

Summary Report

Standing Committee on Geographical Indications

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Questionnaire on Geographical Indications

Introduction

The purpose of this questionnaire was to seek information from AIPPI's National and Regional Groups (**Groups**) on developments in their respective jurisdictions in relation to geographical indications (**GIs**) and appellations of origin (**AOs**), and on the positions taken with regard to issues that have emerged from GI and AO legislation.

By way of background:

- according to the TRIPS Agreement, GIs are "indications which identify a good as originating in the territory of a [Country], or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin";
- a similar definition for GIs is adopted by the WIPO Geneva Act;
- under the WIPO Lisbon Agreement, an AO is a "geographical denomination of a country, region or locality, which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors"; and
- a similar definition for AOs is adopted by the WIPO Geneva Act.

The Standing Committee on Geographical Indications has received reports in response to the questionnaire from the following Groups and Independent Members in alphabetical order:

Argentina, Australia, Brazil, Bulgaria, Canada, China, Denmark, France, Hungary, Iran (Independent Member), Ireland, Israel, Italy, Japan, Kazakhstan (Independent Member), Malaysia, Mexico, the Netherlands, New Zealand, Pakistan, the Republic of Korea, the Slovak Republic (Independent Member), Spain, Sweden, Taiwan (Independent Member), the United Kingdom (**UK**), the United States of America (**U.S.**) and Vietnam.

28 reports were received in total. The Standing Committee and the Reporter General thank all contributors for their helpful and informative reports.

The reports provide a comprehensive overview of national and regional laws, and policy and practice, relating to GIs and AOs. This Summary Report does not attempt to reproduce the

detailed responses in any given report. If any question arises as to the exact position in a particular jurisdiction, or for a detailed account of any particular answer, reference should be made to the original reports. See <http://aippi.org/committee/geographical-indications-1/>.

In this Summary Report:

- references to reports of or responses by one or more "Groups" may include references to Independent Members;
- where percentages of responses are given, they are to the nearest 5%.

In answering the questions below, the Groups were asked to specify whether their answers differed:

- as between GIs and AOs; and
- depending on whether the GI or AO is foreign or domestic.

I. Analysis of current legislation and case law

1) Are GIs and/or AOs protected under your Group's current law?

All Groups report that GIs and/or AOs (but not necessarily both) are protected under their current law.

In the vast majority of cases, both GIs and AOs are protected. While some Groups reported that their law only expressly addresses GIs, the concept of GIs also encompasses AOs.

The Japanese report only mentions GIs. In New Zealand and Vietnam, only GIs are protected; their respective laws do not recognize AOs. The Mexican report notes that only AOs (not GIs) are regulated in the current Mexican Industrial Property Law; but it also states that Mexico applies the provisions of NAFTA and TRIPS concerning GIs.

The Kazakhstan report states that only AOs are protected.

2) If yes, please briefly describe the following:

a) How GIs and AOs are defined and the prerequisites (in particular the type, nature and intensity of link with a territory).

The vast majority of Groups report that GIs are defined in a way identical or similar to the TRIPS definition, i.e. as an indication which identifies a good as originating in a certain territory, region or locality, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.

If AOs are also defined, in most cases the definition is identical or similar to that of the Lisbon Agreement, i.e. the geographical denomination of a country, region or locality which serves to designate a good originating therein, when its quality or characteristics are due exclusively or essentially to the geographical environment, including natural and human factors.

Several EU Member States do not have a definition of GIs or AOs in national legislation, but refer to the definition of GIs and AOs in the EU Regulations, which in

turn mirror those of TRIPS and the Lisbon Agreement respectively.

In some countries (e.g. Canada and New Zealand), GIs are only defined for wines and spirits.

In the USA, AOs are only protected for certain "American Viticultural Areas", but there is no definition; GIs are defined in a way similar to the TRIPS definition.

Some Groups report that their laws have formulated specific forms of protection in addition to GIs and AOs. For example:

- in Argentina, indications of source for wines;
- in Brazil, indications of source for geographic names of areas that have become known as a center of extraction, production or manufacture of a given product or of provision of a given service;
- in France, geographical indications protecting industrial and handicraft products (*IGPIAs*), consisting of a name of a geographical zone or of a specific place denoting a product, other than an agricultural or forestry product, "foodstuff or produce of the sea", originating therefrom, which possesses a specific quality, a reputation or other characteristics that may be attributed essentially to that geographical origin;
- also in France, indications of provenance (sometimes recognised in case law).

