



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 / Regional Group Bulgaria

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
- (b) 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?

Yes, the legal protection of GI and AO is provided through registration with the Patent Office of Republic of Bulgaria and the legal regime is regulated by the Law on Marks and Geographical Indications (Trademark Law).

- 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).

According to the Bulgarian Trademark law the geographic name shall be understood as appellation of origin (AO) and geographic indication (GI).

The appellation of origin is the name of a country, region or certain locality in this country serving to indicate a commodity originating there and which qualities or characteristics are due primarily or exclusively to the geographic environment including natural and human factors.

Geographic indication is the name of a country, region or certain locality in this country serving for indication of a commodity originating there and with quality, popularity or other characteristic that could be attributed to this geographic origin.

As geographic indication shall be considered also traditional names meeting the requirements of the AO and GI mentioned above.

- 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.

- 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.

The application for registration of a geographic name shall be submitted at the Patent Office.

The application must refer to only one geographic name and shall contain:

- 1. the requirement for registration;**
- 2. the name and the address of the applicant;**
- 3. the name for origin or the geographic indication;**
- 4. pointing out of the goods;**
- 5. description of the boundaries of the geographic place,**
- 6. description of the established qualities or peculiarities of the goods and their connection with the geographic environment or the geographic origin.**

To the application shall be attached a copy of the order by the corresponding central department and a certificate of the corresponding municipality that the applicant implements production activity at the defined geographic place.

When the applicant is a foreign person to the application shall be attached a document for registration of the geographic name in the country of origin.

The application shall meet also other requirements established with an ordinance approved by the Council of Ministers.

To the application shall be attached a document for paid fees.

Each application shall be checked whether the above requirements are met.

For each application complying with the requirements for formal regularity an expertise in essence shall be implemented in 18 months term.

When there are grounds for refusal of the registration of geographic name the applicant shall be notified pointing out all the motives for the refusal and 3 months term for objections shall be conceded. (

When it is established that the geographic name meets the requirement of the law a decision for registration shall be taken. The geographic name shall be entered into the State register of the geographic names. The applicant shall be entered as user and a certificate for use of the geographic name shall be issued to him in one month term.

Any person can be entered as a user of registered geographic name. The application shall be filed with the Patent and shall contain the following information:

- 1. the requirement for entering as user;**
- 2. the name and the address,**
- 3. the geographic name and the registration number.**

To the application shall be attached a certificate from the corresponding municipality that the applicant is implementing his production activity at the determined geographic place and a certificate issued by the corresponding central department that the goods produced by the applicant comply with the characteristics or peculiarities established for the geographic name.

When the application for entering meets all of the above requirements, the applicant shall be entered in the State register of the geographic names as user and a certificate for using geographic name shall be issued to him.

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

The registration of the geographic indication shall be deleted at request of person with legal interest when:

- It has been implemented in breach of the requirements defined for GI and AO, as this circumstance has been established with entered into force court decision;**
- It is identical to earlier registered GI or a trade mark for identical goods;**
- It is identical to the name of a previously protected plant variety / breed animal;**
- It is identical to, or similar to, a previously registered geographical indication or a mark for identical / similar goods where consumers are likely to be misled**

The invalidity procedure is before Bulgarian Patent Office. The decision of the Bulgarian Patent Office shall be possible to be appealed against before the Administrative court–city of Sofia.

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

The scope of protection shall comprise prohibition for:

- 1. any use in the commercial activity of the geographic name for commodities that are similar to the commodity for which it has been registered as far as it exploits the popularity of the protected name;**
- 2. incorrect use or imitation of geographic name even if the true origin of the commodity has been noted or its use in translation or together with expressions as "origin", "kind", "type", "imitation" etc.;**
- 3. use of any other incorrect or misleading indication with regard to the source, the origin, the nature or the essential qualities of the commodity pointed out on the packing, in advertising materials or documents connected with the commodity which indication could create incorrect impression about its origin;**
- 4. other activities that could mislead the users about the true origin of the commodity.**

The registered geographic names cannot be turned into generic names until they benefit the protection of the Trademark law.

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

Any activities that could mislead the users about the true origin of the commodity.

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

The right to file belong to each person implementing production activity at the defined geographic place and the commodity produced complies with the established qualities and peculiarities.

The boundaries of the geographic place and the qualities and peculiarities of the commodities as well as the connection of these qualities and peculiarities with the geographic environment or with the geographic origin shall be determined and established by the corresponding central department with an order by its chief.

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

In case of violation of rights of GI/AO, the Bulgarian Trademark Law foresees the following claims for violation:

- 1. for establishing the fact of the violation;**

2. for termination of the violation;
3. for indemnification for damages;
4. for seizure and destruction of the goods subject of the violation as well as of the means of its commitment.

Simultaneously with the above claim, the claimant may request from the court also:

- the goods subject of the violation to be conceded to him;
- to be paid the costs related to the preservation and destruction of the goods subject of the violation;
- publishing of the disposition of the court decision to the account of the infringer in two daily newspapers and in a time zone of a television organization of national coverage determined by the court.

- 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 Bulgarian Trademark law does not allow registration of GI/AO when it is identical/similar with an earlier trade mark registered for identical/similar goods when there is a probability the users to be misled.

As well as, the Bulgarian trademark law does not allow registration of a trademark (absolute grounds) when the applied trademark exclusively consists of applied or registered geographical indication, effective on the territory of the Republic of Bulgaria, or derivatives thereof or mark containing applied or registered geographical indication, effective on the territory of the Republic of Bulgaria, or derivatives thereof, when the applicant is not a registered user of the geographical indication.

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

No, in the Bulgarian legislation there is no specific provisions concerning the inclusion of GI/AO in a domain name

- 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?

The official body that administrate GIs/AOs is the Bulgarian food safety agency, which in accordance with the requirements of Regulation (EC) No 882/2004 of the European Parliament and of the Council of 29 April 2004It is responsible for carrying out official controls - in the production, labeling and marketing of agricultural products and foodstuffs with protected geographical indications

and of traditional specialties guaranteed, as well as of agricultural products and foodstuffs with names with temporary national protection.

The official control shall be carried out at each stage of the production and trade in agricultural products and foodstuffs with protected geographical indications and of traditional specialties, as well as of agricultural products and foodstuffs.

- 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.

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.
- 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.
- 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.
- 16) How should conflicts between GIs/AOs and prior trademark rights be regulated?
- 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?
- 18) Who should have legal standing to protect a GI/AO and which remedies are appropriate?
- 19) Should there be a specific provision or practice concerning the inclusion of a GI/AO in a domain name?

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.

