



STANDING COMMITTEE ON GEOGRAPHICAL INDICATIONS QUESTIONNAIRE TO NATIONAL GROUPS

Introduction

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

2) 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 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 and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors". A similar definition is adopted by the WIPO Geneva Act.

3) Therefore, the rationale for protection of AOs and GIs is to protect signs identifying the geographical origin of goods whose characteristics and/or reputation are linked to such origin.

4) At a worldwide level, many contrasts and divergences have emerged with regard to protection of AOs and GIs. Some countries have enacted specific legislation on AOs / GIs supporting broad protection (particularly in relation to their local typical products). Other countries, who do not tend to favour strong protection of AOs / GIs regulate them, if at all, within the framework of trademark legislation.

5) It is intended that the information obtained by means of this questionnaire will:

- enable AIPPI to further develop its position on issues relating to GIs and AOs, leading to a further Resolution aimed at harmonisation of national laws relating to GIs and AOs; and
- thereby assist in the advocacy of AIPPI's position on such issues to national and regional governments and in international forums.

Previous work of AIPPI

6) AIPPI's most recent study of issues relating to GIs and AOs was Q191 – "Relationship

between trademarks and geographical indications". A Resolution on Q191 was adopted in Gothenburg, Sweden in 2006 (**Gothenburg Resolution**). The Gothenburg Resolution is available at:

<http://aippi.org/wp-content/uploads/committees/191/RS191English.pdf>.

Further information on AOs and GIs, their legal regulation and the debate surrounding them can be found in the Study Guidelines for Q191 available at:

<http://aippi.org/wp-content/uploads/committees/191/WG191English.pdf>

- 7) Other work of AIPPI prior to the Gothenburg Resolution is summarised in the Study Guidelines for Q191,
<http://aippi.org/wp-content/uploads/committees/191/WG191English.pdf>

Discussion

- 8) Set out below is a brief discussion on international legal frameworks for the protection of GIs and AOs, including developments that have taken place since the Gothenburg Resolution.
- 9) At an international level, the two multilateral treaties committing signatory States to protect GIs which have gained the broadest adherence worldwide are the Paris Convention within the WIPO system and the TRIPs Agreement within the WTO system.
- 10) Article 1(2) of the Paris Convention states that the subject-matter of protection of industrial property is (among other things) "indications of source or appellations of origin". Article 10 of the Convention states that seizures and other remedies "shall apply in cases of direct or indirect use of a false indication of the source of the goods or the identity of the producer, manufacturer, or merchant".
- 11) Article 22 of TRIPs requires the protection of "geographical indications". GIs are recognised by Article 1(2) of TRIPs as a category of intellectual property. Under the TRIPs Agreement, GIs are protected against uses misleading the public or constituting an act of unfair competition. Additional and stronger protection is only provided for GIs of wines and spirits. Discussions commenced under the Doha mandate on the question of increasing the level of protection of GIs under the TRIPs Agreement appear to have come to a deadlock.
- 12) Within the WIPO system further agreements concerning AOs and GIs have been adopted, generally providing for a high level of protection:
 - a) the Lisbon Agreement of 1958 protects "appellations of origin" against any form of usurpation or imitation, whether or not this usurpation or imitation is misleading for the public. The Lisbon Agreement provides for the establishment of a system for the deposit of "appellations of origin" with the International Bureau operated by WIPO. Under the Lisbon Agreement, each signatory state is required to protect the appellations of origin registered by another state. A provision is inserted protecting AOs against becoming generic. The list of contracting parties to the

Lisbon Agreement can be found at

http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=10

- b) the Geneva Act of the Lisbon Agreement, adopted in 2015, protects both appellations of origin and geographical indications. Protection is given against various types of use, including uses liable to mislead consumers and/or "impair or dilute in an unfair manner, or take unfair advantage of" the reputation of a AO/GI. Further provisions of the Geneva Act protect AOs/GIs against becoming generic and regulate the relationship between AOs/GIs and trademarks. The list of countries that have signed the Geneva Act can be found at http://www.wipo.int/treaties/en/ActResults.jsp?act_id=50.
- 13) Within the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, there are discussions about the proposal by some delegations concerning the protection of GIs in the domain name system. This is particularly with regard to possible modification of the WIPO UDRP in order to "permit complaints to be made concerning registration and use of domain names in violation of the protection of geographical indications".
- 14) Due to the above divergences, the WIPO Agreements have received limited support among WIPO Member States. Only a relatively small number of States have signed them. This debate emerged in particular during the negotiations leading to the adoption of the WIPO Geneva Act. Negotiations were characterized by a clash between countries pushing for a very high level of protection and other countries refuting the content of the Act and even the legitimacy of the negotiations.
- 15) In addition to the protection for GIs and AOs afforded by the international treaties described above, a high level of protection for GIs and AOs relating to agricultural products and foodstuffs is granted in the European Union under EU Regulation 1151/2012 and other regulations pertaining to specific products. EU Regulation 1151/2012 protects "designations of origin" and "geographical indications" against acts which are of a nature to mislead the public and/or to unduly exploit or freeride on the reputation of the GI/AO. The Regulation contains provisions protecting GIs and AOs against becoming generic and in general against a possible loss of rights, as well as regulating relationships between GIs/AOs and trademarks. The EU system is based on registration and EU case law restricts protection of GIs/AOs which are not registered at EU level.

