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of Intellectual Property Rights**

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REVIEW UNDER ARTICLE 24.2 OF THE APPLICATION OF THE PROVISIONS OF THE SECTION OF THE TRIPS AGREEMENT ON GEOGRAPHICAL INDICATIONS

Responses to the Checklist of Questions¹

Addendum

The Secretariat has received the following responses from the Permanent Delegation of the European Commission in a communication dated 26 November 1998.

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¹ Documents IP/C/13 and IP/C/13/Add.1.

* Responses to the questions in document IP/C/13 only.

Responses from the European Communities

INTRODUCTORY REMARK

In general, Member States' replies focus on national law. The responses by the Community mainly cover European Community law, which includes Regulations directly applicable in Member States.

I. RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13

A. GENERAL

1. Is protection for geographical indications provided through unfair competition law, e.g., passing off, false designation of origin; through a formal procedure for notification/registration before protection is available; or through both? Does the recognition of a geographical indication require registration?

Wines and spirits

At Community level the recognition of a geographical indication for wines requires its recognition by the Producer Member State as well as registration and publication in the Official Journal of the European Communities (Article 1, paragraph 3 of Regulation No. 823/87; Article 72, paragraph 2 of Regulation (EEC) No. 822/87; and Article 2, paragraph 3, point (i) of Regulation (EEC) No. 2392/89). This system provides protection ex officio.

In addition, Council Regulation (EEC) No. 823/87 lays down the conditions which must be respected by Member States for the recognition of quality wines produced in specified regions (quality wines PSR = produced in specified regions). The provisions of the Regulation concern, in particular, the following: demarcation of the area of production; vine varieties; minimum alcohol content; yield per hectare; analysis and assessment of organoleptic characteristics, etc. (Article 2). Member States adopt the specific provisions and recognize the geographical indications of the wines produced in their territory (Article 3.1). The Commission is responsible for the publication of all the geographical indications recognized by the Member States.

Council Regulation (EC) No. 3290/94, Annex XVI, modifies Council Regulation (EEC) No. 822/87, which establishes a common market organization for wine, by adding Article 72a, which implements Article 23.1 of the TRIPS Agreement.

For spirit drinks and aromatized wines, Article 5 of Council Regulation (EEC) No. 1576/89 and Article 6 of Council Regulation (EEC) No. 1601/91 respectively lay down the rules concerning the use of geographical indications in relation to spirit drinks or aromatized wines from the Community, the list of which is contained in annexes to these Regulations.

Regulation (EC) No. 3378/94 has modified the provisions concerning spirits and aromatized wines. It modifies the above-mentioned Regulation No. 1601/91, which lays down rules for the definition, description and presentation of aromatized wines, by adding Article 10a, which implements Article 23.1 of the TRIPS Agreement. It also modifies the above-mentioned Regulation No. 1576/89 on the description and presentation of spirit drinks, by adding an Article 11a, implementing Article 23.1 of the TRIPS Agreement in respect of spirits.

In the context of the implementation of the WTO Agreement, Council Regulation (EC) No. 3288/94 has amended Council Regulation (EC) No. 40/94, on the Community trademark. In particular, to Article 7(1) of Regulation No. 40/94, which lays down the absolute grounds for refusal of the registration of a trademark, a paragraph is added to the effect that geographical indications for wines and spirits shall be refused registration if the wines and spirits do not have that origin.

Concerning wines, the general rule is contained in Article 40, paragraph 1, first indent of Council Regulation (EEC) No. 2392/89, which envisages that the description and presentation of wines and grape musts, and any form of advertising for such products, must not be incorrect or likely to cause confusion or to mislead the persons to whom they are addressed as regards, among other things, geographical indications. This provision shall apply even if the indication is used in translation, or with reference to the actual origin, or with additions such as "type", "style", "method", "imitation", "brand" or the like.

Other geographical indications in relation to agricultural products and foodstuffs

Council Regulation (EEC) No. 2081/92 sets out the procedure for the registration of geographical indications in the Community territory. The procedure contained in Articles 5, 6 and 7 is as follows:

- (1) A group of producers must submit a detailed application for registration to the competent authority of the Member State, in accordance with the conditions specified in the Regulation.
- (2) If the application is considered to be in conformity with the Regulation, it shall be referred to the Community authorities, who will verify that the conditions of the Regulation have been formally satisfied and will publish the application in the *Official Journal* to allow other parties the opportunity to raise objections.
- (3) If an objection is raised, the final decision on registration is taken by the Commission and the Member States.

The Member States are responsible for controlling the application of the Regulation.

When a name is registered in conformity with the definitions and the procedure established in the Regulation, it is protected *ex officio* (against the uses as referred to in Article 13).

In addition, Council Directive No. 79/112/EEC of 18 December 1978 (on the approximation of the laws of the Member States relating to the labelling, presentation and advertising of foodstuffs for sale to the ultimate consumer) provides in Article 2(a)(i) that the labelling and methods used must not be such as could mislead the purchaser, *inter alia*, as to origin or provenance of the foodstuff. This applies also to the presentation of foodstuffs and to advertising .

Article 2 of Directive (EEC) No. 84/450 relating to the approximation of laws, regulations and administrative provisions of Member States concerning misleading advertising, provides for a definition of misleading advertising which may result in unfair competition by reason of its deceptive nature. Article 3 considers, in particular, any information it contains concerning geographical or commercial origin as relevant criterion in determining whether advertising is misleading. Article 4 deals with the legal means Member States shall provide for the control of misleading advertising in the interest of consumers as well as competitors and the general public.

2. *Is there one single regime of protection of geographical indications for all products? If not, identify the different regimes.*

No, at Community level there exist different regimes for the protection of geographical indications (see also the reply to question no. 1):

Wines: Regulation (EEC) No. 823/87 and No. 2392/89 laying down special provisions relating to quality wines produced in specified regions;

Spirits: Regulation (EEC) No. 1576/89 laying down general rules on the definition, description and presentation of spirit drinks;

Table wines: Regulation (EEC) No. 2392/89 establishing general rules for the designation and presentation of wines and grape musts;
Regulation (EEC) No. 822/87 on the common organisation of the market in wine;

Other agricultural products and foodstuffs:
Regulation (EEC) No. 2081/92 on the protection of geographical indications and designations of origin for agricultural products.

In addition, Article 2 of Directive No. 79/112 applies.

3. *Do(es) the regime(s) of protection of geographical indications also extend to services?*

No, not at a Community level.

4. *What provisions of law or regulations are directed to the recognition of geographical indications required by Articles 22.2 and 23.1 of the TRIPS Agreement? Citations to laws should be provided and, if the texts of the laws have not been notified to the WTO, copies should be provided pursuant to Article 63.2.*

The following provisions have been introduced to ensure that the protection of geographical indications required by Article 22 and 23 of the TRIPS Agreement is correctly implemented (see also the reply to question no. 1):

Wines : Article 72a of Regulation (EEC) No. 822/87;²

Spirits : Article 11a of Regulation (EEC) No. 1576/89;²

Aromatised wines : Article 10a of Regulation (EEC) No. 1601/91.²

As regards other agricultural products and foodstuffs, no modification was needed for Regulation (EEC) No. 2081/92.³

Directive No. 79/112 was likewise not modified.

² See document IP/N/EEC/G/2.

³ See document IP/N/EEC/G/1.

5. *If the required recognition of geographical indications is not provided through statutes or regulations, please explain, in detail, the mechanism or mechanisms through which the protection required is provided.*

Please see the replies to the previous questions.

6. *Please provide a few examples of domestic geographical indications protected in accordance with the means discussed above and indicate the means by which such protection is provided.*

Wines

Champagne, Sherry, Porto, Chianti, Samos, Rheinhessen, Moselle luxembourgeoise, Mittelburgenland, etc...

As a first step such geographical indications are recognised at the level of a Member State. Subsequently, they are recognised at a Community level following Article 1, paragraph 3 of Regulation (EEC) No. 823/87. They are protected according to Article 15, paragraph 4 of Regulation (EEC) No. 823/87 and Article 40 of Regulation (EEC) No. 2392/89. They are registered and published in the Official Journal of the European Communities No. 344, p. 110.

Spirits

Cognac, Brandy de Jerez, Grappa di Barolo, Berliner Kummel, Genièvre Flandres Artois, Scotch Whisky, Irish Whiskey, Tsikoudia from Crete, etc...

They are recognized by the Community pursuant to Article 5, paragraph 3 of Regulation (EEC) No. 1576/89. They are protected according to Article 5(3)(b) of the said Regulation. They are registered and published in Annex II of that same Regulation.

Other products

Scottish beef, Cabrales, Roquefort, Gorgonzola, Azeite de Moura, Olive de Kalamata, Opperdoezer Ronde, Wachauer Marille, Danablu, Lübecker Marzipan, Svecia, etc ...

Registration pursuant to Article 17 of Regulation (EEC) No. 2081/92 - simplified procedure for names already legally protected or established by use in Member States.

Queijo do Pico, Coquille Saint-Jacques des Côtes-d'Armor, Jamón de Huelva, Lammefjordsgulerod, etc ...

Registration pursuant to Articles 5, 6 and 7 of Regulation (EEC) No. 2081/92 - normal procedure.

Protection and criteria required in referred Articles 2 (definitions) and 4 (specification) are the same in both procedures.

7. *Is the higher level of protection required for wines and spirits under Article 23.2 of the TRIPS Agreement provided for any other product? If so, please specify such products and the law under which they are protected.*

Yes, for other agricultural products and other foodstuffs pursuant to Regulation (EEC) No. 2081/92. Article 13, paragraph 1(b) provides that registered names shall be protected against "any measure, imitation or evocation, even if the true origin of the product is indicated...".

B. DEFINITION AND CRITERIA FOR RECOGNITION

8. *How are geographical indications defined?*

Wines

Quality wine produced in a specified region (PSR): "specified region" is defined as a wine-growing area or combination of wine-growing areas which produces wine possessing special quality characteristics (Article 3, paragraph 1). It is designed by its geographical name (Article 15, paragraph 3 of Regulation (EEC) No. 823/87). Some exceptions are permitted and enumerated in this Article.

Table wine designated with a geographical unit which is defined as a small locality or group of such localities, a local administrative area or part thereof, a wine-group sub-region or part thereof or a region other than a specified region which is reserved for table wines meeting certain production requirements, particularly as regards vine varieties, minimum natural alcoholic strength by volume and organoleptic characteristics (Article 4, paragraphs 1 and 3 of Regulation (EEC) No. 2392/89). Member States may make the use of a geographical ascription for designating a table wine conditional, in particular, on the wine having been produced wholly from certain clearly specified vine varieties and coming exclusively from the territory, precisely demarcated, whose name it bears (Article 72, paragraph 2 Regulation (EEC) No. 822/87).

Spirits

On a case-by-case basis as listed in Article 5(3)(b) in conjunction with Annex II of Regulation (EEC) No. 1576/89.

Other products

Regulation (EEC) No. 2081/92 provides in Article 2 for two definitions:

"Geographical indication" means the name of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff originating in that region, specific place or country, and which possesses a specific quality, reputation or other characteristics attributable to that geographical origin and the production and/or processing and/or preparation of which take place in the defined geographical area.

"Designation of origin" means the name of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff originating in that region, specific place or country, and the quality or characteristics of which are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors, and the production, processing and preparation of which take place in the defined geographical area.

Furthermore, Article 2, paragraph 3 of Regulation (EEC) No. 2081/92 provides for the protection of certain traditional geographical or non-geographical names designating an agricultural product or foodstuff originating in a region or a specific place which fulfil the conditions set out for designations of origin.

Geographical indications and designations of origin are protected in the same way.

9. *Would such a definition comprise geographical indications identifying products of a certain quality or reputation which are indirectly linked to a specific region?*

Such definitions comprise geographical indications which are directly linked to the region of origin. They identify products of a certain quality, notoriety or reputation which are linked to that region of origin.

10. *In determining whether recognition should be given a geographical indication, what criteria are considered?*

Quality wine

Each Member State follows specific criteria subject to minimum Community rules (Article 2 of Regulation No. 823/87).

At Community level it is provided that the traditional conditions of production must be taken into account and are subject to at least the following criteria:

- determination of the area of production,
- vine varieties,
- cultivation methods,
- wine making methods,
- minimum natural alcoholic strength,
- yield per hectare,
- analysis and assessment of organoleptic characteristics.

Other products

For registration, every name notified by Member States to the Commission must be in conformity with the criteria established in the definitions (see the reply to question no. 8 above) and specified by certain elements (name, description of the product, definition of the area, evidence of the origin, description of the method, details bearing out the link with geographical environment or geographical origin, details of the inspection structures, the specific labelling details and any requirements laid down by Community and/or national provisions).

11. *Is there any human creativity involved in the making of specific products under protection by the system of geographical indications? If so, how much? And do these products involve any human factors?*

Wines

Yes. Traditional conditions of production take into account the human creativity involved in the making of a specific product and therefore include human factors.

Other products

Human factors can be one of the essential criteria provided for in Article 2 of Regulation (EEC) No. 2081/92 which justify the registration of a name.

12. *Are there any other intellectual property rights involved, such as patents for example?*

No.

13. *What authority, if any, may define the geographic region or area for which rights are claimed and on what basis is such definition made?*

Quality wine

The authority lies in the competence of Member States. However, they are obliged to respect the definition of specified regions and the precise demarcation of these regions.

Other products

Groups of producers applying for registration must define the specification (and geographical region or area) notified to the Member State in question and subsequently to the Commission.

14. *Does your legislation contain criteria for homonymous geographical indications for wines?*

Wines

Yes, the general principle for the products of the wine sector is that the geographical name can be used only to designate products of the region to which the name had been assigned according to national and Community legislation (Article 15, paragraph 4 of Regulation (EEC) No. 823/87). With respect to imported wines, paragraphs 2 and 3 of Article 29 of Regulation (EEC) No. 2392/89 apply the same general principle and provide for exceptions only in the case where the name is used in accordance with traditional and consistent usage and on condition that its use is governed by rules in the country concerned. Due regard must be given to the practical risk of confusion.

Other products

For Member States, if the application concerns a name indicating a geographical area also situated in another Member State, that Member State shall be consulted before any decision is taken (Article 5, paragraph 5 of Regulation (EEC) No. 2081/92). The question of a homonymous geographical indication is also a criterion for objection to the registration (Article 7, paragraph 3).

For third countries, if a protected name of a third country is identical to a name protected in the Community, registration shall be granted with due regard for local and traditional usage and the practical risks of confusion. Use of such names shall be authorized only if the country of origin of the product is clearly and visibly indicated on the label (Article 12, paragraph 2).

15. *Does your national legislation provide for recognition and protection of geographical indications or appellations of origin of foreign countries?*

Yes.

Wines

Article 72a of Regulation (EEC) No. 822/87;
Article 40, paragraph 2 of Regulation (EEC) No. 2392/89;
Article 61, paragraphs 1 and 2 of Regulation (EEC) No. 822/87.

Aromatised wines

Article 10a of Regulation (EEC) No. 1601/90.

Spirits

Article 11a of Regulation (EEC) No. 1576/89.

Other products

Article 12 of Regulation (EEC) No. 2081/92.

In addition, Article 2 of Directive No. 79/112 prohibits misleading information as regards origin or provenance. This must be understood as applying to origin or provenance referring to third countries as well.

16. *Is there any specific prohibition in the legislation/regulations/rules/procedures covering geographical indications not protected in the country of origin? If so, please specify the relevant statutory provision.*

The principle of protection of a geographical indication is recognition and protection in the country of origin.

However, the Directives on labelling and advertising always apply independently of the recognition of a geographical indication in the country of origin.

C. PROCEDURE FOR RECOGNITION

17. *With respect to any formal system for recognition of geographical indications, must the applicant be a governmental organization or can a private entity own the rights to a geographical indication?*

Wines

The recognition must be made by a governmental organisation.

The right of using a geographical indication is reserved for the professionals who are established in the area and who respect the conditions of production already established and recognised.

Other products

Pursuant to Article 5 of Regulation (EEC) No. 2081/92, only a group of producers and/or processors working with the product shall be entitled to apply for registration.

18. *What are the competent authorities where the protection of a geographical indication can be obtained?*

Wines

Each Member State appoints the competent authority to protect geographical indications (Article 16 of Regulation (EEC) No. 823/87).

Other products

After the entry into force of Regulation (EEC) No. 2081/92, recognition of geographical indications or designations of origin can be obtained only through a Community procedure.

19. *Do the procedures which lead to the recognition of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

Wines and spirits

It lies in the competence of Member States which must respect Community law for wines (Regulation (EEC) No. 823/87) and spirits (Regulation (EEC) 1576/89).

Other products

Registration pursuant to Regulation (EEC) No. 2081/92 is only granted upon request. In accordance with Article 5, a group or a natural or legal person (producers and/or processors working with the product) shall be entitled to apply for registration.

20. *What, if any, fees are involved in the application and maintenance of rights in a geographical indication?*

Wines and spirits

This lies in the competence of Member States.

At Community level there are no fees involved in the application and maintenance of rights in a geographical indication.

Other products

There are no fees provided for in Regulation (EEC) No. 2081/92.

21. *If criteria must be set out in an application for recognition of a geographical indication, are those criteria purely geographic in nature?*

Wines

No. Please see the reply to question no. 10 above.

Other products

Please see the answer to question No. 10 above.

22. *What other criteria, if any, must be set out in an application for recognition of a geographical indication?*

Please see the answer to question no. 10 above.

23. *What information must be supplied in an application for rights in a geographical indication?*

Wines

It is the competence of Member States. However, the applicants must supply all necessary information with respect to the criteria listed in the answer to question no. 10 above.

Other products

Please see the answer to question no. 10 above.

24. *Must the goods or services with respect to which a geographical indication is claimed be set out?*

Wines

This is the competence of Member States.

Other products

Please see the answer to question no. 10 above.

25. *What mechanisms are provided to oppose the recognition of a geographical indication? How is an investigation conducted after such a complaint?*

Wines

It is the competence of Member States.

As a general rule the following motives for opposition are put forward:

- the criteria enumerated in the reply to question no. 10 above are not fulfilled,
- legitimate interests of someone are damaged.

Other products

After verification of the file concerning the name notified for registration, the Commission publishes in the Official Journal of the European Communities the principal elements of the application. This first publication gives a right of objection. A statement of objection shall be admissible only if it concerns established criteria.

26. *Who can oppose the recognition of a geographical indication?*

Wines and spirits

It is the competence of Member States, but, generally, any legal or natural person who considers his/her legitimate interests are damaged can oppose the recognition of a geographical indication.

Other products

Member States or any legitimately concerned natural or legal person.

27. *If your national legislation provides for recognition and protection of geographical indications or appellations of origin of foreign countries, what is the procedure that has to be followed in order to obtain such recognition and consequent protection?*

The following answer is based on the understanding that the question refers to the possibility of "recognition" of a geographical indication or appellation of origin of a third country in the sense of "participation in existing domestic regimes providing for positive recognition (positive lists)". It does not refer to "protection" within the meaning of the TRIPS Agreement. With respect to the latter, please see the replies to questions nos. 4 and 15 above.

Wines and spirits

Inclusion in a positive list is possible by agreement.

Other products

The recognition of geographical indications or designations of origin of foreign countries pursuant to Regulation (EEC) No. 2081/92 can be obtained in accordance with Article 12:

- by agreement
- by the procedure established in the Regulation as regards application for recognition.

The same conditions as for EC products apply.

D. MAINTENANCE

28. *How long does recognition for a geographical indication continue?*

The recognition is unlimited.

29. *If recognition of a geographical indication must be renewed or reaffirmed, what information must be provided in order to effect such a renewal or reaffirmation? Specify any fees involved in renewal or reaffirmation.*

There is no need for renewing or reaffirming the recognition of a geographical indication. Once recognised the protection is unlimited. With respect to the "fees", see the answer to question no. 20 above.

30. *Must a geographical indication be used in order to maintain rights? If so, how is such use determined?*

This condition is not explicitly contained in EC legislation, but the European Commission considers that a geographical indication must be used. Use would be determined on a case-by-case basis if the question arose.

31. *Is there a specified limit for non-use before rights in a geographical indication cease and, if so, what is that limit?*

No. There is no specified limit for non-use.

32. *Who monitors the use of geographical indications to determine if the criteria identified in the application continue to be met?*

This is the competence of Member States via their control authorities which are appointed by them.

33. *If a government entity is responsible for monitoring the use of geographical indications, what are its procedures for doing so?*

This is the competence of Member States via their control authorities.

34. *Are there means by which interested parties may request termination of a geographical indication based on non-use or failure to maintain the criteria identified in the application? Describe the procedure.*

Wines

This is the competence of Member States.

Other products

Member States have to apply protection ex officio by judicial and administrative bodies (Article 13 of Regulation (EEC) No. 2081/92).

35. *Do the procedures which lead to forfeiture of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

Wines

This lies in the competence of Member States.

Other products

Article 13 of Regulation (EEC) No. 2081/92 lists the situations in which registered names are protected. As this Regulation has direct effect in the territory of the Member States, the competent authorities of Member States must guarantee the protection granted by this provision as follows:

- by national authorities, ex officio (Article 13 of Regulation (EEC) No. 2081/92),

- by the initiative of a natural or legal person (Article 13 of Regulation (EEC) No. 2081/92),
- by the initiative of a Member State (Article 11 of Regulation (EEC) No. 2081/92).

E. SCOPE OF RIGHTS AND USE

36. *May anyone who meets the criteria submitted to obtain recognition of a geographical indication use that geographical indication after recognition is given or must additional criteria or procedures be followed by that party before use is permitted?*

Wines and spirits

This lies in the competence of Member States.

Everybody who meets the established criteria has the right to use the geographical indication.

Other products

Everybody established in the geographical area and who meets conditions of the specification has the right to use the registered name.

37. *Who makes the determination regarding use of a geographical indication by particular parties, the entity responsible for the recognition or the entity that obtained the recognition?*

Wines

Please see the reply to question no. 32 above.

Other products

Anybody established in the geographical area and who meets the conditions of the specifications has the right to use the registered name. In other words, a prior authorization is not needed.

38. *Are there fees involved in receiving authorization to use a particular geographical indication and, if so, what are those fees and how are they established?*

This is the competence of Member States. Please see also the reply to question no. 20 above.

39. *If there is a dispute regarding use of a geographical indication by a particular party, what procedures are followed to resolve it?*

Wines

This lies in the competence of Member States.

Other products

Member States' judicial or administrative bodies have to apply Article 13 of Regulation (EEC) No. 2081/92.

40. *Must individual authorized users of a geographical indication use that geographical indication continually to retain their right to use it and, if so, how is their use determined and how long will disuse be permitted?*

Please see the reply to question no. 30 above.

41. *If there is a dispute over continuity of use by a particular party, how is it resolved?*

It would be resolved by the usual administrative or judicial means of resolution of a dispute concerning the application of the relevant EC legislation.

42. *Does the regime for protection of geographical indications allow geographical indications to be licensed and, if so, what conditions are imposed on such licenses? If such conditions are not met, what is the effect on the geographical indication?*

Wines and spirits

This is the competence of Member States.

Other products

Regulation (EEC) No. 2081/92 does not provide for rules in this respect. However, it is interpreted that licences are allowed (within imposed conditions) in favour of producers who are not established in the area in question for stages other than production or transformation.

43. *How is "grandfathered use" of a geographical indication, under Article 24.4 of the TRIPS Agreement, applied in your country?*

In the European Union no "grandfathered use" of a geographical indication exists.

(For example, Article 5, paragraph 3b of Regulation (EEC) No. 1576/89 establishes that geographical designations are reserved to spirit drinks which acquired their character and qualities in the geographical area indicated.)

F. RELATIONSHIP TO TRADEMARKS

44. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.1 of the TRIPS Agreement are not nullified and impaired?*

The relationship between marks and geographical indications is established at Community level in the following instruments:

- Council Directive (EEC) No. 104/89 harmonising Member States' legislation concerning trademarks excludes the registration of a trademark that is made up exclusively of a geographical indication (Article 3c) or that can, by nature, mislead the public, e.g., on the geographical origin of the product (Article 3g),
- Regulation (EC) No. 3288/94 amending Regulation (EC) No. 40/94 on the Community trademark provides in Article 7 that the Harmonization Office in Alicante shall refuse to register an application for the registration of a Community trade mark:

- (1) which consists exclusively of an indication which may serve, in trade, to designate the geographical origin of goods, or
- (2) for wines, which contains or consists of a geographical indication identifying wines or for spirits which contains or consists of a geographical identifying spirits with respect to such wines or spirits not having that origin.

Third parties may initiate an invalidity procedure against a registered Community trademark before the Harmonization Office on the same grounds, pursuant to Article 51 of the said Regulation.

- Regulation (EEC) No 2392/89 establishing general rules concerning the designation and presentation of wines defines more precisely in Article 40, paragraph 2 the corresponding situations from a trademark angle.

Furthermore, there are special provisions for well-known registered brand names.

- Article 13 of Regulation (EEC) No. 2333/92 establishing general rules concerning the designation and presentation of sparkling wines. There are also special provisions for well-known registered brand names.
- Article 14 of Regulation (EEC) No 2081/92 concerning the protection of geographical indications and designations of origin for agricultural products and foodstuffs.

This provision establishes the following:

- (1) a geographical indication is not registered where, in the light of a trademark's reputation, renown and length of time it has been used, registration is liable to mislead the consumer as to the true identity of the product;
- (2) when a geographical indication has been registered, a trademark attempting to evoke or to usurp the geographical indication shall be refused;
- (3) the use of a trademark evoking a geographical indication and registered before this geographical indication may continue if the trademark was registered in good faith and if the appropriate provisions of Directive (EEC) No. 89/104 have been complied with.

45. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.2 and 16.3 of the TRIPS Agreement are not nullified and impaired?*

Please see the reply to question no. 44 above.

46. *What procedures are foreseen in case of a conflict of a geographical indication with a trademark?*

Please see the reply to question no. 44 above.

G. ENFORCEMENT

47. *How are rights in the geographical indication enforced? Are provisions available under unfair competition law? Trademark law? Other laws? Provide citations to the laws and, if they have not been notified under Article 63.2 of the TRIPS Agreement, please provide copies.*

Member States have to apply relevant EC legislation through judicial and administrative bodies and procedures.

Article 72a of Council Regulation (EEC) No. 822/87 envisages that Member States shall take all necessary measures to enable interested parties to prevent, on the terms stipulated in Articles 23 and 24 of the TRIPS Agreement, the use in the Community of a geographical indication attached to the products referred to in Article 1, paragraph 2(b) of the Regulation for products 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" or the like.

It is, therefore, Member States who are responsible for providing the legal means for interested parties to prevent the use of a geographical indication for a wine or spirit not originating in the place indicated, in accordance with Article 23.1 of the TRIPS Agreement. Interested parties must seek redress from the national authorities of the EC Member States. Member States' laws lay down the procedures to be followed, the competent authorities involved, the instances of appeal and sanctions or penalties applied by the authorities. Member States' courts may request the European Court of Justice for preliminary rulings on the interpretation of Council Regulation (EEC) No. 822/87 under Article 177 of the Treaty Establishing the European Community.

Further, on the measures adopted by EC Member States under Article 23 of the TRIPS Agreement and under Article 72a of Council Regulation (EEC) No. 822/87, Article 11a of Council Regulation (EEC) No. 1576/89 and Article 10a of Council Regulation (EEC) No. 1601/91, as a preliminary remark, one should underline that, pursuant to Council Regulation (EEC) No. 2048/89 laying down general rules on controls in the wine sector, controls on the description and presentation of wine products are subject to common principles and assistance proceedings between a Member State's competent authority and the Commission. Under this Regulation, the control authority designated in one Member State may take protective measures regarding the description, presentation and marketing of a wine sector product. It may request assistance from the Commission or from the competent authority of another Member State. The Commission shall be notified whenever the product which is the subject of the control activities originates in a third country and if the marketing of this product may be of specific interest to other Member States.

- (a) According to Member States' legislation, interested parties are those damaged or likely to be damaged by the misuse of a geographical indication, i.e. producers entitled to use the geographical indication or their representatives. Before an administrative body or an Ombudsman, "any person" (consumer, importer, retailer, producer, exporter) may file a complaint. However, it is unlikely that national governments from WTO Members may file complaints in a Member State: only Italy provides for such a possibility.

National governments from WTO Members are of course free to complain to the European Commission or Member States' governments.

- (b) In all Member States, redress can be sought through civil proceedings. Therefore, the plaintiff may have to prove direct interest in the claim. Where misuses of geographical

indications are subject to criminal penalties, as in Belgium, Germany, France, Italy, Portugal and Spain, an interested party may file a complaint to the police or the public prosecutor, who may then decide to launch a criminal investigation. In Austria, Belgium, Denmark, France, Portugal and the United Kingdom, an interested party may also file a complaint to an administrative authority in the Ministry of Agriculture, Ministry of Economy or local Council according to each Member State's legislation. Finland and Sweden provide for a market jurisdiction where the first instance is the Ombudsman and the appellate body is the Market Court.

WTO Member governments may make representations to the European Commission or Member States' governments.

- (c) The way the entity conducts an investigation depends on where the claim is brought. Before a civil court, the judge relies upon evidence presented by the parties. In cases of criminal investigation, it is conducted "ex officio" by the police or other administrative authority vested with investigative powers by the public prosecutor.

When the complaint is made to an administrative authority or to an Ombudsman, the investigator is the authority where the claim is filed. In both situations, the investigator has the power to issue an order to stop the infringement. If the order is not followed, the administrative authority may decide to bring the case before the public prosecutor while the Ombudsman may bring the case to the Market Court in Finland or to the Stockholm City Court in Sweden.

The Commission services conduct their investigation upon elements brought by the government of the WTO Member.

- (d) The final decision is taken according to the procedure. In civil and criminal cases, any decision taken by a court of first instance may be appealed, subject to restrictions concerning the amount of damages in Germany. In administrative enforcement, any action from the administrative authority may be appealed to the Minister and to administrative courts. In Finland, a decision of the Market Court may be appealed only by the defendant.

After investigation, the Commission may raise the matter with the Member State where the infringement has taken place. If the Commission considers that a Member State has failed to fulfil an obligation under the European Union Treaty, the Commission shall deliver a reasoned opinion on the matter. The latter may bring the matter before the European Court of Justice, if the Member State concerned does not comply with the opinion within the period laid down by the Commission (Article 169 of the EU Treaty).

- (e) The administrative authority and the Ombudsman have the power to issue an order to stop the infringement and/or to give adequate information to the consumer. Their decisions are enforceable through public prosecution and court decisions which may provide for penalties in case of non compliance with the order. Any civil court decision may order the defendant to stop the infringement and to pay damages. In criminal cases, the decision of the court is enforced "ex officio" and may consist of jail penalties, at least in Spain and Germany.

Where the European Court of Justice finds that a Member State has failed to implement its obligations under the Treaty and if the European Commission considers that the Member State does not take the necessary measures to comply with the judgement of

the Court of Justice, the European Commission shall again bring the matter to the Court of Justice, which may order pecuniary sanctions and periodic penalty payments.

48. *Who has the right to enforce a geographical indication?*

Please see the reply to question no. 47 above.

49. *What judicial or administrative bodies have jurisdiction over enforcement actions related to geographical indications? Are there fees involved and, if so, what are those fees?*

Please see the reply to question no. 47 above.

50. *Must the public be notified of the existence of a geographical indication and, if so, how and how often?*

Yes, in the European Union the publication in the Official Journal of the geographical indications and the legal reference of their recognition is foreseen.

51. *Is unauthorized use of a geographical indication subject to criminal action and, if so, describe the procedures. If the law has not been notified pursuant to Article 63.2 of the TRIPS Agreement, please provide a copy.*

Please see the reply to question no. 47 above.

H. INTERNATIONAL AGREEMENTS

52. *Is your government party to an international, including bilateral or plurilateral, agreement for the notification and/or registration of geographical indications? If so, please name the international agreement and explain the relationship between it and your national legislation.*

Yes, the European Union has subscribed to several bilateral agreements concerning wine (Australia, Hungary, Bulgaria, Romania) and spirits (USA, Mexico).

53. *What other international agreements, if any, have been entered into? What do those agreements provide?*

There are no other agreements.

II. RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13/ADD.1

A. GENERAL (SECTION A OF DOCUMENT IP/C/13)

1. *Does your economy's industrial property law and/or related law prevent the use of geographical indications identifying wines or spirits against products not originating in the place indicated by the geographical indication, 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" or the like?*

Please refer to the reply to question no. 1 under I above.

B. DEFINITION AND CRITERIA FOR RECOGNITION (SECTION B OF DOCUMENT IP/C/13)

2. *Is there a clear distinction among the terms "geographical indications", "appellations of origin" and "indications of source" in your economy's industrial property law and/or related law, or are there any substantive criteria to distinguish these terms?*

Please refer to the reply to question no. 8 under I above.

With respect to the term "indication of source", a definition does not exist.

However, Council Directive No. 79/112/EEC of 18 December 1978 (on the approximation of the laws of the Member States relating to the labelling, presentation and advertising of foodstuffs for sale to the ultimate consumer) provides in Article 2(a)(i) that the labelling and methods used must not be such as could mislead the purchaser, *inter alia*, as to origin or provenance of the foodstuff. This applies also to the presentation of foodstuffs and to advertising.

3. *Does your legislation contain criteria for homonymous geographical indications for wines and spirits?*

Please see the reply to question no. 14 under I above.

C. RELATIONSHIP TO TRADEMARKS (SECTION F OF DOCUMENT IP/C/13)

4. *Does your economy's industrial property law and/or related law provide the refusal or invalidation of a trademark registration, which consists of or contains geographical indications identifying wines or spirits with respect to such wines or spirits not originating in the indicated territory?*

Please see the reply to question no. 44 under I above.

Responses from Austria

I. RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13

A. GENERAL

1. *Is protection for geographical indications provided through unfair competition law, e.g., passing off, false designation of origin; through a formal procedure for notification/registration before protection is available; or through both? Does the recognition of a geographical indication require registration?*

Protection for geographical indications is provided through the Law on Unfair Competition (Article 2), the Austrian Trademarks Act (e.g., Article 4(1)2 and 4) and the Austrian Wine Law together with the EU Wine Market Organization. A revision of the Trademarks Act with special emphasis on the question of geographical indications is in progress and Parliamentary treatment foreseen for the autumn. According to the provisions of the new Act it will, for example, be possible to register geographical indications as collective marks. Under the Wine Law no registration is required.

2. *Is there one single regime of protection of geographical indications for all products? If not, identify the different regimes.*

The general answer to this question is no; yet, in particular for wine, yes. The European Regulation No. 2081/92, which applies for agricultural products and foodstuffs, has to be mentioned in this context. A special national protecting regime for these products does not exist. Furthermore, the Austrian Wine Law, the Law on Unfair Competition and the Austrian Trademarks Act have to be cited.

3. *Do(es) the regime(s) of protection of geographical indications also extend to services?*

Yes.

4. *What provisions of law or regulations are directed to the recognition of geographical indications required by Articles 22.2 and 23.1 of the TRIPS Agreement? Citations to laws should be provided and, if the texts of the laws have not been notified to the WTO, copies should be provided pursuant to Article 63.2.*

Austrian Wine Law 1985, Section 25, 1985 for specified regions for quality wine and table wine with geographical indication ("Landwein") has already been notified. Furthermore to add Article 2 of the Law on Unfair Competition and Article 4(1)2 and 4 of the Trademarks Act.

5. *If the required recognition of geographical indications is not provided through statutes or regulations, please explain, in detail, the mechanism or mechanisms through which the protection required is provided.*

A reply to this question would only have to be given if question 4 above was answered negatively – yet, this is not the case.

6. *Please provide a few examples of domestic geographical indications protected in accordance with the means discussed above and indicate the means by which such protection is provided.*

Examples: specified regions for quality wines such as "Wachau", "Kamptal", "Neusiedler See" or "Weststeiermark". Protection is provided by the Austrian Wine Law 1985, Sections 37 and following (provisions about the Federal Wine Control Authority). Examples for indications protected according to European Regulation No. 2081/92 are as follows: "Wachauer Marille", "Steirisches Kürbiskernöl", "Tiroler Graukäse", "Gailtaler Almkäse", "Vorarlberger Bergkäse".

7. *Is the higher level of protection required for wines and spirits under Article 23.2 of the TRIPS Agreement provided for any other product? If so, please specify such products and the law under which they are protected.*

Yes, European Regulation No. 2081/92 provides such protection.

B. DEFINITION AND CRITERIA FOR RECOGNITION

8. *How are geographical indications defined?*

Definition in the European Regulation No. 2081/92 and in Article 22.1 of the TRIPS Agreement. Origin of wine is given by the origin of grapes.

9. *Would such a definition comprise geographical indications identifying products of a certain quality or reputation which are indirectly linked to a specific region?*

Geographical indications smaller than Austria are allowed only for "Landwein" or quality wines.

10. *In determining whether recognition should be given a geographical indication, what criteria are considered?*

Natural sugar content and some analytical parameters.

11. *Is there any human creativity involved in the making of specific products under protection by the system of geographical indications? If so, how much? And do these products involve any human factors?*

All products are strictly defined by the Austrian Wine Law.

12. *Are there any other intellectual property rights involved, such as patents for example?*

No.

13. *What authority, if any, may define the geographic region or area for which rights are claimed and on what basis is such definition made?*

Definition of geographical indications is laid down in a federal law (Austrian Wine Law); therefore, the Parliament is the authority which can change the conditions. For products other than wine, there is no national authority defining the geographical area.

14. *Does your legislation contain criteria for homonymous geographical indications for wines?*

Austria: no. Wine Market Organization: European Regulation No. 2392/89 and No. 3201/90.

