

**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 Australia

Addendum

The present document represents the responses to the Checklist which the Secretariat has received from Australia, by means of a communication from its Permanent Mission, dated 21 April 1999.

I. INTRODUCTION

Australia's detailed responses to the Checklist are provided below. The following notes provide a brief overview of the Australian framework for protection of geographical indications and an explanation of its underlying principles.

Geographical indications are protected in Australia by a variety of specific and general legislative provisions under both State and Commonwealth Acts, the Australia New Zealand Food Authority (ANZFA) food standards and the common law. The Australian regime is underpinned by the need to ensure effective protection against unfair competition, as provided and defined under Article 10*bis* of the Paris Convention (1967), and explicitly referred to in Article 22.2(b) of the TRIPS Agreement.

The legislative, common law and other avenues available to recognize and protect geographical indications in Australia creates a system that is TRIPS-consistent, fair, flexible and not resource-intensive. Foreign and domestic parties alleging misuse of a given geographical indication have a range of options available to pursue their claims. The system is not dependent on the ability of an interested party to point to the appearance of the geographical indication on any official list or register, but rather on demonstrating that use of that geographical term in the circumstances of the case constitutes an act of unfair competition. The available provisions protect against unfair competition in a variety of ways. They include, for example, prohibitions on:

- conduct which misleads or deceives, or is likely to mislead or deceive the public;
- false or misleading claims about the place of origin of goods; and

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

- conduct which is liable to mislead the public as to, *inter alia*, the nature, characteristics, or suitability for their purpose of any goods or services.

If a party alleges misuse of a geographical indication, that party is able to choose the most appropriate means of pursuing protection from a variety of available avenues. Whichever of the available provisions the party chooses to use, the decision-making process will be based on an assessment, as provided under the TRIPS Agreement, of whether the circumstances of the alleged misuse either mislead the public as to the geographical origin of the good, or amount to an act of unfair competition. If they are found to breach either of these rules, there is a variety of remedies and means of enforcement available to ensure that the intellectual property right is protected. The system therefore gives practical effect to TRIPS obligations in a balanced, pragmatic and equitable way.

The desirability of the Australian system lies in its efficiency and flexibility, and direct orientation towards ensuring that the rights of parties with legitimate claims to geographical indications are protected. Accordingly, parties are required to expend time and resources only in the event of an actual claim of misuse. As there are no formally regulated procedures for registering geographical indications (with the exception of wine), there is no danger of available databases becoming outdated. In this way, the system deals easily with the evolution of new geographical indications over time.

II. 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 Australia, geographical indications are protected by a combination of the Australian Wine and Brandy Corporation Act 1980 (Cth), the trademarks legislation (Trade Marks Act 1995 (Cth)), the trade practices legislation (Trade Practices Act 1974 (Cth)), truth in labelling legislation, e.g. the Commerce Trade Descriptions Act 1905, the common law tort of passing off, the state and territory Food Acts, Australia New Zealand Food Authority (ANZFA) Labelling and Advertising Standard, the Australian Food Standards Code Spirit Standard ("P3": note that a joint Australia-New Zealand (ANZFA) spirit standard is pending. The current draft of this includes a provision on geographical indications which is identical to that in the current standard) and the Fair Trading Acts of the Australian states and territories. Of these, only the Australian Wine and Brandy Corporation Act 1980 provides for a formal registration procedure for geographical indications.

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

Australia has a number of different regimes (see answer to question 1) for protecting geographical indications. The trademarks legislation, the trade practices legislation, the common law tort of passing off and the state Fair Trading Acts supply protection for all products. The state and territory Food Acts supply protection for all foods (e.g. NSW Food Act 1989, sections 9 and 8(m)), and the ANZFA standard for labelling and advertising requires that a trade name shall not "give a false or misleading indication of the origin, character or place of manufacture of a food". The Australian Wine and Brandy Corporation Act 1980 only provides protection for wine and grape products, and the Australian Food Standards Code Spirit Standard (P3) only for spirits.

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

Yes except for the Australian Wine and Brandy Corporation Act 1980 and Australian Food Standards Code Spirit Standard (P3).

