



## 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**

Independent Member Taiwan

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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
- (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.  
However, our relevant provisions under the Trademark Act are designed to protect GIs under the certification mark mechanism, while protecting AOs under the collective trademark registration system.
- 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).  
Our Trademark Act does not specifically prescribe differences between the AO and GI in terms of the type, nature and intensity of link with a territory, but have defined as follows:  
  
“Where [a] certification mark [...] serves to certify a place of origin, the goods or

services from that geographical region shall have a given quality, reputation or other characteristic. An applicant may file an application for registration of a sign which contains such geographical name or is capable of indicating such geographical region as a geographical certification mark.” (§80(2) of Trademark Act)

“Where [a] collective trademark [...] serves to indicate a specific place of origin of goods or services of a member, such goods or services from that geographical region shall have a given quality, reputation or other characteristic. An applicant may file an application for registration of a sign which contains such geographical name or is capable of indicating such geographical region as a geographical collective trademark.” (§88(2) of Trademark Act)

Also, we protect GIs for wines and spirits by negative protective measure as the following provision under the Trademark Act:

“A trademark shall not be registered if (a) it is likely to mislead the public as to the nature, quality, or place of origin of the goods or services, or (b) it is identical with or similar to a geographical indication for wines or spirits in the ROC or a foreign country, and is designated to goods that are identical with or similar to wines or spirits, where that foreign country concludes with the ROC an agreement, or accedes to an international treaty, to which the ROC also accedes, or has reciprocal recognition with the ROC of protection of geographical indications for wines or spirits (as provided in Items 8 and 9, Paragraph 1, Article 30 of the Taiwan Trademark Act).”

- 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.

No, there is no *sui generis* laws for GI/AOs. GI/AOs are protected as certification marks or collective trademarks under the Trademark 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.

Although there is no separate laws provided for GIs/AOs, we do provide a system of registration under the Trademark Act, Taiwan IP Office promulgated the “Examination Guidelines on Certification Marks, Collective Trademarks and Collective Membership Marks” as a benchmark reference for examination for the applications of GI/AOs’.

#### **Examination of GI certification marks**

According to Section 2.2 of the Guidelines, an application for registration of a GI certification mark shall be made by filing an application containing (the name and address of) the applicant, a reproduction of the mark, and the list of goods or services to be certified (§19(1) applicable mutatis mutandis to §94 of Trademark Act), and by submitting documents proving such person's capability to certify

another person's goods or services, regulations governing the use of the certification mark, and a declaration that such person does not carry on a business involving manufacture and marketing of goods or provision of services of the kind certified (§82 of Trademark Act). In addition to these documents, an examination of the application as to the distinctiveness of the certification mark and other grounds for refusal of registration are also required (§§29-30 applicable mutatis mutandis to §94 of Trademark Act).

#### **Examination of GI collective trademark**

According to Section 3.2 of the Guidelines, an application for registration of a GI collective trademark shall be made by filing an application containing (the name and address of) the applicant, a reproduction of the trademark, and the list of designated goods or services (§19 applicable mutatis mutandis to §94 of Trademark Act). The application should also set forth the class number(s) and the names of the designated goods or services. If the application is for a GI collective trademark, when specifying the goods or services, the applicant should also specify the scope of the geographical region that the place of origin defines, such as "tea leaves originate in Township in County." The quality, reputation, or other characteristics of the goods or services on which a geographical collective trademark is used to indicate the place where they originate must be related to the geography of that place. The unique natural conditions or cultural traditions of a geographical region often make the region suitable for developing particular goods or services. Therefore, a geographical collective trademark, in principle, is used to certify only one type of goods, such as "tea leaves," "rice," or "taro." However, in exceptional circumstances, a geographical certification mark may certify goods of a general type, such as "aquatic products."

#### **Opposition, invalidation, and revocation proceedings against GI certification marks or GI collective trademark**

According to Sections 2.4.4 and 3.3.4, any person may file an opposition to registration of a certification mark within three months from the day following the date of publication of registration on the grounds that such registration falls under §29(1), §30(1), or §65(3) (§48 applicable mutatis mutandis to §94 of Trademark Act); an interested party may also file invalidation, or a trademark examiner may submit a proposal for invalidation, against the registration of a certification mark on the same grounds after the date of publication of registration (§57 applicable mutatis mutandis to §94 of Trademark Act).

- 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.

(A) Grounds of invalidity/loss of rights

Applied mutatis mutandis to GI/AO as a certification mark, the grounds of invalidity are the same as a registered trademark such as

Descriptiveness (§29(1)(1));

Genericness (§29(1)(2));

Lack of distinctiveness in other forms (§29(1)(3));

Likelihood of confusion (§30(1)(8), §30(1)(10), §30(1)(11), §63(1)(5), etc.); etc.

