

# Protecting Geographical Indications in Emerging Economies

(Brazil, Russia, India and China - BRICs Countries)

A Practical Manual for Producers' Groups

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# Protecting Geographical Indications in Emerging Economies (Brazil, Russia, India and China - BRICs Countries)

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A publication by oriGIn

Giorgio Bocedi

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## FOREWORD

Geographical Indications (GIs) are a global phenomenon. Both developed and developing countries are looking with interest at the socio-economical potential of GIs. In response, a growing number of national and regional laws have been adopting *sui generis* systems to protect GIs and are implementing public policies to help quality products deploy their full potential. Meanwhile, in global trade, GIs provide consumers with a guarantee of quality, and respond to an increasing demand in terms of information and transparency on the origin and properties of the goods they wish to purchase and on the processes through which they are produced. This phenomenon is particularly evident in emerging economies, where sustained economic growth has been producing burgeoning local middle classes and a radical change in food habits.

In this context, the most dynamic emerging economies represent an opportunity for GIs in terms of market potential, especially for those products which have acquired a reputation beyond national borders. While a truly international registry for GIs is still lacking, protecting GIs in third countries according to national rules and procedures – and in particular in the most important product’s export markets – is a priority and a challenge for producers’ groups. A priority in terms of benefiting from effective instruments to fight the increasing risks of product’s imitation and counterfeiting; a challenge with respect to the obstacles which a different linguistic and legal context might generate.

The oriGIn manual “Protecting Geographical Indications in Emerging Economies (Brazil, Russia, India and China - BRICs Countries)” is a comprehensive response to these issues. The manual looks at the laws on GIs currently in force in Brazil, Russia, India and China. These countries – commonly identified with the acronym “BRICs” – represent some of the most dynamic markets in the world. Deploying a practical approach, the manual analyses the legal instruments available to protect GIs, the extent of such protection, registration and renewal procedures, costs, enforcement mechanisms, as well as other practical information (such as local law firms, monitoring agencies, etc.).

We hope that the manual will be a useful and practical tool for producers’ groups interested in protecting and commercializing the GIs of which there are beneficiaries in BRIC countries.

**Ramón González Figueroa,**  
President, oriGIn /  
Director General,  
Consejo Regulador del Tequila (CRT)

**Roberto Varese**  
Chief, Department of Quality,  
Ministero delle Politiche Agricole  
Alimentari e Forestali (Mipaaf)

## ACKNOWLEDGEMENTS

The authors of this manual are: **Mr. Giorgio Bocedi**, lawyer and founder of GB Avvocati, a law firm specialized in intellectual property and food law, Reggio Emilia (Italy); **Mr. Federico Desimoni**, lawyer, food law expert, in-house legal counsel and Vice-Director of the “Consorzio del Prosciutto di Parma” (Italy); and **Mr. Richard Mendelson**, lawyer at Dickenson, Peatman & Fogarty in Napa, California, (USA) and Professor on wine law and geographical indications at the University of California, Berkeley School of Law, where he directs the Program on Wine Law and Policy.

The manual was finalized within the framework of a project on the protection of GIs at the international level, implemented by **oriGIn, the global alliance of GI producers**, with the financial support of the “**Ministero delle Politiche Agricole Alimentari e Forestali**” (Mpaaf). **Mr. Massimo Vittori**, Managing Director of oriGIn, was responsible for the overall management and coordination of the project. **Ms. Claire Victoria Shelden** was the editor.

## GEOGRAPHICAL INDICATIONS IN BRAZIL

by Giorgio Bocedi<sup>1 2</sup>

### Introduction

Brazil has a *sui generis* system for the protection of Geographical Indications (GIs), provided for under its Industrial Property Law (IPL), Federal Law no. 9279/96 of May 14, 1996. The Law, according to the “Sole Paragraph” of Article 182 of Title IV entitled “Geographical Indications”, was implemented by the National Institute for Industrial Property (INPI) through its Resolution no. 075 of November 28, 2000 (Resolution 75/00).

