



## 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 Malaysia**

**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?

**GIs are protected under Malaysia's laws, by Geographical Indications Act 2000 ("GIA 2000") and the Geographical Indications Regulations 2001 (the "GI Regulations").**

**The definition of GI may be broad enough to cover AOs.**

- 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).

**Geographical Indication is defined in section 2 of the GIA 2000 as "an indication which identifies any goods as originating in a country or territory, or a region or locality in that country or territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to their geographical origin".**

**Section 4 excludes from protection the following:**

- (a) geographical indications that do not correspond to the meaning of "geographical indication" as defined in section 2;**
- (b) geographical indications which are contrary to public order or morality;**
- (c) geographical indications which are not or have ceased to be protected in their country or territory of origin; or**
- (d) geographical indications which have fallen into disuse in their country or territory of origin.**

**There are no separate provisions for AOs.**

- 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.

**GIs are protected by sui generis law, under the GIA 2000 and the GI Regulations.**

- 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.

**[Please refer to Q I(1) of Report Q191]**

**The relevant extracts from Report Q191 are reproduced below:**

**An application for registration of a GI will be granted as long as:**

- a) The GIs correspond with the meaning under the Act as an indication which identifies any goods as originating in a country or territory, or a region or locality in that country or territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to their geographical origin;**
- b) The GI is not contrary to public order or morality;**
- c) The GIs are not or have ceased to be protected in their country or territory of origin;**
- d) The GIs have not fallen into disuse in their country or territory of origin.**

**Where no opposition have been filed or no appeal to High Court has been filed against the Registrar's decision, then the Registrar shall register the GI and issue to the applicant a certificate of registration.**

**Further to the Q191 report, please note that the application for registration is provided for in the GI Regulations. Regulation 6(1) provides that the registration shall be made on Form GI 1 accompanied by a copy of statutory declaration by the applicant and the prescribed fee.**

**Form GI1 further requires information of the following:**

- a) **Personal Information of the Applicant**
- b) **The Geographical Area**
- c) **The Goods and Description of the Product**
- d) **Quality, Reputation or other characteristic**
- e) **Proof of Origin**
- f) **Causal Link between the GI Area and a specific quality, the reputation or other characteristics of the product**
- g) **Specific Steps in Production that must take place in the identified geographical area**

**In respect of the possibility of opposition by third parties, [please refer to Q I (3) of Report Q191]. The relevant extracts from Report Q191 are reproduced below:**

**It is possible to oppose such an application or to cancel the registration of a GI. Section 14 of the Act provides that any interested person may within two months from the date of such advertisement file an opposition against the registration of the GI based on the following grounds:**

- The GI does not fall within the meaning of the definition of “geographical indication” under this Act;**
- The GI is contrary to public order or morality;**
- The GI is not or has ceased to be protected in its country of origin; or**
- The GI has fallen into disuse in its country of origin.**

**The Act expressly provides that it does not apply to GIs which are identical with the term customary in common language as the common name for such goods or services in Malaysia or GIs for products of the vine which are identical with the customary name of a grape variety existing in Malaysia as of 1 January 1995. Therefore, it would follow that any interested person may also oppose an application for such GIs.**

- 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.

**[Please refer to Q I (3) and (4) of Report Q191]**

**The relevant extracts from Report Q191 are reproduced below:**

**Section 22 of the GIA provides that the Registrar may, on request of any interested person:**

- **Cancel the registration of a GI on the ground that the GI does not qualify for protection as the same:**
  - o **Does not correspond to the meaning of GI as defined in section 2 of the Act;**
  - o **Is contrary to the public order and morality**
  - o **Is not or has ceased to be protected in its country or territory of origin;**  
**or**
  - o **Has fallen into disuse in its country or territory of origin**
- **Rectify the registration of a GI on the ground that the geographical area specified in the registration does not correspond to the GI, or that the indication of the products for which the GI is used or the indication of the quality, reputation or other characteristic of such products is missing or unsatisfactory**

Further to the Report Q191, it is to be noted that the GIA 2000 does not explicitly provide for who bears the burden of proof. However section 22(2) provides as follows:

*The persons who request for the cancellation or rectification of the registration of the geographical indication shall give notice to the applicant who filed the application for registration of the geographical indication or his successor in title.*

It appears that the burden would lie on the person requesting the cancellation or rectification.

Section 22(3) further provides that the Registrar shall within two months after making a decision to cancel the registration of a GI prepare his grounds of decision in writing.

Any person aggrieved by the decision of the Registrar has the right to appeal to the Court.

