

GEOGRAPHICAL INDICATIONS MODEL LAW/REGULATIONS – EXPLANATORY NOTE

Version 4 - October, 2021

Disclaimer: The contents of this document are the result of a consultation process, and its contents are the sole responsibility of the authors and can in no way be taken to reflect the views of the European Union.

The Model Law for Geographical Indications, Regulations and Forms are based on:

- Existing relevant provisions within the Law on Geographical indications in the CARIFORUM countries, including Cuba;
- EPA, TRIPs agreement, Geneva Act of the Lisbon Agreement;
- Good practice of existing GI legal frameworks (EU, ASEAN countries, African countries);
- Consultations and discussions held with the CARIFORUM/Cuba IP Offices and EPA coordinators.

The main purpose of the GI Model Law and Regulations including Forms is:

- To propose a legal framework that enables the understanding and the implementation of Geographical indications in practice. These proposed provisions can be considered as a whole or only for specific purposes, in order to complete some national provisions considered as incomplete.
- To provide CARIFORUM states with a consistent reference material of legislative and practical documents, ready to use to reform GI legal frameworks.

Current laws in the CARIFORUM countries consider GIs mainly as an IP tool, taking into account the protection aspects, relationships with marks or previous uses and establish relevant enforcement procedures. As a consequence, the legal frameworks do not consider GIs as a quality or production scheme. The present Model Law and Regulations contain a comprehensive vision of GIs, to complete this missing aspect of the GI system in order to strengthen the GIs as local development tools, as well as IP protection tools.

There may be a need for flexibility to introduce stronger provisions on GI protection in the CARIFORUM countries legal frameworks. Depending on the national legal framework in each country, this could be done either through the enactment of GI amended Act (as proposed by this model law) which will introduce a full sui generis GI system, or through the inclusion of relevant provisions in the frameworks currently in place.

The proposed Model Law and Regulations should be of interest for those CARIFORUM countries who are seeking a strong and reliable GI legal framework that benefits producers and consumers, while protecting and promoting the country's goods, culture and traditions nationally and internationally.

Consultation Process

In June of 2020, upon a specifically identified need, the CarIPI Project undertook to develop a Geographical Indications Model Law for CARIFORUM Member States. The aim of the Model Law is to provide a guide for States in need of modernizing their existing laws.

A review was conducted of the currently applicable legislation and/or drafts bills on Geographical Indications in the 16 CARIFORUM States. Feedback was shared and discussed with the IPOs of each country. Consequently, the 1st draft of the GI Model Law was formulated.

This first draft was then circulated among Member States along with explanatory notes in preparation for the first Regional Consultation on the Draft GI Model Law, which was held on 10 December 2020. At this Meeting, Member States were able to provide their feedback and have their questions answered.

Following this first Meeting, Member States were then requested to submit their comments and additional information, particularly on specific matters which arose in the discussions.

A further revised version of the Draft GI Model Law was then prepared along with supporting documents:

- Draft Regulations accompanying the model law.
- Draft Forms for the model law:
 - 1) Application Form
 - 2) Amendment Form
 - 3) Cancellation Form
 - 4) Objection Form
 - 5) Objection Counter Statement
 - 6) Certificate Template
 - 7) Request Misleading Marks Form
 - 8) Request Conflicting Marks Form
- Annexes
 - I. Example of Fines and Timelines
 - II. Proposed Text on Traditional Knowledge (kindly provided by the JIPO, which could be included in the draft model law if a country so considers).

These documents were all circulated to Member States for their review, in preparation for the Second Regional Consultation on the Draft GI Model Law, held on 31 March 2021.

The Draft Law and related documents were then revised based on discussions during the meeting and subsequent feedback submitted by Member States, with the aim to finalise the GI Model Law and present it for endorsement at the III Sub-PSC Meeting scheduled for 14 October 2021.

1. Definitions

Some definitions of key GI concepts deserve to be added in the GI laws. This concerns especially:

- Applicant definition: some more elements concerning the applicant shall be given, as the Registrar shall examine if the applicant is entitled to apply for a GI and as the applicant becomes an “owner” or “right holder” with specific duties towards the GI.

Case of single applicant or single producer: The possibility of the GI registration for a single person shall not be too restrictive. It deserves to be flexible and accept other future producers if not, the GI in this case will constitute a monopoly, and hence not deliver the expected impact for local communities.

- Specifications definition: a GI product relies on specifications elaborated by producers/applicant. There is a need to refer to the specifications or book of requirements: “Specifications” refers to a document, specifying the production geographical area, production conditions and the quality control process of geographical indication goods, which is compiled by the applicant”. Reference of specifications is also made in the article 145 B 2 of the EPA.
- A key issue : once the GI is registered, must the applicant become the GI “owner” or a GI “right holder”? A GI is an IP tool, so the registration confers rights and ownership: to whom? Is the State the official GI owner? Does the applicant become the GI owner or right holder? This aspect deserves to be explained because it will facilitate the practice and the definition of the responsibilities between IPO, GI manager and GI users. We recommend to provide such definition in the law.
- Opposition/objection shall also be defined in the definition/interpretation provision: “Opposition/objection refers to opposition/objection against the registration of a geographical indication by any interested person”.
- Homonymy: the concept shall be clearly defined to avoid misinterpretations.

2. GI uses

It is important to cover the main GI uses and legitimate users. The type of GI uses should be added to define the main GI uses on the products and to identify potential abuses.

The GI users should be defined in the definitions section. It is important to define clearly who will be entitled to use the GI once the GI is registered and protected. The management of users should be clearly defined to avoid misuses in practice.

A list of such producers or legitimate users can be created and the management of such list conferred to a competent authority (IPO? GI applicant/owner/ right holder ?, both...etc....).

3. Procedural elements

Registration process: We propose to add more details at the level of the Law that will be then explained in the implementing regulations.

It would be interesting to differentiate formal examination from substantive examination. The duration of the substantive examination will also be useful in order to avoid too lengthy GI registration procedures. However, IPOs prefer not to indicate timelines in order to have more flexibility during GI examinations.

Clear understanding on the GI modifications/rectifications should be given. GIs modifications can be defined as:

- formal modification of the register as change of GI “owner” or “right holder” address or name of the representative etc....
- specifications modifications: minor or major ones that can impact the substance of the quality of the production process for instance.

Digital or electronic management of GI procedure shall be foreseen, if possible in the concerned country.

4. GI protection

Coexistence case: Coexistence between former trademarks and GI does not exist in most of CARIFORUM countries GI legal frameworks. We propose to add this provision. In this case, trademarks and GIs can coexist, as they are independent and equal IPRs, except in the case of the well-known, prior trademark. Coexistence is interesting as it could avoid conflicts between trademarks and GIs owners/right holders.

Foreign GIs: We propose to include foreign GI protection by direct applications.

Genericity: In relation to the Geneva Act, registered GIs cannot become generic. We propose to add this provision.

GIs on the internet : We propose to add some elements concerning the protection of GIs on the internet, complying with article 145.7 of the EPA.

Duration of the GI : 10 years or indefinite protection as said in article 145.B.1 of the EPA or in article 8 of the Geneva Act of the Lisbon Agreement. The predominant practice worldwide is, GI protection is granted for an indefinite time, as long as the GI exists in practice.

Scope of GI protection :

In order to comply with the EPA and the Geneva Act of the Lisbon agreement, we recommend to open the protection of GIs to any kind of products.

In addition, we propose to extend the prohibition of GI registration with respect to products of the vine, plants or animals for which the relevant indication is identical with the name of a grape variety, plant variety or animal breed existing in the country, as foreseen in article 145.C.2 of the EPA.

Homonymous GIs : We propose to define the concept and to extend homonymous GI conditions to all products and not only wines. Article 145 of the EPA does not make differences among the type of products.

Abuses of notoriety: The Model law provides protection of the registered GI for abuses of notoriety on other types of products than the one covered by the GI, as foreseen in the Geneva Act of the Lisbon Agreement, article 11.1.a.ii), *“in respect of goods that are not of the same kind as those to which the geographical indication applies or services, if such use would indicate or suggest a connection between those goods or services and the beneficiaries of the geographical indication, and would be likely to damage their interests, or, where applicable, because of the reputation of the geographical indication, such use would be likely to impair or dilute in an unfair manner, or take unfair advantage of, that reputation”*.

Sanctions: The Law shall provide some specific sanctions and penalties in case of GI infringement.

4. GI controls

GIs controls do not exist at the moment in the CARIFORUM countries legal frameworks. We propose to integrate this important aspect of the GI system. In the Model Law, there is a reference made to controls of GIs in the definition section and in a specific chapter. Controls refer to the verification of the compliance of products with the specifications by the geographical indication owner/right holder and control/certification body or designated authorities. However, concrete implementation of the GI control shall be discussed as well as the capacity/willingness of the competent authority to provide control oversight.

5. GI Logo

Nothing is said about the creation of a national logo for national GIs to certify all registered geographical indication goods in the existing CARIFORUM countries GI legal frameworks. We propose then the creation of a GI logo in order to recognize the GI products on the market and to enhance the visibility of the GI products and GI system. More information concerning the implementation and use of the GI logo is developed in the Regulations.

We propose afterwards an explanatory note on the main provisions of the drafts proposed during this activity.

1. GEOGRAPHICAL INDICATIONS MODEL LAW

Version 3 October 2021

OBJECT AND REASONS

Purpose of the law

The purpose of this law is to protect (option to include here the word: ‘consumers and’) the intellectual property rights of producers, processors and traders, in addition to fostering creativity, innovation and competitiveness, to facilitating sustainable development, to preserving and strengthening traditional know-how and to reducing poverty.

COMMENT: This provision covers the purpose of the law and the main different outcomes to be achieved through the implementation of the Law.

There is an option to include “consumers”, if in the national legal framework, GIs are considered not only from a IPR purpose but also from consumers’right/protection perspective. It is indeed important to consider GIs for the producers/GI owners-right holders but also from the consumers perspective. This choice shall be made at political level.

Objective

The objective of this law is to provide for the registration and protection of geographical indications in COUNTRY.

COMMENT: The Law covers the registration and the protection of the GIs by the competent authority in the concerned country.

PART I PRELIMINARY

Short Title

1. This Act may be cited as the *Geographical Indication Act*, 20xx.

Definition / Interpretations

2. In this Act:

“Act of unfair competition” means any act of competition contrary to honest business practices in industrial or commercial matters as defined in Article 10bis of the Paris Convention;

“Appeal” refers to an appeal against the decision of the Competent authority in relation to geographical indications;

“Competent authority” refers to the REGISTRAR/ CONTROLLER / DIRECTOR GENERAL OF INTELLECTUAL PROPERTY which is entitled to register and protect geographical indications;

COMMENT: Competent authority may refer to the IP Office, the Registrar, the Director General, the Controller of Intellectual Property, the IP Office or any other relevant authority/body as designed by the national legal framework.

“Control Body” refers to any designated entity such as public institution or private organization issuing a certificate of compliance with the geographical indication specifications;

COMMENT: There is a need to define the concept of GI control body : who can be entitled to perform controls on GI products and GI producers and who will issue/deliver GI compliance certificate. The issuance of certificates will allow for the identification of the producers allowed to produce GI products/GI users as well as for the identification of non-compliance of GI production process.

“Controls” refer to the verification of the compliance of goods with the specifications by any designated authorities;

COMMENT: It is important to specify the scope of GI controls: compliance of the products with the specifications recognized by the competent authority.

“Counterstatement” refers to a submission of any arguments and evidences of one party against another party’s statement;

“Court” means the COUNTRY COMPETENT Court;

“Generic” refers to a name for which the relevant indication is identical with the term customary in common language as the common name for such goods or services in the territory of that COUNTRY;

COMMENT: It is important to give in the definition provision a clear definition of the “generic” terms.