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 relation to Article 22.2, there is no specific law dealing with unfair competition. Australia's obligations are met by the Trade Practices Act 1974 (sections 52 [prohibits conduct by business which is misleading or deceptive, or which is likely to mislead or deceive], 53(eb) [prohibits false claims about the place of origin of goods], 55 [prohibits a corporation from engaging in conduct which is liable to mislead the public as to the nature, manufacturing process, the characteristics, the suitability for their purpose or the quantity of any goods] and 55A [prohibits a corporation from engaging in conduct which is liable to mislead the public about the nature, the characteristics, the suitability for their purpose or the quantity of any services]), the equivalent provisions of the states' and territories' fair trading legislation (i.e. Fair Trading Acts of the Australian Capital Territory (1992), New South Wales (1987), South Australia (1987), Queensland (1989), Victoria (1985), Tasmania and Western Australia (1987), and the Consumer Affairs and Fair Trading Act, Northern Territory), the common law provisions of passing off and truth in labelling legislation (e.g. the Commerce Trade Descriptions Act 1905).

Obligations in respect of Article 23.1 are met by the Australian Wine and Brandy Corporation Act 1980 (sections 40C-D), the Australian Food Standards Code Spirit Standard (clause 12(g)(i)), the Trade Practices Act 1974, the common law provisions of passing off, states' and territories' fair trading legislation and truth in labelling legislation.

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.*

Definition and registration of geographical indications for wine are secured through the AWBC Act. Protection of unregistered geographical indications for all other goods and services is provided by common law, and by the activation of the various legislative provisions cited 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.*

As regards geographical indications for wine: "Adelaide Hills", "Langhorne Creek", "McLaren Vale", "Great Southern", "Orange" and "Hilltops". These geographical indications have been defined in accordance with the AWBC Act and have been entered into Part (a) of the Register of Protected Names. The Register is established and maintained in accordance with the AWBC Act (Section 40ZC). "Coonawarra" is not yet defined and usage must therefore be in accordance with common law guidelines.

Geographical indications for products other than wines are not protected via a formal registration system. If a party alleged false use of a geographical indication, they could invoke the various legislative provisions and/or common law measures detailed 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.*

Under the provisions of the Trade Marks Act 1995, a trademark in respect of any goods may be refused or invalidated on the basis that it contains or consists of a sign that is a geographical indication (see sections 61(1) and 88).

B. DEFINITION AND CRITERIA FOR RECOGNITION

8. *How are geographical indications defined?*

Section 6 of the Trade Marks Act 1995, section 4 of the Australian Wine and Brandy Corporation Act 1980 and the Australian Food Standards Code Spirit Standard (P3) all contain definitions for geographical indications.

Trade Marks Act 1995:

"'geographical indication', in relation to goods originating in a particular country or in a region or locality of that country, means a sign recognised in that country as a sign indicating that the goods:

"(a) originated in that country, region or locality; and

"(b) have a quality, reputation or other characteristic attributable to their geographical origin."

Australian Wine and Brandy Corporation Act 1980:

"'geographical indication', in relation to wine, means:

"(a) a word or expression used in the description and presentation of the wine to indicate the country, region or locality in which the wine originated; or

"(b) a word or expression used in the description and presentation of the wine to suggest that a particular quality, reputation or characteristic of the wine is attributable to the wine having originated in the country, region or locality indicated by the word or expression."

Australian Food Standards Code Spirit Standard (P3)

Clause 12(g)(i):

"For the purpose of this subclause a 'geographical indication' is any indication, whether express or implied, which identifies a spirit as originating in a particular country, locality or region, where a given quality, reputation or other characteristic of the spirit is essentially attributable to its origin in that particular country, locality or region."

In addition, Regulation 25 of the Australian Wine and Brandy Corporation Regulations contains criteria for determining geographical indications for wines.

Note also that, under section 5D of the Australian Wine and Brandy Corporation Act and section 15 of the Trade Marks Act 1995, a wine is taken to have originated in a foreign country or Australia, only if the wine is made within the territory of that country or in Australia, and the wine is

taken to have originated in a particular region or locality only if the wine is made from grapes grown in that region or locality.

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

For wines, neither "Quality" nor "Reputation" are descriptives contained within the criteria for determining geographical indications, outlined in Regulation 25 of the AWBC Regulations. There may be an expectation of quality or reputation associated with some wine geographical indications, however, they are consumer expectations only, established over time.

For spirits, the definition contained in the Australian Food Standards Code Spirit Standard (P3) incorporates the notion of quality or reputation, and includes any indication, either express and implied. It would therefore probably include geographical indications indirectly linked to a specific region, though this has never been tested.