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

**[Please refer to Q I (5) of Report Q191]**

**The relevant extracts from Report Q191 are reproduced below:**

**Section 5 of the Act provides for four broad circumstances whereby any interested person may institute proceedings in the Court to prevent any of the following:**

- **the use in the course of trade of any means in the designation or presentation of any goods that indicates or suggests, in a manner which misleads the public as to the geographical origin of the goods, that the goods in question originate in a geographical area other than the true place of origin;**
- **any use in the course of trade which constitutes an act of unfair competition within the meaning of Article 10 bis of the Paris Convention;**

- any use in the course of trade of a GI which, although literally true as to the country, territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another country, territory, region or locality; or
  - any use in the course of trade of a GI identifying wines for wines not originating in the place indicated by the GI in question or a GI identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the wines or spirits is indicated or the geographical indication is used in translation or accompanied by expressions such as “kind”, “type”, “style” or “imitation”.
- 6) Against what kind of conduct are GIs/AOs protected? For example, against use misleading consumers, parasitism and free riding.

**The conducts where GIs are protected under the GIA are provided for under Section 5 GIA 2000 as set out in Question (5) above.**

**Generally, the GIA 2000 protects against conduct of misleading consumers, unfair competition and false representation.**

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

**[Please refer to Q I (2) of Report Q191]**

**The relevant extracts from Report Q191 are reproduced below:**

**The following persons (“interested person”) may apply for registration of a GI:**  
 – A person who is carrying on an activity as a producer in the geographical area specified in the application with respect to the goods specified in the application, and includes a group or groups of such persons. A producer in this case can refer to

- a) any producer of agricultural products;
- b) any person exploiting natural products;
- c) any manufacturer of products of handicraft or industry; or
- d) any trader dealing in any of the products mentioned in paragraphs a), b) or c).

– A competent authority (in this case referring to any government or statutory body carrying out the functions of, or on behalf of, or sanctioned by, the Government); or

– A trade organization or association.

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

**[Please refer to Q I (5) of Report Q191]**

**The relevant extracts from Report Q191 are reproduced below:**

**The Court may grant an injunction to prevent any unlawful use of the geographical indication and award any damages and any other legal remedy or**



**relief as it deems fit.**

- 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?

**[Please refer to Q I (10) of Report Q191]**

**The relevant extracts from Report Q191 are reproduced below:**

**GI will always prevail over trade marks under the Act, however Section 28(2) of the Act provides for an exception, namely:**

**“Where a trade mark has been applied for or registered in good faith, or where rights to a trade mark have been acquired through use in good faith either**

**a) before the commencement of this Act; or**

**b) before the GI is protected in its country of origin,**

**this Act shall not prejudice the registrability or the validity of the registration of the trade mark or the right to use the trade mark on the basis that such a trade mark is identical with or similar to a GI.”**

**Based on the foregoing, trade marks that have been applied for or registered or used in good faith prior to the commencement of the Act, or before the GI is protected in its country of origin can co-exist with the GI.**

**As yet, the court has not had the opportunity to deal and address conflicts of this nature.**

**Section 28 of the Geographical Indications Act 2000 however provides for exceptions to trade marks which had been in continuous use before 15 April 1994 (for wines or spirits), or where marks had been applied/registered or use before the commencement of the Act (i.e.15 August 2001) or before the protection of the geographical indication in the country of origin:**

**“(1) Nothing in this Act shall prevent continued and similar use in Malaysia of a particular geographical indication of another country identifying wines or spirits in connection with goods or services by any nationals or domiciliaries of Malaysia who have used that geographical indication in a continuous manner with regard to the same or related goods or services in Malaysia either**

**a) for at least ten years before 15 April 1994; or**

**b) in good faith before 15 April 1994.”**

**“(2) Where a trade mark has been applied for or registered in good faith, or where rights to a trade mark have been acquired through use in good faith either**

**a) before the commencement of this Act;or**

**b) before the geographical indication is protected in its country of origin, this Act shall not prejudice the registrability or the validity of the registration of the trade mark, or the right to use the trade mark, on the**

**basis that such a trade mark is identical with or similar to a geographical indication.”**

- 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?

**An application for registration of GI is filed at the Central Geographical Indications Office Malaysia (“CGIOM”) and the application is made to the Registrar of Geographical Indications of the Intellectual Property Division of the Intellectual Property Corporation of Malaysia.**

**The CGIOM at the Registrar of the Geographical Indications of the Intellectual Property Division of the Intellectual Property Corporation of Malaysia will only verify the application to ensure that it complies with the statutory requirements and formalities of the GIA 2000 and GI Regulations.**

- 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.