“Geographical Indication” means

OPTION 1 (based on the TRIPS agreement) an indication/ a name that identifies goods 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 goods is essentially attributable to its geographical origin;

OPTION 2 (based on the Geneva Act) any indication protected in the COUNTRY consisting of or containing the name of a geographical area, or another indication known as referring to such area, which

identifies a good as originating in that geographical area, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin;

COMMENT: We propose a choice of 2 international definitions of GIs: the one of the TRIPS agreement or the most recent one given by the Geneva Act on the Lisbon Agreement.

“Geographical indications applicant”: means any natural or legal person or, in exceptional circumstances, individual identified by the competent authority to act as applicant of a geographical indications registration to exercise legal rights representing the interests of producers or manufacturers of eligible goods and who are desirous of registering a geographical indication in relation to such goods;

COMMENT: We propose to add a clear definition of the GI applicant.

“Geographical indications owner/right holder”: means the geographical indications applicant once the geographical indications is registered by the competent authority;

COMMENT: This provision will explain that once the GI is registered, the applicant becomes the “owner” or “right holders” of the GI name. A GI is an intellectual property right. Otherwise, there is a need to identify who is entitled to the legitimate use the GI names and who will have a responsibility toward the GI protection.

“Goods” means any agricultural or non-agricultural good, unprocessed or processed, including any goods of handicraft or industry;

COMMENT: The Law shall give the scope of products or goods to be covered by the GI system. As the word “good” is more largely used in the CARIFOUM countries and in the international GI legal framework, we propose to use “goods” throughout the text.

“Hearing” refers to the procedure before making decision on any opposition/objection by opponent/objector;

“Homonymous geographical indication” means indications that are spelt and pronounced alike but (which are different in meaning and) which are used to designate the geographical origin of goods stemming from different places or countries;

COMMENT: The Law shall give a clear definition of the homonymy situation.

“Interested party or person” means a person, whether natural or legal, that can affect, be affected by, or perceives himself to be affected by, a decision or activity taken in relation to geographical indications designating a good;

“Trade Mark” or “Mark” is any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark.;

“Paris Convention” means the Convention for the Protection of Industrial Property signed at Paris on 20 March 1883;

“Producer” means

OPTION 1

- (a) any producer of agricultural good or natural goods;
- (b) any processor of natural or agricultural or agri-food goods;
- (c) any industry or manufacturer of goods of handicraft; and
- (d) any trader dealing in the goods mentioned in paragraphs a) b) and c);

OPTION 2

any person who produces, processes, exploits, makes or manufactures goods;

COMMENT: This provision provides a definition of the producer under the law. We propose to limit the “producer” concept only to the people who are directly concerned by the production process or traders who deal with the concerned product. There are 2 proposed options: one option that will cover producers of each type of potential products and the other option that provides general definition.

“Registrar” means the Registrar of Intellectual/Industrial Property (to be adapted if needed);

“Remedies” means the remedies that a judicial or quasi-judicial body can impose under the applicable domestic law, as a result of an action for the infringement of a right or an act of unfair competition, as the case may be.

“Official Gazette” refers to the official gazette of the competent authority;

“Opposition/objection” refers to opposition/objection against the registration of a geographical indication by any interested party/person;

“Specifications” refers

OPTION 1:

to documents and information as required by article 15 of this Act, which is compiled by the applicant;

OPTION 2:

to technical details of the geographical indication that must be provided with the geographical indication application, specifying the production geographical area, production conditions and the quality control process of geographical indication goods, which is compiled by the applicant;

COMMENT: We propose a clear definition of the specification which constitute the “identity card” of the GI product and the reference document for competent authority, producers, control bodies etc.....Further information on the content of the specifications will be given in a specific provision.

“Use of geographical indication” refers to offer for sale, production, sale, export or import of geographical indication goods as well as any promotion and communication material in relation to the geographical indication goods.

COMMENT: We propose a definition of the GI use in order to identify the overall type of uses. This will facilitate the identification of GI (legitimate) users as well as possible misuses.

PART II : Competent Authority

Duties of the competent authority

3. The competent authority shall be entrusted with duties in relation to the administration, maintenance and registration of geographical indications in COUNTRY, including :

- (a) Receiving and examining applications;
- (b) Examining the specifications;
- (c) Receiving oppositions and counterstatements;
- d) registering geographical indications and dealing with the amendment, invalidation and cancellation of geographical indications;
- (e) Conducting hearings in relation to geographical indication applications or registrations [OPTIONAL];
- (f) Publishing the registered geographical indications in Official Gazette;
- (g) Providing control oversight [OPTIONAL];
- (h) Performing any other instruction in relation to geographical indications matters received by the competent Minister/Ministry OPTIONAL.

COMMENT: This provision aims at defining the different competencies of the GI competent authority, given the existing practices worldwide. Based on the existing experience of IP offices on GIs and the existing content of the GI laws in CARIFORUM countries, the duties conferred to the competent authority can cover GIs process of registration, GI protection and promotion. An optional list of additional competencies that go beyond the simple competency of an IP office is provided. Not all the proposed additional competencies are compulsory as IP Offices in the CARIFORUM countries have limited competencies and means. All will depend on the political choice of the GI system in the country and the willingness to confer IP Office a broad competency to register and manage GIs at national level.

Establishment of the Geographical Indication Board (OPTIONAL)

4. (1) There is established a Geographical Indications Board for the purpose of examining applications for geographical indications, promoting the geographical indications system in COUNTRY.

(2) The regulations have effect as to the constitution of the Board and otherwise in relation to the Board.

COMMENT: This provision is optional as sometimes IPOs want to set up a specific board for GI matters. No further provision in relation to this Board is given at the moment. In certain countries, the Board exists and performs activities of GI recognition, control oversight as well as overall promotion of the concept.

PART III - Protection of Geographical Indications

Protection granted to geographical indications

5. (1)

OPTION 1:

Geographical indications that are registered, are protected under this law.

OPTION 2:

Geographical indications are protected under this law whether or not they are registered.

COMMENT:

In the option 1, registration of GIs is proposed as it refers to the predominant practice worldwide. By virtue of registration, the legal title is issued which provides legal certainty to the right holder. Furthermore, in order to extend registration of GIs to foreign countries, including under international agreements, a domestic legal title is required (Lisbon Agreement for example requires: "a domestic legal title, such as a registration, a legislative or administrative act, a judicial or administrative decision"). Therefore, unless the GI is recognized in some way, international protection will not be granted.

Nevertheless, in some cases, Geographical Indications that are not registered could, as the case may be, be protected by competition law or passing-off, and/or under trade mark laws.

In the option 2, the Act would cover registered AND unregistered GIs. This is intended to cover for cases where the registration has not (yet) been undertaken. For unregistered GIs however, there will be no legal title delivered by the competent authority, which creates legal uncertainty for the 'potential GI holders'. A title would have to be obtained by judicial or administrative decision .

(2) Notwithstanding subsection (1), geographical indications which falsely represent to the public that the goods originate in another territory are not protected by this Act.

(3) For the purposes of this section, registration of a geographical indication under this Act raises the presumption that the geographical indication is a geographical indication within the meaning of Section 2.

(4) Geographical indications registered under this Act cannot become generic, unless they fall into degeneration.

COMMENT: This provision is present in certain CARIFORUM countries already and was indicated as important. This explains why it has been integrated. However, there is a need consider its relevancy as well as its implementation in practice.

Homonymy/Homonymous geographical indications

6. (1) In the case of homonymous or partly homonymous geographical indications for products, protection shall be accorded to each indication.

(2) The competent authority shall, in cases of permitted concurrent use of homonymous or partly homonymous geographical indications, determine the practical conditions under which such indications will be differentiated from each other.

(3) For the purposes of subsection (2), the competent authority shall have regard to the need :

(a) to ensure equitable treatment of the producers concerned; and

(b) to ensure that consumers are not misled.

(c) if there is a sufficient distinction made in practice between the geographical indication that was first protected, and the homonym subsequently protected.

COMMENT: This provision covers the homonymous GI cases, including Geneva Act provision. It provides some elements that will help the competent authority to decide whether or not the homonymous names shall be granted for protection.

Exclusion from geographical indication protection

7. The following shall not be protected as geographical indications:

- (a) indications that do not correspond to the definition of "geographical indication" in Section 2;
- (b) indications that are contrary to laws and regulations, public morality, religion, good custom or public order in the territory of the country concerned;
- (c) geographical indications that are not or cease to be protected in their country of origin, or that have fallen into disuse in that country;
- (d) indications that conflict with names of a plant variety or an animal breed in the territory of the country concerned and are likely to mislead the consumer as to the true origin of the product;
- (e) geographical indication that are generic terms in the territory of the country concerned.

COMMENT: This provision provides conditions for a name not to be protected as a GI.

Prohibition against improper use of geographical indications

8. (1) No person shall :

- (a) in the designation or presentation of goods, by any means, indicate or suggest that the goods originate in a geographical area other than the true place of origin in a manner that misleads the public as to the geographical origin of the goods;
- (b) use a registered geographical indication, directly or indirectly, in the course of the trade in respect of goods that are identical or comparable to those of the registered geographical indication where the misuse benefited or would benefit from the reputation of the geographical indication;
- (c) use a registered geographical indication, directly or indirectly, in the course of the trade in respect of goods that are non-identical to those of the registered geographical indication where the unlawful use benefited or would benefit from the reputation of the geographical indication;
- (d) use a registered geographical indication identifying goods not complying with the specifications or not originating in the place indicated by the geographical indication in question even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation", "method" or the like, including imitation, evocation or translation of the registered geographical indication;
- (e) engage in conduct which constitutes an act of unfair competition, being an act of competition contrary to honest practices in industrial or commercial matters and including :
 - (i) all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor;

(ii) false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor;

(iii) indications or allegations, the use of which in the course of trade, is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.

(2) A person who contravenes subsection (1) is guilty of an offence and is liable on summary conviction to a fine of \$XXXXX or to imprisonment for XXXX years or to both such fine and imprisonment.

Specific provisions concerning the implementation of such offences shall be determined by prescribed regulations.

(3) Subsection (1) applied to :

(a) the uses of the geographical indication as an ingredient;

(b) the uses of the geographical indication on the Internet, including uses in domain names.

COMMENT: This provision concerns the GI protection. It provides details concerning the misuses cases, the penal/criminal sanctions in case of misuse. The misuse covers also GI uses as ingredients as well other uses on the internet.

Concerning examples of fines and imprisonment see Annexes.

Civil remedies

9. (1) Any interested person may institute proceedings in the Court to prevent, in respect of geographical indications, any act referred to in Section 8.

(2) The Court may, in proceedings under subsection (1), in addition to granting an injunction, award damages and grant any other remedy or relief the Court thinks fit.

COMMENT: This provision covers the civil actions that can be taken to protect GI names.

Administrative protection

10. The NAME OF THE COMPETENT AUTHORITY FOR ADMINISTRATIVE PROTECTION shall take appropriate administrative and judicial steps to prevent or stop the unlawful use of protected geographical indications to designate goods that are produced or marketed in the COUNTRY.

COMMENT: This provision covers the administrative protection that can be implemented directly by competent bodies such as frauds, customs etc.... to protect the name of the GI against misuses.

Detention and Confiscation

11. (1) The competent courts shall have the authority to order the detention of the goods if there is suspicion that the goods are infringing the rights of the geographical indication.

(2) Subsection (1) shall also apply to the materials and core equipment if there is any suspicion they are used in the production of goods to infringe the rights of the geographical indication.

(3) The infringing goods which are imported, exported, sold or offered for sale shall be confiscated by the competent authorities through the courts' decision whether or not anyone has been convicted of the offence (OPTIONAL).

