

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

Checklist of Questions¹

Responses from New Zealand

Addendum

The Secretariat has received the following responses from the Permanent Mission of New Zealand in a communication dated 1 December 1998.

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

A. GENERAL

1/2/3. 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? Is there one single regime of protection of geographical indications for all products? If not, identify the different regimes. Do(es) the regime(s) of protection of geographical indications also extend to services?

Protection for geographical indications is provided through the Trade Marks Act 1953, the Fair Trading Act and the common law action of "passing off". Section 9 of the Fair Trading Act states that no person shall, in trade, engage in conduct that is misleading or deceptive or is likely to mislead or deceive.

In order to provide for a registration system for geographical indications, the Geographical Indications Act 1994 was passed. This Act provides for the registration and protection of geographical indications in relation to "specified goods". These are those classes of goods declared by the Regulations under the Geographical Indications Act. The Geographical Indications Act is not yet in force and must be brought into force by an Order of Council. The Geographical Indications Regulations enacted under the Geographical Indications Act will prescribe any forms to be used for the purposes of the Act. They will also specify the manner in which applications and determinations under the Act must be published, criteria to which a Geographical Indications Committee must have

¹ Documents IP/C/13 and IP/C/13/Add.1

regard in determining a geographical indication and any fees payable. The Geographical Indications Regulations are currently being drafted.

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*

Section 9 of the Fair Trading Act and Section 4(2) of the Geographical Indications Act apply. Section 9 of the Fair Trading Act states that no person shall, in trade, engage in conduct that is misleading or deceptive or is likely to mislead or deceive. Section 4(2) of the Geographical Indications Act provides that, where a person, in trade, uses, in relation to a specified good a protected geographical indication, whether used:

- (i) together with the true geographical origin of the goods;
- (ii) in translation; or
- (iii) accompanied by any of the words "kind", "type", "style" or "imitation", or any similar word or expression;

and the goods did not originate in the geographical origin to which the protected geographical indication relates, that person will be in breach of Section 9 of the Fair Trading 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.*

See response to questions 1-3 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.*

"New Zealand" (being the North Island, South Island, Chatham Islands), and every region of New Zealand from time to time, shall be deemed to be a geographical indication protected under the Geographical Indications Act. These New Zealand geographical indications will be given automatic protection under the Geographical Indications Act.

It should be emphasized that "New Zealand" as a whole qualifies as a protected geographical indication under the Geographical Indications Act.

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 response to questions 1-3 above. The protection available under the Geographical Indications Act applies in relation to "specified goods". These are declared by the Regulations under the Geographical Indications Act. In developing these Regulations, New Zealand is, of course, mindful of international obligations under the WTO Agreements.

B. DEFINITION AND CRITERIA FOR RECOGNITION

8. *How are geographical indications defined?*

The Geographical Indications Act 1994 defines "geographical indications" as meaning "a description or presentation used to indicate the geographical origin of the goods". "Geographical origin" means any country, region, locality or linear feature.

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 the Geographical Indications Act 1994 clearly links the "specified good" to its geographical origin. It is noteworthy also that Article 22.1 refers to a situation in which a given quality, reputation or other characteristic of a good must be "essentially attributable" to its geographical origin.

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

The criteria will be prescribed by regulations that are currently being drafted.

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?*

Not applicable.

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

The Trade Marks Act. See the response to question 1 above.

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?*

Under the Geographical Indications Act, a Geographical Indications Committee shall determine an application to register a geographical indication relating to a geographical origin in New Zealand. The Committee must have regard to certain factors in making such a determination. See the response to question 10 above.

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

Section 8(3)(a) of the Geographical Indications Act implements Article 23(3) of the TRIPS Agreement. The provision provides that the Registrar of Geographical Indications shall specify the conditions if any applying to the geographical indication. A condition may specify when a homonymous geographical indication can be used.

