



## 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 New Zealand**

**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?

New Zealand law does not recognise “appellations of origin”.

Geographical indications are currently protected under New Zealand law primarily through the following:

- Fair Trading Act 1986
- Trade Marks Act 2002
- Common law tort of passing off.

New Zealand also has the Geographical Indications (Registration of Wines and Spirits) Act 2006 (the “Geographical Indications Act”). This Act is not currently in force. However, Regulations have recently been drafted and the Act is expected to enter into force in the next 6 months.

- 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).

A “geographical indication” is defined in the soon to be implemented Geographical Indications Act as:

A **geographical indication** is an indication that identifies a wine or spirit as originating in the territory of a country, or a region or locality in that territory, where a given quality, or reputation, or other characteristic, of the wine or spirit is essentially attributable to its geographical origin.

Under New Zealand’s other law that provides protection for geographical indications, no definition of geographical indication is given. The laws operate to protect geographical indications in accordance with TRIPS, but do not differentiate between geographical indications and other signs.

- 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 Geographical Indications Act provides sui generic laws for the protection of geographical indications.

Some geographical indications, such as Napa Valley, have been registered as trade marks, particularly certification marks. However, the trade marks legislation does not specifically recognise these as “geographical indications”.

The Fair Trading Act provides protection against misleading or deceptive behaviour in trade generally, and so includes the geographic mislabelling.

The common law of passing off protects against misrepresentations, and has been successfully utilised in New Zealand by the Champagne producers to stop the use of ‘Champagne’ on non-French wine.

- 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.

Once brought into force, the Geographical Indications Act will provide a sui generis registration system for wine and spirit geographical indications. According to the current Act and draft Regulations that we have seen:

- The Act contains three parts: 1) enduring GIs (being North Island, South Island, New Zealand) 2) GIs registered as a consequence of an international agreement 3) GIs registered according to an application process.

- The application process is open to New Zealand and foreign GIs.
- The application can be filed by any “interested party”.
- The filing requirements for each GI (NZ or foreign) are slightly different because the objectives are slightly different.
  - o For foreign GIs, the main examination objective is to ensure compliance with the laws of its origin and that it meets the definition of “geographical indication” in the Act.
  - o For New Zealand geographical indications, the objective is to ensure recognition as a geographical indication should be conferred. The applicant is required to submit information about why a geographical indication meets the definition in the Act, the proposed boundaries, and any conditions on registration.
- Substantive examination of the proposed geographical indication will occur. Registration will not be allowed if the proposed geographical indication falls within one of the exceptions in the Act, which largely reflect the exceptions in the TRIPS agreement around genericism and protection in its home country.
- If accepted by the Intellectual Property Office (IPONZ) for registration, the proposed geographical indication will be the subject of a 3 month opposition period in which third parties will be given the opportunity to oppose.

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.

Under New Zealand's current laws, protection for geographical indications is often dependent upon its reputation in the market. The Fair Trading Act and common law tort of passing off both rely on an aggrieved party being able to show some reputation in the sign (the geographical indication) that results in deception or misrepresentation through another's use.

Under New Zealand's proposed Geographical Indications Act, there are grounds to remove a geographical indication for non-payment of renewal fees, because it is no longer protected in its home country, because it should not have been registered on grounds such as genericism, or because it has become generic. Application can be

made to the Intellectual Property Office of New Zealand. However, the details of how this will work are still being worked through.

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

All geographical indications are protected under New Zealand law.

Wine and spirit geographical indications will be able to be registered under the proposed Geographical Indications Act. The Act provides a level of protection consistent with Article 23 of TRIPS.

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

All geographical indications are protected against use that misleads or deceives consumers.

Geographical indications protected by the tort of passing off are protected against misrepresentations.

Geographical indications protected by trade mark law are protected against confusingly similar use.

Wine and spirit geographical indications registered under the proposed Geographical Indications Act will be protected against misleading use, regardless of whether the true origin of the goods is identified, whether the geographical indication is used in translation, and whether it is accompanied by words such as “kind”, “style” or “imitation”.

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

An “interested person” will have standing to register a geographical indication under the proposed Geographical Indications Act. There is no definition given for ‘interested person’ in the Act, but ‘person’ is defined in the Act as including the government of a country, a corporation sole, an incorporated or unincorporated body or person, and any association or combination of individual persons or incorporated or unincorporated persons. IPONZ’s expectation is that most applicants will be individual producers or consortiums.

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

The Geographical Indications Act interplays with the Fair Trading Act 1986 for the remedies available for the misuse of a registered geographical indication.

A breach of the regulations under the Geographical Indications Act is considered a breach of section 9 of the Fair Trading Act 1986. Section 9 of the Fair Trading Act 1986 imposes civil liability, with the remedies available including injunctions to prevent further contravention, orders to publish corrective statements, and damages.

- 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?

Under the proposed Geographical Indications Act, the general first-in-time, first-in-right principle applies. Coexistence may be allowable if consent is given by the trade mark owner, or the Registrar otherwise deems it reasonable.

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

No.

- 11) Is there anybody that administers GIs/AOs in your country and/or is responsible for the verification of compliance of goods bearing a GI/AO? Please briefly describe the relevant processes, e.g. the process by which compliance with product specifications is verified before such goods are put on the market and/or the subsequent market controls on such goods?

The Intellectual Property Office of New Zealand (IPONZ) will administer the registration process for wine and spirit geographical indications once the Geographical Indications Act is in force. There are rules around the use of geographical indications, but no specific administrator responsible for ensuring the verification of compliance of goods bearing a geographical indication. There are grounds under the Geographical Indications Act and other consumer law to take action against mislabelled geographical indications.

- 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.

Geographical indications are mentioned in some trade agreements. No changes to domestic legislation have been required. The general approach of the New Zealand negotiators has been to encourage good and transparent processes for the protection of geographical indications, in a manner consistent with TRIPS.

## **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.

TRIPS provides a harmonised definition of geographical indication.

- 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.

TRIPS provides flexibility in how WTO member countries provide protection for geographical indications.

Any registration system for geographical indications would ideally provide a process to allow interested third parties the right to be heard and the opportunity to oppose if they so wish.

- 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.

TRIPS has exceptions for the protection of geographical indications.

If the geographical indication is no longer used, protection should not be afforded to it.

If the geographical indication is generic or becomes generic without any resistance on the part of interested parties, protection should not be afforded to the geographical indication.

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

We expect that it would be very unusual for rights of this nature to be in conflict.

If it were to occur, the existing right should be respected.

In some instances, the registration on both, provided consumers are not misled, may be justifiable.

- 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?

TRIPS provides adequate scope for the protection of geographical indications. We are not aware of any evidence to the contrary.

Countries should not discriminate protection of foreign geographical indications.

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

An interested party should be able to protect their geographical indications.

An injunction and some form of relief are appropriate remedies.

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

If the issue creates confusion among consumers then this may be justified. In many instances, the geographical indication will also be a place name. So the instances of obvious cyber-squatting may be harder to determine.

### **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.