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

The criteria used in determining a geographical indication for wine, as per Regulation 25 of the AWBC Regulations are:

- (a) Whether the area falls within the definition of a sub-region, a region, a zone or any other area;
- (b) The history of the founding and development of the area, ascertained from local government records, newspaper archives, books, maps and other relevant material;
- (c) The existence in relation to the area of natural features, including rivers, contour lines and other topographical features;
- (d) The existence in relation to the area of constructed features, including roads, railways, towns and buildings;
- (e) The boundary of the area suggested in the application to the Committee under section 40R;
- (f) Ordinance survey map grid references in relation to the area;
- (g) Local government boundary maps in relation to the area;
- (h) The existence in relation to the area of a word or expression to indicate that area, including:
 - Any history relating to the word or expression; and
 - Whether, and to what extent, the word or expression is known to wine retailers beyond the boundaries of the area; and
 - Whether, and to what extent, the word or expression has been traditionally used in the area or elsewhere; and
 - The appropriateness of the word or expression;

- (i) The degree of discreteness and homogeneity of the proposed geographical indication in respect of the following attributes:
- The geographical formation of the area;
 - The degree to which the climate of the area is uniform, having regard to the temperature, atmospheric pressure, humidity, rainfall, number of hours of sunshine and any other weather conditions experienced in the area throughout the year;
 - Whether the date on which harvesting a particular variety of wine grapes is expected to begin in the area is the same as the date on which harvesting grapes of the same variety is expected to begin in neighbouring areas;
 - Whether part or all of the area is within a natural drainage basin;
 - The availability of water from an irrigation scheme;
 - The elevation of the area;
 - Any plans for the development of the area proposed by Commonwealth, State or municipal authorities;
 - Any relevant traditional divisions within the area;
 - The history of grape and wine production in the area.

[NB: In determining a geographical indication under subsection 40Q(1) of the Act, the Committee is not prohibited under the Act from having regard to any other relevant matters.]

The definition of "region", "subregion", "wine grape vineyard" and "zone" are contained in Regulation 24 of the AWBC Regulations.

Wine is the only product for which there are formalized legislative criteria for determining whether recognition should be given to a geographical indication. For other products, this determination would depend on the terms of the legislative provision on which an aggrieved party relied to oppose an allegedly false use of a particular geographic term. In most cases there will be no need for a specific determination that a particular term is a geographical indication. The level of protection required under the TRIPS Agreement will be provided by proving the elements provided for by the legislative provisions. For example, under the Trade Practices Act, a party would obtain protection for a particular geographic term by demonstrating that use of that term by another party is misleading or deceptive, in that it suggests that the product originates from a place or region that it does not. There would not necessarily be a decision to recognize that term as a geographical indication *per se*.

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?*

Australia would submit that development of the practices according to which wine is made, while a scientifically-based activity, does also involve a degree of human creativity. The implementation of these practices in actually making the wine would not necessarily attribute to the end wine product any additional "human factors" above and beyond the creativity used to develop the wine-making practice itself.

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

In Australia, there are patents for wine making and the processes involved in wine making. Trademark protection is available for the goods, for the shape of the containers and for any aspects of packaging. Any labels would be protected by copyright and design protection could be sought for the appearance of the goods or their packaging.

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?*

In the case of wine, under the Australian Wine and Brandy Corporation Act 1980, the Geographical Indications Committee of the Australian Wine and Brandy Corporation is empowered to determine the names and boundaries of Australian geographical indications in relation to wines and spirits. The criteria for the making of such determinations are set out in the regulations to the Act.

For geographical indications for other goods and services, there is no specific legislation dealing with this issue.

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

No. In relation to trademarks, section 61(2)(c) and 61(3) of the Trade Marks Act 1995 provide defences to oppositions to registration of trademarks based on the ground that the mark contains or consists of a geographical indication. By establishing either of these defences the owner of the trademark retains its eligibility for or the validity of its registration.

It is necessary, in making out the defence based on section 61(2)(c), that the owner has acquired, through use in good faith, rights in the trademark in respect of goods not originating in the same territory as the goods identified by the geographical indication. In relation to section 61(3), the owner must establish that although the trademark is a geographical indication for the designated goods, it is also a geographical indication for the relevant goods and the owner does not intend to use the trademark in relation to the relevant goods in a way that is likely to deceive or confuse members of the public as to the origin of the relevant goods.

The Australian Wine and Brandy Corporation Act 1980 includes provisions that provide that a description and presentation is not false merely because it includes a homonymous geographical indication (see section 40D(5)). [Note also that Article 6.5 of the EU/Australia Wine Agreement (see answer to question 52 below) regulates the use of homonymous European and Australian geographical indications in the context of that Agreement.]

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

Australian legislation refers to geographical indications and not appellations of origin. However, the fact that certain characteristics of goods may be attributable to the geographic location in which they are produced is recognized in the definitions of geographical indications included in our legislation and Australian Food Standards Code Spirits Standard (see the answer to question 8). Provisions relevant to the protection of geographical indications in the Australian Wine and Brandy Corporation Act 1980, Trade Practices Act 1974 (Cth), Australian Food Standards Code Spirit Standard and state and territory Fair Trading Acts are applicable equally to Australian and foreign geographical indications. For goods other than wine, and services, there is no provision under any of the cited legislation which restricts the right of foreign nationals to take action under these Acts to enforce protection of geographical indications.

