

# The Controversy of Trade in Tobacco and Protection of Public Health, A Study of Tobacco Control Measures and Impacts on Trademark Practice: The Stricter, The Better?

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## Abstract

*This paper investigates the anticipated trademark problems may result from tobacco control regulations, particularly the warning label requirements implemented in WTO members and the stricter regulation of plain packaging promulgated in Australia ("tobacco measures"). Following the adoption of the Framework Convention on Tobacco Control ("FCTC") in May 2003 (enforce by February 2005), member countries tend to seek for possibilities to implement and use stricter approach to achieve their public health policy. As the core concept and main goal of WTO is trade liberalization, regardless of types of goods traded among members, whereas the stricter restriction on trademark use means the prohibition of exploiting intellectual property rights of trademark owners, TRIPS is thus unavoidably related and has been brought by tobacco companies to be against the regulations, claiming that this poses unjustifiable trade barriers to business and denying its legitimacy in corresponding to the WTO obligations. To what extent the FCTC instructs or entitles members to pose barriers on trade in tobacco basing on public health purpose? Is there any correlation between the FCTC, a framework adopted under World Health Organization ("WHO"), and the covered agreements under WTO such as TRIPS?*

**Keywords:** warning label, plain-packaging, TRIPS, tobacco control regulation, Framework Convention on Tobacco Control, FCTC, public health policy

## I. INTRODUCTION

Cigarette smoking is the single biggest avoidable cause of death and disability in developed countries<sup>2</sup>. It has been, from time to time, rapidly increasing before the Second World War in the developing countries<sup>3</sup> and becomes one of the biggest threats to current and future world

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<sup>2</sup> See general Richard Edwards, *the Problem of Tobacco Smoking*, *Clinical Review* (2004), available at <http://www.bmj.com/content/328/7433/217.full> (last visited Jun. 17, 2012).

<sup>3</sup> P. Vateesatokit, B. Hughes and B. Ritthphakdee, *Thailand: Winning Battles, but the War's Far from Over* (2000), at 1, available at <http://bmj-tobacco.highwire.org/content/9/2/122>.

health as it does not affect only to people but also provide social and unavoidable economic consequences. It is estimated that tobacco use causes death for more than five million people a year and the number could raise to more than eight million by 2030 unless measures are taken to control the tobacco epidemic<sup>4</sup>.

To cope with the situation, various measures have been adopted to control tobacco consumption<sup>5</sup>. This includes the early policy of warning label requirement (“health warning label”) that has been being used in many countries as well as the recent development of the stricter rule of tobacco control such as plain packaging (“plain package”) in Australia adopted in 2011<sup>6</sup>. In Thailand, one of the early countries adopted the control measures, because of a high consumption of tobacco in the country back in 1980s<sup>7</sup>, with internal force of public<sup>8</sup>, government passed the Tobacco Products Control Act B.E. 2535 and the Non-Smokers’ Health Protection Act B.E. 2535 which cover important provisions on i) total ban on tobacco advertising, promotion and sponsorship, ii) prohibition of youth access to tobacco (under 18), iii) disclosure of constituents and emission of product to the Ministry of Public Health, iv) warning label requirement with 9 pictorial health warnings, and v) prohibition of the misleading descriptors such as “light” or “mild”, and so on.<sup>9</sup> These followed after the first ban on tobacco advertising of Thai government by including tobacco in the dangerous products category under the Consumer Protection Act which brought WTO dispute against Thailand on GATT violation<sup>10</sup>.

While in US, the battle between big tobacco companies and US government also brought some social awareness, evidenced in the law-

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full (last visited Jun. 17, 2012).

<sup>4</sup> Valentina S. Vadi, *Global Health Governance at a Crossroads: Trademark Protection v. Tobacco Control in International Investment Law*, 48 Stan. J. Int’l L. 93 (2012), at 95-96.

<sup>5</sup> Such as plain packaging, prohibition on promotion and advertisement, excise tax and etc.

<sup>6</sup> Tania Voon, *Acquisition of Intellectual Property Rights: Australia’s Plain Tobacco Packaging Dispute*, E.I.P.R. 2013, 35(2), 113-118 (2013), at 113-114.

<sup>7</sup> See Vateesatokit, Hughes and Ritthphakdee, *supra* note 2, at 2.

<sup>8</sup> *Id.*

<sup>9</sup> Thailand Tobacco Products Control Act B.E. 2535 (1992), sec. 4, sec. 8-9, and sec. 11-13.

<sup>10</sup> Panel Report, *Thailand-Restriction on Importation of Internal Taxes on Cigarettes*, BISD/37/S/200 (Nov. 7, 1990).

suits against the Food and Drug Administration (“FDA”) of the five tobacco companies and R.J. Reynolds before the federal court in Kentucky. This happened soon after the President Obama signed the Family Smoking Prevention and Tobacco Control Act (“FSPTCA”) in 2009, which gives FDA authority to regulate tobacco products and amends the Federal Cigarette Label Advertising Act to require cigarette makers to place larger warning labels on their package. The claims based on the ground of constitution and freedom of speech violation as well as trademark (including trade dress) infringement<sup>11</sup>. In European Union (“EU”), after the European Parliament and the Council of the EU have adopted the Directive in 2001<sup>12</sup>, label litigations were also raised to oppose by tobacco companies, claiming an infringement of Article 295 EC and member states’ systems of property ownership and a violation of trademark provisions in TRIPS. Among various issues under consideration of the European Court of Justice (“ECJ”), a number of provisions in TRIPS (i.e. Article 8 and Article 17) were ignored by court to strike down to rule a precedent<sup>13</sup> and left important issues undecided on its legitimacy. Along with stricter approach of the plain package being used in Australia and the problem on uncertainty of legal compatibility of the tobacco regulations with TRIPS, many contentious issues are yet unsolved but can likely be settled by the use of an interpretative tool available in the Vienna Convention on the Law of Treaty or VCLT<sup>14</sup>. At least in the contexts of the warning label requirement and the plain packaging regulation, Articles 31 and 32 are undeniably relevant according to TRIPS Article 64.1 that can be used for purpose of interpretation of the arguments in Articles 8, 15, 16, 17 and 20. The research can be expected to produce a reliable-legal-base answer and provide public analyzing steps to base on. This is according to the customary rule of interpretation that TRIPS should, at the end, comply.

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<sup>11</sup> See generally Benjamin A. Hackman, *On the Mark? Big Tobacco Asserts Property Rights on Cigarette Packaging*, 29 Penn St. Int’l L. Rev. 809 (2011).

<sup>12</sup> *Id.*, at 811.

<sup>13</sup> *Id.*, at 817.

<sup>14</sup> See generally Vienna Convention on the Law of Treaties, 1155 U.N.T.S 331, 8 I.L.M. 679 (1969) [hereinafter VCLT] art. 31 and art. 32.

## **II. INTRODUCTION TO FUNDAMENTAL RULES OF TRIPS AND TRADEMARK**

TRIPS or the Agreement on Trade-Related Aspects of Intellectual Property Rights, constituting as Annex 1C of the Agreement Establishing the World Trade Organization (“WTO Agreement”)<sup>15</sup>, is the most comprehensive international agreement on intellectual property protection<sup>16</sup>. With pressure from the United States Trade Representative (“USTR”) through the use of the Special 301<sup>17</sup>, TRIPS was concluded and put into force in 1995, setting down a minimum standard of protection, in many forms of intellectual property (“IP”). With respect to trademark, TRIPS recognizes trademark and provides protections detailed in Section 2 of Part II, Standards Concerning the Availability, Scope and Use of IPRs, which covers seven provisions. Looking back into TRIPS’ history, the regulation on trademark was not a major negotiation issue as controversial as patents. The major dissent between the two sides of developed and developing countries in the field of trademark, in retrospect, was the extent to i) which rules complementing the Paris Convention should be harmonized in a future agreement within the GATT and ii) whether countries could continue establishing them at the national level. As the consequence, the first compilation proposed by the Chair was the substantive and procedural shortcomings of trademark protection in GATT, which revealed no major problems in Paris Convention, and TRIPS was so drafted in the way to compile and provide some clarifications<sup>18</sup>.

Though TRIPS seems to complete what Paris Convention lacked, as the parties initially put forward of their emphasis on the international harmonization of IP standard and enforcement especially on patent, the provisions of trademark, in comparison to patents, are likely regulated imbalanced. That being said, though TRIPS acknowledges trademark as

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<sup>15</sup> WTO Agreement, Marrakesh Agreement Establishing the World Trade Organization, Apr. 15, 1994, The Legal Texts: The Results Of The Uruguay Round Of Multilateral Trade Negotiations 4 (1999), 1867 U.N.T.S. 154, 33 I.L.M. 1144 (1994), List of Annexes, Annex 1C: Agreement on Trade-Related Aspects of Intellectual Property Rights [hereinafter WTO Agreement].