In Taiwan, GIs and AOs have a similar definition; the difference being that GIs are protected as certification marks, while AOs are protected as collective marks.

In Kazakhstan, there is a single merged definition for GIs and AOs.

Some Groups report that GIs and AOs are protected not only for goods, but also for services. This is the case for GIs registered as certification marks in Australia, for indications of source in Brazil, for GIs and AOs in Taiwan, and for AOs in Iran.

b) Whether that protection is provided by sui generis laws; solely as aspects of other laws, such as by registration as collective or certification marks; or by other (and if so, what) means.

About 75% of Groups report that they have sui generis protection or in any case specific legislation on GIs. In Australia, this legislation only concerns wines; and in Canada and New Zealand, only wines and spirits.

China, Pakistan, the U.S. and Taiwan state that they have no sui generis protection for GIs.

About half of the reports, including those from the Groups that have no sui generis protection, or that have sui generis protection limited to wines and spirits, state that GIs can (also) be protected through certification or collective marks. Only the French report states that registration of GIs/AOs as collective or certification marks is not permitted under French law.

According to some reports, protection of GIs is also achieved through legislation on unfair competition and/or consumer protection. In Canada, Ireland, New Zealand and the UK, the tort of passing off is also applicable to GIs. In Canada, GIs are also

protected through the common law doctrine of shared goodwill.

c) If GIs and/or AOs are protected by sui generis laws, whether your Group's laws provide for a system of registration. If so, what are the steps of this procedure including the content of the application and the possibility of opposition by third parties.

All Groups having a sui generis protection for GIs and/or AOs report that they provide for a system of registration. The exceptions are France, where the national legislation does not regulate registration as such, but rather provides for an approval procedure in the form of recognition by public authorities; and Israel, where only AOs (and not GIs) can be registered.

EU Regulations provide for a registration system. However, some Members States (e.g. Denmark, Ireland, Italy, the Netherlands, Spain and the UK) report that registration is possible only by reason of EU rules, rather than a registration system under their national legislation.

Albeit with some differences the registration procedures tend to have a common scheme i.e.:

- application by an interested party, e.g. a consortium or association of producers; in some cases, individual producers or public bodies can also apply;
- the application usually identifies the applicant and its legal standing, the type of the product and its characteristics, the name of the product and its geographical meaning, the territory of origin of the product, the link between the product and the territory, the manufacturing process and the producers entitled to use the AO/GI;
- substantive examination of the application by a public body, in some cases the Trademark Office; in other cases, a dedicated office for GI/AO registration;
- publication of the application and possible opposition by third parties (see below);
- a final decision on registration.

A two-step registration procedure is provided by the EU Regulations: first, before a competent office of the Member State of origin; secondly, before the EU Commission.

About 75% of the reports note that opposition by third parties to registration is possible. In France, an opposition is only possible against a AOs, but not against IGPIAs. In Kazakhstan, oppositions are possible against AOs, but not against applications for AOs. In Hungary and Japan, the submission of observations, but not opposition, is allowed. The Bulgarian report does not mention opposition.

3) If your country does not protect GIs and/or AOs, was this a deliberate decision and, if so, why?

The Canadian Group comments that the lack of more robust protection for GIs in Canada may be due to its lack of “enduring traditions” for goods linked to specific geographical territories.

All other Groups note that, as they provide for protection of GIs and/or AOs, the question is not applicable.

4) What are the grounds of invalidity/loss of rights for GIs and/or AOs under your Group's law (e.g. becoming generic, lack of use, not paying fees) and where can such be invoked (which court, office, etc.)? Please specify the applicable test, how such is proven (e.g. consumer surveys, expert advice, dictionaries, etc.) and who bears the burden of proof.

Several reports (Canada, China, Denmark, New Zealand, Pakistan, Sweden, the United Kingdom, Taiwan) state that rights on GIs/AOs cannot be granted or are lost over time if they become generic. Other reports (Australia, France, Hungary, Ireland, Israel, Italy) state that becoming generic is not a ground for revocation of an already registered AO/GI.

Another frequent ground for revocation is non-use (in Argentina, Australia, China, Denmark, Ireland, Malaysia, Pakistan, Sweden, the United Kingdom), while the French and Mexican reports note that use is not required in order to maintain rights in relation to GIs/AOs.

Another frequently mentioned ground of invalidity/revocation is the original lack, or the loss over time, of the characteristic(s) of the goods at issue and of the conditions necessary for registration as GIs or AOs (Argentina, Bulgaria, Canada, Hungary, Israel, Malaysia, Mexico, the Republic of Korea, Sweden, Vietnam, Iran, Kazakhstan and the Slovak Republic).

