each Party’s laws and, or relevant administrator policies regarding protection of privacy and personal data.\(^{170}\)

Article Q.C.12 (2) provided: ‘In connection with each Party’s system for the management of ccTLD domain names, appropriate remedies, shall be available, at least in cases where a person registers or holds, with a bad faith intent to profit, a domain name that is identical or confusingly similar to a trademark.’\(^{171}\)

\(^{168}\) Ibid.

\(^{169}\) Ibid.


\(^{171}\) Ibid.
Article 18.28 of the Final Text of the Trans-Pacific Partnership deals with the topic of Domain Names.\textsuperscript{172} The regime provides:

1. In connection with each Party’s system for the management of its country-code top-level domain (ccTLD) domain names, the following shall be available:
   (a) an appropriate procedure for the settlement of disputes, based on, or modelled along the same lines as, the principles established in the Uniform Domain-Name Dispute-Resolution Policy, as approved by the Internet Corporation for Assigned Names and Numbers (ICANN) or that:
      (i) is designed to resolve disputes expeditiously and at low cost;
      (ii) is fair and equitable;
      (iii) is not overly burdensome; and
      (iv) does not preclude resort to judicial proceedings; and
   (b) online public access to a reliable and accurate database of contact information concerning domain-name registrants, in accordance with each Party’s law and, if applicable, relevant administrator policies regarding protection of privacy and personal data.

2. In connection with each Party’s system for the management of ccTLD domain names, appropriate remedies\textsuperscript{[17]} shall be available at least in cases in which a person registers or holds, with a bad faith intent to profit, a domain name that is identical or confusingly similar to a trademark.\textsuperscript{173}

This final text looks largely similar to draft text on the topic of trade mark law and Internet Domain Names.

\textsuperscript{172} Article 18.28 of the Trans-Pacific Partnership 2015 \url{https://ustr.gov/trade-agreements/free-trade-agreements/trans-pacific-partnership/tpp-full-text}

\textsuperscript{173} Ibid.
Kimberlee Weatherall from the University of Sydney wonders whether this was a missed opportunity.\footnote{Kimberlee Weatherall, ‘Section by Section Commentary on the TPP Final IP Chapter Published 6 November 2015 – Part 1 – General Provisions, Trade Mark, GIs, Designs’, 2015, https://works.bepress.com/kimweatherall/31/} She comments: ‘It would probably have been better, rather than name--checking the UDRP specifically, to include in the treaty the key disputes to be addressed, the broad mechanism and any procedural requirements.’\footnote{Ibid.} She observed: ‘Better still, a properly drafted principles--- level IP Chapter would have focused on the goal: that is, an expeditious method for resolving disputes between TM owners and domain name registrants, leaving the detail to local systems or global developments.’\footnote{Ibid.} Kimberlee Weatherall notes that ‘The provision is TRIPS plus and far more detailed than past US free trade agreements, which have not generally included standards such as requirements that any processes be expeditious/fair and equitable/not overly burdensome.’\footnote{Ibid.}

It is noticeable that there is little way of text on public interest safeguards in respect of internet domain names in the Trans-Pacific Partnership. In her book, Internet Domain Names, Trade Marks and Free Speech, Professor Jacqueline Lipton has commented that there is too much focus upon the private interests of trademark holders in respect of Internet Domain Names. She maintains: ‘Since the adoption of the trademark-focused UDRP, very little has been done in the way of global policy development to protect other interests in domain names.’\footnote{Jacqueline Lipton, Internet Domain Names, Trade Marks, and Free Speech, Cheltenham (UK) and Northampton (MA, USA): Edward Elgar, 2010.} Lipton observed that ‘such interests might include free speech, privacy, personality rights, and rights
in geographic and cultural indicators.'\textsuperscript{179} She even worries that ‘competing commercial interests are not currently addressed particularly effectively under the UDRP.’\textsuperscript{180}

5. Geographical Indications

There has been a long history of conflict over geographical indications and international trade. As Dev Gangjee remarks in a recent book, the ‘law in this area’ has been ‘spectacularly messy for over a century.’\textsuperscript{181}

The \textit{Trans-Pacific Partnership} also has extensive text on country names and geographical indications.