COMMENT: This provision is already present in CARIFORUM countries GI laws and is important in terms of GI protection. This kind of provision can also be present in the general IP legislation.

PART IV – Registration of geographical indications

Geographical indication applicant

12. (1) The following may make an application to the competent authority for the registration of a geographical indication:

(a) a person or a group of persons carrying on an activity as producers in the geographical area specified in the application, with respect to the goods specified in the application. In the case of a single person or single entity, the use of the geographical indication shall be open to any new producer(s) able to comply with the specifications;

(b) any organization or competent body linked with producers of goods specified in the application.

COMMENT: The subsection 1.a covers what exists in the CARIFORUM countries at the moment. In the existing legal framework in CARIFORUM countries, groups of people as well as single producers are recognized as applicant. In practice, GIs, as collective rights are applied by group of producers, representing the collective interest and economical representativeness of the GI products.

Concerning the single applicant, as GIs are collective rights, we propose to leave the door open to other producers in the area who will comply with the specifications. In this case, the use of the GI shall be granted also to this new producer.

We also propose to add as applicant any organization or any body linked with producers and that will be able to manage the GI for the benefit for the producers.

(2) An applicant under subsection (1) shall become the owner/right holder of the geographical indication after registration.

(3) When the geographical indication is registered by the competent authority, the geographical indication applicant becomes the geographical indication owner/right holder.

COMMENT: This provision explains that once the GI is registered, the applicant becomes the “owner” (or the right holder) of the GI name. A GI is an intellectual property right, an ownership can be granted sometimes to the State. If not, there is a need to identify who is entitled to legitimate use the GI names and who will have a responsibility toward the GI protection.

Geographical indication group

13. (1) The Membership of a geographical indication group shall be open to any producer located in the geographical area and complying with the specifications.

(2) The group shall ensure that its members comply with the specifications and other obligations designated by laws and regulations.

(3) (OPTIONAL) When the applicant is a group of persons/producers as mentioned in Section 12 subsection (1), it shall discharge their statutory responsibility to administer and function, on a non-profit basis.

COMMENT: This provision concerns the specific case of GI group of producers : their status, the membership conditions (i.e. GI inclusiveness, in order to accept any producer located in the area and complying with the GI specification), as well as some of their competencies towards the GI system. This provision can be optional.

Filing Applications

14. (1) The application for geographical indication registration shall be filed with the competent authority either at the competent authority office, by mail or by electronic means accompanied with the relevant documents.

(2) Applicants are entitled to file the geographical application either directly or through the representation of an agent/attorney-at-law.

COMMENT: This provision provides indication on the filing of the GI application and the type of application, being understood that all IP offices do not have digital procedures.

Content of geographical indications' application

15. (1) An application for the registration of a geographical indication shall specify:

(a) the name, address and nationality of the person making the application, and the capacity in which the applicant is applying for registration;

(b) name of the representative of the applicant if any;

(c) specifications, including the following particulars:

OPTION 1 (based on CARIFORUM countries Acts)

- i. the geographical indication (name) for which registration is sought;
- ii. the goods to which the geographical indication applies;
- iii. the geographical areas to which the geographical indication applies;
- iv. the process of production;
- v. the quality, reputation or other characteristic of the goods in respect of which the geographical indication is used;
- vi. the quality, reputation or other characteristic of the goods and how that quality, reputation or other characteristic (as the case may be) is essentially attributable to the place from which the goods originate,
- vii. where the geographical indication for which registration is sought relates to a country other than COUNTRY, evidence that the geographical indication has obtained recognition or registration as a geographical indication in the qualifying country or countries of origin, where applicable,
- viii. the reference to the control body;
- ix. the labelling rules; and

OPTION 2 (rewording of each part):

- i. the geographical indication (name) for which the registration is sought;
- ii. the goods to which the geographical indication applies;
- iii. a description of the characteristics of the goods in respect of which the geographical indication is applied;
- iv. the geographical area to which the geographical indication applies;
- v. a description of the method of obtaining the goods;
- vi. evidence that the good originates from the defined geographical area;
- vii. description of details establishing the link between a given quality, the reputation or other characteristic of the good and its geographical origin;
- viii. where the geographical indication for which registration is sought relates to a country other than COUNTRY, evidence that the geographical indication has obtained recognition or registration as a geographical indication in the qualifying country of origin, where applicable;
- ix. the name and address of the authorities or, if available, the name and address of bodies verifying compliance with the provisions of the good specification;
- x. the labelling rules; and

(d) such other particulars as may be prescribed.

(2) A person desirous of making an application under subsection (1) shall apply in the prescribed form and pay the prescribed fee.

(3) Where an applicant's ordinary residence or principal place of business is outside COUNTRY, he shall be represented by an attorney-at-law who is resident and practicing as an attorney-at-law in COUNTRY.

COMMENT: This provision provides a detailed content of the GI specifications which is the content mainly used in different countries. So it is a harmonized approach of the specifications content which is proposed. We would recommend providing a clear requirement for the GI specifications and to integrate all the necessary elements that a GI specification shall contain and that will allow the applicant to evidence the eligibility of the applied good as a GI.

Option 1 refers to the GI specifications content, based on the existing GI legal framework in the CARIFORUM countries.

Option 2 proposes a new drafting of each part of the GI specifications in order to give clearer detail on the content of each part: name, product description, geographical area, link between the product and its geographical origin.....

Examination and publication of the application

16. (1) The competent authority shall examine every application to ascertain whether it complies with the requirements of (sections 2, 7, 12 & 15) the present Act and the regulations.

COMMENT: This provision provides competency to the competent authority toward GI applications. However applications shall respect some specific rules of eligibility: definition of the GI, cases of exclusion, content of the specifications and requirements concerning the GI applicant.

(2) The competent authority shall notify applicants whether the geographical indication will be registered.

COMMENT: This provision provides some rules concerning the formal examination of the GI application. Timelines are deleted to give more flexibility to the IPO.

(3) When the application duly complies with the requirements, the competent authority shall officially issue an acknowledgement of application and publish

Option 1 : the application in the prescribed manner.

Option 2 : a summary of the application in the prescribed manner.

COMMENT: This provision provides rules concerning the acceptance of the "GI application" to be published and publication of such application. The publication can be made either including all the specification or using a summary of the specification.

(4) Where the application does not fulfill the requirements, the competent authority shall issue a letter to the applicant specifying the deficiencies to be addressed.

(5) The applicant may amend an application referred to in subsection (4).

(6) The application shall be deemed to have been abandoned if no amended application is submitted to the competent authority within the **DEFINED** period unless the applicant provides a reasonable explanation .

COMMENT: This provision provides rules concerning the case of incomplete application and exchanges with the competent authority. Timelines are deleted to give more flexibility to the IPO.

(7) The competent authority may seek advice from experts in related fields and if needed take this advice into consideration when making its decision.

COMMENT: Given the specific issues that can be raised during GI examination, competent authority can need some specific knowledge. In this case some experts can help.

(8) Specific provisions concerning the implementation of the geographical indications' examination process shall be determined by prescribed regulations.

Objection/Opposition to registration

17. (1) Any interested party or person may, within the prescribed period and in the prescribed manner from the date of publication, give notice to the competent authority of an opposition/objection to the registration of the geographical indication referred to in section 16 on the grounds specified in paragraph (2).

(2) The grounds for opposition against the geographical indication registration are:

- (a) failure to satisfy the definitions relating to geographical indication within section 3 of this Act.
- (b) that the applied geographical indication cannot be registered as a geographical indication as stated in sections 7, 8, 13, 14 & 15 of this Act and regulations.
- (c) that the geographical indication infringes an existing use of the name or similar name or evocation of the name;
- (d) that the geographical indication infringes prior trademark(s) registered in good faith;
- (e) that the geographical indication is homonym with another geographical indication and that no differentiation can be made between the two indications.

(3) **OPTION 1:** The competent authority shall send a copy of the notice referred to in subsection (1) to the geographical indication applicant.

OPTION 2 : The opponent shall send a copy of the notice referred to in subsection (1) to the geographical indications applicant.

(4) Upon receipt of the copy of the notice referred to in subsection (3), the applicant shall, within the prescribed period and in the prescribed manner, send to the competent authority a counter-statement of the grounds on which the applicant relies for his application; and if he does not do so, he shall be deemed to have abandoned the application.

(5) Where the applicant sends a counter-statement and after hearing the parties, if either or both wish to be heard, and considering the merits of the case, the competent authority shall decide whether the geographical indication should be registered.

(6) Parties are entitled to work out proposed rules of coexistence, if needed.

(7) Parties are entitled to work out a phase out period in case of prior geographical indication use as ground of opposition, if needed.

COMMENT: This provision provides rules concerning the opposition/objection process: conditions to lodge an opposition, timeframe and grounds for opposition.

Transitional periods for use of protected geographical indications

18. The producers who were using the name of the geographical indication on their goods marketed prior to the registration of the geographical indication, may only continue to use it for a period no longer than six months/one year/two years, otherwise they will be subject to prosecutions.

COMMENT: This provision provides rules concerning the management of products bearing the GI name but not covered by the GI protection. Agreement can be found between GI holder and the previous users in order to find a way to continue to market such products, within a defined time, until stocks are exhausted. After the defined period, such uses shall be considered as unlawful.

Geographical indication registration

19. (1) Where the competent authority is satisfied that the requirements referred to in section 15 have been complied with in respect of an application and

(a) there has been no opposition/objection to the registration of the geographical indication within the prescribed period; or

(b) there has been an opposition/objection to the registration of the geographical indication and the objection has been decided in the applicant's favour,

the competent authority shall register the geographical indication, issue to the applicant a certificate of registration and publish a notice of the registration.

(2) The competent authority may grant a phase-in period [not exceeding one year] to allow producers holding stocks of products not complying with the geographical indication registration to market their existing stocks without having to re-label them.

(3) Where, as the result of an objection made under this section or for any other reason, the competent authority is satisfied that the application for registration of a geographical indication does not comply with the requirements of this Act or the regulations the competent authority shall refuse the application.

(4) The effective date of registration is deemed to be the date of the geographical indication application.

COMMENT: This provision provides rules concerning the acceptance of the GI application.

Geographical indication register

20. (1) The competent authority shall maintain a Register in which he shall record

- (a) all geographical indications registered under this Act; and
- (b) all matters required by this Act to be recorded.

(2) The Register shall be open for inspection by the public during normal working hours, and any person may obtain extracts therefrom or make copies of such extracts in the manner and under the conditions prescribed.

(3) Specific content of the Register shall be determined by prescribed regulations.

COMMENT: This provision provides rule concerning the GI register as it is important to have a specific register that allows for public information concerning GI procedures.

Cancellation or rectification/amendment of geographical indication registration

21. (1) A geographical indication owner/right holder or any interested party or person with sufficient interest may apply either to the competent authority or to the Court/competent jurisdiction for:

(a) the cancellation of the registration of a geographical indication on the grounds that:

(i) it does not comply with sections 2, 7, 12, 13 & 15 of the present Act or the regulations;

(ii) the owner or right holder of the registered geographical indication has requested cancellation;

(iii) the goods of registered geographical indication have lost their special characteristic as geographical indication goods;

(iv) they are foreign geographical indications which are not or have ceased to be protected in their country of origin or have fallen into disuse in that country.

(b) the rectification /amendment of the registration of a geographical indication on the grounds:

(i) that the geographical area specified in the registration does not correspond to the geographical indication; and/or

(ii) that the specifications shall be amended, particularly the elements related to the development of technologies and sciences and the delimitation of the geographical area. The amendment of the specifications shall be made if it does not vitally affect the decision of geographical indication registration.