As of 31 July 2012, twenty-seven national GIs have been registered in Brazil<sup>3</sup>: six of them have been registered as “Denominações de Origem”. The other twenty-one names have registered as “Indicações de Procedência” (including “Vale dos Vinhedos”, “Pinto Bandera” and “Vales Uva Goethe” for wines). “Cachaça do Brasil” deserves a special mention: this name was recognized as a GI by Decree no. 4.062, of December 21, 2001, which also recognized the names “Cachaça” and “Brazil” as GIs. The Decree points out as well that the name “Cachaça” is exclusively of Brazilian tradition and use. In July 2007, the Association of Producers and Friends of Handmade Cachaça from Paraty obtained the recognition of “Paraty” as “Indicação de Procedência” for spirits of the Cachaça variety.

Meanwhile, as of 31 July 2012, four foreign GIs have been registered as “Denominações de Origem”: “Região dos Vinhos Verdes” (wine, Portugal), “Cognac” (spirit, France), “Franciacorta” (wine, Italy), and “San Daniele” (ham, Italy).<sup>4</sup>

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1 Legal adviser and founder of GB Avvocati, law firm in intellectual property and food law, Reggio Emilia, Italy.

2 Special thanks to Susana Serrão, General Coordinator for GI and Registers DICIG/CGIR, INPI, Brazil.

3 Cf. <[http://www.inpi.gov.br/images/stories/downloads/indicacao\\_geografica/pdf/LISTA\\_COM\\_AS\\_INDICAES\\_GEOGRFICAS\\_RECONHECIDAS\\_-\\_31-07-2.pdf](http://www.inpi.gov.br/images/stories/downloads/indicacao_geografica/pdf/LISTA_COM_AS_INDICAES_GEOGRFICAS_RECONHECIDAS_-_31-07-2.pdf)> (access of 31 July 2012)

4 Cf. <[http://www.inpi.gov.br/images/stories/downloads/indicacao\\_geografica/pdf/LISTA\\_COM\\_AS\\_INDICAES\\_GEOGRFICAS\\_RECONHECIDAS\\_-\\_31-07-2.pdf](http://www.inpi.gov.br/images/stories/downloads/indicacao_geografica/pdf/LISTA_COM_AS_INDICAES_GEOGRFICAS_RECONHECIDAS_-_31-07-2.pdf)> (access of 31 July 2012)

A long list of applications for both national and foreign names is currently pending before the Office.

## 1. The concepts of “Indicação de Procedência” and “Denominação de Origem”

Article 176 of the IPL, within the GI *genus*, distinguishes between “Indicações de Procedência” and “Denominações de Origem”.

An “Indicação de Procedência” is defined as “*the geographic name of a country, city, region or locality in its territory, which has become known as the center of extraction, production or manufacture of a given product or of the provision of a given service*” (Art. 177). The concept of “Indicação de Procedência” is based on the requirement that the name has a reputation due to its geographical origin. This concept is clearly compatible with the internationally recognized definition of GIs, as provided for by Art. 22.1 of the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS).

According to the IPL, a “Denominação de Origem” is defined as “*the geographical name of country, city, region or locality in its territory, used to designate a product or service of which the qualities or characteristics are exclusively or essentially due to the geographical environment, including natural and human factors*” (Art. 178). Although this definition uses the disjunctive “or” between the words “qualities” and “characteristics”, it is interesting to note that Art. 182 of the IPL demands that both requirements must be satisfied for “Denominações de Origem”.<sup>5</sup>

Both definitions include services within their scope. While the expression “geographical name” used in both definitions could be interpreted as excluding traditional names, the INPI clarifies that this concept includes traditional and usual product names.

Resolution 75/00 establishes that its provisions apply both to (i) the graphic representation and (ii) the figurative representation of the geographical name,

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5 Marsha A. Echols, *Geographical Indications for Food Products*, 2008 Kluwer Law International BV, The Netherlands, p. 127.

as well as to (iii) the figurative representation of the relevant geographical area (Art. 3).

Finally, according to the Brazilian law, when a geographical name has become the common name for designating a given product or service, it cannot become a GI.

## 2. Users

The Brazilian IPL establishes that “*The use of the geographical indication<sup>6</sup> shall be reserved to the producers and service providers established in that locality; for ‘Denominações de Origem’, quality requirements shall also be complied with*” (Art. 182).

