



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 adhesion 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 China

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. (No difference on a or b)

- 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).

GI is a sign that signify the place of origin of the goods for which the specific quality, reputation or other features is mainly decided by the natural or cultural factors of the regions

- 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.

There is no sui generis laws solely for AOs and/or GIs in China.

AOs and/or GIs are protected within the framework of trademark laws by registration as collective or certification marks.

On the administrative level, at present, the State Administration for Industry and Commerce/the Trademark Office (SAIC/TMO), the General Administration of Quality Supervision, Inspection and Quarantine (AQSIQ), and the Ministry of Agriculture (MoA) have the power to protect and register geographical indications. The aforesaid three government agencies, however, supervise and protect GIs from different aspects or directions.

SAIC and TMO protect GIs as trademark right as certification mark or collective mark. GI owners may enforce its right in the GI just as an ordinary trademark.

AQSIQ aims to certify the quality of production process and related production standards by means of registration of GIs. In other words. GI registration with AQSIQ is regarded as a tool to inspect and control the quality of a product rather than is private right.

MoA, by means of registration of GI/AO for primary agricultural products, only focuses on the protection of primary agricultural products.

- 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.
- 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.

As a certification mark or collective mark, a GI or AO can be invalidated/cancelled just the same as ordinary trademarks based on the grounds as becoming generic, non-use for 3 years, not paying fees by means of invalidation or cancellation proceeding with the Trademark Review and Adjudication Board (TRAB) of SAIC or the TMO.

For cancellation on non-use, the owner of the GI (certification or collective mark) bears the burden of proof.

For invalidation based on becoming generic, the petitioner bears the burden of proof (including but not limited to consumer surveys, expert advice, dictionaries, etc. that may prove the GI has become generic.)

All administrative decisions regarding the GI trademark right are subject to judicial review, namely, any relevant party may file law suit against the administrative decision.

(No difference on a or b)

AQSIQ issued *Measures for the Protection of Foreign Geographical Indication Products* on March 8, 2016. In Article 33, the AQSIQ indicates, if one of the following circumstances exists, the AQSIQ could issue a notice to revoke the protection of a foreign geographical indication:

- i. The foreign geographical indication was revoked in the country or territory of origin;
- ii. The Chinese domestic judicial organ has ruled that the protection shall be revoked;
- iii. Seriously violating the relevant laws and regulations in China, etc.

(difference on b)

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

The scope of protection of GIs/AOs under China Trademark Law is just the same as scope of protection of a collective/certification mark. (No difference on a or b)

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

Same as ordinary trademark enforcement in China for SAIC. (No difference on a or b)

Article 31 of the Measures for the Protection of Foreign Geographical Indication Products issued by AQSIQ stipulates that, the AQSIQ and Provincial Quality Inspection Departments shall handle complaints of infringement of the legitimate rights and interests of foreign geographical indication products protected by China, and quality inspection departments at all levels investigate and punish the illegal acts according to law; The applicant may also file a lawsuit with the people's court. (difference on b)

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

In domestic GI/AO registration as certification/collective mark in China, in practice, only the entity that may represent the interest of the whole GI industry, most of the time the association of the industry, has the legal standing to register and protect the GI/AO.

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

Same as remedies in violation of trade mark rights. (No difference on a or b)

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 Trademark Office (TMO) of SAIC is responsible for the examination on the application for certification marks and collective marks whether the application is for a GI or not. During the substantive examination process, because of the uniqueness of a collective or certification mark, especially a GI, the absolute ground for refusal is substantially alleviated; but the relative ground of refusal, namely search on prior similar trademark application or registration, is consistent in ordinary trademarks, which means a prior similar trademark will hinder the registration of a certification/collective mark, and vice versa.

However, the court in China may have a different view on whether two marks are similar to each other when a GI certification/collective mark is involved in the judicial review on the grant and validation of a trademark. According to Beijing High People's Court, such claim is not to be supported if any party claims that a GI, in the nature of a certification/collective mark, should not be granted because of the existence the claimant's prior similar ordinary trademark, whether its ordinary trademark is famous or not; similarly, such claim is not to be supported if any party claims that an ordinary trademark should not be granted because of the existence of the claimant's prior GI. The court appears to regard GI, in the nature of certification/collective mark as a different type of mark from ordinary trademark.

