

Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications

Thirty-Ninth Session
Geneva, April 23 to 26, 2018

COMPILATION OF A LIST OF QUESTIONS PROPOSED BY MEMBERS AND
INTERGOVERNMENTAL INTELLECTUAL PROPERTY ORGANIZATIONS WITH
OBSERVER STATUS ON TOPICS REFERRED TO IN THE WORKPLAN ON
GEOGRAPHICAL INDICATIONS

INTRODUCTION

1. It is recalled that, in the framework of the thirty-seventh session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), which was held in Geneva from March 27 to 30, 2017, an Information Session on Geographical Indications took place on March 28, 2017.
2. At the thirty-eighth session of the SCT, which was held in Geneva from October 30 to November 2, 2017, the SCT adopted its Workplan on Geographical Indications, as reflected in the Summary by the Chair of the SCT (see the Annex to document SCT/38/5).
3. In accordance with the Workplan on Geographical Indications, the Chair of the SCT requested the Secretariat “to compile a list of questions proposed by Members and Intergovernmental Intellectual Property Organizations with observer status¹, for consideration by the SCT, which could form the basis of a questionnaire to be distributed to Members and the aforementioned Organizations. The list of questions will be structured according to the following topics:

¹ *i.e.*, organizations which, under their constituting treaty, have responsibility for the protection of industrial property rights.

I. The national and regional systems that can provide a certain protection to geographical indications

- Basis for protection (sign/indication subject of protection, goods/services covered, etc.).
- Application and registration (entitlement to file, content of application, grounds for refusal, examination and opposition, ownership/right of use, requests for protection from other countries...).
- Scope of protection, right to take action and enforcement.

II. The use/misuse of geographical indications, country names and geographical terms on the Internet and in the DNS, including TLDs, gTLDs and ccTLDs (examples, cases, mechanisms to address misuse, basis for protection where appropriate).”

4. The Workplan also included a timetable for its implementation. According to this timetable, in November 2017, the Secretariat would send a circular inviting Members and the aforementioned Organizations to propose the questions referred to above. Accordingly, under Circular letter C. 8707 of November 27, 2017, the Secretariat invited Members and the aforementioned Organizations to propose questions as per the Workplan.

5. At the closing date to reply to the above-mentioned invitation (*i.e.*, on February 6, 2018), individual submissions from the following Member States had been received: Ecuador, France, Mexico, Poland, Republic of Moldova and Switzerland (6). The following Member States sent a joint reply: Argentina, Australia, Chile, Panama, Republic of Korea, United States of America and Uruguay (7). The European Union, in its capacity as a special member of the SCT, also sent a submission to the Secretariat (1). After the closing date to reply to the above-mentioned invitation, individual submissions from the following Member States were received: Brazil, Chile, Colombia and Israel (4).

6. The present document is a revised version of document SCT/39/6. It compiles all the questions communicated to the Secretariat by the deadline indicated in the Workplan, *i.e.* February 6, 2018, as well as all questions received after said deadline (*i.e.*, questions number 36 to 54 and 127 to 146). Although some of the questions may be deemed to overlap, the document reproduces all the questions as such and *in extenso*, according to the structure provided for in the Workplan.

7. The full text of the submissions is posted on the SCT Electronic Forum webpage at <http://www.wipo.int/sct/en/>.

LIST OF QUESTIONS

I. The national and regional systems that can provide a certain protection to geographical indications

A. Basis for protection (sign/indication subject of protection, goods/services covered, etc...)

- (1) The protection of geographical indications shall be ensured by the following:
 - *sui generis* system
 - collective trademarks
 - certification trademarks
 - specific laws
 - others
- (2) Where the protection of geographical indications is ensured by the *sui generis* system, then:
 - the appellation of origin and the geographical indication are each defined individually
 - only the appellation of origin is defined
 - only the geographical indication is defined
- (3) The protection of geographical indications shall be ensured:
 - under the registration via the national procedure
 - under the international agreements
 - under the bilateral agreements
- (4) The protection of geographical indications shall be ensured:
 - exclusively for agri-food products (agricultural products, wines,...)
 - for any type of product
 - for services
- (5) Registration as geographical indications may be requested:
 - exclusively for geographic terms
 - for non-geographic terms
 - for country name (on an exceptional basis or not)
- (6) All countries are culturally diverse. Bearing in mind that Member States have countless handicraft products bearing the hallmarks of their culture, would you argue that it would be appropriate to include this type of protection under geographical indications at the international level?
- (7) What would be the international standard for situations in which it is feasible to grant a geographical indication for several products?
- (8) What type of protection and what procedures relate to appellations of origin, geographical indications and indications of source?

