

WORLDWIDE SYMPOSIUM ON GEOGRAPHICAL INDICATIONS

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BUDAPEST

TRADE MARKS AND GEOGRAPHICAL INDICATIONS

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Companies and Intellectual
Property Commission

a member of **the dti** group

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INTRODUCTION

- The Dutch East India Company established a victualing station at the Cape of Good Hope in 1652.
- Dutch Governor Jan van Riebeeck planted the first vines of French origin in 1655.
- The Cape of Good Hope was described “*as the fairest cape in all the circumference of the world*”.







RT

SAILING CATAMARAN



BOAT COMPANY

HELICOPTERS

WESTPORT HELICOPTERS



GOODS































INTRODUCTION (cont.)

- “First” geographical indication in South Africa came about when the Groot Constantia wine farm was established in 1685.
- Wines produced at Groot Constantia favoured by Napoleon of France, Frederick of Prussia and Bismarck of Germany.
- Constantia wines considered amongst the best ever produced.
- Later French Huguenots arrived in the Cape and imported into South Africa French skills and traditions in wine making, settling in the town of Franschoek and introducing French family names.

INTRODUCTION (cont.)

- Skills of the Dutch and the French employed to select the best wine growing areas, based on soil, climate and location.
- South Africa was occupied by the British from time-to-time (a century from 1806 onwards) who promoted exports from their colony and introduced certain quality control measures; “birth” of South African product legislation.
- For centuries the Cape served as link between the East and Europe - it served in the trade of spices from the East and the provisions of traders from Europe.
- Not surprisingly, South Africa was one of the early countries to provide protection for geographical indications.

INTERNATIONAL AGREEMENTS

- In 1929 South Africa entered into an agreement with France to protect long list of French geographical indications in exchange for the privilege to sell crayfish to France - "*Crayfish Agreement*".
- South Africa *inter alia* agreed to protect certain geographical indications and adopted legislation whereby South Africa was no longer authorised to use certain expressions and words, such as "*champagne*" for sparkling wine, or refer to red wines as "*burgundies*".
- The Crayfish Agreement overtaken by the provisions of TRIPs.
- South Africa became a signatory of TRIPs by virtue of its accession to the Marrakesh Protocol in 1994.
- Article 24(6) of TRIPs proved very controversial in as far as it dealt with the definition of what a customary term is, with special reference to "*port*" and "*sherry*".

INTERNATIONAL AGREEMENTS (cont.)

WINE AGREEMENT WITH THE EUROPEAN UNION (“EU”)

- In 2002 South Africa reached an agreement with the EU which aimed to encourage and promote the trade in wine produced in South Africa.
- The Agreement deals with oenological practices and provides wide ranging protection for geographical indications and indications of place and similar indications.
- The Agreement also brought into effect a prohibition on the use of the names “*port*” and “*sherry*” by South African wine producers.

STATUTORY PROTECTION (1)

LIQUOR PRODUCTS ACT (Act 60 of 1989)

- Uniqueness of the South African wine producing areas and farms for a long time not legally protected.
- Official Wine of Origin scheme established in 1972.
- Scheme not only protects wines of origin, but also wines made from a specific cultivar or vintage.
- South Africa's Wine of Origin certification scheme was officially instituted in 1973, in accordance with the Wine, Other Fermented Beverages and Spirits Act (Act 25 of 1957).

STATUTORY PROTECTION (1)

LIQUOR PRODUCTS ACT (Act 60 of 1989) (cont.)

WINE AND SPIRIT BOARD (“WSB”) - COMPOSITION

- In accordance with the provisions of the Liquor Products Act the control function regarding wine of origin, cultivar, vintage, estate brandy and integrated production of wine, fall under the Wine and Spirit Board.
- Appointed by the Minister of Agriculture, Forestry and Fisheries and consists of a chairperson and 12 members:-
 - ❖ 8x persons with the relevant knowledge, skills or expertise in viticulture, oenology, distilling, regulatory environment of the liquor industry, liquor production, food safety or microbiology
 - ❖ 3x Department of Agriculture, Forestry and Fisheries (“DAFF”) officers
 - ❖ 1x person nominated by the Agricultural Research Council
 - ❖ 1x person designated by the Minister

STATUTORY PROTECTION (1)

LIQUOR PRODUCTS ACT (Act 60 of 1989) (cont.)

WINE AND SPIRIT BOARD - FUNCTIONS

The Board's primary functions are:-

- Running and administering the schemes for Wine of Origin, Estate Brandy and Integrated Production of Wine.
- Advising and making recommendations to the Minister of Agriculture, Forestry and Fisheries on any matter relating to the Liquor Products Act and its subordinate legislation.

STATUTORY PROTECTION (1)

LIQUOR PRODUCTS ACT (Act 60 of 1989) (cont.)

WINE OF ORIGIN SCHEME (cont.)

CERTIFICATION OF ESTATE BRANDY

- During 1993 a Scheme for Estate Brandy was promulgated, which makes provision for the certification of brandy produced on a unit for the production of estate wine/ brandy.
- The Scheme is applicable to pot still brandy, brandy and vintage brandy.
- Various brandy labels produced in South Africa have for several years now been awarded the *Worldwide Best Brandy Award* at the prestigious International Wine & Spirit Competition.