15. *Does your national legislation provide for recognition and protection of geographical indications or appellations of origin of foreign countries?*

Protection of foreign indications is given by the Wine Market Organization (European Regulation No. 2392/89). Foreign indications may also be protected by the Law on Unfair Competition and the Trademarks Act, e.g. if they are misleading the public. Several bilateral agreements on geographical indications exist.

16. *Is there any specific prohibition in the legislation/regulations/rules/procedures covering geographical indications not protected in the country of origin? If so, please specify the relevant statutory provision.*

Please see the response from the European Communities to this question.

C. PROCEDURE FOR RECOGNITION

17. *With respect to any formal system for recognition of geographical indications, must the applicant be a governmental organization or can a private entity own the rights to a geographical indication?*

Recognition needs the changing of a federal law; applicants, in most cases, are producers' representatives.

18. *What are the competent authorities where the protection of a geographical indication can be obtained?*

The Parliament in regard to the Wine Act.

19. *Do the procedures which lead to the recognition of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

Recognition by changing the law needs initiatives of an entity or person.

20. *What, if any, fees are involved in the application and maintenance of rights in a geographical indication?*

No fees.

21. *If criteria must be set out in an application for recognition of a geographical indication, are those criteria purely geographic in nature?*

Criteria are geographical. Furthermore, the wine must be "Landwein" or quality wine referring to the conditions of the Austrian Wine Law.

22. *What other criteria, if any, must be set out in an application for recognition of a geographical indication?*

No other criteria.

23. *What information must be supplied in an application for rights in a geographical indication?*

Exact geographical definition (borders) of the indication.

24. *Must the goods or services with respect to which a geographical indication is claimed be set out?*

Yes.

25. *What mechanisms are provided to oppose the recognition of a geographical indication? How is an investigation conducted after such a complaint?*

Majority in the Parliament against the changing of the law.

26. *Who can oppose the recognition of a geographical indication?*

Anyone who gets the majority against the changing of the law. An examination of the in our view misunderstanding formulation is suggested, as already in the preparatory proceedings for the changing of a law the parties concerned have to be heard.

27. *If your national legislation provides for recognition and protection of geographical indications or appellations of origin of foreign countries, what is the procedure that has to be followed in order to obtain such recognition and consequent protection?*

No national legislation. See EU Regulation No. 2392/89.

D. MAINTENANCE

28. *How long does recognition for a geographical indication continue?*

As long as the law is applicable.

29. *If recognition of a geographical indication must be renewed or reaffirmed, what information must be provided in order to effect such a renewal or reaffirmation? Specify any fees involved in renewal or reaffirmation.*

No renewing outside the law.

30. *Must a geographical indication be used in order to maintain rights? If so, how is such use determined?*

No.

31. *Is there a specified limit for non-use before rights in a geographical indication cease and, if so, what is that limit?*

No.

32. *Who monitors the use of geographical indications to determine if the criteria identified in the application continue to be met?*

The Federal Wine Control Authority defined by Section 37 of the Austrian Wine Law.

33. *If a government entity is responsible for monitoring the use of geographical indications, what are its procedures for doing so?*

The Federal Wine Control Authority can do monitoring whenever it is of the opinion that a geographical indication is used against provisions of the law.

34. *Are there means by which interested parties may request termination of a geographical indication based on non-use or failure to maintain the criteria identified in the application? Describe the procedure.*

First step: indication to the Federal Wine Control Authority; then monitoring by this Authority. If there is a failure, the Authority indicates it to the regional authority (administrative court), which has to decide.

35. *Do the procedures which lead to forfeiture of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

Initiative by the Federal Wine Control Authority. A private person has to inform the Authority.

E. SCOPE OF RIGHTS AND USE

36. *May anyone who meets the criteria submitted to obtain recognition of a geographical indication use that geographical indication after recognition is given or must additional criteria or procedures be followed by that party before use is permitted?*

No additional criteria.

37. *Who makes the determination regarding use of a geographical indication by particular parties, the entity responsible for the recognition or the entity that obtained the recognition?*

All determinations are fixed by law. For other products, see the reply by the European Communities to this question.

38. *Are there fees involved in receiving authorization to use a particular geographical indication and, if so, what are those fees and how are they established?*

See the reply to question 37 above.

39. *If there is a dispute regarding use of a geographical indication by a particular party, what procedures are followed to resolve it?*

See the reply to question 37 above.

40. *Must individual authorized users of a geographical indication use that geographical indication continually to retain their right to use it and, if so, how is their use determined and how long will disuse be permitted?*

No individual authorized persons.

41. *If there is a dispute over continuity of use by a particular party, how is it resolved?*

See the reply to question 37 above.

42. *Does the regime for protection of geographical indications allow geographical indications to be licensed and, if so, what conditions are imposed on such licenses? If such conditions are not met, what is the effect on the geographical indication?*

No licences.

43. *How is "grandfathered use" of a geographical indication, under Article 24.4 of the TRIPS Agreement, applied in your country?*

No need for application in Austria.

F. RELATIONSHIP TO TRADEMARKS

44. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.1 of the TRIPS Agreement are not nullified and impaired?*

Article 72a of EEC Regulation No. 822/87 has been implemented in Austria by a release from the Ministry of Agriculture and Forestry. Therefore, the Federal Wine Control Authority is obliged to monitor this. In regard to cases based on the Unfair Competition Law and the Trademarks Act, priority of rights will be the essential question.

45. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.2 and 16.3 of the TRIPS Agreement are not nullified and impaired?*

See the reply to question 44 above.

46. *What procedures are foreseen in case of a conflict of a geographical indication with a trademark?*

Two possibilities: Federal Wine Control Authority indicates to the regional authority, which decides, or private person searches for decision by court (unfair competition). Cancellation procedure with the nullity division of the Austrian Patent Office.

G. ENFORCEMENT

47. *How are rights in the geographical indication enforced? Are provisions available under unfair competition law? Trademark law? Other laws? Provide citations to the laws and, if they have not been notified under Article 63.2 of the TRIPS Agreement, please provide copies.*

By the Austrian Wine Law. Enforcement may be based on Article 2 of the Unfair Competition Law or Article 4(1)2 and 4 in combination with Article 33 or 33c of the Trademarks Act.

48. *Who has the right to enforce a geographical indication?*

Federal Wine Control Authority, Regional Authority or Court. Unfair Competition Law: competitors; producers; associations of relevant entrepreneurs. Trademarks Act: anybody.

49. *What judicial or administrative bodies have jurisdiction over enforcement actions related to geographical indications? Are there fees involved and, if so, what are those fees?*

Regional Authority or Court. Fees are involved. Nullity division of the Austrian Patent Office (ATS 2,900).

50. *Must the public be notified of the existence of a geographical indication and, if so, how and how often?*

Law is public in Austria, but no special provisions for geographical indications are foreseen.

51. *Is unauthorized use of a geographical indication subject to criminal action and, if so, describe the procedures. If the law has not been notified pursuant to Article 63.2 of the TRIPS Agreement, please provide a copy.*

No criminal action, only subject to administrative court. Trademarks Act: if geographical indications are protected as collective marks, an infringer may be liable to a fine of 360 times the per diem rate (Article 51 of the Trademarks Act).

H. INTERNATIONAL AGREEMENTS

52. *Is your government party to an international, including bilateral or plurilateral, agreement for the notification and/or registration of geographical indications? If so, please name the international agreement and explain the relationship between it and your national legislation.*

No.

53. *What other international agreements, if any, have been entered into? What do those agreements provide?*

All agreements between the EU and third countries.

II. RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13/ADD.1

A. GENERAL (SECTION A OF DOCUMENT IP/C/13)

1. *Does your economy's industrial property law and/or related law prevent the use of geographical indications identifying wines or spirits against products not originating in the place indicated by the geographical indication, 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" or the like?*

European Regulation No. 2081/92 defines the terms "geographical indication" and "appellation of origin," but is silent in regard to the term "indication of source".

As foreseen in the Community Regulations as well, the Austrian Wine Law states, in any case, that a geographical indication defines the origin of the grapes. Therefore, there is no need for distinction among terms. The relevant Austrian industrial property laws (Trademarks Act and Law on Unfair Competition) as well as the TRIPS Agreement itself, do not *expressis verbis* contain the terms "appellations of origin" and "indications of source"; therefore, also no criteria to distinguish these terms and "geographical indications" are mentioned.

B. DEFINITION AND CRITERIA FOR RECOGNITION (SECTION B OF DOCUMENT IP/C/13)

2. *Is there a clear distinction among the terms "geographical indications", "appellations of origin" and "indications of source" in your economy's industrial property law and/or related law, or are there any substantive criteria to distinguish these terms?*

Yes. Article 72a of EEC Regulation No. 822/87 is valid for all Member States of the Community. Use of such denominations may be prevented through the Law on Unfair Competition, if the danger of deceiving the public prevails.

3. *Does your legislation contain criteria for homonymous geographical indications for wines and spirits?*

Yes. Austria has to follow Article 40 of EEC Regulation No. 2392/89 together with Section 24 of the Austrian Wine Law. The present Trademarks Act, as well as the current amendment, contain provisions in regard to refusal and invalidation of trademarks consisting of or containing geographical indications identifying wines or spirits with respect to wines or spirits not originating in the territory indicated.

C. RELATIONSHIP TO TRADEMARKS (SECTION F OF DOCUMENT IP/C/13)

4. *Does your economy's industrial property law and/or related law provide the refusal or invalidation of a trademark registration, which consists of or contains geographical indications identifying wines or spirits with respect to such wines or spirits not originating in the indicated territory?*

Austrian and Community regulations do not contain specific rules for homonymous geographical indications. In many cases (Australia, Eastern European countries), the Community lays down detailed rules of procedure in bilateral agreements. Furthermore, in every case, the principle of non-misleading indications has to be fulfilled.

Responses from Belgium

REPLIES TO THE QUESTIONS IN DOCUMENT IP/C/13

A. GENERAL

1. *Is protection for geographical indications provided through unfair competition law, e.g. passing off, false designation of origin; through a formal procedure for notification/registration before protection is available; or through both? Does the recognition of a geographical indication require registration?*

The recognition and protection of geographical indications are effected through the registration procedure referred to in Article 5 of Council Regulation (EEC) No. 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ L. 208/1, 24 July 1992), a Community instrument binding in its entirety and directly applicable in the member States of the European Union.

However, designations of origin are also protected under Articles 16-21 of the Law of 14 July 1991 on trade practices and consumer information and protection (Moniteur Belge (MB) of 29 August 1991, page 18712) against:

- (1) Use of a name presented as a designation of origin, when such name has not been recognized as a designation of origin;
- (2) the manufacture, offering for sale and sale under a designation of origin, of products which do not meet the requirements laid down in respect of recognition of the designation of origin;
- (3) the manufacture, offering for sale and sale under a designation of origin, of products not covered by a certificate of origin, when such certificate is required.

2. *Is there one single regime of protection of geographical indications for all products? If not, identify the different regimes.*

The above-mentioned Regulation No. 2081/92 establishes a system of protection for geographical indications and designations of origin of agricultural products intended for human consumption, excluding wine products and spirit drinks, for which specific protection is provided (Article 1(1)).

3. *Do(es) the regime(s) of protection of geographical indications also extend to services?*

No.

4. *What provisions of law or regulations are directed to the recognition of geographical indications required by Articles 22.2 and 23.1 of the TRIPS Agreement? Citations to laws should be provided and, if the texts of the laws have not been notified to the WTO, copies should be provided pursuant to Article 63.2.*

Community law

General legislation:

- Council Regulation (EEC) No. 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ L 208/1, 24 July 1992);
- Commission Regulation (EEC) No. 2037/93 of 27 July 1993 laying down detailed rules of application of Council Regulation (EEC) No. 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ L 185/5, 28 July 1993);
- Commission Regulation (EC) No. 2400/96 of 17 December 1996 on the entry of certain names in the "Register of protected designations of origin and protected geographical indications" provided for in Council Regulation (EEC) No. 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ L 327/11, 18 December 1996);
- Council Regulation (EC) No. 535/97 of 17 March 1997 amending Regulation (EEC) No. 2081/92 (EEC) on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ L 83/3, 25 March 1997);
- Commission Regulation (EC) No. 1428/97 of 23 July 1997 amending Regulation (EEC) No. 2037/93 laying down detailed rules of application of Council Regulation (EEC) No. 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ L 196/39, 24 July 1997);
- Commission Regulation (EC) No. 1875/97 of 26 September 1997 supplementing the Annex to Regulation (EC) No. 2400/96 on the entry of certain names in the "Register of protected designations of origin and protected geographical indications" provided for in Council Regulation (EEC) No. 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ L 265/26, 27 September 1997);
- Commission Regulation (EC) No. 2396/97 of 2 December 1997 on the entry of certain names in the "Register of protected designations of origin and protected geographical indications" provided for in Council Regulation (EEC) No. 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ L 331/3, 3 December 1997);
- Commission Regulation (EC) No. 195/98 of 26 January 1998 supplementing the Annex to Regulation (EC) No. 2400/96 on the entry of certain names in the "Register of protected designations of origin and protected geographical indications" provided for in Council Regulation (EEC) No. 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ L 20/20, 27 January 1998);
- Commission Regulation (EC) No. 1265/98 of 18 June 1998 supplementing the Annex to Regulation (EC) No. 2400/96 on the entry of certain names in the "Register of protected designations of origin and protected geographical indications" provided for in Council Regulation (EEC) No. 2081/92 on the protection of geographical

indications and designations of origin for agricultural products and foodstuffs (OJ L 175/7, 19 June 1998);

- Council Regulation (EC) No. 3290/94 of 22 December 1994 on the adjustments and transitional arrangements required in the agriculture sector in order to implement the agreements concluded during the Uruguay Round of multilateral trade negotiations (OJ L 349/105, 31 December 1994);
- Commission Regulation (EC) No. 1107/96 of 12 June 1996 on the registration of geographical indications and designations of origin under the procedure laid down in Article 17 of Council Regulation (EEC) No. 2081/92 (OJ L 148/1, 21 June 1996);
- Commission Regulation (EC) No. 1263/96 of 1 July 1996 supplementing the Annex to Regulation (EC) No. 1107/96 on the registration of geographical indications and designations of origin under the procedure laid down in Article 17 of Regulation (EEC) No. 2081/92 (OJ L 163/19, 2 July 1996);
- Commission Regulation (EC) No. 123/97 of 23 January 1997 supplementing the Annex to Commission Regulation (EC) No. 1107/96 on the registration of geographical indications and designations of origin under the procedure laid down in Article 17 of Regulation (EEC) No. 2081/92 (OJ L 22/19, 24 January 1997);
- Commission Regulation (EC) No. 2325/97 of 24 November 1997 supplementing the Annex to Regulation (EC) No. 1107/96 on the registration of geographical indications and designations of origin under the procedure laid down in Article 17 of Council Regulation (EEC) No. 2081/92 (OJ L 322/33, 25 November 1997);
- Commission Regulation (EC) No. 134/98 of 20 January 1998 supplementing the Annex to Regulation (EC) No. 1107/96 on the registration of geographical indications and designations of origin under the procedure laid down in Article 17 of Council Regulation (EEC) No. 2081/92 (OJ L 15/6, 21 January 1998);
- Commission Regulation (EC) No. 644/98 of 20 March 1998 supplementing the Annex to Regulation (EC) No. 1107/96 on the registration of geographical indications and designations of origin under the procedure laid down in Article 17 of Council Regulation (EEC) No. 2081/92 (OJ L 87/8, 21 March 1998, erratum OJ L 111/73, 9 March 1998).

Legislation on wine products and spirit drinks:

- Council Regulation (EEC) No. 822/87 of 16 March 1987 on the common organization of the market in wine (OJ L 84/1, 27 March 1987);
- Council Regulation (EC) No. 2087/97 of 20 October 1997 amending Regulation (EEC) No. 822/87 on the common organization of the market in wine (OJ L 292/1, 25 October 1997);
- Council Regulation (EEC) No. 823/87 of 16 March 1987 laying down special provisions relating to quality wines produced in specified regions (OJ L 84/59, 27 March 1987);

- Council Regulation (EEC) No. 4252/88 of 21 December 1988 on the preparation and marketing of liqueur wines produced in the Community (OJ L 373/59, 31 December 1988);
- Council Regulation (EEC) No. 1576/89 of 29 May 1989 laying down general rules on the definition, description and presentation of spirit drinks (OJ L 160/1, 12 June 1989);
- Council Regulation (EEC) No. 2392/89 of 24 July 1989 laying down general rules for the description and presentation of wines and grape musts (OJ L 232, 9 August 1989);
- Regulation (EC) No. 3378/94 of the European Parliament and of the Council of 22 December 1994 amending Regulation (EEC) No. 1576/89 laying down general rules on the definition, description and presentation of spirit drinks and Regulation (EEC) No. 1601/91 laying down general rules on the definition, description and presentation of aromatized wines, aromatized wine-based drinks and aromatized wine-product cocktails following the Uruguay Round of the multilateral trade negotiations (OJ L 366/1, 31 December 1994);
- Council Regulation (EEC) 1601/91 10 June 1991 laying down general rules on the definition, description and presentation of aromatized wines, aromatized wine-based drinks and aromatized wine-product cocktails (OJ L 149/1, 14 June 1991).

National law

- Articles 16 to 21 of the Law of 14 July 1991 on trade practices and consumer information and protection (MB of 29 August 1991, page 18712);
- Law of 21 February 1986 setting penalties for offences against the regulations of the European Economic Community relating to the wine market (MB of 19 March 1986, page 3639).

5. *If the required recognition of geographical indications is not provided through statutes or regulations, please explain, in detail, the mechanism or mechanisms through which the protection required is provided.*

Recognition of geographical indications is provided through the laws and regulations listed above.

6. *Please provide a few examples of domestic geographical indications protected in accordance with the means discussed above and indicate the means by which such protection is provided.*

Three names are listed in the Annex to Regulation No. 1107/96: "Jambon d'Ardenne" (PGI), "Fromage de Herve" (PDO) and "Beurre d'Ardenne" (PDO). The national regulations relating to these names are the following:

- Royal Decree of 4 February 1974 recognizing the designation of origin "Jambon d'Ardenne" and laying down the conditions to be met by this product in order to be manufactured, offered for sale or sold under this designation;
- Royal Decree of 14 July 1987 amending the Royal Decree of 4 February 1974 recognizing the designation of origin "Jambon d'Ardenne" and laying down the

conditions to be met by this product in order to be manufactured, offered for sale or sold under this designation (MB of 1 August 1987, page 11637);

- Royal Decree of 18 December 1984 recognizing the designation of origin "Beurre d'Ardenne" and laying down the conditions to be met by this product in order to be manufactured, offered for sale or sold under this designation (MB of 2 February 1985, page 1176);
- Royal Decree of 6 May 1985 amending the Royal Decree of 18 December 1984 recognizing the designation of origin "Beurre d'Ardenne" and laying down the conditions to be met by this product in order to be manufactured, offered for sale or sold under this designation (MB of 1 June 1985, page 8323);
- Ministerial Decree of 23 January 1985 determining the model certificates of origin prescribed by the Royal Decree of 18 December 1984 recognizing the designation of origin "Beurre d'Ardenne" and laying down the conditions to be met by this product in order to be manufactured, offered for sale or sold under this designation (MB of 2 February 1985, page 1179);
- Ministerial Decree of 20 June 1985 approving a model certificate of origin for implementation of the Royal Decree of 18 December 1984 recognizing the designation of origin "Beurre d'Ardenne" and laying down the conditions to be met by this product in order to be manufactured, offered for sale or sold under this designation (MB of 5 September 1985, page 12727).

Moreover, with regard to juniper-flavoured spirit drinks, a protected name is used pursuant to the above-mentioned Regulation No. 1576/89: "Hasseltse jenever".

Compliance with the manufacturing requirements for products with these designations is monitored by private bodies and/or the economic inspection authority of the Ministry of Economic Affairs.

7. *Is the higher level of protection required for wines and spirits under Article 23.2 of the TRIPS Agreement provided for any other product? If so, please specify such products and the law under which they are protected.*

Yes, the higher level of protection is provided for all products covered by the above-mentioned Regulation No. 2081/92.

B. DEFINITION AND CRITERIA FOR RECOGNITION

8. *How are geographical indications defined?*

Designations of origin and geographical indications are defined in Articles 2(2)(a) and 2(2)(b), respectively, of Regulation No. 2081/92:

PDO: "the name of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff:

- originating in that region, specific place or country; and
- the quality or characteristics of which are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors, and the

production, processing and preparation of which take place in the defined geographical area."

PGI: "the name of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff:

- originating in that region, specific place or country; and
- which possesses a specific quality, reputation or other characteristics attributable to that geographical origin and the production and/or processing and/or preparation of which take place in the defined geographical area."

With regard to unfair competition, Article 16 of the Law of 14 July 1991 on trade practices and consumer information and protection gives the following definition of designation of origin: "the geographical name of a country, a region or a locality, serving to designate a product originating therein, the quality or characteristics of which are exclusively or essentially due to a particular geographical environment with its inherent natural and human factors."

9. *Would such a definition comprise geographical indications identifying products of a certain quality or reputation which are indirectly linked to a specific region?*

No. Indirect indications of source are not protected by Community legislation on protected geographical names.

However, Article 2(4) of Regulation No. 2081/92 stipulates that "certain geographical designations shall be treated as designations of origin where the raw materials of the products concerned come from a geographical area larger than or different from the processing area, provided that:

- the production area of the raw materials is limited; and
- special conditions for the production of the raw materials exist; and
- there are inspection arrangements to ensure that those conditions are adhered to."

The designations in question may be or have already been recognized as designations of origin with national protection by the member State concerned, or, if no such scheme exists, have a proven, traditional character and an exceptional reputation and renown (Article 2(6)).

10. *In determining whether recognition should be given a geographical indication, what criteria are considered?*

The following four criteria have been adopted under Community law: origin, typicality, quality and reputation. The combination of these criteria differs according to whether a geographical indication or a designation of origin is involved (cf. Article 2(2) of Regulation No. 2081/92).

11. *Is there any human creativity involved in the making of specific products under protection by the system of geographical indications? If so, how much? And do these products involve any human factors.*

Yes. The geographical environment referred to involves human factors as well as natural factors.

12. *Are there any other intellectual property rights involved, such as patents for example?*

The production, processing and preparation of products with a protected geographical name are governed by methods which contribute to establishing the quality, typicality and reputation of the products concerned, or which are only used in a defined geographical area. Where appropriate, it may be compulsory to apply these methods in order to obtain the protection granted to a PGI or a PDO. However, the protection of a geographical indication or designation of origin registered in accordance with the prevailing rules on the subject automatically extends to the techniques and processes used for the production of the products in question.

Moreover, Article 14(3) of Regulation No. 2081/92 specifies that "A designation of origin or geographical indication shall not be registered where, in the light of a trademark's reputation and renown and the length of time it has been used, registration is liable to mislead the consumer as to the true identity of the product."

13. *What authority, if any, may define the geographic region or area for which rights are claimed and on what basis is such definition made?*

Pursuant to Article 4(1) of the above-mentioned Regulation No. 2081/92, an agricultural product or foodstuff must comply with a specification in order to be eligible to use a protected designation of origin or a protected geographical indication. The elements of the specification are listed non-exhaustively in Article 4(2).

The application for registration, which includes the product specification, is submitted either by a group of producers and/or processors working with the same agricultural product or foodstuff, or by a natural or legal person (Article 5(3)). It is sent to the member State of the European Union in which the geographical area is located (Article 5(4)). The member State checks that the application is justified and forwards the application, including the product specification, to the Commission, if it considers that it satisfies the requirements of Regulation No. 2081/92 (Article 5(5), first subparagraph).

While the Federal Government has sole jurisdiction in Belgium in respect of industrial and intellectual property and competition law, under Article 6.1.VI of the special law on institutional reform of 8 August 1980, the regions (Wallonia, Flanders and Brussels) lay down the rules governing the award of quality marks and designations of origin, on a regional or local basis.

14. *Does your legislation contain criteria for homonymous geographical indications for wines?*

See Article 29(1) and (3) of Regulation No. 2392/89, referred to above.

15. *Does your national legislation provide for recognition and protection of geographical indications or appellations of origin of foreign countries?*

Yes. Broadly speaking, Article 12 of Regulation No. 2081/92 provides that the Regulation may apply to an agricultural product or foodstuff from a third country provided that certain conditions are met.

16. *Is there any specific prohibition in the legislation/regulations/rules/procedures covering geographical indications not protected in the country of origin? If so, please specify the relevant statutory provision.*

The above-mentioned Regulation No. 2081/92 provides that names registered in accordance with the regime introduced by the Regulation may be protected by national measures taken by member States of the European Union, under certain conditions, for a period of five years from the date of publication of the Regulation (24 July 1992). Beyond that date, or in the absence of specific national measures, the directly applicable Community law shall prevail. All geographical names registered pursuant to the Regulation are protected in the country of origin.

With regard to wine products, see Article 29(1) of Regulation No. 2392/89, cited above.

C. PROCEDURE FOR RECOGNITION

17. *With respect to any formal system for recognition of geographical indications, must the applicant be a governmental organization or can a private entity own the rights to a geographical indication?*

According to Article 5(1) of Regulation No. 2081/92, the applicant may be either a group of producers and/or processes working with the same agricultural product or foodstuff, or, subject to certain conditions to be laid down in accordance with the procedure provided for in Article 15, a natural or legal person.

A group or a natural or legal person may apply for registration only in respect of agricultural products or foodstuffs which it produces or obtains within the meaning of Article 2(2)(a) or (b) (definition of PDO and PGI) (Article 5(2)).

In exceptional and duly substantiated cases, applications for registration may also be submitted by a natural or legal person not complying with the definition given above (which is that contained in Article 5(1), second subparagraph), where the person concerned is the only producer in the geographical area defined at the time the application for registration is submitted (Article 1(1) of the above-mentioned Commission Regulation No. 2037/93 of 27 July 1993). In such cases, the person concerned is considered as a group within the meaning of Article 5 of Regulation No. 2081/92.

18. *What are the competent authorities where the protection of a geographical indication can be obtained?*

The application for registration is transmitted to the European Commission by the EU member State to which it was sent for verification of the conditions and requirements laid down by Regulation No. 2081/92, and for a decision to be taken.

19. *Do the procedures which lead to the recognition of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

The system of protection for geographical names introduced by Regulation No. 2081/92 is based on a voluntary initiative by the persons authorized to apply for registration.

20. *What, if any, fees are involved in the application and maintenance of rights in a geographical indication?*

No charge is levied for the continued protection of a geographical name. However, the cost of inspections provided for under Regulation No. 2081/92 are borne by the producers using the protected name (Article 10(7) of the Regulation).

21. *If criteria must be set out in an application for recognition of a geographical indication, are those criteria purely geographic in nature?*

No. Article 4(2) of Regulation No. 2081/92 provides that the product specification which accompanies the application for registration "shall include at least:

- (a) the name of the agricultural product or foodstuff, including the designation of origin or the geographical indication;
- (b) a description of the agricultural product or foodstuff including the raw materials, if appropriate, and principal physical, chemical, microbiological and/or organoleptic characteristics of the product or the foodstuff;
- (c) the definition of the geographical area and, if appropriate, details indicating compliance with the requirements in Article 2(4) (geographical designations where the raw materials of the products concerned come from a geographical area larger than or different from the processing area);
- (d) evidence that the agricultural product or the foodstuff originates in the geographical area, within the meaning of Article 2(2)(a) or (b), whichever is applicable (definitions of PDO and PGI);
- (e) a description of the method of obtaining the agricultural product or foodstuff and, if appropriate, the authentic and unvarying local methods;
- (f) the details bearing out the link with the geographical environment or the geographical origin within the meaning of Article 2(2)(a) or (b), whichever is applicable;
- (g) details of the inspection structures provided for in Article 10;
- (h) the specific labelling details relating to the indication PDO or PGI, whichever is applicable, or the equivalent traditional national indications;
- (i) any requirements laid down by Community and/or national provisions."

22. *What other criteria, if any, must be set out in an application for recognition of a geographical indication?*

See the reply to question 21 above.

23. *What information must be supplied in an application for rights in a geographical indication?*

See the reply to question 21 above.

24. *Must the goods or services with respect to which a geographical indication is claimed be set out?*

Yes.

25. *What mechanisms are provided to oppose the recognition of a geographical indication? How is an investigation conducted after such a complaint?*

Under the terms of Article 7(1) of Regulation No. 2081/92, any member State of the EU may object to the registration of a name, within six months of the date of publication of the registration application in the Official Journal of the European Communities.

Any legitimately concerned natural or legal person may also object to the proposed registration by sending a duly substantiated statement to the competent authority of the member State in which he resides or is established (Article 7(2)). The competent authority shall take the necessary measures to consider these comments or objection within the deadlines laid down.

A statement of objection shall be admissible only if it:

- either shows non-compliance with the conditions referred to in Article 2 of Regulation No. 2081/92;
- or shows that the proposed registration of a name would jeopardize the existence of an entirely or partly identical name or trademark or the existence of products which have legally been on the market for at least five years prior to the date of publication of the application for registration;
- or indicates the features which demonstrate that the name whose registration is applied for is generic in nature (Article 7(4)).

Where an objection is admissible, the European Commission shall ask the member States concerned to seek agreement among themselves in accordance with their internal procedures within three months.

If agreement is reached, the member States in question shall communicate to the Commission all the factors which made agreement possible together with the applicant's opinion and that of the objector. Where there has been no change to the information contained in the application for registration, the Commission shall carry out publication of the application. If there has been a change, it shall again initiate the procedure allowing objections to be raised, where appropriate.

If no agreement is reached, the Commission shall take a decision having regard to traditional fair practice and the actual likelihood of confusion. Should it decide to proceed with registration, the application for registration shall be published in the Official Journal of the European Communities (Article 7(5)).

26. *Who can oppose the recognition of a geographical indication?*

See the reply to question 25 above.

27. *If your national legislation provides for recognition and protection of geographical indications or appellations of origin of foreign countries, what is the procedure that has to be followed in order to obtain such recognition and consequent protection?*

The normal procedure is applied subject to the application of Article 12 of the above-mentioned Regulation No. 2081/92.

D. MAINTENANCE

28. *How long does recognition for a geographical indication continue?*

The geographical name (PGI or PDO) is protected as long as the reputation attaching to the products and foodstuffs covered is justified, that is to say as long as the producers and processors comply with the conditions laid down in the specification established. The inspection structures established by the member States of the EU are responsible for permanent monitoring of such compliance.

29. *If recognition of a geographical indication must be renewed or reaffirmed, what information must be provided in order to effect such a renewal or reaffirmation? Specify any fees involved in renewal or reaffirmation.*

There is no renewal or reaffirmation of the application for registration.

30. *Must a geographical indication be used in order to maintain rights? If so, how is such use determined?*

Regulation No. 2081/92 contains no provisions in this regard.

31. *Is there a specified limit for non-use before rights in a geographical indication cease and, if so, what is that limit?*

See the reply to question 30 above.

32. *Who monitors the use of geographical indications to determine if the criteria identified in the application continue to be met?*

The national inspection authorities and/or private inspection bodies approved by the member States of the EU (Article 10(1) and (2) of Regulation No. 2081/92). In Belgium, inspection is carried out by private bodies and by the economic inspection authority of the Ministry of Economic Affairs.

33. *If a government entity is responsible for monitoring the use of geographical indications, what are its procedures for doing so?*

Article 10(3) of Regulation No. 2081/92 lays down certain general rules concerning, on the one hand, guarantees of objectivity and impartiality on the part of the inspection authorities and/or private bodies and, on the other hand, the permanent availability of the qualified staff and resources necessary to carry out inspection of agricultural products and foodstuffs bearing a protected name.

The Regulation provides that, if a designated inspection authority and/or private body in a member State of the EU establishes that an agricultural product or a foodstuff bearing a protected name of origin in that State does not meet the criteria of the specification, they shall take the steps necessary to ensure compliance with Regulation No. 2081/92 (Article 10(4)).

Under national law, the search and verification powers of the officials of the economic inspection authority are governed by Articles 113 to 119 of the above-mentioned Law of 14 July 1991 on trade practices and consumer information and protection. These officials are empowered to carry out house searches, to make all necessary verifications, to secure production of all documents and books necessary for investigation and verification purposes, to seize such documents and to take samples. They may propose an administrative settlement or submit a complaint to the public prosecutor's office. The Minister of the Economy may also institute an action for termination of

unfair trade practices which damage either the professional interests of one or more vendors (Article 93 of the Law) or the interests of one or more consumers (Article 94).

34. *Are there means by which interested parties may request termination of a geographical indication based on non-use or failure to maintain the criteria identified in the application? Describe the procedure.*

Pursuant to Article 118.1 of the above-mentioned Law of 14 July 1991, anyone in possession of a certificate of origin for a specified product may, with the authorization of the president of the commercial court, call for one or more experts appointed by the president to undertake the description, analysis and examination of the product presumed to be the subject of wrongful use of a designation of origin.

The application is transmitted in duplicate to the president of the commercial court of the place where the wrongful use is presumed to have occurred and contains election of domicile in that place.

The president may use the same order to forbid the person presumed responsible for the wrongful use to alienate the product, allow a custodian to be appointed, have the product placed under seal and, if the acts in question have produced revenue, authorize the attachment of such funds.

Immediately after the order has been issued, it shall be notified by the registrar, by judicial recorded delivery, to the applicant and the person presumed responsible for the wrongful use. No action may be taken until after such notification (Article 108.2).

The applicant and the person presumed responsible for the wrongful use may attend or be represented on the occasion of the description, examination, analysis or seizure, if they have specific authorization from the president of the commercial court (Article 108.3).

The expert report is filed in the registry. A copy thereof is immediately sent by the expert, by registered mail, to the applicant and the person presumed responsible for the wrongful use (Article 108.5).

If, in the month following the date of dispatch as evidenced by the postmark, the applicant has not sued for damages in criminal proceedings or has not issued a summons against the holder of the product complained of and the person making use of the designation of origin to appear before the commercial court whose president issued the order, the latter shall automatically cease to have effect and the holder of the product may demand the handing over of the original application, the order to place the product under seal and the record thereof, subject to the applicant being prohibited from using them and make them public, without prejudice to the award of damages (Article 119).

35. *Do the procedures which lead to forfeiture of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

At the initiative of a member State, in accordance with Article 11 of Regulation No. 2081/92:

- "(1) Any member State may submit that a condition laid down in the product specification of an agricultural product or foodstuff covered by a protected name has not been met.
- (2) The member State referred to in paragraph 1 shall make its submission to the member State concerned. The member State concerned shall examine the complaint and inform the other member State of its findings and of any measures taken.

- (3) In the event of repeated irregularities and the failure of the member States concerned to come to an agreement, a duly substantiated application must be sent to the Commission.
- (4) The Commission shall examine the application by consulting the member States concerned. Where appropriate, having consulted the committee referred to in Article 15, the Commission shall take the necessary steps. These may include cancellation of the registration."

E. SCOPE OF RIGHTS AND USE

36. *May anyone who meets the criteria submitted to obtain recognition of a geographical indication use that geographical indication after recognition is given or must additional criteria or procedures be followed by that party before use is permitted?*

Any producer or processor who satisfies the conditions laid down in the specification may use the geographical indication after it has been recognized and entered in the "Register of protected designations of origin and protected geographical indications" kept by the European Commission.

37. *Who makes the determination regarding use of a geographical indication by particular parties, the entity responsible for the recognition or the entity that obtained the recognition?*

Pursuant to the aforementioned Regulation No. 2081/92, any producer established in the defined area who satisfies the conditions laid down in the specification is entitled to use the geographical indication.

38. *Are there fees involved in receiving authorization to use a particular geographical indication and, if so, what are those fees and how are they established?*

In Belgium, a producer or processor who fulfils the conditions laid down in the specification must request a certificate of origin issued by a private body approved by the King. The relevant fees may, where appropriate, be claimed for the analyses effected. Such fees, the amount of which is fixed by Royal Decree, are broken down according to the types of services rendered by the approved body.

39. *If there is a dispute regarding use of a geographical indication by a particular party, what procedures are followed to resolve it?*

See the reply to question 35 above.

40. *Must individual authorized users of a geographical indication use that geographical indication continually to retain their right to use it and, if so, how is their use determined and how long will disuse be permitted?*

See the reply to question 30 above.

41. *If there is a dispute over continuity of use by a particular party, how is it resolved?*

See the reply to question 40 above.

42. *Does the regime for protection of geographical indications allow geographical indications to be licensed and, if so, what conditions are imposed on such licences? If such conditions are not met, what is the effect on the geographical indication?*

No.

43. *How is "grandfathered use" of a geographical indication, under Article 24.4 of the TRIPS Agreement, applied in your country?*

See the provisions of Article 13, paragraphs 2 and 4, of Regulation No. 2081/92.

F. RELATIONSHIP TO TRADE MARKS

44. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.1 of the TRIPS Agreement are not nullified and impaired?*

Article 14(1) of Regulation No. 2081/92:

"Where a designation of origin or geographical indication is registered in accordance with this Regulation, the application for registration of a trade mark corresponding to one of the situations referred to in Article 13 (content of the protection granted) and relating to the same type of product shall be refused, provided that the application for registration of the trade mark was submitted after the date of the publication provided for in Article 6(2) (publication in the Official Journal of the European Communities).

"Trade marks registered in breach of the first subparagraph shall be declared invalid.

"This paragraph shall also apply where the application for registration of a trade mark was lodged before the date of publication of the application for registration provided for in Article 6(2), provided that that publication occurred before the trade mark was registered."