Article 18.29 of the final text deals with ‘Country Names’: ‘Each Party shall provide the legal means for interested persons to prevent commercial use of the country name of a Party in relation to a good in a manner that misleads consumers as to the origin of that good.’\textsuperscript{182} There has been some significant litigation over country names in the past – particularly involving the company, Virtual Countries, which sought to claim country names in respect of domain names.\textsuperscript{183}

\textsuperscript{179} Ibid.
\textsuperscript{180} Ibid.
\textsuperscript{182} Article 18.29 of the \textit{Trans-Pacific Partnership} \url{https://ustr.gov/trade-agreements/free-trade-agreements/trans-pacific-partnership/tpp-full-text}
\textsuperscript{183} Matthew Rimmer, 'Virtual Countries: Internet Domain Names And Geographical Terms' (2003) 106 \textit{Media International Australia incorporating Culture and Policy} 124-136.
The International Trademark Association (INTA) has argued that ‘Provisions dealing with the relationship between trademarks and GIs should be included in the TPP Agreement, particularly.’

In the draft text, there was basic agreement that ‘The Parties recognize that geographical indications may be protected through a trademark or sui generis system or other legal means.’

A number of countries—notably Chile—have pushed for stronger protection of geographical indications for wine regions. In addition, Chile has also proposed that ‘The Parties recognize the geographical indication Pisco for the exclusive use for products from Chile and Peru.’

This proposal has been widely condemned by other countries. Chile, Singapore, Brunei, and Mexico have proposed an annex, which lists protected geographical indications. The United States has led the opposition to such a proposal.

The United States has sought to nobble these proposals on geographical indications. In its Special 301 Report, the United States explains its antipathy to geographical indications:

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184 International Trademark Association, ‘Trademarks and the Trans-Pacific Partnership’ (2013) 68 (2)

INTA Bulletin http://www.inta.org/INTABulletin/Pages/TrademarksandtheTrans-PacificPartnership.aspx


186 Ibid.
The United States is working intensively through bilateral and multilateral channels to advance U.S. market access interests and to ensure that the trade initiatives of other countries, including with respect to geographical indications (GIs), do not undercut U.S. industries’ market access. GIs typically consist of place names (or words associated with a place) and they identify products or services as having a particular quality, reputation, or other characteristic attributable to their geographic origin.187

The United States much prefers to rely upon trade mark protection (even though certain regions in the United States, such as the Napa Valley and Sonoma, are renowned for wine. Section E of the Intellectual Property Chapter deals with ‘Geographical Indications’.188

Article 18.30 considers the ‘Recognition of Geographical Indications’: ‘The Parties recognise that geographical indications may be protected through a trademark or sui generis system or other legal means’.189

Article 18.31 examines the ‘Administrative Procedures for the Protection or Recognition of Geographical Indications’:

If a Party provides administrative procedures for the protection or recognition of geographical indications, whether through a trademark or a sui generis system, that Party shall with respect to applications for that protection or petitions for that recognition:

(a) accept those applications or petitions without requiring intercession by a Party on behalf of its nationals;

(b) process those applications or petitions without imposition of overly burdensome formalities;

(c) ensure that its laws and regulations governing the filing of those applications or petitions are readily available to the public and clearly set out the procedures for these actions;

(d) make available information sufficient to allow the general public to obtain guidance concerning the procedures for filing applications or petitions and the processing of those applications or petitions in general; and allow an applicant, a petitioner, or their representative to ascertain the status of specific applications and petitions;

(e) ensure that those applications or petitions are published for opposition and provide procedures for opposing geographical indications that are the subject of applications or petitions; and

(f) provide for cancellation of the protection or recognition afforded to a geographical indication.