As regards geographical indications for wine, section 40ZD(1) of the AWBC Act outlines the Register of Protected Names as containing the following parts:

- (a) A part containing geographical indications in relation to wines manufactured in Australia and the conditions (if any) applicable to those indications;
- (b) A part containing traditional expressions ("TEs") in relation to wines manufactured in Australia and the conditions (if any) applicable to those expressions;
- (c) A part containing geographical indications in relation to wines manufactured in an agreement country and the conditions (if any) applicable to those indications;
- (d) A part containing TEs in relation to wines manufactured in an agreement country and the conditions (if any) applicable to those expressions;
- (e) A part containing words or expressions, other than geographical indications or traditional expressions, in relation to wines manufactured in an agreement country and the conditions (if any) applicable to those words or expressions;
- (f) A part containing the names of varieties of grapes for use in the manufacture of wines in Australia and the conditions (if any) applicable to the description and presentation of wines manufactured in Australia from grapes of those varieties;
- (g) A part containing geographical indications in relation to wines manufactured in foreign countries that are not agreement countries and the conditions (if any) applicable to those indications;
- (h) A part containing traditional expressions in relation to wines manufactured in foreign countries that are not agreement countries and the conditions (if any) applicable to those traditional expressions.

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 is no specific prohibition of this type in the trademarks legislation. In response to section 61(1) which provides that the registration of a trademark may be opposed on the ground that the trademark contains or consists of a sign that is a geographical indication, section 61(2)(b) provides a defence. This is based on non-use of the geographical indication for the designated goods in the country in which the designated goods originated. There are no such prohibitions in any of the other legislation/regulations relevant to geographical indications.

C. PROCEDURE FOR RECOGNITION

As indicated above, the only formal system for recognition of geographical indications in Australia is that for wine, under the Australian Wine and Brandy Corporation Act. Except where indicated otherwise, therefore, answers in this section refer only to geographical indications for wines.

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 AWBC Act (Section 40R) allows for any of the following to apply in writing to the Committee for the determination of a geographical indication in relation to a region or locality in Australia:

- (a) A declared winemakers organization;
- (b) A declared wine grape growers organization;
- (c) An organization representing winemakers in a State or Territory;
- (d) An organization representing growers of wine grapes in a State or Territory;
- (e) A winemaker;
- (f) A grower of wine grapes.

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

The Geographical Indication Committee (GIC) is the Commonwealth Statutory Authority established under the AWBC Act (section 40N) and empowered to make determinations of *geographical indications* for wine in relation to regions and localities in Australia.

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 GIC may, either, on its own initiative or on an application made to it in accordance with section 40R (of the AWBC Act) determine a geographical indication in relation to a region or locality in Australia.

For geographical indications for services and goods other than wine and spirits, there is no specific need to determine whether a particular term qualifies as a geographical indication. The focus is rather on whether its use by a given party misleads the consumer or constitutes an act of unfair competition. The means by which the procedure to determine this is initiated will differ according to the legislative provision or other means by which protection is sought. For example, under the Trade Marks Act 1995, a trademark examiner would be responsible for determining whether a particular trademark for which registration is sought contained or consisted of a "false" geographical indication. Actions against relevant sections of the Trade Practices Act 1974, i.e. legal proceedings involving recognition of a geographical indication, may be taken by either the Australian Competition and Consumer Commission (ACCC), which is responsible for the administration of the TPA, or through a right of private action by individuals or corporations.

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

No fees are involved in the application and maintenance of rights in a geographical indication for any goods or services.

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

Criteria for assessment of an application for determination of a geographical indication for wine are a combination of geographical and other factors. These criteria are contained in regulation 25 of the AWBC Regulation (detailed in response 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 any application for rights in a geographical indication?*

Regulation 25(h) of the AWBC Regulations (detailed in response to question 10) requires the submission of the history of the name sought, its appropriateness and the traditional use of the name, locally or otherwise.

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

In relation to wines, in an application for a geographical indication under the AWBC Act, it is obvious that the good with respect to which the indication is claimed is wine. (The entry in the Register of Protected Names consists of the geographical indication, its definition (boundary) and the terms/conditions of the determination.)