The European Commission is currently investigating the possibility of expanding the protection of GIs and AOs to non-agricultural products.

- 16) Differences and disagreements which have emerged within the international framework regard several key points of legislation on GIs and AOs, such as the way of acquiring rights, the prerequisites for protection, the scope of protection, maintaining protection in the face of supervening circumstances and relationships with other IP rights. The questions below are intended to touch upon these issues.

Name of your National/Regional Group

National Group Australia

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Questions

Your Group is invited to submit a Report addressing the questions below. If your Group considers that the answer to a question has already been given in its report on Question Q191, and that nothing has changed since then, a cross-reference to the specific paragraph in your Group's report on Q191 is sufficient.

In each case please specify whether your answer differs:

(a) as between GIs and AOs; and

No

(b) depending on whether the GI or AO is foreign or domestic.

No (unless specified)

I. Analysis of current legislation and case law

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

Yes

2) If yes, please briefly describe the following:

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

The *Australian Grape and Wine Authority Act 2013* (“**AGWA Act**”) defines a Geographical Indication (“GI”) in relation to wine goods, as “*an indication that identifies the goods as originating in a country, or in a region or locality in that country, where a given quality, reputation or other characteristic of the goods is essentially attributable to their geographical origin*”.¹

¹ *Australian Grape and Wine Authority Act 2013* (Cth) s 4.

The *Trade Marks Act 1995* defines a GI in relation to goods as “a sign that identifies the goods as originating in a country, or in a region or locality in that country, where a given quality, reputation or other characteristic of the goods is essentially attributable to their geographical origin.”²

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.

Only the use of GIs for wines is regulated via sui generis laws in Australia under the AGWA Act; however, GIs covering goods and services other than wine are also protected more generally under the *Trade Marks Act 1995* and through consumer protection laws.

1. Australian Grape and Wine Authority Act 2013

The AGWA Act established the Australian Grape and Wine Authority (“AGWA”), which is the body responsible for research, development and extension of the wine industry in Australia, including protecting the reputation of Australian wine.³

The AGWA Act also established a Geographical Indications Committee (“GIC”) with its primary role being to consider applications for the registration and omission of new Australian and foreign GIs.⁴ In accordance with the Australian Grape and Wine Authority Regulations, the GIC considers the following when determining whether to grant a GI:

- (a) *whether the area falls within the definition of a subregion, a region, a zone or any other area;*
- (b) *the history of the founding and development of the area, ascertained from local government records, newspaper archives, books, maps or other relevant material;*
- (c) *the existence in relation to the area of natural features, including rivers, contour lines and other topographical features;*
- (d) *the existence in relation to the area of constructed features, including roads, railways, towns and buildings;*
- (e) *the boundary of the area suggested in the application to the Committee under section 40R;*
- (f) *ordinance survey map grid references in relation to the area;*
- (g) *local government boundary maps in relation to the area;*
- (h) *the existence in relation to the area of a word or expression to indicate that area, including:*
 - (i) *any history relating to the word or expression; and*
 - (ii) *whether, and to what extent, the word or expression is known to wine retailers beyond the boundaries of the area; and*
 - (iii) *whether, and to what extent, the word or expression has been traditionally used*

² *Trade Marks Act 1995* (Cth) s 6.

³ *Australian Grape and Wine Authority Act 2013* (Cth) s 7.

⁴ *Ibid* s 40N and 40P.

in the area or elsewhere; and

(iv) the appropriateness of the word or expression;

(i) the degree of discreteness and homogeneity of the proposed geographical indication in respect of the following attributes:

(i) the geological formation of the area;

(ii) the degree to which the climate of the area is uniform, having regard to the temperature, atmospheric pressure, humidity, rainfall, number of hours of sunshine and any other weather conditions experienced in the area throughout the year;

(iii) whether the date on which harvesting a particular variety of wine grapes is expected to begin in the area is the same as the date on which harvesting grapes of the same variety is expected to begin in neighbouring areas;

(iv) whether part or all of the area is within a natural drainage basin;

(v) the availability of water from an irrigation scheme;

(vi) the elevation of the area;

(vii) any plans for the development of the area proposed by Commonwealth, State or municipal authorities;

(viii) any relevant traditional divisions within the area;

(ix) the history of grape and wine production in the area⁵.

2. Trade Marks Act 1995

The certification trade mark provisions are the principle way to protect a GI for goods and services other than wine in Australia, although wine GIs can also be protected as certification trade marks. GIs must meet the requirements of the Act relating to certification trade marks.

A certification trade mark is defined as a mark that is used or intended to be used to distinguish goods or services by a person approved by the owner of the trade mark (an approved certifier), from uncertified goods or services.⁶ A certification trade mark guarantees the quality, accuracy or some other characteristic of the goods or services including (in the case of goods) their origin, the material from which they are made, and their mode of manufacture.

An application for a certification mark must be accompanied by rules which govern the use of the trade mark. Rules governing the use of a certification trade mark must specify:

- the certification requirements that goods and/or services must meet for the certification trade mark to be applied to them; and
- the process for determining whether goods and/or services meet the certification requirements; and
- the attributes that a person must have to become an approved certifier, that is, a person approved to assess whether goods and/or services meet the certification requirements; and

⁵ *Australian Grape and Wine Authority Regulations 1981* Reg 25.

