



## 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](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](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 Denmark**

**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.

According to The Danish Trademarks Act § 13(2), (1) it is not possible to register a mark, which serves exclusively to designate the geographical origin of the goods and/or services.

Furthermore, according to the Danish Trademarks Act § 5(2), a proprietor of a trademark right cannot prohibit others from making industrial use of specifications re. geographical origin of the goods and/or services in the course of trade, if such use is in accordance with fair trading practices.

Thus, it is not possible to protect GIs and AOs in Denmark due to lack of distinctiveness. However, they may still be protected as collective marks.

The Collective Marks Act protects association and certification marks, which may consist of signs or indications used in the course of trade in order to designate the geographical origin of goods and/or services, see § 3.

A collective mark does not entitle the proprietor to prevent a third party from using a sign or indication in the course of trade, if they are used in accordance with fair trading practices.

Finally, the use of a geographical indication or appellation of origin may be prohibited under the Danish Marketing act, if it is misleading or a violation of fair trading practices.

According to EU-law, designations of origin and geographical indications for agricultural products, foodstuffs and alcoholic beverages are protected by regulations 1151/2012 and 110/2008, which apply in Denmark without implementation.

A national order (BEK no 1376 of 06/12/201) outlines the procedure for appliance of protection in Denmark.

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 Collective Marks Act protects association and certification marks. Such marks are defined as a specific sign belonging to an association of enterprises and used, or intended to be, by its members for goods or services. Or it is defined as a specific sign belonging to a legal entity supervising or laying down standards for goods or services and is used, or intended to be used, for the goods or services being object of supervision, or for which standards are laid down, see §1 (2) and (3)

The Danish Marketing Act does not define AO/GI, but provides a general protection to misleading fair trading practices.

In art. 5 of the regulation 1151/2012 designations of origin and geographical indications are generally defined as a name which identifies a products specific origin, exclusive/essential qualities/characteristics due to a particular geographical environment, or production steps taking place in a defined area.

It must comply with a specification, see art. 7, and an application for registration must be filed, see art. 8.

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.

Apart from the specific protection in EU, the GIs/AOs are only protected as aspects of other laws; as a collective mark or under the Danish Marketing Act.

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.

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

A registration of a collective mark may among other things be revoked due to lack of use or distinctive character, if it has become generic, is liable to mislead the public, or if it violates the general public's interests, see The Collective Marks Act §. 8. This may be invoked in opposition proceedings or a cancellation action before the trademark office or in a court proceeding.

In regard to the protection of agricultural products, foodstuffs and alcoholic beverages, it follows from art. 54 of regulation 1151/2012 that the registration may be cancelled if it does not comply with the conditions of the specification, or if no product is placed on the market for at least seven years. This may be carried out on the Commission's own initiative or at the request of any natural or legal person having a legitimate interest.

Furthermore, it is possible for a person residing in Denmark and with legitimate interests, to file an opposition within a month after the publication of the application, see § 6 in BEK no. 1376 of 06/12/2013.

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

The scope of protection relates to domestic marks, which are registered or brought to market in jurisdiction, see question 6.

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

Collective marks may prevent any person without consent from using a sign in the course of trade, if the sign is identical to or similar with the trade mark, and if the goods or services are identical to or similar with the goods or services. The same applies if there exists a likelihood of confusion, see the Danish Trademarks Act §. 4, to which § 2 of the Collective Marks Act applies.

The Danish Marketing Act generally protects against misleading the consumer or parasitism/free riding.

The EU regulation 1151/2012 protects against commercial use of the name, misuse, imitation or evocation, false or misleading indication or if it is liable to mislead the consumers, see art. 13.

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

Collective marks are administered by the Danish Patent and Trademarks Office (PTO). The Danish Marketing Act is administered by the Danish Consumers' Ombudsman, and the specific EU regulations are in national law administered by the Danish Food Safety Authorities (Fødevarestyrelsen).

It is possible for natural or legal persons to initiate court proceedings. Furthermore, they may file a complaint with the Danish Consumers' Ombudsman or initiate opposition proceedings or a cancellation action with the Danish PTO and the Danish Food Safety Authorities, respectively.

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

The remedies available in case of violation of rights to collective marks are damages, equitable remuneration, a penalty or prison up to 1 year and 6 months.

The remedies available in case of violation of the Danish Marketing Act are prohibition, injunction, damages, equitable remuneration or a penalty

The remedies available in case of violation of the EU regulations is a penalty, see BEK no.. 1376 of 06/12/2013.

- 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?

With collective marks, a prior trademark has priority, unless the application for registration was filed in good faith and that the proprietor of the earlier right has been aware of and tolerated the use, or the proprietor of the older right has not, within a reasonable time, taken the necessary steps to prevent the use of the younger trade mark, see §§ 7-9 in the Trademark Act, to which § 2 in the Collective Marks Act apply.

The EU regulation 1151/2012 art.10 states that an opposition may be based on an earlier right, if this earlier right has been legally on the market for at least five years preceding the date of the publication of the younger right.

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

No

- 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 collective marks are administered by the Danish PTO.

The mark must be registered in the Register of Collective Marks, which requires an application, see § 4. The application must contain a reproduction of the mark, state the applicant's name or company and mention the goods or services for which it is registered.

The specific EU regulations are in national law administered by the Danish Food Safety

Authorities to whom the application must be sent.

Control organs may apply to the Danish Food Safety Authorities for permission to handle specific tasks in relation to the official control of the product specifications, see § 8 of BEK no. 1376 of 06/12/2013.

- 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.

No – Denmark has signed the TRIPS Agreement and the Paris Convention.

## **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. Harmonisation would provide for a more effective protection as it would not differ depending on the country. Especially since these indications are used across borders.

In regard to definitions and prerequisites, it would be easy to use the current EU regulations as a starting point. It would be advisable to include factors such as the length of time and the extent of the use as a geographical indication, the reputation in public and the likelihood of confusion with existing trademarks etc.

- 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.

A registration procedure would make it easier for companies to see which indications that are protected and which are free to use. This procedure should include examination by a competent body and a possibility of opposition for third parties to ensure a fair system.

- 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.

If GIs/AOs become generic or have not been used through an extensive period, it would be most reasonable in accordance with the purpose of the law to result in a loss of rights.

Such a claim would need to be documented through market surveys etc., and the burden of proof should be placed on the opposition party, who claims a ground for invalidity/loss of right is present.

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



The most efficient solution would be for prior trademarks to be able to co-exist with GIs/AOs, if it was registered in good faith of the future registration of the GI/AO.

- 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?  
The protection should be wide in order to have an effective enforcement, but it might be difficult to protect against foreign marks. For this reason, the scope of protection should be limited to domestic marks, which are registered or brought to market in the jurisdiction.

The law should protect against use of an identical or similar mark for similar products, misleading use of the name, misuse, and false or misleading indications.

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

There should be a public body to administer the law with the possibility to delegate the responsibility, and it should be possible for legal or natural persons with legitimate interests to file an opposition.

The remedies would need to include damages, equatable remuneration and penalties in order to ensure compliance.

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

There is no need for a specific provision other than what follows from the general law.

### 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](mailto:StandingCommittees@aippi.org) and should clearly indicate that they are responses to this questionnaire.