Article 18.32 considers the Grounds of Opposition and Cancellation:

1. If a Party protects or recognises a geographical indication through the procedures referred to in Article 18.31 (Administrative Procedures for the Protection or Recognition of Geographical Indications), that Party shall provide procedures that allow interested persons to object to the protection or recognition of a geographical indication and that allow for any such protection or recognition to be refused or otherwise not afforded, at least, on the following grounds:

(a) the geographical indication is likely to cause confusion with a trademark that is the subject of a pre-existing good faith pending application or registration in the territory of the Party;

(b) the geographical indication is likely to cause confusion with a pre-existing trademark, the rights to which have been acquired in accordance with the Party’s law; and

(c) the geographical indication is a term customary in common language as the common name[21] for the relevant good in the territory of the Party.

2. If a Party has protected or recognised a geographical indication through the procedures referred to in Article 18.31 (Administrative Procedures for the Protection or Recognition of Geographical Indications), that Party shall provide procedures that allow for interested persons to seek the cancellation of a geographical indication, and that allow for the protection or recognition to be cancelled, at least, on the grounds listed in paragraph 1. A Party may provide that the grounds listed in paragraph 1 shall apply as of the time of filing the request for protection or recognition of a geographical indication in the territory of the Party.[22]

3. No Party shall preclude the possibility that the protection or recognition of a geographical indication may be cancelled, or otherwise cease, on the basis that the protected or recognised term has ceased meeting the conditions upon which the protection or recognition was originally granted in that Party.

4. If a Party has in place a sui generis system for protecting unregistered geographical indications by means of judicial procedures, that Party shall provide that its judicial authorities have the authority to deny the protection or recognition of a geographical indication if any of the circumstances identified in paragraph 1 has been established.[23] That Party shall also provide a process that allows interested persons to commence a proceeding on the grounds identified in paragraph 1.

5. If a Party provides protection or recognition of a geographical indication through the procedures referred to in Article 18.31 (Administrative Procedures for the Protection or Recognition of Geographical Indications) to the translation or transliteration of that geographical indication, that Party shall make available procedures that are equivalent to, and grounds that are the same as, those referred to in paragraphs 1 and 2 with respect to that translation or transliteration.191

Article 18.33: Guidelines for Determining Whether a Term is the Term Customary in the Common Language:

With respect to the procedures in Article 18.31 (Administrative Procedures for the Protection or Recognition of Geographical Indications) and Article 18.32 (Grounds of Opposition and Cancellation), in determining whether a term is the term customary in common language as the common name for the relevant good in the territory of a Party, that Party’s authorities shall have the authority to take into account how consumers understand the term in the territory of that Party. Factors relevant to such consumer understanding may include:

(a) whether the term is used to refer to the type of good in question, as indicated by competent sources such as dictionaries, newspapers and relevant websites; and

(b) how the good referenced by the term is marketed and used in trade in the territory of that Party.[24]

Article 18.34 examines ‘Multi-Component Terms’: ‘With respect to the procedures in Article 18.31 (Administrative Procedures for the Protection or Recognition of Geographical Indications) and Article 18.32 (Grounds of Opposition and Cancellation), an individual component of a multi-component term that is protected as a geographical indication in the territory of a Party shall not be protected in that Party if that individual component is a term customary in the common language as the common name for the associated good’. 193

Article 18.35 looks at the ‘Date of Protection of a Geographical Indication’: ‘If a Party grants protection or recognition to a geographical indication through the procedures referred to in Article 18.31 (Administrative Procedures for the Protection or Recognition of Geographical

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Indications), that protection or recognition shall commence no earlier than the filing date[25] in the Party or the registration date in the Party, as applicable’. 194

Article 18.36 considers ‘International Agreements’:

1. If a Party protects or recognises a geographical indication pursuant to an international agreement, as of the applicable date under paragraph 6, involving a Party or a non-Party and that geographical indication is not protected through the procedures referred to in Article 18.31 (Administrative Procedures for the Protection or Recognition of Geographical Indications)[26] or Article 18.32.4 (Grounds of Opposition and Cancellation), that Party shall apply at least procedures and grounds that are equivalent to those in Article 18.31(e) (Administrative Procedures for the Protection or Recognition of Geographical Indications) and Article 18.32.1 (Grounds of Opposition and Cancellation), as well as:
(a) make available information sufficient to allow the general public to obtain guidance concerning the procedures for protecting or recognising the geographical indication and allow interested persons to ascertain the status of requests for protection or recognition;
(b) make available to the public, on the Internet, details regarding the terms that the Party is considering protecting or recognising through an international agreement involving a Party or a non-party, including specifying whether the protection or recognition is being considered for any translations or transliterations of those terms, and with respect to multi-component terms, specifying the components, if any, for which protection or recognition is being considered, or the components that are disclaimed;
(c) in respect of opposition procedures, provide a reasonable period of time for interested persons to oppose the protection or recognition of the terms referred to in subparagraph (b). That period shall provide a meaningful opportunity for interested persons to participate in an opposition process; and
(d) inform the other Parties of the opportunity to oppose, no later than the commencement of the opposition period.

2. In respect of international agreements covered by paragraph 6 that permit the protection or recognition of a new geographical indication, a Party shall:[27],[28]
(a) apply paragraph 1(b);
(b) provide an opportunity for interested persons to comment regarding the protection or recognition of the new geographical indication for a reasonable period of time before such a term is protected or recognised; and
(c) inform the other Parties of the opportunity to comment, no later than the commencement of the period for comment.

3. For the purposes of this Article, a Party shall not preclude the possibility that the protection or recognition of a geographical indication could cease.

4. For the purposes of this Article, a Party is not required to apply Article 18.32 (Grounds of Opposition and Cancellation), or obligations equivalent to Article 18.32, to geographical indications for wines and spirits or applications for those geographical indications.

5. Protection or recognition provided pursuant to paragraph 1 shall commence no earlier than the date on which the agreement enters into force or, if that Party grants that protection or recognition on a date after the entry into force of the agreement, on that later date.

6. No Party shall be required to apply this Article to geographical indications that have been specifically identified in, and that are protected or recognised pursuant to, an international agreement involving a Party or a non-Party, provided that the agreement:
(a) was concluded, or agreed in principle,[29] prior to the date of conclusion, or agreement in principle, of this Agreement;
(b) was ratified by a Party prior to the date of ratification of this Agreement by that Party; or
(c) entered into force for a Party prior to the date of entry into force of this Agreement for that Party.195

The United States Trade Representative was pleased by the final text of the agreement, observing that the agreement will keep ‘generic terms available for U.S. producers’:

The chapter helps address the potential for inappropriately “overprotecting” geographical indications in ways that shut out U.S. agricultural and food producers, including by providing opportunities for due process and requiring guidelines on how TPP partners should determine whether a term is generic in its market, as well as safeguards for owners of pre-existing trademarks.196

Moreover, the United States Trade Representative maintains: ‘The TPP will enhance due process and other disciplines on the use of GIs to address growing concerns of U.S. exporters, whose access to foreign markets can be undermined through overly expansive GI protections advocated by certain countries whose agricultural producers compete with U.S. exporters.’197

The Department of Foreign Affairs and Trade in Australia puts a positive spin on the text in the Trans-Pacific Partnership:

The Intellectual Property Chapter contains provisions to promote and protect Australian brands as geographical indications (GIs) in the TPP region… The Chapter requires fair and transparent protection of geographical indications through trade mark or dedicated (sui generis) systems. TPP Parties will provide robust and transparent application systems with opposition and cancellation procedures and grounds, including where a term would be likely to cause confusion with an already protected term, and where a term is generic. There are also safeguards for terms in translation and multi-component terms. The Chapter includes a clarification regarding GIs for wines, namely that a term need not be protected by a country where it is the same as the name of a grape variety that is considered to be generic in that country. With respect to new terms proposed for protection as GIs under international agreements, TPP Parties are required to provide additional transparency mechanisms and procedures for opposition or

196 United States Trade Representative, ‘Overview of the Trans-Pacific Partnership’, https://medium.com/the-trans-pacific-partnership/intellectual-property-3479efdc7adf#.njgmwkrui