<sup>16</sup> Terence P. Stewart, *The GATT Uruguay Round: A Negotiating History*, 478-79 (1993).

<sup>17</sup> *Id.*

<sup>18</sup> *Id.*, at 207-208.

a private right similarly to patent<sup>19</sup> described in the Preamble, it seemingly fails to recognize “*the enjoyment of right without discrimination*”. By comparing with patent provision in Article 27, whether this failure is good or not, the terms carefully chosen should literally connote a limited protection of trademark rights given to owners such in a manner of being restricted to the Articles 15, 16, 17 and 20. This primary understanding is important to analysis on legitimacy of the tobacco measures in the following chapter such as the warning label and plain package<sup>20</sup>. As trademark is long recognized to function as to i) promote market and sell products (advertising function), ii) refer to a particular enterprise (differentiation function), iii) refer to a particular quality of the product (guarantee function), and iv) indicate origin or source of one’s product from others’ (indication of origin function)<sup>21</sup>, impacts on trademark functions and practical trademark system shall also be important that deserve to mention and include in the study. This is in order to manifest the consequences of tobacco measures in practice, a view of holistic-approach perspective that current research rarely touched upon.

### **III. DISPUTES ON TRIPS AGREEMENT AND TREATY INTERPRETATIVE TOOLS**

DSB and Dispute Settlement Understanding (“DSU”) are not related to TRIPS merely because Article 64.1 so indicates but also the nature of the dispute itself that lies upon the enforcement of the dispute settlement process promulgated in the DSU. Under umbrella of WTO, according to Article 3.2, the DSU provides that interpretation of all WTO agreements, including TRIPS, shall be “*in accordance with custom-*

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<sup>19</sup> Agreement on Trade Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, The Legal Texts: The Results Of The Uruguay Round Of Multilateral Trade Negotiations 320 (1999), 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994) [hereinafter TRIPS Agreement] Preamble par. 4 provides: “Recognizing that intellectual property rights are private right...”.

<sup>20</sup> See generally Trevor Stevens, *Tobacco Plain Packaging Reforms: What They Mean to Australian Trademark Law and our International Obligation* (2011), available at <http://www.davies.com.au/pub/detail/501/tobacco-plain-packaging-reforms-what-they-mean-for-australian-trade-mark-law-and-our-international-obligations> (last visited Jun. 18, 2012).

<sup>21</sup> Wat Tingsamij, *Explanation of Trademark Law*, 3 (2002).

ary rules of interpretation of public international law”<sup>22</sup>, known in the name of the Vienna Convention. As evidenced in a number of reports of Panel and Appellate Body (“AB”), discussion on TRIPS disputes usually begin with explanation of its correlation with the VCLT and end up with application and then adjudication. In *India-Patent Protection for Pharmaceutical and Agricultural Chemical Products*, the AB has stated that “. . .the duty of a treaty interpreter is to examine the words of the treaty to determine the intentions of the parties. This should be done in accordance with the principles of treaty interpretation set out in Article 31 of the Vienna Convention. . .”<sup>23</sup> Thus, it is very rational to start our analysis of legitimacy of the health warning label and plain packaging regulations by reviewing the tools of interpretation, starting with Article 31, the General Rule of Interpretation, of the provisions in the VCLT<sup>24</sup>.

#### A. VCLT

Article 31: General Rule of Interpretation reads:

1. A treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose.

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<sup>22</sup> Understanding on Rules and Procedures Governing the Settlement of Disputes, Marrakesh Agreement Establishing the World Trade Organization, Annex 2, The Legal Texts: The Results Of The Uruguay Round Of Multilateral Trade Negotiations 354 (1999), 1869 U.N.T.S. 401, 33 I.L.M. 1226 (1994) [hereinafter DSU] art. 3.2 provides: “The dispute settlement system of the WTO is a central element in providing security and predictability to the multilateral trading system. The Members recognize that it serves to preserve the rights and obligations of Members under the covered agreements, and to clarify the existing provisions of those agreements in accordance with customary rules of interpretation of public international law. Recommendations and rulings of the DSB cannot add to or diminish the rights and obligations provided in the covered agreements”.

<sup>23</sup> Appellate Body Report, *India – Patent Protection for Pharmaceutical and Agricultural Chemical Products*, 45, WT/DS50/AB/R (Dec. 19, 1997) [hereinafter *India-Patent for Pharmaceuticals Appellate Body Report*]; Panel Report, *India – Patent Protection for Pharmaceutical and Agricultural Chemical Products*, WT/DS50/R (Sept. 5, 1997), as modified by Appellate Body Report.

<sup>24</sup> Nattapong Suwan-in, *Compulsory License, A Long Debate on TRIPS Agreement Interpretation: Discovering the Truth of Thailand’s Imposition on Pharmaceutical Patents*, 7 Asian J. WTO & Int’l Health L. & Pol’y 225 (2012), at 231-232.

2. The context for the purpose of the interpretation of a treaty shall comprise, in addition to the text, including its preamble and annexes:
  - a) Any agreement relating to the treaty which was made between all the parties in connection with the conclusion of the treaty;
  - b) Any instrument which was made by one or more parties in connection with the conclusion of the treaty and accepted by the other parties as an instrument related to the treaty.
3. There shall be taken into account, together with the context:
  - a) Any subsequent agreement between the parties regarding the interpretation of the treaty or the application of its provisions;
  - b) Any subsequent practice in the application of the treaty which establishes the agreement of the parties regarding its interpretation;
  - c) Any relevant rules of international law applicable in the relations between the parties.

Article 31 begins its core concept of interpretation with a plain meaning against a broader context of holistic approach. Though there is no term holistic or rational in the provision, its key captures the cornerstone that TRIPS must be interpreted in good faith in accordance with the ordinary meaning to be given to the terms in their context and in the light of its object and purpose. The wording suggests a logic of human nature and cogent belief that interpretation must be first started somewhere with the ordinary terms and its meanings before extending its understanding to surrounding context as well as object and also purpose<sup>25</sup>. As Prof. Susy Frankel described Article 31 as a “*logical progression*” rather than a “*hierarchy of legal norms*”<sup>26</sup> and the Appellate Body in *United States-Standards for Reformulated and Conventional Gasoline* has also confirmed that *the need to apply other rules of international law is unnecessary if Article 31.1 already provides the answer*<sup>27</sup>, in consideration of the case of tobacco measures, our analysis shall then accordingly be scoped and focused on i) the treaty terms provided in TRIPS, ii) its object and purpose provided in Article 8, iii) TRIPS’ preamble,

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<sup>25</sup> *Id.*, at 232-233.

<sup>26</sup> Susy Frankel, *WTO Application of “the Customary Rules of Interpretation of Public International Law” to Intellectual Property*, 46(2) Va. J. Int’l L. 365, 386 (2006).

<sup>27</sup> Appellate Body Report, *United States – Standards for Reformulated and Conventional Gasoline*, WT/DS2/AB/R (Apr. 29, 1996).

and iv) any subsequent agreement or practice or any relevant rules by means of VCLT Article 31.3, in order to conclude if the measures are in violation of provisions in TRIPS. To facilitate an interpretation, FCTC and the Doha Declaration on Public Health (“Doha Declaration”) are usually brought by implementing states to support their legitimacy and compatibility with international obligations. To what extent FCTC can be used to support government’s argument and to what extent FCTC can entitle Member states to pose barrier on trade in tobacco, resulted from the warning label and/or plain packaging requirement, as claimed by Australia?<sup>28</sup> In response to these, our analytical study in the following session will hence demonstrate the correlation of the FCTC, the Doha Declaration, and TRIPS by means of Article 31 of the VCLT. As the Doha Declaration was previously analyzed in the author’s article<sup>29</sup> and it is nowadays confirmed by the AB’s decision in *US-Clove Cigarettes* that the Declaration can constitute as a subsequent agreement subject to VCLT Article 31.3(a)<sup>30</sup>, the one problem left for determination is then the legal status of the FCTC. This is in order to solve the TRIPS-violation-dispute questions.

## B. FRAMEWORK CONVENTION ON TOBACCO CONTROL: ITS ROLE AND THE LEGAL STATUS

1. *Introduction to the Framework Convention on Tobacco Control* — The WHO Framework Convention on Tobacco Control or FCTC is the first treaty adopted in World Health Organization by virtue of Article 19 of the Constitution. Within the competence of the organization, Health Assembly of WHO has authority to adopt conventions or agreements with respect to any matter related<sup>31</sup>.