⁶ *Trade Marks Act 1995* (Cth) s 169.

- the requirements that the owner of the certification trade mark, or an approved user, must meet to use the certification trade mark in relation to goods and/or services; and
- other requirements about the use of the certification trade mark by the owner or an approved user; and
- the procedure for resolving a dispute about whether goods and/or services meet the certification requirements; and
- the procedure for resolving a dispute about any other issue relating to the certification trade mark.⁷

These rules are assessed and approved by the Australian Competition and Consumer Commission (“**ACCC**”) before the trade mark can be accepted for registration. The ACCC must also be satisfied that the rules would not be detrimental to the public, or raise any concerns relating to competition, unconscionable conduct, unfair practices, product safety and/or product information.

When deciding whether a trade mark is capable of distinguishing the goods or services certified by the Applicant, or an approved certifier, from goods or services which are not certified, the following must be taken into account:

- the extent to which the certification trade mark is inherently adapted to distinguish the certified goods and/or services; or
- the extent to which the certification trade mark has become adapted to distinguish the certified goods and/or services because of use or any other circumstances.⁸

As GIs by their very nature are often descriptive, they are generally not considered to be inherently distinctive and are therefore commonly subject to objection during examination. In that case, evidence of acquired distinctiveness is usually required to satisfy the Registrar that the certification trade mark has become adapted to distinguish the claimed goods or services.

3. Consumer Laws

Australian Consumer Laws makes it unlawful for a person to:

- Engage in conduct that is misleading or deceptive or likely to mislead or deceive;⁹ or
- Make false or misleading representations.¹⁰

A person engages in misleading and deceptive conduct if, for example, the person makes a statement in trade or commerce that is misleading or deceiving or likely to mislead or

⁷ Ibid s 173.

⁸ Ibid s 41.

⁹ *Competition And Consumer Act 2010 - Schedule 2 (Cth)* s 18.

¹⁰ Ibid s 29.

deceive.¹¹ Therefore, making a claim that a good has a certain origin when it does not is likely to be considered misleading or deceptive conduct and therefore fall foul of the Australian Consumer Law.

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.

1. Australian Grape and Wine Authority Act 2013

The AGWA Act provides for a system of registration via the the Register of Protected Geographical Indications and Other Terms (“**the Register**”).¹² The Register contains a list of geographical indications and traditional wine terms that are protected under Australian law.

The Register is divided into the following four parts:

Part 1 - Australian geographical indications and foreign country geographical indications (and translations)

Part 2 - Traditional expressions relating to wines originating in a foreign country and any conditions of use applicable to those expressions

Part 3 - Quality wine terms for wines originating in Australia and any conditions of use applicable to those terms (these are all traditional terms used for Australian fortified wine).

Part 4 - Additional terms and any conditions of use applicable to those terms (includes Icewine, Methode Champenoise, Moscato).¹³

Applications for a GI must be submitted to the GIC from an individual winemaker or wine grape grower, or an association or declared organisation representing growers and/or winemakers.¹⁴ A fee of AU\$27,500 must be paid before an application is accepted.¹⁵

Before a GI is registered, a range of factors are taken into account, including the boundary of the GI and the conditions of use. For international GIs, the Committee identifies the boundary of the GI and conditions of use that are applicable after taking into account whether the GI is protected by the laws of the country where the GI is located.¹⁶

The application undergoes a publication period during which third parties can object to the inclusion of the GI on the Register.¹⁷ This includes third parties who own trade marks for or

¹¹ Ibid.

¹² *Australian Grape and Wine Authority Act 2013* (Cth) s 40ZC.

¹³ Ibid s 40ZD.

¹⁴ Ibid s 40R.

¹⁵ Wine Australia, *Geographical Indications Committee* (2016) Wine Australia <<https://www.wineaustralia.com/labelling/register-of-protected-gis-and-other-terms/geographical-indications-committee>>.

¹⁶ *Australian Grape and Wine Authority Regulations 1981* s 25.

¹⁷ *Australian Grape and Wine Authority Act 2013* (Cth) s 40RA.

including the GI. Objections can be made on the grounds of prior rights to the proposed GI (i.e. that the proposed GI will cause consumer confusion with the prior trade mark).¹⁸

The Registrar's decision can be appealed to the Federal Court.¹⁹

When assessing an application for a GI, the GIC must consider relevant criteria (outlined above in response to question 2(b)) and consult with any declared wine growers' or winemakers organisations.²⁰

The GIC then makes an interim determination which is published in the Commonwealth Government Notices Gazette and the prospective region's local newspaper.²¹ Comments are considered by the GIC prior to making a final determination.²²

Appeals against the final determination must be made to the Administrative Appeals Tribunal (AAT) within 28 days.²³ At the end of this process the GI is entered into the Register of Protected Geographical Indications and Other Terms.

2. Trade Marks Act 1995

As outlined above in response to Question 1(b), the application for a certification trade mark is much the same as for a regular trade mark application; however, the application must be accompanied by rules which govern the use of the trade mark and which are assessed by the ACCC.

When considering whether or not the rules are detrimental to the public, the ACCC considers the rules themselves and how effective they are in ensuring the specified standards are met. It also considers broadly the effect the certification scheme is likely to have on the community.