COMMENT: This provision provides rules concerning either the GI cancellation and GI rectification. It also can be considered in two separate provisions. GI cancellation and GI rectification do not cover the same reality. This explains why the grounds for each case are different.

The case of cancellation can happen when the GI product and/or its specific context disappear or when the applicant/right holder/owner/right holder decides to do so.

The case of rectification is different as it is implemented because of GI specification changes due to natural factors (such as climate changes), due to innovation processes to be integrated or due to other elements that have to be integrated in the specification (extension of the area, new raw materials/ingredients etc.).

(2) In any proceedings under this article, notice of the request for cancellation or rectification

(a) shall be served on the person, owner/right holder who filed the application for registration of the geographical indication; and

(b) shall, by a publication in the prescribed manner, be given to all persons having the right to use the geographical indication under section 30.

(3) The persons referred to in subsection (2) and any other interested person may, within such period as the competent authority or the Court/competent jurisdiction specifies in the notice and publication referred to in that subsection, apply to be joined in the proceedings.

(4) The Court/competent jurisdiction shall notify the competent authority of the decision of the Court/competent jurisdiction or the decision on any appeal therefrom and the competent authority shall record it and publish a notice of the decision as soon as possible.

Option that integrates Registrar competency:

The Registrar shall notify the interested parties of the decision or the decision on any appeal therefrom. The Registrar shall record it and publish a notice of the decision as soon as possible. This decision may be subject of appeal.

(5) The cancellation of geographical indication registration shall be deemed to have been effective from the date of the notice of decision.

COMMENT: The rest of the provision provides rules concerning GI cancellation/rectification procedure, based on the existing CARIFORUM countries legal framework.

Correction of errors

22. The competent authority may, subject to the regulations, correct any error of translation or transcription, clerical error or mistake in any application or document filed with the competent authority or in any matter recorded pursuant to this Act or the regulations.

Extension of time

23. Where the competent authority is satisfied that the circumstances justify it, upon receiving a written request, extend the time for doing any act or taking any proceedings under this law or the regulations, upon notice to parties concerned and upon such terms as he may direct notwithstanding that the time for doing the law or taking the proceedings has expired.

Discretionary power

24. The competent authority shall, before exercising any discretionary power vested in him by this Act in a manner that is likely to adversely affect any party to proceedings before him, give that party an opportunity to be heard.

Publication

25. The competent authority shall publish in the *Official Gazette/IP Journal*/and in a newspaper published daily in COUNTRY everything required to be published under this Act.

COMMENT: The provision is aligned with traditional provision in many CARIFORUM GI legal frameworks. It will be more detailed in regulations.

Jurisdiction of Court (OPTIONAL)

26. (1) The Court has jurisdiction in cases of disputes relating to the application of this Act and in matters which, under this Act, are to be referred to the Court/competent jurisdiction.

(2) Any party aggrieved by a decision of the competent authority may, within TIME TO BE DEFINED after the date of the decision, appeal against the decision to a Court/competent jurisdiction.

COMMENT: This provision provides rules concerning the jurisdiction of national Court(s) in case of GI disputes. GI decisions must be appealed to a Court.

National Logo for Certifying Geographical Indication Goods

27. (1) The competent authority/ministry shall constitute a National Logo to certify all registered geographical indication goods in COUNTRY.

(2) The modalities of the national logo are provided by regulations.

COMMENT: The provision provides the creation of a national logo that will identify the GI products of the concerned country. The existence of a national (or regional) logo will help to increase the visibility of GI products on the markets. More information concerning the national logo is detailed in the regulations.

PART V – Registration of foreign geographical indications

Requirements of Foreign Geographical Indication Registration

28. (1) A foreign geographical indication shall be registered through the submission of the application to the competent authority in accordance with the provisions of the Act and regulations.

(2) A foreign geographical indication shall be eligible for registration as long as the foreign geographical indication is protected in accordance with the applicable laws in its country of origin and is not in conflict with the provisions of the Act and regulations.

(3) The competent authority shall not allow the registration of a foreign geographical indication which has ceased to be protected in its country of origin or has fallen into disuse in that country.

Procedure for Foreign Geographical Indication Registration

29. (1) The application for a foreign geographical indication registration shall be filed with the competent authority.

(2) Terms defined in PART IV of this Act shall be applied mutatis mutandis to the foreign geographical indication registration procedure.

COMMENT: These provisions concern the GI registration process. Foreign GI may access to the GI registration in the country, mostly if there is no international agreement. Same procedure as national GIs must be implemented. However, applicant must evidence the existence of the GI in the country of origin.

PART VI: Effects of geographical indications Registration

Rights Conferred

30. (1) When a geographical indication is registered at the competent authority, in accordance with the provisions of this Act and regulations, only geographical indication owner/right holder and producers of goods possessing the quality, reputation or other characteristic specified in the Register who are carrying on their activity in the geographical area specified in the Register, who are complying with the good's specifications, have the right to use the registered geographical indication in the course of trade, with respect to such goods.

COMMENT: This provision concerns the GI right of use and is adapted to the one present in the CARIFORUM legal frameworks. The GI use is conferred to the GI owner/right holder, considered as the association of producers and to the producers (raw material, processors etc...) who are complying with the GI specifications.

(2) The right referred to in subsection (1) shall not be transferable.

COMMENT: Normally, GIs are not subject of transfer or licenses. The right is given to the producer/enterprise as legal person.

If the GI owner/right holder changes, this will be considered as a rectification of the GI as the competent authority will have to check whether the potential new owner/right holder will be able to manage the GI.

If a producer changes (succession, change of legal structure etc...), normally there is no transfer but a new application of the GI use made either to the GI owner/right holder or to the control body.

(3) The geographical indication owner/right holder shall have the right to institute a complaint to the competent courts either against

- any person who used its geographical indication without authorization or against any member of geographical indication group who infringed a geographical indication as provided for in section 8 of this Act.

- any trademark application

COMMENT: This provision provides clear competency to GI owners/right holders to defend the GI against misuses.

(4) A list of geographical indications users is established and maintained by the (competent authority/ the geographical indication owner/right holder/ both). All producers handling the good in accordance with the specification have the right to use the Geographical Indication.

COMMENT: This provision proposed the setting up of a GI users list which can be useful in practice to identify the persons entitled to use and possible misuses. In some countries, this list is made public which is a guarantee of transparency and it provides transparent information for consumers that want to buy the real GI product.

Duration of Protection

31 (1) The protection of geographical indications shall be :

OPTION 1 :of indefinite duration.

OPTION 2: granted for 10 years and renewable for further periods of 10 years.

COMMENT: In many countries and in some international agreements, GIs are registered for an indefinite time. GI goods are generally traditional goods and are not subject to many changes. This explains why the protection is normally granted as long as the product or good exists and not for 10 years as for the mark system. This general principle is proposed in this provision.

However, for country that would like to limit the duration of protection for 10 years as for the trademarks system, this option is given.

(2) The registration of geographical indication shall be valid from the date of the filing of the application provided that its registration is not cancelled or invalidated according to this Act.

Renewal of protection (ONLY in case of limited duration of protection e.g. 10 years)

The geographical indication applicant/owner/right holder may, within the prescribed period before the registration of geographical indication expires, make a request in the prescribed form to the Registrar for the renewal of the registration. Failing this, the request for renewal may be made within up to six months after the expiry.

COMMENT: This provision is necessary only in case of GI limited duration of protection.

Transfer of geographical indications (OPTIONAL)

The owner/right holder of a geographical indication shall not transfer to any other person, any right to a registered geographical indication under this Act.

Provided that, such rights shall be devolved on the successor of such owner/right holder and that such new owner/right holder complies with the conditions defined in section 12.

COMMENT: As mentioned earlier, normally, GIs are not subject to transfer or licenses. The right is given to the producer/enterprise as legal person. However, some authorities may wish to include a case of GI transfer that shall be limited on a specific situation: the case of the successor of the owner/right holder (in case of death or transfer of ownership/use to another legal person) within the conditions that the new owner/right holder complies with the specific conditions of the GI applicant.

Acknowledgment of Registration

32. All geographical indications duly registered by the competent authority prior to the coming into force of this Act shall be valid.

COMMENT: This provision provides the recognition of previous GI registered under the previous law, even if they do not comply with the new legal framework.

PART VII - Control Compliance of Geographical Indication Specifications

Geographical indication compliance control

33. (1) Geographical indications are subject of control compliance that can cover the following systems:

- The applicant may choose a collective internal control system by groups or association, subject to competent authority validation and audits;

And/or

- The applicant may select a control body which is authorized to deliver relevant controls in COUNTRY. The control body is a competent and impartial public or private body, if possible accredited according to the International Standard Organization or any organization recognized/authorized by the competent authority of COUNTRY which has reliable control system.

COMMENT: This provision considers the GI control system as well as the possibilities of control with a specific control organizations: internal control system, a type of collective control performed by communities for modest costs most of the time, public controls or specific independent control body such as a bureau of standards or ISO accredited body (as for organic farming or fair-trade certifications).

(2) OPTIONAL To verify the effective compliance after registration, the competent authority/competent Ministry may invite the owner/right holder or interested person to provide additional explanation or evidence. The competent authority may request advice from experts in related fields in order to consider and reach a decision if needed.

(3) The control compliance shall ensure the verification of the compliance of goods with the specifications.

OPTIONAL The control body shall send an annual report to the competent authority every year including a list of geographical indication/controlled producers, users, goods, quantities and measures taken if any. The competent authority shall determine the date of the report based on the harvest season or the end of the calendar year.

COMMENT: This provision proposes a link between the control organizations and the competent authority. In this case control organizations shall report annually their activity to the competent authority. The implementation of such provision depends on the willingness of the competent authority to have responsibility for the GI control issues and if yes, if such authority has the resources to understand and monitor the control organization's activity.

(4) **OPTIONAL** In the case of non-compliance with the specifications by any producers or users, the control body shall report to the competent authority appropriate measures and sanctions as follows:

(a)- Remarks and advice;

(b)- Warning;

(c)- Disqualify operator or producer for any lot of his products;

(d)- Temporary revocation of the rights of the operator or producer in relation to the use of the geographical indication;

(e)- Permanent revocation of the rights of the operator or producer in relation to the use of the geographical indication.

COMMENT: This provision provides general information on the sanctions that can be implemented by control organizations in case of non-compliance with the specification. This provision is not compulsory in case of certification process.

(5) The Geographical Indication owner/right holder or producer shall report to the competent authority on the implementation of the measures.

COMMENT: This provision provides competency to the GI owner/right holder to report the monitoring of the GI including the measures taken in order to correct the non-compliance cases with the GI specification. This activity is interesting in order to assess the correct management of the GI.

Efficiency of the control body

34. (1) The competent authority shall verify the competence and the efficiency of the control body.

(2) The competent authority is authorized to withdraw the recognition/authorization of the control body on the grounds of inefficiency by outlining the evidence in writing and may order the applicant to select control body.

(3) If necessary, the competent authority shall define additional regulations for controls after registration of the geographical indication registration.

COMMENT: This provision is additional to the one concerning the reporting of control organization to the competent authority. If the competent authority wishes to have a clear competency on control oversights, it must check the competency of the GI control organizations. However, this all depends on the resources allocated to this competency.

PART VIII - Geographical Indication and Recognition or Rejection of Mark

Geographical Indication and Marks

35. (1) Where a geographical indication is definitely registered in accordance with this Act, the application for registration of a mark corresponding to one of the situations defined in sections 8 (1) and 30 and relating to the same type of goods shall be refused.

(2) The competent authority shall refuse any application for registration of a mark which is identical with or confusingly similar to, or otherwise corresponds to one of the situations defined in sections 8 (1) and 30 a geographical indication applied before the filing date of application for mark registration and the geographical indication is subsequently protected.