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<sup>28</sup> Australia Tobacco Plain Packaging Act 2011, No.148, 2011, Sec. 3 (1)(b) provides: “to give effect to certain obligations that Australia has as a party to the Convention on Tobacco Control”; See also Tania Voon, *Flexibilities in WTO Law to Support Tobacco Control Regulation*, 39 Am. J.L. & Med. 199 (2013), at 204-205.

<sup>29</sup> See generally Suwan-in, *supra* note 23.

<sup>30</sup> See Benn McGrady, *Revisiting TRIPS and Trademark: the Case of Tobacco* (2012), at 2, available at <http://ssrn.com/abstract=2144269> (last visited Jul. 29, 2013).

<sup>31</sup> World Health Organization Constitution, 14 U.N.T.S 185 (1948) [hereinafter WHO Constitution] art. 19 provides: “The Health Assembly shall have authority to adopt conventions or agreements with respect to any matter within the competence of the Organiza-



To the first time that the Health Assembly has ever adopted, WHO activated its constitution to develop the treaty to protect present and future generations from health, social and economic consequences of tobacco use<sup>32</sup>. Especially at this time when the global nature of the tobacco epidemic required a global health governance mechanism to effectively address the problem, the move represented a major breakthrough in international public health law as WHO has never before adopted conventions, despite of the instruments, for instance, recommendations and regulations<sup>33</sup>. The convention reflects scientific consensus on the lethal effects of tobacco smoke and advances global cooperation for tobacco control<sup>34</sup>, so adopted on May 21, 2003 in the 56<sup>th</sup> World Health Assembly and came into force on February 27, 2005<sup>35</sup>. It contains thirty-eight provisions in total, regulates from the rules that govern production, sale, distribution, advertisement, and taxation of tobacco to protection of environment and settlement of disputes, just to name a few. Similarly to TRIPS, FCTC provides minimum standard of requirements suggested to its member. Because the FCTC, by law, binds only the state parties that have ratified it (currently signed by 168 countries and of 177 ratifying countries<sup>36</sup>), in case where there is conflict with other treaty regimes such as TRIPS, one may question about its legal status and their correlation. This is especially when the FCTC suggests and uses a non-obligatory language and even a very open-ended term.

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tion. A two-thirds vote of the Health Assembly shall be required for the adoption of such conventions or agreements, which shall come into force for each Member when accepted by it in accordance with its constitutional processes”.

<sup>32</sup> World Health Organization Constitution, Framework Convention on Tobacco Control (2005) [hereinafter FCTC] art. 3 provides: “The objective of this Convention and its protocols is to protect present and future generations from the devastating health, social, environmental and economic consequences of tobacco consumption and exposure to tobacco smoke by providing a framework for tobacco control measures to be implemented by the Parties at the national, regional and international levels in order to reduce continually and substantially the prevalence of tobacco use and exposure to tobacco smoke”.

<sup>33</sup> See Vadi, *supra* note 3, at 100-101.

<sup>34</sup> *Id.*, at 101-102.

<sup>35</sup> Wikipedia, the Free Encyclopedia, *World Health Organization Framework Convention on Tobacco Control*, [http://en.wikipedia.org/wiki/World\\_Health\\_Organization\\_Framework\\_Convention\\_on\\_Tobacco\\_Control](http://en.wikipedia.org/wiki/World_Health_Organization_Framework_Convention_on_Tobacco_Control) (last visited Aug. 26, 2013).

<sup>36</sup> *Id.*

2. *FCTC and its Legal Status subject to the Vienna Convention.*

— FCTC, by relying on Article 19 of the Constitution<sup>37</sup>, is an international convention or agreement legitimately resolved via voting at the ratio of two thirds in majority by the assembly and also in pursuit of the constitutional procedure<sup>38</sup>. To likely constitute as a subsequent agreement according to points of views of some scholars, claiming that FCTC can be a ground to strengthen and support developing countries from departure of their burden of disease from tobacco when this sort of tobacco control infrastructure was absent, to our remark that the FCTC is a framework convention under the WHO, while TRIPS is of or belongs to the WTO, to be interpreted in conjunction with Article 31 of the VCLT, we found difficulty to agree with the notion with two main reasons in support of our argument.

First, FCTC and TRIPS are separated agreements, came to alive for each individual purpose and launched in a different period of time. While the FCTC, under WHO, has objectives to protect human health and social consequences from tobacco use, TRIPS, on the other hand is under WTO, mainly aimed to overcome the problem of discrimination and generate free trade. As the previous decision made by AB in the *ACP-EC Partnership Agreement*<sup>39</sup> has previously ruled that “*the material issues to consider a subsequent agreement by the meaning of Article 31.3(a) of the VLCT shall be (i) adopted by the same parties as of the covered treaty,*<sup>40</sup>*(ii) characterized as an agreement bearing specifically upon the interpretation of a treaty which is, in the WTO context, adopted pursuant to Article IX:2 of the WTO Agreement,*<sup>41</sup> *and (iii) in*

<sup>37</sup> See *supra* note 30.

<sup>38</sup> *Id.*

<sup>39</sup> See generally Ministerial Conference, *European Communities – The ACP-EC Partnership Agreement*, WT/MIN(01)/15 (Nov. 14, 2001), available at [http://www.wto.org/english/thewto\\_e/minist\\_e/min01\\_e/mindecl\\_acp\\_ec\\_agre\\_e.pdf](http://www.wto.org/english/thewto_e/minist_e/min01_e/mindecl_acp_ec_agre_e.pdf) (last visited Mar. 20, 2012).

<sup>40</sup> World Trade Organization [WTO], 18 Dispute Settlement Reports 2008 7281 (June 28, 2010). “We agree with the Panel that the Doha Article 1 Waiver was adopted by the same parties that approved the European Communities’ Schedule . . . .”

<sup>41</sup> *Id.*, at 7281-82 (the International Law Commission (ILC) describes a subsequent agreement within the meaning of Articles 31(3)(a) of the Vienna Convention as a further authentic element of interpretation to be taken into account together with the context”. In our view, by referring to “authentic interpretation”, the ILC reads Article 31(3)(a) as referring to agreements bearing specifically upon the interpretation of a treaty. In the WTO context,

*force as to interpret the covered treaty, not to connote the creation of new obligation or modification of the covered treaty”*,<sup>42</sup> it is difficult to say that FCTC is a subsequent treaty adopted pursuant to Article IX:2 of the WTO Agreement and in force to interpret TRIPS, the covered agreement and treaty in dispute. This is though a scholar such as Prof. Benn McGrady likely sees the provisions of FCTC being relevant in interpretation of WTO law (so as its guideline), regardless of the fact that it was made under WHO<sup>43</sup>. Without support from the Panel’s and AB’s decisions in the recent case of *US-Clove Cigarettes* that concluded nothing *explicitly* regarding the legal status of the FCTC but *literally* and *merely*, an acknowledgement and recognition of importance of tobacco control to Member countries<sup>44</sup>, therefore, it is thorny to conclude that the FCTC can contribute to interpret TRIPS as a subsequent agreement though some proponents and implementing countries may so far attempt to claim so<sup>45</sup>.

Second, the authority of the Health Assembly, according to Article 19 of the WHO constitution, is limited to only the adoption of conven-

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multilateral interpretations adopted pursuant to Article IX:2 of the WTO Agreement are most akin to subsequent agreements within the meaning of Article 31(3)(a) of the Vienna Convention . . . .” The Doha Declaration is also adopted pursuant to Article IX:2 of the WTO Agreement because it was proposed initially through the TRIPS Council which in turn made recommendations to the General Council and the General Council then reported to the Ministerial Conference at Doha, which oversaw the functioning of the TRIPS (Annex 1C), and approved by consensus from all Members. Article IX:2 reads “The Ministerial Conference and the General Council shall have the exclusive authority to adopt interpretations of this Agreement and of the Multilateral Trade Agreements. In the case of an interpretation of a Multilateral Trade Agreement in Annex 1, they shall exercise their authority on the basis of a recommendation by the Council overseeing the functioning of that Agreement. The decision to adopt an interpretation shall be taken by a three-fourths majority of the Members. ).

<sup>42</sup> *Id.*, at 7282.

<sup>43</sup> Benn McGrady, *Trade and Public Health: The WTO, Tobacco, Alcohol, and Diet*, 36-37 (2011) “The basic obligations set out in a number of provisions have been supplemented by guidelines that are an expression of best practice... assuming this to be the case, these guidelines arguably fill out the content of basic FCTC obligations and would be relevant in interpretation of WTO law in much the same way as the provisions of the FCTC itself”.

<sup>44</sup> See Voon, *supra* note 27; See also McGrady, *supra* note 29, at 6; See also Tania Voon, *Note on WTO Appellate Body Report in US-Measures Affecting the Production and Sale of Clove Cigarettes* (2012), at 8, available at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=2143804](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2143804) (last visited Jul. 31, 2013).