Article 14(2):

"With due regard for Community law, use of a trade mark corresponding to one of the situations referred to in Article 13 (i.e. one which infringes a protected name) which was registered in good faith before the date on which application for registration of a designation of origin or geographical indication was lodged may continue notwithstanding the registration of a designation of origin or geographical indication, where there are no grounds for invalidity or revocation of the trade mark as provided respectively by Article 3(1)(c) and (g) and Article 12(2)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the member States relating to trade marks".

As regards wines and grape musts, see Article 40, paragraphs 2 and 3, of the above-mentioned Regulation No. 2392/89.

45. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.2 and 16.3 of the TRIPS Agreement are not nullified and impaired?*

Article 14(3) of Regulation No. 2081/92:

"A designation of origin or geographical indication shall not be registered where, in the light of a trade mark's reputation and renown and the length of time it has been used, registration is liable to mislead the consumer as to the true identity of the product."

46. *What procedures are foreseen in case of a conflict of a geographical indication with a trademark?*

See the reply to question 44 above.

G. ENFORCEMENT

47. *How are rights in the geographical indication enforced? Are provisions available under unfair competition law? Trademark law? Other laws? Provide citations to the laws and, if they have not been notified under Article 63.2 of the TRIPS Agreement, please provide copies.*

See the replies to questions 17, 34 and 44 above. Member States adopt the necessary measures to enforce the provisions of Regulation No. 2081/92.

The same obligation applies with regard to wine products: Article 16 of Regulation 823/87 and Articles 72(4), 72a and 79 of Regulation No. 822/87.

48. *Who has the right to enforce a geographical indication?*

See the replies to questions 17, 34 and 35 above.

49. *What judicial or administrative bodies have jurisdiction over enforcement actions related to geographical indications? Are there fees involved and, if so, what are those fees?*

See the reply to question 34 above.

50. *Must the public be notified of the existence of a geographical indication and, if so, how and how often?*

The public is notified of the existence of a registered and protected name by means of publication of that name (and of the amendments to the Register of protected designations of origin and protected geographical indications) in the Official Journal of the European Communities (Article 6(4) of Regulation No. 2081/92). Publication in the *Moniteur Belge* is also effected.

51. *Is unauthorized use of a geographical indication subject to criminal action and, if so, describe the procedures. If the law has not been notified pursuant to Article 63.2 of the TRIPS Agreement, please provide a copy.*

Yes. See the replies to questions 33 and 34 above.

H. INTERNATIONAL AGREEMENTS

52. *Is your government party to an international, including bilateral or plurilateral, agreement for the notification and/or registration of geographical indications? If so, please name the international agreement and explain the relationship between it and your national legislation.*

Belgium is a member of the European Union and as such applies Community legislation on geographical indications and designations of origin.

53. *What other international agreements, if any, have been entered into? What do those agreements provide?*

None.

Responses from Denmark

I. RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13

A. GENERAL

1. *Is protection for geographical indications provided through unfair competition law, e.g., passing off, false designation of origin; through a formal procedure for notification/registration before protection is available; or through both? Does the recognition of a geographical indication require registration?*

The protection for geographical indications is provided through provisions in the Danish Marketing Practices Act, No. 428 of 1 June 1994 (*Markedsføringsloven*) and the Danish Food etc. Act, No. 310 of 6 June 1973 (*Levnedsmiddelloven*). Such protection does not require registration. Legal means to prevent use of geographical indications is in Denmark further based on the EU Council and Commission Regulations (the most important ones being Regulations No. 822/87, No. 823/87, No. 2392/89, No. 3201/90 and No. 3378/94).

2. *Is there one single regime of protection of geographical indications for all products? If not, identify the different regimes.*

The Danish Marketing Practices Act provides the general protection of geographical indications (cf. Articles 1 and 2 - prohibition against unfair competition and misleading advertising). A single regime of geographical protection does not exist. However, the general clause in Article 23 of the Danish Food etc. Act stipulates that foodstuffs must not be sold under circumstances which can result in the consumer being misled concerning the marketing of food, wines and spirits (the origin of the product, the time of production, nature, sort, quantity, compositions, treatment, characteristics and effect). Further, it is possible to obtain a registration of a collective mark including a geographical indication (cf. Article 3 of the Collective Marks Act (*Faellesmaerkeloven*)), but this registration does not provide protection of geographical indications used by a third person in accordance with good marketing practice. The latter regulation corresponds with the EEC Regulation No. 2081/92.

3. *Do(es) the regime(s) of protection of geographical indications also extend to services?*

As the protection ensured through the above Acts applies to all kinds of marketing practices incompatible with good marketing practices, the protection extends to services.

4. *What provisions of law or regulations are directed to the recognition of geographical indications required by Articles 22.2 and 23.1 of the TRIPS Agreement? Citations to laws should be provided and, if the texts of the laws have not been notified to the WTO, copies should be provided pursuant to Article 63.2.*

According to Article 22 of the TRIPS Agreement, the Danish Marketing Practices Act, Article 2, provides for a prohibition against misleading advertising. This provision undoubtedly includes the use of geographical indications calculated to mislead. Article 23 of the Danish Food etc. Act provides protection as mentioned in the reply to question 2 above.

5. *If the required recognition of geographical indications is not provided through statutes or regulations, please explain, in detail, the mechanism or mechanisms through which the protection required is provided.*

The protection is provided through the provisions of the above Acts.

6. *Please provide a few examples of domestic geographical indications protected in accordance with the means discussed above and indicate the means by which such protection is provided.*

Case law regarding domestic geographical indications is scarce. Nevertheless, Denmark is in compliance with its obligations under the TRIPS Agreement. As an example, U57.545 H can be mentioned, where a shopkeeper had violated the provision of prohibition against misleading advertising in the Danish Competition Law, which was applicable at that time, by selling foreign tomatoes under such indication on a show-card that the buyer would normally get the impression that the tomatoes were of Danish origin.

7. *Is the higher level of protection required for wines and spirits under Article 23.2 of the TRIPS Agreement provided for any other product? If so, please specify such products and the law under which they are protected.*

Yes. EU Regulation No. 2081/92 provides such protection.

B. DEFINITION AND CRITERIA FOR RECOGNITION

8. *How are geographical indications defined?*

Geographical indications are not specifically defined. However, the Danish Marketing Practices Act and the Food Act provide for a general prohibition against acts which can mislead consumers. These general rules are applied in cases of false or misleading use of geographical indications.

9. *Would such a definition comprise geographical indications identifying products of a certain quality or reputation which are indirectly linked to a specific region?*

Yes, as the protection applies to all kinds of misleading information, it will also cover such indirect links to specific regions.

10. *In determining whether recognition should be given a geographical indication, what criteria are considered?*

Criteria concerning recognition of geographical indications are based on a specific judgement. The main criterion is whether a geographical indication is known as a geographical indication in the relevant sector of the public. If it is not known or if it has become a generic term, protection is not granted.

11. *Is there any human creativity involved in the making of specific products under protection by the system of geographical indications? If so, how much? And do these products involve any human factors?*

Human creativity does not necessarily have to be involved in the making of the geographical indication.

12. *Are there any other intellectual property rights involved, such as patents for example?*

Other intellectual property rights may be involved in cases where the geographical indication is applied for as a trademark according to the Danish Trade Marks Act. The Collective Marks Act contains a provision that expressly allows for registration of geographical indications (cf. section 3).

13. *What authority, if any, may define the geographic region or area for which rights are claimed and on what basis is such definition made?*

No authority "defines" the geographic region or area for which rights are claimed. The court decides whether the use of a geographical indication is misleading according to the above Acts.

14. *Does your legislation contain criteria for homonymous geographical indications for wines?*

The practical conditions under which homonymous geographical indications will be distinguished from one another are based on EU Regulation No. 2392/89, particularly Articles 25-29 and 40; EU Regulation No. 3201/90 and the Food Act (section 23) and the Danish Marketing Practices Act (sections 1 and 2). According to these rules, only geographical indications mentioned in Regulation No. 3201/90 can be used as a description for wine in the EU and wine imported from a third country. Further, geographical indications may not imply the risk of confusion or mislead the consumer as to the true origin of the wine. The interpretation of the Danish Marketing Practices Act and the Danish Food etc. Act is always based on a specific judgement of how a homonymous geographical indication is able to mislead the consumer as to the true origin of the wine.

15. *Does your national legislation provide for recognition and protection of geographical indications or appellations of origin of foreign countries?*

The proceedings relating to the use of a misleading geographical indication as mentioned above apply to all indications, no matter the origin.

16. *Is there any specific prohibition in the legislation/regulations/rules/procedures covering geographical indications not protected in the country of origin? If so, please specify the relevant statutory provision.*

No.

C. PROCEDURE FOR RECOGNITION

17. *With respect to any formal system for recognition of geographical indications, must the applicant be a governmental organization or can a private entity own the rights to a geographical indication?*

No formal system for recognition of geographical indications exists.

18/19. *What are the competent authorities where the protection of a geographical indication can be obtained? Do the procedures which lead to the recognition of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

The protection of geographical indications is obtained through the procedures laid down in the Danish Marketing Practices Act.

20. *What, if any, fees are involved in the application and maintenance of rights in a geographical indication?*

No fees are involved.

21-24. *If criteria must be set out in an application for recognition of a geographical indication, are those criteria purely geographic in nature? What other criteria, if any, must be set out in an application for recognition of a geographical indication? What information must be supplied in an application for rights in a geographical indication? Must the goods or services with respect to which a geographical indication is claimed be set out?*

No criteria or information are to be set out in this context (cf. the above reply).

25-27. *What mechanisms are provided to oppose the recognition of a geographical indication? How is an investigation conducted after such a complaint? Who can oppose the recognition of a geographical indication? If your national legislation provides for recognition and protection of geographical indications or appellations of origin of foreign countries, what is the procedure that has to be followed in order to obtain such recognition and consequent protection?*

The Danish protection of geographical indications is not based on a system of recognition but rather on prohibition against misleading use of a geographical indication. The recognition of a geographical indication is in this context based on a normal court procedure where the defendant has the possibility of opposing the claim that his indication is misleading.

D. MAINTENANCE

28. *How long does recognition for a geographical indication continue?*

No prescribed time-limit for the protection against misleading information appears from the Danish Marketing Practices Act or the Danish Food etc. Act.

29. *If recognition of a geographical indication must be renewed or reaffirmed, what information must be provided in order to effect such a renewal or reaffirmation? Specify any fees involved in renewal or reaffirmation.*

No system for renewal or reaffirmation of the protection of geographical indications exists.

30. *Must a geographical indication be used in order to maintain rights? If so, how is such use determined?*

No requirements of use exist in this context.

31. *Is there a specified limit for non-use before rights in a geographical indication cease and, if so, what is that limit?*

There are no such limits for non-use.

32. *Who monitors the use of geographical indications to determine if the criteria identified in the application continue to be met?*

There are no provisions laid down in this context (cf. the reply to question no. 1 above).

33. *If a government entity is responsible for monitoring the use of geographical indications, what are its procedures for doing so?*

See the reply to question 32 above.

34. *Are there means by which interested parties may request termination of a geographical indication based on non-use or failure to maintain the criteria identified in the application? Describe the procedure.*

There are no such means.

35. *Do the procedures which lead to forfeiture of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

Actions against misleading use of a geographical indication can be initiated both by the Danish authorities and by other entities having a "legal interest" in the matter.

E. SCOPE OF RIGHTS AND USE

36. *May anyone who meets the criteria submitted to obtain recognition of a geographical indication use that geographical indication after recognition is given or must additional criteria or procedures be followed by that party before use is permitted?*

If a person or entity is entitled to use a geographical indication, which is not misleading, no additional criteria are required.

37. *Who makes the determination regarding use of a geographical indication by particular parties, the entity responsible for the recognition or the entity that obtained the recognition?*

The determination regarding use of a geographical indication is made by a court of law.

38. *Are there fees involved in receiving authorization to use a particular geographical indication and, if so, what are those fees and how are they established?*

No fees are involved.

39. *If there is a dispute regarding use of a geographical indication by a particular party, what procedures are followed to resolve it?*

To resolve a dispute regarding geographical indications, the procedure of the Danish Marketing Practices Act should be used.

40. *Must individual authorized users of a geographical indication use that geographical indication continually to retain their right to use it and, if so, how is their use determined and how long will disuse be permitted?*

No provisions exist in this regard.

41. *If there is a dispute over continuity of use by a particular party, how is it resolved?*

Such dispute can be resolved through a normal court procedure.

42. *Does the regime for protection of geographical indications allow geographical indications to be licensed and, if so, what conditions are imposed on such licenses? If such conditions are not met, what is the effect on the geographical indication?*

There are no licensing provisions concerning geographical indications.

43. *How is "grandfathered use" of a geographical indication, under Article 24.4 of the TRIPS Agreement, applied in your country?*

"Grandfather use" will be considered by the competent authorities, if claimed by one of the parties.

F. RELATIONSHIP TO TRADEMARKS

44. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.1 of the TRIPS Agreement are not nullified and impaired?*

A trademark that consists solely of a geographical indication cannot be registered, except if it has acquired distinctiveness through use. Many figurative marks (e.g. labels for wines and foodstuffs) which contain geographical indications as an element can, however, be registered if the applicant resides in the region or if the products originate from the region. Such trademark registration will not be affected by a subsequent recognition of a geographical indication.

45. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.2 and 16.3 of the TRIPS Agreement are not nullified and impaired?*

See the reply to question 44 above.

46. *What procedures are foreseen in case of a conflict of a geographical indication with a trademark?*

The procedures in case of a conflict are the normal procedures as applied in case of any trademark conflict, i.e. both administrative procedures (opposition and revocation) and normal civil procedures before the courts of law.

G. ENFORCEMENT

47. *How are rights in the geographical indication enforced? Are provisions available under unfair competition law? Trademark law? Other laws? Provide citations to the laws and, if they have not been notified under Article 63.2 of the TRIPS Agreement, please provide copies.*

In the Danish Trade Marks Act, the grounds for refusal are laid down in sections 13 and 14. A trademark cannot be registered if the mark infringes a geographical origin or violates the provisions concerning good marketing practice according to the Danish Marketing Practices Act. If the registration has, nevertheless, taken place, it can be invalidated by actions taken by the injured party. This party can be a person, an entity or a public authority. Geographical indications are enforced by a normal court procedure. The provisions available for this procedure are the above Acts, which are the Danish Marketing Practices Act, the Danish Food etc. Act and the Danish Trade Marks Act. The procedure regarding the Food etc. Act is initiated by the Public Prosecutor.

48. *Who has the right to enforce a geographical indication?*

The Danish authorities ensure ex officio, as a part of the examination procedure and opposition procedure form third parties, that geographical indications are not registered as trademarks. Further, the Consumer Ombudsman is entitled to bring actions against the users of misleading information regarding geographical indications. Eventually, any person or entity is entitled to enforce a geographical indication (cf. the Danish Trade Marks Act and the Danish Marketing Practices Act). The protection according to the Danish Food etc. Act must be enforced by the Public Prosecutor (Section 64) and no fees are involved.

49. *What judicial or administrative bodies have jurisdiction over enforcement actions related to geographical indications? Are there fees involved and, if so, what are those fees?*

Measures in this respect are taken by courts of law or by the Consumer Ombudsman.

50. *Must the public be notified of the existence of a geographical indication and, if so, how and how often?*

No.

51. *Is unauthorized use of a geographical indication subject to criminal action and, if so, describe the procedures. If the law has not been notified pursuant to Article 63.2 of the TRIPS Agreement, please provide a copy.*

Sanctions against violations of the Danish Marketing Practices Act are fines or detention without trial. The Danish Food etc. Act provides for fines, detention without trial or up to one year of imprisonment.

H. INTERNATIONAL AGREEMENTS

52. *Is your government party to an international, including bilateral or plurilateral, agreement for the notification and/or registration of geographical indications? If so, please name the international agreement and explain the relationship between it and your national legislation.*

Denmark is a party to the Madrid Protocol, the Paris Convention and of course the TRIPS Agreement, but no agreement with the specific aim of protecting geographical indications.

53. *What other international agreements, if any, have been entered into? What do those agreements provide?*

None.

II. RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13/ADD.1

A. GENERAL (SECTION A OF DOCUMENT IP/C/13)

1. *Does your economy's industrial property law and/or related law prevent the use of geographical indications identifying wines or spirits against products not originating in the place indicated by the geographical indication, 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" or the like?*

There are no clear distinctions among the terms mentioned in the question.

B. DEFINITION AND CRITERIA FOR RECOGNITION (SECTION B OF DOCUMENT IP/C/13)

2. *Is there a clear distinction among the terms "geographical indications", "appellations of origin" and "indications of source" in your economy's industrial property law and/or related law, or are there any substantive criteria to distinguish these terms?*

The Danish Marketing Practices Act and the Danish Food etc. Act prevent the use of a geographical indication as said in the question.

3. *Does your legislation contain criteria for homonymous geographical indications for wines and spirits?*

See the replies to questions 44 and 47 under I above.

C. RELATIONSHIP TO TRADEMARKS (SECTION F OF DOCUMENT IP/C/13)

4. *Does your economy's industrial property law and/or related law provide the refusal or invalidation of a trademark registration, which consists of or contains geographical indications identifying wines or spirits with respect to such wines or spirits not originating in the indicated territory?*

See the reply to question 14 under I above.

Responses from Finland

RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13

A. GENERAL

1. *Is protection for geographical indications provided through unfair competition law, e.g., passing off, false designation of origin; through a formal procedure for notification/registration before protection is available; or through both? Does the recognition of a geographical indication require registration?*

Geographical indications enjoy general protection under the Consumer Protection Act (No. 38/1978). The purpose of this Act is to discourage any acts, which are inappropriate in relation to consumers. To this effect, the Act contains various provisions aiming at prohibiting such acts. In respect of marketing, sections 1 and 2 contain particularly prohibitions to use marketing allegations or other statements which are contrary to good practice or which may be regarded as misleading marketing. These provisions can be applied, for example, in cases where a product has been released on the market with a label or sign, which could be misleading to the public. Similarly, these provisions can be applied when misleading information of the type, quantity, quality, origin or other characteristics of the product has been given to consumers.

The Unfair Business Practises Act provides for specific remedies to prevent forms of exploitation described in Article 22.2 (a) and (b) of the TRIPS Agreement. Also, the Trademarks Act provides a general obligation to refuse registration in cases where the mark applied for is misleading. Thus, a geographical indication must not indicate an origin if there is no real connection between the indicated origin and the used geographical indication.

Indications relating to wines and spirits enjoy protection under the Alcohol Act (No. 1143/94). Paragraph 43 states the responsibility of the producer and the importer. According to this provision, the producer and the importer shall answer for the quality and composition of the alcoholic beverages delivered by them for consumption as well as for the circumstance that the product and its labelling and other presentation of it are in compliance with the provisions and regulations issued.

The protection of agricultural products and foodstuffs is based on the implementation of the EEC Regulation on the protection of geographical indications and designations of origin (No. 2081/92) and the supplementary provisions to it. The Ministry of Agriculture and Forestry has, by virtue of the Act on implementation of the common agricultural policy of the EC (No. 1100/94), given out a Decision on the minimum protection of agricultural products and foodstuffs (No. 933/95), as well as a Decision on certificates concerning special character of agricultural products and foodstuffs (No. 934/1995).

2. *Is there one single regime of protection of geographical indications for all products? If not, identify the different regimes.*

See the answer to question 1 above.

3. *Do(es) the regime(s) of protection of geographical indications also extend to services?*

Yes, as the protection through the abovementioned Acts applies to all kinds of marketing practices, the protection covers both goods and services.

4. *What provisions of law or regulations are directed to the recognition of geographical indications required by Articles 22.2 and 23.1 of the TRIPS Agreement? Citations to laws should be provided and, if the texts of the laws have not been notified to the WTO, copies should be provided pursuant to Article 63.2.*

See the answer to question 1 above.

5. *If the required recognition of geographical indications is not provided through statutes or regulations, please explain, in detail, the mechanism or mechanisms through which the protection required is provided.*

See the answer to question 1 above.

6. *Please provide a few examples of domestic geographical indications protected in accordance with the means discussed above and indicate the means by which such protection is provided.*

The protection of "Lapin puikula-peruna" (a name of a potato brand originating from the Lapland region) has been registered under Council Regulation (EEC) No. 2081/92.

7. *Is the higher level of protection required for wines and spirits under Article 23.2 of the TRIPS Agreement provided for any other product? If so, please specify such products and the law under which they are protected.*

See the joint reply by the European Communities and their member States.

B. DEFINITION AND CRITERIA FOR RECOGNITION

8. *How are geographical indications defined?*

See the joint reply by the European Communities and their member States. See also Finland's answers to questions 1, 2, 4 and 5 above and to the explanation therein on our Trademark Act.

9. *Would such a definition comprise geographical indications identifying products of a certain quality or reputation which are indirectly linked to a specific region?*

The national legislation is aimed at prohibiting inappropriate marketing and the use of misleading information. Definition is therefore not dependable on whether the link to a certain region is direct or indirect.

10. *In determining whether recognition should be given a geographical indication, what criteria are considered?*

See the answer to question 8 above.

11. *Is there any human creativity involved in the making of specific products under protection by the system of geographical indications? If so, how much? And do these products involve any human factors?*

See the joint reply by the European Communities and their member States.

12. *Are there any other intellectual property rights involved, such as patents for example?*

Trademarks.

13. *What authority, if any, may define the geographic region or area for which rights are claimed and on what basis is such definition made?*

For agricultural products and foodstuffs, the Finnish Ministry of Agriculture and Forestry defines the geographical region or area for which rights are claimed having received the opinions of the Name Protection Board, the local agricultural authority and the supervisory authority. After examination of the application, the Ministry delivers the application to the European Commission.

14. *Does your legislation contain criteria for homonymous geographical indications for wines?*

See the joint reply by the European Communities and their member States. According to the Finnish Alcohol Act, it is forbidden to give misleading information of the origin or other characteristics of the product. The decision whether the use of a homonymous name is misleading will be taken case by case.

15. *Does your national legislation provide for recognition and protection of geographical indications or appellations of origin of foreign countries?*

Yes, see the joint reply by the European Communities and their member States.

16. *Is there any specific prohibition in the legislation/regulations/rules/procedures covering geographical indications not protected in the country of origin? If so, please specify the relevant statutory provision.*

No.

C. PROCEDURE FOR RECOGNITION

17. *With respect to any formal system for recognition of geographical indications, must the applicant be a governmental organization or can a private entity own the rights to a geographical indication?*

See the joint reply by the European Communities and their member States. There is no national system for recognition of geographical indications.

18. *What are the competent authorities where the protection of a geographical indication can be obtained?*

See the answer to question 13 above.

19. *Do the procedures which lead to the recognition of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

An application is required to initiate a procedure leading to the recognition of a geographical indication.

20. *What, if any, fees are involved in the application and maintenance of rights in a geographical indication?*

No, there are no fees involved.

21-24. *If criteria must be set out in an application for recognition of a geographical indication, are those criteria purely geographic in nature? What other criteria, if any, must be set out in an application for recognition of a geographical indication? What information must be supplied in an application for rights in a geographical indication? Must the goods or services with respect to which a geographical indication is claimed be set out?*

Registration of a geographical indication can be obtained through a Community procedure for agricultural products and foodstuffs. Criteria for recognition are set out in the Community legislation. (See the joint reply by the Communities and their member States.)

For wines and other products the protection is based on the prohibition to give misleading information. (See our earlier replies).

25. *What mechanisms are provided to oppose the recognition of a geographical indication? How is an investigation conducted after such a complaint?*

Council Regulation No. 2081/92, Article 7 describes the mechanism to oppose the recognition of a geographical indication of an agricultural product or foodstuff.

26. *Who can oppose the recognition of a geographical indication?*

With respect to agricultural products and foodstuffs, any member State of the European Union and any legitimately concerned natural or legal person may, according to Council Regulation No. 2081/92, Article 7, oppose to the proposed registration. See also Finland's answers to questions 47 and 48 below.

27. *If your national legislation provides for recognition and protection of geographical indications or appellations of origin of foreign countries, what is the procedure that has to be followed in order to obtain such recognition and consequent protection?*

Council Regulation No. 2081/92, Article 12 describes the procedures for agricultural products and foodstuffs.

D. MAINTENANCE

28/29. *How long does recognition for a geographical indication continue? If recognition of a geographical indication must be renewed or reaffirmed, what information must be provided in order to effect such a renewal or reaffirmation? Specify any fees involved in renewal or reaffirmation.*

There is no time limit for recognition of the geographical indications.

30/31. *Must a geographical indication be used in order to maintain rights? If so, how is such use determined? Is there a specified limit for non-use before rights in a geographical indication cease and, if so, what is that limit?*

See the joint reply by the European Communities and their member States.

32. *Who monitors the use of geographical indications to determine if the criteria identified in the application continue to be met?*

National Food Administration, National Product Control Agency for Welfare and Health as well as the Provincial State Offices direct the monitoring of the use of geographical indications. The municipal authorities primarily carry out supervision in practice. From the standpoint of consumers, the Consumer Ombudsman and the municipal consumer authorities also carry out the monitoring.

33-35. *If a government entity is responsible for monitoring the use of geographical indications, what are its procedures for doing so? Are there means by which interested parties may request termination of a geographical indication based on non-use or failure to maintain the criteria identified in the application? Describe the procedure. Do the procedures which lead to forfeiture of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

The national legislation is based on a structure where the emphasis lies in the assessment whether the indication is misleading or not. The abovementioned monitoring authorities are obliged to carry out surveillance ex officio and they are also entitled to do so by request. Monitoring consists of inspecting documents, storage, sales as well as transport. Also marketing is monitored. Interested parties or consumers may report any deficiencies or misconduct directly to municipal authorities, even though there is no formal procedure for doing so.

See also joint replies by the European Communities (Council Regulation No. 2081/92).

E. SCOPE OF RIGHTS AND USE

36-42. The right to use a particular geographical indication is determined on the basis of an assessment concerning the product and its characteristics. Thus any person or party may use the geographical indication to the extent that his/her product meets the criteria submitted to obtain the indication in question. Because there is no possibility of obtaining an authorisation in advance, there are neither any fees nor procedures involved nor any provisions concerning the non-use or licensing.

43. *How is "grandfathered use" of a geographical indication, under Article 24.4 of the TRIPS Agreement, applied in your country?*

There are no provisions covering grandfathered use.

F. RELATIONSHIP TO TRADEMARKS

44-46. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.1 of the TRIPS Agreement are not nullified and impaired? What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.2 and 16.3 of the TRIPS Agreement are not nullified and impaired? What procedures are foreseen in case of a conflict of a geographical indication with a trademark?*

On the Community legislation, see the joint replies by the European Communities.

At the national level, the relationship between trademarks and geographical indications is determined mainly in connection with the application procedure for trademark registration. As a general rule, the Trademarks Act excludes the registration of a mark, which can mislead the public on the origin of the product. Also a prior right to a geographical indication (registered on the basis of Council Regulation No. 2081/92) prevents the registration of an identical or similar trademark. If a

trademark has been registered contrary to these rules, the registration may be invalidated according to the provisions of the Trademarks Act.

G. ENFORCEMENT

47-49. How are rights in the geographical indication enforced? Are provisions available under unfair competition law? Trademark law? Other laws? Provide citations to the laws and, if they have not been notified under Article 63.2 of the TRIPS Agreement, please provide copies. Who has the right to enforce a geographical indication? What judicial or administrative bodies have jurisdiction over enforcement actions related to geographical indications? Are there fees involved and, if so, what are those fees?

The provision concerning enforcement is available under various laws. Inappropriate acts can be prohibited under Section 2 of the Consumer Protection Act and Section 6 of the Unfair Business Practices Act. When these prohibitions are violated, the Market Court may issue orders, also interim ones, prohibitions or fines of the continuation of such violations. If such an order is not obeyed, a new order may be issued. In addition, compensation for damages shall be paid for violations of such a prohibition. According to Section 49 of the Alcohol Act, alcoholic beverages may be removed from the market, if the product or its presentation is contrary to the provisions and regulations concerning it.

A consumer can turn to the Consumer Ombudsman and ask the ombudsman to investigate the matter and to take it to the Market Court. The Ombudsman can also ex officio take up matters concerning misleading marketing. According to the Unfair Business Practices Act, the Market Court may issue an order or a prohibition at the request of an interested party whose rights are violated or whose business is affected by the violation.

Filing a complaint with the Consumer Ombudsman is not liable to any fees. When a case is brought to the Market Court, the plaintiff is responsible for the disbursement of the trial fee, which is at the moment Fmk 1,000. A person with limited means may also be granted cost-free proceedings.

50. Must the public be notified of the existence of a geographical indication and, if so, how and how often?

Geographical indications for agricultural products and foodstuffs are notified to the public under the provisions of Council Regulation No. 2081/92. As for other products, there are no specific provisions concerning the publication or the notification of the existence of a geographical indication.

51. Is unauthorized use of a geographical indication subject to criminal action and, if so, describe the procedures. If the law has not been notified pursuant to Article 63.2 of the TRIPS Agreement, please provide a copy.

Under the provisions of the Consumer Protection Act and the Unfair Business Practices Act, a violation of an order issued by the Market Court is punishable. Penalties include fines and up to one year's imprisonment.

H. INTERNATIONAL AGREEMENTS

52/53. Is your government party to an international, including bilateral or plurilateral, agreement for the notification and/or registration of geographical indications? If so, please name the international agreement and explain the relationship between it and your national legislation. What other international agreements, if any, have been entered into? What do those agreements provide?

Finland is not a party to any international agreement, which would directly concern the notification and/or registration of geographical indications. As a member of the European Union, Finland is under the obligation to implement Community legislation and to conform to the agreements, which the Union has entered into.

Responses from France

I. RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13

A. GENERAL

1. *Is protection for geographical indications provided through unfair competition law, e.g., passing off, false designation of origin; through a formal procedure for notification/registration before protection is available; or through both? Does the recognition of a geographical indication require registration?*

There are various texts providing protection for geographical indications: the Consumer Code enacted by Law No. 93-949 of 26 July 1993, as amended, and Decree No. 68-807 of 13 September 1968.

In general, geographical indications are subject to the general requirement of conformity laid down by Articles L 212-1 ff. of the Consumer Code. Thus, deception with respect to the nature, composition or origin (Article L 217-6 of the Consumer Code) of the product and the possession, display and offering for sale of such products are punishable offences.

Similarly, Article L 121-1 prohibits all advertising that includes, in whatever form, allegations, indications or representations that are false or such as to mislead where these relate to ... the origin ... of the goods and services advertised.

Articles L 115-1 to L 155-26 of the Consumer Code afford specific protection for the designations eligible under French intellectual property law, namely appellations of origin and registered appellations of origin, as well as protected geographical indications and protected designations of origin within the meaning of Council Regulation (EEC) No. 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs. In this case each recognized geographical indication is published in the Official Journal of the French Republic (Journal Officiel de la République Française - JORF) in the form of a decree-order, which establishes entitlement to protection.

2. *Is there one single regime of protection of geographical indications for all products? If not, identify the different regimes.*

In France, the geographical indication protection regimes apply to all products. However, only agricultural and food products, raw or processed, are eligible for a registered appellation of origin or an agricultural label/certificate of conformity with geographical indication.

3. *Do(es) the regime(s) of protection of geographical indications also extend to services?*

No, as far as geographical indications as defined in the TRIPS Agreement are concerned.

4. *What provisions of law or regulations are directed to the recognition of geographical indications required by Articles 22.2 and 23.1 of the TRIPS Agreement? Citations to laws should be provided and, if the texts of the laws have not been notified to the WTO, copies should be provided pursuant to Article 63.2.*

See the reply to question 1 above. All these provisions were notified by France at the beginning of 1996 and published in documents IP/N/1/FRA/G/1 to 5 and IP/N/1/FRA/O/1.

5. *If the required recognition of geographical indications is not provided through statutes or regulations, please explain, in detail, the mechanism or mechanisms through which the protection required is provided.*

The entire procedure is expressly addressed by the texts in question.

6. *Please provide a few examples of domestic geographical indications protected in accordance with the means discussed above and indicate the means by which such protection is provided.*

France has notified the following examples of geographical indications:

(1) Agricultural and agri-food products

- Spirit drinks:

Cognac, Registered Appellation of Origin (RAO), Decree of 15 May 1935.

- Wines:

Chateauneuf du Pape RAO, Decree of 2 November 1966;

Southern French wines, Decree of 15 October 1987.

- Cheeses and other dairy produce:

Beaufort RAO, Decree of 12 August 1993;

Tomme de Savoie, Label No. 02.76, Order of 27 July 1978, Protected Geographical Indication (PGI).

- Other food products:

Nyons olive oil and Nyons black olives RAO, Decrees of 10 January 1994;

Landes yellow chicken, Label No. 18-91, Order of 23 June 1992, PGI;

Lautrec pink garlic, Label No. 02.66, Order of 20 June 1966, PGI.

(2) Other products

Tahiti Monoi, appellation of origin, Decree No. 92-340 of 1 April 1992, appended.

All these geographical indications are protected in France by the provisions of the Consumer Code and by Decree No. 68-807 (see the reply to question 1 above).

7. *Is the higher level of protection required for wines and spirits under Article 23.2 of the TRIPS Agreement provided for any other product? If so, please specify such products and the law under which they are protected.*

The Intellectual Property Code has been amended to take into account Article 23.2 of the TRIPS Agreement for wines and spirits. However, in France all products with geographical indications benefit from a high level of protection.

B. DEFINITION AND CRITERIA FOR RECOGNITION

8. *How are geographical indications defined?*

Geographical indications are defined by the following texts:

- Articles L 115.1, L 115.22, L 115.23 and L 115.26.1 of the Consumer Code, as amended by the Law of 3 January 1994;
- Article 5 of Decree No. 68-807 of 13 September 1968;
- Article 2 of Regulation (EEC) 2081/92 of 14 July 1992.

9. *Would such a definition comprise geographical indications identifying products of a certain quality or reputation which are indirectly linked to a specific region?*

The definition of geographical indications refers to criteria of quality, renown and reputation which in France are directly linked with the region of origin.

10. *In determining whether recognition should be given a geographical indication, what criteria are considered?*

Criteria expressing the link with the place of origin (renown, reputation, quality, natural factors, human factors) are taken into consideration in the geographical indication recognition procedure.

11. *Is there any human creativity involved in the making of specific products under protection by the system of geographical indications? If so, how much? And do these products involve any human factors?*

Human factors form part of the criteria adopted for the recognition of a specific product eligible in France for a designation of origin.

12. *Are there any other intellectual property rights involved, such as patents for example?*

No.

13. *What authority, if any, may define the geographic region or area for which rights are claimed and on what basis is such definition made?*

The request for the recognition of geographical indications is always based on a request from the trade. The National Institute of Appellations of Origin (INAO) and the National Joint-Trade Wines Office (ONIVINS) in their capacity as public institutions, the National Commission of Agricultural and Food Product Labels and Certificates (CNLC), an independent administrative authority, and the ministries concerned all contribute within their sphere of competence to the definition of production areas, conditions of production and control requirements.

The opinion of the Conseil d'Etat, the higher administrative jurisdiction, is required by the ministries concerned for the recognition by decree of a geographical indication for a product other than an agricultural product or foodstuff.

14. *Does your legislation contain criteria for homonymous geographical indications for wines?*

With regard to wines, the Community provisions concerning homonymous geographical indications are set out in Article 15.4, for similar products, and in Article 15.5, for other products, of Council Regulation (EEC) No. 823/87, as amended, of 16 March 1987 laying down special provisions relating to quality wines produced in specified regions.

The French legislation, under Article L 115-5 of the Consumer Code, also excludes any possibility of homonymous geographical indications, for similar products, and any use of the geographical name constituting a designation of origin or any term evoking it, for other products, where such use might lead to the misappropriation or lessening of the renown of a designation of origin.

15. *Does your national legislation provide for recognition and protection of geographical indications or appellations of origin of foreign countries?*

The relevant provisions of the Consumer Code are similarly applicable to foreign geographical indications if they have previously been incorporated in the lists of the bilateral or multilateral agreements to which France is party. (For example, the designations: Havana, for Cuban tobacco, and Budweiser, Budvar and Pilsen, for Czech beers, are protected by previous decisions of the French courts.)

A foreign geographical indication can also be protected in France on the basis of the general provisions of the Consumer Code (L 212-1 ff., L 217-6 and L 121-1, see the reply to question 1 above).

16. *Is there any specific prohibition in the legislation/regulations/rules/procedures covering geographical indications not protected in the country of origin? If so, please specify the relevant statutory provision.*

The protection of a geographical indication by France is based on the principle of its recognition and protection in the country of origin.

C. PROCEDURE FOR RECOGNITION

17. *With respect to any formal system for recognition of geographical indications, must the applicant be a governmental organization or can a private entity own the rights to a geographical indication?*

Each geographical indication is the subject of recognition by the public authority and cannot be owned privately.

The right to use a geographical indication is reserved for members of the trade who respect the conditions attached to each geographical indication.

18. *What are the competent authorities where the protection of a geographical indication can be obtained?*

Each within its own sphere of competence, the INAO, ONIVINS, CNLC, the ministries concerned and the Conseil d'Etat all contribute to the recognition of geographical indications (see the reply to question 13 above).

19. *Do the procedures which lead to the recognition of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

The initiative must necessarily come from the trade.

20. *What, if any, fees are involved in the application and maintenance of rights in a geographical indication?*

The trade makes a financial contribution to the costs of applying and maintaining rights in geographical indications.

21. *If criteria must be set out in an application for recognition of a geographical indication, are those criteria purely geographic in nature?*

No, see the reply to question 10 above.

22. *What other criteria, if any, must be set out in an application for recognition of a geographical indication?*

See the reply to question 10 above.