(3) Any mark registered in breach of the subsections (1) and (2) shall be invalidated by the Court at the request of any interested party or at the request of competent authority (if possible).

COMMENT: This provision provides rules concerning the relationships between GIs & trademark, in this case posterior trademarks that cannot be registered after GI recognition/registration.

Misleading marks

36. On the motion of the competent authority or of an interested party, the competent authority shall refuse or invalidate the registration of a mark that contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the mark for such goods in COUNTRY is of such a nature as to mislead the public as to the true place of origin or otherwise corresponds to one of the situations defined in sections 8 (1) and 30.

COMMENT: This provision provides rules concerning misleading trademarks that can be refused or cancelled.

Exceptions regarding prior users

37. (1) Nothing in this Act shall prevent continued and similar use in COUNTRY of a particular geographical indication of another country in connection with goods or services by citizens, permanent residents or immigrants of COUNTRY who have used that geographical indication in a continuous manner with regard to the same or related goods or services in COUNTRY:

- (a) for a period of at least 10 years immediately preceding 15th April, 1994; or
- (b) in good faith prior to that date.

(2) Where a trademark has been applied for or registered in good faith, or where rights to a trademark have been acquired through use in good faith

- (a) before date of application of WTO obligations; or

(b) before the geographical indication is protected in its country of origin,

this Act shall not prejudice the registrability of or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication.

(3) Nothing in this Act shall apply in respect of a geographical indication of any country with respect to goods or services for which the relevant indication is identical with the term customarily used in common language as the common name for such goods or services in COUNTRY.

(4) Any request for relief made under PART III of this Act in connection with the use or registration of a trademark must be presented within 5 years after the adverse use of the protected geographical indication has become generally known in COUNTRY or after the date of registration of the trademark in COUNTRY.

(5) Subsection (4) applies only where the trademark has been published by the date of registration of the trademark in COUNTRY, where that date is earlier than the date on which the adverse use became generally known in COUNTRY and provided that the geographical indication is not used or registered in bad faith.

(6) This Act does not affect the right of any person to use, in the course of trade, that person's name or the name of that person's predecessor in business, except where such name is used in a manner that is likely to mislead the public.

COMMENT: This provision covers TRIPS exceptions and is adapted to the one present in the CARIFORUM legal frameworks.

Marks having a reputation or renown

38. A name proposed for registration as a Geographical indication shall not be registered or shall be invalidated at the request of any interested party where, in light of a mark's reputation and renown and the length of time it has been used, registration of the name proposed as the Geographical indication would be liable to mislead the consumer as to the true identity of the product.

COMMENT: This provision covers the case of famous trademarks that can prevent a GI registration.

Coexistence between mark and geographical indication

39. The competent authority shall ensure that, subject to the provisions of section 37 to 39, a mark, the use of which corresponds to one of the situations referred to in section 8 (1), and which has been applied for, registered or established by use, in good faith within COUNTRY, before the date of application of the WTO obligations in COUNTRY, or before the date of application for protection of the geographical indication in COUNTRY, may continue to be used notwithstanding the registration of the geographical indication, provided that no grounds for the invalidity or revocation of the trade mark exist as specified

by laws. In such a cases, the use of the Geographical Indication shall be permitted as well as the use of the relevant mark and the Geographical Indication and the trade mark shall not be used in a manner which may mislead the public as to the identities of the respective goods

COMMENT: This provision covers the case of coexistence between marks and GI.

PART IX - Miscellaneous

Saving

40. Nothing in this Act, nor any provision of the specifications referred to in Section 15(c), shall affect the implementation of rules relating to :

- (a) rules relating to safety and hygiene.
- (b) rules relating to the placing of product on the market, competition rules, anti-fraud and consumer deception, other than specific provisions set out in this Act.

COMMENT: This provision can be useful to prevent the Product specification being used to undermine , e.g. marketing and competition rules etc.

Application of International Treaties and Interpretation

41. The provisions of any international treaties in respect of the geographical indications, to which the COUNTRY is a party, shall apply to matters dealt with by this Act. In case of conflict with provisions of this Act, the provisions of any international treaties shall be considered as principal provisions.

Regulations

42. The Minister may make regulations prescribing anything that is required under this Act to be prescribed, and generally, for the effective operation of this Act.

2. GEOGRAPHICAL INDICATIONS MODEL REGULATIONS

Version OCTOBER 2021

GEOGRAPHICAL INDICATIONS REGULATIONS, YEAR

Authority: These Regulations were made on DATE, by the Minister under section 42 of the *Geographical Indications Act*.

Commencement: DATE

PART I : PRELIMINARY

1. Citation

These Regulations may be cited as the *Geographical Indications Regulations, DATE*.

2. Interpretation

In these Regulations,

"fee" means the fee specified in the *XXXX Schedule*;

"form" means the forms set out in the *XXXXX Schedule*;

"*Official Gazette*" includes such other publication as is approved by the Director/Registrar for the purpose.

3. Language of the documents and translation

Applications shall be in the *official national language*, and any document forming part of an application or submitted to the competent authority pursuant to the Act or these Regulations, and which is in a language other than *official national language*, shall be accompanied by an *official national language [certified]* translation verified by the translator as being to the best of his knowledge complete and faithful.

COMMENT: This provision covers the official language to be used in the GI procedure and translations of the texts. Translations of the act, regulations and forms will be made, and this paragraph adapted accordingly. If necessary, certified translations are covered.

4. Signatures by partnerships, companies & associations

(1) A document purporting to be signed for or on behalf of a partnership shall contain the names of all the partners in full, and shall be signed

(a) by all the parties, or by any partner qualified to sign stating that he signs on behalf of the partnership;
or

(b) by any other person who satisfies the competent authority that he is authorised to sign the document.

(2) A document purporting to be signed for or on behalf of a body corporate shall be signed by a Director or by the Secretary or other principal officer of the body corporate, or by any other person who satisfies the competent authority that he is authorised to sign the document.

(3) A document purporting to be signed for or on behalf of a person or an association may be signed by any person who satisfies the competent authority that he is duly authorised.

5. Representation by attorney-at-law

(1) The appointment of an attorney-at-law shall be made by an authorisation of agent, which shall be signed by the applicant or, if there are more than one, by each applicant.

(2) The authorisation of agent appointing an attorney-at-law may be filed together with the application or within 2 months from its filing date and, if the appointment is not so made or is not in accordance with section 15 (1) of the Act and paragraph (b), any procedural steps taken by the agent, other than the filing of the application, shall be deemed not to have been taken.

COMMENT: This provision covers the representation of GI applicants by an attorney-at-law. The model Law already provides to possibility to be represented. This provision gives further details.

PART II REGISTRATION OF GEOGRAPHICAL INDICATIONS

6. Application for registration Form 1

(1) The application for the registration of a geographical indication shall be made in *Form 1* and shall be signed by the applicant or an authorised agent.

(2) The application shall indicate the applicant's name, address, nationality, residence and its legal status. The application shall also mention information in relation to the geographical indication: name of the geographical indication, goods to be covered by the geographical indication, geographical area, process of production, the quality reputation or other characteristics of the goods, the quality, reputation or other characteristic of the goods and how that quality, reputation or other characteristic (as the case may be) is essentially attributable to the place from which the goods originate, where the geographical indication for which registration is sought relates to a country other than **COUNTRY**, evidence that the geographical indication has obtained recognition or registration as a geographical indication in the qualifying country or countries of origin, where applicable, and the reference to the control body and the labelling rules.

COMMENT: This provision covers the GI application and the concrete content of the application and its form. GI application will include the product specifications.

(3) For the purposes of this regulation,

(a) "name" means, in the case of an individual, that person's family name and given names and, in the case of a legal entity, its full official designation;

(b) "address" means the full address of an individual or, in the case of a legal entity, the address of its registered office;

(c) "nationality" means, in the case of an individual, the State of which that person is a national and, in the case of a legal entity, the State under whose laws it is constituted;

(d) "residence" means the State in which an individual is resident

(e) "legal status" means, in case of organizations or competent authority, the type of status for which the organization or authority is registered or recognized.

(4) An application submitted pursuant to this regulation, shall be signed by the applicant or the applicant's duly authorized agent.

7. Withdrawal of application

(1) An application may be withdrawn by written declaration submitted to the competent authority and signed by each applicant or an authorised agent.

(2) The application fee shall not be refunded if the application is withdrawn.

8. Marking application

(1) Upon receipt, the competent authority shall mark on each document making up the application, the actual date of receipt and the application number consisting of (see each way of giving a number) and, where any corrections or other later filed documents are received on different dates, the Director/Registrar shall also mark their actual date of receipt in the appropriate place of the request for registration of the geographical indication.

(2) The application number allotted under paragraph (1) shall be quoted in all subsequent communications concerning the application.

9. Objection to or conditional acceptance of application

(1) Where upon examination in accordance with section 16 of the Act the competent authority objects to the application for registration of a geographical indication, he shall notify the applicant in writing of his objections with all the relevant details, and invite the applicant to amend the application, to submit his observations in writing or to apply for a hearing within 2 months from the date of the notification; and, if the applicant does not comply with the invitation within the set period, he shall be deemed to have withdrawn his application.

(2) Where upon examination in accordance with section 16 of the Act the competent authority decides to accept the application subject to amendments, modifications, conditions or limitations, communication of the decision to the applicant shall be made in writing.

(3) Where the applicant objects to the amendments, modifications, conditions or limitations referred to in paragraph (2), he/she shall, within 2 months from the date of the communication, request a hearing in writing or submit his/her observations in writing.

(4) Where the applicant does not object to the amendments, modifications, conditions or limitations referred to in paragraph (2), he/she shall notify the competent authority in writing and amend his application accordingly.

(5) Where the applicant does not respond within the set period, he shall be deemed to have withdrawn his/her application.

(6) Upon receipt of a request for a hearing, the competent authority shall give the applicant at least two months notice in writing of the date and time when he/she may be heard.

(7) At the reasonable request of the applicant, the Registrar may provide an extension of time in order, for the applicant, to provide its observation.

COMMENT: This provision covers the case of objection or conditional acceptance of the GI application by the registrar/IP Office and its relationships with the GI applicant.

10. Refusal of application or conditional acceptance to which applicant objects

(1) Where after a hearing or after consideration of the applicant's amendments or observations in writing the competent authority refuses the application or accepts it, subject to any amendments, modifications, conditions or limitations to which the applicant objects, communication of the decision to the applicant shall be made in writing.

(2) The applicant may, within one month from the date of the communication referred to under paragraph, request the competent authority to state in writing the grounds of his decision and the material used by him/her in arriving thereat.

11. Acceptance of application

(1) Where the competent authority accepts the application unconditionally or accepts it subject to any conditions or limitations to which the applicant does not object, he/she shall so notify the applicant, requesting to pay the publication fee within one month from the date of the notification.

(2) Where the publication fee referred to in paragraph (1) is paid within the time limit prescribed, the competent authority shall proceed to publish the application setting out

- (a) the geographical indication for which registration is sought;
- (b) the name, address and nationality of the individual or legal entity filing the application, and the capacity in which the applicant is applying for registration;
- (c) the name and address of any agent;
- (d) the address for service if an agent has not been appointed in accordance with section 16 of the Act and regulation 5;
- (e) the demarcation of the geographical area to which the geographical indication applies;
- (f) the goods for which the geographical indication is used;
- (g) the quality, reputation or other characteristic of the goods for which the geographical indication is used, and any conditions under which the indication may be used;

- (h) the filing date and number of the application;
- (i) the geographical indication specifications is annexed.

(3) Where the publication fee referred to in paragraph (1) is not paid within the specified time limit, the competent authority must remind the applicant in writing once. If the applicant does not pay the publication fee within one month from the date of Registrar letter, the application shall be considered withdrawn.