<sup>45</sup> See Voon, *supra* note 43, at 204-205.

tions or agreements with respect to matters within the competence of the Organization. As the context imparts, “*within the competence of the Organization*” and its ordinary meaning explain a limited scope of authority that the assembly is allowed to restrictly be on a health related issue that shall become the gist of the agreement. The terms make us understand that it is probably going too far to conclude that this includes an interpretative function to explain trade related matter and provision such specified in TRIPS.

Found in the same provision, apart from the subsection 3(a), the VCLT further regulates other interpretative tools that are yet applicable to the FCTC for purpose of interpretation. According to this issue, if both parties in dispute adopt the FCTC provisions into their practice, it is possibly that the FCTC can work as a subsequent practice (VCLT Article 31.3(b), or at least as a relevant rule of international law, pursuant to the VCLT Article 31.3(c), defined by the International Law Commission<sup>46</sup>. However, viewing FCTC from the Article 31.3(c) perspective, Prof. Tania Voon from Melbourne Law School likely sees some difficulties of applying the provision. They are i) the concept or definition of the relevant rules of international law<sup>47</sup>, and ii) the interpretation of the term “between the parties”, that both subsections (a) and (c) share in common. Despite of the fact that a relevant rule of international law can work across international organizations, such as the FCTC under WHO to the interpretation of TRIPS under WTO<sup>48</sup>, to precisely prove

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<sup>46</sup> “Relevant” means that the rules are on the same subject matter or that in any way affect the specified interpretation. The term “international law” without adjective should denote public international law, rather than private international law which is specified and under the principle of conflict of laws. Further, the phrase “applicable in the relations between the parties” supports that even treaty obligations are covered by Article 31 (3) (c). That was a particularly important matter where one treaty had to be interpreted in the light of other treaties binding on the parties. Moreover, this phrase should refer to parties to the treaty that is being interpreted.

<sup>47</sup> Sebastian Mantilla Blanco, *the Interpretation of the WTO Agreement* (2010), at 16, available at [http://www.javeriana.edu.co/juridicas/pub\\_rev/univ\\_est/documents/4Interpretacion.pdf](http://www.javeriana.edu.co/juridicas/pub_rev/univ_est/documents/4Interpretacion.pdf) (last visited Jul. 29, 2013).

<sup>48</sup> See Voon, *supra* note 27, at 205-206. “The uncertainty surrounding the scope of VCLT Article 31(3)(c) need not pose a significant barrier to panels or the Appellate Body referring to the WHO FCTC in the course of resolving tobacco-related disputes, because Article 31(3)(c) does not provide the only means of referring to non-WTO law in the course of interpretation...”; See also Panel Report *EC-Measures Affecting the Approval and Marketing of Biotech Products*, 7.68, WT/DS291/R, WT/DS292/R, WT/DS293/R (Sept. 29,

its legal basis, Sebastián Mantilla-Blanco, in his research paper of the Interpretation of the WTO Agreement, has given four guidelines for consideration. Saying, first, such rule by its nature, must be relevant for the interpretation of any international regime. Second, the rule must be applicable in the relations between the parties. Third, the relevance of non-mandatory rules must be assessed on a case-by-case basis, bearing in mind that their applicability to a specific relationship depends on the objectively-ascertained intention of the parties. And forth, the source of a rule will not affect its application in this context. As previously ruled by the Panel in EC-Biotech that the term “rules of international law” as used in VCLT Article 31.3(c) is broad enough to cover all general sources of international law<sup>49</sup>, then the second criteria seems holding the key in order to decide whether the FCTC can be classified as a relevant rule of international law. According to this issue, the Panel in EC-Approval and Marketing of Biotech Products<sup>50</sup> had previously suggested that “the parties” shall mean all the WTO Members, such that only a treaty to which all WTO Members are party could be counted as a rule of international law pursuant to VCLT Article 31.3(c). As the trend shows in i) the US-Clove Cigarettes that somehow demonstrates the correlation of FCTC and the WTO covered agreement, and ii) the decision made by the Panel in EC-Approval and Marketing of Biotech Products that somehow supports the use of FCTC for purpose of interpretation<sup>51</sup>, together with iii) the recent opinions made by Pascal Lamy, the Director-General of WTO and Dr. Margaret Chan, the Director-General of WHO, confirming that WTO rules and the implementation of the FCTC are actually in line and in fact compatible<sup>52</sup>, the

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2006) [hereinafter EC-Approval and Marketing of Biotech Products]. “we recognize that a proper interpretation of the term “the parties” must also take account of the fact that Article 31(3)(c) of the Vienna Convention is considered an expression of the “principle of systematic integration”... in a multilateral context such as the WTO, when recourse is had to a non-WTO rule for the purposes of interpreting provisions of the WTO agreements, a delicate balance must be struck...”.

<sup>49</sup> See Blanco, *supra* note 46, at 111.

<sup>50</sup> See EC- Approval and Marketing of Biotech Products Panel Report, *supra* note 47.

<sup>51</sup> *Id.*, 7.94. “the mere fact that one or more disputing parties are not parties to a convention does not necessarily mean that a convention cannot shed light on the meaning and scope of a treaty term to be interpreted”.

<sup>52</sup> WHO Framework Convention on Tobacco Control, *WTO Rules and the Implementation of the WHO FCTC are not incompatible* (2011), available at <http://www.who.int/fctc/>

multilateral instruments such as the FCTC can (or should) at least be relevant to determine “ordinary meaning” of particular terms pursuant to the VCLT Article 31.1 as of the same logic of applying GATT’s necessity test to the term “necessary” appeared elsewhere in other treaties. This is regardless of any practice followed by the parties (if any) that can possibly be amounted to “subsequent practice” by means of VCLT Article 31.3(b).

#### **IV. LEGAL ANALYSIS ON LEGITIMACY OF HEALTH WARNING LABEL AND PLAIN PACKAGING REGULATIONS UNDER TRIPS**

##### **A. HEALTH WARNING LABEL REQUIREMENT AND PLAIN-PACKAGING REGULATION ON TOBACCO**

Under the Framework Convention on Tobacco Control, warning label regulation is understood as a health warning requirement for package of tobacco product which describes harmful effects of tobacco use and regulated by competent national authority. Within different jurisdictions and under different legal systems, the requirement of the health warning label may be regulated in a different manner and level, basing on national health policy specifically set by Member states that in any case would deem legitimate as long as the standard in FCTC is met<sup>53</sup>. Despite of the proportion of the warning label that the regulation may require, there is a common form of pictorial warning and/or messages imposed by WTO Members that can possibly amount to a restriction of trademark use. In EU, according to the Directive adopted in 2001, the label requirement mandates that the two most visible surface of every cigarette package shall display a warning label at least 30 percent of the most visible exterior. The proportion may be increased up to 35 percent if Members have official languages up to three<sup>54</sup>. Similar to the FSPTCA of the US that requires top half of the front and rear panels of

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[wto\\_fctc/en/index.html](http://wto_fctc/en/index.html) (last visited Jun. 18, 2012).

<sup>53</sup> FCTC art. 1(b)(i) provides: “(b) each unit packet and package of tobacco products and any outside packaging and labelling of such products also carry health warnings describing the harmful effects of tobacco use, and may include other appropriate messages. These warnings and messages: (i) shall be approved by the competent national authority...”

<sup>54</sup> See Hackman, *supra* note 10, at 811-813.

cigarette packs to contain one of the nine warnings, showing the risks of smoking and a warning message, up to 70 percent of the warning area<sup>55</sup>. While in Thailand, the Tobacco Products Control Act B.E. 2535 requires pictorial warning label at the proportion of 55 percent<sup>56</sup>. Notwithstanding the percentage that each country's law requires, the regulations commonly limit the appearance of tobacco trademark that may communicate to public and prevent owners from their use. Even at this time when the plain packaging regulation was first introduced in Australia, offering public a concrete form of a tighten measure that steps beyond a simple health warning label to a smaller and stricter scope by forcing the use of trademark (either via registration or use) to be restricted in a single form of a plain, standard font, size, color and identical design of word without device<sup>57</sup>, these bring a significant question on legitimacy and compatibility of the regulations with the international intellectual property obligations such as TRIPS.

## B. COMPATIBILITY OF THE TOBACCO MEASURES WITH TRIPS

Among various arguments alleged by tobacco companies, criticisms brought against tobacco measures, in the context of trademark, are mostly and commonly on the claims of i) infringement and devaluation of protected trademarks<sup>58</sup>, ii) denigration of trademark goodwill and value through the use of pictorial warnings<sup>59</sup>, iii) expropriation of property and private right by limiting their right to use<sup>60</sup>, and iv) its incompatibility with the provisions of TRIPS, namely Article 15.4, 16,

<sup>55</sup> *Id.*, at 817-818.