- (9) Does the available protection mechanism specifically identify geographical indications as distinct from other protected signs or designations protected under the same mechanism? If yes, please explain how.
- (10) Does the available protection mechanism recognize geographical indications as the object of an intellectual property right? If yes, is such protection mechanism a *sui generis* system or part of another intellectual property regime (*i.e.* trade mark law, etc.)?
- (11) Does the available protection mechanism require the causal link between a given quality, the reputation or other characteristics of the product on the one hand, and its geographical origin on the other, to be expressed and justified?
- (12) Which definition of geographical indications is used in your country, the one found in the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) or another definition?
- (13) What is the range of geographical indication protection in your country? What products are covered?
- (14) In addition to registration as an intellectual property right, are there other means of protecting a geographical indication (such as food standards, court decisions, sectoral legislation or regulations)? Describe the various laws, mechanisms and/or systems for obtaining exclusive use of a geographical indication.
- (15) *Protection Systems and Examination Authority* - Does your legislation establish a geographical indication registry?
- (16) *Protection Systems and Examination Authority* - According to your legislation, are there any other means, other than a registry, for the recognition and protection of geographical indications?
- (17) *Protection Systems and Examination Authority* - Can geographical indications be protected as trademarks, collective marks, and/or certification marks in your country?
- (18) *Protection Systems and Examination Authority* - Are foreign geographical indications protectable in your country?
- (19) *Protection Systems and Examination Authority* - Do you have a separate *sui generis* protection system for 1) domestic geographical indications, or 2) foreign geographical indications?
- (20) *Protection Systems and Examination Authority* - Are geographical indications for which protection is sought via international agreements assessed before a decision is made to protect them? Does this assessment align with domestic processes for geographical indication examination?
- (21) *Protection Systems and Examination Authority* - If geographical indications protected under international agreements are not assessed under a process equivalent to a domestic process for geographical indication examination, does the protection offered differ between the two?
- (22) *Protection Systems and Examination Authority* - What domestic agencies are responsible for determining whether a domestic geographic designation is a geographical indication? A foreign origin geographical indication?

- (23) *Eligible Subject Matter - For the following question, if you indicated that your country has multiple protection systems, please identify to which one your answer to the following applies - How is a geographical indication defined in your country?*
- (24) *Eligible Subject Matter - For the following question, if you indicated that your country has multiple protection systems, please identify to which one your answer to the following applies - If you have a sui generis regime for the protection of geographical indications and that regime does not protect geographical indications for all goods and/or services, which types or categories of goods and/or services are eligible for such geographical indication protection? Are goods other than agricultural products or wines/spirits protectable? How are other goods and/or services protected?*
- (25) *Eligible Subject Matter - For the following question, if you indicated that your country has multiple protection systems, please identify to which one your answer to the following applies - Is there any limitation on the size of the production area to which a geographic designation can refer?*
- (26) *Eligible Subject Matter - For the following question, if you indicated that your country has multiple protection systems, please identify to which one your answer to the following applies - Is a geographical indication composed of figurative elements or the abbreviation of a geographical name protectable? If so, please provide a particular example.*
- (27) *Eligible Subject Matter - For the following question, if you indicated that your country has multiple protection systems, please identify to which one your answer to the following applies - If a geographical indication is protected in the country of origin under a sui generis regime, can that geographical indication be accepted for registration in your certification mark system? Please also answer if the reverse is true for your country, that is, if the geographical indication is protected as a certification trademark in the country of origin, can the geographical indication be accepted for registration in your sui generis regime?*
- (28) *Eligible Subject Matter - For the following question, if you indicated that your country has multiple protection systems, please identify to which one your answer to the following applies - If not, what is the rationale for making it a prerequisite that the instrument of protection be identical in both countries, rather than just substantially equivalent?*
- (29) What are the categories of goods that are protected by geographical indications? Are there different kinds of geographical indications for different categories of goods (e.g. marble as a non-agricultural geographical indication)? If yes, please explain.
- (30) What kind of specific characteristics of goods determines that they may be registered as ageographical indication? Following the registration of ageographical indication, do you provide any kind of measures to control/monitor whether those specific characteristics of the goods are maintained?
- (31) For geographical indications for products, the link to the geographical area is decisive for quality and reputational purposes. Thus, with regard to a geographical indication for services, given that the characteristics could be replicated in another region owing to the nature of the figure, how are these characteristics determined?
- (32) In different national systems, in the absence of bilateral, regional or multilateral agreements, how are rules for the recognition and protection of geographical indications outside the national territory determined?

- (33) What systems, mechanisms and laws enable the beneficiaries of a geographical indication to obtain an exclusive right of use of the denomination concerned? What procedures and costs are required by such systems, mechanisms and laws? Please indicate, wherever relevant, the various systems, mechanisms and laws in your answers to the following questions and, whenever possible, provide examples.
- (34) Apart from registrations of an intellectual property right, are there any other legal options that can restrict the right to use the geographical indication to beneficiaries of the said geographical indication?
- (35) What are the required conditions to obtain protection of a geographical indication?
- (36) Can geographical indications and appellations of origin be used to designate services?
- (37) If so, how is the causal link between the quality, characteristics and reputation of the service and the defined geographical area determined?
- (38) In this case, what are the requirements for authorizations to use the geographical indication or appellation of origin and how are recognition or protection procedures carried out in third countries?
- (39) What difficulties or benefits may arise if such a service appellation is accepted?
- (40) Can an appellation of origin or geographical indication designate a living animal?
- (41) Can appellations of origin or geographical indications be composed of figurative elements?
- (42) Is it possible for an appellation of origin or geographical indication to designate more than one product and/or service which are in different classes of the Nice Classification?
- (43) Is it possible for the same geographical location to be part of different appellations of origin designating different products?
- (44) Can geographical indications and appellations of origin be used to designate artisanal products?
- (45) In the case of appellations of origin designating artisanal products, how stringent is the natural factor requirement?
- (46) What are artisanal products?
- (47) *Protection Systems* – Identify the main features of your geographical indication recognition and protection system, including the duration of protection, requirements for maintaining protection and the factors that could lead to loss of protection
- (48) *Protection Systems* – If your national legislation provides for two or more geographical indication recognition and protection systems, can the different protection systems coexist?
- (49) *Requirements for the Recognition and Protection of Geographical Indications According to Available Systems* – What kind of products can be protected through geographical indications under your legislation?

