



# **MAIN FEATURES OF MALAYSIA'S GEOGRAPHICAL INDICATIONS ACT 2022**

**11 November 2022**

**Intellectual Property Corporation of Malaysia (MyIPO)**



# GEOGRAPHICAL INDICATIONS

# GEOGRAPHICAL INDICATIONS (GI)

*“Geographical indication” means an indication which may contain one or more words 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 its geographical origin (Ref: Section 2)*

*Based on Art. 22.1 of Trade-Related Aspects of Intellectual Property Rights (TRIPs)*

*“... indications which identify a good as originating in the territory of a member, 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”*

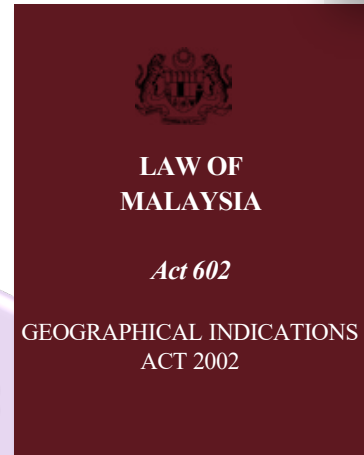
# GEOGRAPHICAL INDICATIONS

## PROTECTION FOR GI

- Protection is given upon fulfilling three components:
  - AN INDICATION
  - GEOGRAPHICAL LOCATION
  - GOODS - the quality / reputation / character of the goods is attributable to its geographical origin

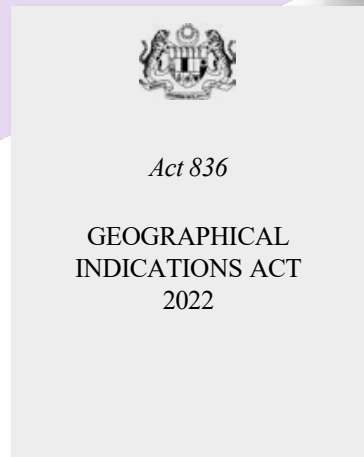
# **HISTORICAL BACKGROUND OF GEOGRAPHICAL INDICATIONS ACT 2022**

# HISTORICAL BACKGROUND OF GEOGRAPHICAL INDICATIONS LAW IN MALAYSIA



## GEOGRAPHICAL INDICATIONS ACT 2000

- Passed by the Parliament in 2000
- Contained 7 Parts, 32 sections and 1 Schedule
- Authoritative Text was in Bahasa Malaysia
- Came into force on 15 August 2000



## GEOGRAPHICAL INDICATIONS ACT 2022

- Act 602 was repealed and replaced by Act 836
- Contains 15 Parts, 101 Sections and 1 Schedule
- Tabled and passed by the Parliament in December 2021
- Came into force on 18 March 2022
- Subsidiary legislations: Geographical Indications Regulations 2022, Guidelines of Geographical Indications 2022
- Authoritative Text is in Bahasa Malaysia

# RATIONAL AND MAIN OBJECTIVES TO REPEAL THE GIA 2000

1. Strengthen the geographical indications protection system according to international and local development and needs
2. Expand the scope of protection of GI in Malaysia
3. Introduce new and comprehensive internal procedures in the Geographical Indications Office
4. Introduce provisions of offences and criminal jurisdiction to enforce the rights obtained under the act and expand the scope of civil action
5. Expand the level of protection given to registered geographical indications in Malaysia
6. Refine the procedures of filing application for registration of geographical indications including examination, opposition proceeding, registration and cancellation procedures

