

Geographical Indications Bill Passed

June 1, 2014

Background

A geographical indication (GI) indicates a certain quality or characteristic of an item which is attributable to its place of origin. The GI “champagne” for instance, denotes sparkling wine produced from grapes grown in the Champagne region of France.

As part of the *European Union-Singapore Free Trade Agreement* (EUSFTA), Singapore’s Parliament passed the GI Bill on 14 April 2014 (GI Bill) to enhance the existing protection regime for GIs in Singapore. Presently, GIs are protected in Singapore through the *GI Act* and the *Trade Marks Act* through certification and collective marks. The existing *GI Act*:

- disallows the use of GI labels on products which do not come from the place indicated by the GI if this would mislead the public as to the geographical origin of the products; and
- affords a higher level of protection for GIs used on wines and spirits in that such GIs cannot be used even if consumers are not misled as to the geographical origin of the wines and spirits – for example, it is not permissible to use the term “Bordeaux-like” in respect of wine even if consumers are not misled into thinking that the wine comes from Bordeaux.

Under the proposed new geographical indicator regime, GIs would enjoy enhanced protection such as the following:

- the establishment of a GI registry to accept and examine applications to register GIs used in respect of wines and spirits and selected categories of agricultural products and foodstuffs;
- registration of a GI will be considered prima facie evidence of the validity of the registration in legal proceedings;
- a higher level of protection for registered GIs for agricultural products and foodstuffs similar to the additional protection given for GIs used on wines and spirits;
- amendments to the *Trade Marks Act* to align the current trademarks regime with the new regime of registered GIs: once the *Trade Marks Act* is amended, it will not be possible to register a trademark which contains a GI that is already registered under the new GI law (or if the application to register the GI was lodged before the application to register the trademark); and
- border enforcement measures for registered GIs: holders of registered GIs may request Singapore custom authorities to detain infringing goods that are to be imported into and exported out of Singapore.

The rights granted to GI holders under the new GI protection regime, when it comes into force, will co-exist with those

under the present regime under the current GI Act. However, holders who wish to benefit from increased certainty of recognition, enhanced level of protection (especially for GIs used on agricultural products and foodstuffs), and improved border enforcement measures can opt for registration.

The changes under the Bill will be implemented in a three stage process to correspond with the ratification of the EUSFTA by the European Union.

The first stage of change will be highlighted by the establishment of the GI registry. This will happen after the EU Parliament ratifies the EUSFTA. However, GIs registered at this first stage will be treated as being “provisionally registered” and will not enjoy any protection over and above the current protection given to unregistered GIs. A provisionally registered GI will also not block or be cited against a pending trademark application.

The second stage of change will bring into effect the additional protection for registered GIs and amendments to the Trade Marks Act. This will take place after the EUSFTA is provisionally applied.

The third stage of change will be highlighted by the coming into effect of the border enforcement measures for registered GIs. This will be effected within three years after the EUSFTA comes into force.

Implications for trademark applicants

Until the second stage of change occurs, any conflicting trademarks that are pending registration before the commencement of the second stage of change will not be blocked by a provisional GI registration.

However, as holders of registered GIs may pursue actions for infringement of GIs against trademark owners after the second stage of change occurs, parties applying to register trademarks before the second stage occurs should check whether there are any earlier provisionally registered GIs which might conflict with their trademark before proceeding to use the trademark.

Implications for GI holders

As it is widely expected that the EUSFTA will become reality in the near future, custodians of geographical indicators should consider registering their GIs under the new regime so as to be able to enjoy the enhanced protection. Additionally, GI custodians should also consider the benefits of registering their GIs as a certification or collective mark. A registered trademark may give the GI custodian additional remedies under criminal law. This is over and above available civil remedies. Furthermore, the application for a GI as a certification or collective mark before the second stage of change under the GI Bill occurs will mean that the trademark registry will begin policing or citing pending trademark applications containing such GIs at an earlier stage.

GI custodians who are unsure of their registration options and the pros and cons of these options may contact the authors for more information.

Your Key Contacts



Gilbert Leong

Senior Partner, Singapore

D +65 6885 3638

gilbert.leong@dentons.com