- (50) *Protection of Foreign Geographical Indications*– Can geographical indications be recognized by means of bilateral international treaties? What is the value and level of protection of these geographical indications under your national legislation? Are they treated differently from geographical indications applied for according to your domestic procedure?
- (51) *Examination Authority* – Does your country recognize geographical indications as an unregistered right?
- (52) *Eligible Subject Matter* – Where a geographical indication is composite of a place name and a common product name or other common elements, such as “Camembert de Normandie” what is the scope of the protection deriving from the composite geographical indication? Is protection for such common elements disclaimed? How may the public understand the scope of the protection?
- (53) *Eligible Subject Matter* – Where such a composite geographical indication exists with regard to a particular product category (such as cheese), is there any prohibition on developing and protecting a subsequent geographical indication from that same area with regard to a different product within that same category (such as a different type of cheese) or with respect to a different product type (such as fruit)? If so, could the development of such a subsequent geographical indication be achieved without being deemed as a form of dilution?
- (54) What measures would allow the recognition of geographical indications at the international level related to non-agricultural products, such as products from nature, manufactured goods, handicrafts and services?

B. Application and registration (entitlement to file, content of application, grounds for refusal, examination and opposition, ownership/right of use, requests for protection from other countries...)

(55) The request for the registration of a geographical indication may be filed by:

- a group (association)
- a legal entity
- a natural person
- a public institution

(please specify if there are certain specific requirements)

(56) The request for the registration of geographical indications shall be filed with:

- the National Office of industrial/intellectual property
- other institution (ministry, ...)

(please specify the name of institution/institutions)

(57) The request for the registration of a geographical indication shall be filed:

- on a standard form
- in free form

- (58) The request/application for the registration of a geographical indication shall be accompanied by:
- the product specification (approved by an authorized institution)
 - the single document (document setting out the main points of the specification)
 - the status of the group
 - other documents (to be specified)
- (59) The applicant group/person:
- must have its head office in the defined geographical area
 - must provide confirmation of activating in the defined geographical area
 - there are no requirements concerning the legal address of the person requesting registration
- (60) The request for the registration of a geographical indication shall be filed:
- on paper carrier
 - by e-mail, fax
 - in electronic format (on-line)
- (61) Registration of geographical indications is subject to payment of a fee:
- yes
 - no
- (62) Registration of geographical indications shall imply the following fees:
- a single fee
 - for filing an application
 - for publication
 - for examination
 - for registration
 - for granting the right to use
 - for filing an opposition/appeal
 - other fees (to be specified)
- (63) The grounds for refusal to register a geographical indication may be:
- absolute (misleading, contrary to the public order or morality etc.)
 - relative (conflict with earlier rights – trademark right, the right to a name, etc.)
- (64) Geographical indications may coexist with other prior intellectual property objects (and under what conditions):
- with homonymous geographical indications
 - with registered trademarks
 - names of plant varieties, animal breeds
- (65) When applying for registration of a trademark which contains a protected geographical indication and which would conflict with the rights conferred by the registration of that geographical indication:

- the trademark shall be refused only in relation to the goods identical/similar to the goods that correspond to the protected geographical indication
 - the trademark shall be refused for goods different from the goods that correspond to a protected geographical indication, including for services
 - the trademark shall not be refused
- (66) The right to use a protected geographical indication:
- shall be obtained without additional procedures following registration of the geographical indication (by the group/person that filed the application for registration)
 - shall be granted through a separate procedure (to be specified)
 - shall be granted for a limited time
- (67) In order to obtain the right to use, the person must join the group that requested registration of the geographical indication:
- yes
 - no
- (68) The list of persons holding the right to use:
- shall be kept by the authority registering the geographical indications
 - shall be kept by other institutions (please, specify the names)
 - shall be kept by the group that requested registration of the geographical indication
- (69) The list of persons holding the right to use:
- shall be public (regularly updated lists, databases, ...)
 - shall not be public
- (70) Third parties may submit:
- observations (following publication of the application that has not undergone substantive examination)
 - oppositions (following publication of the application that has not undergone substantive examination)
 - appeals (following publication of the application that has undergone substantive examination)
- (71) Official control shall cover:
- verification of a product's conformity with the hygiene and health standards
 - verification of a product's conformity with the corresponding product specification
 - verification of traceability
 - other actions (to be specified)
- (72) Verification of a product's conformity with the corresponding product specification shall be carried out by:
- state institutions
 - private institutions
 - state or private institutions