Some reports mentioned that rights are also lost when GIs/AOs are or become misleading for consumers (Denmark, Ireland, the Republic of Korea, Sweden, the UK, Taiwan and Kazakhstan); are in conflict with earlier GIs or trademarks (Bulgaria, Canada, Hungary, the Republic of Korea, Taiwan and Kazakhstan) or with names of plant varieties and animal breeds (Bulgaria and Hungary); or are contrary to public order or morality (Malaysia and Iran).

Payment of fees is necessary according to the reports from China and Pakistan, while it is not in Mexico.

Specifically for foreign GIs, a cause of loss of rights is the lack or loss of protection in the country of origin (China, Israel, Malaysia, Kazakhstan).

Several reports from EU Members States note that GIs and AOs registered at the EU level can be cancelled by the EU Commission when they have not been used for at least seven years or when the compliance with the conditions of the specification is not ensured.

Several reports note that evidence regarding the grounds of invalidity or revocation can be given by any means. Some reports specifically mention evidence through market surveys.

The burden of proof usually lies with the party seeking invalidation or revocation, unless the ground is non-use, for which it is the party having rights that has to prove use. Only the Iranian report mentions that the burden of proof is with the defendant.

Cancellation or revocation actions can be brought before the competent administrative office (Australia, Bulgaria, China, Denmark, Hungary, Ireland, Japan,

Malaysia, the Republic of Korea, Sweden and Taiwan) and/or before Courts (Canada, Denmark, Ireland, Sweden). In some cases, the decision of the administrative offices may be reviewed, upon an appeal, by Courts (this is mentioned in the reports from China, Mexico and the Republic of Korea).

5) What is the scope of protection of GIs/AOs under your Group's current law?

Some Groups report that their sui generis or specific legislation on GIs and/or AOs only covers some kinds of products (e.g. wine, wine based spirits, agricultural and food products in Argentina; wine and spirits in Canada).

Several reports by EU Member States note that at present EU Regulations only provide protection for GIs/AOs of agricultural products and food, wines, spirits and aromatised wine products.

As for the scope of the protection, the reports describe different approaches on whether protection should be afforded only against conduct misleading the public or, more broadly, also against parasitism or free riding, without public confusion. For more detail, see Question 6 below.

6) Against what kind of conduct are GIs/AOs protected? For example, against use misleading consumers, parasitism and free riding.

Several Groups report that GIs and/or AOs are protected both against uses that mislead or deceive consumers and against free riding or parasitism exploiting the reputation of GIs/AOs (Argentina, Brazil, Bulgaria, Denmark, France, Hungary, Ireland, Italy, the Netherlands, Spain, Sweden, Taiwan and the Slovak Republic).

Some reports specify that use of protected GIs/AOs is not permitted for goods not originating from the relevant territory (Argentina and Canada, for GIs for wines and spirits). Some Groups further state that this kind of use is not permitted, even if the true origin of the product is indicated, or if the GIs/AOs are accompanied by expression like "type", "style", "kind", "imitation" or similar (Hungary, Israel for GIs and AOs of wines, Malaysia for wines).

Other reports only mention uses likely to mislead or deceive (New Zealand, where however misrepresentation according to the tort of passing off is also prohibited; the USA; Iran). Similarly, in Australia, protection is generally only provided against misleading or deceptive use, although a broader protection against any use of false descriptions or presentations is afforded for wines and under the Competition and Consumer Act.

The reports from Brazil, Japan, Malaysia and Iran specify that use of a GI/AO is also not allowed when it amounts to an act of unfair competition.

The French report states that use of a designation of origin or a IGPIA protected in France is generally forbidden in any case of appropriation (in addition to false, fallacious or misleading use). The UK report states that collective and certification marks are protected in the UK against passing off and that an essential element of it is a misrepresentation. The Japanese report states that there is a violation of a right in relation to a GI when a member of a registered group of producers affixes a GI to a product that does not meet the required standard and puts it on the market, or when a producer or processor who is not a member of a registered group of producers affixes a GI to a product and puts it on the market.

The Mexican report notes that it is forbidden to use exactly the same GI and/or AO for the products which the GI and/or AO concern, without having the authorization or licence to do so. The report from the Republic of Korea states that a registered collective or certification mark with a GI is protected against use of an identical or confusingly similar trademark for goods that fall within the scope of what is identical to the designated goods of the registered GI. Further, under the Korean Agricultural and Marine Products Quality Control Act, it is prohibited to use a GI identical or confusingly similar to a registered GI on identical or similar goods, packaging or containers or in promotional materials and related documents.

