

Name of your National/Regional Group

National Group Ireland

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

All registered PDOs/AOs and PGIs benefit from the same level of protection in the EU and hence in Ireland also. So the response will not be separated into PDOs/AOs and GIs.

(b) depending on whether the GI or AO is foreign or domestic.

Foreign GIs, AOs/PDOs are governed by the TRIPS Agreement and also have some protection under the Consumer Protection Act 2007.

I. Analysis of current legislation and case law

1) Are GIs and/or AOs protected under your Group's current law?

Domestic GIs/AOs: GIs and AOs/Protected Designation of Origin (PDOs) are protected under EU law¹ which is directly applicable in Ireland. It is also worth noting that there are no differences between the scope of protection of GIs and PDOs, i.e. all registered PDOs and PGIs benefit from the same level of protection in the EU. Currently, there are no national laws that specifically deal with GIs/AOs/PDOs. The Trade Marks Act 1996² sets out under Section 8 that use of a GI is an absolute Ground of Refusal of a trade mark. Also, Chapters 1 and 2 of the Consumer Protection Act 2007³ deal with unfair or misleading commercial law. Irish trade mark law in relation to collective marks and certification marks in addition to laws in relation to passing off/unfair competition also offer remedies for holders of GIs and PDOs.

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 definition of a GI and a PDO are found in art 5 of Regulation 1151/2012. The definition of a PDO here appears to mirror the definition of AOs as per art 2 of the Lisbon Agreement.

¹ REGULATION (EU) No 1151/2012; Regulation (EC) No 110/2008 for spirits and EC Regulation 1234/2007, which incorporates EC Regulation 479/2008 for wine.

² <http://www.irishstatutebook.ie/eli/1996/act/6/section/8/enacted/en/html#sec8>

³ <http://www.irishstatutebook.ie/eli/2007/act/19/enacted/en/html>

According to the EU Commission - "A geographical indication is a distinctive sign used to identify a product as originating in the territory of a particular country, region or locality where its quality, reputation or other characteristic is linked to its geographical origin."⁴

According to the Irish Department of Food, Agriculture and the Marine (the National governing body for GIs/PDOs) - A geographical indication is a sign used on goods that have a specific geographical origin and possess qualities, reputation or characteristics that are essentially attributable to that place of origin. Most commonly, a geographical indication includes the name of the place or origin of the goods.⁵

EUIPO defines a PDO as covering products which are produced, processed and prepared in a given geographical area whose quality or characteristics are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors.⁶

The Irish Department of Food, Agriculture and the Marine state that PDOs are for products with a strong link to the defined geographical area where they are produced.⁷

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.

Protection in the EU is by sui generis laws, also some protection provided through trade mark law/collective/certification trade mark laws, consumer protection law, tort of passing off, counterfeit laws and laws relating to unfair competition and through enforcement by State/public authorities.

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.

Domestic GIs/AOs: There are two different procedures for the registration of a GI in the EU: one applicable to wines, agricultural products and foodstuffs and another one applicable to spirits. The main actors involved in the procedure are applicants (group of producers) and national and European authorities responsible for registration. The group of producers interested in applying for the registration of a European GI name in the EU must follow a procedure that includes two phases, one at the national level and the other at the European level. The whole process can take several years.

⁴ <http://ec.europa.eu/trade/policy/accessing-markets/intellectual-property/geographical-indications/>

⁵ <http://www.agriculture.gov.ie/gi/>

⁶ https://euiipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/observatory/documents/Geographical_indications_report/geographical_indications_report_en.pdf

⁷ <https://www.agriculture.gov.ie/gi/pdopgitsg-protectedfoodnames/>

Once a group of producers has defined its product according to precise specifications, it must send the application for registration of a product name as a GI to its competent national authorities. The national authorities examine the application in order to check that it is justified and meets the conditions in Regulation 1151/2012 (for an agricultural product or a foodstuff) or Regulation 1234/2007 (for a wine). If no objection is raised and the requirements of the regulation are met, the Member State takes a favourable decision. If objection is raised, the Member State considers the admissibility of the objections and decides whether to reject or accept the application. The decision is made public. Then a request from the producers group sent to the European Commission.

After receiving the documents from the Member State, the Commission examines the application. If the Commission considers that the conditions laid down in the Regulations are met, it publishes in the Official Journal of the European Union, the single document of the application and the reference to the publication of the specification (the Member States must provide for an electronic access to the publication of the specification). Where that is not the case, the Commission rejects the registration application.