Moreover, §93(1) of the Trademark Act merely provides specifically that TIPO may, upon an application by any person or ex officio, revoke the registration of a certification mark [...] or collective trademark if:

- (1) the certification mark is used by the proprietor of such mark as a trademark;
- (2) the proprietor of the certification mark carries on a business of goods or services of the kind certified;
- (3) the proprietor of the certification mark is no longer competent to certify another person's goods or services to which the registration certification mark is designated;
- (4) the proprietor of the certification mark discriminates against those who apply for certification;
- (5) the proprietor of such trademark or mark transfers, licenses, or creates a pledge which falls under the preceding article;
- (6) the proprietor of such trademark or mark does not manage or supervise the use pursuant to the regulations governing the use; or
- (7) the proprietor of such trademark or mark uses such trademark or mark improperly that is likely to cause damage to others or the public.

(B) Where can an illegal registration be invoked?

The Trademark Office of the TIPO.

(C) Test

All materials are considered. e.g. consumer surveys, expert advice, dictionaries, etc.

(D) Burden of proof

The person who claims the right should bear the burden of proof.

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

Same as a registered trademark, a GI/AO owner may keep an unauthorized third person from

- (1) using a mark which is identical with the registered GI in relation to goods or services which are identical with those for which it is registered;
- (2) using a mark which is identical with the registered GI and used in relation to goods or services similar to those for which the registered one is designated, and hence there exists a likelihood of confusion on relevant consumers; or

- (3) using a mark which is similar to the registered GI and used in relation to goods or services identical with or similar to those for which the registered one is designated, and hence there exists a likelihood of confusion on relevant consumers.  
(Applied mutatis mutandis; §35 and §94)

In addition to the GI protection to wines and spirits, neither the collective trademark nor the certification trademark limits the types of products, i.e. agriculture or non-agriculture.

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

GIs/AOs are protected against use that misleads consumers and free riding. Specifically the following provisions provide related protection:

- Item 11, Paragraph 1, Article 30 of the Trademark Act: A trademark shall not be registered if such is identical with or similar to another person's well-known trademark or mark, and hence there exists a likelihood of confusion on the relevant public or a likelihood of dilution of the distinctiveness or reputation of the said well-known trademark or mark, unless the proprietor of the said well-known trademark or mark consents to the application.
- Paragraphs 1 and 2, Article 21 of the Fair Trade Act: No enterprise shall make or use false or misleading representations or symbols on the matter that is relevant to goods and is sufficient to affect trading decisions on goods or in advertisements, or in any other way make it known to the public. The matter, referred to in the preceding paragraph that is relevant to the goods, and is sufficient to affect trading decisions, includes: price, quantity, quality, content, production process, production date, valid period, method of use, purpose of use, place of origin, manufacturer, place of manufacturing, processor, place of processing, or any other relevant item that has touting effects. No enterprise shall sell, transport, export or import goods bearing false or misleading representations referred to in the preceding paragraph.
- Item 1, Article 6 of the Commodity Labeling Act: The labeling of commodities shall not have the content containing incorrect, false and/or misleading information or claims.
- Paragraphs 1 and 2, Article 13 of the Regulations Governing the Labeling of the Alcohol Products: GI referred to in the Act shall mean a geographical origin, such as a nation or region, that is sufficient to represent the quality, reputation or other characteristics of the goods, and such origin shall be the place of production of the goods. GI shall comply with the regulations prescribed by each region or country. The labeling of alcohol products shall not be used in translation or accompanied by expressions such as "kind," "type," "style," "imitation" or the like, to convey erroneous impression or inference as to the origin of the alcohol product, even where the true origin of the product is indicated.