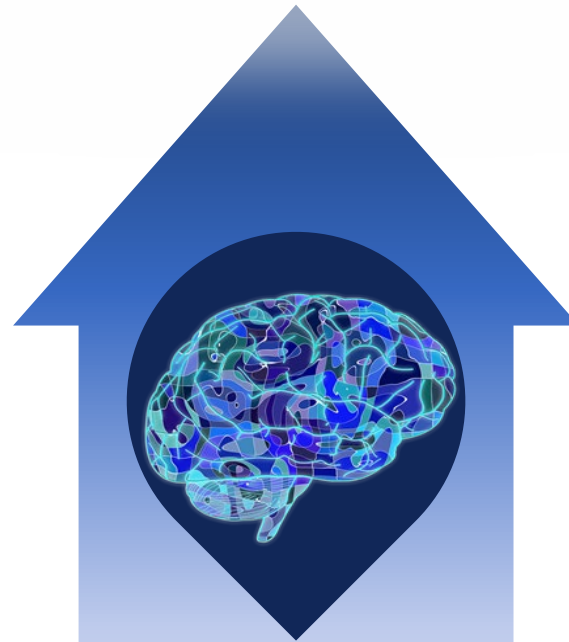
# NEW FEATURES OF GIA 2022



# THE GEOGRAPHICAL INDICATIONS ACT 2022



• **NEW**



• **COMPREHENSIVE**



• **EASY**

# THE GEOGRAPHICAL INDICATIONS ACT 2022

DATE OF COMING INTO  
FORCE :

**18 MARCH 2022**

□ **Related subsidiary legislations:**

- The Geographical Indications Regulations 2022
- The Guidelines of Geographical Indications 2022

# CATEGORIES OF GOODS LISTED UNDER THE FIRST SCHEDULE OF THE GGI 2022

## Class 1:

Wine and Spirit:

Wine

Spirit

## Class 2:

Prepared foodstuff and beverages:

Coffee

Tea

Cocoa

Beer

Rice

Bread

Pastries

## Class 2:

Confectionery

Chocolate

Salt

Spices and condiments

Preserved herbs

Edible oils

Sugar

Sweetener

# CATEGORIES OF GOODS LISTED UNDER THE FIRST SCHEDULE OF THE GGI 2022

## **Class 3:**

Agricultural, aquacultural, horticultural products:

Vegetable

Vegetable product

Fruit

Fruit product

Meat

Meat product

Horticultural comestible product which is prepared for consumption

Raw and unprocessed grains

Raw and unprocessed seeds

Flowers and part of flowers

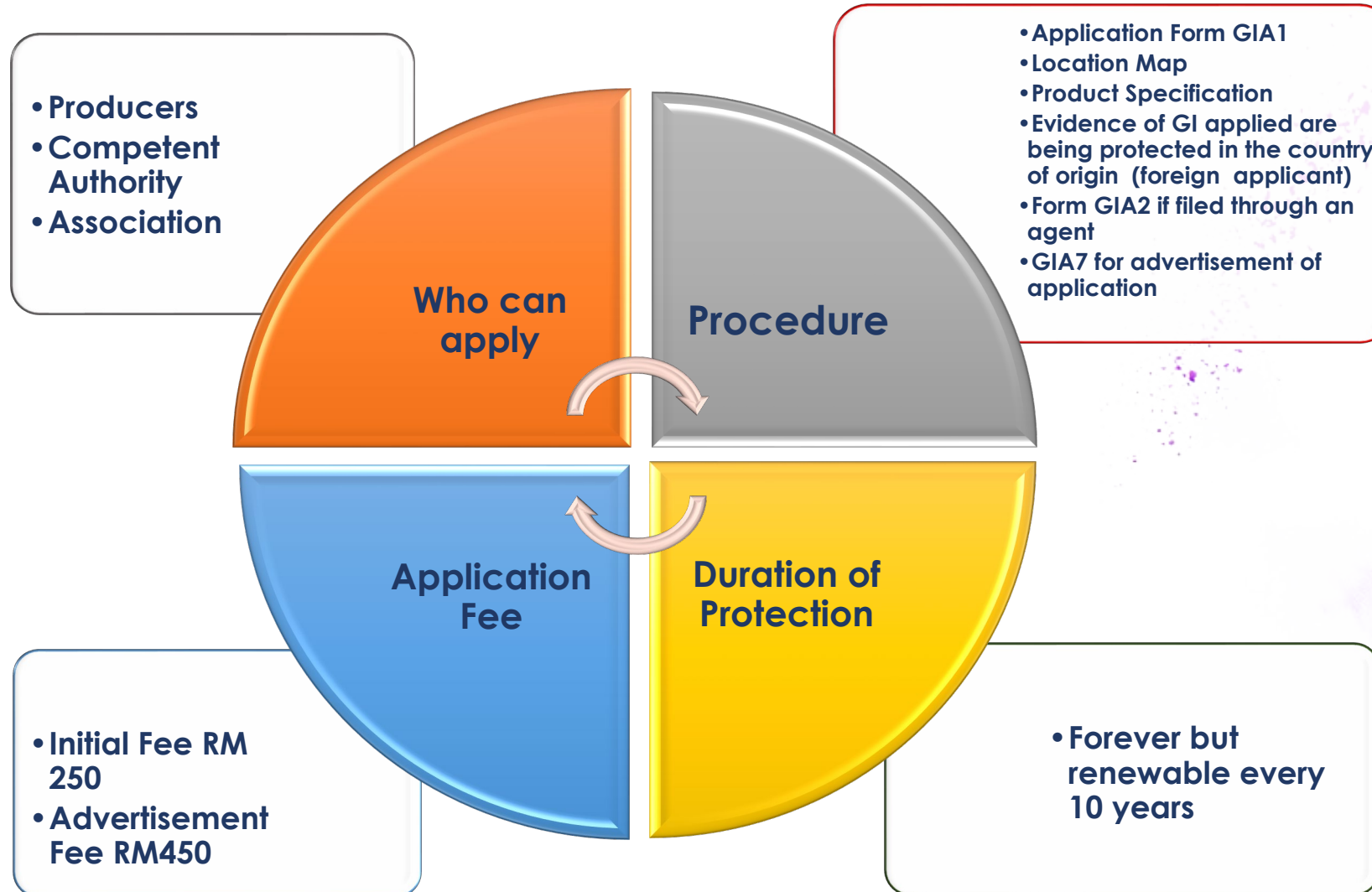
## **Class 4:**

Handicraft

## **Class 5:**

Textiles (other than handicraft)

# APPLICATION SYSTEM



# VARIANT OF GI

- ✓ Introduced registration of variant of Geographical Indication
- ✓ Translation, transliteration or other variant of the indication are accepted as GI
- ✓ Application of variant requires different application form

# HOMONYMOUS GI

- ✓ Accept registration of homonymous GI for goods other than wine
- ✓ Registration is allowed provided there are practical conditions differentiating the homonymous GI from the earlier registered GI

# EXAMINATION – GROUNDS FOR REFUSAL OF REGISTRATION

## Grounds for refusal of registration of geographical indication

**10.** (1) The Registrar shall refuse to register a geographical indication if—

- (a) the geographical indication does not correspond to the meaning of “geographical indication” as defined in section 2;
- (b) the geographical indication identifies goods that do not fall within any of the categories of goods as determined by the Registrar;
- (c) the geographical indication consists exclusively of an indication which is identical with the term customary in the common language as the common name of any goods in Malaysia if registration is sought in relation to the goods;
- (d) the geographical indication is contrary to public order or morality;
- (e) the geographical indication is not or has ceased to be protected in its country or territory of origin;
- (f) the goods does not originate in the country, region or locality indicated in the application for the registration of geographical indication; or
- (g) the geographical indication in relation to the goods is of such a nature which may mislead the public as to the true place of origin of the goods.

(2) Subject to section 11, the Registrar shall refuse to register a geographical indication if there exists a likelihood of confusion on the part of the public because the geographical indication is identical with or similar to, and has the same geographical origin as, an earlier geographical indication.

(3) The Registrar shall not register a geographical indication if there exists a likelihood of confusion on the part of the public by reason the geographical indication is identical with or similar to a trademark if the trademark fulfils any of the following conditions:

(a) the trademark is a registered trademark or protected international registration designating Malaysia, and taking into account, where appropriate, the priorities claimed in respect of the trademark under the Trademarks Act 2019 where—

(i) the application for the registration of the trademark was made in good faith; or

(ii) the trademark was registered in good faith,

under the Trademarks Act 2019 or any previous written law relating to trademarks before the date of application for registration of the geographical indication in Malaysia; or

(b) the trademark has been used in good faith in Malaysia in the course of trade before the date of application for registration of the geographical indication in Malaysia.