The publication opens an opposition period during which any Member State or third country may object to the registration, by sending a duly substantiated statement (notice of opposition which must contain a declaration that the application might infringe the conditions laid down in Regulation 1151/2012) to the Commission. Notice of opposition must be followed in two months by a reasoned statement of opposition. The opposition period lasts three months and no consultation between the interested parties is foreseen. Where an objection is admissible for an agricultural product or a foodstuff, the Commission will invite the interested parties to undertake appropriate consultations. If no agreement is reached, the Commission will take a decision and publish it in the Official Journal of the European Union (OJEU).

If no objection is made, the name is registered and entered into the European Register of Protected Geographical Indications and Designations of Origin DOOR database (for agricultural products and foodstuffs) or E-Bacchus database (for wines). The registration is published in the OJEU.

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.

The grounds of invalidity/loss of rights are the same as found under national⁸ and EU trade mark law such as misleading use, becoming generic, non-use during a period of five years, and so on. The validity of a trademark registration can be challenged based on absolute or relative grounds for refusal. The Trade Mark Act 1996 under Section 52 implements Articles 4 and 5 of Directive 2015/2436, which states that trade marks shall not be registered or, if registered, shall be liable to be declared invalid if the:

“(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;

(g) trade marks which are of such a nature as to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or service”⁹.

In Ireland an application can be made by any party to the Controller or the High Court. The burden of proof is on the owner of the GI/AO/GDO for non-use. For becoming generic/has become misleading, the onus of proof is on the applicant for cancellation proceedings.

The test is essentially that the GI/PDO should never have been registered. Grounds for Invalidity must be set out in a written document. Statutory Declarations are used.

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

Art 13 of Regulation 1151/2012 sets out the scope of protection afforded to GIs and AOs/PDOs which generally covers any practice that is likely to mislead the consumer as to the true origin of the product.

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

Art 13 of Regulation 1151/2012 sets out the type of conduct prohibited - protection is against any use of a registered name for a comparable product as well as misuse, imitation, evocation, false or misleading indication and any practice liable to mislead the public as to the true origin of the product, either direct/indirect commercial usage of the name of the product registered, where use becomes false or misleading to consumers as to its origin, packaging of the product, advertising material such that it is likely to mislead the consumer as to its origin. Use that exploits the reputation of the protected name is also protected.

⁸ <http://www.irishstatutebook.ie/eli/1996/act/6/section/52/enacted/en/html#sec52> Section 52 of the Trade Marks Act 1996 sets out grounds for invalidity, implementing Directive 2015/2436.

⁹ <http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32015L2436&from=EN>. Ireland has yet to enact this legislation and must do so by 19 January 2019.

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

The national authority in charge of applications and examinations of PDOs and PGIs in Ireland is the Food Division of the Department of Agriculture and Food, which in turn must notify the Commission. The group holding the registration can seek remedies under civil law. The state can intervene by way of action under criminal law.

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

The same remedies are the same as that for counterfeiting/infringement/passing off and can be both civil such as: injunctions, account of profits, damages, orders for delivery up, disposal, seizure by customs/police; and criminal such as a prison term and/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?

The principle "first in time, first in right" is not automatically applied for GIs in the EU. A GI can be registered and co-exists with an existing trademark if all the GI requirements are met. On the contrary, a trademark cannot be registered if a GI name is already protected. EU Regulation No 1151/2012, Articles 23.3 of Regulation 110/2008 (spirits) and 118k of Regulation 1234/2007 provide that a designation of origin or geographical indication cannot be registered where, in the light of a trademark's reputation and renown and the length of time it has been used, registration is liable to mislead the consumer as to the true identity of the product.

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?

With regard to inspection, any group aiming to produce a PDO or PGI must contact an inspection body. This must certify that the procedures for the production, processing and preparation of a product meets the specifications. The applicants nominate the inspection body. This may be a public body (in some cases the Trading Standards Office) or a private one. The national controlling authority for Irish PGIs and PDOs is the Food Division of the Department of Agriculture and Food, which in turn must notify the Commission.

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.**

GIs should be defined as they are set out under the TRIPs Agreement and AOs/PDOs as under the Lisbon Agreement.

- 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.**

AOs/PDOs and GI registration procedure should be dealt with through collective mark system as this would allow for any conflicts that may arise to be dealt with through trade mark law principles.

- 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 of invalidity/loss of rights should be similar to those already existing in Irish and EU trade mark law.

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

“First in time, first in right”.

- 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?**

They should have the same scope of protection as trade marks as under collective marks and hence the same provisions with regard to protection afforded to domestic/foreigner marks. They should be protected against infringement, passing off and counterfeiting.

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

The relevant public authority nominated under the provisions in the country of origin.

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

No.