7) Who has legal standing to protect a GI/AO. For example, individual producers, consortiums and associations, public bodies.

About 75% of the Groups report that legal standing is available to individual producers (in Argentina, Australia, Brazil, Bulgaria, Canada, Hungary, Israel, Italy, Malaysia, Mexico, the Netherlands, New Zealand, the USA, Iran and Kazakhstan), to groups, associations, organizations or consortia of producers (in Argentina, Australia, Brazil, China, France, Hungary, Ireland, Israel, Italy, Japan, Malaysia, Mexico, the Netherlands, New Zealand, Pakistan, the Republic of Korea, Iran and Kazakhstan) and even to the chambers of commerce (in Japan). In some countries (in Italy, Malaysia, Mexico, the Netherlands, New Zealand, Spain, Vietnam, Taiwan and Kazakhstan), public bodies, administrative authorities, competent Ministries or the State may also take action to protect GIs/AOs.

8) What remedies are available in the case of violation of rights in a GI/AO?

The vast majority (about 85%) of reports state that, in the case of a violation of the rights on a GI/AO, an injunction may be available and the infringer may be ordered to pay damages.

Other frequently mentioned remedies are:

- recovery of profits;
- seizure, recall and/or destruction of the infringing goods and of any related material, or removal of the infringing signs from them;
- transfer of the goods to the holder of the AO/GI;
- penalties;
- publication of the ruling or order to the infringer to advertise or disseminate information about the findings of the ruling.

Some reports state that, in order to better protect the rights on GIs/AOs, urgent interim measures may also be available.

In some jurisdictions, administrative and/or criminal sanctions may also be issued in the case of violation of a right in relation to a GI/AO.

9) How does your Group's law regulate the conflict between a GI/AO and a prior trademark? Does the GI/AO or the trademark prevail or do they coexist? Under what conditions?

The reports describe different solutions. In some countries (Argentina, Canada, Israel,

New Zealand, Pakistan), earlier trademarks, on which rights were acquired in good faith, prevail over later GIs/AOs.

Other reports note that registration of a later GI/AO is not barred by an earlier trademark, and that the GI/AO and the earlier trademark can coexist (Australia, for wines; Hungary; Iran; Ireland; Italy; Malaysia; the Netherlands; Spain; Sweden; Vietnam).

However, several reports note that the earlier trademark will prevail, such that no coexistence is permitted and the GI/AO cannot be registered if, taking into account the reputation, renown and length of use of the trademark, the registration of the GI/AO could mislead consumers as to the true origin of the product (see the reports from Bulgaria, Hungary, Ireland, Italy, the Netherlands, Spain, Sweden, the UK, Vietnam). In the Slovak Republic, the later GI cannot be registered if it can cause confusion with an earlier trademark. Some reports (France, Ireland, Italy, the Netherlands, Spain, Sweden, UK) also make reference to the EU Regulations where, similarly, GIs/AOs and earlier trademarks can coexist, unless the registration of the GI/AO may mislead consumers.

The French report states that in France a designation of origin always prevails over trademarks, including earlier trademarks, as a matter of public order. However, complex trademarks, composed of a designation of origin and one or more other distinctive elements, may be registered. IGPIAs and earlier trademarks can coexist unless, to consumers, the trademark is the exclusive source of the reputation or knowledge in relation to the product. In this case, an IGPIA cannot be granted.

In the case of GIs registered as collective or certification marks, some reports (China, Denmark, the Republic of Korea, the USA, Taiwan) refer to the rules of conflict of trademark law, where earlier trademarks take precedence.

10) Is there any specific provision or practice concerning the inclusion of a GI/AO in a domain name?

A few reports mention the existence of a provision or practice regarding the inclusion of a GI/AO in a domain name.

In Italy, the Domain Name Disputes Resolution Administrative Proceeding of the administrative entity resolving disputes in the matter of “.it” domain names provides that GIs/AOs are to be protected not only against any commercial use of a denomination for products that do not show the features indicated in the relevant protocols of production, but also against any use of the GI/AO which illicitly exploits the reputation thereof.

In Mexico, the guidelines regarding the resolution of domain name disputes for “.mx” domain names state that cancellation or transfer of ownership of a particular “.mx” domain name may be requested when the conflicting domain name is identical or confusingly similar to an appellation of origin over which the interested party has rights. The Mexican Institute of Industrial Property is the only competent authority with the legitimacy to claim exclusive rights over a specific domain name including an AO, registered or used in bad faith.