- (73) If the official control is carried out by a public authority/state institution, the latter:
- shall be accredited by the certification body
 - shall not be accredited by the certification body
- (74) The products marketed under a protected geographical indication:
- shall be marked with certain inscriptions (to be specified)
 - shall be marked with certain symbols (to be specified)
- (75) In order to request protection in other countries:
- national registration shall be required
 - national registration shall not be required
- (76) The term of protection granted to a geographical indication shall be:
- limited
 - unlimited
- (77) If the term of protection granted to a geographical indication is limited, then the period shall be:
- 10 years with the possibility of renewal
 - five years with the possibility of renewal
 - other provisions
- (78) If the term of protection granted to a geographical indication is limited, then renewal shall be possible:
- subject to the presentation of supporting documents
 - without any conditions, upon simple request
- (79) Protection of geographical indications from other countries may be obtained:
- on the same conditions as apply to the national geographical indications
 - under simplified conditions, providing the geographical indications are protected in their country of origin
- (80) Under the available protection mechanism, is the test for determining whether a term has become generic, limited to the factual circumstances in the particular territory (following the so-called “territoriality principle”)?
- (81) Does the available protection mechanism require that in order to maintain protection for a registered geographical indication, the denomination must be used on the market? If yes, what frequency of use is required?
- (82) Does your legislation recognize the possibility for registration/protection of geographical indications from outside your home territory? If yes, please describe available protection mechanism(s).
- (83) *Application* - If your country has a geographical indication registry, what are the specific requirements for the registration of a geographical indication and what are the associated costs?

- (84) *Application* - Who is the appropriate legal person to apply for geographical indication protection? Are the national, regional or provincial authorities entitled to apply for geographical indications located within their geographical jurisdictions? Is this "person" considered to be the title holder of the geographical indication? If not, what entity is for purposes of civil enforcement?
- (85) *Application* - Does your legislation require a representative or agent to process a geographical indication application?
- (86) *Application* - Is documentation required to be submitted to establish a link between the good/service with the geographic origin? If so, what types of evidence would suffice?
- (87) *Application* - Is there a requirement that someone in your country visit the geographical origin of the good/service in order to determine whether that link is accurate? For domestic geographical indication applications? For foreign geographical indication applications?
- (88) *Application* - Are production standards, beyond geographic origin, required to be submitted? If so, in what form?
- (89) *Application* - Are domestic geographical indications required to demonstrate reputation as a condition for obtaining protection? Foreign geographical indications? Is reputation described in your relevant legislation as an element linked to the geographical origin of the good or service? If so, where must that reputation exist for the foreign geographical indications – in the country of origin or the territory in which protection is sought?
- (90) *Application* - What evidence is required to establish a link between the reputation and the geographic designation, if applicable?
- (91) *Application* - Is there any administrative fee to apply for geographical indication protection? If there is a fee, what is the fee for domestic applications? For foreign geographical indication applications? For foreign applications filed via international agreements?
- (92) *Application* - Does your geographical indication system provide for the protections of translations or transliterations? Is this protection automatic, or is there a requirement for identifying the specific translations or transliterations for which protection is sought? Who determines what is a translation or a transliteration of a geographical indication?
- (93) *Application* - Are the translations or transliterations for which protection is sought published as such for the benefit of the public and third parties?
- (94) *Examination* - Is geographical indication protection automatically conferred under your law when protection exists in the country of origin for a foreign geographical indication?
- (95) *Examination* - Can a geographical indication be protected under your law even if the term is not protected as a geographical indication in the country of origin?
- (96) *Examination* - What are the grounds for refusing protection/recognition of a geographical indication?

- If a product owes its reputation to its geographical origin, is that enough for it to receive protection/recognition as a geographical indication, without necessarily having to possess a different quality?
 - If an essential link between the quality, reputation, and/or other characteristic of the goods and geographical origin must be established in order for the geographical indication to be protected/recognized, what is the standard for recognizing/accepting said link?
 - If only one stage of its preparation, processing, or production takes places in the defined region, is that enough for the protection/recognition of the geographical indication?
- (97) *Examination* - Is a determination that the proposed term is generic for the goods/services in your country a ground for refusing protection or recognition of the term as a geographical indication?
- (98) *Examination* - What are the criteria for determining if a proposed term is considered to be generic?
- Does the relevant examination authority consider sources such as whether the proposed term is found in dictionaries, relevant websites, databases, or in international standards?
 - Does the relevant examination authority give consideration as to whether the product that is identified by the proposed term is already produced and sold in your country by different producers; imported into your country from outside the proposed protected region or manufactured and traded outside the protected region? That is, is the examination authority required to consider whether the term is common in trade?
- (99) *Examination* - What role does consumer perception in your country have with determining whether a term is considered generic? In other words, who is the audience for evaluating whether a term is thought to be a generic or common term that describes a category of goods or services that can come from anywhere and how is the consumer's perception solicited, e.g., survey, national newspapers, etc.?
- (100) *Examination* - Regarding proposed compound terms consisting of multiple components, will an individual term that is perceived to be generic in your country remain available for public use? If yes, how is the public notified of such decision?
- (101) *Examination* - Are prior trademark rights a ground of refusal for a later applied for or requested geographical indication? What if a prior trademark contains a generic element that conflicts with an applied for geographical indication? Is the geographical indication refused based on genericness or based on the prior trademark right, or both?
- (102) *Examination* - Are competition principles considered as part of the examination process?
- (103) *Examination* - Does your legislation allow for the coexistence between trademarks and geographical indications?