<sup>56</sup> See *supra* note 8, sec.12; See also Thailand's Ministry of Public Health Notice of Rules, Procedures, and Conditions for the Display and Content of Cigarette Labels (2009), available at <http://www.tobaccocontrolaws.org/files/live/Thailand/Thailand%20-%20Cigarette%20Label%20Regs%202009.pdf> (last visited Aug. 25, 2013).

<sup>57</sup> See Vadi, *supra* note 3, at 96-97. "Plain packaging is a packaging regime that requires the removal of colors, designs, and logos from cigarette packs while allowing the brand name to be displayed in a standard font. Plain packaging is to reduce the incidence of smoking by making cigarette packets less appealing. The Bill will require all cigarettes to be sold in unattractive olive-green packs"; See also McGrady, *supra* note 29.

<sup>58</sup> See Hackman, *supra* note 10, at 818-819.

<sup>59</sup> See Vadi, *supra* note 3, at 106-107.

<sup>60</sup> Sam Foster Halabi, *International Trademark Protection and Global Public Health: A Just-Compensation Regime for Expropriations and Regulatory Takings*, 61 *Cath. U. L. Rev.* 325 (2012), at 345.

17, 20, and unjustification pursuant to Article 8.1. As the terms provided in TRIPS are flexible and reserved for members' implementation<sup>61</sup>, TRIPS can thus be understood when the VCLT is brought to interpret together with precedents ruled by Panel and AB that possibly guide to a feasible solution may adopt by WTO<sup>62</sup>. To the extent that some proponents view tobacco measures as a fair use exempted by Article 17, while opposers yet reject such argument, the following analysis will therefore extract individual elements of the Articles, including Article 15.4 and Article 20, and discuss all in details. With regards to the challenge on the fair-use exception, Articles 16 and 17 of the TRIPS provide:

TRIPS: Article 16 and 17

Art. 16.1 (Right Conferred)	Art. 17
The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion...	Members 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 interests of the owner of the trademark and of third parties

To view the warning label and the plain package regulations as fair-use, the conditions in Article 17 literally communicate the rule providing that the exception must be limited and be exception to the right conferred. Without a right to protect, there is likely no exception would be required. At the heart of the debate, the key would then underline the ordinary meaning of the term "right conferred" in Article 16 and

<sup>61</sup> TRIPS art.1.1 provides: "Members shall give effect to the provisions of this Agreement. Members may, but shall not be obliged to, implement in their law more extensive protection than is required by this Agreement, provided that such protection does not contravene the provisions of this Agreement. Members shall be free to determine the appropriate method of implementing the provisions of this Agreement within their own legal system and practice".

<sup>62</sup> See *supra* note 22.



capture their correlation to form a holistic understanding. Simply, the provision states that the owner of a registered trademark shall have the exclusive right to prevent a third party to use identical/similar mark on similar products that would likely cause confusion to consumers. It is a matter of fact that the right granted is the right of exclusivity which its nature can exemplify the negativity or negative right to exclude the use of trademark by someone else. As positive right can easily understand as the right to use, none of the provision in the article entitles tobacco companies to protest or claim when their right is restricted (or limited) for such a vital purpose like public health. Furthermore, as it was earlier mentioned in the EC-Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs<sup>63</sup>, the Panel noted that;

*“The limited exceptions apply to the right conferred by a trademark... Article 17 permits exceptions, to rights to exclude legitimate competition, rather, they confer, inter alia, the right to prevent uses that would result in a likelihood of confusion”*

It can hence be argued that the claim earlier made by tobacco companies is in no way compliance with the provisions in TRIPS. Whereby TRIPS provides flexibility in implementation to Member states via Article 1.1, positive right (i.e. right to use) is de facto provided at a domestic level during the process of national implementation<sup>64</sup> rather than in the international level. It then sounds unreasonable to claim that the restriction of tobacco measures to use trademark would amount to a violation of TRIPS. Added in support by the TRIPS’s preparatory work in the light of VCLT Article 32<sup>65</sup>, the history also confirms our conclu-

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<sup>63</sup> Panel Report, *EC-Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs*, 7.651, WT/DS290/R (Mar. 15, 2005)

<sup>64</sup> For instance, rights i) to authorize other persons to use trademark [Section 20(1)(b)], ii) to bring an action for infringement of trademark [Section 26(1)(b)], iii) to display trademark on goods in respect of which the trademark is registered or on their packages or containers [Section 26(1)(c)], v) to permit any person to apply trademark to goods [Section 26(1)(f)], v) to assign a registered trademark [Section 106(1)] and etc., as literally explain in the Australian Trademark Act 1995, though there is yet a dissent on the nature of trademark right appeared in the high court of Australia (See *JT International SA v. Commonwealth of Australia and British American Tobacco Australasia Limited v. The Commonwealth*). Other countries’ trademark laws, such as Thailand, are also promulgated in the same manner.

<sup>65</sup> VCLT art. 32 provides: “Supplementary Means of Interpretation: Recourse may be had to supplementary means of interpretation, including the preparatory work of the treaty and

sion, provided that the content of Article 16.1 is the result of the second phase of discussion, triggered by the EC proposal of the draft in 1990, which its emphasis was initially on the negative right, the claim of the tobacco companies is hence unpersuasive and also unreasonable.

As interest in using trademarks is deeply connected to its capability of being distinguish goods of undertakings in the course of trade from others at the gist of the trademark law, acknowledged by the Panel's decision in *EC-Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs* 66, trademarks can yet be expected to perform its function though tobacco measures are in force<sup>67</sup>. This is because the word-mark<sup>68</sup> is yet allowed to indicate and communicate to consumers of its origin in a specific form, now prescribed by specific law, namely the warning label and the plain package. TRIPS does not oblige WTO Members to provide trademark holders with a right to use their marks<sup>69</sup>.

TRIPS: Article 2

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the circumstances of its conclusion, in order to confirm the meaning resulting from the application of Article 31, or to determine the meaning when the interpretation according to Article 31: (a) Leaves the meaning ambiguous or obscure; or (b) Leads to a result which is manifestly absurd or unreasonable”.

<sup>66</sup> See *supra* note 62. “The TRIPS Agreement itself sets out a statement of what all WTO Members consider adequate standards and principles concerning trademark protection. Although it sets out standards for legal rights, it also provides guidance as to WTO Members’ shared understandings of the policies and norms relevant to trademarks and, hence, what might be the legitimate interests of trademark owners. The function of trademarks can be understood by references to Article 15.1 as distinguishing goods and services of undertakings in the course of trade. Every trademark owner has a legitimate interest in preserving the distinctiveness, or capacity to distinguish, of its trademark so that it can perform that function. This includes its interest in using its own trademark in connection with the relevant goods and services of its own and authorized undertakings. Taking account of that legitimate interest will also take account of the trademark owner’s interest in the economic value of its mark arising from the reputation that it enjoys and the quality that it denotes”.

<sup>67</sup> See *general Halabi, supra* note 59.

<sup>68</sup> There are generally two types of trademarks, namely i) word marks (i.e. the characters comprising the name of a brand) and ii) non-word marks (i.e. device, figurative or stylized marks) such as logos and combined marks containing stylized letters, shape marks and color marks. Some may refer to this non-word mark as a device mark. Please take Marlboro, a famous mark of tobacco products, as an example.

<sup>69</sup> See *EC-Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs* Panel Report, *supra* note 62, para.7.610-7.611; See also McGrady, *supra* note 29.

Art. 20	Interpretative Tool VCLT Art.31.1
The use of trademark in the course of trade shall not be unjustifiably encumbered by special requirements, such as use with another trademark, use in a special form or use in a manner detrimental to its capacity to distinguish the goods or services of one undertaking from those of other undertakings...	<i>Ordinary Meaning:</i>
	1. There is a special requirement(s)
	2. Such requirement is related to the course of trade
	3. Such requirement must be unjustifiably (unjustified)
	4. There is encumbrance arisen from such requirement
	5. Encumbrance is to the use of mark

Notwithstanding the exclusive right provided by TRIPS, the Agreement further recognizes trademark as a private right in paragraph four of its Preamble<sup>70</sup>. It is an affirmation of capitalistic principle that is translated into Article 20<sup>71</sup> and aim to outlaw special requirement making use of trademark difficult in the course of trade and to save owners from unjustified encumbrances. As touched many times by commentators in their research, Article 20 likely provides a strongest opposition for tobacco companies to be against tobacco measures as its character appears to be within scope of the Article 20. Found in the article, the law requires a numbers of proof to show that i) there is a special requirement imposed, ii) the requirement imposed is related to the course of trade, iii) what imposed in the course of trade is unjustified, iv) such unjustified requirement causes encumbrance, and v) that encumbrance influences the use of mark. “Requirement”, per its wording, is referring to the act of demand, requisition, or requiring. While “encumbrance”

<sup>70</sup> See supra note 18.