In Spain, article 13(4) of Law 6/2015 includes the prohibition on use of a registered GI/AO as a domain name by anyone without right to do so.

In Sweden, the Internet Foundation (IIS), which is responsible for the internet top level domains “.se” and “.nu” states in its terms and conditions of registration that a domain name may be deregistered or transferred to the party requesting dispute resolution proceedings if (i) the domain name is identical or similar to GIs/AOs covered by certain EU Regulations which are legally binding in Sweden and to which the party requesting dispute resolution can prove its rights, (ii) the domain name has been registered or used in bad faith, and (iii) the domain holder has no right to or justify interest in the domain name.

The report from Vietnam also makes reference to specific provisions on the issue.

The Dutch report comments on a WIPO Administrative Panel Decision, whereby the protection of GIs/AOS is excluded from the scope of the Uniform Domain Name Dispute Resolution Policy (UDRP).

The French report specifies that inclusion of GIs/AOs in a domain name may constitute misuse/infringement. Similarly, the Italian report states that, according to the Italian Code of Industrial Property, domain names are unregistered distinctive signs. Accordingly, in the case of inclusion of a GI/AO in a domain name, the same rules that regulate the inclusion of a GI/AO in a trademark should apply.

The reports from Australia and Canada state that the policies for domain name dispute resolutions may also be applied to certification marks where such marks are included in a domain name.

11) Is there any body that administers GIs/AOs in your country and/or is responsible for the verification of compliance of goods bearing a GI/AO? Please briefly describe the relevant processes, e.g. the process by which compliance with product specifications is verified before such goods are put on the market and/or the subsequent market controls on such goods.

About 65% of the Groups report that public authorities (State, Ministries, Government and administrative authorities) are tasked with administering GIs/AOs and verifying the compliance of goods bearing them.

Some reports specify that such controls may consist of checks and tests on the products, inspections at the premises of the producers during the various stages of the manufacturing process, collecting samples, chemical analysis, examination of books and documents or requests for information. Consortiums and associations of producers are responsible to verify compliance of the products with the required standards. In case of products not complying with the standards, the competent authorities may issue sanctions, including corrective orders, orders to cease use of the GIs/AOs or even revocation of the GIs/AOs.

In other jurisdictions, no controls by public authorities are provided. This is reported for Brazil, where the GI owner is solely responsible for verifying compliance of goods bearing the GI/AO and the quality control; Canada, where after registration there are no further government controls; New Zealand, where the Intellectual Property Office administers the registration process, but there is no specific administrator responsible for ensuring the verification of compliance of goods bearing a GI; Pakistan, where there are no bodies tasked with administering GIs; the USA, where there is no separate body administering GIs/AOs and only individual membership or certifying organizations supervise their members' use; Kazakhstan, which answered “No” to this

question.

In Israel, controls by public authorities are provided for the only local registered AO (“Jaffa”), but not for goods bearing other GIs/AOs, even if some controls can be achieved by way of application of the Consumers Protection Law. In Japan, after registration, the producers’ group has to verify the compliance of products bearing the GI and then report to the competent Ministry.

- 12) Please describe any other developments in your country in relation to GIs or AOs which you consider relevant, including any proposals for reform. For example, to the extent that your country has been involved in any negotiations or discussions regarding the protection of GIs and AOs in any fora, such as multilateral, regional or bilateral agreements, please specify whether your country is negotiating or has signed any agreement with other countries that includes provisions on GIs/AOs and whether it was necessary to amend domestic legislation as a result of such agreements.**

Recent amendments or proposed amendments in national laws are reported by Argentina, Australia, Israel, Mexico, Pakistan, Spain, Sweden and Vietnam.

At the international level, the Australian report mentions the Australia-United States Free Trade Agreement that came into effect on 1 January 2005 and the Agreement between Australia and the European Community on Trade in Wine signed in December 2008.

The Canadian and the Italian reports mention the Comprehensive Economic and Trade Agreement (CETA) between Canada and the European Union. The Canadian Group reports that, in order to implement the CETA, Canadian law on GIs will require several changes, including in particular the extension of protection of GIs not only to wine and spirits, but in general to agricultural foods and products.

The Chinese report mentions the 2006 Memorandum of understanding on geographical indications signed by the Chinese General Administration of Quality Supervision, Inspection and Quarantine and the EU Trade Commission.