COMMENT: This provision covers the acceptance of the GI application by the Registrar/IP office, the conditions of GI publication and the content of the publication. Publication is conditional on the payment of fee.

12. Objection to or conditional acceptance of application; hearing

(1) A notice of objection/opposition under section 17(1) of the Act shall be given in Form XXX within 3 months of the date of the publication referred to in regulation 11(2), and shall be accompanied by the specified fee and any supporting evidence.

(2) A counter-statement referred to in section 17(4) & 17(5) of the Act

- (a) shall be subject to the payment of the specified fee;
- (b) shall be given within 3 months of the date on which the notice of objection/opposition is sent to the applicant;
- (c) shall be in writing, stating the grounds specified in section 17(2) upon which the applicant relies for his application; and
- (d) shall be accompanied by any supporting evidence.

(3) A request for a hearing under section 17(5) of the Act shall be made to the competent authority in writing at any time after the filing of the notice of objection/opposition, but not later than one month after the expiry of the specified period for filing the counter-statement.

(4) The competent authority shall give the parties at least one month's written notice of the date set for the hearing; and each party shall, within that period, pay the specified fee for the hearing.

(5) Where the objector/opponent or the applicant does not reside or carry on business in COUNTRY, the competent authority may require to give security for the costs of the objection/opposition proceedings for such amount as the competent authority thinks fit.

(6) Where the competent authority decides to register the geographical indication under section 18(1) of the Act, any objector and the applicant will be notified in writing, stating the reasons for the decision and, in the case of the applicant, requesting him to pay the registration fee as specified in article 11(3).

(7) Where the competent authority decides to refuse to register the geographical indication under section 18(3) of the Act, the objector/opponent and the applicant will be notified in writing, stating the reasons for his decision.

COMMENT: This provision provides a procedure concerning the case of GI application objection/opposition. Not many timelines are given in order to provide flexibility to the Registrar/IP Office.

13. Registration of geographical indication

(1) Subject to the payment of the registration fee within the period specified in regulation 11(3), the competent authority shall register the geographical indication in accordance with section 18 of the Act and this regulation.

(2) The registration of the geographical indication shall include

- (a) the geographical indication registered;
- (b) the demarcation of the geographical area to which the geographical indication applies;
- (c) the name and address of the individual or legal entity in whose name the indication is registered;
- (d) the name and address of any agent;
- (e) the address for service if an agent has not been appointed in accordance with xxxx;
- (f) the goods for which the geographical indication is used;
- (g) the quality, reputation or other characteristic of the goods for which the geographical indication is used and any conditions under which the indication may be used;
- (h) the filing date and number of the application as well as the date of registration;
- (i) in case of foreign geographical indication, the country of origin;
- (j) the geographical indication specification.

(3) The publication of the reference to the registration of a geographical indication shall contain the particulars specified in paragraph (2).

(4) The certificate of registration of the geographical indication shall be issued in **Form xxxxx**.

COMMENT: This provision provides information concerning the GI registration, namely the fee, the content of GI publication and certificate.

14. Cancellation or rectification/amendment of geographical indication registration

(1) The publication referred to in section 25 of the Act shall

- (a) identify the geographical indication by setting out the particulars referred to in regulation 13(2) in case of geographical indication registration;
- (b) identify the person who, or the authority which, has applied for the cancellation or rectification/amendment of the registration of the geographical indication by setting out the name and address of the person or authority, and of the representative or any agent; and
- (c) specify the period within which the persons having the right to use the geographical indication under section 30 of the Act may apply to join in the proceedings.

(2) The period to be specified by the Court under section 21 of the Act shall not be less than one month from the date of the notice or publication, as the case may be.

(3) Where the Court notifies the competent authority under section 21(3) of the Act that a decision has been taken to cancel or rectify /amend the registration of the geographical indication, the competent authority shall cancel the registration or rectify/amend it in accordance with and in the manner specified in the Court's decision, as the case may be.

(4) The publication under section 21(4) of the Act of the reference to the cancellation or rectification/amendment of the registration of a geographical indication shall

(a) identify the geographical indication by setting out the particulars referred to in regulation 13(2);

(b) indicate that the registration of the geographical indication has been cancelled or rectified/amended, as the case may be, and, if rectified, specify the manner in which the registration has been so rectified; and

(c) cite the decision of the Court, if any, by which the registration of the geographical indication has been cancelled or rectified/amended.

COMMENT: This provision provides a procedure concerning the case of request for cancellation or amendment/rectification of the GI registration. Not many timelines are given in order to provide flexibility to the Registrar/IP Office.

15. Publication

Particulars of geographical indications and other proceedings under the Act and any other information required to be published under the Act or these Regulations shall be published, in accordance with the directions of the competent authority, in the *Official Gazette/IP Journal/in a newspaper published daily*.

16. Renewal of protection (if integrated in the Act)

The request for geographical indication renewal shall be submitted in the six-month period prior to the expiry of the registration. The basic fee for the renewal and, where appropriate, one or more class fees for each class of goods or services exceeding the first one shall also be paid within this period. Failing this, the request may be submitted and the fees paid within a further period of six months following the expiry of registration, provided that an additional fee for late payment of the renewal fee or late submission of the request for renewal is paid within this further period.

COMMENT: This provision provides rules concerning the renewal of protection in case of GIs that are registered for 10 years..

Transfer of GI ownership/use (if integrated in the Act)

A request under section XXXX of the Act to transfer the ownership/use of a geographical indication shall be made using *Form XXXX* and shall be subject to the payment of the specified fee.

COMMENT: This provision provides rules concerning the renewal of protection in case of GIs that are registered for 10 years..

PART III SPECIAL PROVISIONS CONCERNING TRADE MARKS

COMMENT: This part III takes into account existing provisions in the CARIFORUM GI legal framework.

17. Refusal or invalidation of registration of misleading mark, form

(1) A request under section 36 of the Act to refuse or to invalidate the registration of a misleading trade mark shall be made using *Form XXXX* and shall be subject to the payment of the specified fee; and the procedure set out in regulation 12 shall apply *mutatis mutandis*.

(2) Where the competent authority on his/her own motion decides to refuse or invalidate the registration of a trade mark pursuant to section 36 of the Act, competent authority shall, in writing, notify the registered owner of the mark, stating the reasons for the decision and giving at least one /two month(s) to submit a counter-statement and to request a hearing.

(3) Where a hearing is requested, the competent authority shall give the registered owner of the trade mark at least one month's written notice of the date set for the hearing; and the registered owner shall, within that period, pay the specified fee for the hearing.

(4) The competent authority shall notify the registered owner under paragraph (3) in writing of the final decision, stating the reasons therefor.

18. Refusal or invalidation of a mark conflicting with geographical indications, form

(1) A request under section 35(3) of the Act to refuse or to invalidate the registration of a trade mark which conflicts with a geographical indication shall be made using *Form xxxx*, and shall be subject to the payment of the specified fee; and the procedure set out in regulation 12 shall apply *mutatis mutandis*.

(2) Where the competent authority on his own initiative decides to refuse or invalidate the registration of a trademark pursuant to section 35 of the Act, competent authority shall in writing so notify the registered owner of the mark, stating the reasons for the decision and giving at least one/two month(s) to submit a counter-statement and to request a hearing.

(3) Where a hearing is requested, the competent authority shall give the registered owner of a trade mark at least one month's written notice of the date set for the hearing, and the registered owner shall within that period pay the specified fee for the hearing.

(4) The competent authority shall notify the registered owner of the trade mark in writing of the final decision, stating the reasons therefor.

19. Publication of invalidation of registration of mark

(1) The competent authority shall record and publish a reference to the invalidation of the registration of a trade mark pursuant to section 35 or 36 of the Act.

(2) The publication of the reference to the invalidation of the registration of the trade mark pursuant to section 35 or 36 of the Act shall include

- (a) the representation of the trade mark;
- (b) the registration number of the trade mark;
- (c) the name and address of the registered owner;

- (d) the date of registration;
- (e) the list of goods and services in respect of which the trade mark was registered, with an indication of the corresponding class or classes of the International Classification; and
- (f) an indication of the grounds on which the registration of the trade mark has been invalidated.

PART IV GENERAL

COMMENT: This part IVI takes into account existing provisions in the CARIFORUM GI legal framework.

20. Address for service

- (1) There shall be furnished to the competent authority,
 - (a) by every applicant for the registration of a geographical indication, an address for service in COUNTRY for the purpose of his application; and
 - (b) by every person concerned in any proceedings to which these Regulations relate, including the applicant for, or the owner/right holder of a geographical indication, an address for service in COUNTRY; and the address so furnished or, where another address being an address in COUNTRY has been furnished in place thereof, that address, shall be treated for the purposes of that application or those proceedings as the address of that applicant or of that person, as the case may be.
- (2) Where an agent has been appointed in accordance with section 15 of the Act and regulation 5, the address of the agent shall, for all purposes connected with the Act and these Regulations, be treated as the address to which communications to the person who appointed the agent shall be transmitted.

21. Inspection of Register

Inspection of the Register shall be subject to payment of the specified fee, and requests for certified copies of extracts from the Register or for copies of documents shall be made to the competent authority in writing and shall be subject to payment of the specified fee.

22. Entries of changes in the Register

The competent authority shall cause to be entered in the Register in respect of every geographical indication the information indicated in regulation 13(2), as well as any change with respect to that information, in particular, any change in the name, address or address for service indicated therein.

23. Correction of errors

Corrections of errors referred to in section 22 of the Act

- (a) may be made by the Director/Registrar either upon receipt of a request in writing and subject to such terms as he may consider appropriate or on his own initiative;
- (b) shall be communicated in writing to all interested persons; and
- (c) where considered necessary, shall be published in the *Official Gazette/IP Journal/Newspaper* by the Director/Registrar.

24. Hearing

(1) The competent authority shall, before deciding adversely in respect of any person any discretionary power given to him by the Act or these Regulations, notify that person in writing of the opportunity to be heard thereon, and shall indicate a time limit of not less than one month for filing a request for a hearing.

(2) The request for a hearing shall be in writing and shall be subject to payment of the specified fee.

(3) Upon receiving a request for hearing, the competent authority shall give the person applying and any other interested person at least one month's notice in writing of the date and time of the hearing.

(4) After hearing any party desiring to be heard, the competent authority shall decide the matter and shall notify all parties of his decision and, if any party so desires, shall give his reason for the decision.

25. Direction as to furnishing of documents

At any stage of any proceedings before the competent authority, he may direct that such documents, information or evidence as he may require be furnished within such period of time as he may fix.

26. Dispensation by the competent authority

Where under these Regulations any person is required to do any act or thing or any document or evidence is required to be produced or filed and it is shown to the satisfaction of the competent authority that from any reasonable cause that person is unable to do that act or thing or that that document or evidence cannot be produced or filed, the competent authority may, upon the production of such evidence and subject to such terms as he thinks fit, dispense with the doing of any such act or thing or the production or filing of such document or evidence.

27. Evidence

(1) Evidence under these Regulations may be given by statutory declaration or affidavit.

(2) The competent authority may, if deemed necessary, in any particular case, take oral evidence *in lieu* of or in addition to evidence referred to under paragraph (1), and shall allow any witness to be cross-examined on the affidavit or declaration.

28. Administrative directions

Where no provision is made in the Act or these Regulations in respect of any matter arising in the administration of the Act, the competent authority may give such directions in respect thereof as deemed necessary in the circumstances.

29. Inquiries at the Office

The competent authority may acknowledge inquiries made to the Office, but need not furnish the applicant or any other person with information which would require a search of the public records of the Office, or provide advice on matters concerning the interpretation of the Act or these Regulations or any other question of law.