<sup>71</sup> Nuno Pires de Carvalho, The TRIPS Regime of Trademarks and Designs, 89 (1993), at 45.

would mean an obstruction that impedes or a burden<sup>72</sup>, the entire provision thus gives us an understanding that Article 20 shall denote a “special” demand or requirement, but not voluntariness<sup>73</sup>, in a sense that a trademark use in the course of trade will be prohibited or restricted and finally causes obstruction to trademark owners. To the extent that the warning label and plain packaging regulations restrict the use of trademarks in various formats prescribed by laws, it seems reasonable to conclude that Article 20 would likely apply to both the measures that prevent trademark from performing their functions.

Now turning us to the consideration of “unjustification” last mentioned in the article, “justified”, according to Wordnet dictionary, means to show or prove to be just, right or reasonable. So, to be seen as “just”, there must be a goal to be pursued. At least those that are prohibited under GATT should not be considered legitimate or “just”<sup>74</sup> in pursuit of the law. The AB, in *Brazil-Measures Affecting Imports of Retreaded Tyres*<sup>75</sup>, has mentioned that discrimination would be arbitrary or unjustifiably when i) the reasons given for discrimination bear no rational connection to the objective falling within the purview of a paragraph of Article XX, or ii) would go against that objective. Thus, in order to conclude whether the tobacco measures are unjustifiable, there must first be i) a public health policy and objective of invoking state that fall within GATT Article XX(b)<sup>76</sup> and ii) also a proof that the measures can achieve such goal.

<sup>72</sup> See generally Wordnet dictionary

<sup>73</sup> See Panel Report, *Indonesia-Certain Measures Affecting the Automobile Industry*, 14.278, WT/DS54/R (Jul. 2, 1998).

<sup>74</sup> Nuno Pires de Carvalho, *The TRIPS Regime of Trademarks and Designs*, 89 (1993), at 329.

<sup>75</sup> Appellate Body Report, *Brazil-Measures Affecting Imports of Retreaded Tyres*, 227, WT/DS332/AB/R (Dec. 3, 2007).

<sup>76</sup> General Agreement on Tariffs and Trade 1994, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1A, THE LEGAL TEXTS: THE RESULTS OF THE URUGUAY ROUND OF MULTILATERAL TRADE NEGOTIATIONS 17 (1999), 1867 U.N.T.S. 187, 33 I.L.M. 1153 (1994) [hereinafter GATT 1994] art. XX(b) provides: “Subject to the requirement that such measures are not applied in a manner which would constitute a means of arbitrary or unjustifiable discrimination between countries where the same conditions prevail, or a disguised restriction on international trade, nothing in this Agreement shall be construed to prevent the adoption or enforcement by any contracting party of measures: ... (b) necessary to protect human, animal or plant life or health...”.

For long that justification has been treated as close to the necessity test in many WTO case law<sup>77</sup>, this may imply a requirement of applying the test in the proof of justification according to TRIPS Article 20, in the light of the GATT, due to the WTO dispute procedure<sup>78</sup>. In the context of Australia, for example, the objectives of adopting the warning label requirement is to i) increase consumer knowledge of health effects relating to smoking and ii) to encourage the cessation of smoking and to discourage uptake or relapse, along with a number of requirements specified in the Trade Practice (Consumer Product Information Standards) (Tobacco) Regulations 2004. The measure is viewed, at least, not against its objectives and likely consistent. It is deemed justifiable according to the above interpretation with support from the case law. While the plain package, the objectives set out in Section 3 of the Tobacco Plain Packaging Act 2011<sup>79</sup> is broad enough to possibly conclude that the measure undertaken is also consistent (emphasis added). Likely, the measure requirements related to public policy objective are usually recognized and accepted to be justifiable (emphasis added)<sup>80</sup>. Though there is a number of scholars and researchers in support this notion<sup>81</sup>, this paper argues that it is not always the case. Based on the VCLT Ar-

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<sup>77</sup> See Daniel Gervais, *Analysis of the Compatibility of certain Tobacco Product Packaging Rules with the TRIPS Agreement and the Paris Convention* (2010), at 29, available at <http://www.smoke-free.ca/trade-and-tobacco/Resources/Gervais.pdf> (last visited Aug. 26, 2013).

<sup>78</sup> *Id.*, at 28.

<sup>79</sup> See *supra* note 27, sec. 3 provides: “Objects of this Act, (1) The objects of this Act are:(a) to improve public health by:(i) discouraging people from taking up smoking, or using tobacco products; and (ii) encouraging people to give up smoking, and to stop using tobacco products; and (iii) discouraging people who have given up smoking, or who have stopped using tobacco products, from relapsing; and (iv) reducing people’s exposure to smoke from tobacco products; and (b) to give effect to certain obligations that Australia has as a party to the Convention on Tobacco Control.

(2) It is the intention of the Parliament to contribute to achieving the objects in subsection (1) by regulating the retail packaging and appearance of tobacco products in order to:(a) reduce the appeal of tobacco products to consumers; and (b) increase the effectiveness of health warnings on the retail packaging of tobacco products; and (c) reduce the ability of the retail packaging of tobacco products to mislead consumers about the harmful effects of smoking or using tobacco products”.

<sup>80</sup> See Carvalho, *supra* note 73, at 330; See also Alberto Alemanno and Enrico Bonadio, *Do you Mind My Smoking? Plain Packaging of Cigarettes under the TRIPS Agreement*, 10 J. Marshall Rev. Intell. Prop. L. 450 (2011), at 464-465.

<sup>81</sup> *Id.*

ticle 31.1, to make our interpretation entirely and holistically coherent, it is worth noting that interpretation should also be consistent with the principle provision in TRIPS Article 8. The provision reads :

Art. 8.1 (Principles)
Members may, in formulating or amending their laws and regulations, adopted measures necessary to protect public health and nutrition, and to promote the public interest in sectors of vital importance to their socio-economic and technological development, provided that such measures are consistent with the provisions of this Agreement

Rather than overriding Members' obligations<sup>82</sup>, Article 8 likely works to interpret and mirror the main purpose of balancing the right to promote public interest in sectors of vital importance to their socio-economic and technological development, provided that such measures are consistent with the provisions in TRIPS. With regards to this issue, Member states can adopt measures to protect public health and nutrition as long as it is "necessary"<sup>83</sup>. As the term used in Article 8.1 is different to the term used in the Article 20, by viewing the term on as-is basis, it can be reasonably expected that the standard of proving or threshold of justifiability should therefore be lower than the threshold of the necessity test<sup>84</sup>. Similar to the AB's decision in *Brazil-Measures Affecting Imports of Retreaded Tyres*, the invoking Member would then need to demonstrate a genuine relationship of ends and means between the objective pursued and the measures at issue, such that the measure brings about a material contribution to achieve its objective<sup>85</sup>. A Member may also demonstrate this through evidence of a qualitative or quantitative nature, given that no set requirements on the type of evidence that a Member must have to support implementation of a measure and a member needs not prove that the measure will be effective in achieving its

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<sup>82</sup> See Gervais, *supra* note 76, at 17.

<sup>83</sup> See *supra* note 75.

<sup>84</sup> See McGrady, *supra* note 29, at 4.

<sup>85</sup> See *supra* note 74, para. 145.

objective because it can only be evaluated with the benefit of time<sup>86</sup>.

To prove “necessary”, Panel and AB have previously ruled in the two important cases which set standard in their precedents. Here, US-Standard for Reformulated and Conventional Gasoline in 1996 (Panel) and US-Import Prohibition of Certain Shrimp and Shrimp Products in 1998 (AB), both have sum up the three major elements to qualify “necessary”. That to be said, in order to be necessary, i) there must be a policy in respect of the measure designed to protect public health, ii) there is correlation between the measure and policy objective that is necessary to fulfill, and iii) such measure is the only way to accomplish the policy, given that no other less restrictive measure than the one intended. Thus, while there is no common statistical information confirms efficiency of tobacco measures, especially the plain-packaging, towards tobacco consumption<sup>87</sup>: this paper found it difficult to conclude that the plain packaging regulation, in particular, would then be justifiable unless the objective in public health is set at the maximum as to protect the entire nation from being in touch with tobacco. To the extent that this research argues that impacts resulted from the plain package on trademark use will likely be tremendous<sup>88</sup>: by comparing to the case EC-Measures Affecting Asbestos and Asbestos-Containing Products<sup>89</sup>: it is still possible that the plain packaging regulation can yet amount to the term necessary and justifiable subject to Article 20 in the light of the TRIPS’s principle in Article 8. Supported by the Panel’s decision in *European Communities I*<sup>90</sup> and the latter case of *Thai Cigarette* in 1990<sup>91</sup>: the level of public policy objective is therefore left up to Members to decide.