- (104) *Examination* - Regarding homonymous geographical indications, does your legislation recognize homonymous geographical indications? If yes, for which types of goods or services?
- (105) *Opposition* - Are applications for geographical indication protection published for opposition or public notice? Does this apply to both domestic and foreign geographical indications as well as foreign geographical indication protected via international agreements?
- (106) *Opposition* - Can a request for geographical indication protection be opposed by a third party? What are the grounds for opposition? If a request for geographical indication protection can be opposed by a third party, how is the public notified of a decision on such an opposition?
- (107) *Invalidation* - Can a registered geographical indication be invalidated, whether it is domestic, foreign, or foreign geographical indication recognized via an international agreement?
- (108) *Invalidation* - What are the available grounds for invalidation?
- (109) *Maintenance and Authorization for Use* - In most countries, there is a prohibition on use of a certification mark by its owner for the certified goods. Does this prohibition preclude use of the certification marks to protect geographical indications geographical indications “owned” by their beneficiaries? For example, can a certification mark owned by an association with legal personality be used by members of that association?
- (110) *Maintenance and Authorization for Use* - Is there a requirement to use or enforce the registered (or unregistered) geographical indication to maintain rights in the geographical indication and avoid a claim of abandonment or acquiescence?
- (111) *Maintenance and Authorization for Use* - Is there a mechanism for third parties to seek cancellation of protection on the basis that the geographical indication is not in use in the territory concerned?
- (112) *Maintenance and Authorization for Use* - Are there requirements to renew a geographical indication registration for the geographical indication protection to remain in force?
- (113) *Maintenance and Authorization for Use* - Is there a procedure to become an authorized user, and is periodic renewal required for an authorized use to continue?
- (114) *Maintenance and Authorization for Use* - Is there capacity to amend a geographical indication once it is protected? If so, what is the process?
- (115) *Maintenance and Authorization for Use* - If your legislation protects homonymous geographical indications, what are the means that your legislation provides/foresees to avoid confusion in the case of homonymous geographical indications?
- (116) Where genericity is considered as a ground for refusing a geographical indication, are there specific guidelines for determining this characteristic?
- (117) Is the previous questioning applicable to supervening genericity?
- (118) Who can apply for the registration or protection of a geographical indication?

- (119) Is it necessary to demonstrate a link between the quality and reputation or another given characteristic of the product concerned and its geographical origin? If so, who is obliged to demonstrate such a link (e.g.: producer groups/beneficiaries of the geographical indication)?
- (120) Are there any databases making an inventory of information on geographical indications that are protected either nationally or regionally? Are these databases freely accessible to the public?
- (121) Do the laws or standards applied to products designated by a geographical name ensure that the use of such geographical names is restricted to the corresponding beneficiaries of the geographical indication?
- (122) Is protection of a geographical indication granted for an unlimited period? If protection is granted for a limited period, what are the conditions required for the renewal of said protection? Is demonstration of the link mentioned in question 100 subject to a new examination?
- (123) Can a geographical indication be protected and coexist with earlier marks that are totally or partially homonymous? If so, what are the conditions for such coexistence?
- (124) Can the use of a geographical indication be restricted to the beneficiaries thereof without formally identifying a holder of the geographical indication?
- (125) Does the use of a geographical indication require authorization? If so, what are the conditions and possible costs of this authorization for the beneficiaries?
- (126) Is the use of a geographical indication by the beneficiaries subject to regular, independent monitoring?
- (127) *Procedure for the Recognition and Protection of Geographical Indications* – Briefly describe the stages of the application and registration procedure for a geographical indication.
- (128) *Procedure for the Recognition and Protection of Geographical Indications* – If producers are applying for a geographical indication, is proof of association required?
- (129) *Requirements for the Recognition and Protection of Geographical Indications According to Available Systems* – How are the specific characteristics of products eligible for protection technically ascertained?
- (130) *Requirements for the Recognition and Protection of Geographical Indications According to Available Systems* – In your legislation, which is the competent authority for conducting examinations of the technical requirements to be met by the geographical indication?
- (131) *Possibility of Homonymity for Geographical Indications* – If your legislation does not provide express protection for homonymous geographical indications, is there in practice another mechanism for achieving coexistence?
- (132) *Refusal of Registration* – Are there procedures for opposition by third parties? Who has the right to lodge an opposition?
- (133) *Refusal of Registration* – If recognition of a geographical indication is sought and there is already a registered trademark with that designation, could the geographical

indication applied for be refused registration? Could an order instead be made to cancel the prior registration of the owner of the trademark? Finally, is the co-existence of both rights established?