197 Ibid.
opportunities for comment. These provisions will enable Australian agricultural exporters to better protect access for their products in TPP markets.\textsuperscript{198}

The Consortium for Common Food Names was delighted by the text on trade mark law and geographical indications in the \textit{Trans-Pacific Partnership}.\textsuperscript{199} Jaime Castaneda, the consortium’s executive director, commented:

\begin{quote}
The protection of these food names is an issue of enormous importance for producers and consumers of cheeses, meats, beverages and other foods worldwide. While the threat continues to grow, in 2015 we succeeded in elevating the issue and in opposing restrictions on the use of many common names across four continents.\textsuperscript{200}
\end{quote}

The group was pleased that the regime countered the European model in respect of geographical indications: ‘The TPP text aims to foster more transparency and fairer play in how countries consider GI registrations.’\textsuperscript{201} The Consortium for Common Food Names explained its lobbying approach in these terms: ‘In the lead up to the TPP agreement, CCFN and its members earlier in the year secured references to the threat posed by GIs that block the use of common food names in two reports from the White House’s Office of the U.S. Trade

\begin{itemize}
\item \textsuperscript{200} Ibid.
\item \textsuperscript{201} Ibid.
\end{itemize}
Representative.’ The group said: ‘Using geographical indications to restrict trade is a trend that has proliferated in recent years as European interests have sought to restrict competition from the United States and other non-European counties’. The group commented: ‘The USTR reports noted that geographical indications can act as a trade barrier and agreed with the consortium that more objective criteria are needed for determining if a food name is eligible for restriction.’

Australia is in an intermediate position – providing special protection in respect of geographical indications for wine, but not for food. This position is the result of a succession of trade agreements with the European Union. There have been significant conflicts over the boundaries of geographical indications in Australia for regions such as Coonawarra and King Valley.

In a report for the Rural Industries Research and Development Corporation, William van Caenegem, Peter Drahos, and Jen Cleary have explored Australia’s position in respect of geographical indications. After engaging in interviews with a wide range of stakeholders, the academics make a case for the introduction of a regime of geographical indications in respect of food. The authors observed: ‘We find that although there is no universal need for

202 Ibid.
203 Ibid.
204 Ibid.
registered GIs, there is a case to be made for the introduction of a food GI registration system.  

In their view, ‘Our data show that the availability of flexible, low-cost GI registration could be a useful response to some local issues and conditions in particular regions and relating to particular problems.’ Nonetheless, the writers commented: ‘There is no ‘one-size-fits-all’ GI system that will accommodate the plethora of business models or the broad diversity of agricultural and food industry activity across Australia.’

William van Caenegem, Peter Drahos, and Jen Cleary observed: ‘That diversity ranges across high volume, commodity production in areas such as grains, fruit, vegetables and livestock, with little value-adding occurring in the region of product origin; through to high-value goods such as whisky, cheese, chocolate and truffles where much of the value-adding occurs within the region or origin and is dependent upon characteristics of the region as a signifier of quality.’ The authors make the case: ‘In the case of high-value goods aimed at discerning consumers, either through direct sales, or through broader distribution channels, the option of GI registration may well be beneficial.’ They comment: ‘Whatever form the design of a food GI register might take, we emphasise that while the principle of flexibility is important and necessary to support the diversity of Australian food production, the credibility of such a register and system should not be compromised.’ The researchers concluded: ‘Our recommendation is that the design of a
GI registration scheme for Australia’s food sector should become an integral part of the planning and policy conversations taking place around the future of Australian agriculture.  

The Productivity Commission considered Australia’s approach to the protection of trade marks and geographical indications in its review of Intellectual Property Arrangements in 2016.

Professor Michael Geist provides an overview of the other complex regime in the *Trans-Pacific Partnership*:

Section E of the TPP’s intellectual property chapter establishes the legal protections for geographical indications. The U.S. is opposed to GI protection (it argues that trademarks can achieve the same thing) and wanted to use the TPP to help block European demands for GI protection. The section therefore creates several types of GI protection: protections for new GIs (very stringent requirements including the possibility of cancellation), protections for existing GIs (which are effectively grandfathered), and protections for new GIs due to existing international agreements, for which a couple of procedures are identified.

