

**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

URUGUAY

The document contains the responses to the checklist of questions which the Secretariat has received from the Permanent Mission of Uruguay in a communication dated 25 June 2003.

**RESPONSES TO THE CHECKLIST OF QUESTIONS ON
GEOGRAPHICAL INDICATIONS (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 are protected by the legislation on distinctive signs (trademarks), there being no unfair competition legislation law in the country. Within geographical indications the domestic legislation distinguishes between appellations of origin and indications of source. The latter enjoy protection without the need for registration (Article 74 of Law No. 17.011), while appellations of origin must be registered in order to obtain protection.

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

There are two regimes of protection: the regime under Law No. 17.011, which protects distinctive signs and covers all products and services, and the regime established by the National Institute of Wine Production (Instituto Nacional de Vitivinicultura) (INAVI) for wines and spirits, which therefore enjoy a double system of protection.

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

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.

Articles 4.4 and 5.7 and Chapter XII on geographical indications of Law No. 17.011 of 25 September 1998 and Articles 64 to 72 of Regulatory Decree No. 34/999 of 3 February 1999 fulfil the requirements of Article 22.2 of the TRIPS Agreement. As for the protection required under Article 23.1, that is included within the above-mentioned protection. The texts of the above-mentioned law and decree are attached. The National Institute of Wine Production should be consulted with regard to the regulations which they apply.

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.

No.

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.

At the moment there are no domestic geographical indications protected under Law No. 17.011. With regard to the protection regime established by INAMHI, that body itself should be consulted.

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.

All products and services enjoy the same level of protection under Law No. 17.011.

B. DEFINITION AND CRITERIA FOR RECOGNITION

8. How are geographical indications defined?

Article 73 of Law No. 17.011 states that "geographical indications consist of indications of source and appellations of origin". Article 74 establishes that an "indication of source is the use of a geographical name on a product or service that identifies the place of extraction, production or manufacture of a given product or the provision of a given service as the source", while Article 75 provides that an "appellation of origin is the geographical name of a country, a city, a region or a locality used to designate a product or service whose qualities or characteristics are exclusively or essentially due to the geographical environment, including natural or 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?

Not indirectly.

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

Those specified in the above-mentioned law.

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, human factors are involved.

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?

In the case of wines and spirits it is INAVI, and for other products or services it is the competent authority in that field.

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

There is no specific legal provision relating to homonymous geographical indications for wines in Law No. 17.011.

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

Yes, Articles 65 and 67 of Regulatory Decree No. 34/999.

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 none.

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?

Neither the one nor the other (Article 65 of Regulatory Decree No. 34/999).

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

The National Directorate of Industrial Property and INAVI.

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?

They must be based on the initiative of an entity or person.

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

A fee of 12 Adjustable Units must be paid for a single kind and 7 Adjustable Units for each additional kind when applying for registration, there being no fee for their maintenance.

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

There are no criteria as such, but there are legal requirements, such as the quality requirement for the protection of appellations of origin.

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

Please refer to the previous answer.

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

The registration of national appellations of origin must be accompanied by a statement certifying that they have been granted by the competent authority. In the case of domestic wine production the certificate must be issued by the INAVI. In the case of the registration of foreign appellations of origin already recognized in the country of origin, that fact must be certified in the application.

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?

There is a procedure to oppose recognition; it is governed by Article 69 of Regulatory Decree No. 34/999.

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

Third parties with a direct, personal and legitimate interest may oppose recognition.

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.

D. MAINTENANCE

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

There is no time-limit for appellations of origin once they have been registered (Article 71 of Decree No. 34/999).

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.

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?

There is no provision for such action.

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

There is none.

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 provisions covering non-use. In the second case, an administrative action for annulment could be brought.

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?

They must 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?

It may be used once recognition has been granted.

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?

Use is not required.

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 the case of a licence for use, this will be governed by the provisions of the civil law applicable to such contracts.

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

The procedures of the civil law will apply under the General Code of Procedure.

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 provisions relating to the use of the appellation of origin.

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

Idem.

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?

As stated in the reply to question 38, licences may be granted in response to the wish of the parties and in accordance with the relevant provisions of the civil law.

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

Article 79 of Law No. 17.011 excludes from the prohibition on use those geographical indications identifying wines and spirits that have been used in a continuous manner for at least 10 years preceding 15 April 1994.

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?

Domestic legislation does not allow the registration of appellations of origin as trademarks. However, indications of source may be registered as trademarks provided that their use is not liable to create confusion regarding the origin, source, qualities or characteristics of the goods or services for which the trademark is used.

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?

As has already been stated, different signs have different types of protection.

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

In the event of a protected geographical indication being registered as a trademark the interested party will be able to apply for it to be annulled.

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.

Rights are enforced by means of administrative proceedings before the National Directorate of Industrial Property, an application for annulment before the Administrative Tribunal, and civil and criminal proceedings before the competent courts.

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

The right holder.

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 have already stated, the National Directorate of Industrial Property, the Administrative Tribunal and the judiciary. Yes, fees and taxes must be paid if the judiciary is involved.

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

A single notification is made through the Industrial Property Bulletin.

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.

Article 85 of Law No. 17.011 provides for the application of the criminal provisions contained in Articles 81 to 84 against those infringing the rules on appellations of origin.

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.

Uruguay is a party to the Paris Convention, ratified by Decree-Law No. 14.910, and the TRIPS Agreement, which it ratified by Law No. 16.671. In the regional context it has signed the

MERCOSUR protocol on trademarks and appellations of origin, which was ratified by Law No. 17.052.

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

Only those mentioned in the previous paragraph.