The Registrar must advertise the initial assessment of the rules in the *Australian Official Journal of Trade Marks* ("**Official Journal**") in accordance with the regulations.²⁴ The Applicant, or any other person, may respond in writing to the ACCC in relation to the initial assessment and may request that the ACCC hold a conference in relation to the initial assessment.²⁵ Such a response or request must be made within one month of the advertisement of the initial assessment in the Official Journal.²⁶

After holding a conference (if one is called) and considering any written submissions the ACCC will make a final assessment.²⁷ If the ACCC is satisfied then a certificate will be issued

¹⁸ Ibid s 40RB.

¹⁹ Ibid s 40RF.

²⁰ Ibid s 40S.

²¹ Ibid s 40V.

²² Ibid s 40W.

²³ Ibid s 40X (2)(a).

²⁴ *Trade Marks Regulations 1995* Reg 16.3.

²⁵ Ibid.

²⁶ Ibid.

²⁷ *Trade Marks Act 1995* (Cth) s 175.

to the Applicant with a copy sent to the Registrar.²⁸ Once the rules have been certified by the ACCC and the trade mark has been advertised as accepted in the Official Journal the rules are published as certified on the IP Australia website.²⁹

Once the application is advertised as accepted in the Official Journal, then the application is subject to opposition by third parties for a two month period.³⁰ The application can be opposed on the same grounds as a regular trade mark application, with the exception of Section 41 which is instead replaced with the comparable Section 177.³¹ The grounds of opposition include that the Opponent has earlier use of a similar trade mark,³² that the Applicant is not intending to use the mark,³³ or that the trade mark is similar to a trade mark that has acquired a reputation in Australia.³⁴

Any person may oppose an application during the opposition period.³⁵ The opposition begins with filing a Notice of Intention to Oppose, followed by a Statement of Grounds and Particulars (which details the grounds on which the Opponent intends to rely on in the opposition).³⁶

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

N/A

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.

1. Australian Grape and Wine Authority Act 2013

Under the AGWA Act, the GIC may, either on its own initiative or on an application made in accordance with section 40ZAC, determine that an Australian GI is to be omitted from the Register on the ground that the GI is not in use.³⁷

On receipt of an application for removal for non-use, the GIC must publish a notice inviting persons to make written submissions in relation to the proposed removal.³⁸

After considering any submissions made, the GIC may make a determination to omit the GI

²⁸ Ibid.

²⁹ Ibid s 179.

³⁰ *Trade Marks Regulations 1995* Reg 5.6.

³¹ *Trade Marks Act 1995* (Cth) s 177.

³² Ibid s 58A.

³³ Ibid s 59.

³⁴ Ibid s 60.

³⁵ Ibid s 52.

³⁶ *Trade Marks Regulations 1995* Reg 5.6 and 5.7.

³⁷ *Australian Grape and Wine Authority Act 2013* (Cth) s 40ZAB.

³⁸ Ibid s 40ZAE.

from the Register if they are satisfied that:

(a) that the GI has been registered for a period of more than 5 years before the date of the notice under section 40ZAE;

(b) that the GI has not been used during the period of 3 years before the date of the notice under section 40ZAE (see subsection (3)); and

(c) that no special circumstances exist in relation to the region or locality indicated by the GI that would preclude the making of a determination to omit the GI from the Register.³⁹

For the purposes of the requirement at (b), there has been no use of the GI if there has not been a production of wine for commercial use originating in the region or locality indicated by the GI and wine originating in the region or locality indicated by the GI has not been described and presented for sale within Australia, or for export, using that GI.⁴⁰

Special circumstances exist if the region or locality indicated by the GI has been affected by fire, drought or some other disaster and, as a result of being affected, there has not been a production of wine during the relevant period.⁴¹

A GI, once registered, cannot become genericised.⁴²

2. Trade Marks Act 1995

a) *Renewal*

A trade mark registration, including a certification registration, may be renewed every ten years.⁴³ Fees are applicable and there is no limit to the number of times a trade mark registration may be renewed. Any person (whether incorporated or not) may pay for the renewal.

b) *Removal for Non-Use*

Certification trade marks, like regular trade marks, are subject to removal from the Register for non-use. Any third party can file an application for removal of a trade mark for non-use on the grounds that;

1. On the day the trade mark was registered, the owner had no good faith intention to use, assign or authorise the use of the mark in Australia, and has not used the mark in Australia; or
2. Where the trade mark has been continually registered for a period of 3 years, the

³⁹ Ibid s 40ZAF.

⁴⁰ Ibid.

⁴¹ Ibid.

⁴² William Van Caenegem et al, 'Pride and Profit: Geographical Indications as Regional Development Tools in Australia' (2014) 16.1 *Journal of Economic and Social Policy* 12.

⁴³ *Trade Marks Act 1995* (Cth) s 79.

owner has not used the trade mark. This applies only where a period of 5 years has passed from the filing date in respect of the application for the registration of the trade mark.⁴⁴

The burden is on the trade mark owner to show use of the trade mark within the relevant period. Evidence showing use of the trade mark in good faith during the relevant period is required to demonstrate use of the trade mark, although, a small amount of genuine use will usually be sufficient to successfully oppose a removal application.

c) Genericism

Section 87(2)(a) of the *Trade Marks Act* when read in conjunction with section 24, gives the court power to revoke the registration of a mark that has become generic. The test for considering whether a mark has become generic is whether the mark is “*generally accepted within the relevant trade*” as a sign describing or denoting the name of the good or service.⁴⁵

The burden of proof is on the Applicant asserting that a mark has become generic, and strong evidence would be required to establish genericism (e.g. consumer surveys, expert advice etc.).