Indeed, there are different opinions on the Trial Guide regarding GI issued by Beijing High People's Court in 2014. There was a breakthrough in the litigation on the review

of opposition concerning the trademark  "螺旋卡帕" No. 4662547 in 2016. In this case, after

holding an expert seminar, the Court finally held the trademark  "螺旋卡帕" No. 4662547

shall be rejected since it is similar to the prior GI mark  "100% NAPA VALLEY" No. 4502959 on the similar goods according to Article 29 of the *Trademark Law*. This case shall draw our attention as there may be more similar cases in the future.

(No difference on a or b)

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

No. (No difference on a or b)

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?

On the administrative level, at present, there are three (3) government bodies that have the power to protect and register geographical indications. They are:

1. State Administration for Industry and Commerce/the Trademark Office (SAIC/TMO)
2. General Administration of Quality Supervision, Inspection and Quarantine (AQSIQ)
3. Ministry of Agriculture (MoA)

The aforesaid three government agencies, however, supervise and protect GIs from different aspects or directions.

1. SAIC and TMO protect GIs as trademark right as certification mark or collective mark. GI owners may enforce its right in the GI just as an ordinary trademark.
 2. AQSIQ aims to certify the quality of production process and related production standards by means of registration of GIs. In other words. GI registration with AQSIQ is regarded as a tool to inspect and control the quality of a product rather than is private right.
 3. MoA, by means of registration of GI/AO for primary agricultural products, only focuses on the protection of primary agricultural products.
- 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.

In 2006, the AQSIQ and EU Trade Commission signed *Memorandum of Understanding on Geographical Indications*. In the Memo, both parties confirmed that they would determine the 10 geographical indication products, to be bilateral mutual recognized and protected. In 2012, the negotiation completed. Chinese agricultural products Longjing Tea, Dongshan White Asparagus, Guanxi Pomelo, Jinxiang Garlic, Lixian Ma Yang Medicine, Pinggu Big Peach, Shaanxi Apple, Yancheng Lobster, Zhenjiang Balsamic Vinegar and Longkou Fans had been recognized and protected as GI products by EU, and EU's Rockefeller Cheese, Azera Sauce, Pajagan Cheese, Parma Ham, Córdoba Olive Oil, Majina Olive Oil, Conti Cheese, Steele Cheese, Scotland Farm Salmon and Farmhouse Cheese had been recognized and protected as GI products by China. It is no need to amend the domestic legislation according to the agreements.

As far as we know, SAIC has been involved in EU-China Agreement on GIs, and the negotiations are ongoing. However, we did not find any public reporting.

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.

Yes. In consistent with TRIPS definition, namely, an indication which identify a good as originating in the territory or a region or locality, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin

- 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.

N/A.

- 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.

Please refer to our reply to the question 4.

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

If a GI mark is applied prior to an ordinary trademark which is similar to this GI mark or contains this GI mark on the similar goods, the ordinary trademark shall not be approved for registration whether based on the first-to-file principle or the GI clause.

However, if the ordinary trademark is filed prior to the similar GI mark, such conflicts shall be discussed in further. Basically, we hold the prior ordinary trademark shall not block the registration of the GI mark.

- 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?

In China, we do not see there is any difference on the protection of domestic or foreign GI. However, for the special protection, we hold the scope should be determined according to the principle of reciprocity.

As to the second question, we hold we can refer to the provisions of trademark infringement as stipulated in Article 57 of *China Trademark Law*, which is relatively complete.

Article 57 of the *Trademark Law*. Any of the following acts shall be an infringement of the exclusive right to use a registered trademark:

- (1) to use a trademark that is identical with a registered trademark in respect of the same goods without authorization of the proprietor of the registered trademark;
- (2) to use a trademark similar to a registered trademark in respect of the same goods or to use a trademark identical with or similar to a registered trademark in respect of similar goods, without authorization of the proprietor of the registered trademark, where such use is likely to cause confusion;
- (3) to sell the goods that infringe the exclusive right to use a registered trademark;
- (4) to counterfeit, or to make, without authorization, representations of a registered trademark of another person, or to sell such representations of a registered trademark as were counterfeited, or made without authorization;
- (5) to replace, without authorization, a registered trademark and put the goods bearing the replaced trademark on the market;
- (6) to intentionally provide a person with conveniences for such person's infringement of the trademark of another person or facilitate such person's infringement of the trademark of another person;
- (7) to cause, in other aspects, prejudice to the exclusive right of another person to use a registered trademark.

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

In terms of GI/AO registered as certification or collective mark, the trademark right owner should have the legal standing to protect GI/AO.

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

N/A

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.