The INPI website refers to the GI rights “owners”. It is possible as well to refer to them as GI users or to the associations representing them. In this respect, according to Art. 5 of Resolution 75/00, associations or institutions, and the legal persons representing the collectivity having the right to the exclusive use of the geographical name and established in the relevant territory, can apply for the registration of a GI, as representatives of producers or service providers. The above-mentioned provision highlights another important requirement: the use of a GI is restricted to producers and service providers established in the relevant geographical area.<sup>7</sup>

## 3. Registration Procedure

Article 1, Sole Paragraph of Decision 75/00 clarifies that the registration has a declarative effect, and implies no recognition of the GI: it means, in other words, that a GI might exist irrespectively of its registration.

### 3.1 Subjects entitled to apply for registration

Associations, institutions and the legal persons representing a collective entity that have the right to the exclusive use of the geographical name and are established in the relevant territory can apply for “Indicação de Procedência” and “Denominação de Origem” (Article 5, Resolution 75/00).

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6 Both “Indicações de Procedência” and “Denominações de Origem”.

7 Marsha A. Echols, *op. cit.*, p. 128.

## 3.2 Application procedure

### 3.2.1 Application for registration of a national GI

The requirements of the application for registration are provided for in Article 6 of Resolution 75/00. The application shall refer exclusively to a geographical name.

The application shall include:

I. The petition, which shall include:

- i) The geographical name;
- ii) A description of the product or the service;
- iii) The characteristics of the product or the service.

II. A document demonstrating the legal standing of the applicant.

III. The regulation of use of the geographical name.

IV. A document delimitating the geographical area.

V. Labels in the cases of graphic or figurative representations of the country, city, region or locality.

VI. A power of attorney, where necessary.

VII. A receipt of payment of the relevant fees.

Concerning the requirement referred to in point IV, in addition to the delimitation of the geographical area, the application shall further include, in the case of an “Indicação de Procedência”:

- a) elements demonstrating that the geographical name has become known as the center of extraction, production or manufacture of the product or the provision of the service;

- b) elements demonstrating the existence of a control structure on producers or service providers, which have the right to the exclusive use of the “Indicação de Procedência”, as well as on the product or provision of a service distinguished as an “Indicação de Procedência”;

- c) elements demonstrating that producers or providers of the service are established in the delimited geographical area and are carrying out, effectively, activities of production or provision of the service.

In case of a “Denominação de Origem”:

- a) a description of the qualities and characteristics that are, exclusively or essentially, due to the geographical environment, including natural and human factors;

- b) a description of the process or method of obtaining the product or the service, which shall be local, loyal and traditional;

- c) elements demonstrating the existence of a control structure on producers or providers of the service that have right to the exclusive use of the “Denominação de Origem”, as well as on the product or provision of service distinguished as “Denominação de Origem”;

- d) elements demonstrating that producers or providers of the service are established in the delimited geographical area and are carrying out, effectively, activities of production or provision of the service.

### 3.2.2 Application for registration of foreign GIs

If the application concerns a foreign geographical name, which is already recognized as a GI in its country of origin or by an international organization, the registration must be requested by the right owner. However, the practice shows that associations or legal persons representing the producers from third countries (the so-called beneficiaries of GI rights in jurisdictions which do not recognize a specific right owner or where the right owner is an independent body not involved in the production) can also apply for GI registration in Brazil.

Moreover, in case of foreign GIs, the documents mentioned in paragraph 3.2.1 may not be submitted, provided that the relevant elements arise from the official document that recognizes a GI in its country of origin. This document must be submitted in an authentic copy, accompanied by an official translation (Article 8, Resolution 75/00).

A standard application form is published on the INPI website: [http://www.inpi.gov.br/index.php?option=com\\_content&view=article&id=53:downloads-de-formularios&catid=76&Itemid=131](http://www.inpi.gov.br/index.php?option=com_content&view=article&id=53:downloads-de-formularios&catid=76&Itemid=131) (see also Annex I).

### 3.2.3 Examination, publication and opposition, recognition, and application for reconsideration.

**Examination:** When the application is filed before the INPI, a formal examination takes place.

**Publication and opposition:** If the INPI considers that the requirements of the legislation are met, the application for registration shall be published for opposition by third parties within 60 days. Within 60 days from the date of the submission of opposition by third parties, the applicant may submit its observations.

**Recognition:** If no oppositions are submitted or, in the case of oppositions, at the end of the second period referred to in the previous paragraph, the INPI shall make a decision of recognition or refusal.

**Application for reconsideration:** In the case of refusal of recognition, the applicant can submit application for reconsideration within 60 days. The President of the INPI shall make a decision on the applications for reconsideration.