The Dutch report comments on developments at the EU level, in particular with regard to the envisaged extension of the EU protection of GIs to GIs of non-agricultural products. In this regard, the Swedish Group reports that the Swedish Government through the Ministry of Justice argued in 2014 against expansion of protection for GIs to non-agricultural products.

The UK report states that, as a consequence of Brexit, the UK is expected to take domestic steps to recognize existing EU GIs/AOs in the UK or to allow their conversion into national rights.

The Israeli Group states that Israel signed the final Geneva Act of the Lisbon Agreement but that this cannot be interpreted as a decision or a declaration by Israel that it intends to become party to the amended Lisbon Agreement or to implement same in the domestic legislation.

II. Proposals for improvements and for harmonisation

13) Should there be harmonised definitions of GIs and AOs? If so, please propose appropriate definitions and prerequisites.

About 70% of reports responded “Yes” to the question. However, the reports from the U.S. and Taiwan stated that there is no need for harmonized definitions, while the report from Vietnam states that they have no recommendation in this regard.

In relation to a possible definition, the reports from Australia, Canada, New Zealand and Pakistan only mention GIs and propose a definition in line with the TRIPS agreement.

The reports from Argentina, Hungary, Ireland, Malaysia and Mexico propose a definition for AOs in line with the Lisbon agreement, and a definition for GIs in line with the TRIPS agreement. The Italian report proposes a definition of AOs in line with the Lisbon Agreement and a definition of GIs slightly different to the TRIPS agreement, in that, GIs should be protected when “even only their reputation is exclusively or essentially due to the geographical environment of origin”. The Mexican report notes that cases of geographical origin consisting of a trans-border geographical area should be taken into consideration.

The reports from Denmark, the Netherlands, Spain and Sweden propose to adopt the definitions contained, both for GIs and AOs, in the current EU Regulations.

The French report proposes to adopt the definition of AOs in the Lisbon Agreement, and the definition of GIs in the Geneva Act of the Lisbon Agreement.

The UK report proposes to adopt the definition in the Geneva Act of the Lisbon Agreement for both GIs and AOs.

The Brazilian report proposes for AOs a definition which is in line with the Lisbon Agreement and states that GIs do not require such a strong link with or dependence on the environment. It further states that Brazilian law defines an indication of source as the geographical name of a country, city, region or locality that has become known as a centre of extraction, production or manufacture of a given product or a given service.

The report from the Israeli Group states that the definition of a GI is wider than the definition of an AO and encompasses the definition of an AO, so a single GI definition may be used instead of the dual definitions. Similarly, the report from Iran notes that AOs are considered a sub category of GIs.

The Japanese report states that a definition should contain the following prerequisites: i) names to be protected are the names of specific agricultural, forestry and fishery products; ii) each of such products is made in a specific place, region or country; iii) the quality, reputation or other established characteristics of the product are essentially attributable to its place of production; and iv) the product has actually been made in the region for at least a predetermined number of years.

14) Should there be a registration procedure for GIs and AOs? If so, what should its key features be? For example, content of the application; examination by competent bodies; possibility of opposition by third parties.

About 75% of reports responded “Yes” to the question on whether there should be a registration procedure for GIs and AOs. Only the US report responded “No”. The reports from Ireland and the Republic of Korea state that the registration procedure through the system of collective marks is enough.

Several reports (Argentina, Australia, Brazil, Canada, Denmark, France, Hungary, Israel, Japan, Pakistan, Malaysia, Mexico, New Zealand, Taiwan, Iran) detail the steps of the registration procedure for GIs or AOs or, at least, give some indications in this regard. Further reports (Italy, the Netherlands, Spain, Sweden, the UK) state that the registration procedure of the EU Regulations can be taken as a model.

In the reports that provide details of what the key features of a registration procedure should be, the following elements are frequently mentioned.

- Detailed application requesting protection for a GI/AO. The application should at least contain an identification of the type of product protected, the name of the product, the geographical area of origin, a demonstration of the link between the product and the area, a description of the manufacturing process, regulations on the use of the GI/AO, the producers allowed to use the GI/AO and possibly also controls on the use of them. According to some reports, the application could be submitted by groups, associations of producers or legal entities representing them, or by individual producers.
- Substantive examination of the application by an independent public authority.
- Publication of the application.
- Possibility for third parties to oppose the registration.
- Final decision on registration.

The Hungarian report states that no opposition should be allowed, but only the filing of observations. The French report notes that the GI/AO should receive a registration or provisional grant before being open to opposition.

15) What should the grounds of invalidity/loss of rights for GIs and/or AOs be? For example, becoming generic, lack of use, not paying fees. Please specify what the applicable test should be, how such should be proven and who should bear the burden of proof.

