

Draft geographical indication bill published for review

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Introduction

Following consultation with stakeholders, the Intellectual Property Organisation of Pakistan (IPO) prepared and published on its website the Draft Geographical Indication Protection Bill 2016, in accordance with the Agreement on Trade-related Aspects of Intellectual Property Rights (TRIPS).

The Trade Marks Ordinance 2001 provides for the registration of geographical indication marks under Section 82 of Collective Marks chapter and Section 83 of Certification Marks chapter (Paragraph 3 of the First and Second Schedule, respectively), under which a mark which consists of geographical signs or indications may be registered.

As there are minimal provisions relating to geographical indication protection in existing IP legislation, there is a need for comprehensive legislation that provides improved protection and public awareness of geographical indication products in Pakistan and aligns with international standards. The draft bill published on the IPO website is open for discussion and public comment. In September 2016 the IPO consulted stakeholders from government ministries, chambers of commerce, trade associations, small and medium-sized enterprises, academia and non-government organisations to gauge their feedback on the draft bill.

Draft bill details

The main features of the Draft Geographical Indication Protection Bill 2016 include the following.

Definitions

The draft bill defines the following terms used in connection with geographical indications:

- 'Geographical indication' is defined as "an indication which identifies a product of particular geographical origin, quality, reputation or other characteristics which are attributable to its geographical origin; and at least one of the activities of production, processing or preparation of which takes within the geographical area".
- 'Geographical origin' is defined as "an area of a country, region, or locality which also includes seas, lakes, rivers, islands, mountains or any other area of a similar nature".

- 'Homonymous geographical indications' are defined as indications "that are spelled or pronounced alike, but which identify products originating in different places, within a country or in different countries".
- 'Indication' refers to words, letters and numerals, geographical and other names, devices and figurative representations, or a combination thereof, indicating the geographical origin of the goods to which they are applied.

Geographical Indication Registry

The IPO will establish the Geographical Indication Registry, which will be under its administrative control. The registry will be entrusted with administration and registration responsibilities and matters relating to the control of geographical indication products in Pakistan under the Geographical Indication Protection Bill.

Prohibition of geographical indication registration

An application that does not correspond with a geographical indication cannot be registered if it:

- refers to an existing plant variety or animal breed;
- is contrary to existing law;
- is against public order or morality;
- has become a generic term for particular goods or indications;
- is not protected by its country of origin; or
- falsely represents where the goods come from.

Right of application

Any natural person, association of producers or public institution linked to the region that represents the interests of producers is entitled to file or apply for geographical indication registration.

Contents of application

A geographical indication application requires the following product specifications:

- the product's name;
- a description of the product;
- a description of the geographical area in question;
- evidence of the defined geographical indication area;
- details of the product's techniques (eg, authentic, specific, local or traditional techniques); and
- the certification body's name and address and any additional information, as required.

Registration of homonymous geographical indications

A homonymous geographical indication may be registered after the registry has considered the practical conditions under which the homonymous indication in question will be differentiated from the registered geographical indication to ensure that the consumers of such products will not be confused or misled as a consequence of the registration. The registry may require the proprietor of a particular product to provide further information to dispel any chance of confusion among similar homonymous marks.

Registration of trans-border geographical indications

An application for a geographical indication of trans-border geographical origin may be filed jointly by two or more applicants with proof of registration of the geographical indication in their country of origin.

Substantive examination of application, publication and registration

The registry will examine applications and may require applicants to provide further information or additional evidence in support thereof. After examination, the registry may approve or reject the application. Approval may be absolute or subject to certain conditions deemed necessary by the registry.

On the approval of an application, the registrar will publish the mark in the *Geographical Indication Journal* to invite oppositions. If no opposition is received within 90 days of publication, the mark will be registered in the Register of Registered Geographical Indication.

Oppositions

Any interested party may file an opposition action against a geographical indication application based on certain grounds. The registrar may require the applicant to submit a counterstatement. On examination, the registrar will notify the applicant and opponent of its decision and reasons in writing, which may be appealed.

Registration of foreign geographical indications

Foreign geographical indications may be registered in Pakistan provided that:

- they are registered in accordance with local legislation in their country of origin;
- they are protected in their country of origin; and
- the application is made by a legal representative.

Use of geographical indication

A registered geographical indication can be used by registered and authorised users on:

- products;
- packaging;
- advertising material; and
- any other document relating to registered geographical products.

Revocation of registered geographical indication

The registrar may revoke a registered geographical indication on its own initiative or following a cancellation application by an interested party if:

- the indication is no longer used;
- the indication does not comply with the corresponding product specifications;
- conditions specified in the draft bill are not fulfilled; or
- the right of ownership belongs to another natural or legal person.

Update of register

The register may be updated to:

- correct an error;
- change the name, address or description of a registered proprietor, authorised user or certification body; or
- amend a product specification.

Scope of protection

A registered geographical indication grants the proprietor and authorised user the right to bring claims against infringers and counterfeiters. Further, the indication is protected against any commercial misuse (including unauthorised use, imitation, translation of the indication and false indication) regarding similar or comparable goods where the misuse is likely to benefit the infringer or mislead the public.

Duration of protection

A geographical indication registration lasts 10 years and can then be renewed.

Interaction between trademark and geographical indication

Any trademark containing a geographical indication will be refused registration if:

- its use contravenes the scope of geographical indication protection; or
- the application was made after the date of application for the geographical indication.

Further, if a trademark is registered in breach of a geographical indication, the registrar of trademarks will invalidate it on request by an interested party or of its own accord.

Offences, penalties and procedures

Any party that breaches a geographical indication's scope of protection could face imprisonment or a fine, as appropriate.

Offences by companies

A company or a person in charge of a company when an offence is committed will be held liable unless he or she can prove that the offence was committed without his or her knowledge or that he or she exercised all due diligence to prevent the commission of such offence.

Comment

The Draft Geographical Indication Protection Bill 2016 is another step in the IPO's effort to bring local laws in line with TRIPS and the Paris Convention. The establishment of the IPO Tribunals and the draft bill will add to existing law and help to foster positive change, public awareness and development in Pakistan's IP field.

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