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

Upon receipt of an application, which is complete in terms of the criteria outlined in Regulation 25 of the AWBC Regulations and following consultation with the declared winemaker organization and declared grape growers organization and any other organization or person the Committee thinks appropriate, the Geographical Indications Committee (GIC) makes an "interim determination" which is published in the Commonwealth Gazette Government Notices and the local newspaper. Interested parties have a month from this date to make submissions to the GIC in respect of the determination. These submissions are considered by the GIC to assess whether, in the light of the material presented and the criteria outlined in Regulation 25 the "interim" name or boundary should be varied. The GIC will then make and publish in the Commonwealth Gazette Government Notices and local newspaper a "final determination". Application can then be made under the (Commonwealth) Administrative Appeals Tribunal Act 1975 to the Administrative Appeals Tribunal (AAT) for a review of the "final determination". This application must be lodged within 28 days of the publication of the "final determination". As soon as possible after the 28 day review period or after the decision of the AAT the "final determination" is entered in to the RPN. A "final determination" of the GIC takes effect on the day on which particulars of the determination are included in the RPN.

Follow up action taken by the GIC will vary with each submission received. However, it is always referred to the original applicant, as it may contain material of which they were not aware, when preparing their application. The GIC will consult with the declared winemaker organization and declared grape growers organization and any other organization or person the GIC thinks appropriate.

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

The notice of "interim determination" does not impose limitations on who is able to make submissions on the determination (AWBC Act, Section 40V). However, application to the AAT for a review of a "final determination" must be made by or on behalf of any person whose interests are affected by the determination (AWBC Act section 40X(2)).

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?*

Regarding wine, while there are parts of the Register of Protected Names provided specifically for foreign wine geographical indications, there is no formal legislative procedure laid out under the Australian Wine and Brandy Corporation Act, or its Regulations, as to the process to be followed to have a term placed on the register. A minimum requirement for recognition would, however, be that the geographical indication be protected as such in its country of origin.

D. MAINTENANCE

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

There is no mechanism under Australian legislation for a review of a geographical indication (for wine or any other good or service) and there is no "sunset legislation".

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.*

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?*

In relation to Australian trademark law, the owner of a geographical indication will be unable to oppose the registration as a trademark of the geographical indication, or have it removed from the register if the geographical indication has ceased to be used as a geographical indication for the designated goods in the country in which the designated goods originated.

Section 61 of the Trade Marks Act 1995 provides for any person to oppose the registration of a trademark on the grounds that the mark contains or consists of a geographical indication where the goods in respect of which the mark is to be used do not originate in the region of the geographical indication. Section 61(2)(b) provides a defence to the opposition to registration based on the non-use of the geographical indication for the designated goods in the country in which the designated goods originate. If the geographical indication is not used the opposition will not be successful.

In order to succeed in the opposition hearing, the opponent would need to lodge evidence of use in support of his/her opposition action.

In addition, the extended operation of section 61 through section 88(2) will prevent the owner of the geographical indication from successfully seeking rectification of the register by applying to a prescribed court to have the trademark removed.

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 limit for non-use before rights in a geographical indication cease.

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

There is no requirement under existing legislation to ensure that the initial criteria for registration continue to exist.

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

The AWBC monitors wine industry compliance on the use of geographical indications for wine through its audit and export approval programs. Part VIA of the AWBC Act relates to record keeping and inspection powers, while Part VIB (Division 2) relates to the presentation of wine for sale, export and import.

For spirits, different procedures apply to the monitoring of spirits at the border, and those which are on the domestic market. At the border, the Australian Quarantine Inspection Service (AQIS) has responsibility for ensuring that spirits being imported into Australia comply with the provisions on geographical indications in the Australian Food Standards Code Spirit Standard. Under the Imported Foods Control Act 1992 (Cth), AQIS inspectors inspect 5% of all spirits consignments for compliance with the provisions of the Spirits Standard, including those on geographical indications. If an inspector determined, on the basis of the definition in the Standard, that a spirit being imported into Australia used a "false" geographical indication, the procedure would be as follows: First, the producer would be given the option of bringing the product into line with the Standard i.e. removing the alleged false indication. If this were not possible, or the producer refused to do so, AQIS is empowered to order that the products be re-exported or destroyed. The producer has a right to appeal this decision. If no appeal is taken, or the appeal is rejected and the producer does not re-export the product, AQIS has the right to seize the goods and deal with them appropriately.

Enforcement of the Spirits Standard for spirits produced domestically is the responsibility of state governments. The Australian food standards are incorporated into state/territory law via state and territory Food Acts. Overall responsibility for the standards is thereby devolved to state/territory health authorities. Responsibility for enforcement of the Food Acts rests with either a state/territory or local government body (for example, in New South Wales it is the state government-level Public Health Unit). These bodies have the authority to institute legal proceedings in the event of an alleged contravention of food standard provisions. In the case of the geographical indication provisions in the Spirit Standard, the relevant authorities do have the power to institute proceedings ex officio, a procedure which would most frequently occur following information or complaints received from the public or industry.