- (134) *Refusal of Registration* – Is co-existence between trademarks and geographical indications allowed in your legislation? If so, does one system prevail over the other?
- (135) *Existence of National Programs to Support Products of Recognized Origin Through Geographical Indications* – Does your country have support programs for producers of goods recognized or protected by geographical indications?
- (136) *Existence of National Programs to Support Products of Recognized Origin Through Geographical Indications* – If so, how are they financed, and how are the results of such programs measured?
- (137) *Examination Authority* – Does your country maintain a register for geographical indications (as that term is understood under the TRIPS Agreement)? If so, is registration contingent upon compliance with a domestic examination for formal and substantive eligibility? Is registration made pursuant to a classification system (if so, please specify which classification system)?
- (138) *Examination Authority* – Does your country maintain a register for appellations of origin (as that term is understood under the Lisbon Agreement)? If so, is registration contingent upon compliance with a domestic examination for formal and substantive eligibility? Is registration made pursuant to a classification system (if so, please specify which classification system)?
- (139) *Eligible Subject Matter* – Is there any limitation on the size of the production area to which a geographic designation can refer? By what criteria, if any, are production area boundaries set? Are such boundaries subject to an examination or other review process? Can a third party request the reduction or expansion of a production area?
- (140) *Eligible Subject Matter* – Can the production area exceed the geographic boundaries of the place identified by the geographic designation? If so, would your authorities substantiate the grant of the geographical indication based on the fact that the reputation of the geographical indication covers a larger area than the modern day administrative boundaries of the geographic name? After production area boundaries have been established, can they subsequently be expanded? If so, is there any criteria that must be fulfilled as a condition to such expansion?
- (141) *Eligible Subject Matter* – In your country are there circumstances under which similar trademarks and geographical indications can co-exist? Or are they mutually exclusive rights? If they are mutually exclusive how is priority of right determined as between them?
- (142) *Application* – Once a geographical indication has been established, is that geographical indication open to all producers of the registered product from that same region regardless of whether those producers began production subsequent to the creation of the geographical indication?

- (143) *Application* – Are domestic geographical indications required to demonstrate reputation as a geographical indication as a condition for obtaining protection? Foreign geographical indications? Is reputation described in your relevant legislation as an element linked to the geographical origin of the good or service? If so, where must that reputation exist for the foreign geographical indications?
- (144) *Application* – What evidence, if any, is required to establish a link between the product bearing the geographical indication and a given quality or characteristic of such product that is essentially attributable to its geographic origin?
- (145) What would be the efforts to approximate national legislation in order to make it easier to protect this intellectual property asset at the international level?
- (146) What are the forecasts for the extension of the concept of geographical indications to the other economic sectors not restricted to agri-food products, wines and distilled beverages, such as handicrafts, manufactured products, minerals and miscellaneous services?
- C. Scope of protection, right to take action and enforcement
- (147) Surveillance of the use of protected geographical indications on the market:
- shall be carried out by the following institutions (to be specified)
 - shall not be carried out
- (148) Surveillance of the use of protected geographical indications on the market aims to:
- prevent abusive use of geographical indications
 - protect the consumer
 - both
- (149) Protection of the geographical indications at the customs border shall be ensured:
- *ex officio*
 - based on the application for intervention
- (150) Any action concerning infringement of rights in relation to a geographical indication may be initiated by:
- the holder of the right to use a protected geographical indication
 - a person entitled to represent the holder of the right to use
 - other institutions/organizations (to be specified)
- (151) Does the available protection mechanism provide for protection of geographical indications against unauthorized use/against use taking unfair advantage of, or detrimental to, the repute of the denomination?
- (152) Please describe all enforcement measures available for geographical indications in your legislation, including administrative controls, judicial remedies and targeted anti-counterfeiting measures (Omit internet-based measures covered in Questionnaire II)
- (153) In your country, is the protection mechanism *ex officio* or *ex parte*?

- (154) Are any anti-counterfeiting measures enforced in relation to geographical indications in your country, particularly through border controls and customs seizure of counterfeit products?
- (155) Does the protection mechanism in your country protect against usurpation (identical or similar products) but also against misappropriation of notoriety (other products)?
- (156) *Enforcement* - Once a geographical indication is protected in your country, who bears responsibility for preventing unauthorized use?
- What are the contact details of the relevant competent authorities for administrative enforcement?
 - Are there any timeframes for action?
 - Are there any mechanisms for redress or appeal for either concerned party over an administrative enforcement action?
- (157) *Enforcement* - Do you offer administrative enforcement by way of an administrative standard of identity labeling system? For example, do your food regulatory agencies issue administrative standards for labeling food products bearing a particular geographical indication?
- (158) *Enforcement* - Is a civil infringement action available to right holders or authorized users to address geographical indication infringement?
- (159) *Enforcement* - What responsibilities does the rights holder have to ensure that the geographical indication is not infringed or used without authorization?
- (160) *Enforcement* - Does your country have a register for authorized users?
- (161) *Enforcement* - Who has legal standing to bring enforcement action on the registration?
- (162) *Enforcement* - Can the geographical indication registration be recorded or otherwise notified at the border to prevent entry of unauthorized goods?
- (163) *Enforcement* - What sanctions are available for the use of a protected geographical indication without the authorization of the owner/any registered user for the same type of good or service, and for a different type of good or service?
- (164) *Enforcement* - Regarding the compound terms consisting of multiple components (for example, "Parmigiano reggiano"), can you bring an action against a third party's unauthorized use of only one component (such as "Parmigiano")?
- (165) Does any member state regulate unfair competition arising from the evocation of a geographical indication? In that case, does this cover only products of the same species or of a different nature? Does this evocation have to be graphic or is there allowance for some other kind of connection (phonetic, for example)?
- (166) Is it feasible to protect elements associated with a geographical indication, for example, aromas or textures of the products? In other words, would the protection of non-traditional geographical indications be feasible, as in the trademark system?
- (167) What is the scope of protection of geographical indications? Are there any differences according to the products concerned or the systems, mechanisms and laws considered?

