



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
Independent Member Kazakhstan***

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?
AOs are protected in Kazakhstan.
- 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).
An appellation of origin means a designation which constitutes or contains the name of the country, region, population center, area or any other geographical indication as well as any indication derivative of such name and became famous as a result of using it in relation to the good which special characteristics, quality, reputation or other characteristics are connected with its geographical origin including the specific environmental conditions and (or) human factor.
- 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.
The protection is provided by the Law of the Republic of Kazakhstan “On Trade Marks, Service Marks and Appellations of Origin”
- 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.

Application shall be submitted on a standard form and shall contain:

- 1) request to carry out examination of the name and (or) to grant the right for the name where the applicant (applicants) as well as his (their) location or residence shall be indicated;
- 2) designation in regard to which the application is filed;
- 3) kind of the good;
- 4) description of the specific characteristics of the good;
- 5) indication of the place of good manufacture (limits of geographical location).

If the geographical location which name is applied as appellation of origin is located in the territory of the Republic of Kazakhstan the application shall include the opinion of the local executive authority that the applicant produces the good within the borders of the mentioned geographical location and the special features, quality, reputation or other characteristics of this good are mainly determined by the environmental conditions and (or) human factors typical for this geographical location.

The application for granting the exclusive right for the registered earlier appellation on origin located in the territory of the Republic of Kazakhstan shall include the opinion of the authorized body that the applicant manufactures within the borders of this geographical location the good that has the special features specified in the State register of appellations of origin of the Republic of Kazakhstan.

If the geographical location which name is applied as appellation of origin is located outside the Republic of Kazakhstan the document confirming the applicant's right for the requested appellation of origin shall be attached to the application. The proof of payment for service of the expert organization on carrying out the examination shall also be attached to the application. Amount of payment shall be established in accordance with the legislation of the Republic of Kazakhstan. In case of records management through the representative the power of attorney shall be attached to the application.

The AOs Applications are not published in Kazakhstan, therefore no opposition period is provided for regarding the AOs Applications. The opposition period regarding the registered AOs is five years from publication date.

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.

1. The registration of the appellation of origin and (or) granting the right to use the appellation of origin may be contested and nullified if it was made in violation of the requirements established by Articles 26, 27 and 29 of the TM Law.

2. The registration of the appellation of origin and (or) granting the right to use the appellation of origin may be contested and nullified within five years of the date of

publication of the information about the state registration of the appellation of origin in the official bulletin if the use of the appellation of origin is able to mislead the consumer about the good or its manufacturer due to the trademark with earlier priority as well as the general recognition in the Republic of Kazakhstan as a result of the active use.

3. The registration of the appellation of origin shall be terminated:

1) due to disappearance of the representative conditions in the said geographical location and failure to produce the good with the characteristics specified in the State register of appellations of origin in regard to the reviewed appellation of origin;

2) due to the termination of the legal protection of the appellation of origin in the country of origin. 2. The right to use the appellation of origin of goods shall be terminated: 1) due to the expiry of its term specified in Article 34 of this Law; 2) due to loss of the special features of the good specified in the State register of appellations of

origin in regard to the reviewed appellation of origin; 3) upon the request of the owner of the right to use the appellation of origin filed to the authorized body;

4) upon the liquidation of the legal entity or termination of business activity of the individual – owner of the right to use the appellation of origin.

- 5) What is the scope of protection of GIs/AOs under your Group's current law?
- 6) Against what kind of conduct are GIs/AOs protected? For example, against use misleading consumers, parasitism and free riding.
 - 6) Who has legal standing to protect a GI/AO. For example, individual producers, consortiums and associations, public bodies.

The AO are registered as per se if it meets the requirements of the TM Law but the right to use the registered AO may be granted to individual producers, legal entities, consortiums and associations, public bodies provided they are producing in this geographical location goods the special characteristics of which are related, exclusively or mainly, with the geographical area including environmental conditions and (or) human factors.
- 8) What remedies are available in the case of violation of rights in a GI/AO?
- 9) How does your Group's law regulate the conflict between a GI/AO and a prior trademark? Does the GI/AO or the trademark prevail or do they coexist? Under what conditions?
- 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?

No.

- 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? The owners of the trademarks that are identical or confusingly similar to the well-known trademark and registered before the trademark was acknowledged as well-known reserve the right for their subsequent use during the period established by the authorized body but not longer than seven years.
- 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?

The Owners of the right to use an AoO may right to protect the AO.

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

No.

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.