15/16. *Does your national legislation provide for recognition and protection of geographical indications or appellations of origin of foreign countries? 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.*

Section 9(1)(a)(ii) of the Geographical Indications Act provides for registration of geographical indications or appellations of origin of foreign countries notified under a bilateral or multilateral agreement requiring the protection of geographical indications. Although there is no specific prohibition against the registration of geographical indications not protected in the country of origin, in practice, as New Zealand will only register foreign geographical indications notified to it under a bilateral or multilateral agreement, it is unlikely that geographical indications would be registered which are not protected 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?*

In relation to a geographical indication inside New Zealand, a private entity may make an application for the protection of that geographical indication under the Geographical Indications Act.

See the response to question 15 above for registration of foreign geographical indications.

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

In respect to a geographical indication within New Zealand, an application for registration of that geographical indication may be made to the Surveyor-General in accordance with the Regulations made under the Act.

See the response to question 15 above for registration of foreign geographical indications.

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 Geographical Indications Act only protects those geographical indications that are registered under the Act. To obtain recognition there must be an application lodged by an entity or person.

In relation to the registration of a geographical indication inside New Zealand, any person may make an application to the Surveyor-General for the registration of a geographical indication inside New Zealand. The Surveyor-General then appoints a Geographical Indications Committee to make a determination in respect of the application. A determination of the application by a Committee is made in accordance with the Regulations made under the Act.

See the response to question 15 above for registration of foreign geographical indications.

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

Any fees involved in the application and maintenance of rights in a geographical indication will be prescribed by regulation.

It is proposed that the fees will be payable to the Registrar of Protected Geographical Indications for:

- Submitting a geographical indication for registration on the Register of Protected Geographical Indications.
- Notifying the Registrar of an alteration or removal of a protected geographical indication.
- Inspecting the Register.
- Obtaining a certified copy of particulars on the Register.

It is proposed that fees also be payable to the Surveyor-General for:

- Application to determine a geographical indication relating to a geographical indication in New Zealand.
- Application to determine two or more geographical indications the geographical origins of which are in New Zealand and are contiguous.
- Application to alter a protected geographical indication relating to a geographical origin in New Zealand.
- Application to remove from the Register a protected geographical indication relating to a geographical origin in New Zealand.
- Application to the New Zealand Geographic Board to review a determination of a Geographical Indications Committee.

21/22/23. 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?

See the response to question 10 above.

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

The "specified goods" to which an application relates must be set out in the application for the determination of a geographical indication. See also the response to questions 1-3 above.

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

In relation to a geographical indication within New Zealand, any person who is dissatisfied with a determination may apply to the New Zealand Geographic Board for a review of the determination of a geographical indication. This application may be made any time within 15 working days after the date of publication of notice of the determination by the Geographical Indications Committee. This application must be in the form prescribed by the Regulations.

Once an application for review has been received, the Board shall review the determination of the Geographical Indications Committee and may reverse, alter, or confirm it. The Board in making its decision must have regard to natural justice.

Once a decision has been made the Board must publish its decision.

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

See the response 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?*

See the response to question 15 above.

D. MAINTENANCE

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

Indefinitely. However, an application may be made to have the geographical indication altered or removed from the Register of Protected 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.*

Not applicable. See the response to question 28 above.

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

No. Protection of the geographical indication in relation to the specified goods is granted through registration.

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

Not applicable.

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

Not applicable.

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

Not applicable.

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?*

An application for removal or amendment of a registered geographical indication in relation to a geographical indication inside New Zealand may be made in accordance with the Regulations.

Once an application for removal or amendment is made, a Geographical Indications Committee considers the application, and the Registrar of Geographical Indications acts on the basis of that determination.

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?*

Any interested party may make an application for the removal or amendment of a registered domestic geographical indication.

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?*

Anyone whose specified goods originate within the registered geographical indication may use that geographical indication. There are no additional criteria or procedures imposed on the use of a geographical indication.