Regarding other goods and services, the Australian Competition and Consumer Commission (ACCC) is responsible for identifying breaches and potential breaches of the Trade Practices Act. Its primary sources of information are: complaints (from customers, consumers etc), corporate intelligence by the ACCC and media reports in newspapers, trade journals, newsletters, radio, television etc.

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.*

Regarding geographical indications for wine, the AWBC Act provides for the determination of geographical indications, but there is no procedure for varying or terminating a geographical indication once it is entered into the RPN.

There are no such means for other geographical indications.

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?*

Not applicable. Refer to answer to question 34.

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?*

Regarding geographical indications for wine, the ability to use a geographical indication is available to all wine originating within the determined boundary. There is no requirement that geographical indications be limited to land planted to vines at the time of the determination or that subsequent plantings substantiate that they meet the criteria (other than location) prior to use.

This question is not applicable to geographical indications for other goods and services.

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 geographical indication is automatically available for use on wine originating within the determined boundary. The determination of the boundary is the responsibility of the Geographical Indication Committee acting under the AWBC Act.

This question is not applicable to other geographical indications.

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. Refer to answer to question 36.

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

Regarding geographical indications for wines, AWBC activities are directed at establishing a "culture of compliance" within industry. Given the maintenance of proper records (Part VIA of the AWBC Act) and the absolute nature of the determined line and the availability of the geographical indication to all wine originating within that boundary, the scope for disputation is limited. Dispute resolution in the first instance is through discussion with AWBC representatives and then through the Federal Court.

Regarding spirits at the border, if an importer/producer wished to challenge a determination by an AQIS inspector regarding an allegedly "false" use of a geographical indication on an imported

spirit, the Imported Foods Control Act 1992 (Cth) provides that the decision may be reviewed by the Administrative Appeals Tribunal (a Commonwealth body). If a spirit has passed the inspection process and entered into the domestic market, any dispute regarding use on that spirit of a geographical indication would be done via the procedures provided under the state/territory Food Acts, via the state/territory authority responsible for the Act's enforcement (see response to question 33).

In the case of domestically-produced spirits, the state/territory authorities responsible for enforcing the state/territory Food Acts (see response to question 33) are empowered to institute legal proceedings. This would usually occur following a complaint from the public or industry.

Regarding geographical indications for other goods and services, an individual may bring a civil action under any of the general legislative provisions listed in the first paragraph of the response to question 4. The issue will then be settled through the courts. Alternatively, for breaches of the Trade Practices Act, the Australian Competition and Consumer Commission may bring an action on behalf of an interested party in the Federal Court. If a dispute over geographical indications arose under the provisions of the state/territory fair trading legislation, and fell into the category of "country of origin" claim (i.e. potential breaches of sections 52 and 53 of the Trade Practices Act, and equivalent provisions of the Fair Trading legislation), the ACCC has memoranda of understanding with each of the states encouraging them to refer the case to the ACCC. This is in light of the priority placed by the ACCC on country of origin claims.

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?

This question is applicable only to geographical indications for wines, and the answer is no. Once a geographical indication has been entered onto the Register of Protected Names, it is available to be used in relation to all wine originating within that determined area.

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

Not applicable. Refer to answer 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?

None of the Australian legislation or regulations regarding geographical indications allow geographical indications to be licensed.

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

There has not been such a case in our implementing practice up to now.

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?

Australia's obligations under Article 16.1 of the TRIPS Agreement are met by sections 20, 61(2)(c) and 120 of the Trade Marks Act 1995, sections 52 and 53 of the Trade Practices Act 1974 and the common law action of passing off.

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 Geographical Indications Committee will not accept an application for determining a geographical indication for wine where the proposed name is the same as a trademark that provides exclusivity to the registered owner, unless the owner provides a letter agreeing to forego his exclusive rights and permit registration of the geographical indication.

Regarding the other legal means for the protection of geographical indications listed in response to question 1, in each case the factors relevant to the determination of the status and effective scope of protection afforded to well-known marks in conformity with Article 16.2 and 16.3 of the TRIPS Agreement are inherently relevant to the process of "recognising" a geographical indication in the application of these legal means. A key factor in this regard is the normal signification of a term or indication for the relevant public. It is not therefore required to identify specific steps in relation to these legal means.