- (168) Can a geographical indication be used as a trademark? If so, how can these marks be distinguished from other marks that are not geographical indications? Is there a list of geographical indications that are protected as marks?
- (169) Can a denomination that constitutes a geographical indication be registered as a word mark? Or can it only be registered if combined with several other word elements and/or figurative elements?
- (170) Does the protection of a geographical indication require its effective use in the market of the territory concerned?
- (171) Does the protection of geographical indications take into account translations, modified forms and limitations?
- (172) Does the protection of geographical indications take into account the characteristic form of the product, when there is one?
- (173) What procedures are available in the case of an infringement of rights relating to a geographical indication? Do you have any information on costs?
- (174) *Rights and Enforcement of Geographical Indications* – What rights are granted to geographical indication holders?
- (175) *Rights and Enforcement of Geographical Indications* - What are the measures under your legislation to deal with infringers of the rights conferred by geographical indications?
- (176) *Rights and Enforcement of Geographical Indications* – Does your legislation establish border enforcement mechanisms for geographical indications? If so, are there ex officio mechanisms, or only at the request of interested parties?
- (177) *Rights and Enforcement of Geographical Indications* – Is there provision for measures for the destruction of allegedly infringing property? If so, is a prior court order necessary for destruction?
- (178) *Enforcement* – Does your law recognize a defense to infringement based on acquiescence following a prolonged period of non-enforcement of a geographical indication or on the basis that the term has de facto become customary in the common language of the territory? If so, under what conditions?
- (179) *Enforcement* – Is a civil infringement action available to right holders or authorized users to address geographical indication infringement? If so, what remedies are available in such action?
- (180) In the case of protection of geographical indications of products and services, the limits of protection remain. Is protection limited only to the distinctive sign or to related goods and services? For example, regarding a product that holds specific forms of preparation involving traditional knowledge, would it be in some way protected by geographical indications? Are the specifications or use regulations also part of the scope of protection?

- (181) In many countries the geographical indication is taken as a declarative and therefore pre-existing register. In this case, it remains to know if the right is retroactive to registration and how much retroactive is the right?
- (182) In the case of ownership of geographical indications, is the right to exclude third parties restricted only to the small group of organized producers or to all those established in the region? What role would the State play in enforcing this right, especially when products circulate in international trade?
- (183) Is there already an agenda for the development of clearer rules on product labelling in order to inform their real origin, avoiding unfair competition and consumer confusion?

II. **The use/misuse of geographical indications, country names and geographical terms on the Internet and in the DNS, including TLDs, gTLDs and ccTLDs (examples, cases, mechanisms to address misuse, basis for protection where appropriate)**

- (184) *Use/misuse on the Internet* - Does your national legislation provide for geographical indication protection against counterfeiting that occur on the internet? Does it provide for the protection of country names and names of geographical significance, including against misleading and/or unfair use on the internet? Which instruments does your country have in cases of geographical indication counterfeiting that occur on the internet? Does it have jurisdiction on the use of any denomination or trade description that may jeopardize country names and names of geographical significance?
- (185) *Use/misuse on the Internet* - What type of legal and technical instruments (binding or soft law) or dispute resolution mechanisms are available in your jurisdiction on the sale of counterfeit goods, or other forms of infringement, via the internet covering also geographical indications? In case there are soft law instruments available, e.g. memorandum of understanding, which major internet platforms have acceded to such a type of agreements? Please, distinguish between State measures (whether binding or not) and those taken on the initiative of private parties (either platforms or networks themselves or by agreement with third parties).
- (186) *Use/misuse in the DNS - Basis for protection* - The use of geographic, country names and indicators in the DNS can occur as second-level domain name (SLD) or as a top-level domain name (TLD), which in turn can be as a generic TLD (gTLD) or a country-code TLD (ccTLD). The current rules for such usages differ for the type of domain name. Are the current mechanisms in place, including eventual safeguards against possible abuse, working properly? Have any gaps been identified in terms of legal basis for the protection of geo-domain names? Does your country maintain a repository of protected/reserved names? Under what legal basis?
- (187) *Use/misuse in the DNS - Basis for protection* - On the basis of the national rules, can the beneficiaries of a geographical indication challenge the registration by judicial means or oppose an ongoing registration of a second-level of domain name linked to:
- domain name of first generic level (gSLD) (for example: X.vin OR X.wine), or
 - domain name of first national level (ccTLD) (for example: X.fr).

If so, please explain the procedure made available.