23. *What information must be supplied in an application for rights in a geographical indication?*

Any information tending to show that the application is well-founded and, in particular, the links with the place of origin, renown, reputation, qualities, and natural and human factors.

24. *Must the goods or services with respect to which a geographical indication is claimed be set out?*

The application for recognition specifies the product for which a geographical indication is requested.

25. *What mechanisms are provided to oppose the recognition of a geographical indication? How is an investigation conducted after such a complaint?*

Various comment and public enquiry procedures are followed in connection with the geographical indication recognition process. These enable the members of the trade to express their views. If recognition is disputed, the channels of appeal against administrative decisions are available.

26. *Who can oppose the recognition of a geographical indication?*

Any natural or legal person may comment on/oppose the recognition of a geographical indication.

27. *If your national legislation provides for recognition and protection of geographical indications or appellations of origin of foreign countries, what is the procedure that has to be followed in order to obtain such recognition and consequent protection?*

The recognition of a foreign geographical indication in France presupposes incorporation in the lists of bilateral or multilateral agreements.

The criminal courts are competent under the rules of ordinary law for products for which a geographical indication has been recognized in France or abroad.

Under Articles L 115-16 and L 115-18 (Consumer Code), it is an offence, on the one hand, to make unlawful use of or, on the other hand, to affix or have affixed or to cause to appear by excision, addition or alteration an incorrect designation of origin on natural or manufactured products offered for sale or intended to be offered for sale. The sale, offering for sale or placing in free circulation of such products is subject to the same penalties (Articles L 115-16 and L 115-18 of the Consumer Code). Article L 115-17 allows individuals, unions or associations to claim criminal indemnification if they consider themselves to have been injured by the offence.

In general, geographical indications are subject to the general requirement of conformity established by Articles L 212-1 ff. of the Consumer Code. Thus, deception with respect to the nature, composition or origin (Article L 217-6 of the Consumer Code) of the product and the possession, display and offering for sale of such products are punishable offences.

Similarly, Article L 121-1 prohibits all advertising that includes, in whatever form, allegations, indications or representations that are false or such as to mislead where these relate to ... the origin ... of the goods and services advertised.

Proceedings may be instituted in the civil or criminal courts, for example on the basis of Article L 115-5 of the Consumer Code which prohibits any use liable to lead to the misappropriation or lessening of the renown of a designation of origin.

Any foreigner who is the owner of intellectual property rights protected in France may have them enforced in any court, in accordance with the same rules of attribution of jurisdiction.

D. MAINTENANCE

28. *How long does recognition for a geographical indication continue?*

Geographical indications are recognized indefinitely.

29. *If recognition of a geographical indication must be renewed or reaffirmed, what information must be provided in order to effect such a renewal or reaffirmation? Specify any fees involved in renewal or reaffirmation.*

There is no provision for such a procedure (see the reply to question 28 above).

30. *Must a geographical indication be used in order to maintain rights? If so, how is such use determined?*

The protection of a geographical indication is not subject to its continuous use. The inspection procedures attest to the use of a geographical indication.

31. *Is there a specified limit for non-use before rights in a geographical indication cease and, if so, what is that limit?*

No.

32. *Who monitors the use of geographical indications to determine if the criteria identified in the application continue to be met?*

Quality and quantity controls are carried out by a third party: INAO, ONIVINS, certifying bodies, control commissions, public official monitoring services.

33. *If a government entity is responsible for monitoring the use of geographical indications, what are its procedures for doing so?*

Quality and quantity controls are based on documents and on-the-spot inspections of the production conditions and the products (analysis, tasting, labelling, packaging).

34. *Are there means by which interested parties may request termination of a geographical indication based on non-use or failure to maintain the criteria identified in the application? Describe the procedure.*

At the request of interested members of the trade, the production conditions and the production area may be modified under a procedure identical to the recognition procedure.

35. *Do the procedures which lead to forfeiture of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

Apart from requests for modifications of the production area and production conditions (see reply to question 34 above), action to withdraw recognition of a geographical indication is rare and taken at the request of the trade (e.g., AOC Parsac-Saint Emilion, recognition Decree revoked by a Decree of 24 June 1993).

E. SCOPE OF RIGHTS AND USE

36. *May anyone who meets the criteria submitted to obtain recognition of a geographical indication use that geographical indication after recognition is given or must additional criteria or procedures be followed by that party before use is permitted?*

The requirements attached to the use of a geographical indication are all laid down in the recognition texts. The producer must be located in the production area and must respect the specific production conditions.

37. *Who makes the determination regarding use of a geographical indication by particular parties, the entity responsible for the recognition or the entity that obtained the recognition?*

See the replies to questions 30 and 32 above.

38. *Are there fees involved in receiving authorization to use a particular geographical indication and, if so, what are those fees and how are they established?*

See the reply to question 20 above.

39. *If there is a dispute regarding use of a geographical indication by a particular party, what procedures are followed to resolve it?*

The ordinary courts are competent in accordance with the rules of ordinary law to deal with products having a recognized geographical indication. The legal provisions cited in reply to question 27 above are applicable.

40. *Must individual authorized users of a geographical indication use that geographical indication continually to retain their right to use it and, if so, how is their use determined and how long will disuse be permitted?*

No.

41. *If there is a dispute over continuity of use by a particular party, how is it resolved?*

See the reply to question 40 above (negative).

42. *Does the regime for the protection of geographical indications allow geographical indications to be licensed and, if so, what conditions are imposed on such licences? If such conditions are not met, what is the effect on the geographical indication?*

In France, geographical indications and, more particularly, designations of origin are a specific intellectual property right. This regime does not operate on a licensing basis.

43. *How is "grandfathered use" of a geographical indication, under Article 24.4 of the TRIPS applied in your country?*

Today, France no longer uses for its products any third-country geographical indication recognized and protected in its country of origin. It has abandoned these practices by means of transition periods negotiated at the time. Some geographical indications recognized and protected in France, particularly some of the most prestigious designations of origin, are being used by certain Members of the WTO within the meaning of the Article 24.4 exception.

F. RELATIONSHIP TO TRADEMARKS

44. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.1 of the TRIPS Agreement are not nullified and impaired?*

The relationship between trademarks and geographical indications is organized as follows:

- Article 40.3 of Regulation (EEC) No. 2392/89 and Article 13.3 of Regulation (EEC) No. 2333/92 preserve, in particular, the right to a brand name for a wine which contains the name of a specified region if that brand name corresponds to the identity of its original holder and if it was registered at least 25 years before the official recognition of the geographical indication and has actually been used since then without interruption. This right cannot be invoked against the use of geographical names for wines.
- Article 14 of Regulation (EEC) No. 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs deals with the relationship between trademarks and geographical indications:

- Paragraph 2, in particular, provides that the use of a trademark registered in good faith before the date on which application for registration of a geographical indication was lodged may continue notwithstanding the registration of a geographical indication, where there are no grounds for invalidity or revocation of associated with a risk of the consumer's being deceived.
- Paragraph 3 stipulates that: "A designation of origin or geographical indication shall not be registered where, in the light of a trademark's reputation and renown and the length of time it has been used, registration is liable to mislead the consumer as to the true identity of the product".
- The Consumer Code (Article L 115-5) provides that "neither the geographical name constituting the designation of origin nor any other term evoking it may be employed for any similar product, subject to the laws and regulations in force on 6 July 1990, or for any other product or service, where such use may lead to the misappropriation or lessening of the renown of the designation of origin".

45. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Articles 16.2 and 16.3 of the TRIPS Agreement are not nullified and impaired?*

See the reply to question 44 above.

46. *What procedures are foreseen in case of a conflict of a geographical indication with a trademark?*

In the event of a conflict between a geographical indication and a trademark, the provisions of Articles L 711-2, L 711-3 and L 711-4 of the Intellectual Property Code will apply.

Article L 711-2 excludes from registration as a trademark, as non-distinctive, signs or names which may serve to designate ... the geographical origin ... of the goods or service.

Article L 711-3: "The following may not be adopted as a mark or an element of a mark:

- (a) Signs excluded by Article 6^{ter} of the Paris Convention for the Protection of Intellectual Property of 20 March 1883, as revised, or by Article 23.2 of Annex IC to the Agreement Establishing the World Trade Organization;
- (b) signs contrary to public policy or morality or whose use is prohibited by law; or
- (c) signs liable to mislead the public, particularly as regards the nature, quality or geographical origin of the goods or services."

Article L 711-4: "Signs may not be adopted as marks where they infringe prior rights, particularly:

- (...),
- (d) a protected appellation of origin,
(...)."

Proceedings may be instituted in the civil or criminal courts, for example, on the basis of Article L 115-5 of the Consumer Code which prohibits any use liable to lead to the misappropriation or lessening of the renown of a designation of origin.

G. ENFORCEMENT

47. *How are rights in the geographical indication enforced? Are provisions available under unfair competition law? Trademark law? Other laws? Provide citations to the laws and, if they have not been notified under Article 63.2 of the TRIPS Agreement, please provide copies.*

See the reply to question 39 above.

48. *Who has the right to enforce a geographical indication?*

The owners of intellectual property rights have the capacity to have their rights enforced in the courts. In French, the term "right owner" is preferred to the term "right holder" used in the TRIPS Agreement.

The public authorities generally provide protection against the misuse of geographical indications by instituting criminal proceedings. An action for wrongful use of a geographical indication may also be brought in the civil courts (see the reply to question 27 above).

When the wrongful use of a geographical indication constitutes a criminal offence, the procedures are as follows:

- (1) Any natural or legal person who finds that wrongful use is being made of a geographical indication may refer the matter to the administrative authority responsible for the application of the Consumer Code (General Directorate of Competition, Consumption and Enforcement - DGCCRF).

This administration then makes the appropriate administrative inquiries in order that, if necessary, the offenders may be prosecuted.

The case is referred to the judicial authority (State prosecutor) on the basis of an administrative document which sets out all the established facts.

In accordance with the general rules of French criminal law, the interests of the plaintiff are normally protected by means of a public prosecution initiated by both the administration and the State prosecutor.

Within these proceedings, the plaintiff may obtain compensation for the injury suffered and claim criminal indemnification in the form of damages and interest. The plaintiff does not have to be represented by a lawyer.

- (2) Within the context of their normal supervisory activities, the DGCCRF's supervisors may, on their own initiative, investigate any wrongful use of a geographical indication and, moreover, refer the matter, under the above-mentioned conditions, to the judicial authorities.

Furthermore, anyone who considers himself injured by this offence may, by lodging a complaint with the investigating judge, bring criminal indemnification proceedings and instigate a public prosecution.

The general role of the police and gendarmerie is to receive complaints and, where appropriate, after making their inquiries, refer the matter to the State prosecutor.

The National Institute of Appellations of Origin, an administrative public institution responsible for monitoring, promoting and protecting appellations of origin and for protecting the wine market and the economic regime for alcohol, under the Ministry of Agriculture and Fisheries, may bring criminal indemnification proceedings under Article 23 of the Decree-Law of 30 July 1935 relating to the protection of the wine market and the economic regime for alcohol, published in the OJ of 31 July 1935.

Article L 421-1 of the Consumer Code states that: "Lawfully declared associations whose explicit statutory purpose is to protect the interests of the consumer may, if so authorized, exercise the rights accorded to parties bringing criminal indemnification proceedings in relation to acts which harm, directly or indirectly, the collective interests of consumers (...)".

According to Article L 421-7 of the same Code "The associations mentioned in Article L 421-1 may apply to be joined to proceedings before the civil courts (...) when the purpose of the initial action is to obtain compensation for injury suffered by one or more consumers because of acts that do not constitute a criminal offence".

49. *What judicial or administrative bodies have jurisdiction over enforcement actions related to geographical indications? Are there fees involved and, if so, what are those fees?*

See the reply to question 39 above.

50. *Must the public be notified of the existence of a geographical indication and, if so, how and how often?*

The text recognizing a geographical indication is published in the Official Journal (JORF).

51. *Is unauthorized use of a geographical indication subject to criminal action and, if so, describe the procedures. If the law has not been notified pursuant to Article 63.2 of the TRIPS Agreement, please provide a copy.*

See the reply to question 39 above.

H. INTERNATIONAL AGREEMENTS

52. *Is your government party to an international, including bilateral or plurilateral, agreement for the notification and/or registration of geographical indications? If so, please name the international agreement and explain the relationship between it and your national legislation.*

France is a Member of the WTO.

It has also acceded to the following WIPO Series Conventions which deal, in part, with geographical indications:

- Paris Convention;
- Madrid Agreement for the Repression of False or Deceptive Indications of Sources on Goods of Origin;

- Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, under which all French appellations of origin are registered.

France is also party to the Stresa Convention on the Use of Appellations of Origin and Denominations of Cheeses.

France protects French and foreign designations of origin in accordance with its national legislation and, by decree, has incorporated these international conventions and agreements into its domestic law in order to have them applied and their terms respected.

53. *What other international agreements, if any, have been entered into? What do those agreements provide?*

Before the implementation of the TRIPS Agreement, France had signed bilateral agreements in order to protect French appellations of origin (see document IP/N/4/FRA/1 of 29 January 1996).

As a member State of the European Union, France applies the various agreements relating to the protection of geographical indications concluded by the European Communities, in particular with Australia, the United States, Mexico, Hungary, Romania and Bulgaria.

II. RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13/ADD.1

A. GENERAL (SECTION A OF DOCUMENT IP/C/13)

1. *Does your economy's industrial property law and/or related law prevent the use of geographical indications identifying wines or spirits against products not originating in the place indicated by the geographical indication, 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" or the like?*

The French legislation (Consumer Code, Article L 115-5) states that "neither the geographical name constituting the appellation of origin nor any other term evoking it may be employed for any similar product, subject to the laws and regulations in force on 6 July 1990, or for any other product or service, where such use may lead to the misappropriation or lessening of the renown of the designation of origin".

As a party to the Lisbon Agreement, France has been applying its provisions since 25 September 1966. According to Article 3 of this Agreement, "protection is provided against any misuse or imitation, even if the true origin of the product is indicated or the designation is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like".

Article 13(b) of Regulation (EEC) No. 2081/92, which is directly applicable in France, contains similar provisions.

B. DEFINITION AND CRITERIA FOR RECOGNITION (SECTION B OF DOCUMENT IP/C/13)

2. *Is there a clear distinction among the terms "geographical indications", "appellations of origin" and "indications of source" in your country's industrial property law and/or related law, or are there any substantive criteria to distinguish these terms?*

The French legislation recognizes the appellation of origin as an intellectual property right and as the "name of a country, region or locality used to designate a product originating therein and

whose quality or characteristics are due to a particular geographical environment with its inherent natural and human factors."

As a member of the European Union, it applies Council Regulation (EEC) No. 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs.

Article 2 of this Regulation defines designation of origin and geographical indication as follows:

"For the purposes of this Regulation:

"(a) Designation of origin: means the name of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff:

- Originating in that region, specific place or country; and
- the quality or characteristics of which are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors, and the production, processing and preparation of which take place in the defined geographical area;

"(b) geographical indication: means the name of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff:

- originating in that region, specific place or country; and
- which possesses a specific quality, reputation or other characteristics attributable to that geographical origin and the production and/or processing and/or preparation of which take place in the defined geographical area.

"Certain traditional geographical or non-geographical names designating an agricultural product or a foodstuff originating in a region or a specific place, which fulfil the conditions referred to in the second indent of paragraph 2(a) shall also be considered as designations of origin."

These geographical names are geographical indications within the meaning of Article 22 of the TRIPS Agreement.

3. *Does your legislation contain criteria for homonymous geographical indications for wines and spirits?*

See the reply to question 14 under I above.

C. RELATIONSHIP TO TRADEMARKS (SECTION F OF DOCUMENT IP/C/13)

4. *Does your economy's industrial property law and/or related law provide for the refusal or invalidation of a trademark registration which consists of or contains geographical indications identifying wines or spirits with respect to such wines or spirits not originating in the indicated territory?*

See the reply to question 46 under I above.

Responses from Germany

I. RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13

A. GENERAL

1. *Is protection for geographical indications provided through unfair competition law, e.g. passing off, false designation of origin; through a formal procedure for notification/registration before protection is available; or through both? Does the recognition of a geographical registration require registration?*

In Germany the following mechanisms for the protection of geographical indications exist:

- EC-wide protection under EC Regulation No. 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ No. L 208, 24 July 1992, p. 1), which is directly applicable in Germany; this Regulation does not apply to wines and spirits;
- EC-wide protection of geographical indications for wines (EC Regulation No. 2392/89, OJ No. L 232, 9 August 1989, p. 13) and spirits (EC Regulation No. 1576/89, OJ No. L 160, 12 June 1989, p. 1);
- protection against unfair and misleading use of a geographical indication under German law;
- protection as a collective mark;
- protection of geographical indications for wines under the German Wine Act (Weingesetz);
- national protection of certain geographical indications for spirits.

With regard to protection under Regulation 2081/92, Part 6, Chapter 2 of the German Trade Mark Law contains provisions dealing with purely procedural matters. The material prerequisites for protection are contained in the Regulation itself which is directly applicable in Germany.

Apart from the system established by EC Regulation 2081/92, no system of registration of geographical indications exists in Germany. Protection of geographical indications in German law (which are called "*geographische Herkunftsangaben*", i.e. "indications of geographical origin") is based on legal provisions prohibiting acts contrary to honest business practices; and especially acts likely to mislead or deceive the public. According to Section 127, paragraph 1 of the Trade Mark Law, geographical indications are protected against misleading use.

Paragraph 2 of Section 127 of the Trade Mark Law protects geographical indications which stand - in the public view, i.e. in the relevant trade circles - not only for the origin of the product but also for a certain quality. In such cases, the geographical indication may not be used for products which do not have the quality generally associated with products bearing the geographical indication in question. The relevant quality standard is not elaborately determined by a product specification, it rather depends on what the relevant sectors of the public expect of a product bearing the geographical indication in question. According to Section 127, paragraph 3 of the Trade Mark Law, geographical

indications which have acquired a particular reputation are protected against any damage to or exploitation of such reputation, irrespective of whether or not the public is being misled.

These provisions are supplemented by Section 3 of the Unfair Competition Act (*Gesetz gegen den unlauteren Wettbewerb*) and Section 17, paragraph 1, No. 5 of the Act on Foodstuffs and Commodities (*Lebensmittel-und Bedarfsgegenständegesetz*). Both forbid misleading designations. All these provisions are also applicable to geographical indications which designate a place or an area outside Germany.

Geographical indications for goods or services can also be registered as collective marks (Sections 97 and 99 Trade Mark Law). It is, however, not possible to register a geographical indication as a trade mark (see Section 8, paragraph 2, No. 2 of the Trade Mark Law), unless a trade mark contains a geographical indication and has - by virtue of its use in affected trade circles - established itself as the distinguishing sign for the goods or services for which the trade mark has been filed (see Section 8, paragraph 3 of the Trade Mark Law).

Geographical indications for wines are governed by Section 23, paragraph 1 of the Wine Act (*Weingesetz*). Some of the admissible geographical indications are laid down in the Wine Act itself, some are governed by ordinances of the Federal Ministry of Food, Agriculture and Forestry, and some have been laid down by the *Land*⁴ governments and the communities. In principle, everyone producing wine made from grapes cultivated in a specific geographical unit is allowed to use - without any further recognition procedure - the geographical indication of that unit.

2. *Is there one single regime of protection of geographical indications for all products? If not, identify the different regimes.*

(a) General

The protection against unfair or misleading use and the protection as collective marks (see under question 1 above) covers geographical indications for all sorts of goods or services. EC law provides protection according to special regimes for wines (EC Regulation No. 2392/89, OJ No. L 232, 9 August 1989, p. 13), spirits (EC Regulation No. 1576/89, OJ No. L 160, 12 June 1989, p. 1), foodstuffs and agricultural products (EC Regulation No. 2081/92, OJ No. L 208, 24 July 1992, p. 1).

In addition to that, Section 137 of the Trade Mark Law authorizes the Federal Ministry of Justice to lay down by legal ordinance detailed provisions concerning individual indications of geographical origin, including the area of origin, the quality or other properties of the goods to which the geographical indication applies, and the way the indication is used. The only legal ordinance which has yet been passed concerns steel from the town of Solingen, (*Verordnung zum Schutz des Namens Solingen*, i.e. "Ordinance for the Protection of the Name Solingen" of 16 December 1994, BGBl. I.S. 3833).

(b) Geographical indications for wines

In the wine sector, there is a regime under public law governing geographical indications. The relevant provisions are laid down in EC wine law and in the rules of the Wine Act and the Wine Ordinance (Federal law) as well as in the Regulations and Acts of the *Länder*.⁴

⁴ Federal State.

(c) Geographical indications for spirits

Apart from 19 German spirit drinks with geographical descriptions, protected under the EC Regulation on Spirit Drinks No. 1576/89 (OJ EC No. L 160 of 12 June 1989):

- one spirit drink is currently protected in the national ordinance on spirit drinks (*Deutscher Weinbrand*); and
- two spirit drinks in the so-called German definitions of spirit drinks (*Steinhäger, Schwarzwälder Kirschwasser*). These are, however, no legal norms in form and in substance. In case of legal disputes on the question whether a specific labelling or presentation of spirit drinks is liable to mislead the public, the courts draw on these definitions as an aid in interpretation.

Apart from that, the general protection against unfair or misleading use of geographical indications applies (e.g. *Bayerischer Bärwurz, Pfälzer Weinbrand*).

3. *Do(es) the regime(s) of protection of geographical indications also extend to services?*

The general protection against unfair or misleading use and the protection as collective marks (see under question 1 above) also extends to services.

4/5/6. *What provisions of law or regulations are directed to the recognition of geographical indications required by Articles 22.2 and 23.1 of the TRIPS Agreement? If the required recognition of geographical indications is not provided through statutes or regulations, please explain, in detail, the mechanisms through which the protection required is provided. Please provide a few examples of domestic geographical indications protected in accordance with the means discussed above and indicate the means by which such protection is provided.*

(a) General protection of geographical indications irrespective of the goods or services concerned

In order to enjoy the kind of protection against unfair or misleading use described in the answer to question 1 above, geographical indications do not have to be formally recognized in an administrative procedure. Such protection is afforded if the relevant sectors of the public in Germany understand the indication in question as referring to the geographical origin of the goods or services to which it applies, either because the place of origin is explicitly, "directly", mentioned in the indication (*Westfälischer Schinken, Solinger Stahl, Pfälzer Weinbrand*) or because the origin is "indirectly" referred to, for example by reference to a flag, a symbol (for instance the "Berliner Bear") or a picture which suggests a certain geographical origin. Whether this is the case may have to be proved in court.

Injunctive relief is provided for violations of the prohibitions against unfair or misleading use of geographical indications (Sections 126 et seq. of the Trade Mark Law; Section 3 of the Law Against Unfair Competition). This claim for injunctive relief cannot only be asserted by everybody who legally uses the geographical indication in question, but also by businessmen who market goods or services of the same or similar type on the same market, by associations having as one of their purposes the repression of unfair competition, by consumer associations, and by the chambers of industry and commerce or craft chambers (Section 128, paragraph 1 of the Trade Mark Law and Section 13, paragraph 2 of the Law Against Unfair Competition). This is in line with Article 22.2 of the TRIPS Agreement.

(b) Geographical indications for wines

According to Article 72(a) of Regulation (EEC) No. 823/87, Member States have to adopt suitable measures to enable the persons concerned, pursuant to the provisions of Articles 23 and 24 of the TRIPS Agreement, to prevent in the EC the use of geographical indications for products whose origin does not correspond to the place specified in the geographical indication, even if the actual origin is indicated or if the geographical indication is used in a translation or together with expressions like "method", "type", "style", "imitation".

Furthermore, the *Land*⁵ authorities in charge of the controls, including wine inspectors, may prohibit the placing on the market as well as imports and exports of products for which misleading indications, designations, other information or presentations are used and may withdraw these products from the market. "Misleading" also means presentations, designs or correct information which could raise false expectations regarding the geographical origin of the products. This rule also applies if the producer country has been duly indicated (Section 25, paragraph 1 and paragraph 3 of the Wine Act). Such a violation can also be prosecuted under criminal law (Section 49, No. 4 of the Wine Act).

According to Section 23, paragraph 1 of the Wine Act, only the following indications of origin of products may be used:

- (1) for quality wine psr, in addition to the name of the specified region prescribed on the basis of legal acts by the European Community:
 - (a) the names of the vineyard sites and areas registered in the vineyard register;
 - (b) the names of communities and places;
- (2) for *vin de pays (Landwein)* the names of areas cultivating it;
- (3) for table wine which has not been defined as *vin de pays (Landwein)* the names of wine-growing areas and subregions.

Section 3 of the Wine Act lays down the 13 German wine-growing areas.

According to Section 23, paragraph 4 of the Wine Act the *Land*⁵ governments regulate the establishment and keeping of the vineyard register (register of vineyard sites and areas). In doing so, they have to lay down, for the geographical units of vineyard site and area:

- (1) the demarcation;
- (2) detailed prerequisites and the procedure for registrations and deletions including determination of the names;
- (3) application eligibility as well as content and form of the applications for registration of vineyard sites and areas in the vineyard register;
- (4) registration ex officio and deletion.

Section 2 of the Wine Ordinance lays down the 19 German areas cultivating *vin de pays (Landwein)*.

⁵ See footnote 4 above.

Section 1 of the Wine Ordinance lays down the 5 German wine-growing areas for table wine, including their subregions.

(c) Additional protection of geographical indications for spirits

Additional protection is provided by the following provisions:

- Article 1, paragraph 4(c) of the EC Regulation on spirit drinks: No. 1578/89 for *Korn* and *Kornbrand*;
- Annex II in conjunction with Article 5, paragraph 3 of the EC Regulation on spirit drinks, No. 1576/89; Annex III to the EC Regulation on spirit drinks, No. 1576/89;
- Section 2 of the national ordinance on spirit drinks (*Deutscher Weinbrand*);
- German definitions of spirit drinks (*Steinhäger*, *Schwarzwälder Kirschwasser*). These definitions represent a written summary of the generally accepted view on the composition and labelling of the individual categories of spirit drinks, which the German spirit drinks industry has elaborated in agreement with business circles and consumers. In case of legal disputes on the question whether a specific labelling or presentation of spirit drinks is liable to mislead the public, the courts draw on these definitions as an aid in interpretation.

In addition to the mechanisms mentioned in this response under (a) above, misleading use of geographical indications for spirits can be enjoined by virtue of an administrative procedure under food law. This is, for instance, the case when a manufacturer of spirit drinks markets a product with an indication which the general public understands as pointing to the geographical origin of the product, but the product does not in any way come from this region (no raw materials from this region, no manufacturing or production stages in this region), e.g. if a German enterprise were to produce a *Weinbrand* (brandy) in Hamburg from French wines and market the brandy under the geographical indication *Pfälzer Weinbrand*.

Competitors, consumer protection associations or the protective association for spirit drinks can turn to the food inspection authorities locally responsible for the surveillance of the composition and presentation of spirit drinks and request them to issue an administrative injunction. Against this injunction the manufacturer or dealer concerned can initiate an administrative opposition procedure, and, if the administrative opposition procedure was unsuccessful, legal proceedings in an administrative court.

7. *Is the higher level of protection required for wines and spirits under Article 23.2 of the TRIPS Agreement provided for any other product? If so, please specify such products and the law under which they are protected.*

Section 8, paragraph 2, No. 2 of the Trade Mark Law provides that "trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the ... geographical origin ... of the goods or of the rendering of the services" shall not be registered ex officio. An exemption exists for such trademarks which - by virtue of the use which has been made of them - have established themselves in affected trade circles as the distinguishing sign for the goods or services for which such marks were filed (Section 8, paragraph 3 of the Trade Mark Law). If a geographical indication has been registered in violation of these provisions, everybody may request the German Patent Office to cancel the registration (see Section 50, paragraph 1, No. 3, and paragraph 2 of the Trade Mark Law).

These provisions are of general applicability. They are not limited to geographical indications for wines or spirits, but cover all sorts of geographical indications, "direct" or "indirect" (see under questions 4-6 above), domestic or foreign.

B. DEFINITION AND CRITERIA FOR RECOGNITION

8. *How are geographical indications defined?*

(a) General protection of geographical indications irrespective of the goods or services concerned

Section 126, paragraph 1 of the Trade Mark Law defines geographical indications ("geographische Herkunftsangaben") as "names of places, areas, regions or countries as well as other indications or signs used in the course of trade to identify the geographical origin of goods or services". According to Section 126, paragraph 2 of the Trade Mark Law, names, indications or signs of a generic nature shall not be eligible for protection as geographical indications.

(b) Geographical indications for wines

EC wine legislation and the German Wine Act use different legal definitions to identify the origin of specific products.

According to Article 6 of Regulation (EEC) No. 823/87 quality wines psr may be obtained only from grapes of vine varieties harvested within the specified region.

Name of a geographical unit (Article 2, paragraph 3(a); Article 4, paragraph 1; Article 11, paragraph 2(i); Article 13, paragraph 1; Article 20, paragraph 3(a); Article 29, paragraph 1 of Regulation (EEC) No. 2392/98. This is the name of a specified region, a region which is not a specified one (wine-growing area or area cultivating *vin de pays (Landwein)*), a subregion or part of a subregion, a community or part thereof, a vineyard site or a unit comprising several vineyard sites (collective site or area).

The Geographical designation ("*Geographische Bezeichnung*") (Title of Section 23 of the Wine Act). The catalogue of admissible geographical indications under the German Wine Act includes the following: the name of the specified wine-growing area, names of vineyard sites and areas registered in the vineyard register, names of communities and parts thereof, names of areas cultivating *vin de pays (Landwein)*, names of areas, names of wine-growing areas and subregions. This catalogue basically matches that containing the names of geographical units of EC legislation, but makes their use conditional on specific prerequisites or restricts their use.

Geographical indication ("*Geographische Angabe*") (Article 26, subparagraph 1(a); paragraph 2(b); Article 29 of Regulation (EEC) No. 2392/89; heading of Section 39 of the Wine Ordinance). This term is also identical with the term "geographical designation".

Indication of origin ("*Angabe der Herkunft/Herkunftsangabe*") (Section 23(1) of the Wine Act; Section 39(5) of the Wine Ordinance and heading of Section 40 of the Wine Ordinance). These terms are identical with the term "geographical designation".

(c) Geographical indications for spirits

The following distinction can be made with respect to geographical descriptions for spirits:

- (1) Indications or designations of geographical origin as designations of an actually existing city, region or state, which are either used alone (e.g. *Cognac*, *Calvados*) or in combination with a generic term (e.g. *Deutscher Weinbrand*, *Schwarzwälder Kirschwasser*);
- (2) indirect traditional indications or designations of geographical origin, e.g. *Korn* or *Kornbrand*, the use of which is by legal provision exclusively reserved to a specific region (e.g. Article 1, paragraph 4(c) of the EU Regulation on spirit drinks, No. 1576/89), because the products in question are traditionally produced only in these regions.

9. *Would such a definition comprise geographical indications identifying products of a certain quality or reputation which are indirectly linked to a specific region?*

(a) General

The term "*geographische Herkunftsangabe*" used in Section 126 covers all signs which may serve to indicate the geographical origin of goods or services, irrespective of whether a certain quality or reputation of these goods or service is linked to their geographical origin or not, and irrespective of whether the place of origin is explicitly, "directly", mentioned in the indication (*Westfälischer Schinken*, *Solinger Stal*, *Pfälzer Weinbrand*) or whether it is indirectly referred to, for example by reference to a flag, a symbol (for instance the "Berlin Bear"), or a picture which suggests a certain geographical origin.

(b) Geographical indications for wines

The German Wine Act does not establish an explicit link between origin and quality.

(c) Geographical indications for spirits

With regard to spirits, a link between origin and quality exists. The examples "Bourbon" (cf. agreement on spirit drinks between the EU and the USA) or *Korn* show that this is the case. Thus, a specific origin (German-speaking area of the EU) is tied to the indication *Korn*. This recognition of origin is justified as this spirit drink has always been produced only in this region according to a specific manufacturing process set by law (spent grains mash process instead of wort process, i.e. only the healthy whole grain with all its components from only five domestic raw materials may be used, thus no defective grain, flour, etc.). This manufacturing process traditionally only exists in this region.

10. *In determining whether recognition should be given a geographical indication, what criteria are considered?*

(a) General

See under questions 4-6 above. There is no formal process of recognition of geographical indications. In case of conflict, a court will decide on the basis of admissible evidence. The only criterion for determining whether a sign is to be protected as a geographical indication is whether the relevant sectors of the public in Germany understand it as indicating the geographical origin of the goods or services to which it applies.

(b) Geographical indications for spirits

Criteria to be considered are a special, outstanding quality distinguishing the product in question from generic products either because the raw materials have a special quality due to their geographical origin (soil, climate) (e.g. *Schwarzwälder Kirschwasser* or because of a characteristic manufacturing process prevailing in the region of origin.

11. *Is there any human creativity involved in the making of specific products under protection by the system of geographical indications? If so, how much? And do these products involve any human factors?*

(a) General

Involvement of human creativity in the making of products to which a geographical indication applies is no prerequisite for protection.

(b) Geographical indications for wines

Apart from the site conditions of the vine (microclimate and soil conditions), human factors, such as the care taken over viticulture and the production practices, also play a major role. Therefore, a domestic quality wine psr may only bear the indication of the wine-growing area if an official inspection number has been assigned to it as part of the organoleptic examination (Section 19, paragraph 1 of the Wine Act).

(c) Geographical indications for spirits

Human creativity and human factors (particular recipe, distiller's experience) can play a key role in some cases.

12. *Are there any other intellectual property rights involved, such as patents for example?*

There is no obvious legal connection in German law between the protection of geographical indications and patent protection.

13. *What authority, if any, may define the geographical region or area for which rights are claimed and on what basis is such definition made?*

(a) General

In Germany, no administrative authority is charged with regulating the use of geographical indications. The geographical region or area for which a geographical indication may legally be used is the region or area which the relevant sectors of the public in Germany associate with such a geographical indication. In case of conflict, a court will decide on the basis of admissible evidence, such as, for instance, opinion polls, whether the geographical indication in question has been used in a misleading way or not.

With regard to protection of geographical indications as collective marks (Sections 97 et seq. of the Trade Mark Law), the geographical region or area can be defined by the association filing for registration of the collective mark in the regulations governing its use.

(b) Geographical indications for wines

Specific wine-growing areas are laid down by Parliament in the German Wine Act.

The areas cultivating *vin de pays* (*Landwein*) and areas cultivating table wines are laid down by ordinance of the Federal Ministry of Food, Agriculture and Forestry with the consent of the *Bundesrat*.

The *Land*⁶ governments demarcate the viticultural regions by ordinance.

The responsible *Land*⁶ ministries in each case demarcate the sites and areas and order their registration in the vineyard register.

Applications for registrations of sites should be made by the local government of the region where the areas under vines are located. Owners and beneficiaries may, in principle, submit proposals to the local government regarding the names of sites. For giving advice to the local government, a site committee should be formed in the communities usually consisting of the Mayor as well as of persons representing viticulture and the wine trade.

Applications for registrations of areas are to be made by the office of the county district commissioner (*Landratsamt*) or the administration of the town, constituting an administrative district of its own, responsible for the areas under vines. Viticulture and wine trade organizations are to be heard before the filing of applications.

Before fixing sites and areas, the responsible *Land*⁶ minister hears an expert committee commenting on:

- the equivalence and similarity of yields of a site;
- the similarity of yields of an area, the traditional use of site and area names;
- an economically sound demarcation of sites and areas maintaining the site-related character.

14. *Does your legislation contain criteria for homonymous geographical indications for wines?*

Under Article 15, paragraph 4 of Regulation (EEC) 823/87, the name of a specified wine-growing area or a community or of a part thereof assigned in line with Community or national regulations may not be used by others to designate products of the wine sector.

Section 39, paragraph 1 of the Wine Ordinance sets out the following:

If the name:

- (1) of an area is used to designate a quality wine psr, it should be preceded by the indication "area" in characters of the same type, size and colour if it is identical or could be confused with any other geographical indication;
- (2) of a site is used to designate a quality wine psr, the names of the community or part thereof should be added.

⁶ See footnote 4 above.

15. *Does your national legislation provide for recognition and protection of geographical indications or appellations of origin of foreign countries?*

(a) General

There is no distinction between foreign and domestic geographical indications as far as the general protection against unfair and misleading use and protection as collective marks is concerned.

(b) Geographical indications for spirits

In the German spirit drinks sector, geographical descriptions of other EU member States are directly protected through the EC Regulation on spirit drinks, No. 1576/89. Specific spirit drinks with protected geographical descriptions from third countries are protected in Germany on the basis of the directly applicable Commission Regulation (EC) No. 1267/94 regarding the application of the mutual recognition of specific spirit drinks agreed between the European Union and third countries, e.g. "Bourbon" for the USA or "Tequila" for Mexico.

16. *Is there any specific prohibition in the legislation/regulations rules/procedures covering geographical indications or appellations not protected in the country of origin?*

(a) General

No such prohibition exists as far as the general protection against unfair and misleading use and protection as collective marks is concerned.

(b) Geographical indications for wines

The following applies under Article 29, paragraph 1 of Regulation (EEC) No. 2392/89.