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

Under Australian trademark law all applications for trademarks containing geographical indications are dealt with by the Australian Trade Marks Office as follows:

If the trademark as a whole is not capable of distinguishing the goods an objection to its registration is raised by the examiner, relying on the terms of section of the Trade Marks Act 1995. The strength of the objection is increased by the fact that a geographical indication is an apt description for goods produced in that region, and also because such indications may have to be used by others in order that their similar goods can be properly described. A geographical indication is therefore held to be not inherently adapted to distinguish and not capable of distinguishing the applicant's goods.

Application of a geographical indication to goods whose origin does not correspond with the indication will lead to deception and confusion, and thus offend under section 43 of the Trade Marks Act. An objection in these terms will also be raised in respect of the application, unless the goods are described as having their origin in the region of the geographical indication.

If the trademark is, despite the inclusion of the geographical indication, capable of distinguishing the applicant's goods, no objection under section 41 will be raised. The same consideration under section 43 will be made and an objection raised unless the registration of the mark is limited to use in relation only to goods originating in the region of the geographic indication.

If the application relates to wines, the applicant will be advised of the terms of the Australian Wine and Brandy Corporation Act 1980 which prescribes certain conditions to be met in the description and presentation of wine, and implements the EC/Australia Wine Agreement, a bilateral agreement entered into by the member states of the European Union and Australia in 1994. Substantial penalties of up to two years jail and/or a \$A 60,000 fine now apply to the false or misleading description or presentation of wine involving the improper use of a registered geographical indication or other wine name appearing in the Australian Register of Protected Names.

When the trademark is accepted for registration, the details are published and the mark may be opposed under section 61 of the Trade Marks Act on the grounds that the trademark contains or consists of a sign that is a geographical indication and the goods in respect of which the mark is to be used do not originate in the region of the geographical indication. If the opposition is successful, registration of the mark will be refused under section 55 of the Act.

If a registered mark is thought to contain or consist of a geographical indication, an aggrieved person may apply under section 88 of the Trade Marks Act to have the registration cancelled, removed or amended on any ground on which the registration of the mark could be opposed. This includes the grounds that the trademark contains or consists of a sign that is a geographical indication (section 61) or that its registration could lead to deception and confusion (section 43).

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 response to question 1.

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

The trade practices (Cth) and fair trading legislation (states and territories) provide for action to be taken by any interested party, or by the ACCC or relevant state and territory fair trading bodies on behalf of affected parties. In addition, opposition to the registration of a trademark which contains or consists of a geographical indication can be taken by any person.

The AWBC Act also provides for a wide range of interested parties to take action to enforce a geographical indication for wine. Specifically:

"Section 40K Prosecution of offences

"(1) To avoid doubt, it is declared that any of the following may institute a proceeding for an offence against section 40C, 40E, 40G or 40H:

- (a) the Corporation;
- (b) a person engaged in the manufacture of wine or the growing of wine grapes in Australia or in an agreement country;
- (c) an organization established under the law of Australia or of an agreement country whose objects or purposes include any of the following:
 - (i) the promotion of the manufacture of wine, the growing of wine grapes or the marketing of wine;
 - (ii) the promotion or protection of the interests of persons engaged in the manufacture of wine, the growing of wine grapes or the marketing of wine;
 - (iii) the promotion or protection of the interests of consumers of wine.

"This section does not limit the operation of section 13 of the Crimes Act 1914."

"Section 40L Injunctions

"(1) If a person has engaged, is engaging or proposes to engage in any conduct in contravention of this Division, the Federal Court of Australia may grant an injunction:

- (a) restraining the person from engaging in the conduct; and
- (b) if the Court thinks it desirable to do so - requiring the person to do a particular act.

"(2) An application for an injunction may be made by, or on behalf of, an interested person.

"(3) The following are interested persons for the purposes of subsection (2):

- (a) the Corporation;
- (b) a declared wine makers organization;
- (c) a declared wine grape growers organization;
- (d) a person who is a manufacturer of wine, or a grower of wine grapes, in Australia or an agreement country;
- (e) an organization established under the law of Australia or of an agreement country whose objects or purposes include any of the following:
 - (i) the promotion of the manufacture of wine, the growing of wine grapes or the marketing of wine;
 - (ii) the promotion or protection of the interests of persons engaged in the manufacture of wine, the growing of wine grapes or the marketing of wine;
 - (iii) the promotion or protection of the interests of consumers of wine.

"(4) The Court may grant an interim injunction pending a determination of an application for an injunction.

"(5) The Court may discharge or vary an injunction granted under this section.

