

GEOGRAPHICAL INDICATIONS ACT

(CHAPTER 117B)

(Original Enactment: Act 44 of 1998)
REVISED EDITION 1999
(30th December 1999)

An Act to provide for the protection of geographical indications in relation to goods.

[15th January 1999]

Short title

1. This Act may be cited as the Geographical Indications Act.

Interpretation

2. In this Act, unless the context otherwise requires —

“Court” means the High Court;

“geographical indication” means any indication used in trade to identify goods as originating from a place, provided that —

(a) the place is a qualifying country or a region or locality in the qualifying country; and

(b) a given quality, reputation or other characteristic of the goods is essentially attributable to that place;

“goods” means any natural or agricultural product or any product of handicraft or industry;

“interested party”, in relation to goods identified by a geographical indication, means a producer of the goods, a trader of the goods, or an association of such producers or traders or of such producers and traders;

“Paris Convention” means the Paris Convention for the Protection of Industrial Property signed at Paris on March 20, 1883, as revised or amended from time to time;

“place” means a country or territory and includes a region or locality in that country or territory;

“producer” means —

(a) in relation to agricultural products, a person who produces those products for sale or other commercial purposes;

(b) in relation to natural products, a person who exploits those products for sale or other commercial purposes; or

(c) in relation to products of handicraft or industry, a person who manufactures those products for sale or other commercial purposes;

“qualifying country” means any country or territory which is —

(a) a member of the World Trade Organisation;

(b) a party to the Paris Convention; or

(c) designated by the Minister as a qualifying country under section 11;

“trade mark” has the same meaning as in the Trade Marks Act (Cap. 332);

“trader”, in relation to goods, means any person —

(a) who sells the goods in Singapore; or

(b) who supplies the goods in Singapore for the purpose of their being sold by another person in Singapore;

“use” means use as part of, or in connection with —

(a) any transaction, including a purchase, sale or exchange;

(b) any importing or exporting;

(c) any advertisement; or

(d) any invoice, wine list, catalogue, business letter, business paper, price list or other commercial document.

Interested party may bring action for certain uses of geographical indication

3.—(1) Subject to the provisions of this Act, an interested party of goods identified by a geographical indication may bring an action against a person for carrying out an act to which this section applies in relation to the geographical indication.

(2) This section shall apply to the following acts:

(a) the use of a geographical indication in relation to any goods which did not originate in the place indicated by the geographical indication, in a manner which misleads the public as to the geographical origin of the goods;

(b) any use of a geographical indication which constitutes an act of unfair competition within the meaning of Article 10 bis of the Paris Convention;

(c) any use of a geographical indication, being a geographical indication which identifies a wine, in relation to a wine which did not originate from the place indicated by the geographical indication, whether or not —

(i) the true geographical origin of the second-mentioned wine is used together with the geographical indication;

(ii) the geographical indication is used in translation; or

(iii) the geographical indication is accompanied by any of the words “kind”, “type”, “style”, “imitation” or any similar word or expression; and

(d) any use of a geographical indication, being a geographical indication which identifies a spirit, in relation to a spirit which did not originate from the place indicated by the geographical indication, whether or not —

(i) the true geographical origin of the second-mentioned spirit is used together with the geographical indication;

(ii) the geographical indication is used in translation; or

(iii) the geographical indication is accompanied by any of the words “kind”, “type”, “style”, “imitation” or any similar word or expression.

(3) Any use of a geographical indication within the meaning of subsection (2) shall be deemed to be an act to which this section applies even if the geographical indication is literally true as to the geographical origin of the goods in question, provided that such use falsely represents to the public that the goods originate in another place.

(4) For the purposes of subsection (2), “use of a geographical indication” includes the use of a trade mark which contains or consists of the geographical indication in question.

Remedies

4. Subject to the provisions of this Act, if it is established to the satisfaction of the Court that the defendant to an action brought under section 3(1) has carried out or is carrying out an act to which section 3 applies, the Court may grant to the plaintiff one or both of the following:

(a) an injunction (subject to such terms, if any, as the Court thinks fit) to restrain the further carrying out of the act;

(b) damages or an account of profits.

Homonymous geographical indications for wines

5.—(1) Subject to section 3(3), any interested party of wines identified by homonymous geographical indications may take action under section 3 against the carrying out of an act to which that section applies.

(2) Any interested party of wines identified by homonymous geographical indications may apply to the Court for a declaration of the practical conditions under which the geographical indications are to be differentiated from one another.

(3) The Court shall, in making a declaration under subsection (2), take into account —

(a) the need to ensure equitable treatment of all the interested parties concerned; and

(b) the need to ensure that consumers are not misled.

Certain uses of geographical indications excepted

6. Section 3 shall not apply to —

- (a) the use of a geographical indication, being a geographical indication which is contrary to public policy or morality;
- (b) the use of a geographical indication, being a geographical indication which is not or has ceased to be protected in its country or territory of origin, or which has fallen into disuse in that country or territory; or
- (c) the use of a geographical indication in relation to any goods or services which has become the common name of the goods or services in Singapore.

Exceptions regarding prior users

7.—(1) Section 3 shall not apply to the use by a qualified person of a wine or spirit identified by a geographical indication in relation to goods or services if the qualified person, or he and his predecessor in title, have continuously used in Singapore that geographical indication in relation to those goods or services or related goods or services either —

- (a) for at least 10 years preceding 15th April 1994; or
- (b) in good faith preceding that date.

(2) For the purposes of subsection (1), “qualified person” means —

- (a) a citizen of Singapore or an individual resident in Singapore;
- (b) a body corporate incorporated under any written law in Singapore; or
- (c) any other person who has a real and effective industrial or commercial

establishment in Singapore.

(3) Section 3 shall not apply to the use by a person of a trade mark which is identical or similar to a geographical indication if —

(a) the application for the registration of the trade mark was made in good faith, or the trade mark was registered in good faith, under the Trade Marks Act (Cap. 332) or any previous law relating to trade marks; or

(b) he, or he and his predecessor in title, have continuously used that trade mark in good faith in Singapore in the course of trade, either —

- (i) before 15th January 1999; or
- (ii) before the geographical indication in question is protected in its country or territory of origin.

Exception for use of personal name

8. Section 3 shall not apply to the use in the course of trade by a person of that person’s name or the name of that person’s predecessor in business, except where the name is used in such a manner as to mislead the public.

Exception for failure to take action

9.—(1) No action under section 3 against a person for the use of a trade mark which contains or consists of a geographical indication shall be brought after the expiry of 5 years —

- (a) from the date such use by that person or his predecessor in title has become generally known in Singapore; or
- (b) from the date of registration of that trade mark by that person under the Trade Marks Act or any previous law relating to trade marks, if the trade mark has been published by that date, whichever is earlier.

(2) Subsection (1) shall not apply where the trade mark was used, or registered, in bad faith.

Rules

10. The Rules Committee constituted under section 80(3) of the Supreme Court of Judicature Act (Cap. 322) may make rules with respect to —

- (a) proceedings and the practice and procedure of the Court under this Act; and
- (b) the fees and costs of such proceedings.

Minister may designate other qualifying countries

11. The Minister may, by notification in the Gazette, designate any country or territory as a qualifying country for the purposes of this Act.

Rights under other laws unaffected

12. Nothing in this Act shall affect the rights of a person under the Trade Marks Act (Cap. 332) or the law relating to passing off.