**Countries should have a harmonised definition of AOs and GIs to ensure uniform protection and understanding in today’s cross-border trade and globalisation environment. However, instead of having to adopt a new definition and prerequisite, the current TRIPS Agreement already provides for the basic international regulatory framework for GIs. Therefore, any definitions of GIs should be consistent with the one in the TRIPS Agreement.**

**Similarly, any definition of AO’s should be consistent with the definition provided**

**for in the WIPO 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.

**[Please refer to Q II (11) of Report Q191]**

**The relevant extracts from Report Q191 are reproduced below:**

**Countries should provide for registration systems dealing specifically with GIs. However, failure to register a GI in a country should not be a legal bar to the enforcement of the same as long as evidence can be adduced to prove that such GI exists in its country of origin.**

**Yes. Ultimately, this goes back to consumer's rights. If a GI is misdescriptive of the goods/services provided/rendered, consumers will be misled and deceived into believing that the use of the term on goods/services had connection with the place so identified.**

**However, failure to register a GI in a country should not be a legal bar to the enforcement of the same as long as evidence can be adduced to prove the existence of such GI in its country of origin.**

**Further to the Report Q191 as above, the key features should include providing for the person who may apply for registration, the process for verification and examination of the GI by competent bodies, opposition by third parties and the scope of protection provided by the registration.**

**The content of the application should include details of the geographical area, the goods and description of the product, quality, reputation, proof of origin, the causal link between the GI area and a specific quality, the reputation or other characteristics of the product. This will allow the application to be properly examined and verified by the relevant authorities.**

**There should also be a procedure for opposition by third parties in cases circumstances where it is contrary to the public order and morality, is not or has ceased to be protected in its country or territory of origin or has fallen into disuse in its country or territory or origin**

- 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 for GIs are:**

- The GI does not correspond to the meaning of GI as defined in section 2 of the Act**
- Is contrary to the public order and morality**

- Is not or has ceased to be protected in its country or territory of origin; or
- Has fallen into disuse in its country or territory of origin

The applicable test and the way it should be proven should be a matter of practice in which the relevant authorities should provide the relevant guidelines and manual. The party challenging the validity of the GIs should bear the burden of proof.

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

**[Please refer to Q II (14) of Report Q191]**

**The relevant extracts from Report Q191 are reproduced below:**

**GIs should prevail over trade marks except where such trade marks are used or registered in good faith before the GI is protected in its country of origin. Under these circumstances, such trade marks should be allowed to co-exist with the GIs only in countries where such conflict arises.**

**Conflicts between trade marks and GIs may be resolved via an ex officio examination of protectability of the trade mark/GI in the country of origin with an opportunity for opposition by third parties and an ability to challenge the decision of the Registrar or relevant authority at the national courts.**

**In Malaysia, the Geographical Indications Act seeks to resolve the conflicts between trade marks and GIs by the application of the “first in time” principle. S. 28(2) of the Geographical Indications Act 2000 provides as follows:**

- “(2) Where a trade mark has been applied for or registered in good faith, or where rights to a trade mark have been acquired through use in good faith either**
- a) before the commencement of this Act; or**
  - b) before the geographical indication is protected in its country of origin, this Act shall not prejudice the registrability or the validity of the registration of the trade mark, or the right to use the trade mark, on the basis that such a trade mark is identical with or similar to a geographical indication”.**

**We are of the view that co-existence should be based on the principles of territoriality, exclusivity and priority.**

- 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 GIs/AOs should be the right to use the GI/AO to prevent its use by a third party whose product does not conform to the standards. It should not matter if the GIs/AOs are domestic or foreign.**

**Conducts which should be protected against are:**

- a) the use in the course of trade of any means in the designation or presentation of any

goods that indicates or suggests, in a manner which misleads the public as to the geographical origin of the goods, that the goods in question originate in a geographical area other than the true place of origin;

b) any use in the course of trade which constitutes an act of unfair competition within the meaning of Article 10 bis of the Paris Convention;

c) any use in the course of trade of a GI which, although literally true as to the country, territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another country, territory, region or locality; or

any use in the course of trade of a GI identifying wines for wines not originating in the d) place indicated by the GI in question or a GI identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the wines or spirits is indicated or the geographical indication is used in translation or accompanied by expressions such as “kind”, “type”, “style” or “imitation”.

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

**[Please refer to Q II (13) of Report Q191]**

**The relevant extracts from Report Q191 are reproduced below:**

**Protection of GIs should be made available to interested parties, whether they are individuals, trade organizations or a competent authority. Producers carrying on their activity in the geographical area specified by the GI should have a right to use the GI in the course of trade and in respect of the goods in accordance to the quality, reputation or characteristics specified.**

**The appropriate remedies would be injunctions and damages.**

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

**No, there should not be a specific provision or practice concerning the inclusion of GI/AO in a domain name.**

**As of now, there exists no uniform harmonization of GIs law in the international level yet. To include protection to GIs through the Uniform Domain-Name Dispute-Resolution Policy without a complete harmonization of the law would make the implementation inconsistent and ineffective.**

## **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.