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

An Australian GI may be protected as a certification trade mark. A certification trade mark shows that particular goods and services meet an official set of standards, or in the case of a GI, that a certain product comes from a certain country, region or locality.

Otherwise, except in the case of GIs for wine, a GI will be protected only against use which is likely to mislead or deceive in relation to the origin or any other characteristics of the goods to which the GI relates.

GIs in respect of wines are regulated by the *Australian Grape and Wine Authority Act 2013*. In accordance with the Act, a person must not, in trade or commerce, intentionally sell or export wine with a false or misleading description and presentation.⁴⁶ A description and presentation of wine is false or misleading if it includes a registered geographical indication and the wine did not originate in a country or locality in relation to which the geographical indication is registered or the indication is used in such a way as to mislead or likely to mislead as to the country, region or locality in which the wine originated. It is not a defence to show that the product bearing the description and presentation is purely for export.

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

The owner of a certification mark has the exclusive rights to control the use of the certification mark in respect of goods and services that meet certain characteristics. As a result, a

⁴⁴ Ibid s 92.

⁴⁵ Ibid s 24.

⁴⁶ *Australian Grape and Wine Authority Act 2013* (Cth) s 40C and 40E

certification mark allows the owner to prevent uncertified goods from being labelled with the GIs and also prevents the unauthorised use of the mark – even where the goods and services may meet the certification requirements. The AGWA provides protection against similar kinds of conduct. In particular the Act seeks to regulate the terms used to describe wine in product information, labels and advertisements.

However sections 18 and 29 of Schedule 2 of the *Competition and Consumer Act 2010* (Cth) (the Australian Consumer Law), provide a broader level of protection and make it an offence to engage in false or misleading conduct, or conduct likely to mislead or deceive, or make false or misleading representations, or representations that are likely to mislead or deceive, in trade or commerce. This includes false or misleading labelling in relation to the place of origin of goods.

This may protect GIs from false and / or misleading representations made in respect of particular goods and services. In contrast to the Trade Marks Act and the AGWA, this allows rights holders to target conduct that doesn't directly use a particular GI. As such the kinds of conduct that may be restricted include representations that goods or services are of a particular, quality, style, possess certain characteristics or are from a particular origin.

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

1. Australian Grape and Wine Authority Act 2013

Any of the following may apply in writing to the GIC for the determination of a geographical indication in relation to a region or locality in Australia:

- (a) a declared winemakers organisation;
- (b) a declared wine grape growers organisation;
- (c) an organisation representing winemakers in a State or Territory;
- (d) an organisation representing growers of wine grapes in a State or Territory;
- (e) a winemaker;
- (f) a grower of wine grapes.

In regards to an application for a foreign GI, the Regulations state that “A person may apply in writing to the Geographical Indications Committee for the determination of a GI in relation to a foreign country or a region or locality in a foreign country.”⁴⁷ The definition of a person includes a body of persons, whether incorporated or not.⁴⁸

2. Trade Marks Act 1995

In relation to certification marks, ownership requirements are the same as those required for a regular trade mark. That is, a person who claims to be the owner of the trade mark may apply.⁴⁹ The definition of a person includes a body of persons, whether incorporated or not.⁵⁰

⁴⁷ *Australian Grape and Wine Authority Regulations 1981* Reg 56.

⁴⁸ *Trade Marks Act 1995* (Cth) s 6.

⁴⁹ *Ibid* s 27.

⁵⁰ *Ibid* s 6 (1)(a).

In addition to claiming to be the owner of the trade mark, the Applicant must also:

- use or intend to use the trade mark, or
- authorise or intend to authorise another person to use the trade mark, or
- intend to assign it to a body corporate that is about to be formed with a view that the body corporate will use the trade mark.⁵¹

Certification trade marks are generally filed by a representative body from an industry group who want to regulate a scheme which identifies a characteristic of particular goods or services.

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

1. Australian Grape and Wine Authority Act 2013

It is an offence, if a seller, exporter or importer of wine sells, exports, or imports it with a false description.⁵²

A description will be false, for example, if it:

- a) indicates that wine originated in Australia or another country, when it did not originate in the indicated country; or
- b) indicates a registered geographical indication, when it did not originate from the geographical region associated with that registered geographical indication.

In each case, a criminal offence is committed.

Outside of criminal provisions in the AGWA, the Federal Court may also grant an injunction in order to protect geographical indications and other terms.⁵³ An application for an injunction may be made by, or on behalf of, the following persons:

- a) the Authority;
- b) a declared wine makers organisation;
- c) a declared wine grape growers organisation;
- d) a person who is a manufacturer of wine, or a grower of wine grapes, in Australia or a designated foreign country;
- e) an organisation established under the law of Australia or of a designated foreign country whose objects or purposes include any of the following:
 - (i) the promotion of the manufacture of wine, the growing of wine grapes or the marketing of wine;
 - (ii) the promotion or protection of the interests of persons engaged in the manufacture of wine, the growing of wine grapes or the marketing of wine;
 - (iii) the promotion or protection of the interests of consumers of wine.