30. Annexed Schedule to forms

(1) Where any information required to be set out in a form furnished by the competent authority is too lengthy to be set out in the space provided, the person completing the form may, subject to paragraph (2), incorporate the information in the form by setting out in the space provided in the form the following sentence: "The annexed schedule is incorporated in this form", and by annexing the information to the form as that schedule.

(2) A separate schedule is required in respect of each item that is incorporated in a form by reference pursuant to paragraph (1).

31. Fees

The fees specified in the **XXXX Schedule** are payable in respect of the matters to which they relate.

COMMENT: This provision provides a list of potential fees, based on the content of the Regulation. We ask States to share their current fees or what they consider appropriate fees, in order to provide a comparative table but did not receive any information from the States.

Examples of fees schedule to be included in the Regulations. The exact type of fees and amounts shall be defined by national authorities.

Matter or Proceeding	Fee \$
1. Application for registration of geographical indication	
2. Request for hearing	
3. Request to the competent authority to state in writing, grounds of decision to refuse application or to accept it subject to conditions	
4. Publication fee	
5. Notice of objection to registration of geographical indication	
6. Counter-statement to notice of objection	
7. Application for cancellation or rectification/amendment of geographical indication registration	
8. Registration fee	
9. Renewal registration fee	
10. Request to refuse or to invalidate the registration of a misleading trademark.	
11. Hearing relating to request to refuse or to invalidate the registration of a misleading trademark	
12. Request to refuse or to invalidate the registration of a trademark which conflicts with a geographical indication for wines and spirits	
13. Hearing relating to request to refuse or to invalidate the registration of a trademark which conflicts with a geographical indication for wines and spirits	
14. Inspection of Register	
15. Request for certified copies of extracts from Register or for copies of documents (per page)	
14. Request for correction of error	
15. Integration in the list of GI users	
16. Use of the national GI logo	

PART V - GEOGRAPHICAL INDICATION BOARD (OPTIONAL)

COMMENT: This part V provides information concerning all the aspects of the functioning of the GI Board.

Given the specific technical issues that can be raised during GI examination, the competent authority may need some specific technical knowledge or expertise not available within the IP Office. In this case some external experts could be identified/appointed to assist in the examination/decision process either individually or through the possible creation of a GI Board.

Maybe some detailed provisions could be integrated in a sub-regulation.

32. Creation of the GI Board

(1) The Ministry of XXXX establishes a GI Board with the main purpose of examining applications for geographical indications, promoting the geographical indications system in the COUNTRY

OPTION : and dealing with any appeal against the registration of a geographical indication.

(2) The GI Board is located within the XXXX, recognized as the competent authority on Geographical Indication matters by the section 3 of the Act.

(3) Decisions of the GI Board are binding the final decision of the competent authority.

33. Powers and duties of the GI Board

The Geographical Indication Board shall have the following powers and duties:

- to study and to promote potential goods to be registered and protected under Geographical Indication in the COUNTRY,
- to consider and to decide any appeal against a decision of the competent authority under the Act and regulations,
- to propose or order rectification/amendment or cancellation of a registered Geographical Indication over the decision of the competent authority,
- to provide advice and recommendations to the competent authority in relation to Geographical Indications matters,
- to consider and to appoint experts from relevant sectors,
- to perform any other instruction in relation to Geographical Indication matters received by the

COMMENT: This provision provides a list of potential powers and duties of the GI Board. It covers what exists in other GI legal frameworks.

34. Composition of the GI Board

(1) The GI Board shall be composed of at least 5 members.

(2) The composition of the Geographical Indication Board may consist of: (choose and adapt as necessary)

- The competent authority of Intellectual Property Office as a member and President of GI Board Secretariat.
- a Senior Official of the Ministry of XXXX in charge of Intellectual Property or his representative as the Board Chairman.
- Representatives of the Ministry of Agriculture, Forestry and Fisheries as a member.
- Representatives of the Ministry of Mines and Energy as a member.
- Representatives of the Ministry of Industry and Handicraft.
- Representatives of the Ministry of Law/Legal Affairs.
- Representatives of authorities or institutions in charge of inspecting and/or controlling the quality of goods.
- Qualified persons from organizations or agencies related to consumers' protection.
- Representatives of private sectors.
- Other qualified expert(s).

(3) The GI Board members are appointed by the XXXX, based on a list of representatives, proposed by the concerned Ministry, authorities, institutions, organizations or agencies. The XXXX shall issue a letter of mission for each member of the GI Board.

(4) Each concerned ministry, authority, institution, organization or agency shall appoint at least 2 representatives to take part in the activities of the GI Board .

COMMENT: This provision provides information concerning the composition and the appointment of the GI Board. It covers what exists in other GI legal frameworks.

35. Duration of the appointment

(1) Members of the Geographical Indication Board as referred to in the section 34 shall be appointed and dismissed by the XXXX for a term of 3 three years. A retiring Member may be reappointed.

(2) Apart from retirement upon expiration of their term, the GI Board Members who are qualified persons shall cease to hold their positions upon the following reasons:

(a) Death

(b) Resignation from the concerned member notified by registered letter

(c) Resignation on XXXX request

(d) Being incompetent or quasi-incompetent

(e) Exclusion pronounced by the XXXX for serious reasons, the concerned member has been previously invited by mail, if necessary by registered mail, to provide explanations to the GI Board.

(3) In the event of appointment of a Board Member who is a qualified person in place of a Board Member who leaves his office before the expiration of his term, or in case of appointment of additional Board Member who is a qualified person while the Board Member previously appointed are still holding their positions, such appointed person shall be in office for a period equal to the remaining term of the Board Member previously appointed.

36. Experts' appointment

In implementing its duties and functions as referred to in section 33, the Geographical Indication Board can be assisted by one or several experts. In these circumstances, the GI Board chairman may appoint one or more experts on a proposal of their related organizations to take part, as adviser, to the works of the GI Board.

37. Sub-committees

(1) The Geographical Indication Board is empowered to appoint subcommittee(s) to make consideration or to perform any specific tasks assigned by the Board.

(2) The subcommittees are composed of members of the GI Board and any other relevant expert(s) that could assist in the completion of the task conferred by the GI Board.

(3) The GI Board is empowered to end the subcommittees once the task has been performed.

38. Secretariat of the GI Board

(1) The competent authority shall be assigned as President of the GI Board Secretariat.

(2) The office of the secretariat of the GI Board is located at the Intellectual Property Office. If necessary, the President of the Secretariat of the GI Board shall assign any officials of the Intellectual Property Office as his/her assistants.

(3) Members of the GI Board may, if necessary, assist the Secretariat in the implementation of its tasks.

39. Secretariat's duties

(1) The Secretariat of the GI Board shall ensure the implementation of administrative tasks of the Board as follows sending invitations, drafting minutes of the various meetings of the GI Board and, in general, all writings concerning the operation of the GI Board, except those related to accounting.

(2) The Secretariat is also responsible for the development of the GI Board by participating in meetings, taking operational decisions and overseeing its communication policy.

40. GI Board Meetings

(1) Members of the GI Board and the sub committees shall meet at the invitation of the Board Chairman as often as their duties defined in the section 33 request .

(2) The meeting may be convened by any means, but at least 07 days in advance.

(3) The agenda is defined by the Board President.

(4) The GI Board secretariat shall hold the minutes of the GI Board meetings. The minutes are drawn up without blanks or deletions and signed by the Board President and one other member. They are transcribed in chronological order.

41. Quorum rules

(1) The members of the GI Board shall attend the meeting personally/virtually following the invitation of the Board President.

(2) If a member cannot attend the meeting, he/she can be represented by a colleague from the same institution who has been nominated by its institution, as referred to in section 34.

(3) For the meeting to be held, the quorum shall be more than half of the total number of the GI Board Members.

(4) In case of absence or inability to carry out the duty by the Board President, the present members shall designate a GI Board member to preside over the meeting.

42. Decisions of the GI Board

(1) Decisions of the meetings held by the GI Board shall be adopted by fifty percent plus one vote (50+1). Each Board Member shall have one vote. In the event of a tie, the vote of the Board Chairman shall be predominant.

(2) The provisions set in paragraph (1) shall apply to the meetings of the subcommittees *mutatis mutandis*.

43. Internal rules

The GI Board may, if appropriate, elaborate and adopt internal rules that clarify its functioning.

PART VI - GEOGRAPHICAL INDICATION NATIONAL LOGO

COMMENT: This part VI provides explanation on the creation and the use of a GI national logo. This logo could be used for national GI products as well as for foreign GI products registered in the country. The use of a GI logo is important in order to spread the knowledge of the quality scheme to the public.

44. Creation of the National Logo

(1) As mentioned in section 27 of the Act, a National logo designed to label protected geographical indications is established. This National logo shall be administered by the XXXX.

(2) The COUNTRY Geographical Indication Logo shall be illustrated below:

INCLUDE AN ILLUSTRATION OF THE LOGO –
EXAMPLES:



(3) The logo consists of the words “Protected Geographical Indication” written in OFFICIAL LANGUAGE.

45. Condition to use the National Logo

(1) Protected geographical indications and the National Logo may be used by any producer or operator producing and/or marketing a product conforming to the corresponding specifications.

(2) A person wishing to use the National Geographical Indication Logo as referred to in paragraph (1) and section 45 of the Regulations shall apply either via the Geographical Indication Association or directly to the Intellectual Property Office and receive prior permission from the competent authority.

(OPTION) The Intellectual Property Office is empowered to issue permission to use the National Logo.

COMMENT: The last sentence of the provision is only a proposal

(3) In the case of products originating in the COUNTRY that are marketed under a protected geographical indication registered in accordance with the procedures laid down in these Regulations, the National Logo associated with it shall appear on the labelling. In addition, the registered name of the product should appear in the same field of vision. The indications ‘protected geographical indication’ or the corresponding abbreviations or ‘PGI’ may appear on the labelling.

(4) In the case of products originating in third countries marketed under a name entered in the register, the indications referred to in paragraph 2 or the National logo associated with them may appear on the labelling.

46. User of the National Logo

(1) Persons having the right to use the National Geographical Indication Logo must have the following qualifications:

a) GI direct users

- being the geographical indication owner/right holder
- being a producer or a member of the geographical indication association;
- complying with the geographical indication specifications.

b) GI indirect users

- being a retailer, trader or any person who places the product on the market and promotes that product.

(2) Permission to use the National logo:

- **OPTION 1**: is subject of fees
- **OPTION 2**: is not subject of fees.

(3) Users are entitled to produce their own National logo stickers, labels or packaging according to the specifications provided by the Intellectual Property Office.

COMMENT: This provision defines who is entitled to use the GI national logo, the existence or not of fees and the type of uses.

47. Control of the National Logo

(1) The Intellectual Property Office /Registry shall manage and update a list of persons allowed to use the National Geographical Indication Logo. The list of the allowed persons shall remain available for consultation at the Intellectual Property Office/ Registry upon request of any interested person / or accessible on the website of the IPO.

COMMENT: This provision provides a list GI logo users managed by the IP Office. The existence of such a list can be interesting in order to manage the use of the logo and identify the potential logo misuses.

(2) In case the Intellectual Property Office/ Registry later finds the person allowed to use the National Geographical Indication Logo does not comply with the provisions set out previously, the Intellectual Property Office/ Registry has the right to request the said allowed person to come and provide information or documents or other items as necessary to assist in its deliberations. The Intellectual Property Office/ Registry is entitled to take administrative actions and sanctions in case of infringements to the National logo.

COMMENT: This provision provides conditions in relation to basic uses of the logo. IP Offices are proposed to manage these situations. However, we do not know if such competencies could be considered in the CARIFORUM countries legal framework.