Where an imported wine is described on the label by means of a geographical description, use may be made only of the name of a geographical unit and only under the following conditions:

- (1) in the case of wines originating in the territory of a third country, which is a Member of the World Trade Organization, or a region or locality in this territory, this geographical description must be used in line with the TRIPS Agreement. To this effect, the third country concerned is put on a list after submitting its legal provisions on the application of the TRIPS Agreement to the Commission;
- (2) in the case of third countries not applying Part II, Section 3 of the TRIPS Agreement, the following requirements must be met:
 - (a) the geographical indication in question designates a clearly demarcated wine-growing area, which is smaller than the entire wine-growing area of the third country concerned;
 - (b) the grapes from which the product was made come from this geographical unit;
 - (c) the grapes from which the wine with characteristic properties was made are harvested in this geographical unit;

- (d) the geographical indication is used on the domestic market of the country of origin to designate the wines and is intended for this purpose under the provisions of this country.

To this effect, the third country concerned is mentioned on a list after submitting its pertinent legal provisions to the Commission.

(c) Geographical indications for spirits

No such prohibitions exist.

C. PROCEDURE FOR RECOGNITION

17-27. With respect to any formal system for recognition of geographical indications, must the applicant be a governmental organization or can a private entity own the rights to a geographical indication? What are the competent authorities where the protection of a geographical indicator can be obtained? Do the procedures which lead to the recognition of a geographical indication take place ex officio or must they be based on the initiative of an entity or person? What, if any, fees are involved in the application and maintenance of rights in a geographical indication? If criteria must be set out in an application for recognition of a geographical indication, are those criteria purely geographical in nature? What other criteria must be set out in an application for recognition of a geographical indication? What information must be supplied in an application for rights in a geographical indication? Must the goods or services with respect to which a geographical indication is claimed to be set out? What mechanism are provided to oppose the recognition of a geographical indication? Who can oppose the recognition of a geographical indication? If your national legislation provides for recognition and protection of geographical indications or appellations of origin of foreign countries, what is the procedure that has to be followed in order to obtain such recognition and consequent protection?

(a) General

There is no formal system or procedure for recognition of geographical indications in German law.

Only if a foreign or domestic geographical indication is to be protected as a collective mark (Sections 97 et seq. of the Trade Mark Law), a formal procedure has to be followed. Such protection requires registration in the register kept by the German Patent Office. Applications for registration may only be filed by private or public associations having legal capacity (see Section 98 of the German Trade Mark Law).

Protection is afforded for specific classes of goods or services which have to be set out in the application. The fee for filing a collective mark covering three classes of goods or services is DM 1,500 plus DM 250 for every additional class of goods or services. The fee for extending protection in three classes of goods or services is DM 3,000, plus DM 450 for every additional class of goods or services. The application for registration must be accompanied by regulations governing the use of the mark (Section 102, paragraph 1 of the Trade Mark Act), in which the elements mentioned in Section 102, paragraphs 2 and 3 of the Trade Mark Act have to be specified. These elements are not of a purely geographical nature, but include the name, seat, purpose, representation of the association filing for registration, the conditions of membership, information on the group of persons having authority to use the collective mark, the conditions of use of the collective mark, including a provision to the effect that any person whose goods or services originate in the geographical area concerned and fulfill the conditions set out in the regulations shall be authorized to become a member of the association and shall be admitted to the group of persons having authority to

use the mark. The regulations also have to set out the rights and obligations of the parties concerned in the event of infringement of the collective mark. They may be inspected by anyone. Within three months following the date of publication of the registration of the collective mark, the proprietor of an earlier mark may file an opposition with the German Patent Office (Sections 97, paragraph 2 in conjunction with Section 42 of the Trade Mark Act).

(b) Geographical indications for wines

Questions 17-27 do not apply to the German legal system as the individual wine grower does not have to apply for a recognition of the geographical indication. On the contrary, he is entitled without any further (legal) act to use the geographical indication for wines harvested in the respective geographical unit. In the case of quality wines psr, the wine must, however, also have been produced in the respective geographical unit and an official organoleptic examination must be carried out.

The geographical indications under wine law constitute an exclusive right *sui generis*, which cannot be assigned to one single individual, but which is a type of "collective right" from which benefits arise for each individual owner within a geographical unit. The beneficiaries are accordingly all wine growers operating in a geographical unit.

(c) Geographical indications for spirits

There is no formal administrative application procedure for the recognition of geographical indications for spirits.

The indications or designations of origin in the spirit drinks sector are either expressly protected in Germany through a corresponding definition in legal provisions (EC Regulation No. 1576/89 or national ordinance on spirit drinks) or through the general prohibitions against unfair or misleading use of geographical indications.

In the event of several producers of spirit drinks in a certain region wishing to adopt an additional new geographical description into the national ordinance on spirit drinks, the competent Federal Ministry of Health initiates a legislative process and involves the other ministries concerned, the *Länder*⁷ which are responsible for enforcement, and would request the producer and consumer protection associations to deliver an opinion. Should this process reveal that a supposed geographical description has already become a generic name (e.g. *Stonsdorfer*), this term would not be protected as a geographical description.

It should be noted that a geographical description in the spirit drinks sector is not reserved for one single private enterprise in general. On the contrary, all enterprises having their registered office in a protected geographical area of spirit drinks (e.g. "Black Forest") and producing the geographically protected product according to the criteria defined in legal texts or in accordance with the public view are entitled to use this geographical indication (e.g. *Schwarzwälder Kirschwasser*).

A specific process of protection for foreign geographical indications within the framework of a national administrative or law-making procedure does not exist. Such indications are protected under the general legal provisions and proceedings.

⁷ See footnote 4 above.

D. MAINTENANCE

28/29. How long does recognition for a geographical indication continue? If recognition of a geographical indication must be renewed or reaffirmed, what information must be provided in order to affect such a renewal or reaffirmation?

Geographical indications are protected against unfair and misleading use as long as they are recognized by the relevant sectors of the public in Germany as indicating the geographical origin of the goods or services to which they apply. There is no need to formally renew or reaffirm recognition of a geographical indication.

Collective marks are protected for a period of ten years. The period of protection may be renewed for further periods of ten years against payment of a renewal fee. No further information has to be provided.

30/31. Must a geographical indication be used in order to maintain rights? Is there a specified limit for non-use before rights in a geographical indication cease and, if so, what is that limit?

Section 3 of the Law Against Unfair Competition, which protects the general public against misleading use of geographical indications, does not require that the geographical indication has in fact been used to indicate the geographical origin of goods or services. It suffices if a not negligible part of the relevant sectors of the public in Germany is likely to be misled as to the true origin of the goods or services.

In order to enjoy protection against unfair or misleading use under Sections 126 et seq. of the Trade Mark Law, a geographical indication must in fact have been used in the course of trade to indicate the geographical origin of goods or services. It is irrelevant by whom and for what kinds of goods or services it has been used, as long as the use was not misleading. There is no explicit limit for non-use.

Geographical indications which have been registered as a collective mark (Sections 97 and 99 of the Trade Marks Act) have to be used in order to retain trademark protection (see Section 97, paragraph 2 in conjunction with Section 25, Section 43 paragraph 1, Section 29 paragraph 1, and Section 55 of the Trade Marks Act). Collective marks have to be used for the goods or services for which they are registered. The limit for non-use is five years (Sections 97, paragraph 2 and 100, paragraph 2 in conjunction with Section 26 of the Trade Marks Act).

32,33. Who monitors the use of geographical indications to determine if the criteria identified in the application continue to be met? If a government entity is responsible for monitoring the use of geographical indications, what are its procedures for doing so?

(a) General

Use of geographical indications is not monitored by an administrative authority. If a geographical indication has, however, been used in a misleading way, injunctive relief can be claimed by everybody who legally uses the geographical indication in question, by business persons who market goods or services of the same or similar type on the same market, by associations having as one of their purposes the repression of unfair competition, by consumer associations, and by the chambers of industry and commerce or craft chambers (Section 128, paragraph 1 of the Trade Marks Act in conjunction with Section 13, paragraph 2 of the Law Against Unfair Competition (see under question 4 above).

If a geographical indication has been registered as a collective mark, the proprietor himself, i.e. the association (see under questions 17-27 above), is responsible for monitoring the use of the collective mark. If the proprietor does not take reasonable steps to prevent the collective mark from being wrongfully used in a manner incompatible with the purpose of the association or the regulations governing use of the mark, everybody may request the German Patent Office to cancel the registration (see Section 105, paragraph 1, No. 2 of the Trade Marks Act).

(b) Geographical indications for wines

The *Länder*⁸ are responsible for monitoring compliance in the wine sector. Changes or deletions are carried out ex officio if the legal prerequisites no longer apply.

34/35. Are there means by which interested parties may request termination of a geographical indication based on non-use or failure to maintain the criteria identified in the application? Describe the procedure. Do the procedures which lead to forfeiture of a geographical indication take place ex officio or must they be based on the initiative of an entity or person.

Unfair or misleading use of a geographical indication can be enjoined, but geographical indications are not liable to "forfeiture" in German law. A geographical indication continues to exist as long as it is recognized as such in the affected trade circles in Germany.

Means by which interested parties may request termination of a geographical indication based on non-use or failure to maintain the criteria identified in the application exist only in cases where a geographical indication has been registered as a collective mark. Everybody can request the German Patent Office to cancel the mark if it has not been used within five years after registration (see Section 99, paragraph 2 in conjunction with Sections 49 and 54 of the Trade Marks Act) or if one of the additional grounds for refusal mentioned in Section 105 of the Trade Marks Act exists, including wrongful use of the collective mark (see Section 105, paragraph 1, No. 2 of the Trade Marks Act).

In case of non-use, everybody can initiate an action for cancellation at a competent court of justice (see Section 99, paragraph 2 in conjunction with Section 55 of the Trade Marks Act).

E. SCOPE OF RIGHTS AND USE

36. May anyone who meets the criteria submitted to obtain recognition of a geographical indication use that geographical indication after recognition is given or must additional criteria or procedures be followed by that party before use is permitted?

(a) General

There is no formal system or procedure for recognition of geographical indications in German law. Geographical indications may be used by everybody for goods or services fulfilling the expectations of the relevant sectors of the public in Germany as to their geographical origin and, if any, as to their quality or other properties.

Section 100 of the Trade Mark Law stipulates that the registration of a geographical indication as a collective mark does not entitle the proprietor to prohibit a third party from using such indications in the course of trade, provided such use is in accordance with the accepted principles of morality and does not contravene Section 127 of the Trade Mark Act (see under question 1 above). Any person whose goods or services originate in the geographical area concerned and fulfil the conditions for use set out in the regulations is entitled to become a member of the association owning

⁸ See footnote 4 above.

the collective mark and to be admitted to the group of persons who have authority to use the mark (Section 103, paragraph 3 of the Trade Marks Act).

(b) Geographical indications for wine

In the wine sector too, a geographical indication may, in principle, be used without meeting further criteria after it has been defined by the State. Only indications for quality wines *psr* may only be used after the assignment of an inspection number within the framework of an official organoleptic examination.

(c) Geographical indications for spirits

Following recognition in a legal text, anybody fulfilling the criteria may use the geographical description in question. The authorities carry out spot checks for surveillance.

37. *Who makes the determination regarding use of a geographical indication by particular parties, the entity responsible for the recognition or the entity that obtained the recognition.*

Since there is no formal system or procedure for recognition of geographical indications in German law, no governmental entities or agencies are involved. In cases of conflict, a court will decide whether a geographical indication has, in an individual case, been used in a misleading or unfair manner.

If the geographical indication has been registered as a collective mark, everybody may file a request for cancellation with the Patent Office if the proprietor of the collective mark does not take reasonable steps to prevent the collective mark being wrongfully used in a manner incompatible with the purpose of the association or the regulations governing use of the mark (Section 105, paragraph 1, No. 2 of the Trade Marks Act).

38. *Are there fees involved in receiving authorization to use a particular geographical indication and, if so, what are those fees and how are they established.*

Authorization is no prerequisite for the use of a geographical indication. Geographical indications may be used by everybody for goods or services fulfilling the expectations of the relevant sectors of the public in Germany as to their geographical origin and, if any, as to their quality or other properties.

The fee for filing a collective mark covering three classes of goods or services is DM 1,500, plus DM 250 for every additional class of goods or services.

39. *If there is a dispute regarding use of a geographical indication by a particular party, what procedures are followed to resolve it?*

(a) General

In cases of dispute regarding use of a geographical indication, violations of the prohibitions against unfair or misleading use of geographical indications (Section 126 *et seq.* of the Trade Mark Law, Section 3 of the Law Against Unfair Competition (see under question 1 above)) can be enjoined by a court of justice following an ordinary court procedure or by way of a provisional disposition. The claim for injunctive relief (see under question 4 above) cannot only be asserted by everybody who legally uses the geographical indication in question, but also by businessmen who market goods or services of the same or similar type on the same market, by associations having as one of their purposes the repression of unfair competition, by consumer associations, and by the chambers of

industry and commerce or craft chambers (Section 128, paragraph 1 of the Trade Marks Act and Section 13, paragraph 2 of the Law Against Unfair Competition).

If a geographical indication has been registered as a collective mark, the proprietor (i.e. the association (see under question 17-27 above)) is entitled to bring an action for infringement and to claim damages. Persons who have authority to use the collective mark may bring such an action only with the consent of the proprietor (Section 101 of the Trade Marks Act).

(b) Geographical indications for wine

The use of inadmissible geographical indications for wine must be prosecuted ex officio by the responsible administrative authorities of the *Länder*⁹ (surveillance authorities) as well as by the prosecuting authorities. Such use entails a ban on importation and can lead to the seizure of products thus indicated by the customs authorities.

40/41. Must individual authorized users of a geographical indication use that geographical indication continually to retain their right to use it and, if so, how is their use determined and how long will disuse be permitted? If there is a dispute over continuity of use by a particular party, how is it resolved?

Protection of geographical indications against unfair and misleading use under Sections 126 *et seq.* of the Trade Mark Law and Section 3 of the Law Against Unfair Competition does not require use.

Geographical indications which have been registered as a collective mark (Sections 97 and 99 of the Trade Marks Act) have to be used in order to retain protection (see Section 97, paragraph 2 in conjunction with Section 25, Section 43 paragraph 1, Section 29 paragraph 1, and Section 55 of the Trade Marks Act). Collective marks have to be used for the goods or services for which they have been registered. Authorized use by one person or undertaking is sufficient. The limit for non-use is five years (Sections 97, paragraph 2 and 100, paragraph 2 in conjunction with Section 26 of the Trade Marks Act). If the collective mark has not been used within five years after registration, anybody may request the German Patent Office to cancel the collective mark (see Section 99, paragraph 2 in conjunction with Sections 49 and 54 of the Trade Marks Act), or initiate an action for cancellation at a competent court of justice (see Section 99, paragraph 2 in conjunction with Section 55 of the Trade Marks Act).

42. Does the regime for protection of geographical indications allow geographical indications to be licenced and, if so, what conditions are imposed on such licences? If such conditions are not met, what is the effect on the geographical indication?

Geographical indications as such cannot be licensed. They may be used by everybody for goods or services fulfilling the expectations of the relevant sectors of the public in Germany as to their geographical origin and, if any, as to their quality or other properties.

Collective marks can be licensed (see Section 97, paragraph 2 in conjunction with Section 30 of the Trade Marks Act), if this is authorized by the regulations governing their use (Section 102, paragraph 2, No. 4 of the Trade Marks Act). The licensee has to abide by any conditions of use specified in the regulations (Section 102, paragraph 2, No. 5 of the Trade Marks Act). If the collective mark is wrongfully used by the licensee in a manner incompatible with the purpose of the association or the regulations governing use of the mark and the proprietor does not take reasonable

⁹ See footnote 4 above.

steps to prevent such use, everybody may request the German Patent Office to cancel the registration (see Section 105, paragraph 1, No. 2 of the Trade Marks Act).

43. *How is "grandfathered use" of a geographical indication, under Article 24.4 of the TRIPS Agreement, applied in your country?*

Through an acquired rights regulation such as for Schwarzwälder Kirschwasser. Firms situated outside of the Black Forest which had already marketed their products under the name "Schwarzwälder Kirschwasser" before 1963 may continue to do so.

F. RELATIONSHIP TO TRADEMARKS

44-46. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.1 of the TRIPS Agreement are not nullified and impaired? What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.2 and 16.3 of the TRIPS Agreement are not nullified and impaired? What procedures are foreseen in case of conflict of a geographical indication with a trade mark?*

The rights of owners of registered trademarks are not unduly affected by the protection of geographical indications. Conflicts are resolved with regard to the priority of the rights in conflict. Protection of geographical indications under Section 126 *et seq.* of the Trade Marks Act begins when they are used for the first time to designate the geographical origin of goods or services. The proprietor of an earlier trademark can enjoin third parties from using an identical or similar sign (including geographical indications) where such use would result in a likelihood of confusion (Section 14, paragraph 2, No. 1 and 2, and paragraph 5 of the Trade Marks Act). If the mark has a reputation in Germany, the owner can enjoin use of an identical or similar sign (including geographical indications), if such use takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark (Section 14, paragraph 2, No. 3, and paragraph 5 of the Trade Marks Act).

It should be noted, however, that trademarks may not be used in a way that is liable to mislead the public in Germany as to the geographical origin of the goods or services to which they apply (Section 3 of the Law Against Unfair Competition). In addition to that, everybody can request the German Patent Office to cancel the registration of a trademark or initiate an action for cancellation with a civil court if this trademark, in consequence of the use made of it by the proprietor or with his consent, is liable to mislead the public in Germany as to the geographical origin of the goods or services for which it has been registered (Section 49, paragraph 2, No. 2, Section 53 and Section 55 of the Trade Marks Act).

G. ENFORCEMENT

47/48. *How are rights in the geographical indications enforced? Are provisions available under unfair competition law? Trade Mark Law? Other laws? Who has the right to enforce a geographical indication?*

Injunctive relief is provided for violations of the prohibitions against unfair or misleading use of geographical indications (Section 126 *et seq.* of the Trade Marks Act, Section 3 of the Act Against Unfair Competition (see under question 1 above)). This claim for injunctive relief cannot only be asserted by everybody who legally uses the geographical indication in question, but also by businessmen who market goods or services of the same or similar type on the same market, by associations having as one of their purposes the repression of unfair competition, by consumer associations, and by the chambers of industry and commerce or craft chambers (Section 128, paragraph 1 of the Trade Marks Act and Section 13, paragraph 2 of the Act Against Unfair Competition). In addition to that, everybody who legally uses the geographical indication in question

can claim compensation for damages resulting from wilful or negligent breaches of Section 127 of the Trade Marks Act (Section 126, paragraph 2 of the Trade Marks Act).

If a geographical indication has been protected as a collective mark, injunctive relief and compensation for damages can be afforded in accordance with Section 97, paragraph 2 and Section 14 of the Trade Marks Act. These claims can be enforced by the proprietor of the collective mark (i.e. the association (see under questions 17-27 above)). Persons who have authority to use the collective mark may bring an action only with the consent of the proprietor (Section 101 of the Trade Marks Act).

Goods which unlawfully bear a geographical indication are, on import, export or in transit ex officio subject to seizure by the customs authorities for the purpose of removing the unlawful marking where the infringement is obvious (Section 151 of the Trade Marks Act).

49. *What judicial or administrative bodies have jurisdiction over enforcement actions related to geographical indications? Are there fees involved and, if so, what are those fees?*

(a) General

The civil chambers of the Regional Courts (*Landgericht*) have exclusive jurisdiction for litigation regarding geographical indications, regardless of the value in dispute (Section 140, paragraph 1 of the Trade Marks Act). The *Länder* Governments¹⁰ are empowered to concentrate such litigation with one regional court by means of a legal ordinance (Section 140, subsection 2 of the Trade Marks Act). Most of the *Länder* have done this.

Court costs, also including those of the taking of evidence, are determined in civil proceedings in accordance with the value in dispute, and are laid down by law in the Court Costs Act (GKG). This applies on principle also to lawyers' fees which - depending on the value in dispute - are regulated by the Federal Code of Lawyers' Fees. The parties may agree in writing on higher lawyers' fees. The court can order, in response to an application, that the fees are only to be calculated in accordance with a part of the value in dispute, if a party makes a plausible case that the burden of the costs of the proceedings would pose a considerable danger to their economic position were they to be calculated in accordance with the full value in dispute (Section 142 of the Trade Marks Act).

The losing party bears the costs of the winning party (Section 91 of the Code of Civil Procedure). This includes lawyers' fees up to the level laid down by law in the Federal Code of Lawyers' Fees. If only partial success is achieved in the proceedings, all of the costs of the proceedings (including the necessary lawyers' fees incurred by both parties) are divided between the parties (Section 92 of the Code of Civil Procedure).

For details of the procedure, see the replies to the Checklist of Issues on Enforcement (IP/N/6/DEU/1).

(b) Geographical indications for wine

In the wine sector, under Section 31, paragraph 1 of the Wine Act, only the officials of the competent surveillance authorities, including the wine inspectors, are charged with enforcing the applicable provisions; in case of imminent danger, also all other police officers.

¹⁰ See footnote 4 above.

50. *Must the public be notified of the existence of a geographical indication and, if so, how and how often?*

(a) General

There is no formal notification requirement.

(b) Geographical indications for wine

Acts and ordinances are published in the respective law gazettes of the Federal Government and the *Länder*¹¹, the names of sites and areas are notified in the official publications of the *Länder* (official gazette). Furthermore, all indications of geographical origin of German wine are published in the Federal Law Gazette published by the Federal Ministry of Justice.

51. *Is unauthorized use of a geographical indication subject to criminal action and, if so, describe the procedures.*

(a) General

Yes, see Section 144 of the Trade Marks Act.

In principle, the public prosecution offices and the authorities and officers of the police service are obligated to prosecute criminal offences ex officio (Sections 152, 158 paragraph 1, 160 and 163 of the Code of Criminal Procedure). Violations of geographical indications which constitute criminal offences are, however, prosecuted only upon request, unless the prosecution authorities deem that ex officio prosecution is justified in view of the particular public interest (Sections 376 and 374 of the Code of Criminal Procedure). Section 374 of the Code of Criminal Procedure provides that acts which constitute offences in accordance with Section 144, paragraphs 1 and 2 of the Trade Marks Act may be prosecuted by a private action without the prosecution authorities having to intervene. If the prosecution authorities file a public action because of a particular public interest, Section 395, paragraph 2, No. 3 of the Code of Criminal Procedure affords the injured party the opportunity to join the proceedings as a joint plaintiff.

(b) Geographical indications for wines

In the wine sector, anybody who markets, imports, exports or advertises a product with misleading designations, indications or any other information or presentations is liable to a term of imprisonment not exceeding one year or to a fine under Section 49, No. 4 of the Wine Act.

Under Section 40 of the Wine Act, an administrative offence is committed by anybody negligently perpetrating the above-mentioned actions. The administrative offence can be punished with a fine of up to DM 50,000.

H. INTERNATIONAL AGREEMENTS

52. *Is your government party to an international, including bilateral or plurilateral, agreement for the notification and/or registration of geographical indications? If so, please name the international agreement and explain the relationship between it and your national legislation.*

¹¹ See footnote 4 above.

EC Regulation No. 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ No. L 208, 24 July 1992, p. 1) is directly applicable in Germany.

Germany has entered into the following bilateral agreements on the protection of geographical indications which through ratification have become applicable as German law (see reference in IP/N/4/DEU/2 and IP/N/4/DUE/2/Corr.1):

- Agreement between the Federal Republic of Germany and the French Republic on the Protection of Indications of Source, Appellations of Origin and Other Geographical Denominations of 8 March 1960 (BGBl. 1961 II, p. 482) with amendments of 23 April 1969 (BGBl. 1969 II, p. 856, 2064);
- Agreement between the Federal Republic of Germany and the Italian Republic on the Protection of Indications of Source, Appellations of Origin and Other Geographical Denominations of 23 July 1963 (BGBl. 1965 II, p. 156, BGBl. 1967 p. 1815);
- Agreement between the Federal Republic of Germany and the Kingdom of Greece on the Protection of Indications of Source, Appellations of Origin and Other Geographical Denominations of 16 April 1960 (BGBl. 1965 II, p. 176, BGBl. 1967 p. 1944) with amendments of 23 April 1969 (BGBl. 1969 II, 854) and of 24 May 1972 (BGBl. 1972 II, 564);
- Treaty between the Swiss Confederation and the Federal Republic of Germany on the Protection of Indications of Source and Other Geographical Denominations of 7 March 1967 (BGBl. 1969 II. p. 138);
- Treaty between the Federal Republic of Germany and the Spanish State on the Protection of Indications of Source, Appellations of Origin and Other Geographical Denominations of 11 September 1970 (BGBl. 1972 II, p. 109, BGBl. 1973, p. 1305) with amendments of 10 October 1994 (BGBl. 1994 II, p. 3534, BGBl. 1995 II, p. 492).

Germany is also a member of the International Wine and Vine Office (OIV), which provides for a separate registration system for the recognition of indications or designations of geographical origin for wine products including wine spirits.

53. *What other international agreements, if any, have been entered into? What do these agreements provide?*

Germany is a party to the following multilateral agreements relevant to the protection of geographical indications:

- Paris Convention for the Protection of Industrial Property (1967) (see Articles 10 *et seq.*);
- Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods (1967).

II. RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13/ADD.1

A. GENERAL (SECTION A OF DOCUMENT IP/C/13)

1. *Does your economy's Industrial Property Law and/or related law prevent the use of geographical indications identifying wines or spirits against products not originating in the place indicated by the geographical indication, 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" or the like?*

(a) Geographical Indications for Wines

Under Article 72(a) of Regulation (EEC) 823/87, Member States have to adopt suitable measures to enable the persons concerned, pursuant to the provisions of Articles 23 and 24 of the Agreement on Trade-Related Aspects of Intellectual Property Rights, to prevent in the Community the use of geographical indications for products whose origin does not correspond to the place specified in the geographical indication, even if the actual origin is indicated or if the geographical indication is used in a translation or together with expressions like "method", "type", "style", "imitation".

According to Section 3 of the Act Against Unfair Competitions (*Gesetz gegen den unlauteren Wettbewerb*), the persons concerned may claim injunctive relief under civil law.

Furthermore, the *Land*¹² authorities in charge of the controls, including wine inspectors, may prohibit the placing on the market as well as imports and exports of products for which misleading indications, designations, other information or presentations are used and may withdraw these products from the market. Misleading also means presentations, designs or correct information which could raise false expectations regarding the geographical origin of the products. This rule also applies if the producer country has been duly indicated (Section 25, paragraphs 1 and 3 of the Wine Act). Such a violation can also be prosecuted under criminal law (Section 48, No. 4 of the Wine Act).

(b) Geographical Indications for Spirits

Under the Act on Foods and Commodities (Article 17) as well as under the Act Against Unfair Competition (Article 3), imposing a general ban on the misrepresentation and deception of consumers, it is in any case inadmissible to place a spirit drink on the market under a protected geographical indication, unless it comes from this geographical region. Neither would the use of indications such as, for example "according to type", "similar" etc. render it admissible. It should be pointed out in the context that the use of such "indications of similarity" is expressly prohibited under Article 8 of the EC Regulation on spirit drinks, No. 1576/89, already in the case of protected generic designations such as whisky, for example. It would *all the more* be inadmissible for protected geographical indications, which are to be protected more strongly than generic designations (so-called "all the more" conclusion).

To sum up, it may be said that in the spirit drinks sector the civil persons concerned (competitors, consumer or producer protection associations) can take action against the inadmissible use of geographical indications by a judicial injunction under Article 3 of the Act Against Unfair Competition, or alternatively the responsible food control authorities, can resort to official enforcement under Article 17 of the Act on Foods and Commodities.

¹² See footnote 4 above.

B. DEFINITION AND CRITERIA FOR RECOGNITION (SECTION B OF DOCUMENT IP/C/13)

2. *Is there a clear distinction among the terms "geographical indications", "appellations of origin" and "indications of source" in your economy's Industrial Property Law and/or related law, or are there any substantive criteria to distinguish these terms?*

(a) Geographical Indications for Wines

EC wine legislation and the German Wine Act use different legal terms for geographical indications or the indication or origin of products without any factual differences in principle. Neither EC wine legislation nor the national wine law contain the term "designation of origin".

Name of a geographical unit (Article 2, paragraph 3(a); Article 4, paragraph 1; Article 11, paragraph 2(1); Article 13, paragraph 1; Article 20, paragraph 3(a); Article 23, paragraph 1 of Regulation (EEC) No. 2392). The statutory list defines this as the name of a specified region, a region which is not a specified one (wine-growing area or area cultivating *vin de pays* (*Landwein*), a subregion or part of a subregion, a community or part thereof, a vineyard site or a unit comprising several vineyard sites (collective site or area).

Geographical indication (Title of Section 23 of the Wine Act). The catalogue of admissible geographical indications under the Wine Act includes the following: the name of the specified wine-growing area, names of vineyard sites and areas registered in the vineyard register, names of communities and parts thereof, names of areas cultivating *vin de pays* (*Landwein*), names of areas, names of wine-growing areas and subregions.

This catalogue basically matches that containing the names of geographical units of EC legislation, but makes their use conditional on specific prerequisites or restricts their use.

Geographical description (Article 26, subparagraph 1(a); paragraph 2(b); Article 29 of Regulation (EEC) No. 2392/98; heading of Section 39 (Wine Ordinance). This term is also identical with the term "geographical indication".

Indication of origin/origin indication (Section 23(1) of the Wine Act; Section 39(5) of the Wine Ordinance; and the heading of Section 40 of the Wine Ordinance). These terms are identical with the term "geographical indication".

(b) Geographical Indications for Spirits

The EC Law on spirit drinks does not differentiate between a "geographical indication", a "designation of origin" or an "indication of origin". Instead, it uses in Article 5, paragraph 3 of Regulation (EEC) No. 1576/89 in conjunction with Annex II to this Regulation the term "geographical indication". The definition of a geographical indication in Article 5, paragraph 3(b) of Regulation (EEC) No. 1576/89, according to which the production stage, in which the spirit drink with a geographical indication obtains its character and its final properties, comprises substantively - according to the product and the respective traditional production - apart from indications of geographical origin also the "stricter" case of a geographical designation of origin as defined in French law, for example.

The EC Law on spirit drinks knows, apart from the "geographical indications" as defined in Article 5, paragraph 3 of the Regulation (EEC) No. 1576/89, also so-called "reserved designations" (see Article 12, paragraph 2 of Regulation (EEC) No. 1576/89). These are designations such as *Korn*, *Kornbrand*, *Grappa*, *Ouzo*, *Pacharan* and *Jagatee*, the use of which in the sense of traditional indications of geographical origin related to (language areas) was exclusively reserved to specific

Member States or regions. As can be gathered from the respective definitions in Article 1, paragraph 4 of Regulation (EEC) No. 1576/89, all production stages have to take place in the respective reserved area in the case of these so-called "reserved designations" - in contrast to "geographical indications" as defined in Article 5, paragraph 3 of Regulation (EEC) No. 1576/89.

3. *Does your legislation contain criteria for homonymous geographical indications for wines and spirits?*

(a) Geographical Indications for Wines

Under Article 15, paragraph 4 of Regulation (EEC) 823/87, the name of a specified wine-growing area or a community or of a part thereof assigned in line with Community or national regulations may not be used by others to designate products of the wine sector.

Article 39, paragraph 1 of the Wine Ordinance stipulates the following:

If the name

- (1) of an area is used to designate a quality wine psr, it should be preceded by the indication "area" in characters of the same type, size and colour, if it is identical or could be confused with any other geographical indication;
- (2) of a site is used to designate a quality wine psr, the names of the community or part thereof should be added.

(b) Geographical Indications for Spirits

There is no special regulation governing the use of possible homonymous geographical indications in the spirit drinks sector.

C. RELATIONSHIP TO TRADEMARKS (SECTION F OF DOCUMENT IP/C/13)

4. *Does your economy's Industrial Property Law and/or related law provide the refusal or invalidation of a trade mark registration, which consists of or contains geographical indications identifying wines or spirits with respect to such wines or spirits not originating in the indicated territory?*

It can be referred to paragraph 2 of the answer to question under I above.

Responses from Italy

I. RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13

A. GENERAL

1. *Is protection for geographical indications provided through unfair competition law, e.g., passing off, false designation of origin; through a formal procedure for notification/registration before protection is available; or through both? Does the recognition of a geographical indication require registration?*

On a general basis, our legislation envisages the protection of geographical indications through notification and registration.

2. *Is there one single regime of protection of geographical indications for all products? If not, identify the different regimes.*

Negative answer. There are different regimes: for wines, we signal Law 164 of 10 February 1992 in application of EEC Regulation 823/87, published in the Official Journal of 26 February 1992; for alcoholic drinks, we signal the Decree of the President of the Italian Republic of 16 July 1997, No. 297, in application of EEC Regulation No. 1576/89; for agro-food, the reference is to Article 2 of EEC Regulation No. 2081/92 with sectoral provisions of procedural origin.

3. *Do(es) the regime(s) of protection of geographical indications also extend to services?*

The protection for wines concerns also distribution and marketing phases.

4. *What provisions of law or regulations are directed to the recognition of geographical indications required by Articles 22.2 and 23.1 of the TRIPS Agreement? Citations to laws should be provided and, if the texts of the laws have not been notified to the WTO, copies should be provided pursuant to Article 63.2.*

In order to recognize the geographical indications, usually application provisions are applied for the protection indicated in Article 22.2, even the provisions existing before the Community Regulation for the different sectors (i.e. the Law of 5 February 1992, No. 169 concerning the controlled designation of origin of olive oils); in accordance with Article 23.1, the provisions of the Law of 10 February 1992, No. 164 are applied for wines, while the provisions of the Presidential Decree, No. 297 of 16 July 1997, are applied for alcoholic drinks.

5. *If the required recognition of geographical indications is not provided through statutes or regulations, please explain, in detail, the mechanism or mechanisms through which the protection required is provided.*

The recognition is possible exclusively through specific regulations.

6. *Please provide a few examples of domestic geographical indications protected in accordance with the means discussed above and indicate the means by which such protection is provided.*

Ministerial Decree of 18 May 1998 concerning the recognition of wine DOC "Molise" in accordance with Law 164/92; Ministerial Decree of 4 July 1997 concerning the recognition of DOC oil from Tuscany in accordance with Law 169/92.

7. *Is the higher level of protection required for wines and spirits under Article 23.2 of the TRIPS Agreement provided for any other product? If so, please specify such products and the law under which they are protected.*

Positive answer, it applies to all agro-food products registered in accordance with Regulation (EEC) No. 2081/92.

B. DEFINITION AND CRITERIA FOR RECOGNITION

8. *How are geographical indications defined?*

Geographical indications are those which identify a product as originating from the national territory or from a region or a determined place of such territory when a certain quality, fame or other characteristics of the product can be essentially attributed to its geographical origin; for the different sectors, we use the Community definitions contained in Regulations on wines, alcoholic drinks, flavoured wines and agricultural and agro-food productions.

9. *Would such a definition comprise geographical indications identifying products of a certain quality or reputation which are indirectly linked to a specific region?*

No. The quality or reputation must be directly linked with geographical origin.

10. *In determining whether recognition should be given a geographical indication, what criteria are considered?*

For the wine sector, we apply Community provisions indicated in (EEC) Regulation No. 822/87 and at national level the provisions indicated in Law 164/92; for alcoholic drinks, we apply the provisions of (EEC) Regulation No. 1576/89; for flavoured wines, we apply the provisions of (EEC) Regulation No. 1601/91; the agro-food sector follows (EEC) Regulation No. 2081/92.

11. *Is there any human creativity involved in the making of specific products under protection by the system of geographical indications? If so, how much? And do these products involve any human factors?*

Positive answer for both questions; in fact, as for wines and agro-food products, protection depends also on human factors linked to the preparation of products.

12. *Are there any other intellectual property rights involved, such as patents for example?*

Negative answer.

13. *What authority, if any, may define the geographic region or area for which rights are claimed and on what basis is such definition made?*

The definition is indicated in the production criteria approved by the competent public authority.

14. *Does your legislation contain criteria for homonymous geographical indications for wines?*

Positive answer. Article 24, subparagraph 4bis of Law 164/92, as modified by the Legislative Decree of 19 March 1996, No. 198.

15. *Does your national legislation provide for recognition and protection of geographical indications or appellations of origin of foreign countries?*

Only in case of bilateral agreements. In all other cases, the national legislation is adapted to Community rules. We signal for the wine sector a determined agreement with the Swiss Government; for the dairy products sector, we refer to the multilateral agreement of Stresa, which implies also third countries.

16. *Is there any specific prohibition in the legislation/regulations/rules/procedures covering geographical indications not protected in the country of origin? If so, please specify the relevant statutory provision.*

There are not any specific provisions, also on the basis of the Community Regulation of the sector.

C. RECOGNITION PROCEDURES

17. *With respect to any formal system for recognition of geographical indications, must the applicant be a governmental organization or can a private entity own the rights to a geographical indication?*

The activation of the formal recognition system can be subject to public or private initiatives.

18. *What are the competent authorities where the protection of a geographical indication can be obtained?*

The competent authority on the basis of institutional regulation is the Ministry for Agricultural Policies, as a centre for the coordination of regional policies, also through the action of the various sector committees.

19. *Do the procedures which lead to the recognition of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

The initiative for the implementation of recognition procedures can be carried out following a public (regions) or private initiative.

20. *What, if any, fees are involved in the application and maintenance of rights in a geographical indication?*

Except the usual administration fees, there are no specific contributions linked to the right of use of a geographical indication.

21. *If criteria must be set out in an application for recognition of a geographical indication, are those criteria purely geographic in nature?*

Not exclusively. In fact, the features connected with natural environment and human factors are taken into account.

22. *What other criteria, if any, must be set out in an application for recognition of a geographical indication?*

See the answer to question 21 above.

23. *What information must be supplied in an application for rights in a geographical indication?*

Information is the one required by Law 164/92 for the wine sector; the agro-food sector is ruled by disposition of (EEC) Regulation No. 2081/92.

