

ISSUES AFFECTING THE PROTECTION AND ENFORCEMENT OF GEOGRAPHICAL INDICATIONS (GIs)

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ISSUES AFFECTING THE PROTECTION AND ENFORCEMENT OF GI

- Co-existence with prior trade marks
- Control of GIs to ensure quality
- Enhancing the level of GI protection

WHAT IS A GI?

WORLD INTELLECTUAL PROPERTY ORGANISATION (WIPO):

GI is a sign used on products that have a specific geographical origin and possess qualities or a reputation that are due to that origin. In order to function as a GI, a sign must identify a product as originating in a given place.

MALAYSIAN GEOGRAPHICAL INDICATIONS ACT 2022:

“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.

EXAMPLE:



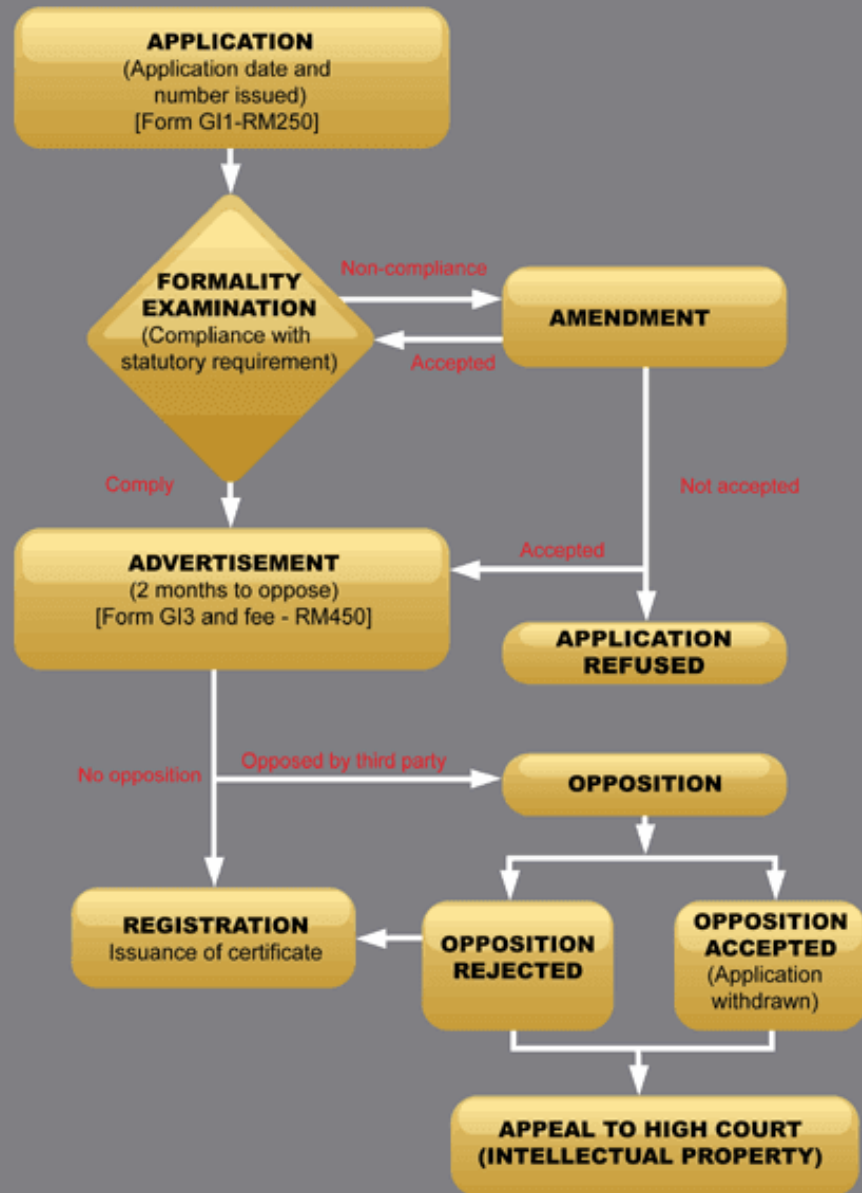
Sarawak Pepper; geographical indication that the pepper is produced in Sarawak



Champagne; originates from a French region named “Champagne” itself which is located 90 miles northeast of Paris

APPLICATION FOR A GI

- Section 8(1) of GIA 2022: “Any person” may file an application for registration of a GI
 - Section 8(5): “Person” refers to
 - (a) any person who is carrying on an activity as a producer in the geographical area with respect to the goods and include an association of such persons; or
 - (b) a competent authority
- An application for registration shall be filed with the Intellectual Property Corporation of Malaysia (MyIPO) GI Form 1 to GI Form 19, which includes, inter alia:
 - (1) an identification of the applicant and the capacity in which the applicant seeks registration;
 - (2) the geographical indication;
 - (3) the geographical area to which the GI applies;
 - (4) the goods for which the GI applies; and
 - (5) the quality, reputation or other characteristic(s) of the goods.
- An official filing fee is payable.