(3) Entitlement to use the National Geographical Indication Logo shall be revoked in the following circumstances:

a) If any allowed person uses the National Logo in ways other than specified in the present article, the Intellectual Property Office/ Registry has the right to revoke the allowance to use the National Geographical Indication Logo and the person allowed to use the National Geographical Indication Logo must cease to use the said Logo.

b) In case the registration of a geographical indication according to section 20 of the Act has been invalidated or cancelled, it shall be deemed that permission to use the National Geographical Indication Logo is also invalidated or cancelled.

(4) When a right to use the National Geographical Indication Logo has been invalidated or cancelled, the allowed person must return the allowance document to the Intellectual Property Office within 30 days of written notification regarding such decision.

48. Duration of the authorization

The authorization to use the National Geographical Indication Logo lasts as long as the authorized person complies with the rules of the concerned geographical indication.

PART VII – MISCELLANEOUS

49 List of geographical indications

The competent authority shall publish from time to time, in the Official Gazette/IP Journal/Newspaper published daily, a list of the geographical indications registered in accordance with the Act.

COMMENT: This provision proposes to establish a list of GIs published by the IP Office. This information is important in order to provide information about the registered GIs.

MISSING PROVISIONS

Section 8.2 of the Act, provisions concerning implementation of offences : who, how? Some more information on this matter is requested. Will the IPO be competent?

3. ADDITIONAL COMMENTS

3.1. Additional text on TK for inclusion in Model GI Law

1. Please insert new paragraph in s. 7 [Exclusion from geographical indication protection] as follows:

Indications that use, utilize, concern, involve, contain, include or otherwise rely on or benefit from or incorporate any genetic resources, traditional knowledge and/or traditional cultural expressions or their derivatives, without the consent of the holder of the genetic resource, traditional knowledge and/or traditional cultural expression or derivative.

COMMENT : We do not see how to integrate this provision as it will recognize rights to “genetic resource, traditional knowledge and/or traditional cultural expression or derivative”. However, these rights are not clearly recognized in many legal frameworks as such. Including this provision will mean recognizing such rights and GIs will not have such “power” to recognize these rights as such.

The condition “without the consent of the holder of the genetic resource, traditional knowledge and/or traditional cultural expression or derivative” could be managed in the specifications.

2. Please insert new paragraph in s. 8 [Prohibition against improper use of geographical indication] as follows:

In the designation or presentation of the goods by any means, indicate or suggest that the goods are made by or originate in an Indigenous or local community, that is liable to mislead the public as to the nature or geographical origin of the goods.

COMMENT : Our comment is linked to the previous one. What is the definition of “indigenous”, of “local community”? Is there an international/national definition? Proposed provisions in section 8 will cover broadly the misleading uses of GI. It will be more relevant to specify in the specification who is able to produce GI products – including local communities, then the GI right holder will have a legal bases to fight against such misuses.

3. Please insert new paragraph in s. 15(1)(c) [Content of geographical indications application] as follows:

information on the country of origin, country of source, community of source and the resource provider of any genetic resources, traditional knowledge and traditional cultural expressions or their derivatives which are used, utilized, contained, included or otherwise incorporated in the geographical indication or geographical indication value chain or process

COMMENT : Same comment as for the 1st proposal.

3.2. Examples of fines and imprisonment for GI offences

Country	Fines	Imprisonment	Other
Antigua & Barbuda	Summary conviction Maximum 55,000\$	Summary conviction Maximum 3 years	
Guyana	Summary conviction 20,000\$	Summary conviction 2 years	Both
Jamaica	Case of summary conviction : maximum 1 million \$ Case of conviction before a Circuit court: not defined	Case of summary conviction : maximum 12 months Case of conviction before a Circuit court: maximum 5 years	Both fines & imprisonment
Saint Lucia	Summary conviction 10,000\$	Summary conviction 2 years	Both?
Saint Vincent & the Grenadines	Summary conviction 10,000\$	Summary conviction 2 years	Both
Trinidad & Tobago	Summary conviction 8,000\$	Summary conviction 3 years	Both
France (French consumer code – Misleading commercial practices)	Maximum 300 000€	Maximum 2 years	Prohibition to exercise public or social job or an industrial or commercial job in relation to the GI offence during maximum 5 years.

Other provisions present in the CARIFORUM countries GI legal framework:

In proceedings under this section, the Court may, in addition issue an injunction to award damages and grant any other civil remedy or relief as it shall consider appropriate.

3.1. Examples of timelines

Cambodia

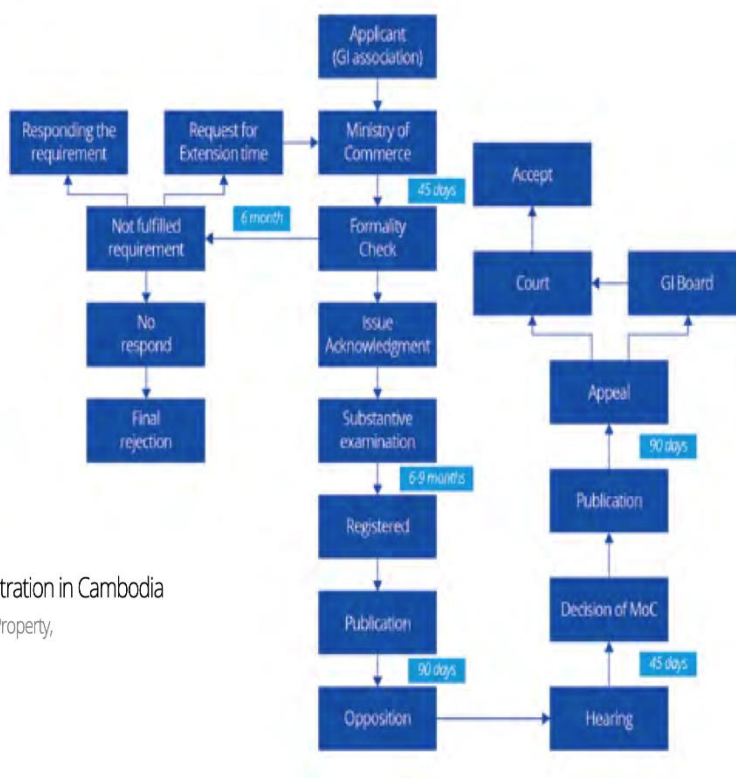


Figure 2: Procedure for GI registration in Cambodia

Source: Department of Intellectual Property, Ministry of Commerce, Cambodia

CONTACT DETAILS

Ministry of Commerce

Source: Arise + ASEAN

Thailand

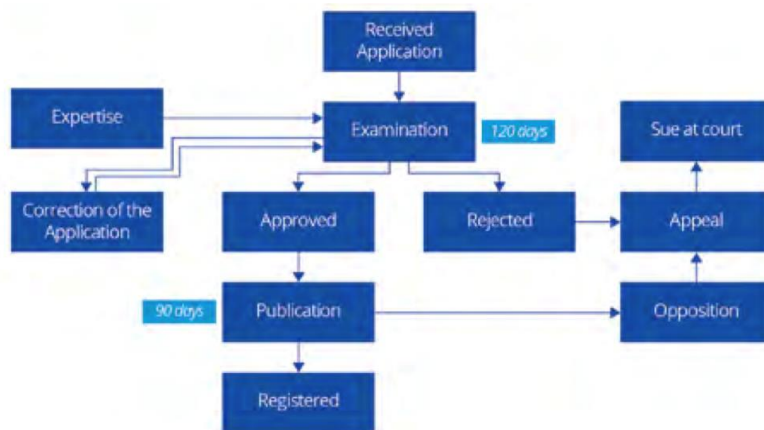
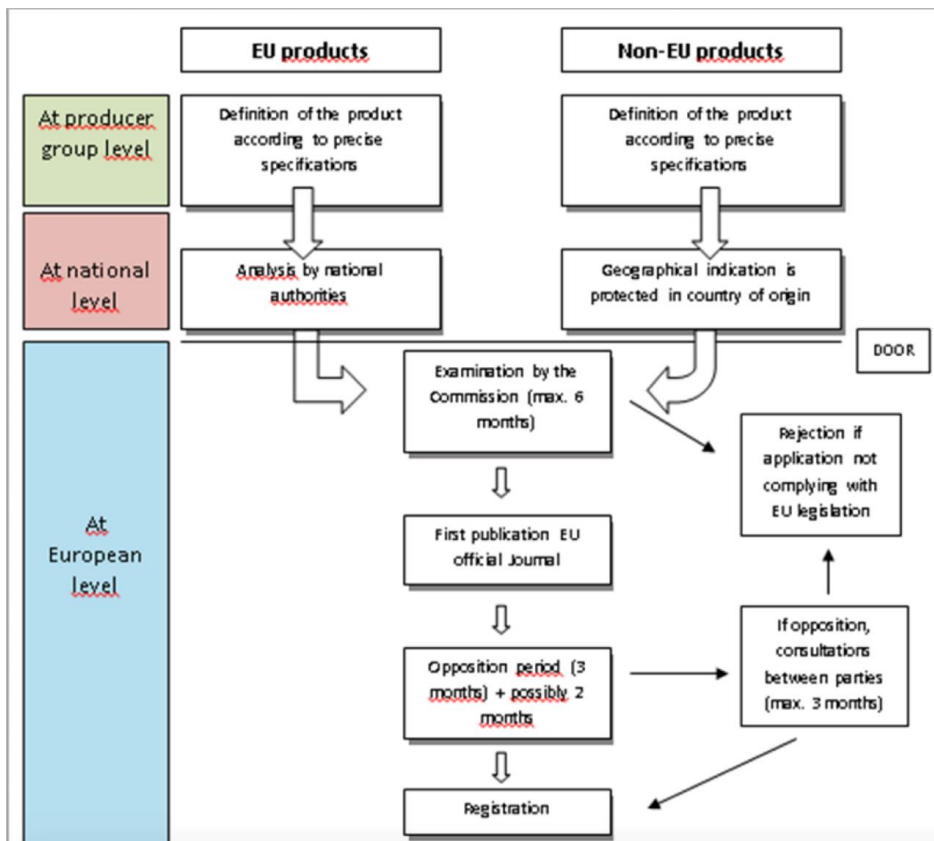


Figure 6: Procedure for GI registration in Thailand
 Source: Department of Intellectual Property, Ministry of Commerce, Thailand

Source: Arise + ASEAN

European Union

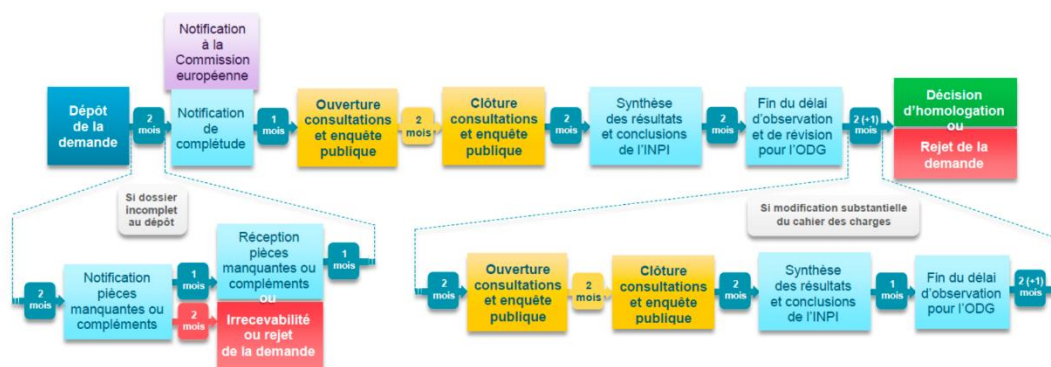


Source: DG Agri, European Commission

France

For wines, agricultural or agro-food products: no timeline.

For industrial and craft products:



Source French IPO, INPI

Timeline: between 1,5 and 2 years maximum.