The reports submitted mention several grounds of invalidity/loss of rights for GIs and AOs. The following grounds are mentioned.

- Becoming generic: Brazil, Canada (which refers to the fact that the sign is a customary term), Denmark, Hungary, Ireland, Israel, Mexico (but only GIs not AOs), New Zealand, Pakistan, the USA, Taiwan, Iran. The Italian Group states that a GI or AO should be protected until it is still perceived by the relevant public as linked to the geographical environment of origin.
- Non-use: Denmark, Ireland, Israel, Japan, Malaysia, the Netherlands (if non-use lasts more than seven years), New Zealand, Pakistan (if non-use lasts five

years), Taiwan, Iran.

- The fact that the term cannot qualify as a GI, that the conditions for protection do not exist, or that the conditions change in the course of time and the grounds to protect GIs/AOs no longer exist: Australia, Canada, Japan, Malaysia, Mexico, the Netherlands, Vietnam.
- Public deception: Ireland, Israel, the USA.
- Non-payment of fees: Japan, Pakistan, Taiwan.
- Breach of the conditions of use of the GIs/AOs: Hungary, the Republic of Korea.
- The fact that the AO/GI is not or is no longer protected in the country of origin: Canada, Malaysia, the Republic of Korea.
- Conflict with prior rights: Canada, Hungary.
- Fraud: Pakistan.
- Being contrary the public order and morality: Malaysia.

According to the French report, a GI/AO should only be revoked when the collective producers' organization responsible for monitoring the application of the specification and upholding the GI/AO is no longer performing its role.

Some reports state that rights on GIs/AOs should not be lost due to lack of use (France, Mexico, Spain), non-payment of fees (France, Mexico, Spain) or becoming generic (France).

The position in the reports from Denmark, the Netherlands, Pakistan and Taiwan is that, in cases of invalidation or revocation of a GI/AO, the burden of proof should lie with the claimant, i.e. the party seeking such invalidation or revocation.

Possible evidence of the invalidation or revocation grounds could consist of market surveys, expert reports, witness statement and dictionaries.

16) How should conflicts between GIs/AOs and prior trademark rights be regulated?

Several reports state that conflicts between GIs/AOs and a prior trademark should be resolved applying the principle of "first in time, first in right": Ireland, Israel, Italy (which, however, specifies that this rule should apply provided that any practice which is liable to mislead the public or misappropriate any reputation of a protected GI or trademark should be forbidden), Mexico, Pakistan, the USA. Following this principle, the reports from Australia, Canada and Pakistan specify that prior trademarks prevail over later GIs/AOs.

Several other reports state that a prior trademark, the rights to which were acquired in good faith, must coexist with later GIs/AOs: Denmark, Hungary, Malaysia, the Netherlands, Spain, the UK, Iran. The reports of four EU Member States (Hungary, the Netherlands, Spain, UK) specify that, similar to the EU Regulations, no coexistence should be possible and the prior trademark should bar the registration of the later AO/GI when, due to the reputation, renown and length of use of the

trademark, the public could be misled as to the true origin of the products.

The report from New Zealand states that the prior existing right should be respected but that, in some instances, the registration of both the prior trademark and the GI/AO may be justifiable, provided that consumers are not misled.

According to the report from Vietnam, if the prior trademark is well-known the later GI may be rejected. Otherwise, if the prior trademark is not well-known, the trademark and the GI should coexist.

The report from Taiwan states that trademarks and GIs/AOs should not coexist, as this would cause confusion and mislead consumers, and mentions the possibility of revoking the trademark registration.

17) What scope of protection should GIs/AOs have and should it matter if these are domestic or foreign? Against which conduct by third parties should they be protected?

About half of the reports state that both domestic and foreign GIs/AOs must be protected: Argentina, Brazil, Canada, China, Italy, Malaysia, Mexico, New Zealand, Pakistan, the Republic of Korea, Sweden, the UK, Vietnam, Taiwan. The Chinese report states that protection should be determined according to the principle of reciprocity. The Italian Group states that, in order to be protected, GIs/AOs must be perceived as such by the relevant public also in the country where the protection is sought. The report from Vietnam states that protection of foreign GIs requires that such GIs are protected in their country or region of origin.

The Danish Group, with regards to marks, states that the scope of protection should be limited to domestic marks, registered or brought to market in the jurisdiction. The Japanese report states that after registration, domestic and foreign GIs/AOs should be treated in the same manner, but prior to registration, it is necessary to judge whether or not to give them the same level of protection.