His assessment is that the regime reflects a United States paradigm in respect of the relationship between agriculture, trade mark law, and geographical indications.

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213 Ibid.


Professor Michael Geist has considered the position of Canada in the debate over geographical indications. He observed that there was a confusing patchwork of rules in respect of geographical indications – given the Comprehensive Economic Trade Partnership (CETA), and the Trans-Pacific Partnership. Geist noted that side-letters complicated the position in respect of geographical indications:

If that was not sufficiently complex, Canada also signed four side letters on GIs. The letters with Peru and Chile simply confirm that existing GI approach found in the Peru and Chile free trade agreements with Canada. The letter with Japan confirms the existence of GIs protected in each country and opens the door to new ones in the future. Most notably, the letter with Mexico identifies three Mexican GIs that are eligible for protection, but Canada reserves the right to use the TPP’s cancellation provisions. This letter may explain the confusing footnote that allows for two different compliance approaches.

Geist laments that ‘a trade agreement that is supposed to make things easier for business actually succeeds in making it more difficult’. He warns: ‘These rules will have a real-world impact on Canada and Canadian businesses, which will be left to grapple with numerous different legal approaches and commitments to GIs arising from domestic rules, the various trade agreements, and side letters with one-third of TPP members.’

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217 Ibid.

218 Ibid.

219 Ibid.
The European Union has been watching the debate over geographical indications in the *Trans-Pacific Partnership* closely. The European Union is at loggerheads with the United States over the protection of geographical indications in the *Trans-Atlantic Trade and Investment Partnership*.

The European Union has pushed for an expansive protection of geographical indications for alcohol and food in a variety of fora – including in the World Intellectual Property Organization, and the World Trade Organization. The European Union has also relied upon bilateral agreements and regional agreements to provide for greater protection of geographical indications.

Masimo Vittori, the Managing Director of oriGIn – the global network of geographical indications producers – has analysed the possible impact of the *Trans-Pacific Partnership* and the *Trans-Atlantic Trade and Investment Partnership* upon geographical indications.\(^{220}\) He remains concerned about the level of protection of geographical indications in the United States and the European Union.

The International Dairy Association was upset by the effort of the European Union to push for expanded protection of geographical indications in the *Trans-Atlantic Trade and Investment Partnership*.\(^{221}\)

\(^{220}\) Masimo Vittori, ‘The Geographical Indication (Food) in the TPP and TTIP’, oriGIn, 28 February 2016, [https://www.youtube.com/watch?v=c5v2aHECEjs](https://www.youtube.com/watch?v=c5v2aHECEjs)

There has also been competition between Australia and Japan over wagyu beef.\textsuperscript{222}

No doubt, in any future international trade agreement, the European Union will be pressing Australia to extend geographical indications protection to food and foodstuffs.

**Conclusion**

In the conclusion to her groundbreaking book, *No Logo*, Naomi Klein called for a coalition of activists to challenge the hegemony of Big Brands, and reclaim the cultural commons: ‘Ethical shareholders, culture jammers, street reclaimers, McUnion organizers, human-rights hactivists, school-logo fighters and Internet corporate watchdogs are at the early stages of demanding a citizen-centered alternative to the international rule of brands.’\textsuperscript{223} She suggested: ‘That demand, still sometimes in some areas of the world whispered for fear of a jinx, is to build a resistance—both high-tech and grassroots, both focused and fragmented—that is as global, as capable of coordinated action, as the multinational corporations it seeks to subvert.’\textsuperscript{224} Such a challenge remains with international trade agreements, such as the *Trans-Pacific Partnership*, with its panoply of rights and remedies for global trade marks and big brands. There has also been further concern about trade mark owners invoking investor-state dispute settlement to challenge various labelling schemes (such as in the fields of tobacco, food and alcohol).


\textsuperscript{224} Ibid.