* Kindly refer to Geographical Indications Regulations for detail procedures

Upon examination and being satisfied the GI qualifies for registration, the Registrar shall cause the application to be advertised, for which an official fee is payable. Within two months of the date of advertisement, any interested person may oppose the Registration. The Registrar shall then decide the opposition, and either refuse or register the GI. In the case of registration, a certificate is issued. A registered GI is given 10 years of protection from its date of filing and is renewable for every 10 years.

(Source: MyIPO)

PROTECTION OF GI

- The GIA 2022 provides specifically provisions pertaining to protection of GI: **Part XII, Section(s) 77 & 78**
- A protection of GI encompasses, **regardless whether or not the geographical indication is registered as against another geographical indication** 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.
- BENEFITS OF REGISTERING A GI:
 - Section 25: a registered proprietor of a GI has the right to use and authorise other persons to use the GI. The registered proprietor may also institute criminal or civil proceedings
 - Section 27: A registration of a GI is prima facie evidence of anything contained in the Register
 - Section 18: A registered geographical indication is given ten years of protection from the date of filling and is renewable for every ten years.

CONTROL OF GI TO ENSURE QUALITY

- A GI products/goods rely heavily on their geographical origin for their particular qualities.
 - Regulation 3(1)(f): The quality, reputation or other characteristics of the goods, as the case may be, is essentially attributable to the place from which the goods originate
- In Malaysia, a quality of a good is heavily assess and examined before allowing to be registered as a GI.
 - Regulation 5(1): It requires the application for GI to provide the details of the quality, reputation or other characteristics of the goods in the application for registration of GI
- A certificate of registration that is issued would contain, pursuant to Regulation 12(4)(g) - the demarcated geographical area, the name and address of the person in whose name the GI is registered, the concerned goods, the quality, reputation and other characteristics of the goods and any conditions for use etc.

CO-EXISTENCE WITH PRIOR TRADEMARK (TM)

- In the GIA 2022, one of the grounds under Section 10, for a Registrar to refuse the registration of a GI, is that there is deemed to exist a likelihood of confusion on part of the public between a GI and TM. However, the refusal is subject to the TM fulfilling any of the following condition:
 - TM is a registered TM or protected international registration designating Malaysia before date of application for registration of the GI, taking into account priorities claimed under the Trademarks Act 2019 (“TMA 2019”) i.e., application for registration of TM made in good faith or TM registered in good faith
 - TM has been used in good faith in Malaysia in the course of trade before date of application for registration of the GI in Malaysia
 - TM is a well-known TM in Malaysia, before the date of application for registration of GI
 - The registration of GI is liable to mislead consumers as to the true identity of the goods identified by that GI

TRADEMARKS ACT 2019

REFUSAL OF REGISTRATION OF TRADEMARKS IN RELATION TO GI:

- Section 23(4)(b): the Registrar shall refuse to register the following as a trademark if the trademark contains or consists of recognized geographical indications.
- Section 23(5)(b): the Registrar shall refuse to register a trademark if it is of such a nature as to deceive or mislead the public as to the nature, quality or geographical origin of the goods or services.
- Section 46(1)(d): the registration of a trademark may be revoked by the Court on an application by an aggrieved person where in consequence of the use of the trademark by the registered proprietor or with his consent in relation to the goods or services for which the trademark is registered, it is liable to mislead the public, including in respect of the nature, quality or geographical origin of those goods or services.

THE AGRICULTURAL AND PROCESSED FOOD PRODUCTS EXPORT DEVELOPMENT AUTHORITY OF INDIA (APEDA) & ORS v SYARIKAT FAIZA SDN BHD [2011] 2 MLJ 768

- It was the view of the Court that the applicant's had the locus standi to file the present action under s.45(1)(a) of GIA 2000 as "any person aggrieved" for the following reasons:
 - The first applicant is tasked with, among others, the development of the Indian rice industry and promotion of rice grown in India.
 - The second applicant is responsible for developing the PONNI rice variety, and is the author of the PONNI mark, and the third, fourth and fifth applicants are all stake, holders in the PONNI mark.
 - Trade Mark Registration No 00007172 grants exclusive rights to the Defendant to the use of the PONNI as a trademark and could and would affect the ability of the first applicant to develop and promote the Indian rice industry in Malaysia and elsewhere and the exclusive rights granted to the Defendant for the use of PONNI as a trademark in Malaysia could and would affect their ability to distribute and/or otherwise trade in PONNI rice in Malaysia and elsewhere.