2. Trade Marks Act 1995

⁵¹ Ibid s 6 (1)(b).

⁵² *Australian Grape and Wine Authority Act 2013* (Cth) s s 40C, 40E and 44.

⁵³ Ibid s 44AB(1)(c).

Where a GI is registered as a certification trade mark, rights holders may be entitled to the remedies provided for under section 126 of the Act.

If liability for infringement has been established then s 126 provides that the owner / authorised user may be entitled to:

- a. An injunction; and/or
- b. Damages or an account of profits at the option of the owner / authorised user.

The court may grant a final injunction or an interlocutory injunction in order to preserve the status quo pending a final hearing.⁵⁴

Where the owner / registered user is entitled to damages or an account of profit they must elect between these remedies.⁵⁵ In most cases the availability of one of these remedies versus the other will depend on the conduct of the infringer and whether it is feasible to determine an account.

In addition to compensatory damages under s 126(1), additional damages may be available under s 126(2). When considering whether to award additional damages the court will have regard to:

- a. The flagrancy of the infringement;
- b. The need to deter similar infringements of registered trade marks;
- c. The conduct of the infringing party after the infringing conduct and after being informed of its alleged infringement; and
- d. Any benefit shown to have accrued to the infringing party because of the infringement.

Courts may also make an order that the infringing mark be removed from the respondent's products or for the infringing goods to be delivered up to the owner / authorised user if this is not possible.⁵⁶ The court may also make a declaration that the mark has been infringed.

3. Passing Off

The tort of passing off protects the rights holder's reputation in the GI. The remedies available for passing off seek to rectify the damage incurred as a result of a misrepresentation made in respect of that reputation.⁵⁷

Where the tort of passing off is made out, the types of remedies available are similar to those under the Act. In particular these remedies include an injunction (interlocutory or permanent, if the conduct is ongoing), a declaration,⁵⁸ damages, an account of profits, or an order for delivery up or erasure.

In contrast to remedies under the Act, in passing off cases an account of profits is only awarded at the discretion of the court.⁵⁹

4. Australian Consumer Law (ACL)

⁵⁴ *Australian Broadcasting Corp v O'Neill* (2006) 227 CLR 57; 229 ALR 457; [2006] HCA 46 at [71].

⁵⁵ *Colbeam Palmer Ltd v Stock Affiliates Pty Ltd* (1968) 122 CLR 25 at 32.

⁵⁶ *Slazenger & Sons v Feltham & Co* (1889) 6 RPC 531 (CA).

⁵⁷ *Conagra Inc v McCain Foods (Aust) Pty Ltd* (1992) 33 FCR 302; 106 ALR 465; 23 IPR 193.

⁵⁸ *Treasure Cot Co Ltd v Hamley Bros Ltd* (1950) 67 RPC 89.

⁵⁹ *Colbeam Palmer Ltd v Stock Affiliates Pty Ltd* (1970) 122 CLR 25 at 29.

The ACL provides a minimum level of protection for consumers and in particular regulates representations made in respect of GIs. These representations may be in breach of the ACL where they are misleading or deceptive, unconscionable or false. The scope of the ACL means that the remedies available will vary depending upon the nature of the conduct that has been complained of.

Damages awarded under s 236 reflect loss or damage incurred as a result of conduct that contravened the ACL. In particular, the court may consider injury to reputation when considering damages under the ACL.⁶⁰ However an account of profits is not available under the ACL.

The provisions for accessorial liability under s 232 mean that persons who assist others in the contravention of the ACL may also be liable for damages. Additionally, injunctive relief is also available.⁶¹

Under the ACL the ACCC can also commence proceedings and may ask the court to impose pecuniary penalties.⁶² Alternatively, the regulator may also apply for non-punitive orders that require internal compliance programs to be established or corrective advertising be displayed.⁶³

However, rights holders should be aware that s 255 of the ACL provides that some country of origin representations do not contravene parts of the ACL and that this may prevent the rights holder from obtaining remedies that may otherwise have been entitled to.

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 Regulations allow for the co-existence of Australian geographical indications and trade marks which were registered by IP Australia prior to the registration of the geographical indication.⁶⁴

A pre-existing trade mark which includes a registered GI may continue to be used provided the true source of the grapes is clearly identified. The GIC's view is that the GI would need to be sufficiently specific to ensure the label does not mislead as to the origin of the wine.⁶⁵ An example of a wine label considered acceptable to the GIC where MUDGE is a registered GI and Mudgee Wine Co. is a pre-existing registered trade mark is depicted below:

⁶⁰ *Brabazon v Western Mail Ltd* (1985) 8 FCR 122; 58 ALR 712 at 127 – 128 (FCR), *Butcher v Lachlan Elder Realty Pty Ltd* (2004) 218 CLR 592; 79 ALJR 308; [2004] HCA 60 at 604.