In relation to conduct by third parties against which GIs/AOs should be protected, several reports state that this is the case when use is made of the GI/AO which is misleading or deceitful for the consumer as to the origin or the characteristics of the product (Argentina, Australia, Denmark, Hungary, Israel, Italy, Malaysia, the Netherlands, the Republic of Korea, Spain). The U.S. Group states that the scope of protection of a GI/AO should be limited to what is necessary to protect its function as an accurate indication to consumers of services or qualities.

Further, several Groups consider that any conduct which harms or unduly exploits or takes advantage of the reputation of the protected GIs/AOs must be forbidden: see the reports from Hungary, Italy, Mexico, the Netherlands and Spain (the last two making reference to the rules of EU Regulations). The Danish Group is of the opinion that any misuse of the GI/AO should not be permitted. The Israeli report states that any abusive use is a violation. According to the French Group, GIs/AOs should be protected against any reproduction or imitation, regardless of whether the public is misled.

Other illicit conduct mentioned in the reports are any false indication or representation (Australia, for wines, Denmark, Malaysia, the Republic of Korea) or the fact that the GI/AO is used by a non-entitled party, e.g. a person who does not meet the requirements for use or does not conform to the relevant standards (Argentina,

Malaysia).

Some Groups are of the opinion that the scope of protection of GIs and AOs could be determined by referring to and applying the trademark law: see the reports from China, Ireland, the UK and Taiwan.

18) Who should have legal standing to protect a GI/AO and which remedies are appropriate?

The reports mainly identify the following categories of person or bodies who should have legal standing to protect GIs/AOs.

- Individual producers, manufacturers or, in general, any natural or legal person authorized to use the GI/AO (Australia, Hungary, Italy, Malaysia, Mexico, the USA, Iran). The Pakistani report states that any member of the association that owns the GI should have such legal standing.
- Groups, consortiums, organizations, associations and/or managing entities administering GIs/AOs and representing the interest of the producers (Australia, Brazil, France, Hungary, Italy, Japan, Malaysia, Mexico, Spain, Sweden, Vietnam, Iran).
- Public authorities, either at the governmental or local levels (Canada, Ireland, Italy, Malaysia, Mexico, the Netherlands, Spain, Vietnam, Iran).
- The person or body that can be identified as the owner or the right holder of the GI/AO (Israel, the Netherlands, the USA, Kazakhstan).

According to the reports from the Canadian and New Zealand Groups, more generally, any interested person should have legal standing to act. The Hungarian report states that such legal standing should also be available to consumer protection organizations. Where the GI/AO is protected through trademark registration, it is the trademark owner who has legal standing to protect it: see the reports from China and the UK, the latter specifying that also authorized users may take action.

In relation to remedies, some reports indicate injunctions and damages as appropriate remedies (Australia, Canada, Denmark, Japan, Malaysia). Other remedies could include recovery of profits (Australia and Canada), punitive damages (Canada), penalties (Denmark) and destruction or disposal of the infringing goods and related material (Canada). Other Groups suggest using the general remedies of trademark law (Italy) or intellectual property rights (the UK), or the general remedies available in civil/criminal/administrative proceedings (the Republic of Korea).

19) Should there be a specific provision or practice concerning the inclusion of a GI/AO in a domain name?

The reports on this question show contrasting positions among the Groups.

Several Groups are in favour of a specific provision or practice concerning the inclusion of a GI/AO in a domain name. In particular, this specific provision could state that only the right holder can request the registration of a domain name containing a protected GI/AO and, further, in case of registration of such domain name by third parties, the domain name registration can be cancelled or transferred. The Groups that are in favour of adoption of specific provisions are Argentina,

Australia (provided that the use of the domain name is misleading for the public), Brazil, Canada, France, Japan, Mexico, Pakistan, Spain, Sweden, Vietnam, Taiwan and Iran.

Other Groups are against the adoption of specific provisions: Denmark, Hungary, Ireland, Israel, Malaysia, the Netherlands, the Republic of Korea, the UK, the U.S. and Kazakhstan. The main reason is that existing laws and practice are considered sufficient to cover and protect GIs/AOs, without the need for other provisions. Two Groups (Israel and Malaysia) further state that it would not be desirable to adopt such specific provisions before a uniformity is achieved in the definition and the scope of protection of GIs/AOs.

The Italian Group is of the opinion that the rules applicable to trademark protection should extend to GIs/AOs.

The report from New Zealand states that the adoption of a specific provision may be justified if the issue creates confusion among consumers.

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