24. *Must the goods or services with respect to which a geographical indication is claimed be set out?*

Positive answer, according to criteria of the relative production regulations.

25. *What mechanisms are provided to oppose the recognition of a geographical indication? How is an investigation conducted after such a complaint?*

Opposition mechanisms are indicated for the wine sector by Law No. 164/92, while for the agro-food sector they are indicated by Article 7 of (EEC) Regulation No. 2081/92.

26. *Who can oppose the recognition of a geographical indication?*

For the wine sector, according to Law No. 184/92, anybody can oppose the procedure,. However, the competent public authority and the sector committee have to verify. For the agro-food sector, Article 7 of (EEC) Regulation No. 2081/92 points out who can oppose the recognition of a geographical indication.

27. *If your national legislation provides for recognition and protection of geographical indications or appellations of origin of foreign countries, what is the procedure that has to be followed in order to obtain such recognition and consequent protection?*

Protection is applied in accordance with the obligations under the TRIPS Agreement.

D. MAINTENANCE

28. *How long does recognition for a geographical indication continue?*

Without prejudice to the verification of the persistence of requirement, there are no limits of time.

29. *If recognition of a geographical indication must be renewed or reaffirmed, what information must be provided in order to effect such a renewal or reaffirmation? Specify any fees involved in renewal or reaffirmation.*

Negative answer. There are no renewal procedures for a geographical indication.

30. *Must a geographical indication be used in order to maintain rights? If so, how is such use determined?*

In general for the wine sector identification is annulled when the rights are not activated in the time foreseen by the national legislation. (Article 9 of Law 164/92).

31. *Is there a specified limit for non-use before rights in a geographical indication cease and, if so, what is that limit?*

For the wine sector, limits for non-use are indicated in Article 9 of Law 164/92.

32. *Who monitors the use of geographical indications to determine if the criteria identified in the application continue to be met?*

Authorities of the central and peripheral public administration together with sector committees and the consortiums which have the task of monitoring in the sectors of their competence.

33. *If a government entity is responsible for monitoring the use of geographical indications, what are its procedures for doing so?*

For the wine sector, procedures and forms are indicated in Law 164/92.

34. *Are there means by which interested parties may request termination of a geographical indication based on non-use or failure to maintain the criteria identified in the application? Describe the procedure.*

Law 164/92 provides for the wine sector, while (EEC) Regulation No. 2081/92, Article 11 provides for the agro-food sector.

35. *Do the procedures which lead to forfeiture of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

For the wine sector, the relative provisions are indicated by Law 164/92, Chapter II; for the agro-food sector, it is necessary to prove the forfeiture of requirements occurring after the Community registration, according to (EEC) Regulation No. 2081/92.

E. SCOPE OF RIGHTS AND USE

36. *May anyone who meets the criteria submitted to obtain recognition of a geographical indication use that geographical indication after recognition is given or must additional criteria or procedures be followed by that party before use is permitted?*

Yes, but the relative production criteria must be observed.

37. *Who makes the determination regarding use of a geographical indication by particular parties, the entity responsible for the recognition or the entity that obtained the recognition?*

There are no particular parties. However, the entity responsible for the recognition is competent in this sector.

38. *Are there fees involved in receiving authorization to use a particular geographical indication and, if so, what are those fees and how are they established?*

We confirm that, according to the national legislation, the authorization to use a geographical indication is not submitted to the payment of particular fees.

39. *If there is a dispute regarding use of a geographical indication by a particular party, what procedures are followed to resolve it?*

The relative procedures are foreseen by Law 164/92 for the wine sector, and by (EEC) Regulation No. 2081/92 for the agro-food sector.

40. *Must individual authorized users of a geographical indication use that geographical indication continually to retain their right to use it and, if so, how is their use determined and how long will disuse be permitted?*

We point out that in the wine sector time-limits of non-use of the denomination are fixed.

41. *If there is a dispute over continuity of use by a particular party, how is it resolved?*

The normal legal objection ways are used.

42. *Does the regime for protection of geographical indications allow geographical indications to be licensed and, if so, what conditions are imposed on such licenses? If such conditions are not met, what is the effect on the geographical indication?*

Negative answer.

43. *How is "grandfathered use" of a geographical indication, under Article 24.4 of the TRIPS Agreement, applied in your country?*

On the basis of the Community provisions in this matter.

F. RELATIONSHIP TO TRADE MARKS

44. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.1 of the TRIPS Agreement are not nullified and impaired?*

We refer to the Community Regulations on this matter.

45. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.2 and 16.3 of the TRIPS Agreement are not nullified and impaired?*

We refer to the Community Regulations on this matter. In any case, trade marks formed by false geographical indication are nullified.

46. *What procedures are foreseen in case of a conflict of a geographical indication with a trademark?*

We refer to the Community regulations on this matter, in particular for the agro-food sector to Article 13 of (EEC) Regulation No. 2081/92.

G. ENFORCEMENT

47. *How are rights in the geographical indication enforced? Are provisions available under unfair competition law? Trademark law? Other laws? Provide citations to the laws and, if they have not been notified under Article 63.2 of the TRIPS Agreement, please provide copies.*

Law 164/92 and the other national legislation provide for regulations of sanctions character (Cf. Cap. X of Law 164/92).

48. *Who has the right to enforce a geographical indication?*

The competent public administrations together with the producers associations (protection consortiums).

49. *What judicial or administrative bodies have jurisdiction over enforcement actions related to geographical indications? Are there fees involved and, if so, what are those fees?*

Administrative courts and ordinary courts. Specific fees are not foreseen, but only the normal court costs.

50. *Must the public be notified of the existence of a geographical indication and, if so, how and how often?*

Positive answer. It is made through publication in the Official Journals of the member State.

51. *Is unauthorized use of a geographical indication subject to criminal action and, if so, describe the procedures. If the law has not been notified pursuant to Article 63.2 of the TRIPS Agreement, please provide a copy.*

We refer to the sanctions system foreseen for the wine sector, by Law 164/92.

H. INTERNATIONAL AGREEMENTS

52. *Is your government party to an international, including bilateral or plurilateral, agreement for the notification and/or registration of geographical indications? If so, please name the international agreement and explain the relationship between it and your national legislation.*

As we have already pointed out, in the wine sector is in force the bilateral agreement with Switzerland, while for the dairy sector there is the multilateral agreement of Stresa, which was signed also by third countries.

53. *What other international agreements, if any, have been entered into? What do those agreements provide?*

Negative answer.

II. RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13/ADD.1

A. GENERAL (SECTION A OF DOCUMENT IP/C/13)

1. *Does your economy's industrial property law and/or related law prevent the use of geographical indications identifying wines or spirits against products not originating in the place indicated by the geographical indication, 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" or the like?*

The National Law, No. 164 of 10 February 1992, for wines contains a clear distinction between the terms "geographical indication" and "denomination of origin". For other products of the agricultural and agro-food sector, please see the distinctions indicated in EEC Regulation No. 2081/92.

B. DEFINITION AND CRITERIA FOR RECOGNITION (SECTION B OF DOCUMENT IP/C/13)

2. *Is there a clear distinction among the terms "geographical indications", "appellations of origin" and "indications of source" in your economy's industrial property law and/or related law, or are there any substantive criteria to distinguish these terms?*

Positive answer. The national law which prevents the use of geographical indications for the products which do not come from the indicated place is Law No. 164 of 10 February 1992, Article 28.

3. *Does your legislation contain criteria for homonymous geographical indications for wines and spirits?*

Positive answer. The rule foresees the refusal or invalidity of the registration of a trademark containing or constituted by geographical indications which identify products that do not come from the indicated territory. This rule is contained in Law No. 164 of 10 February 1992, Article 24.

C. RELATIONSHIP TO TRADEMARKS (SECTION F OF DOCUMENT IP/C/13)

4. *Does your economy's industrial property law and/or related law provide the refusal or invalidation of a trademark registration, which consists of or contains geographical indications identifying wines or spirits with respect to such wines or spirits not originating in the indicated territory?*

Positive answer. The rule which indicates the criteria for the use of geographical indications, through the appropriate differences, is contained in Law No. 164 of 10 February 1992, Article 24, subparagraph 4*bis*.

Responses from the Netherlands

RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13

INTRODUCTORY REMARK

In the Netherlands, the Agricultural Produce Decree (*Landbouwkwaliteitsbesluit geografische aanduidingen, oorsprongsbenamingen en specificiteitscertificering*, hereafter referred to as "LGAOS") is the only regulation that explicitly covers geographical indications. Other regulations refer in more general terms to designations of origin. Since these also include geographical indications, these other regulations will be considered as well. The latter category, however, does not always link a product's origin with quality, reputation or another essential characteristic.

That is why we have considered the regulations referring to these general designations of origin only in the answers to the questions under A. In other sections, these regulations have not been considered, unless this is specifically mentioned.

LGAOS is a national decree adopted to implement Council Regulation 2081/92 (EEC), that aims to protect geographical indications and designations of origin. Since EU Regulations also apply under Dutch law, reference is made to Regulation 2081/92 in the answers.

A. GENERAL

1. *Is protection for geographical indications provided through unfair competition law, e.g., passing off, false designation of origin; through a formal procedure for notification/registration before protection is available; or through both? Does the recognition of a geographical indication require registration?*

Various national rules provide for the protection of geographical indications and designations of origin:

- (1) The Civil Code (*Burgerlijk Wetboek*) protects against wrongful use of geographical indications by means of provisions regarding misleading advertisements. Misleading claims regarding the origin of products or services provided commercially constitute tort (Civil Code, Section 6:194). The civil court can impose compensations or injunctions. No further requirements to ensure protection against misleading claims are defined.
- (2) The Commodities Act (*Warenwet*) has a general provision that prohibits advertising for a commodity in the pursuance of a profession or trade in a way that is in violation of the provisions on the designation of the commodity's origin (Commodities Act, Section 20, paragraph 1, concerning section 8, under c). Under a decree on the labelling of foodstuffs (*Warenwetbesluit etikettering van levensmiddelen*), pre-packaged food and drinks must indicate the place of origin or provenance to prevent buyers of the product from being misled as to the product's true origin or provenance.
- (3) The Dutch Advertising Code was drawn up by the advertising branch for self-regulation. The Code contains a general provision (Section 7) stating that advertisements may not be misleading, notably with respect to a product's origin or provenance.

- (4) The Benelux Trademark Law may provide some protection as to geographical indications that have been registered as collective brands (Section 19). The use of geographical indications in accordance with normal trade practice and in everyday language can, however, not be prevented.
- (5) In addition to the general protection as described above, there are various specific regulations that provide protection of geographical indications:
 - (a) The Agricultural Produce Decree (*Landbouwkwaliteitsbesluit geografische aanduidinge, oorsprongsbenamingen en specifiteitscertificering* (LGAOS)) was adopted to implement Council Regulation 2081/92. Only registered geographical indications and designations of origin come under this decree.
 - (b) Other agriculture quality regulations (for cheese products, for instance) and regulations adopted under the Industrial Organisation Act (the 1978 wine regulation for instance, laid down by the Central Commodity Board for Arable Products) provide for the use of geographical indications. Sometimes, this concerns the use of the *Holland kwaliteit* label. Regulations under the Industrial Organisation Act generally lay down the requirements products must meet if they wish to be provided with a certain geographical indication.

2. *Is there one single regime of protection of geographical indications for all products? If not, identify the different regimes.*

The protection provided under the Civil Code, Section 6:194, the Trademark Law and the Dutch Advertising Code applies to all commodities and services. Protection under the Commodities Act applies to all commodities. The Agricultural Produce Decree, the agriculture quality regulations and the regulations adopted under the Industrial Organisation Act only apply to agricultural produce and foodstuffs.

Geographical indications not specifically protected under LGAOS enjoy protection under the above mentioned regulations.

3. *Do(es) the regime(s) of protection of geographical indications also extend to services?*

The protection of geographical indications only extends to services in cases of misleading advertising (tort) and trademark law.

4. *What provisions of law or regulations are directed to the recognition of geographical indications required by Articles 22.2 and 23.1 of the TRIPS Agreement? Citations to laws should be provided and, if the texts of the laws have not been notified to the WTO, copies should be provided pursuant to Article 63.2.*

The Civil Code, Section 6:194, recognises the protection of geographical indications required by Article 22 of the TRIPS Agreement:

"Hij die omtrent goederen of diensten die door hem of degene ten behoeve van wie hij handelt in de uitoefening van een beroep of bedrijf worden aangeboden, een mededeling openbaar maakt of laat maken, handelt onrechtmatig, indien deze mededeling in een of meer opzichten misleidend is, zoals ten aanzien van:

(...)
de herkomst (...) van vervaardigen."

("He who, in the pursuance of a profession or trade, makes public or has made public a statement with respect to goods or services offered by him or on behalf of the person he acts for, acts wrongfully if this statement is misleading in one or more ways, with respect to, for instance,
(...)
the origin (...) of manufacture.")

Protection against unfair competition is provided for by Section 6:162 of the Civil Code:

"1. Hij die jegens een ander een onrechtmatige daad pleegt, welke hem kan worden toegerekend, is verplicht de schade die de ander dientengevolge lijdt, te vergoeden.

"2. Als onrechtmatige daad worden aangemerkt een inbreuk op een recht en een doen of nalaten in strijd met een wettelijke plicht of met hetgeen volgens ongeschreven recht in het maatschappelijk verkeer betaamt, een en ander behoudens de aanwezigheid van een rechtvaardigingsgrond.

"3. Een onrechtmatige daad kan aan de dader worden toegerekend, indien zij te wijten is aan zijn schuld of aan een oorzaak welke krachtens de wet of de in het verkeer geldende opvattingen voor zijn rekening komt."

("1. He who acts wrongfully towards another, for which action he can be held accountable, is obliged to compensate the other party for the damages suffered.

"2. A wrongful act is a breach of another's right and an act or failure to act which is in conflict with legal obligations or unwritten social mores, for which no justification exists.

"3. He who commits a wrongful act may be held accountable if the act is the result of his own shortcoming or another cause which by law or in the general social view is his responsibility.")

5. *If the required recognition of geographical indications is not provided through statutes or regulations, please explain, in detail, the mechanism or mechanisms through which the protection required is provided.*

-

6. *Please provide a few examples of domestic geographical indications protected in accordance with the means discussed above and indicate the means by which such protection is provided.*

Most complaints about geographical indications are investigated on the grounds of the Dutch Advertising Code, since filing a complaint with the Advertising Code Foundation is less of a step than filing a complaint under the Civil Code. However, the Advertising Code Foundation is only authorised to make recommendations; it has no power to impose injunctions or compensations. Most complaints pertain to the use of geographical indications such as "Made in Holland" when in actual fact the product concerned was manufactured elsewhere. Most of the remaining cases concern violations of the Benelux Trademark Law.

There are no known civil law suits regarding real geographical indications as described in Article 22 of the TRIPS Agreement.

7. *Is the higher level of protection required for wines and spirits under Article 23.2 of the TRIPS Agreement provided for any other product? If so, please specify such products and the law under which they are protected.*

Yes. Regulation 2081/92 offers such protection.

B. DEFINITION AND CRITERIA FOR RECOGNITION

8. *How are geographical indications defined?*

For a definition of geographical indications, LGAOS (the Agricultural Produce Decree) refers to the first paragraph of Article 1 of EU Regulation 2081/92. Next to geographical locations, the EU Regulation also defines designations of origin, for which more stringent requirements apply (the product has qualities or characteristics which are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors, and the production, processing and preparation of the product take place in the defined geographical area). Our answers in this document do not pertain to designations of origin.

9. *Would such a definition comprise geographical indications identifying products of a certain quality or reputation which are indirectly linked to a specific region?*

No, the definition only applies for direct indications, that is the name of a specific place, region or country.

10. *In determining whether recognition should be given a geographical indication, what criteria are considered?*

- (a) The agricultural product or foodstuff must originate from the region, specific place or, in exceptional cases, country named;
- (b) the origin of the product is connected to a particular quality, reputation or other characteristic; and
- (c) the product must be produced and/or processed and/or prepared in the defined geographical area.

11. *Is there any human creativity involved in the making of specific products under protection by the system of geographical indications? If so, how much? And do these products involve any human factors?*

No.

12. *Are there any other intellectual property rights involved, such as patents for example?*

See question 2 above (trademark law).

13. *What authority, if any, may define the geographic region or area for which rights are claimed and on what basis is such definition made?*

The party applying for the registration of a geographical indication must delineate the geographical area, in pursuance of Article 4, paragraph 2(c) of the EC Regulation. The application is

assessed by the Central Commodity Board for Arable Products (AKK) (LGAOS, sections 4 and 5, concerning section 2 of the Agricultural Produce Regulation or *Landbouwkwaliteitsregeling*).

14. *Does your legislation contain criteria for homonymous geographical indications for wines?*

The *Verordening hpa Wijn 1997* (wine regulation) laid down by the AKK implements EC Regulation 2392/89 of 24 July 1989, laying down general rules for the description and presentation of wines and grape musts, in the Netherlands.

15. *Does your national legislation provide for recognition and protection of geographical indications or appellations of origin of foreign countries?*

The Netherlands was not a party to the Madrid Agreement to combat false denominations of origin nor to the Lisbon Agreement to protect and register designations of origin. Under EC Regulation 2081/92, registered geographical indications are protected throughout the EU (Article 2). Under strict conditions, agricultural products or foodstuffs from third countries may be eligible for protection according to the EC Regulation (Article 12). General provisions protect all geographical indications regardless of origin against wrongful use (tort) and misleading advertising (see under questions 1, 2 and 4 above).

16. *Is there any specific prohibition in the legislation/regulations/rules/procedures covering geographical indications not protected in the country of origin? If so, please specify the relevant statutory provision.*

In the Netherlands, provisions regarding tort and misleading advertising (see under questions 1, 2 and 4 above) protect consumers against misleading geographical indications regardless of whether the indication is protected in the country of origin or not.

C. PROCEDURE FOR RECOGNITION

17. *With respect to any formal system for recognition of geographical indications, must the applicant be a governmental organization or can a private entity own the rights to a geographical indication?*

The rights of a registered geographical indication in pursuance of EC Regulation 2081/92 cannot be held by a natural or legal person. Normally, a group of producers or manufacturers of a product or foodstuff, and in exceptional cases a natural or legal person, may apply for the registration of a geographical indication (Article 5, paragraph 1 of EC Regulation 2081/92). Dutch natural or legal persons wishing to submit such an application must be a member of one of the four commodity boards (milk; fruit and vegetables; poultry eggs and egg products; meat products) (LGAOS, section 6). The National Inspection Service for Livestock and Meat (RVV) is the competent authority for products which do not fall in one of these four categories.

18. *What are the competent authorities where the protection of a geographical indication can be obtained?*

Applications must be submitted to the Central Commodity Board for Arable Products, which is responsible for the primary assessment. It is then passed on to the Minister of Agriculture, Nature Management and Fisheries, who must determine whether the reason for the application is justified and, if so, it is forwarded to the European Commission which completes the registration.

19. *Do the procedures which lead to the recognition of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

An application procedure is required for the recognition of a geographical indication (see also the answers to questions 17 and 18 above).

20. *What, if any, fees are involved in the application and maintenance of rights in a geographical indication?*

No fees are involved in an application or maintenance of rights in a geographical indication.

21-24. *If criteria must be set out in an application for recognition of a geographical indication, are those criteria purely geographic in nature? What other criteria, if any, must be set out in an application for recognition of a geographical indication? What information must be supplied in an application for rights in a geographical indication? Must the goods or services with respect to which a geographical indication is claimed be set out?*

For a geographical indication to be registered, a product dossier must be submitted containing at least (Article 4, paragraph 2 of EC Regulation 2081/92):

- a) the name of the agricultural product or foodstuff, including its geographical indication;
- b) a description of the agricultural product or foodstuff, including, if applicable, its ingredients and primary physical, chemical, microbiological and/or organoleptic characteristics;
- c) the delineation of the geographical area;
- d) information indicating that the agricultural product or foodstuff originates from the defined geographical area;
- e) a description of how the product was made and if applicable, of authentic, regional production methods;
- f) information proving the product's relation with the geographical area;
- g) the name of the competent authority which sees to it that an agricultural product or foodstuff meets the requirements of the product dossier;
- h) specific information regarding labels on packaging and claims such as 'protected geographical indication' or equivalent claims to tradition;
- i) if applicable, a summary of EU or national conditions which the product must comply with.

25/26. *What mechanisms are provided to oppose the recognition of a geographical indication? How is an investigation conducted after such a complaint? Who can oppose the recognition of a geographical indication?*

Any natural or legal person able to prove that he or she might be economically disadvantaged by the Commission's intended registration may file an objection within five months of publication of

the intended registration in the Official Journal of the EU. A declaration of the grounds of the objection must be sent to the Central Commodity Board for Arable Products. On the basis of this declaration, the Minister of Agriculture shall decide whether or not to object to the registration with the Commission (section 4, Agricultural Produce Regulation). The objection procedure shall be carried out in accordance with the provisions in Article 7 of the EC Regulation (Member States must reach consensus on the objection and failing this the Commission is charged with the decision.)

27. *If your national legislation provides for recognition and protection of geographical indications or appellations of origin of foreign countries, what is the procedure that has to be followed in order to obtain such recognition and consequent protection?*

The same procedure applies for geographical indications from third countries as for geographical indications from EU Member States (Article 12 of the EC Regulation).

D. MAINTENANCE

28. *How long does recognition for a geographical indication continue?*

Unlimited.

29. *If recognition of a geographical indication must be renewed or reaffirmed, what information must be provided in order to effect such a renewal or reaffirmation? Specify any fees involved in renewal or reaffirmation.*

-

30. *Must a geographical indication be used in order to maintain rights? If so, how is such use determined?*

No.

31. *Is there a specified limit for non-use before rights in a geographical indication cease and, if so, what is that limit?*

No.

32. *Who monitors the use of geographical indications to determine if the criteria identified in the application continue to be met?*

The five competent authorities named in the answer to question 17 above (LGAOS, section 7).

33. *If a government entity is responsible for monitoring the use of geographical indications, what are its procedures for doing so?*

-

34. *Are there means by which interested parties may request termination of a geographical indication based on non-use or failure to maintain the criteria identified in the application? Describe the procedure.*

No.

35. *Do the procedures which lead to forfeiture of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

-

E. SCOPE OF RIGHTS AND USE

36. *May anyone who meets the criteria submitted to obtain recognition of a geographical indication use that geographical indication after recognition is given or must additional criteria or procedures be followed by that party before use is permitted?*

A producer or manufacturer wanting to use a protected geographical indication must join one of the organisations listed in the response to question 17 above (section 6, paragraph 2 of LGAOS).

37. *Who makes the determination regarding use of a geographical indication by particular parties, the entity responsible for the recognition or the entity that obtained the recognition?*

Members of the organisations listed in the answer to question 17 are authorised to use geographical indications under the supervision of named bodies.

38. *Are there fees involved in receiving authorization to use a particular geographical indication and, if so, what are those fees and how are they established?*

No fees are involved in acquiring authorisation to use a particular geographical indication.

39. *If there is a dispute regarding use of a geographical indication by a particular party, what procedures are followed to resolve it?*

A dispute regarding the use of a geographical indication by a particular party can be resolved by filing a civil lawsuit against the allegedly unlawful user of this indication (see under question 1 above).

40. *Must individual authorized users of a geographical indication use that geographical indication continually to retain their right to use it and, if so, how is their use determined and how long will disuse be permitted?*

No.

41. *If there is a dispute over continuity of use by a particular party, how is it resolved?*

-

42. *Does the regime for protection of geographical indications allow geographical indications to be licensed and, if so, what conditions are imposed on such licenses? If such conditions are not met, what is the effect on the geographical indication?*

No. The right to use a geographical indication in pursuance of EC Regulation 2081/92 cannot be owned by a natural or legal person; thus, licences are not granted.

43. *How is "grandfathered use" of a geographical indication, under Article 24.4 of the TRIPS Agreement, applied in your country?*

An objection against an intended registration of a geographical indication (see the answers to questions 25 and 26 above) may be made on the grounds that the registration would damage an existing brand or product which has exactly or partly the same name and which was legally available on the market on 24 July 1992 (date of publication of the EC Regulation) (Article 7, paragraph 4 of the Regulation).

F. RELATIONSHIP TO TRADEMARKS

44-46. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.1 of the TRIPS Agreement are not nullified and impaired? What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.2 and 16.3 of the TRIPS Agreement are not nullified and impaired? What procedures are foreseen in case of a conflict of a geographical indication with a trademark?*

The licenceholder of an existing brand can object to an intended registration of a particular geographical indication (see the answer to question 43 above).

The registration of a brand which coincides with a particular geographical indication will be rejected, unless the registration was applied for or obtained before the publication of the registration-application of the geographical indication concerned. Brands registered in contradiction with this ruling shall be rendered null (Article 14, paragraph 1 of the EC Regulation).

A brand which is equivalent to a geographical indication and which was submitted for registration in good faith before an application was made for a geographical indication may be used, provided that it does not consist exclusively of names used in trade to indicate a designation of origin, or which could mislead the public as to the place of origin (Article 14, paragraph 2 of the Regulation concerning Article 3, paragraph 1, sub c and sub g of the EC Trademark Directive).

A geographical indication will not be registered if, in view of a brand's name and fame and the length of time that it has been used, the registration might mislead consumers as to the real identity of a product with such a geographical indication (Article 14, paragraph 3 of the Regulation).

In accordance with the Benelux Trademark Law (section 5(2c)), the right to hold a brand is withdrawn if the brandname of the goods or services concerned is used in such a way that the public may have been misled regarding the geographical origin of the goods or services.

An amendment to the Benelux Trademark Law will come into effect shortly, rendering registered brands null and void which bear geographical indications or which pertain to wines or spirits which do not originate from the geographical area named on the mark (section 4, under 7 *Benelux Merkenwet*).

G. ENFORCEMENT

47. *How are rights in the geographical indication enforced? Are provisions available under unfair competition law? Trademark law? Other laws? Provide citations to the laws and, if they have not been notified under Article 63.2 of the TRIPS Agreement, please provide copies.*

The competent authorities listed in the response to question 17 above enforce compliance with the provisions in a product dossier and carry out inspections of products bearing a geographical indication (section 7 of LGAOS).

In addition, the Health Protection Inspectorate (Government Food Inspection Service) is authorised to hand out fines and initiate lawsuits.

The Civil Code protects against unlawful use of a geographical indication on the grounds of Acts described in the answer to question 1 above (under (1), (2), (4) and (5)). Self-regulation, mentioned under (3) in that answer, is realised through the Advertising Code Foundation.

48. *Who has the right to enforce a geographical indication?*

Any person wanting to be protected against misleading geographical indications.

49. *What judicial or administrative bodies have jurisdiction over enforcement actions related to geographical indications? Are there fees involved and, if so, what are those fees?*

See the answer to question 47 above.

50. *Must the public be notified of the existence of a geographical indication and, if so, how and how often?*

Intended registrations of geographical indications are published in the so-called PBO newsletter (of the Central Commodity Board for Arable Products) immediately following publication in the Official Journal of the EU.

51. *Is unauthorized use of a geographical indication subject to criminal action and, if so, describe the procedures. If the law has not been notified pursuant to Article 63.2 of the TRIPS Agreement, please provide a copy.*

Members of the organisations listed in the answer to question 17 above found in violation of LGAOS will be disciplined, unless the prosecuting attorney in consultation with the competent authority concerned decides that the violation must be tried in the criminal court of law (see section 13 concerning section 18(2) of the *Landbouwkwaliteitswet*). Disciplinary measures are: reprimands, monetary fines up to Dfl. 10,000, increased supervision for a maximum of two years and publication of the disciplinary decision.

Violations by non-members will always be treated as a criminal offence.

A person found guilty of breaching the *Landbouwkwaliteitswet* (Agricultural Produce Act) will be sentenced in pursuance of the *Wet op Economische Delicten* (Economic Misdemeanours Act), with a maximum fine of Dfl. 25,000.

H. INTERNATIONAL AGREEMENTS

52. *Is your government party to an international, including bilateral or plurilateral, agreement for the notification and/or registration of geographical indications? If so, please name the international agreement and explain the relationship between it and your national legislation.*

No.

53. *What other international agreements, if any, have been entered into? What do those agreements provide?*

No agreements with any relevance to geographical indications.

Responses from Spain

I. RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13

A. GENERAL

1. *Is protection for geographical indications provided through unfair competition law, e.g., passing off, false designation of origin; through a formal procedure for notification/registration before protection is available; or through both? Does the recognition of a geographical indication require registration?*

In Spain, in order that a geographical indication may be protected from being used falsely on an unentitled product, the indication must have been approved as a Designation of Origin (PDO, quality wine psr), a Specific Designation (PGI), a Geographical Designation (for spirit drinks only) or a Geographical Indication for so-called "vinos de la tierra" (local wines).

This approval is made effective through legal provisions, normally Orders ("Ordenes"), which are published in the corresponding Official Journal ("Boletín Oficial") of the Autonomous Community concerned and, subsequently, in the Official Journal of the State. From this point on, the protection is in effect and it is not necessary to implement any other procedure, such as registration.

2. *Is there one single regime of protection of geographical indications for all products? If not, identify the different regimes.*

At present, there are four regimes of protection according to product type. These are based on the following provisions:

- For wines with a Designation of Origin (quality wines psr), Law 25/1970, Vineyard, Wine and Alcohol Regulations (Articles 81, 82 and 83); Regulation (EEC) 823/87 laying down special provisions relating to quality wines produced in specified regions (Article 15.4); and Regulation (EEC) 2392/89 laying down general rules for the description and presentation of wines and grape musts (Article 40);
- For table wines entitled to the indication "vinos de la tierra", the Order of 11 December 1986 establishing the rules for the use of geographical names and the term "vino de la tierra" in the description of table wines (Articles 2 and 3); Regulation (EEC) 822/87 on the common organization of the market in wine (Article 72.4); and Regulation (EEC) 2392/89 laying down general rules for the description and presentation of wines and grape musts (Article 40);
- For spirits, Law 25/1970, Vineyard, Wine and Alcohol Regulations (Articles 81, 82 and 83); and Regulation (EEC) 1576/89 laying down general rules on the definition, description and presentation of spirit drinks (Article 5.3);
- For other agri-food products, Law 25/1970, Vineyard, Wine and Alcohol Regulations (Articles 81, 82 and 83); and Regulation (EEC) 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (Article 13).

Furthermore, in general terms, Law 32/88 on Trademarks stipulates that signs which may mislead the public as to the true geographical origin of the product may not be registered as trademarks (Article 11.1.f) and, within the EU, it is also necessary to take into account

Directive 79/112/EEC on the approximation of the laws of the member States relating to the labelling, presentation and advertising of foodstuffs (Article 2.1.a.i).

3. *Do(es) the regime(s) of protection of geographical indications also extend to services?*

The protected geographical indications (in the various forms described in the reply to question 1 above) extend only to agri-food products and not to any other type of products or services, either in Spain or at EU level.

4. *What provisions of law or regulations are directed to the recognition of geographical indications required by Articles 22.2 and 23.1 of the TRIPS Agreement? Citations to laws should be provided and, if the texts of the laws have not been notified to the WTO, copies should be provided pursuant to Article 63.2.*

The provisions directed to the recognition of geographical indications required by Articles 22.2 and 23.1 of the TRIPS Agreement are those described in the reply to question 2 above.

The provisions preventing the wrongful use of geographical indications (as set out in Articles 22.2 and 23.1 of the TRIPS Agreement) are: Law 25/70, Regulation (EEC) 2392/88, Regulation (EEC) 2081/92, Law 32/88 and Directive 79/112/EEC.

Moreover, to ensure that the protection of geographical indications required by Articles 22 and 23 of the TRIPS Agreement is properly applied, the following legal texts have been introduced:

- Article 72 of Regulation (EEC) 822/87 (for wines);
- Article 11 of Regulation (EEC) 1576/89 (for spirit drinks);
- Article 10 of Regulation (EEC) 1601/91 laying down general rules on the definition, description and presentation of aromatized wines, aromatized wine-based drinks and aromatized wine-product cocktails (for aromatized wines).

5. *If the required recognition of geographical indications is not provided through statutes or regulations, please explain, in detail, the mechanism or mechanisms through which the protection required is provided.*

Protection for geographical indications is provided by the legislation already mentioned in the reply to question 2 above.

6. *Please provide a few examples of domestic geographical indications protected in accordance with the means discussed above and indicate the means by which such protection is provided.*

Quality wines psr

Examples: Jerez-Xeres-Sherry, Manzanilla Sanlucar de Barrameda, Malaga, Montilla-Moriles, Rioja, Ribera del Duero, etc.

The geographical indication is first approved by the corresponding Autonomous Community and then ratified by the Spanish State. After that, it is recognized at Community level under Article 1.3 of Regulation (EEC) 823/87. It is protected under Article 15.4 of Regulation (EEC) 823/87 and Article 40 of Regulation (EEC) 2392/89. Finally, it is registered and published in the Official Journal of the European Communities.

"Vinos de la tierra"

Examples: Medina del Campo, Ribera del Arlanza, Manchuela, Cebreros, etc.

These geographical indications are approved by the competent Autonomous Community. Their protection is based on Article 72.4 of Regulation (EEC) 822/87 and Article 40 of Regulation (EEC) 2392/89.

Spirit drinks

Examples: Brandy de Jerez, Pacahran Navarro, Orujo de Galicia, Chinchon, Palo de Mallorca, etc.

These are recognized at Community level on the basis of Article 5.3 of Regulation (EEC) 1576/89 and protected under its Article 5.3.b. They are registered and published in Annex II of the Regulation.

Other agri-food products

Examples: Manchego cheese, Baena, Guijuelo, Alcarria honey, Navarre asparagus, etc.

Registered under Article 17 of Regulation (EEC) 2081/92, simplified procedure for names already legally protected in the member State.

Examples: Huelva ham, Gallega veal, Almagro aubergine, etc.

Registered under Articles 5, 6 and 7 of Regulation (EEC) 2081/92, normal procedure.

The protection and the necessary criteria under Articles 2 (definitions) and 4 (specification) of the Regulation are the same for both procedures.

7. *Is the higher level of protection required for wines and spirits under Article 23.2 of the TRIPS Agreement provided for any other product? If so, please specify such products and the law under which they are protected.*

Article 23.2 of the TRIPS Agreement establishes the possibility of the existence of regulations which refuse or invalidate trademarks for wines or spirits which contain or consist of a protected geographical indication for wines or spirits, respectively.

In Spain, there is a regulation which refuses requests for such a trademark but there is no possibility of invalidation if the trademark was registered prior to the recognition of the geographical indication and, accordingly, under certain conditions acquired rights apply.

What the Checklist calls a "higher level of protection" is available for:

- Wines with a Designation of Origin (quality wines psr), under Law 26/1970, which establishes that trademarks which refer to DOs may be registered only if they are used on products entitled to such a designation and subject to authorization by the Regulatory Authority ("Consejo Regulador") (Article 83.3); and Regulation (EEC) 2392/89 laying down general rules for the description and presentation of wines and grape musts (Article 40);
- Other agri-food products, under Regulation (EEC) 2081/92 (Article 14);

- And, in general terms, under Law 32/88 on Trademarks, which stipulates that Designations of Origin may not be registered as guarantee marks (Article 62.2). Similarly, trademarks composed exclusively of indications used in trade to designate geographical provenance are not registrable (Article 11.1.c).

B. DEFINITION AND CRITERIA FOR RECOGNITION

8. *How are geographical indications defined?*

The definitions of the types of protected geographical indications currently subject to regulation in Spain are indicated below, together with the provision containing the definition:

At national level

DESIGNATION OF ORIGIN ("Denominacion de Origen - DO"), for wines, spirit drinks and other agri-food products:

"Geographical name of a region, district, place or locality used to designate a product from that area having distinctive qualities and characteristics due mainly to the natural environment and to its preparation and cultivation.

"A geographical name of a region, district, place or locality is considered to be used to designate a product originating in that area if it is permanently in wide circulation and well-known on the domestic market or has at least achieved a considerable reputation on a regional scale or a developed market abroad" (Article 79 of Law 25/1970).

SPECIFIC DESIGNATION ("Denominacion Especifica - DE"), for spirit drinks and other agri-food products:

"Description applicable to a product which has distinctive qualities among products of the same kind due to its raw material base, environment or methods of production." (Article 3 of Royal Decree 1573/1985 regulating generic and specific names of food products.)

VINO DE LA TIERRA (for some table wines entitled to a geographical indication):

Term applicable to table wines from certain wine-growing areas by whose name it must be accompanied. These wines must satisfy certain conditions with respect to varieties, alcoholic strength, volatile acidity and sulphur dioxide (Article 3 of the Order of 11 December 1986 establishing rules for the use of geographical names and the term "vino de la tierra" in the description of table wines).

At European Union level

QUALITY WINE PRODUCED IN A SPECIFIED REGION (QUALITY WINE PSR) (and its variants: quality sparkling wine psr, quality liqueur wine psr and quality semi-sparkling wine psr):

"Specified region shall mean a wine-growing area or combination of wine-growing areas which produces wine possessing special quality characteristics and whose name is used to designate them" (Article 3 of Regulation (EEC) 823/87). Some exceptions are allowed and are listed in Article 15.3 of the Regulation, e.g. "Cava".

TABLE WINES DESCRIBED USING A GEOGRAPHICAL INDICATION:

"The said geographical indications shall correspond to a geographical unit which is smaller than the Member State and may be: a small locality or a group of such localities, a local administrative area or part thereof, a wine-growing subregion or part thereof or a region other than a specified region (Article 4.1 of Regulation (EEC) 2392/89). ... In addition, these geographical indications shall be reserved for table wines meeting certain production requirements, particularly as regards vine varieties, minimum natural alcoholic strength by volume and organoleptic characteristics (Article 4.3 of the same Regulation)."