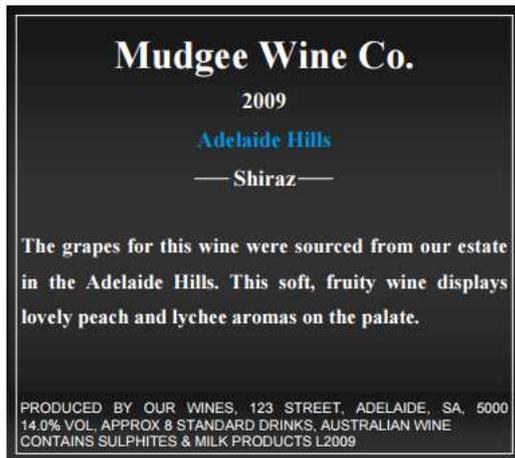
⁶¹ *Competition And Consumer Act 2010 - Schedule 2* (Cth) s 232.

⁶² *Ibid* s 224-225.

⁶³ *Ibid* s 246.

⁶⁴ *Australian Grape and Wine Authority Regulations 1981* Reg 17A.

⁶⁵ Australian Grape and Wine Authority, *Geographical Indications Guidelines* (June 2014) Wine Australia <<https://wineaustralia.com/WineAustralia/media/WineAustralia/Labelling/AGWA-Geographical-Indications-Guidelines-logo-changes-June14.pdf>>.



(<https://wineaustralia.com/WineAustralia/media/WineAustralia/Labeling/AGWA-Geographical-Indications-Guidelines-logo-changes-June14.pdf>)

In that case, the source of the grapes (being from Adelaide Hills) is clearly identified, and so it is considered that consumers are unlikely to be misled as to the origin of the wine.

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

There is no specific provision or practice concerning the inclusion of a GI/AO in .au domain names.

There is also no specific provision or practice concerning the inclusion of a certification trade mark in .au domain names. For domain name registration and dispute purposes, certification trade marks are treated the same as standard trade marks; certification trade marks can act as the basis for the registration of domain names and for filing domain name disputes.

11) Is there anybody 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?

1. Australian Grape and Wine Authority Act 2013

The AGWA Act established the Label Integrity Program (“LIP”), the object being to help “*ensure the truth, and the reputation for truthfulness, of statements made on wine labels, or made for commercial purposes in other ways, about the vintage, variety or geographical indication of wine manufactured in Australia*”.

To verify labelling claims, all parties involved in the wine supply chain must keep an auditable trail of documents indicating the vintage, grape variety and Geographical Indication of wine or grape products that they grow, manufacture, supply or receive (regardless of whether they are

acting as an agent).⁶⁶ The LIP prescribes what events must be recorded, but does not prescribe a form in which they must be kept.

Winemakers may at any time be selected for audit by an AGWA auditor. More than 400 audits are conducted each year.⁶⁷ The audit may be a cold-call or, an arranged visit, or, may be a desk audit where copies of specific records are requested for audit at the AGWA offices.⁶⁸ Auditors may collect samples in order to survey compliance with the Food Standards Code and to determine potential Australian exposure to wine contamination issues.

In addition to compliance through the LIP, to ensure compliance with the Food Standards Code sampling and chemical analysis of a statistically valid sample of Australian wine is conducted.⁶⁹ Each year around 1,200 samples are collected and submitted for chemical analysis to ensure compliance with the Food Standards Code.⁷⁰

2. Trade Marks Act 1995

In regards to compliance with standards of goods bearing certification marks, the verification of goods is outlined in the rules accompanying use of the certification mark.

As outlined above in response to Question 2(b), the rules that accompany an application for a certification mark must address the process for determining whether the goods/services meet the certification requirements, the attributes that a person must have to become an approved certifier and the procedure of resolving a dispute as to whether the goods/services meet the certification requirements.⁷¹

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 AOs/GIs and whether it was necessary to amend domestic legislation as a result of such agreements.

The Australia-United States Free Trade Agreement came into effect on 1 January 2005 and brought with it a series of amendments dealing with conflicts between geographical

⁶⁶ *Australian Grape and Wine Authority Act 2013* (Cth) s 39F.

⁶⁷ Wine Australia, *Regulatory Services* (2016) Wine Australia <<https://www.wineaustralia.com/selling/further-information/regulatory-services>> .

⁶⁸ Wine Australia, *Audits* (2016) Wine Australia <<https://www.wineaustralia.com/labelling/label-integrity-program/audits>> .

⁶⁹ *Australia New Zealand Food Standards Code - Standard 4.5.1 - Wine Production Requirements (Australia Only)*.

⁷⁰ Wine Australia, *Regulatory Services* (2016) Wine Australia <<https://www.wineaustralia.com/selling/further-information/regulatory-services>> .

⁷¹ *Trade Marks Act 1995* (Cth) s 173.

indications and trade marks.⁷²

In December 2008 the EU and Australia signed the *Agreement Between the European Community and Australia on Trade in Wine* which led to legislative amendments and the new *Wine Australia Corporation Act 2010 (formerly the Australian Wine and Brandy Corporation Act 1980 (Cth))*. The amendments guaranteed and improved access for Australian wine producers to the European export market, in exchange for Australia agreeing to protect certain European GI's, traditional expressions and vine variety names.

The *Australian Grape and Wine Authority Act 2013* came into force on 1 July 2014. The purpose of the Act was to create a single authority to support Australian wine grape growers and winemakers. The Act established the AGWA by merging the existing Wine Australia Corporation (WAC) and Grape and Wine Research and Development Corporation (GWRDC).