STATUTORY PROTECTION (2)

TRADE MARKS ACT (Act 194 of 1993)

In terms of the Trade Marks Act geographical indications can be protected as either **CERTIFICATION MARKS** or as **COLLECTIVE MARKS**.

Section 42 - Certification Marks

”42.(1) *A mark **capable of distinguishing**, in the **course of trade**, **goods or services certified** by any person in respect of kind, quality, quantity, intended purpose, value, **geographical origin** or **other characteristics** of the goods or services, or the **mode** or time of production of the goods or of rendering of the services, as the case may be, **from goods or services not so certified**, shall, on application in the prescribed manner, be registrable as a certification trade mark in respect of such first-mentioned goods or services, in the name, as proprietor thereof, of that person: **Provided that a mark may not be so registered in the name of a person who carries on a trade in the goods or services in respect of which registration is sought.***

(2) *Subject to the provisions of this section, the provisions of this Act shall, except in so far as is otherwise provided, and in so far as they can be applied, apply to a certification trade mark.”*

STATUTORY PROTECTION (2)

TRADE MARKS ACT (Act 194 of 1993) (cont.)

Section 42 - Certification Marks (cont.)

- The application for the registration of a certification mark shall be accompanied by (i) **a statement** by the applicant that he **does not carry on a trade in the goods or services** in respect of which registration is sought and by (ii) **rules governing the use of the mark**.
- The rules shall specify (i) **the conditions for the use of the mark**, the (ii) **circumstances** in which the proprietor is to certify the goods or services and (iii) in respect of **which characteristics** of the goods or services or other aspects referred to in section 42 (1) the applicant will certify the goods or services.

STATUTORY PROTECTION (2)

TRADE MARKS ACT (Act 194 of 1993) (cont.)

Section 43 – Collective Marks

“43.(1) *A mark **capable of distinguishing**, in the **course of trade**, goods or services of persons who are **members of any association from goods or services of persons who are not members** thereof, shall, on application in the manner prescribed and subject to the provisions of this section, be registrable as a collective trade mark in respect of such first-mentioned goods or services in the name of such association as the proprietor thereof.*

(2) ***Geographical names or other indications of geographical origin may be registered as collective trade marks.***”

- An application for the registration of a collective mark shall be accompanied by **rules** governing the use of the mark.
- The rules shall specify (i) the **persons authorised** to use the mark, (ii) the **conditions of membership** of the association and, when applicable, (iii) the **conditions of the use** of the mark, including any **sanctions against misuse**.

STATUTORY PROTECTION (2)

TRADE MARKS ACT (Act 194 of 1993) (cont.)

- Geographical indications applied for for protection as either certification or collective trade marks must still pass the threshold of being registrable trade marks for purposes of Sections 9 and 10 of the Trade Marks Act.
- Such geographical indications must still serve the basic trade mark function of being **capable of distinguishing** and may **not consist exclusively** of a sign or an indication which may designate kind, quality, quantity or geographical origin of goods or services.

STATUTORY PROTECTION (3)

MERCHANDISE MARKS ACT (Act 17 of 1941)

- This Act deals with (i) trade descriptions, (ii) ambush marketing and (iii) prohibition on the use of certain marks.
- This Act has in the past been used as an *interim measure* to afford protection to geographical indications in relation to agricultural food products (excluding wines and spirits).

“Section 15 - Use of certain marks may be prohibited

(1) The Minister may, after such investigation as he or she may think fit, by notice in the Gazette, prohibit either absolutely or conditionally the use of-

(b) any mark, word, letter or figure or any arrangement or combination thereof, in connection with any trade, business, profession, occupation or event, or in connection with a trade mark, mark or trade description applied to goods.”

STATUTORY PROTECTION (3)

MERCHANDISE MARKS ACT (Act 17 of 1941) (cont.)

- Protection in terms of the Merchandise Marks Act is an absolute protection in relation to any use of the prohibited mark and is not limited to specific goods or services as trade marks are; nor is it required to be capable of distinguishing and there are no time limits attached to the use of the protected mark.
- Protection in terms of the Merchandise Marks Act is – as any other intellectual property right – granted as a civil right and it is the responsibility of the right holder to protect the right through the civil remedies available therefore.

STATUTORY PROTECTION (4)

AGRICULTURAL PRODUCT STANDARDS ACT (Act 119 of 1990)

- This Act, as the Liquor Products Act, falls under the mandate of, and is administered by, the national Department of Agriculture, Forestry and Fisheries (“DAFF”).
- Section 6A of the Agricultural Product Standards Act grants the relevant Minister the power to prohibit the unauthorised use of specified geographical names or terms, in connection with the sale or export of a specified product, on such conditions as may be specified.
- The Act is applicable to agricultural products, excluding wines and spirits.
- Changes to the Act, as well as implementing regulations, to allow for creation of agricultural geographical indications in relation to agricultural products, excluding wines and spirits, in South Africa, is being envisaged by the implementing department.

IN CONCLUSION

- South Africa, through several avenues, provides adequate protection for geographical indications.
- This protection is sound, well-tested and imbedded in the national legal IP framework of South Africa.

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