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<sup>86</sup> *Id.*, para 151.

<sup>87</sup> See Gervais, *supra* note 76, at 27.

<sup>88</sup> See C. The Stricter, the Better? Impacts on Trademark System in Practice

<sup>89</sup> Appellate Body Report, *European Communities - Measures Affecting Asbestos and Asbestos-Containing Products*, WT/DS135/AB/R (Mar. 12, 2001) [hereinafter EC-Measures Affecting Asbestos and Asbestos-Containing Products]; Panel Report, *European Communities - Measures Affecting Asbestos and Asbestos-Containing Products*, WT/DS135/R (Sep. 18, 2000).

<sup>90</sup> See Carvalho, *supra* note 73, at 190. “...paragraph one of Article 8 reflects the fact that the TRIPS Agreement does not generally provide for the grant of positive rights to exploit for use certain subject matter, but rather provides for the grant of negative rights to prevent certain acts. This fundamental feature of IP protection inherently grants Members freedom to pursue legitimate public policy objectives...”.

<sup>91</sup> See *supra* note 9.

## **V. THE STRICTER, THE BETTER? IMPACTS ON TRADE-MARK SYSTEM IN PRACTICE**

Though the balance can be maintained via interpretative tool such as ordinary meaning, object and purpose, and subsequent agreement, i.e. the Doha Declaration, that recently confirmed in the US-Clove Cigarettes, it does not change the fact that there are likely impacts resulted from the imposition of tobacco measures. At this point of problem where general research hardly touched on, as the use of trademark on tobacco in the context of plain package is now limited to only the plain text, while devices and figures are required to be taken down, the limitation thus raises a number of questions to courts, government registrars and IP lawyers on how the measures are supposed to work in conjunction with current practice where the fact of “trademark use” (as opposed to non-use) is very much important.

### **1. Trademark Use: Acquisition of Trademark Protection (Via Use)**

Trademark use has long been acknowledged and recognized in trademark law of its vital function on distinctiveness that relates to consumers’ capability of distinguishing source or origin of products. In the context of trademark acquisition, many civil law system and almost Anglo-American common law countries give trademark protection through the use of a mark if it is capable of distinguishing one’s source of product from others<sup>92</sup>. To the extent that the use of trademark is now limited as the result of the plain packaging regulation, distinctiveness is expected to be hard for marks’ owners to establish, through the use of plain text without figures or devices, that would create brand image in minds of consumers. Especially for tobacco product which its advertising is prohibited in many countries’ laws, brand image will likely require a longer time and effort until a mark will become distinguishable. Possibly that a mark being limited by force of the health warning label will also face the same dilemma, the problem in this case will be very less severe comparing to the plain package as its word marks can nonetheless indicate and communicate to consumers its origin. Though the plain packaging measure may be considered legitimate as explained in the previous chapter, the impact to the acquisition of trademark pro-

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<sup>92</sup> See Gervais, *supra* note 76, at 16.



tection via use is yet another issue which is a big question to users and also legislators to dwell.

## 2. Trademark Use: Registration of a New Mark and Trademark Infringement (Likelihood of Confusion)

Another issue related to trademark use is the analysis on the level of similarity appeared in most of the countries' trademark registration. In case where a mark in application is consisted of both wording and device, analysis or consideration of a trademark registrar on similarity of the two marks will generally be on the mark entirely comparing to the previous ones registered (emphasis added). As the use of a registered trademark relating to tobacco will now be limited and different from what they formerly registered with IP office, the question will then be how a registrar and court will scrutinize the similarity. While there is much uncertainty under the current system, it is foreseeably that the solution may base on two different approaches.

First, "as-is" basis, according to this approach, registrars may scrutinize similarity of the two marks basing on documents and samples of the marks provided without taking the fact of actual use into account. However, as the trademark use is undeniably related to the scope of protection and public's likelihood of confusion, the actual use will then, to some extent, influence the scrutiny in registrars' minds, causing them to possibly switch to the second approach where the consideration will base on the use of plain text in the case of plain package. According to TRIPS Article 15.4, this will likely pose a further question on legitimacy of using the registrars' discretion, the provision reads;

### TRIPS: Article 15.4

Art. 15.4 (Protectable Subject Matter)
The nature of the goods or services to which a trademark is to be applied shall in no case form an obstacle to registration of the trademark

This paper argues that registrars will likely encounter difficulty of implementing the second approach, provided that the discretion on comparing the similarity will likely be in violation of Article 15.4 of the TRIPS. This is because the focus of comparison is now on the nature of tobacco product. Very much likely that registrars will choose the “as-is” basis approach, fraudulent applicant may take advantage from this weakness by creating a mark with fancy device and stylized wording with different spelling and sound, i.e. Marlboro vs. Morlbare, as to deceive public in terms of origin or source of product that will generally amount to trademark infringement. As such mark, in comparison to the registered mark, would be deemed different on its sound and device but similar in spelling, the all-combined deception, which may entirely appear to be sufficiently distinctive, may cause likelihood of confusion to public once it is accepted for registration and used on tobacco product by force of the plain packaging regulation. Will this later case amount to infringement of the Marlboro trademark as it would likely cause confusion to consumers and mislead public?

Another example that would cause problem on trademark is a generic mark whereby its protection and distinctiveness can acquire through a combination of stylized wording and devices. When these are all combined together, registrar will usually require an applicant to disclaim on the generic word partially form and contribute as the whole registered trademark. As its right of protection will be limited and scoped on any device and/or components forming an entire registered mark, once it is registered and applied on a plain package of tobacco, it is hard to imagine how the registrar and court will deal with the situation in practice when merely an generic word is now appeared on tobacco product by force of the plain packaging law. Though the provisions are considered legitimate and compatible with the TRIPS, the problem is hard to imagine and the refusal of a registrar for trademark registration will also likely amount to the violation of TRIPS Article 15.4. Similar to our previous analysis, the problem is yet remained to be seen and suggests Members to beware if they intend to apply the regulation in the future<sup>93</sup>.

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<sup>93</sup> Currently, United Kingdom and New Zealand are considering of adopting tobacco plain packaging regulation to control tobacco product distributed in the countries; *See Voon, supra* note 5, at 118.

### 3. Trademark Use: Cancellation of Trademark (Non-Use)

In many countries' national trademark laws, non-use of a registered trademark may cause cancellation or revocation as trademark is recognized by Paris Convention as industrial property protected for business purpose. Because of some components of a registered mark that must be taken down and leave the use to merely on a plain word, question regarding non-use of components is then arisen if this amounts to a cancellation. Regarding this particular issue, Australian Tobacco Plain Packaging Act, explicitly regulates that non-use of a trademark for the purpose of complying with the Act does not provide a basis for revoking or refusing to register<sup>94</sup>. To the extent that this exception clause applies to both i) revocation of trademark and ii) refusal to register a trademark based on the reason of non-use, the correlation of this Act to the Australian trademark law seems to provide a compromising solution to the problem on cancellation but unlikely to the problem on registration of trademark. Only in the situation where trademark use is a pre-condition to apply or file for trademark registration that this clause would benefit, without devices or other compositions, such exception would not change the fact that distinctiveness and brand image are yet difficult to be created to acquire protection via use in minds of consumers. Similar to the second problem on registration of a new mark explained above, this exception clause is seen having limitation on its scope in implementation. Likely, the health warning label owns a lesser number of problems in comparison with the plain package imposed by Australia. So, will the stricter regulation always be better? By taking these impacts on trademark practice into account, whereas the effectiveness of the regulation is yet suspicious, these may second the implementing country to re-estimate the measure before adopting radi-

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<sup>94</sup> See *supra* note 27, sec. 28(3) provides: "To avoid doubt, for the purposes of sections 38 and 84A of the *Trade Marks Act 1995*, and regulations 17A.27 and 17A.42A of the *Trade Marks Regulations 1995*: (a) the operation of this Act; or (b) the circumstance that a person is prevented, by or under this Act, from using a trade mark on or in relation to the retail packaging of tobacco products, or on tobacco products; are not circumstances that make it reasonable or appropriate: (c) not to register the trade mark; or (d) to revoke the acceptance of an application for registration of the trade mark; or (e) to register the trade mark subject to conditions or limitations; or (f) to revoke the registration of the trade mark".

cal approach on tobacco control such as the plan package. This is unless the national trademark system is entirely reformed and adjusted for its full implementation.