II. Proposals for improvements and for harmonisation

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

We consider the current definitions acceptable.

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

We consider the current registration process acceptable.

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.

In their submissions to the Australian Government's draft report on Intellectual Property Arrangements with respect to Geographical Indications (supplementary to their submissions in relation to the inquiry into Australia's intellectual property arrangements), the AGWA proposed reform in the area of the power of the GIC to omit or amend a GI that is protected on the Register.⁷³

With the exception of removal of a GI for non-use under Section 40ZAC and 40ZAB of the AGWA Act, the GIC has no discretion over whether to omit a GI from the Register.

⁷² Steven Stern, 'A history of Australia's wine Geographical Indications legislation' in Dev S. Gangjee (ed) *Research Handbook on Intellectual Property and Geographical Indications* (EE Elgar, 2016) 245, 247

⁷³ Rachel Triggs, *Response to Information Requests* (7 June 2016) Australian Government Productivity Commission <http://www.pc.gov.au/data/assets/pdf_file/0014/201551/subdr527-intellectual-property.pdf>

The AGWA therefore supported a proposal whereby discretion was vested in the GIC to amend or omit a GI from the Register on the grounds that:

- a) environmental or production changes warrant the expansion or contraction of a GI;*
- b) a region becomes known colloquially by a different name to that by which it was determined (and/or there is regional support for its name to be altered); or*
- c) the GI ceases to meet the criteria set out in regulation 24 or 25 of the Australian Grape and Wine Authority Regulations 1981 (AGWA Regulations), in particular, it fails to have the requisite degree of homogeneity.⁷⁴*

We consider this proposal is reasonable.

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

We consider the current system acceptable.

The AGWA Act provides an acceptable outline of the grounds for objecting to the determination of a GI on the basis of prior trade mark rights.

The Act states:

Registered owner of a registered trade mark

(1) The registered owner of a registered trade mark may object to the determination of a proposed GI on one of the following grounds:

- (a) that the trade mark consists of a word, expression or other indication that is identical to the proposed GI;*
- (b) that:*
 - (i) the trade mark consists of a word, expression or other indication; and*
 - (ii) the proposed GI is likely to cause confusion with that word, expression or other indication;*
- (c) that:*
 - (i) the trade mark contains a word, expression or other indication; and*
 - (ii) the proposed GI is likely to cause confusion with that word, expression or other indication; and*
 - (iii) the owner has trade mark rights in that word, expression or other indication.*

(2) The owner may object on the ground specified in paragraph (1)(c) even if there are conditions or limitations entered on the Register of Trade Marks suggesting that the owner does not have trade mark rights to that word, expression or other indication.

⁷⁴ Ibid.

Trade mark pending

(3) If a person has an application pending for the registration of a trade mark under the Trade Marks Act 1995, the person may object to the determination of a proposed GI on one of the following grounds:

(a) that:

- (i) the application was made in good faith; and
- (ii) the trade mark consists of a word, expression or other indication that is identical to the proposed GI; and
- (iii) prima facie, the requirements under the Trade Marks Act 1995 for accepting an application for registration of a trade mark would be satisfied in respect of the trade mark applied for;

(b) that:

- (i) the application was made in good faith; and
- (ii) the trade mark consists of a word, expression or other indication; and
- (iii) the proposed GI is likely to cause confusion with that word, expression or other indication; and
- (iv) prima facie, the requirements under the Trade Marks Act 1995 for accepting an application for registration of a trade mark would be satisfied in respect of the trade mark applied for;

(c) that:

- (i) the application was made in good faith; and
- (ii) the trade mark contains a word, expression or other indication; and
- (iii) the proposed GI is likely to cause confusion with that word, expression or other indication; and
- (iv) prima facie, the requirements under the Trade Marks Act 1995 for accepting an application for registration of a trade mark would be satisfied in respect of the trade mark applied for; and
- (v) after registration, the applicant would have trade mark rights in the word, expression or other indication.

Trade mark not registered

(4) If a person claims to have trade mark rights in a trade mark that is not registered, the person may object to the determination of a proposed GI on one of the following grounds:

(a) that:

- (i) the trade mark consists of a word, expression or other indication that is identical to the proposed GI; and
- (ii) the person has trade mark rights in that word, expression or other indication; and
- (iii) the rights were acquired through use in good faith;

(b) that:

- (i) the trade mark consists of or contains a word, expression or other indication; and
- (ii) the proposed GI is likely to cause confusion with that word, expression or other indication; and
- (iii) the person has trade mark rights in that word, expression or other

indication; and
*(iv) the rights were acquired through use in good faith.*⁷⁵

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?

We consider that the current protection, outlined in response to Questions 5 and 6 above, is acceptable.

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

We consider that the current system, outlined in response to Question 7 above, is acceptable.

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

We consider that it is worthwhile considering a provision to allow for domain name complaints to be brought if use of a domain name consisting of or featuring a GI is likely to mislead the public as to the nature of goods sold or advertised on a website to which the domain name resolves.

Responses to this Questionnaire

Groups are requested to submit responses to this questionnaire **by May 29, 2017**. Responses should be sent by email to StandingCommittees@aippi.org and should clearly indicate that they are responses to this questionnaire.

⁷⁵ *Australian Grape and Wine Authority Act 2013 (Cth) s 40RB.*