"(6) The power of the Court to grant an injunction restraining a person from engaging in conduct may be exercised:

- (a) whether or not it appears to the Court that the person intends to engage again, or to continue to engage, in conduct of that kind; and
- (b) whether or not the person has previously engaged in conduct of that kind.

"(7) The powers conferred on the Federal Court of Australia by this section are in addition to, and not in derogation of, any other powers of the Court."

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?*

All the courts and tribunals with jurisdiction over enforcement actions related to geographical indications have fee schedules i.e. they require payment of a fee to bring an action. The amount of the fee depends on the level of superiority of the court, and the type of action brought.

Regarding specific actions:

- If a claimant based an action on the tort of passing off, the case would be heard at first instance in a Magistrates Court.
- If provisions of the Trade Practices Act were invoked, the action would be heard in the Federal Court [note, however, that if the action were brought by the Australian Competition and Consumer Commission on behalf of an interested party, the ACCC would cover the costs of the case ie the claimant would incur no costs].
- Under the state Fair Trading Acts, actions relevant to geographical indications are heard at first instance in the Supreme Court.
- Under the AWBC Act, dispute resolution in the first instance is through discussion with AWBC representatives (no fees) and then through the Federal Court.
- Actions involving the Australian Food Standards Code Spirit Standard may arise under either the Imported Foods Control Act 1992, or the state/territory Food Acts. Under the former, disputes are heard by the Administrative Appeals Tribunal. Under the latter, in the case of a civil action, a dispute is heard in the District Court; in the case of a criminal prosecution, it is heard by the Magistrates Court.

In relation to trademark oppositions, the Registrar of Trade Marks gives the opponent and the applicant the opportunity of being heard at a hearing on the opposition and then decides whether or not to register the mark. The applicant or the opponent may appeal the decision of the Registrar to the Federal Court (section 55).

The filing of the opposition notice requires a fee of \$A 250. Depending on how the proceedings progress there may be further fees payable for extensions of time or for filing of further evidence. If matters progress to a hearing, there would be an amount not exceeding \$A 500 payable to request and/or attend the hearing.

If a registered trademark is thought to contain or consist of a geographical indication, an aggrieved person may apply under section 88 of the Trade Marks Act to have the registration cancelled, removed or amended on any ground on which the registration of the mark could be opposed. This includes the grounds that the trademark contains or consists of a sign that is a geographical indication (section 61) or that its registration could lead to deception and confusion (section 43).

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

Regarding geographical indications for wine, the public must be advised of the publication of the "interim" and "final" determinations of a geographical indication. However, once the geographical indication is entered into the RPN, there is no ongoing requirement in this regard. The RPN must be available for public inspection during normal business hours.

This question is not applicable to geographical indications for other goods and services.

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.*

In regard to geographical indications for wines, yes. Sections 40K and 40L, AWBC Act (see response to question 48 above).

In regard to geographical indications for spirits, under the Food Acts of the states/territories, the authority responsible for enforcement of the Act is authorised to institute a criminal prosecution, which would take place in the state/territory Magistrates Court.

In regard to other geographical indications, breaches of sections 53, 55 and 55A of the Trade Practices Act and the equivalent provisions of the state Fair Trading Acts can give rise to criminal sanctions. Prosecution occurs through the Department of Public Prosecutions ("DPP"). The DPP must prove all elements of the offence "beyond reasonable doubt" (compared with the standard "on the balance of probabilities", in the case of a civil action).

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 Agreement between Australia and the European Community on Trade in Wine. Australia developed its system for protecting geographical indications for wine following entry into the EU/Australia Wine Agreement. EC geographical indications for wine which Australia is required to protect under the Agreement are entered into the AWBC Register of Protected Names.

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

None.

The ACCC has cooperation arrangements in place with both the New Zealand Commerce Commission and the Chinese Taipei Fair Trade Commission. These agreements make provision for information exchange and the provision of assistance between the ACCC and these two enforcement agencies. These agreements would cover the exchange of information and provision of assistance in investigations into misleading or deceptive "country of origin" claims.

III. 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 answer to question 46 and definition of "geographical indication" contained in the ANZFA Spirit Standard P3(12)(g)(ii), quoted verbatim in answer to question 8.

B. DEFINITION AND CRITERIA FOR RECOGNITION (SECTION B OF DOCUMENT IIP/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?*

Australian legislation refers to geographical indications and not appellations of origin or indications of source. However, the fact that certain characteristics of goods may be attributable to the geographic location in which they are produced is recognized in the definitions of geographical indications included in our legislation (see the answer to question 8).

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

See the answer to question 14.

C. RELATIONSHIP TO TRADEMARKS (SECTION F OF DOCUMENT IIP/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 answers to questions 1 and 46.