- (188) *Use/misuse in the DNS - ccTLDs* - Does the ccTLDs regulatory framework of your country mention geographical indications, country names and names of geographical significance (or IPRs in general) as valid titles to activate dispute resolution and curative mechanisms in case of cybersquatting? If yes, please provide examples of cases where the claim was based on a geographical indications or on any other IPRs title other than trademarks.
- (189) *Use/misuse in the DNS - ccTLDs* - In the ccTLD process, does your national legislation provide for measures, procedures and remedies for interested parties to prevent or invalidate the registration of geographical indications, country names and names of geographical significance as Second-level domains before an administrative or judicial authority? If yes, does your legislation allow to make an injunction to order the national registrar to prevent or invalidate registration?
- (190) *Use/misuse in the DNS - gTLDs* - Is there any role that the “WIPO Arbitration and Mediation Centre” might play to settle disputes concerning delegation as gTLDs of geographical names coinciding with geographical indications, country names and names of geographical significance, as in the field of trademarks?
- (191) *Use/misuse in the DNS - gTLD delegations* - Does the current legal and institutional framework for the delegation of “generic terms” as Top-level domains provide for sufficient international legal instruments to prevent the “ex ante” delegation of geographical indications, country names and names of geographical significance?
- (192) *Use/misuse in the DNS - gTLD delegations* - Under which conditions should the gTLDs process provide for the delegation of a geographical name, coinciding or not with a geographical indication, a country name or a name of geographical significance, as a Top-level domain? Is there any rule, legal measure, remedy or legal basis in your country suitable to prevent the delegation as Top-level domains of geographical indications, country names and names of geographical significance?
- (193) *Use/misuse in the DNS - gTLD delegations* - Trademark Clearinghouse” (TMCH) is a “rights protection mechanism” based on a database of signs built-in the gTLD program². The database is currently dedicated to trademarks. Would you support the use of this mechanism to prevent unauthorized delegation as gTLD of geographical indications, country names and names of geographical significance? If not, why not?
- (194) Do you have any legal (binding or otherwise) or technical tools to prevent illegal uses of geographical indications on websites (including social networks, non-commercial platforms) in your country? If there are legal tools of a non-binding nature (such as cooperation agreements) or technical measures (such as upstream blocking), which websites have adopted them?
- (195) What legal and/or technical means are available to identify the holder of a domain name in your country?
- (196) What are the timeframes and costs of proceedings against a domain name holder in your country in case of abusive registration?

² TMCH is a centralized database of verified trademarks that is connected to each and every new Top Level Domain (TLD) that is delegated. The insertion and verification of trademarks within the database of TMCH is made on a voluntary basis upon payment of a fee by the trademark holders, subject to the renewal.

- (197) In your country, what types of infringements of the geographical indication are punishable (such as cybersquatting, typosquatting, misappropriation of notoriety, dilution, denigration, other services, infringements on the domain name itself, metatags, keywords and other methods allowing referencing)?
- (198) Are there any systems in place to supervise registrars through, for example, state supervision or controls, or have they themselves made commitments in respect of protection?
- (199) Is the notion of “geographical term” defined in national or regional law? Are there any databases making an inventory of information on country names and/or geographical terms that are protected nationally or regionally? Are these databases freely accessible to the public?
- (200) What systems, mechanisms and laws ensure legal protection of country names and geographical terms and respectively combat the misuse thereof? Does this protection encompass modified forms of the geographical term? What rights are granted by these systems, mechanisms and laws? What are the procedures and costs required by such systems, mechanisms and laws? Please specify, wherever relevant, the various systems, mechanisms and laws in your reply to the following questions, and if possible, provide examples.
- (201) Are there any conditions for registering a second-level domain name, consisting of a geographical indication, a country name or a geographical name, or containing one such denomination or having similarities with one such denomination, in the ccTLD?
- (202) Is the registration, renewal and use of a domain name in the ccTLD subject to domiciliation in the country of the country code in question? Does the procedure for registration under a ccTLD require demonstration of a link between the country and the applicant /holder of the country domain name?
- (203) Is there a procedure, in the ccTLD of your country, for the settlement of disputes between a complainant and an adverse party relating to a domain name (UDRP or UDRP variant) that must be included in all contracts for the registration of a domain name?
- (204) If so, does this procedure recognize a right or claim against misuse that can be raised with regard to the registration of a domain name containing the following titles or terms:
- intellectual property right
 - geographical indication
 - appellations of origin
 - indication of source
 - country name
 - other geographical name.
- (205) Are there any frameworks, in your countries, for overseeing registrars (ccTLDs and/or gTLDs) consisting of, for example, supervision or direct control by the State, specific regulations or specific obligations imposed by the State?

- (206) Can the beneficiaries of a right relating to a geographical term (country name, indication of source, geographic indication or other geographic term) or the beneficiaries of any other claim against misuse legally contest the registration of a domain name, based on internal law:
- as a generic top level domain (gTLD)?
 - as a generic second level domain (gSLD)?
 - as a country code second-level domain (ccSLD)?
- (207) If so, have the judicial authorities (civil, criminal or administrative) of your country already ruled on a dispute involving a geographical term (country name, indication of source, or other geographical term) and a domain name?
- (208) If so, what was the final decision and what were the key considerations relating to this matter?
- (209) Has your Government (through one of its bodies or other regional or local administrative units) acquired one (or several) gTLDs that contain a geographical term referring to a country or a place inside the territory of the country (for example, .swiss, acquired by the Swiss Confederation)?
- (210) What is/would be the most appropriate manner in which to protect geographical terms from being improperly registered in the DNS?
- (211) What types of instruments or legal means are available for the beneficiaries of a geographical term (country name, indication of source, geographical indication) or of any other claim against misuse to prohibit or stop the sale of counterfeit products on the Internet (*i.e.* products displaying a false or incorrect indication of source)?
- (212) Are there any non-binding instruments of soft law (*e.g.* Memoranda of Understanding) to address Internet sales of goods that display a false or incorrect indication of source?
- (213) Do such instruments apply to domain name hosts?
- (214) What Internet platforms have committed to abide by such instruments?

8. The SCT is invited to consider the content of the present document.

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