#### 4. Trademark Use: The Use of Misleading Word

As the result of tobacco measures, there is also a claim that restriction of the use of trademark will amount to limitation on the use of components incorporated into a cigarette name, such as “mild”, “light”, and “ultra-light” descriptors commonly seen in market, that are legitimate and available<sup>95</sup>. To our notice that tobacco manufacturers and their affiliated advertisers have strategies to frame the information on its package, including the shape and size of the package by using such descriptors<sup>96</sup>, to create credence qualities in products through design suggestion and implication to make consumers believed that smoking a “mild” cigarette, for example, constitutes a positive health measure<sup>97</sup>, it is also questionable if such restriction will constitute a trademark infringement<sup>98</sup>.

Looking the problem from international law perspective, through the use of TRIPS Article 1.1 and Article 2.199 and Article 6quinquies of the Paris Convention<sup>100</sup>, the misleading representations can actually be

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<sup>95</sup> See Vadi, *supra* note 3, at 105-106. “Tobacco company usually claims that the terms “light”, “mild”, and “low” were incorporated into cigarette names and communicated differences of taste to consumers and such banning would not only destroy valuable trademarks and the goods that they represent but would also tantamount to indirect expropriation”.

<sup>96</sup> See Halabi, *supra* note 59, at 350-351.

<sup>97</sup> *Id.*, at 353-355.

<sup>98</sup> See Vadi, *supra* note 3, at 123-124.

<sup>99</sup> TRIPS art.2 provides: “In respect of Parts II, III and IV of this Agreement, Members shall comply with Articles 1 through 12, and Article 19, of the Paris Convention (1967)”.

<sup>100</sup> Paris Convention for the Protection of Industrial Property of 1883, 25 Stat. 1372, T.S. No. 379, 10 Martens Nouveau Recueil 2d 133, *revised* Dec. 14, 1900, 32 Stat. 1936, T.S. No. 411, 30 Martens Nouveau Recueil 2d 465, *revised* June 2, 1911, 38 Stat. 1645, T.S. No. 579, 8 Martens Nouveau Recueil 3d 760, *revised* Nov. 6, 1925, 47 Stat. 1789, T.S. No. 834, 74 L.N.T.S. 289, *revised* June 2, 1934, 53 Stat. 1748, T.S. No. 941, 192 L.N.T.S. 17, *revised* Oct. 31, 1958, 13 U.S.T. 1, T.I.A.S. No. 4931, 828 U.N.T.S. 107, *revised* July 14, 1967, 21 U.S.T. 1583, T.I.A.S. No. 6923, 828 U.N.T.S. 305 [hereinafter Paris Convention] art. 6quinquies.B provides: “Trademarks covered by this Article may be neither denied registration nor invalidated except in the following cases: (i) when they are of such

rejected by law as it is likely contrary to public order. Particularly in this issue, there are scholars, through their research, proposed “ex-ante” and “ex-post” approaches to prevent such unpleasant dilemma<sup>101</sup>. To our notice that only the ex-ante approach that is relevant to our problem of the misleading representation<sup>102</sup>, this paper argues that legislation can thus be used to pose additional requirements of trademark eligibility to prevent the problem as long as it does not conflict or violate provisions in TRIPS, namely Articles 15.4 and 20 and by means of Paris Convention Article 6quinquies. By taking Australian Trademark Law<sup>103</sup> and the US’s<sup>104</sup>, as an example, restriction on the use of misleading words or waiver of the claim of protection can actually be done by excluding them from incorporating in a trademark. This thus rebuts the argument of tobacco companies on the ground of legitimacy. Supported by medical evidence which shows that smokers would likely adopt a “light” version of a cigarette as a health measure, often as an alternative to quit smoking<sup>105</sup>, the current mechanism can therefore provide a perfect solution to the current problem resulted from tobacco measures.

## **VI. CONCLUSION**

The battle and claims of tobacco companies against health warning label and plain packaging regulations adopted in many countries have highlighted some significant issues concerning TRIPS that we have overlooked for many years. Many problems argued by tobacco

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a nature as to infringe rights acquired by third parties in the country where protection is claimed; (ii) when they are devoid of any distinctive character, ...or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed; (iii) when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public...”.

<sup>101</sup> See general Halabi, *supra* note 59.

<sup>102</sup> *Id.*, at 356-357. The ex-post approach was recently proposed by Prof. Sam Foster Halabi, College of Law, University of Tulsa.

<sup>103</sup> Australia Trademarks Act 1995, sec. 43 provides: “An application for the registration of a trademark in respect of particular goods or services must be rejected if, because of some connotation that the trademark or a sign contained in the trademark has, the use of the trademark in relation to those goods or services would be likely to deceive or cause confusion”.

<sup>104</sup> See Halabi, *supra* note 59, at 369-370.

<sup>105</sup> *Id.*, at 370-371.

companies are unlikely found in the contents of the TRIPS as priority of WTO Members in their early negotiation was on the bargain in patent provisions and the drafters' willingness to leave it opened for purpose of flexibility.

To provide analyzing steps to rely on, the Vienna Convention on the Law of Treaties or VCLT is necessary to be used to project the gist of the TRIPS and reveal the results of the Members' negotiations. Among the eighty five provisions, Articles 31 and 32 are very likely relevant to our understanding of the provisions in TRIPS by relying on its ordinary meaning in the light of its object and purpose. Together with previous decisions ruled by the DSB, the analysis revealed that among other claims, problems are mostly clustered on Articles 15.4, 16, 17 and 20, which is deeply connected to interpretation of justification and necessity under TRIPS Article 8.1. While the tobacco measures are seen falling under the scope of Article 20 provision, both regulations are likely found legitimate, justified, and compatible with TRIPS principle ruled in Article 8.1 as well as the Doha Declaration and the FCTC<sup>106</sup> with support from the DSB's precedents and TRIPS's history found in its preparatory works. Moreover, as the provision of TRIPS Article 16 is related to negative right, constituted as the right conferred of trademark holders, and while the tobacco measures under consideration are not an exception to the right conferred specified thereof, the measures are therefore considered not in violation of the TRIPS in both Article 16 and 17, as well as Article 15.4 that is regulated to merely prohibit discrimination on goods basing on nature that will form obstacles to trademark registration.

Trademark, unlike copyright and patent, is not intendedly protected to reward trademark creation but rather, it tires to the benefits mutually shared by manufacturers and also consumers. In review of the gist, i) the enhancement of fair competition, as to distinguish one's source or origin of product (emphasis added) from competitors, and ii) reduction of consumers' confusion and information cost are what the law mostly and profoundly emphasizes on<sup>107</sup>. Because the trademark law is origi-

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<sup>106</sup> See Section IV: Legal Analysis on Legitimacy of Health Warning Label and Plain Packaging Regulations under TRIPS, B. Compatibility of the Tobacco Measures with TRIPS.

<sup>107</sup> See Halabi, *supra* note 59, at 365-366.

nally created to prevent consumers' confusion and to provide fair competition in market, as the result of the tobacco measures, trademarks' capability of distinguishing origin or source of product is yet observed to remain though it is transformed into a form of a plain package or restricted in its size because of the health warning label requirement. Unless opposers can provide evidence showing that consumers will likely switch their consumption to a competing or like product in the same market, the measures would likely be considered legitimate and compatible to TRIPS where trademark distinctiveness is yet existed and subject to protection by virtue of the trademark law<sup>108</sup>.

Notwithstanding the tobacco measures' legitimacy and compatibility to TRIPS, this paper argues that there shall also be some impacts resulted from the restriction of trademark use that would likely affect trademark system in practice. Based on the fact that trademark acquisition, either via registration or use, trademark infringement and also trademark revocation, are all relying on the actual use of a trademark, discretion and standard of the courts and registrars in their consideration of trademark acquisition, revocation, and infringement will also likely be changed in response to the development of tobacco control measure.

Rather to call for Members' attention on the impacts, it is not the objective of this paper to oppose any radical implementation of any public health measure or to be against the regulations which aim to bring healthier population and stronger development in Member countries. To fully implement public health policy in the WTO Member states without violating both international and national trademark laws, Members are urged and encouraged to harmonize the systems with holistic approach, aiming to facilitate domestic health and the flow in trade simultaneously, in order to form a strong and balanced system to benefit right holders and also users. As previously observed through the use of Section 28 in Australian Tobacco Plain Packaging Act, though the provision is reserved to be further interpreted, the law is considered to be a good beginning of founding a harmonized system of trade and IP that other Member states can take into account. Among different approaches of tobacco measures such as the plain package and the public health

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<sup>108</sup> See Vadi, *supra* note 3, at 122-124.

warning label, countries may choose either a stricter or more flexible measure to implement. This is together with the number of unavoidable impacts that the Members shall always bear in mind.

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