## EXAMINATION - GROUNDS FOR REFUSAL OF REGISTRATION (CONT.)

(4) The Registrar shall refuse to register a geographical indication that is identical with or similar to a trademark if—

- (a) before the date of application for registration of the geographical indication, the trademark is a well-known trademark in Malaysia; and
- (b) the registration of the geographical indication is liable to mislead consumers as to the true identity of the goods identified by that geographical indication.

(5) Notwithstanding subsections (3) and (4), the Registrar may, in his discretion, register any geographical indication referred to in subsection (3) or (4), if the proprietor of the trademark referred to in subsection (3) or (4), as the case may be—

- (a) consents to the registration; or
- (b) fails to file a notice to the Registrar of his opposition to the registration in accordance with subsection 16(1).

(6) For the purposes of this section—

- (a) a reference to a geographical indication includes a variant of the geographical indication; and
- (b) a refusal of registration under this section of any variant of a geographical indication does not prevent the registration of any other variant of the geographical indication if that variant satisfies the requirements of this Act.



# REVOCACTION BY REGISTRAR

- ✓ Registrar may revoke the acceptance of GI before registration if:-
  - (a) the application for the registration of GI has been accepted in error;
  - or
  - (b) special circumstances of the case namely :-
    - (i) The GI should not have been registered
    - (ii) The GI should be registered with additional or different condition or limitation

## **PUBLICATION OF GEOGRAPHICAL INDICATION**

- ✓ Under GIA 2000, accepted GIs were published in the Government Gazette
- ✓ Under GIA 2022, accepted GIs are published under an in-house publication system known as Intellectual Property Official Journal (IPOJ)

## **OPPOSITION TO APPLICATION FOR REGISTRATION**

- ✓ Additional grounds of Oppositions are introduced under GIA 2022

# CANCELLATION OF GI BY COURT

- ✓ The registration of GI may be cancelled on the following grounds:
  - (a) The GI was registered in breach of Sect. 10 of GIA 2022
  - (b) The registration was obtained fraudulently or by misrepresentation
  - (c) The GI has fallen into disuse or has ceased to be protected in its country or territory of origin
  - (d) There has been a failure by a registered proprietor to maintain, in Malaysia, any commercial activity or interest in relation to the GI, including commercialization, promotion or market monitoring
  - (e) In consequence of (d) above, the GI has become a common name of the goods in Malaysia

## **VOLUNTARY CANCELLATION OF GI**

- ✓ This provision allows a registered proprietor to cancel his registration by filing a form as determined by the Registrar

## **TRANSFER OF REGISTRATION OF GI**

- ✓ This provision allows a registered proprietor to transfer the rights of his registered GI to another person

# GROUNDS TO INSTITUTE PROCEEDINGS AGAINST CERTAIN USES OF GI

- ✓ Introduced under GIA 2022
- ✓ The grounds are specified under section 77

## PROVISIONS ON “OFFENCES”

- ✓ No provision on offences or criminal jurisdiction under GIA 2000
- ✓ The introduction under GIA 2022 will empower the Assistant Controller to enforce the rights of registered proprietor

## **RENEWAL OF GEOGRAPHICAL INDICATION**

- ✓ The renewal procedures under GIA 2022 are more structured

## **REGISTRATION SYSTEM FOR GI AGENTS**

- ✓ Introduced new registration system for GI Agents
- ✓ To ensure high level of quality service is rendered to their clients

# FEES

- ✓ Fees are as prescribed in the Second Schedule of the Geographical Indications Regulations 2022
- ✓ Existing fees are maintained except for renewal fee of registered geographical indications agent
- ✓ New fees are introduced for the new proceedings

The background of the slide is white with decorative particle trails in shades of purple and blue. One trail starts from the top left and curves downwards towards the center. Another trail starts from the bottom right and curves upwards towards the center. A solid purple horizontal line runs across the bottom of the slide.

**THANK YOU!**