- Paragraph 5, Article 32 of the Tobacco and Alcohol Administration Act: No false or misleading statements may be made in the labeling on the container or the external packaging or brochures of alcohol products. No translated text or terms such as "kind," "type," "style," "imitation," or any similar indications or supplemental explanations may be used to indicate production in another place of origin. The same shall be true when the product is already correctly labeled with the actual place of origin.
  - Item 2, Article 17 of the Foreign Trade Act: an exporter/importer shall not fail to or untruthfully label the source identification or the country of origin as required.
- 7) Who has legal standing to protect a GI/AO. For example, individual producers, consortiums and associations, public bodies.  
The eligibility to apply for a certification mark vested in governmental bodies, legal entities, or organizations that are competent to certify another person's goods or services. (§81(1)) However, for the impartiality and credibility of the GI/AO, an entity is not eligible as an applicant if it is by itself to engage in the business of goods or services certifiable by the very mark. (§81(2))
- 8) What remedies are available in the case of violation of rights in a GI/AO?  
Injunctive relieves and monetary damages are available to a mark holder. In addition, an infringer may be subject to criminal penalties such as imprisonment or a fine.
- 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?  
§30(I)(X) of the Trademark Act allows the co-existence of a new trademark and a prior trademark if the owner of the prior trademark agrees with the coexistence and the coexistence is not obviously improper. We believe it is obviously improper to allow the coexistence of a GI/AO and a trademark since it will cause confusion on consumers. Therefore it shall be considered on a case by case manner when a GI/AO registration conflicts with a prior trademark.
- 10) Is there any specific provision or practice concerning the inclusion of a GI/AO in a domain name?  
Yes, but only the Chinese names for the ".tw" and ".台灣" top level domain names have reserved terms. Namely:  
A) title of local administrative divisions down to the "township" level in the hierarchy shall be reserved. For example. "台中 (Taichung in Chinese)," "台中市 (Taichung city)," and "淡水鎮 (Tamshui Township)" are reserved whereas "淡水 (Tamshui)" along is open for registration.  
B) Chinese names of schools that are registered with the Minister of Education,  
C) Chinese names regarding the exercise of the State's Sovereignty,  
D) Chinese names and abbreviations of the governmental bodies, and  
E) Chinese names reserved by the TWNIC (Taiwan Network Information Center).

Other than that, there is no specific provision or practice regarding the inclusion of a

GI/AO in a domain name. We believe the domain name disputes shall be resolved according to the domain name dispute resolution measures.

- 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?

If a user intends to use a specific certification mark, he has to receive approval from the mark's owner. The owner of the certification mark shall verify whether the use of the certification mark is in compliance with the "Use Specification". The "Use Specification" serves as a fundamental basis governing the use of a certification mark, accompanying a mark's registration. Specifically, the "Use Specification" shall set forth, among others, the means of managing the use of the certification mark ((§82(4)(3))The authority will supervise the owner of the certification mark and may revoke the certification mark if the supervisory authority believes the owner misuses its power or has other misconducts.

Same rules are applied to the owner of the the GI/AO collective marks (§89(2)(3)).

- 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.

N/A

## **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.

Since there are still differences between AOs and GIs (the sources of product may be different to the place of origin), we are of the opinion that there is no need to harmonize definitions of AOs and GOs.

- 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.

Yes. They should be applied by a legal entity which is reputed and competent to recognize and supervise the use of GI/AOs. The application shall be examined by competent authority. After registration, the authority or any third party may supervise the use of GI/AOs.

- 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.

The grounds listed are all appropriate grounds for invalidating the GIs and/or AOs. In particular, if the GIs and/or AOs transform into a generic term, the rights for GIs and/or AOs should be invalidated since the purpose of the indication would not exist. The person who requests to invalidate the GIs and/or AOs should bear the burden of proof; any objective evidence (such as governmental surveys, consumer surveys, dictionaries, etc.) or opinions from experts or the public can be proposed.

- 16) How should conflicts between GIs/AOs and prior trademark rights be regulated?  
They should not co-exist since their co-existence will cause confusion and mislead consumers.

GIs/AOs are public resources that are fundamentally different from trademark. Thus, to maintain the GIs/AOs, the Trademark Act excludes others from applying for registration of a conflicting trademark or revokes the trademark registration.

For further information “A trademark shall not be registered if (a) it is likely to mislead the public as to the nature, quality, or place of origin of the goods or services, or (b) it is identical with or similar to a geographical indication for wines or spirits in the ROC or a foreign country, and is designated to goods that are identical with or similar to wines or spirits, where that foreign country concludes with the ROC an agreement, or accedes to an international treaty, to which the ROC also accedes, or has reciprocal recognition with the ROC of protection of geographical indications for wines or spirits” provided by Items Paragraphs 8 and 9, Article 30 of the Trademark Act.

- 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 scope of protection of GI/AO should be the same as other kinds of trademarks. It does not matter whether the GI/AOs are domestic or foreign in view of consumer protection. They should be protected in any third parties misuse or counterfeit GI/AO. And, as mentioned above, several provisions such as false labelling of the source identification or the country of origin have restricted acts from any third parties.

- 18) Who should have legal standing to protect a GI/AO and which remedies are appropriate?  
The owner of GI/AO shall have legal standing to protect GI/AO under the trademark law, while the authority or interested parties may intervene based on different laws such as unfair competition. It depends on the facts to determine which remedy is appropriate. For example, if it is a registration GI certification/collective mark, it shall firstly resort to the IP office if any third party attempts to register a similar mark. If it is an infringement, the right owner shall seek remedies at the court proceeding.

- 19) Should there be a specific provision or practice concerning the inclusion of a GI/AO in a domain name?  
Yes. A provision should be given as that only the owner of the "GI certification mark" or "GI collective trademark" applies for a related domain name or top level domain such as .wine or .vin to prevent the domain name from being abused by other parties.

## **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.