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 response to question 36 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?*

Not applicable.

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

The Geographical Indications Act provides that if a person uses a protected geographical indication and the goods did not originate in the geographical origin to which the protected geographical indication relates, the person shall be deemed to have contravened Section 9 of the Fair Trading Act.

The relevant provision in the Fair Trading Act states that no person shall, in trade, engage in conduct that is misleading or deceptive or that is likely to mislead or deceive. Therefore, under the Geographical Indications Act, if someone is deemed to have contravened this provision under the Fair Trading Act, an interested party may apply to the High Court of New Zealand for an injunction restraining the offender from using the protected geographical indication in a misleading or deceptive manner.

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 response to question 30 above.

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

Not applicable.

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 Geographical Indications Act is silent as to whether geographical indications can be licensed. However, as the use of a geographical indication in relation to specified goods must be by someone in the geographical origin protected by the geographical indication it is unlikely that a geographical indication could be licensed.

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

Section 5(3)(a) and (b) of the Geographical Indications Act allow the use of a protected geographical indication, in relation to specified goods under the Act, if the goods were produced, or being produced, before the registration of the protected geographical indication, or the goods were declared to be specified goods.

Section 5(2)(c) of the Geographical Indications Act also provides a grandfather provision in relation to the use of trademarks registered before goods became specified goods under the Act.

F. RELATIONSHIP TO TRADEMARKS

44/45. *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?*

See the responses to questions 43 above and 46 below.

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

Section 5(2)(c) of the Geographical Indications Act provides that the use, in relation to specified goods, of a trademark, applied for or registered under the Trade Marks Act 1953, if the trademark was applied for, registered, or used in New Zealand in good faith in relation to goods of the same class, before goods of that class were declared to be specified goods, is not restricted. This provision creates a grandfather provision for the use of trademarks.

A party is also prevented from obtaining as a registered trademark containing a geographical indication that is protected under the Geographical Indications Act. Under Section 16 of the Trade Marks Act 1953, it is not lawful to register as a trademark any matter the use of which would be likely to deceive or cause confusion, or would be contrary to law. An application to register a protected geographical indication as a trademark would be considered to be covered by either or both of these provisions.

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 responses to questions 1-4 above. The Fair Trading Act provides for the legal means for interested parties to prevent the misuse of a geographical indication. An interested party may apply to the High Court for an injunction restraining use of a protected geographical indication in a misleading or deceptive manner. If the geographical indication is also registered as a trademark, then rights may be enforced under the Trade Marks Act.

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

Any interested party has the right to enforce a geographical indication.

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?*

Enforcement of a geographical indication occurs under the Fair Trading Act. The High Court of New Zealand has the jurisdiction to hear claims for injunctive relief for the misleading or deceptive use of a geographical indication.

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

Where an application for the registration, amendment or removal of a geographical indication has been forwarded to a Geographical Indications Committee for a determination, that Committee shall publish, on the payment by the applicant of any fees prescribed by Regulations, a copy of the application, a statement of what the Committee is required to determine, and a statement inviting written submissions on the application to be made to the Committee.

Once a determination has been made, the Committee shall publish the result of the determination on payment of any prescribed fees.

Any person may have access to the Register for the purpose of inspecting it during each working day at such times as the Registrar shall determine. A fee may be imposed for this service by the Regulations. Copies and certified copies of any particulars in the Register may also be obtained.

51. *Is unauthorized use of a geographical indication subject to criminal action and, if so, describe the procedures.*

Enforcement of a geographical indication is by civil action.

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?*

No.

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 response to question 4 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?*

- The Geographical Indications Act defines "geographical indication" as meaning "a description or presentation used to indicate the geographical origin of the goods".
- "Geographical origin" is defined in the Geographical Indications Act as meaning a country, region, locality or linear feature.
- See the response to question 8 under I above.

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

See the response 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 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 response to question 46 under I above.