- The Court was also of the view:
 - 'PONNI' was directly descriptive of a particular variety of rice originating from the Tamil Nadu Region in Southern India. The word PONNI, as on 6 June 2000, had become known as the name of a variety of rice from Tamil Nadu
 - PONNI rice had a meaning at the time the Defendant filed its registration as the PONNI rice was available for sale and consumption in India, Malaysia and many countries around the world
 - The use of the mark Ponni by the respondent as a trademark or badge of origin for rice in general was likely cause confusion if the mark Ponni was applied to other varieties of rice. Consumers would be misled into buying rice which is not in fact the Ponni variety of rice originating from the region where Ponni rice originated. Therefore, the registration and use of the Ponni as a trademark was bound to cause confusion

Maestro Swiss Chocolate Sdn Bhd & Ors v Chocosuisse Union Des Fabricants Suisses De Chocolat (a co-operative society formed under title XXIX of the Swiss Code of Obligations) & Ors and another appeal

- The plaintiffs claimed that the defendants had wrongfully used the mark 'Maestro Swiss' ('the mark') in relation to their chocolate products and that through the use of the mark the defendants had wrongfully misrepresented to members of the public that the defendants' 'Vochelle' chocolates were 'connected' or 'associated' with the chocolate products of the plaintiffs which shared the goodwill and reputation of being known as or under the trade name of 'Swiss chocolate'.
- The plaintiffs also relied on the statutory protection against unlawful use of a geographical indication under the Geographical Indications Act 2000 ('the GIA'). In its decision, the court held:

"Hence, for the above reasons we are inclined to agree with learned counsel for the plaintiffs 'that, a trade mark or indication which is used not in a bona fide way and/or which use causes or is likely to cause confusion or deception to the public is not a protectable geographical indication coming within the GIA or s 27(2) of the GIA' and it 'is only in respect of things done before the GIA came into force on 15 August 2001 that may not be the subject of any legal proceedings. Things done after 15 August 2001 may still be the subject of legal proceedings'. With respect the Court of Appeal therefore erred in relying on s 27(2) of the GIA to dismiss the claim of the plaintiffs under GIA."

INSTITUTING CIVIL ACTION FOR GI

- A claimant, who wants to initiate an action against any person based on the GIA 2022, may rely on the grounds under section 77:
 - The use in the course of trade of a GI in a manner which misleads the public as to the geographical origin of the goods;
 - Any use in the course of trade of a GI which constitutes as an unfair competition within the meaning of Article 10bis of the Paris Convention for the Protection of Industrial Property
 - Any use in the course of trade of a GI identifying the wines for wines not originating in the place indicated by the GI
- The claimant will have to prove that the use of the GI was not bona fide, even if the true origin of those goods is indicated or the GI is literally true as to the geographical origin of the goods in question, provided that such use falsely represent to the public that the goods originate in another country, territory, region or locality

ENHANCING THE LEVEL OF GI PROTECTION

- The GIA 2022 introduces a new Part IX entitled "OFFENCE" which **criminalises** the following acts that constitutes an offence against GI:
 - Falsely applying a **registered geographical indication** to any goods;
 - Importing and selling any goods with falsely applied geographical indication;
 - Submitting false information to the Geographical Indications Office or making false entries in the Register
 - Falsely representing a geographical indication as a registered indication and falsely representing the goods for which a geographical indication is registered; or
 - Disobedience to any summons to appear as a witness or a request made by the Registrar to produce any document or article
- The punishment for a person, if found on conviction, liable in committing these offences follows the related sections.
- The Controller, Deputy Controller or Assistant Controller has the powers to perform the duties imposed and exercise the powers conferred on him under Part X of GIA 2022, Investigation and Enforcement

WHAT IF THE GI IS NOT ACCORDING TO THE QUALITY?

- Under Section 34(1)(b)(ii): it's an offence if a person falsely applies a registered geographical indication to the goods if the goods are not in accordance with the quality, reputation or characteristic as specified in the Register.
- Section 12(11): the Registrar may revoke the acceptance and proceed as if the application for the registration of the geographical indication had not been accepted if it is satisfied that (where after the acceptance of an application for the registration of a geographical indication but before the registration of the geographical indication) —
 - (a) the application for the registration of the geographical indication has been accepted in error; or
 - (b) in the special circumstances of the case—
 - i. the geographical indication shall not be registered; or
 - ii. the geographical indication shall be registered subject to any additional or different condition or limitation

THANK YOU!