GEOGRAPHICAL DESIGNATION (GD) (for spirit drinks):

Those listed in Annex II to Regulation (EEC) 1576/89 which "shall be reserved for spirit drinks in the case of which the production stage during which they acquired their character and definitive qualities took place in the geographical area indicated" (Article 5.3.b of the Regulation).

PROTECTED DESIGNATION OF ORIGIN (PDO) (agri-food products, other than wines and spirit drinks):

"The name of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff:

- "originating in that region, specific place or country; and
- "the quality or characteristics of which are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors, and the production, processing and preparation of which take place in the defined geographical area" (Article 2.2.a of Regulation (EEC) 2081/92).

PROTECTED GEOGRAPHICAL INDICATION (PGI) (agri-food products, other than wines and spirit drinks):

"The name of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff:

- "originating in that region, specific place or country; and
- "which possesses a specific quality, reputation or other characteristics attributable to that geographical origin and the production and/or processing and/or preparation of which take place in the defined geographical area" (Article 2.2.b of Regulation (EEC) 2081/92).

In addition, Article 2.3 of Regulation (EEC) 2081/92 protects as designations of origin certain traditional geographical or non-geographical names designating an agricultural product or a foodstuff originating in a region or a specific place, which fulfil the conditions referred to in the second indent of the definition of a designation of origin.

PDOs and PGIs receive the same form of protection.

9. *Would such a definition comprise geographical indications identifying products of a certain quality or reputation which are indirectly linked to a specific region?*

The above definitions relate to geographical indications which are directly linked to the region of origin and identify products of a certain quality, renown or reputation which are tied to their region of origin.

10. *In determining whether recognition should be given a geographical indication, what criteria are considered?*

A geographical indication, within the typology described above, is only recognized if it satisfies the corresponding definition. Furthermore, in the case of:

Quality wines psr

Although each member State follows its own criteria, there are certain minimum criteria laid down at Community level (Article 2 of Regulation (EEC) 823/87). These are mandatory and define the following parameters:

- demarcation of the area of production;
- vine varieties;
- cultivation methods;
- wine-making methods;
- minimum natural alcoholic strength by volume;
- yield per hectare;
- analysis and assessment of organoleptic characteristics.

Agri-food products (other than wines and spirit drinks)

The parameters which, as a minimum, the Community requires to be defined are laid down in Article 4.2 of Regulation (EEC) 2081/92 which is reproduced in the reply to question 23 below.

11. *Is there any human creativity involved in the making of specific products under protection by the system of geographical indications? If so, how much? And do these products involve any human factors?*

Yes, for all the products protected by geographical indications, since in varying degrees they are prepared (from a wine to a fresh fruit) and depend on the human factor and within that the creativity which over time has succeeded in perfecting or devising special methods of production, preparation or processing which have given or helped to give the final product its distinctive characteristics.

12. *Are there any other intellectual property rights involved, such as patents for example?*

These methods of production, preparation or processing may or may not be patented and, for example, varieties or breeds may or may not be registered, but none of this is essential for the development and recognition of a geographical indication.

13. *What authority, if any, may define the geographic region or area for which rights are claimed and on what basis is such definition made?*

The demarcation of the geographical area linked to a protected geographical indication is determined by the appropriate authority of the Autonomous Community concerned (when the area of production lies entirely within the territory of a single Autonomous Community) or by the national Ministry of Agriculture, Fisheries and Food (if more than one Autonomous Community is involved).

Depending on the type of product and the type of protected geographical indication, the demarcation process is based on the climate, the soil, the varieties or breeds involved, and the methods of production, preparation or processing developed by the enterprises located in the area.

In the case of agri-food products (other than wines and spirits), it is the group of producers and/or processors applying to the competent State authority for the registration of a new geographical indication (Article 5 of Regulation (EEC) 2081/92) that proposes the corresponding geographical demarcation.

14. *Does your legislation contain criteria for homonymous geographical indications for wines?*

Yes, there is legislation on homonymous geographical indications for wines: the Order of 11 December 1986 does not permit the recognition of geographical names for table wines which coincide with the description of a quality wine psr. At EU level, Article 4 of Regulation (EEC) 2392/89 introduces a similar criterion.

With respect to imported wines, Article 29.2 and 3 of Regulation (EEC) 2392/89 prohibits, as a general principle, the presence in their description of the name of a geographical unit used to describe a table wine or a quality wine psr or the name of a given region in the Community. Exceptions may be allowed only where the geographical name in question is employed in the third country in accordance with traditional and consistent usage and on condition that its use is governed by rules in that country.

15. *Does your national legislation provide for recognition and protection of geographical indications or appellations of origin of foreign countries?*

Spain has provided for the recognition and protection of geographical indications of other countries through:

- Bilateral mutual protection agreements with: Germany, Portugal, France, Switzerland, Italy, Austria, Hungary and Czechoslovakia;
- Since Spain was admitted to the EU (1 January 1988), there has been mutual recognition and protection with all the other member countries (currently: Austria, Belgium, Denmark, Finland, France, Germany, Greece, Holland, Ireland, Italy, Luxembourg, Portugal, Sweden and United Kingdom);
- EU-third country agreements (United States, Mexico, Australia, etc.). In the case of wine, these agreements grant foreign geographical indications the same protection as that enjoyed by quality wines psr, in accordance with Article 61 of Regulation (EEC) 822/87;
- Annex II of Commission Regulation (EEC) 3201/90 of 16 October 1990 laying down detailed rules for the description and presentation of wines and grape musts.

Furthermore, protection for names of other countries is also provided through the prohibition of the use of false indications of origin:

- Article 72 of Regulation (EEC) 822/87 and Article 40.2 of Regulation 2392/89 (for wines);
- Article 10 of Regulation (EEC) 1601/90 (for aromatized wines);
- Article 11 of Regulation (EEC) 1576/89 (for spirit drinks);
- Article 12 of Regulation (EEC) 2081/92 (for other agri-food products).

In addition, Article 11.1.e of Law 32/88 on Trademarks and Article 2 of Directive 79/112/EEC prohibit misleading information as to the origin or provenance of the product. This should also be understood to apply to third-country origins or provenances.

16. *Is there any specific prohibition in the legislation/regulations/rules/procedures covering geographical indications not protected in the country of origin? If so, please specify the relevant statutory provision.*

Spanish legislation does prohibit the use of geographical indications not protected in the country of origin but only where it is a question of repressing a false indication of origin. This is provided for in all the bilateral agreements mentioned in the first indent of the reply to question 15 above and in the Spanish Law on Trademarks. Moreover, the Community directives on labelling and advertising always contain similar provisions.

C. PROCEDURE FOR RECOGNITION

17. *With respect to any formal system for recognition of geographical indications, must the applicant be a governmental organization or can a private entity own the rights to a geographical indication?*

With regard to the procedure for applying for the recognition of a geographical indication, there are two possibilities:

- for wines and spirit drinks, it is the producers and/or processors themselves who must apply to the appropriate public authority (autonomous or central, depending on whether the demarcation area of the geographical indication lies in only one or more than one Autonomous Community) (Article 84.1 of Law 25/1970), although it is possible for the authority to act ex officio (Article 85 of Law 25/1970);
- for other agri-food products, only groups of producers and/or processors or, subject to certain conditions, natural or legal persons who obtain or produce the product in question are entitled to apply for registration (Article 5.1 of Regulation (EEC) 2081/92).

18. *What are the competent authorities where the protection of a geographical indication can be obtained?*

The authorities competent to recognize a new geographical indication are:

- For wines and spirit drinks, the corresponding authority of the Autonomous Community concerned, where there is only one, or the National Ministry of

Agriculture, Fisheries and Food, where more than one Autonomous Community is involved;

- For other agri-food products, the Commission of the European Union.

19. *Do the procedures which lead to the recognition of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

See the reply to question 17 above.

20. *What, if any, fees are involved in the application and maintenance of rights in a geographical indication?*

No fees of any kind are involved.

21. *If criteria must be set out in an application for recognition of a geographical indication, are those criteria purely geographic in nature?*

The criteria which must be set out in an application for recognition of a geographical indication are not purely geographical in nature. They include the following: the agronomic characteristics of the geographical area (climate, uniformity and fertility of the soil, homogeneity of the cultivation conditions, varieties or breeds), the uniformity of the analytical and organoleptic characteristics of the product originating in the area in question, the technical skill of the makers or processors and their observance of the traditional practices which have given the product its originality, and their location, marketing conditions and level of recognition and reputation in the market.

For further details see the reply to question 10 above.

22. *What other criteria, if any, must be set out in an application for recognition of a geographical indication?*

See the reply to question 21 above.

23. *What information must be supplied in an application for rights in a geographical indication?*

In general, the information which must be supplied in an application for recognition of a geographical indication is:

- For wines and spirit drinks, the official letter of application signed by the group of producers and/or processors or interested individuals accompanied by a statement showing that the requirements necessary to obtain a DO or DE have been met in so far as the definition is satisfied and on the basis of the criteria set out in the reply to question 10 above;
- For other agri-food products, the member State shall transmit to the Commission of the EU a product specification drawn up by the applicants and endorsed by the Government, together with all the documentation on which the decision to submit the application is based.

In accordance with the provisions of Article 4.2 of Regulation (EEC) 2081/92, this product specification shall include at least:

- (a) The name of the agricultural product or foodstuff, including the designation of origin or the geographical indication;
- (b) a description of the agricultural product or foodstuff, including the raw materials, if appropriate, and principal physical, chemical, microbiological and/or organoleptic characteristics of the product or the foodstuff;
- (c) the definition of the geographical area and, if appropriate, details indicating compliance with the requirements in Article 2(4);
- (d) evidence that the agricultural product or the foodstuff originates in the geographical area, within the meaning of Article 2(2)(a) or (b), whichever is applicable;
- (e) a description of the method of obtaining the agricultural product or foodstuff and, if appropriate, the authentic and unvarying local methods;
- (f) the details bearing out the link with the geographical environment or the geographical origin within the meaning of Article 2(2)(a) or (b), whichever is applicable;
- (g) details of the inspection structures provided for in Article 10;
- (h) the specific labelling details relating to the indication PDO or PGI, whichever is applicable, or the equivalent traditional national indications;
- (i) any requirements laid down by Community and/or national provisions.

24. *Must the goods or services with respect to which a geographical indication is claimed be set out?*

Yes, a geographical indication must always be linked with a specific product.

25. *What mechanisms are provided to oppose the recognition of a geographical indication? How is an investigation conducted after such a complaint?*

When a new geographical indication is approved and, accordingly, published in the corresponding Official Journal (of the Autonomous Community or the State), any natural or legal person may oppose its recognition by appealing against the administrative decision. The competent administrative body will then examine the grounds for the appeal and give a ruling.

The grounds for opposing recognition may be, for example, that the criteria set out in the reply to question 10 above are not fulfilled or that someone's legitimate interests have been injured.

In the case of agri-food products other than wines or spirit drinks, in addition to the procedure described, when the new geographical indication is submitted to the EU, a period of six months from the date of publication of the registration application by the Commission shall be allowed (Article 7 of Regulation (EEC) 2081/92) during which any other member State may object to the registration,

either ex officio or by transmitting the objection of any legitimately concerned natural or legal person established in that State.

If the Commission admits the objection, the two States have three months in which to reach agreement; if no agreement is reached, it is the Commission that decides.

26. *Who can oppose the recognition of a geographical indication?*

See the reply to question 25 above.

27. *If your national legislation provides for recognition and protection of geographical indications or appellations of origin of foreign countries, what is the procedure that has to be followed in order to obtain such recognition and consequent protection?*

The following reply is based on the understanding that the possibility of recognition of a third-country geographical indication refers to the possibility of "participating in the domestic regime by means of a positive recognition (positive list)". Therefore, it does not relate to protection within the meaning of the TRIPS Agreement (in this connection, see the replies to questions 4 and 15 above).

Thus, the procedure for the recognition of geographical indications of foreign countries depends on the country and the product:

- if it is a member country of the EU and it is a question of wines or spirit drinks, once the State concerned publishes the approval of the geographical indication, it is automatically recognized and protected throughout the Community;
- if it is a member country of the EU and it is a question of other agri-food products, the member State must apply to the Commission for its inclusion in the EU's "Register of protected designations of origin and protected geographical indications";
- if it is not a member country of the EU, the procedure is to exchange lists of the names it is desired to protect, within the framework of the corresponding bilateral agreement (between States prior to Spain's admission to the EU and between the latter and third countries since then).

Moreover, for the agri-food products (other than wines and spirit drinks) of EU third countries, their geographical indications may also be recognized under the procedure described in the second indent, provided that the conditions of Article 12 of Regulation (EEC) 2081/92 are fulfilled.

D. MAINTENANCE

28. *How long does recognition for a geographical indication continue?*

Recognition for a geographical indication continues indefinitely.

29. *If recognition of a geographical indication must be renewed or reaffirmed, what information must be provided in order to effect such a renewal or reaffirmation? Specify any fees involved in renewal or reaffirmation.*

Recognition of a geographical indication does not have to be renewed or reaffirmed, so there are no fees to be paid.

30. *Must a geographical indication be used in order to maintain rights? If so, how is such use determined?*

A geographical indication does not have to be used in order to maintain rights. However, all those Spain currently recognizes are in fact being used.

31. *Is there a specified limit for non-use before rights in a geographical indication cease and, if so, what is that limit?*

There is no such limit.

32. *Who monitors the use of geographical indications to determine if the criteria identified in the application continue to be met?*

For quality wines psr, spirit drinks with a DE and the DOs and DEs of other agri-food products there is in each case a Regulatory Authority ("Consejo Regulador") responsible, among other things, for monitoring compliance with the corresponding regulations (which, obviously, include "the criteria identified in the application").

"Vinos de la tierra" and spirit drinks with geographical designations are monitored by the general government supervisory bodies.

33. *If a government entity is responsible for monitoring the use of geographical indications, what are its procedures for doing so?*

The regulatory authorities have suitably trained inspectors ("veedores") for carrying out the above-mentioned monitoring duties.

There are also inspectors (civil servants) for supervising the geographical indications for which there is no regulatory authority.

34. *Are there means by which interested parties may request termination of a geographical indication based on non-use or failure to maintain the criteria identified in the application? Describe the procedure.*

For wines and spirit drinks, there are no means of terminating a geographical indication once it has been recognized.

However, for other agri-food products there is the possibility of the Commission cancelling the registration in response to a complaint from a member State that a condition laid down in the corresponding "product specification" has not been met (Article 11 of Regulation 2081/92).

35. *Do the procedures which lead to forfeiture of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

See the reply to question 34 above.

E. SCOPE OF RIGHTS AND USE

36. *May anyone who meets the criteria submitted to obtain recognition of a geographical indication use that geographical indication after recognition is given or must additional criteria or procedures be followed by that party before use is permitted?*

The situation differs according to the type of product:

- For quality wines psr, spirit drinks with a DE and the DOs and DEs of other agri-food products, recognition of the new designation is not sufficient for a producer or processor to start using it, even if his product meets the required criteria. The interested party must first register with his regulatory authority and then, batch by batch, the products for which permission to display the designation is being requested must pass various tests based on chemical and organoleptic analyses;
- For spirit drinks with geographical designations, the interested party must first register them in a register maintained for the purpose by competent government service;
- For "vinos de la tierra", recognition of the new geographical name is sufficient to start using it, provided the corresponding criteria are met.

37. *Who makes the determination regarding use of a geographical indication by particular parties, the entity responsible for the recognition or the entity that obtained the recognition?*

A recognized geographical indication may be used freely by those entitled to it (see reply to previous question).

38. *Are there fees involved in receiving authorization to use a particular geographical indication and, if so, what are those fees and how are they established?*

No fees are paid for receiving authorization to use a geographical indication. However, if there is a regulatory authority, those registered with it are required to pay certain parafiscal charges intended for its maintenance (Article 90 of Law 25/1970), namely:

- (a) A percentage (maximum 1 per cent) of the product of the number of hectares registered in the name of each interested party and the average value in pesetas of the yield of one hectare for the area and the previous season;
- (b) a percentage (maximum 1.5 per cent) of the value obtained by multiplying the average unit price of the protected product by the volume sold;
- (c) as a maximum, 100 pesetas for each certificate or invoice and twice the cost price for each seal.

39. *If there is a dispute regarding use of a geographical indication by a particular party, what procedures are followed to resolve it?*

Disputes regarding the use of a recognized geographical indication are settled, in the first instance, within the regulatory authority (if it is a designation of a kind for which there is such an authority, see reply to question 38 above), from which it may be referred to the competent body (administrative and/or judicial) of the corresponding Autonomous Community (or the State if more than one Autonomous Community is involved).

40. *Must individual authorized users of a geographical indication use that geographical indication continually to retain their right to use it and, if so, how is their use determined and how long will disuse be permitted?*

In principle, the use of a recognized geographical indication by the producers or processors entitled thereto is voluntary, but there are DO regulations which stipulate that an entry in a regulatory authority register loses that status if a certain time elapses without the corresponding designation being used.

41. *If there is a dispute over continuity of use by a particular party, how is it resolved?*

If the corresponding regulations specify continuity of use, then, if a problem were to arise with its interpretation, it would be settled by the regulatory authority itself.

The interested party could appeal the decision to the appropriate higher body, administrative or judicial.

42. *Does the regime for protection of geographical indications allow geographical indications to be licensed and, if so, what conditions are imposed on such licenses? If such conditions are not met, what is the effect on the geographical indication?*

The protected geographical indication regime makes no provision for "licensing". The requirements that must be met for a producer and/or processor to be able to use a geographical indication are set out in the reply to question 36 above.

43. *How is "grandfathered use" of a geographical indication, under Article 24.4 of the TRIPS Agreement, applied in your country?*

"Grandfathered use" does not exist in Spain.

F. RELATIONSHIP TO TRADEMARKS

44. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.1 of the TRIPS Agreement are not nullified and impaired?*

The relationship between geographical indications and trademarks is established at EU level by means of the following instruments:

- Directive 89/104/EEC to approximate the laws of the member States relating to trademarks prohibits the registration of trademarks consisting exclusively of geographical indications (Article 3.c) or which are of such a nature as to deceive the public as to the geographical origin of the product (Article 3.g);
- Regulation (EEC) 3288/94 amending Regulation (EC) 40/94 on the Community trademark which in its Article 7 establishes that the Alicante Harmonization Office shall refuse any application for a trademark which:
 - (1) consists exclusively of an indication which may serve, in trade, to designate the geographical origin of goods; or
 - (2) for wines, contains or consists of a geographical indication identifying wines or, for spirits, contains or consists of a geographical indication identifying spirits with respect to such wines or spirits not having that origin.

Under Article 51 of the Regulation mentioned, third parties may initiate an invalidation proceeding against a trademark already registered with the Alicante Harmonization Office.

- Article 40.3 of Regulation (EEC) 2392/89 and Article 13.3 of Regulation (EEC) 2333/92, which (the latter) lay down general rules for the description and presentation of sparkling wines, preserve the right to a brand name for a wine which contains the name of a specified region if that brand name corresponds to the identity of an original holder, provided that the brand name was registered at least 25 years before the official recognition of the geographical name in question and the brand name has actually been used without interruption.
- Article 14 of Regulation (EEC) 2081/92 stipulates that:
 - A geographical indication shall not be registered where, in the light of a trademark's reputation and renown and the length of time it has been used, registration is liable to mislead the consumer as to the true identity of the product;
 - When a geographical indication has been registered, a trademark which attempts to evoke or misuse it shall be refused;
 - Use of a trademark which evokes a geographical indication and which was registered before that geographical indication may continue if the trademark was registered in good faith and complies with the corresponding provisions of Directive 89/104/EEC.

In the Spanish legislation, Article 84.2 of Law 26/1970 stipulates that before a new DO or DE is approved, a report must be requested from the Registry of Industrial Property and the Company Register and this report must be favourable. In the event of a conflict due to the existence of a trademark with the same name, negotiations must be arranged with the holder.

45. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.2 and 16.3 of the TRIPS Agreement are not nullified and impaired?*

See the reply to the previous question.

46. *What procedures are foreseen in case of a conflict of a geographical indication with a trademark?*

If there is a conflict between a geographical indication and a trademark, the following procedure applies:

- if the trademark has priority, negotiations with the holder (see reply to question 44 above);
- if the protected geographical indication already exists when an attempt is made to register the trademark, the regulatory authority for the designation or the competent government service shall ex officio raise an objection to its registration with the Spanish Patents and Trademarks Office (Article 83.4 of Law 25/1970).

See also the reply to question 44 above.

G. ENFORCEMENT

47. *How are rights in the geographical indication enforced? Are provisions available under unfair competition law? Trademark law? Other laws? Provide citations to the laws and, if they have not been notified under Article 63.2 of the TRIPS Agreement, please provide copies.*

Preventing the unlawful use of geographical indications is the same as preventing unfair competition, so that the reply to question 4 above is equally applicable here.

It might be added that Article 13(c) of Law 32/1988 on Trademarks states that "signs or media which involve the unlawful exploitation of the reputation of other registered signs or media" may not be registered as trademarks.

Is a copy required?

48. *Who has the right to enforce a geographical indication?*

See the reply to question 32 above.

49. *What judicial or administrative bodies have jurisdiction over enforcement actions related to geographical indications? Are there fees involved and, if so, what are those fees?*

In respect, the regulatory authorities and the government services responsible for monitoring compliance with the regulations on protected geographical indications always act in the exercise of their powers and, accordingly, there is no need to pay anything to initiate their action.

50. *Must the public be notified of the existence of a geographical indication and, if so, how and how often?*

The obligation to publish the list of protected geographical indications periodically is not regulated at national level. However, they have all been published, both the approval and the corresponding Regulation, in the Official Journal of the Autonomous Community concerned and subsequently in that of the State, and the Government will provide any interested party with an up-to-date list of names.

At Community level, an up-to-date list of quality wines psr (Article 1 of Regulation (EEC) 823/87 and "vinos de la tierra" of all the Member States (Article 11.1 of Regulation (EEC) 3201/90) must be published, with an unspecified frequency, in the C series of the Official Journal of the European Communities.

As for the DEs and GDs of spirit drinks, they are listed in Annex II of Regulation (EEC) 1576/89. However, the updating of this list is a slow and difficult process since it involves the amendment of a Council Regulation.

The names of other agri-food products are published in the OJEC and subsequently (if there have been no objections within six months of publication) entered in the "Register of protected designations of origin and protected geographical indications" kept by the EU Commission (paragraphs 2 and 3 of Article 6 of Regulation (EEC) 2081/92).

51. *Is unauthorized use of a geographical indication subject to criminal action and, if so, describe the procedures. If the law has not been notified pursuant to Article 63.2 of the TRIPS Agreement, please provide a copy.*

The unauthorized use of a geographical indication is identified as a criminal offence in Article 275 of the current Penal Code (Organic Law 10/1995): "Anyone who deliberately and without authorization uses, in trade, a designation of origin or a geographical indication representative of a protected quality legally protected in order to distinguish the products covered, being aware of the existence of the said protection, shall be liable to six months to two years imprisonment and a fine of six to twenty-four months ...".

If these offences "are especially serious, taking into account the value of the objects produced or the severity of the injury caused" (Article 276 of the Penal Code), they may lead to a prison term of "from two to four years, a fine of from eight to twenty-four months, and special disqualification from the pursuit of the trade related with the offence committed for a period of from two to five years". In addition, the judge may order the "temporary (for not more than five years) or permanent closure of the business or establishment of the person convicted".

Is the text required?

H. INTERNATIONAL AGREEMENTS

52/53. *Is your government party to an international, including bilateral or plurilateral, agreement for the notification and/or registration of geographical indications? If so, please name the international agreement and explain the relationship between it and your national legislation. What other international agreements, if any, have been entered into? What do those agreements provide?*

Yes, the EU has signed various bilateral agreements on wines (Australia, Hungary, Bulgaria, Romania) and spirits (United States, Mexico).

Other international agreements:

- Paris Convention of 20 March 1883 for the protection of industrial property;
- Madrid Agreement of 14 April 1891 for the Repression of False or Deceptive Indications of Sources on Goods of Origin.

II. RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13/ADD.1

A. GENERAL (SECTION A OF DOCUMENT IP/C/13)

1. *Does your economy's industrial property law and/or related law prevent the use of geographical indications identifying wines or spirits against products not originating in the place indicated by the geographical indication, 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" or the like?*

See the reply to question 1 under I above.

B. DEFINITION AND CRITERIA FOR RECOGNITION (SECTION B OF DOCUMENT IP/C/13)

2. *Is there a clear distinction among the terms "geographical indications", "appellations of origin" and "indications of source" in your economy's industrial property law and/or related law, or are there any substantive criteria to distinguish these terms?*

See the reply to question 8 under I above.

There is no definition for the term "indications of source".

However, Article 2.A.i of Directive 79/112 EEC states that the labelling and the methods used must not be such as could mislead the purchaser as to the origin or provenance of the product. This also applies to the presentation and advertising.

3. *Does your legislation contain criteria for homonymous geographical indications for wines and spirits.*

See the reply to question 14 under I above.

C. RELATIONSHIP TO TRADEMARKS (SECTION F OF DOCUMENT IP/C/13)

4. *Does your economy's industrial property law and/or related law provide the refusal or invalidation of a trade mark registration, which consists of or contains geographical indications identifying wines or spirits with respect to such wines or spirits not originating in the indicated territory?*

See the reply to question 44 under I above.

Responses from Sweden

I. RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13

A. GENERAL

1. *Is protection for geographical indications provided through unfair competition law, e.g., passing off, false designation of origin; through a formal procedure for notification/registration before protection is available; or through both? Does the recognition of a geographical indication require registration?*

The protection of geographical indications is provided through provisions in the Swedish Marketing Act of 27 April 1995 (Swedish Statute Book 1995 No. 450, with amendments). Such protection does not require registration.

2. *Is there one single regime of protection of geographical indications for all products? If not, identify the different regimes.*

The Marketing Act provides the general protection for geographical indications. A special regime exists concerning the marketing of alcoholic beverages in the Act (Swedish Statute Book 1978, No. 763) Containing Certain Provisions Concerning the Marketing of Alcoholic Beverages.

3. *Do(es) the regime(s) of protection of geographical indications also extend to services?*

As the protection ensured through these Acts applies to all kinds of marketing practices which are incompatible with good marketing practices, the protection covers both goods and services.

4. *What provisions of law or regulations are directed to the recognition of geographical indications required by Articles 22.2 and 23.1 of the TRIPS Agreement? Citations to laws should be provided and, if the texts of the laws have not been notified to the WTO, copies should be provided pursuant to Article 63.2.*

As has been indicated earlier in communications to the World Trade Organization, generally speaking, the provisions of the Marketing Act and in the special Act applying to alcoholic beverages and also, in respect of trademarks, the provisions under the Trademarks Act (Swedish Statute Book 1960, No. 644, with later amendments) cover the protection required under Articles 22.2 and 23.1 of the TRIPS Agreement. Reference is made to the attached document "Protection of Geographical Indications in Sweden" prepared by the Ministry of Justice in January 1997 and notified to the TRIPS Council.¹³

5. *If the required recognition of geographical indications is not provided through statutes or regulations, please explain, in detail, the mechanism or mechanisms through which the protection required is provided.*

This question is not applicable; the protection is provided in statute.

6. *Please provide a few examples of domestic geographical indications protected in accordance with the means discussed above and indicate the means by which such protection is provided.*

The Ministry of Justice is not aware of specific cases where a geographical denomination has been deemed to be contrary to the provisions of the Marketing Act of the other Act cited above.

¹³ See the Annex on pages 140-142 below.

7. *Is the higher level of protection required for wines and spirits under Article 23.2 of the TRIPS Agreement provided for any other product? If so, please specify such products and the law under which they are protected.*

Yes. See the reply to question 7 concerning EC legislation (in the Section above reproducing the answers from the European Communities to the Checklist).

B. DEFINITION AND CRITERIA FOR RECOGNITION

8. *How are geographical indications defined?*

Geographical denominations are not defined. The Marketing Act prohibits any claims or statements, in the course of a businessman's activities, for instance advertising, which are misleading as regards the businessman's own or other businessmen's operations, especially concerning the nature, quantity, quality or other features of the product or its origin, use and environmental or health effects. This would include also all kinds of misleading information about the geographical origin of the product or service.

9. *Would such a definition comprise geographical indications identifying products of a certain quality or reputation which are indirectly linked to a specific region?*

It probably would cover also such indirect links to specific regions as the protection applies to all kinds of misleading information of the kind mentioned.

10. *In determining whether recognition should be given a geographical indication, what criteria are considered?*

The criteria used are those mentioned above in the reply to question 8.

11. *Is there any human creativity involved in the making of specific products under protection by the system of geographical indications? If so, how much? And do these products involve any human factors?*

There does not necessarily have to be any human creativity involved in the geographical indication whose use could be prohibited under the Marketing Act or the other Act mentioned above.

12. *Are there any other intellectual property rights involved, such as patents for example?*

It would seem that other intellectual property rights may be involved only in cases where the geographical denomination has taken the character of a trademark or a certification or collective mark under the trademark legislation.

13. *What authority, if any, may define the geographic region or area for which rights are claimed and on what basis is such definition made?*

There is no authority which "defines" the geographic region or area for which rights are claimed; it is the Court which decides whether there is an improper marketing act undertaken which would be contrary to good marketing practices, including the determination of whether there is an improper indication of the geographical origin.

14. *Does your legislation contain criteria for homonymous geographical indications for wines?*

The legislation contains provisions on the protection of homonymous geographical indications for wines in the sense that the above-mentioned Act relating to alcoholic beverages prescribes (as regards protection granted to foreign States) that false or deceptive indications of origin may not be used through which the beverages directly or indirectly are alleged to have been produced or manufactured in a foreign State or in a locality in the foreign State. This applies also where the true origin is indicated or where the indication is used only in translation or is accompanied by expressions like "kind", "type", "style", "imitation" or similar expressions.

15. *Does your national legislation provide for recognition and protection of geographical indications or appellations of origin of foreign countries?*

The proceedings relating to the use of false/misleading indications of geographical origin apply to all such indications and do not depend on the origin of the "originals".

16. *Is there any specific prohibition in the legislation/regulations/rules/procedures covering geographical indications not protected in the country of origin? If so, please specify the relevant statutory provision.*

There are no specific provisions concerning the protection of geographical indications which are not protected in their country of origin; the protection is based on the concept that indications used are misleading in this country and that is not depending on the protection in the country of origin.

C. PROCEDURE FOR RECOGNITION

17. *With respect to any formal system for recognition of geographical indications, must the applicant be a governmental organization or can a private entity own the rights to a geographical indication?*

There is no formal system for recognition of geographical indications.

18. *What are the competent authorities where the protection of a geographical indication can be obtained?*

The protection of geographical indications is obtained through the procedures under the Marketing Act (proceedings at the Stockholm City Court, which may be appealed against to the Market Court, which is a specialized court competent in, for instance, matters relating to the Marketing Act).

19. *Do the procedures which lead to the recognition of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

The proceedings leading to a protection of a specific geographical indication are initiated at the Stockholm City Court by the Consumer Ombudsman, who is a Government official; he usually acts upon the complaint by some injured party but he may also act upon his own initiative. To that extent, the procedures may take place ex officio. However, also businessmen affected by the alleged misleading marketing, and associations of consumers, businessmen or wage or salary earners may bring such an action.

20. *What, if any, fees are involved in the application and maintenance of rights in a geographical indication?*

There are no fees applicable to the initiation of proceedings under the Marketing Act.

21. *If criteria must be set out in an application for recognition of a geographical indication, are those criteria purely geographic in nature?*

It follows from the provisions of the Marketing Act that the protection against misleading indications of geographical origin are not necessarily of a geographical nature.

22. *What other criteria, if any, must be set out in an application for recognition of a geographical indication?*

There are no provisions about criteria which must be set out in this context.

23. *What information must be supplied in an application for rights in a geographical indication?*

There are no provisions about any specific information that must be submitted, but it is obvious that the Consumer Ombudsman must state the factual circumstances about why, for instance, a businessman's indications concerning geographical origin are to be considered as misleading.

24. *Must the goods or services with respect to which a geographical indication is claimed be set out?*

There is no specific requirement in this context.

25. *What mechanisms are provided to oppose the recognition of a geographical indication? How is an investigation conducted after such a complaint?*

As stated above, the system is not based on the "recognition" as such of specific geographic indications but rather on the approach of preventing the use of false or misleading indications of geographical origin. Obviously, the defendant in a case would be able to oppose the claim that his indication is actually false or misleading but this is part of the normal court procedure and there are no specific mechanisms provided for in this context.

26. *Who can oppose the recognition of a geographical indication?*

There are no specific provisions about who can oppose the recognition of a geographical indication in this context; like in the case of question 25 above this is part of the normal court procedure.

27. *If your national legislation provides for recognition and protection of geographical indications or appellations of origin of foreign countries, what is the procedure that has to be followed in order to obtain such recognition and consequent protection?*

Those procedures are described in the document referred to in the answer to question 4 above. Briefly, the Consumer Ombudsman may file an action at the Stockholm City Court concerning a so-called market disruption fee or a prohibition in, for instance, cases of misleading information about geographical origin. As mentioned above, such actions may be filed either upon complaint by the injured party or at the Ombudsman's own initiative. Consequently, a foreign party whose interests are affected should preferably file a complaint with the Consumer Ombudsman.

D. MAINTENANCE

28. *How long does recognition for a geographical indication continue?*

There is no prescribed time-limit for the protection against false or misleading information of geographical origin under the Marketing Act.

29. *If recognition of a geographical indication must be renewed or reaffirmed, what information must be provided in order to effect such a renewal or reaffirmation? Specify any fees involved in renewal or reaffirmation.*

There is no such specific system for renewal or reaffirmal of the protection of geographical indications (apart from cases where the geographical indication in question is protected under the Trademark Act).

30. *Must a geographical indication be used in order to maintain rights? If so, how is such use determined?*

There are no requirements of use in this context.

31. *Is there a specified limit for non-use before rights in a geographical indication cease and, if so, what is that limit?*

There are no provisions on specified limits for non-use in this context.

32. *Who monitors the use of geographical indications to determine if the criteria identified in the application continue to be met?*

There are no specific provisions on the monitoring of the use of geographical indications.

33. *If a government entity is responsible for monitoring the use of geographical indications, what are its procedures for doing so?*

There is no Government authority responsible specifically for monitoring the use of geographical indications.

34. *Are there means by which interested parties may request termination of a geographical indication based on non-use or failure to maintain the criteria identified in the application? Describe the procedure.*

There are no specific means by which interested parties may request the termination of a geographical indication based on non-use, etc; the use of a specific indication of the geographical origin of a product or service depends on whether it is actually still false or misleading or not.

35. *Do the procedures which lead to forfeiture of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

As mentioned above, actions against the use of false or misleading indications relating to geographical origin may be filed by the Consumer Ombudsman (which action may lead to a prohibition against the use of that specific geographical indication) either upon complaint or at his own initiative.

E. SCOPE OF RIGHTS AND USE

36. *May anyone who meets the criteria submitted to obtain recognition of a geographical indication use that geographical indication after recognition is given or must additional criteria or procedures be followed by that party before use is permitted?*

The legislation relating to the protection of geographical indications is based on the approach that Court decisions, in specific cases, restrict (through a preventive market disruption fee) or prohibit the use of, *inter alia*, statements which are misleading in respect of the geographical origin of products or services. Consequently, there are no specified criteria for the determination of which indications of origin would enjoy protection under these provisions, and the question of other persons' use of a particular indication of geographical origin does not have relevance.

37. *Who makes the determination regarding use of a geographical indication by particular parties, the entity responsible for the recognition or the entity that obtained the recognition?*

This issue is decided in the particular proceeding before the Stockholm City Court/the Market Court.

38. *Are there fees involved in receiving authorization to use a particular geographical indication and, if so, what are those fees and how are they established?*

There are no fees involved in this context.

39. *If there is a dispute regarding use of a geographical indication by a particular party, what procedures are followed to resolve it?*

The normal procedures under the Marketing Act would apply (see the document referred to in the reply to question 4 above).

40. *Must individual authorized users of a geographical indication use that geographical indication continually to retain their right to use it and, if so, how is their use determined and how long will disuse be permitted?*

There are no specific provisions on the retention of the right of specific geographical indications.

41. *If there is a dispute over continuity of use by a particular party, how is it resolved?*

Such conflicts are resolved through the normal procedures under the Marketing Act (see above).

42. *Does the regime for protection of geographical indications allow geographical indications to be licensed and, if so, what conditions are imposed on such licenses? If such conditions are not met, what is the effect on the geographical indication?*

There are no specific provisions on licensing of the rights in geographical indications (apart from cases where those are trademarks, in which cases the normal provisions in the Trademark Act apply).

43. *How is "grandfathered use" of a geographical indication, under Article 24.4 of the TRIPS Agreement, applied in your country?*

There are presently no provisions in this respect.

F. RELATIONSHIP TO TRADEMARKS

44. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.1 of the TRIPS Agreement are not nullified and impaired?*

In relation to the registration or protection of trademarks, the obligations under Article 22.1 of the TRIPS Agreement are met by various provisions in the Trademark Act. Thus, a trademark may not be registered where the mark would violate the provisions of, for instance, the Marketing Act. If registration has nevertheless taken place, that may be invalidated where the ground for non-registration still exists. Action for such invalidation may be brought by the injured party and also, in certain situations, by a public authority or by an association of persons conducting business in the sector concerned. Furthermore, the Trademark Act contains provisions on prohibition by means of Court orders of the use of deceptive trade symbols where such bodies as just mentioned may bring actions.

45. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.2 and 16.3 of the TRIPS Agreement are not nullified and impaired?*

The same applies as in the situation referred to in the reply to question 44 above.

46. *What procedures are foreseen in case of a conflict of a geographical indication with a trademark?*

See the reply to question 44 above.

G. ENFORCEMENT

47. *How are rights in the geographical indication enforced? Are provisions available under unfair competition law? Trademark law? Other laws? Provide citations to the laws and, if they have not been notified under Article 63.2 of the TRIPS Agreement, please provide copies.*

The procedures for the enforcement of rights in geographical indications are described in some detail in the document referred to in the reply to question 4 above. Essentially such protection is enforced through the provisions in the Marketing Act and the Trademark Act.

48. *Who has the right to enforce a geographical indication?*

As mentioned in the document referred to in the reply to question 4 above, the Consumer Ombudsman is entitled to bring actions concerning the use of false/misleading information concerning, for instance, geographical indications.

49. *What judicial or administrative bodies have jurisdiction over enforcement actions related to geographical indications? Are there fees involved and, if so, what are those fees?*

As mentioned above, measures in this respect are taken by the Stockholm City Court, upon action brought by the Consumer Ombudsman, and the decisions by the Stockholm City Court may be appealed against to the Market Court.

50. *Must the public be notified of the existence of a geographical indication and, if so, how and how often?*

There are no provisions on notifying the public about the existence of geographical indications.

51. *Is unauthorized use of a geographical indication subject to criminal action and, if so, describe the procedures. If the law has not been notified pursuant to Article 63.2 of the TRIPS Agreement, please provide a copy.*

The sanctions against violations of the Marketing Act are "Market Disruption Fees" of between 5,000 and 5 million Swedish Crowns, payable to the State, "Prohibition and Information Orders", "Compensation for Damages" and, finally "Orders to Eliminate Misleading Statements". Consequently there are, strictly speaking, no criminal sanctions, even if the market disruption fee to a certain extent has the same function.

H. INTERNATIONAL AGREEMENTS

52. *Is your government party to an international, including bilateral or plurilateral, agreement for the notification and/or registration of geographical indications? If so, please name the international agreement and explain the relationship between it and your national legislation.*

Sweden is not party to the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, but is party to the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods, which to a certain extent may offer protection to geographical indications. Sweden is of course also party to the TRIPS Agreement and the Paris Convention.

53. *What other international agreements, if any, have been entered into? What do those agreements provide?*

Sweden is not party to any other agreements in this area.

II. RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13/ADD.1

A. GENERAL (SECTION A OF DOCUMENT IP/C/13)

1. *Does your economy's industrial property law and/or related law prevent the use of geographical indications identifying wines or spirits against products not originating in the place indicated by the geographical indication, 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" or the like?*

There is in Swedish law no clear distinction between the various terms indicated in the question, nor are there any substantive criteria to distinguish these terms. Generally speaking, geographical indications are protected under the Marketing Act (Act 1995 No. 450), more specifically under the provisions prohibiting any claims or statements, in the course of a businessman's activities, for instance advertising, which are misleading as to the businessman's own or other businessmen's operations, especially concerning the nature, quantity, quality or other feature of the product or its origin, use and environmental or health effects. As indicated in the reply to question 8 under I above, this provision applies also to all kinds of misleading information about the geographical origin of the product or service.

B. DEFINITION AND CRITERIA FOR RECOGNITION (SECTION B OF DOCUMENT IP/C/13)

2. *Is there a clear distinction among the terms "geographical indications", "appellations of origin" and "indications of source" in your economy's industrial property law and/or related law, or are there any substantive criteria to distinguish these terms?*

As mentioned in the reply to question 2 under I above, a special regime exists concerning the marketing of alcoholic beverages in the Act (1978, No. 763) Containing Certain Provisions Concerning the Marketing of Alcoholic Beverages. That legislation prohibits any false or deceptive indication of origin through which the beverages are alleged to have been produced or manufactured in a foreign State (for instance a State Member of the WTO) or in a region or locality of the foreign State. This applies also where the true origin is indicated or where the indication is used only in translation or is accompanied by expressions such as "kind", "type", "style", "imitation" or similar expressions.

3. *Does your legislation contain criteria for homonymous geographical indications for wines and spirits?*

There are no specific provisions of the type indicated in the question. Rather, the availability of refusals of applications for registration (and of invalidation of a registration if granted) follows from other provisions in the Trademarks Act. Thus, a trademark may not be registered if the mark would violate the provisions of, for instance, the Marketing Act or the above-mentioned specific Act relating to alcoholic beverages. If registration has nevertheless been granted, that registration may be invalidated where the ground for non-registration still exists. Reference is made to the reply to question 44 under I above.

C. RELATIONSHIP TO TRADEMARKS (SECTION F OF DOCUMENT IP/C/13)

4. *Does your economy's industrial property law and/or related law provide the refusal or invalidation of a trademark registration, which consists of or contains geographical indications identifying wines or spirits with respect to such wines or spirits not originating in the indicated territory?*

The law does not contain any specific criteria for homonymous geographical indications for wines and spirits.

ANNEX FROM SWEDEN

PROTECTION OF GEOGRAPHICAL INDICATIONS IN SWEDEN

1. Generally speaking, protection of geographical indications in Sweden is provided under the Marketing Act (Swedish Statute Book 1995, No. 450, with later amendments). Specific provisions concerning the marketing of alcoholic beverages are contained in the Act Containing Certain Provisions Concerning the Marketing of Alcoholic Beverages (Swedish Statute Book 1978, No. 763, as amended by Act No. 1995, No. 453). Finally, provisions on trademarks are contained in the Trademarks Act (Swedish Statute Book 1960, No. 644, with later amendments). All those Acts have been notified to the TRIPS Council.

2. The substance of the protection provided under the Marketing Act is based on a catalogue of rules which set out provisions or requirements in respect of certain marketing measures. Generally speaking, all marketing must be compatible with good marketing practices and also in other respects be fair towards both consumers and businessmen. The catalogue just mentioned gives details about practices which are not acceptable from that point of view. That catalogue includes rules on

advertising identification, misleading advertising, misleading packaging sizes, misleading imitations, bankruptcy sales, clearance sales, bargain sales, unsolicited products and sales promotion offers. Of particular interest in the context of the protection of geographical indications are the provisions on misleading advertising, etc. which states that a businessman may not, in the course of marketing, make claims or other statements which are misleading as regards the businessman's own or other businessmen's operations, which rule applies especially to statements relating to the nature, quantity, quality or other features of the product or to its origin, use and environmental or health effects.

3. As regards more specifically alcoholic beverages, Article 5 of the above-mentioned Act of 1978, as amended in 1995, provides that in the course of marketing of such beverages false or deceptive indications may not be used, through which the beverages directly or indirectly are alleged to have been produced or manufactured in the foreign State, or in a region or locality in the foreign State. This applies also where the true origin is indicated or where the indication is used only in translation or is accompanied by expressions like "kind", "type", "style", "imitation" or similar expression. Acts which violate those provisions will be considered as inappropriate in relation to consumers and subject to prohibitions, etc. under the Marketing Act. Consequently, the procedures under the Marketing Act are available also for violations of those provisions.

4. The sanctions for violations of the Marketing Act include, in the first instance, that any person or company which intentionally or with carelessness contravenes any of the rules of the above-mentioned catalogue, may be ordered to pay, to the State, a so-called "market disruption fee" of between 5,000 and 5 million Swedish Crowns (corresponding roughly to between US\$800 and US\$80,000). In addition, prohibition and information orders (e.g. orders prohibiting marketing acts which would violate the Act and orders to provide such information which is especially important from a consumer perspective) may be issued, and the offender may be ordered to pay compensation for damages to those, including consumers, which have been injured by the acts in question, to eliminate misleading statements, etc.

5. The Act also contains provisions on the procedures for the imposition of sanctions for violations of the Act. First, proceedings concerning the imposition of a market disruption fee may be instituted at the Stockholm City Court (which is the District Court of Stockholm) by the Consumer Ombudsman. (The Consumer Ombudsman is a person, who must be a lawyer and who is, under the Marketing Act, appointed by the Government to deal with matters relating to marketing practices, contracts in consumer relations and product liability. He usually acts upon complaint from any interested party, who can obviously be a Swedish national or a foreigner, but may also act on his own initiative). If the Consumer Ombudsman in a particular case decides not to present an application for a market disruption fee, any businessman affected by the marketing and any association of such businessmen may institute such a proceeding. Furthermore, actions concerning prohibition orders (e.g. against the continuation of marketing acts which would violate the Act) may be instituted at the Stockholm City Court by the Consumer Ombudsman, by any businessman affected by the marketing and any association of consumers, businessmen or wage or salary earners. Also interim decisions may be issued by the Court while proceedings are pending. Finally, actions concerning the payment of damages may be instituted either at the Stockholm City Court or at any district court competent under the Code of Judicial Procedure. The Consumer Ombudsman has the authority to issue certain orders himself, primarily such which concern obligations for a businessman to provide information concerning such products and acts where a violation of the Marketing Act may occur. Such decisions by the Ombudsman may be appealed to the Stockholm City Court.

6. Any judgements and decisions by the Stockholm City Court or any other district Court may be appealed against to the Market Court. This Court is a specialized Court competent in, in addition to matters concerning the Marketing Act, also matters concerning unfair competition and matters relating to, for instance, product liability and contracts in consumer relations. The Market Court consists of a President and a Vice President, who must have experience as judges, and five special

members who must be economic experts. The Market Court is the final instance in, *inter alia*, matters relating to the application of the Marketing Act.

7. Article 14, first paragraph, of the Trademarks Act (Swedish Statute Book 1960, No. 644) provides that a trademark may not be registered in certain main situations which are set out in the Article, for example in case the mark is contrary to laws or regulations or public order; this is obviously the case where a mark would violate the provisions of the Marketing Act. In addition, Article 25 of the Trademarks Act provides that the registration of a mark may be invalidated in case a trademark has been registered contrary to the provisions of the Act and the ground for refusal still exists.

Responses from the United Kingdom

I. RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13

A. GENERAL

1. *Is protection for geographical indications provided through unfair competition law, e.g., passing off, false designation of origin; through a formal procedure for notification/registration before protection is available; or through both? Does the recognition of a geographical indication require registration?*

Protection of geographical indications is provided in the United Kingdom through various statutory instruments including the Trade Marks Act 1994, the Trade Descriptions Act 1968; through European Community law including EC Regulations No. 2081/92 (covering agricultural products and foodstuffs and providing for the registration of protected designations of origin (PDOs) and protected geographical indications (PGIs)), No. 1601/91 and No. 1576/89 as amended by Regulation No. 3378/94; and also through the common law tort of passing off. Registration of a geographical indication is sometimes necessary. Also EC Regulations No. 822/87, No. 823/87 and No. 2392/89 for wines.

2. *Is there one single regime of protection of geographical indications for all products? If not, identify the different regimes.*

A passing off action can be brought in respect of a geographical indication for any product. Similarly, action under the Trade Marks Act 1994 is possible in respect of any geographical indication that is registered except where protection is also sought through EC Regulation No. 2081/92 (covering agricultural products and foodstuffs). Protection for geographical indications for wines and spirits is available through EC Regulations No. 1601/91 (wines) and No. 1576/89 (spirits) as implemented in the United Kingdom by the Common Agriculture Policy (Wine) Regulations 1996 and the Spirits and Drinks Regulations 1990 and also through the Scotch Whisky Act 1988.

Protection under the Trade Descriptions Act 1968 is available to all products.

3. *Do(es) the regime(s) of protection of geographical indications also extend to services?*

Protection under the Trade Marks Act 1994 and under the common law tort of passing off is available for geographical indications for services.

The Trade Descriptions Act 1968 also applies to services.

4. *What provisions of law or regulations are directed to the recognition of geographical indications required by Articles 22.2 and 23.1 of the TRIPS Agreement? Citations to laws should be provided and, if the texts of the laws have not been notified to the WTO, copies should be provided pursuant to Article 63.2.*

The requirements of Articles 22.2 and 23.1 are met by the common law tort of passing off. Further legal means are provided under Section 3 of the Trade Descriptions Act 1968, Section 10 in particular of the Trade Marks Act 1994 and, in respect of Article 23.1 of the TRIPS Agreement, by Article 72a of Council Regulation No. 822/87, Article 40 of Council Regulation No. 2392/89, Article 3 of Council Regulation No. 2333/92, Article 11a of Council Regulation No. 1576/89 and Article 10a of Council Regulation No. 1601/91 as implemented in the United Kingdom by the

Common Agriculture Policy (Wine) Regulations 1996 (see especially Sections 3 and 5) and the Spirits Drinks Regulations 1990 (see especially Sections 2 and 3).

5. *If the required recognition of geographical indications is not provided through statutes or regulations, please explain, in detail, the mechanism or mechanisms through which the protection required is provided.*

A passing off action is brought in accordance with the procedures outlined in the United Kingdom's responses to the Checklist of Issues on Enforcement (IP/C/5).¹⁴

6. *Please provide a few examples of domestic geographical indications protected in accordance with the means discussed above and indicate the means by which such protection is provided.*

Relevant passing off cases

- Champagne: J. Bollinger v Costa Brava Wine Co. Ltd. [1960] RPC 16;
Taittinger SA v Allbey Ltd. [1993] FSR 641
- Scotch Whisky: John Walker and Sons Ltd. v Henry Ost and Co. Ltd. [1970] RPC 489.
- Swiss chocolate: Chocosuisse Union des Fabricants Suisses de Chocolat v Cadbury Ltd.
[1997] Times 25 November

Trademarks

Certification/collective marks:

- Stilton (cheese)
- Shetland (wool)

Protected designations of origin

Cheeses:

- Beacon Fell traditional Lancashire cheese
- Bonchester cheese
- Buxton blue
- Dovedale cheese
- Single Gloucester
- Swaledale cheese/Swaledale ewes' cheese
- White Stilton cheese/Blue Stilton cheese
- West Country Farmhouse Cheddar cheese

Fresh meat and offal:

- Orkney beef
- Orkney lamb
- Shetland lamb

Fruit, vegetables and cereals:

¹⁴ See document IP/N/6/GBR/1.

- Jersey Royal potatoes

Other products of animal origin:

- Cornish clotted cream

Protected geographical indications

Beer:

- Newcastle brown ale
- Kentish ale and Kentish strong ale
- Rutland bitter

Ciders:

- Gloucestershire cider/perry
- Herefordshire cider/perry
- Worcestershire cider/perry

Cheeses:

- Teviotdale cheese

Fresh fish, molluscs and crustaceans and products derived therefrom:

- Whitstable oysters

Fresh meat and offal:

- Scotch beef
- Scotch lamb

EU legislation

See responses from the EC reproduced in the present document.

7. *Is the higher level of protection required for wines and spirits under Article 23.2 of the TRIPS Agreement provided for any other product? If so, please specify such products and the law under which they are protected.*

The protection provided under the Trade Marks Act 1994 in respect of Article 23.2 is provided in respect of all geographical indications.

B. DEFINITION AND CRITERIA FOR RECOGNITION

8. *How are geographical indications defined?*

EC Regulation No. 3378/94 defines a "geographical designation" thus: "any indication identifying a product as originating in the territory of a third country which is a Member of the World Trade Organization, or in a region or locality of that territory, where a quality, reputation or other specific characteristic of that product can essentially be attributed to that geographical origin".

EC Regulation No. 2081/92 (covering agricultural products and foodstuffs) gives definitions for both designations of origin and geographical indications.

Geographical indications have not been defined for wines and spirits in the Community.

Neither the Trade Marks Act 1994 nor the Trade Descriptions Act 1968 provide a definition of geographical indication. However, detailed guidance is provided in the Trade Marks Registry Work Manual for trademark examiners on the acceptability of geographical indications for registration as trademarks.

9. *Would such a definition comprise geographical indications identifying products of a certain quality or reputation which are indirectly linked to a specific region?*

No.

10. *In determining whether recognition should be given a geographical indication, what criteria are considered?*

The requirements for registering a geographical indication as a trademark are the same as for any other trademark, except for certification marks and collective marks. Such marks allow the registration of geographical indications and they may be refused on the same grounds as ordinary trademarks and also if the public is liable to be misled in relation to the character or significance of the mark. Regulations governing the use of certification marks and collective marks must be provided by the applicants detailing *inter alia* the characteristics to be certified by the mark (certification marks). Detailed guidance is provided in the Trade Marks Registry Work Manual for trademark examiners on the acceptability of geographical indications for registration as trademarks.

Protected Geographical Indication (PGI) registration is open to products which must be produced or processed or prepared within a geographical area and have a reputation, features or certain qualities attributable to that area. Protected Designation of Origin (PDO) registration is open to products which are produced, processed and prepared within a particular geographical area, and with features and characteristics which must be due to the geographical area. The methods used to produce the product must be unique in that area. Most foods intended for human consumption can register including meat, dairy and fish products, fruits and vegetables, beer, beverages made from plant extracts, bread, pastries, cakes, biscuits and confectionery. Other products which can also be registered are as follows: natural mineral water and spring water, natural gums and resins, hay, essential oils (e.g. lavender oil). A name cannot be registered as a PGI or PDO if a similar trade mark already exists which, because of its reputation and renown or the length of time it has been used, might lead to confusion as to the true identity of the product, nor can a name that has become generic be registered as a PGI or PDO.

No specific criteria are used for wines and spirits in the United Kingdom. Most are long-standing and have long since been included in EU legislation. Any requests for new geographical indications would be examined on their merits and then put to the Commission.

11. *Is there any human creativity involved in the making of specific products under protection by the system of geographical indications? If so, how much? And do these products involve any human factors?*

Under the Trade Marks Act 1994, there is no evaluation of the characteristics of a geographical indication. This is also the case for PGI/PDO registrations.

Traditional conditions of production for wine and spirits take into account the human creativity involved in the making of a specific product and therefore include human factors.

12. *Are there any other intellectual property rights involved, such as patents for example?*

No.

13. *What authority, if any, may define the geographic region or area for which rights are claimed and on what basis is such definition made?*

No authority makes such a determination in respect of protection provided under the Trade Marks Act 1994, the Trade Descriptions Act 1968 and passing off. The specification of a trademark registration may be restricted as to the geographical area to which it applies.

For PGI and PDO registration, the geographical region or area in question must be defined in the application.

The Ministry of Agriculture, Fisheries and Food (MAFF) defines the geographical region subject to approval by the Commission for wines and the Agricultural Council for spirits and aromatized wines.

14. *Does your legislation contain criteria for homonymous geographical indications for wines?*

No.

15. *Does your national legislation provide for recognition and protection of geographical indications or appellations of origin for foreign countries?*

Yes. See also the answers to questions 1, 2 and 8 above.

16. *Is there any specific prohibition in the legislation/regulations/rules/procedures covering geographical indications not protected in the country of origin? If so, please specify the relevant statutory provision.*

The Common Agriculture Policy (Wine) Regulations 1996 and the Spirits Drinks Regulations 1990 provide enforcement of the EC Regulations which only provide protection if the geographical indication is protected in the country of origin. Otherwise no.

C. PROCEDURE FOR RECOGNITION

17. *With respect to any formal system for recognition of geographical indications, must the applicant be a governmental organization or can a private entity own the rights to a geographical indication?*

Applications for PGI and PDO registrations for foods must be put forward by groups of producers. Such groups may include other interested parties. However, individuals can put forward applications if:

- local and traditional methods and practices are used; and
- the geographical area has characteristics which differ from neighbouring areas; or
- the product has characteristics which are different to those of similar products.

Producers who are not part of the original applicant group, but who can show that their product conforms fully with the registered specification, may use the registered name.

A governmental organization must make the recognition for wine and spirits.

Private entities can own trademark rights.

18. *What are the competent authorities where the protection of a geographical indication can be obtained?*

Ministry of Agriculture, Fisheries and Food (MAFF) for foods and agricultural products (applications sent to European Commission for consideration), wines and spirit drinks.

United Kingdom Trade Marks Registry for trademarks. Also the Office for Harmonization of the Internal Market (OHIM) for Community trademarks.

19. *Do the procedures which lead to the recognition of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

Applications for PGI or PDO registrations must be put forward by groups of producers or, under certain circumstances, individuals.

Trademark owners must apply for registration of their marks.

Protection of geographical indications for wines and spirits takes place ex officio.

20. *What, if any, fees are involved in the application and maintenance of rights in a geographical indication?*

Application to register a trademark (covering one class of goods or service): £200; fee for each additional class of goods or service: £50; renewal of trademark registration: £200 (on the 10th anniversary of the filing date and every ten years after that); fee for each additional class of goods or services: £50; additional fee for late payment: £50.

All products registered as PGI or PDO will be subject to inspection to ensure that the requirements of the registered specification are met. Applicants must nominate an inspection body. Participants must meet the cost of inspections.

For wines and spirits there are no fees.

21. *If criteria must be set out in an application for recognition of a geographical indication, are those criteria purely geographic in nature?*

No.

There is no specific application procedure for wines and spirits.

See also the answer to question 10 above.

22. *What other criteria, if any, must be set out in an application for recognition of a geographical indication?*

Applications for PGI and PDO registrations must include *inter alia* an indication as to the category of the product, the main characteristics of the product (size, shape, flavour, etc.), the method of production, background information (including whether there have been any significant technological changes to the specification of the product in recent years and what they are) about the product and labelling information, if applicable.

Applications for the registration of trademarks must include, *inter alia*, a statement of the goods or services in relation to which it is sought to register the trademark as well as a specification of the class in Schedule 4 of the Trade Marks Rules 1995 to which it relates and a representation of the mark.

See also the answer to question 21 above.

23. *What information must be supplied in an application for rights in a geographical indication?*

Applications for PGI and PDO registrations must specify the product name; applicant details; names and addresses of group members, together with their connection to the product; a definition of the geographical area; an explanation of how that area differs from neighbouring areas (if applicable); whether the product is produced, processed, prepared or its raw materials originate in the defined area, and if not what other areas are involved; a list of raw materials and their source areas; a description of how the main characteristics are linked to the geographical area and influenced by its environment; whether the product and its specification are protected by any national or European certification schemes, specifying the schemes; the name of a nominated inspection body; these are in addition to the details listed in the answer to the previous question.

Further to the details in the answer to the previous question: trademark applicants must provide a request for registration of the trademark and the name and address of the applicant.

See also the answer to question 21 above.

24. *Must the goods or services with respect to which a geographical indication is claimed be set out?*

In applications for both PGI/PDO registrations and trademarks, the category or class of goods must be specified.

There is no recent experience in the wines and spirits sector. Geographical indications are generally long established and set out in the EC Regulations.

25. *What mechanisms are provided to oppose the recognition of a geographical indication? How is an investigation conducted after such a complaint?*

PGI/PDO: Article 7 of EC Regulation No. 2081/92 provides for opposition:

1. Within six months of the date of publication in the Official Journal of the European Communities referred to in Article 6(2), any member State may object to the registration.
2. The competent authorities of the member States shall ensure that all persons who can demonstrate a legitimate economic interest are authorized to consult the application. In addition and in accordance with the existing situation in the member States, the member States may provide access to other parties with a legitimate interest.

3. Any legitimately concerned natural or legal person may object to the proposed registration by sending a duly substantiated statement to the competent authority of the member State in which he resides or is established. The competent authority shall take the necessary measures to consider these comments or objection within the deadlines laid down.
4. A statement of objection shall be admissible only if it:
 - either shows non-compliance with the conditions referred to in Article 2;
 - or shows that the proposed registration of a name would jeopardize the existence of an entirely or partly identical name or trademark or the existence of products which are legally on the market at the time of publication of this Regulation in the Official Journal of the European Communities;
 - or indicates the features which demonstrate that the name whose registration is applied for is generic in nature.
5. Where an objection is admissible within the meaning of paragraph 4, the Commission shall ask the member States concerned to seek agreement among themselves in accordance with their internal procedures within three months. If:
 - (a) agreement is reached, the member States in question shall communicate to the Commission all the factors which made agreement possible together with the applicant's opinion and that of the objector. Where there has been no change to the information received under Article 5, the Commission shall proceed in accordance with Article 6(4). If there has been a change, it shall again initiate the procedure laid down in Article 7;
 - (b) no agreement is reached, the Commission shall take a decision in accordance with the procedure laid down in Article 15, having regard to traditional fair practice and of the actual likelihood of confusion. Should it decide to proceed with registration, the Commission shall carry out publication in accordance with Article 6(4).

Under Section 38(2) of the Trade Marks Act 1994, any person may give notice of opposition to a trademark within three months of the date on which an application is published, which notice must include a statement of the grounds for opposition. The applicant may make a counter-statement. The opponent must file evidence, after which the applicant may file evidence, following which reply evidence may be filed by the opponent; after this, additional evidence can only be filed at the discretion of the Registrar. The Registrar then comes to a decision, either on the evidence filed or at a hearing, which decision may be appealed.

There is no formal procedure for wines and spirits. Geographical indications are agreed through European Commission, European Council and WTO procedures when opportunities are provided for new indications to be challenged.

26. *Who can oppose the recognition of a geographical indication?*

See answer to the immediately preceding question.

27. *If your national legislation provides for recognition and protection of geographical indications or appellations of origin of foreign countries, what is the procedure that has to be followed in order to obtain such recognition and consequent protection?*

The United Kingdom recognizes PGIs and PDOs from other EU member States. Provision for the recognition of PGIs and PDOs from third countries is set out in Article 12 of Council Regulation No. 2081/92. Discussions on this provision by the appropriate Regulatory Committee have still to take place.

The procedure for registering trademarks is the same as that set out above.

For wines and spirits, such procedures are laid down at European Community level and enforced in the United Kingdom legislation.

D. MAINTENANCE

28. *How long does recognition for a geographical indication continue?*

There is no prescribed time-limit for PGI/PDO registrations. The right to use the registered name will be withdrawn from any producer no longer conforming to the registered product's specification, but recognition of the PGI/PDO registrations themselves continues.

There is also no prescribed time-limit for trademarks, provided renewal fees are paid.

Similarly, there are no prescribed time-limits for wines and spirits geographical indications.

29. *If recognition of a geographical indication must be renewed or reaffirmed, what information must be provided in order to effect such a renewal or reaffirmation? Specify any fees involved in renewal or reaffirmation.*

Renewal of trade mark registration: £200 (on the 10th anniversary of the filing date and every 10 years after that); fee for each additional class of goods or services: £50; additional fee for late payment: £50.

30. *Must a geographical indication be used in order to maintain rights? If so, how is such use determined?*

In general, a trademark may be revoked for non-use, if it has not been put to genuine use in the United Kingdom for an uninterrupted period of five years.

There is no requirement of use to maintain PGI/PDO registrations, nor for wines and spirits geographical indications.

31. *Is there a specified limit for non-use before rights in a geographical indication cease and, if so, what is that limit?*

See the answer to the immediately preceding question.

32. *Who monitors the use of geographical indications to determine if the criteria identified in the application continue to be met?*

Trademarks are not monitored by any one entity, simply by interested parties.

All products registered as PGI/PDO are subject to regular inspection to ensure that the requirements of the registered specification are met.

There are no criteria for wines and spirits geographical indications.

33. *If a government entity is responsible for monitoring the use of geographical indications, what are its procedures for doing so?*

No entity performs such monitoring other than for wines and spirits.

The Wine Standards Board (WSB) monitors labelling at wholesale and import/export level for wines. Local government authorities monitor spirits and the retail sector for wines on behalf of the Government.

34. *Are there means by which interested parties may request termination of a geographical indication based on non-use or failure to maintain the criteria identified in the application? Describe the procedure.*

A third party may apply for revocation of a trademark on the grounds of non-use, if it has not been put to genuine use in the United Kingdom for an uninterrupted period of five years. The onus is on the party applying for revocation to show non-use.

In the case of PGI/PDO registrations, Article 11 of Council Regulation No. 2081/92 lays down procedures whereby member State(s) may submit to the member State concerned that a condition laid down in a PGI/PDO specification has not been met. If the member State(s) fail to reach an agreement on the matter, it is referred to the European Commission for a decision.

Not applicable to wines and spirits.

35. *Do the procedures which lead to forfeiture of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

A trademark may be revoked or declared invalid on a number of grounds following an application by any person, i.e. such action is not ex officio. However, a trademark will be removed from the Register if a renewal is not made.

PGI/PDO registrations are not forfeited following ex officio procedures.

Not applicable to wines and spirits (see answers to questions 28 to 31 above).

E. SCOPE OF RIGHTS AND USE

36. *May anyone who meets the criteria submitted to obtain recognition of a geographical indication use that geographical indication after recognition is given or must additional criteria or procedures be followed by that party before use is permitted?*

Only the owner, or those to whom he gives authorization, may use a trademark.

Producers who are not part of the original applicant group, but who can show that their product conforms fully with a registered PGI/PDO specification, may use the registered name.

Since requests are made ex officio, any product conforming to a geographical indication for wines or spirits may use the name.

37. *Who makes the determination regarding use of a geographical indication by particular parties, the entity responsible for the recognition or the entity that obtained the recognition?*

The entity that obtained the recognition.

Geographical indications for wines and spirits are set up ex officio. Once established they are policed by the Wines Standards Board (WSB) and local government authorities. However, it is open to individuals or trade associations to complain to the Ministry of Agriculture, Fisheries and Food (MAFF) or to take civil action, if they believe a geographical indication is being misused.

38. *Are there fees involved in receiving authorization to use a particular geographical indication and, if so, what are those fees and how are they established?*

The conditions of use, including fees, of a trademark by an authorized user are a matter for that user and the mark owner.

There are no fees for wines or spirits.

39. *If there is a dispute regarding use of a geographical indication by a particular party, what procedures are followed to resolve it?*

A passing off action is brought in accordance with the procedures outlined in the United Kingdom's responses to the Checklist of Issues on Enforcement (IP/C/5).¹⁵

Infringement proceedings may be undertaken in the civil courts by the proprietor of a trademark.

Where EC regulations have been contravened, the competent authorities may prosecute.

40. *Must individual authorized users of a geographical indication use that geographical indication continually to retain their right to use it and, if so, how is their use determined and how long will disuse be permitted?*

A third party may apply for revocation of a trademark on the grounds of non-use, if it has not been put to genuine use in the United Kingdom for an uninterrupted period of five years.

The right to continue to use PGI/PDO designations is dependent on the producer continuing to conform to the registered product's specification.

There is no condition of use for wine and spirits indications.

41. *If there is a dispute over continuity of use by a particular party, how is it resolved?*

Under Section 46(1) of the Trade Marks Act 1994, any person may apply for revocation of a trademark, which notice must include a statement of the grounds for revocation. The proprietor may make a counter-statement and is obliged to file evidence of the use of his trademark on which he intends to rely. The applicant for revocation must file evidence, after which the proprietor may file evidence, following which reply evidence may be filed by the applicant for revocation; after this, additional evidence can only be filed at the discretion of the Registrar. The Registrar then comes to a decision, either on the evidence filed or at a hearing, which decision may be appealed.

¹⁵ See document IP/N/6/GBR/1.

See the answer to immediately preceding question.

42. *Does the regime for protection of geographical indications allow geographical indications to be licensed and, if so, what conditions are imposed on such licences? If such conditions are not met, what is the effect on the geographical indication?*

Trademarks may be licensed in accordance with Section 28 of the Trade Marks Act 1994. The conditions of such licences are matters for the parties concerned.

There is no provision for the licensing of PGI or PDO designations, nor for wines and spirits indications.

43. *How is "grandfathered use" of a geographical indication, under Article 24.4 of the TRIPS Agreement, applied in your country?*

EC regulations apply and are enforced through United Kingdom legislation.

F. RELATIONSHIP TO TRADEMARKS

44. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.1 of the TRIPS Agreement are not nullified and impaired?*

Article 14 of EC Regulation No. 2081/92 sets out the relationship between PGI/PDO designations and trade marks:

1. Where a designation of origin or geographical indication is registered in accordance with this Regulation, the application for registration of a trademark corresponding to one of the situations referred to in Article 13 and relating to the same type of product shall be refused, provided that the application for registration of the trademark was submitted after the date of the publication provided for in Article 6(2).

Trademarks registered in breach of the first subparagraph shall be declared invalid. This paragraph shall also apply where the application for registration of a trademark was lodged before the date of publication of the application for registration provided for in Article 6(2), provided that the publication occurred before the trademark was registered.

2. With due regard for Community law, use of a trademark corresponding to one of the situations referred to in Article 13 which was registered in good faith before the date on which application for registration of a designation of origin or geographical indication was lodged may continue notwithstanding the registration of a designation of origin or geographical indication, where there are no grounds for invalidity or revocation of the trademark as provided respectively by Article 3(1)(c) and (g) and Article 12(2)(b) of the First Council Directive No. 89/104/EEC of 21 December 1988 to approximate the laws of the member States relating to trademarks.

3. A designation of origin or geographical indication shall not be registered where, in the light of a trademark's reputation and renown and the length of time it has been used, registration is liable to mislead the consumer as to the true identity of the product.

Efforts are made within the United Kingdom Trade Marks Registry to meet these requirements on registration.

Not applicable to wines and spirits indications.

45. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.2 and 16.3 of the TRIPS Agreement are not nullified and impaired?*

See the answer to the immediately preceding question.

46. *What procedures are foreseen in case of a conflict of a geographical indication with a trademark?*

The normal court and administrative procedures that are available for trademark disputes. See also the answer to question 44 above.

G. ENFORCEMENT

47. *How are rights in the geographical indication enforced? Are provisions available under unfair competition law? Trademark law? Other laws? Provide citations to the laws and, if they have not been notified under Article 63.2 of the TRIPS Agreement, please provide copies.*

A passing off action is brought in accordance with the procedures outlined in the United Kingdom's responses to the Checklist of Issues on Enforcement (IP/C/5).¹⁶

A trademark proprietor may bring an action in the civil courts.

Local weights and measures authorities enforce the Trade Descriptions Act 1968.

Enforcement of the EU legislation on PDOs and PGIs will be the responsibility of Trading Standards Officers. A Statutory Instrument providing for these enforcement powers is being drafted.

In the wines and spirits sector, European Community legislation on geographical indications is enforced by the Wine Standards Board (WSB) and local government authorities, who may ultimately pursue cases through the criminal courts. Individuals are also free to pursue cases through the civil courts.

48. *Who has the right to enforce a geographical indication?*

See the answer to the immediately preceding question.

49. *What judicial or administrative bodies have jurisdiction over enforcement actions related to geographical indications? Are there fees involved and, if so, what are those fees?*

The civil courts (see also answers to previous questions).

50. *Must the public be notified of the existence of a geographical indication and, if so, how and how often?*

No. In the case of PGIs and PDOs, the public is notified of registrations by publication in the Official Journal of the European Communities. Summary sheets for registered PGIs and PDOs are also published on the Internet.

There is no onus on member States to publish lists of geographical indications for wines and spirits, but the European Community publishes all approved geographical indications in its Official Journal.

¹⁶ See document IP/N/6/GBR/1.

51. *Is unauthorized use of a geographical indication subject to criminal action and, if so, describe the procedures. If the law has not been notified pursuant to Article 63.2 of the TRIPS Agreement, please provide a copy.*

Sections 92, 94, 95 and 99 of the Trade Marks Act 1994 set out certain criminal offences in relation to trademarks.

See also answers to questions 47 to 49 above.

H. INTERNATIONAL AGREEMENTS

52. *Is your government party to an international, including bilateral or plurilateral, agreement for the notification and/or registration of geographical indications? If so, please name the international agreement and explain the relationship between it and your national legislation.*

No.

53. *What other international agreements, if any, have been entered into? What do those agreements provide?*

None.

II. RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13/ADD.1

A. GENERAL (SECTION A OF DOCUMENT IP/C/13)

1. *Does your economy's industrial property law and/or related law prevent the use of geographical indications identifying wines or spirits against products not originating in the place indicated by the geographical indication, 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" or the like?*

Article 13 of EC Regulation No. 2081/92 (relating to foods and agricultural products) provides that registered names shall be protected *inter alia* against any misuse, imitation or evocation, even if the true origin of the product is indicated or if the protected name is translated or accompanied by an expression such as "style", "type", "method", "as produced in", "imitation" or similar.

United Kingdom legislation provides for enforcement of the EC regulations covering this point in relation to wines and spirits indications.

B. DEFINITION AND CRITERIA FOR RECOGNITION (SECTION B OF DOCUMENT IP/C/13)

2. *Is there a clear distinction among the terms "geographical indications", "appellations of origin" and "indications of source" in your economy's industrial property law and/or related law, or are there any substantive criteria to distinguish these terms?*

EC Regulation No. 2081/92 (covering agricultural products and foodstuffs) distinguishes between Protected Designation of Origin (PDO) and Protected Geographical Indication (PGI).

United Kingdom legislation for wines and spirits does not define these terms. However, it provides for enforcement of EC definitions. See also the answer to question 8 under I above.

3. *Does your legislation contain criteria for homonymous geographical indications for wines and spirits.*

See the answer to question 14 under I above.

C. RELATIONSHIP TO TRADEMARKS (SECTION OF DOCUMENT IP/C/13)

4. *Does your economy's industrial property law and/or related law provide the refusal or invalidation of a trade mark registration, which consists of or contains geographical indications identifying wines or spirits with respect to such wines or spirits not originating in the indicated territory?*

Sections 3(3)(b) and 46(1)(d) of the Trade Marks Act 1994 allow for refusal or revocation of a trademark that is liable to deceive or mislead the public.

United Kingdom legislation provides for enforcement of the EC regulations covering this point in relation to wines and spirits indications.