### 3.2.4 Language

The application, as well as any relevant document, shall be submitted in Portuguese; any document in a foreign language shall be accompanied by a translation.

## 3.3 Technical representation

The application can be lodged by any subject having the right to apply or by their representatives. The power of attorney shall be submitted in Portuguese and within 60 days of the first proceedings concerning the relevant file. A person residing abroad shall maintain a representative in the country with power to represent him before the administrative and judicial authorities.

### 3.4 Fees

The fee for the application of a “Indicação de Procedência” is 500 Brazilian Real. The fee for the application of a “Denominação de Origem” is 1,800 Brazilian Real. The fee for the certification of registration lodged within the ordinary deadline is 1,000 Brazilian Real.<sup>8</sup> All fees concerning the registration procedure are listed in Annex II.

## 4. Protection

The protection granted to GIs in Brazil extends to the graphical or figurative representation of them, as well as to the geographical representation of the country, city, region or locality, the name of which represents a GI (Art. 181, IPL).

The protection covers names used in the manufacturing, importing, exporting, selling, exhibiting or stocking of products bearing a false GI. It also applies to the use of indicative terms such as “type,” “species,” “kind,” “system,” “similar,” “substitute,” “identical,” or the like, which fail to clearly state the true origin of the product (Art 193, IPL). Criminal sanctions are established for the aforementioned conduct. The protection does not apply to false GIs used in translation.

Article 181 of the IPL provides that a geographical name that is not an “Indicação de Procedência” or a “Denominação de Origem” can be used as a characteristic element of a trademark for a product or service, provided that it does not suggest a false origin.

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<sup>8</sup> Exchange rate EUR/Brazilian Real: 1/2.5 (July 2012).



The legislation in force, according to the TRIPS provisions, establishes no term for the registration of the GI. The INPI clarifies on its website that this means that the registration is valid as long as the conditions laid down in the law are respected.

## 5. GIs and Trademarks

According to Art. 124, paragraph IX of the IPL, GIs, imitations of them which might generate likelihood of confusion, or signs that might falsely refer to a GI, shall not be registered as trademarks. Paragraph X of Art. 124 the IPL also prohibits the registration of signs that induce false indications regarding the origin, source, nature, quality or usefulness of the product or service to which the mark is intended to be applied.

## 6. The MERCOSUR Resolution n°26/30

The MERCOSUR<sup>9</sup> Resolution no. 26/30, Technical Rule for the Labeling of Packaged Foods, is applicable to the labeling of any food that is commercialized in the Member States of MERCOSUR, regardless of its origin. This provision establishes that geographical appellations of a country, a region, or a population, that are recognized as places in which foods are manufactured with specific characteristics, cannot be used in the labeling or the advertisement of foods that are manufactured in other places when this can mislead the consumer.

## 7. Relevant Regulatory Framework

- Industrial Property Law, Federal Law no. 9279/96 of May 14, 1996;<sup>10</sup>
- Legislation Act of the President of the National Institute for Industrial Property no. 134 of April 15, 1997;
- Resolution of the National Institute for Industrial Property no. 075 of November 28, 2000;<sup>11</sup>

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<sup>9</sup> Mercosur is an economic and political agreement among Argentina, Brazil, Paraguay and Uruguay, established in 1991 by the Treaty of Asunción.

<sup>10</sup> Cf. the English version <[http://www.sice.org/int\\_prop/nat\\_leg/Brazil/ENG/L9279eI.asp](http://www.sice.org/int_prop/nat_leg/Brazil/ENG/L9279eI.asp)> and the Portuguese version <[http://www.planalto.gov.br/ccivil\\_03/leis/L9279.htm](http://www.planalto.gov.br/ccivil_03/leis/L9279.htm)>

<sup>11</sup> Cf. the Portuguese version <<http://www.inpi.gov.br/images/stories/ResolucaoIG.pdf>>

- MERCOSUR/GMC/RES. no. 26/03 - Technical Rule for the Labeling of Packaged Foods.<sup>12</sup>

## 8. INPI Contact Information

National Institute of Industrial Property

Praça Mauá n.º 7, 9º andar, A/C sala 905 - Centro - Rio de Janeiro/RJ - Cep: 20081-240

Tel. +55 (21) 3037-4023 / 3037-3353

E-mail: [cgir@inpi.gov.br](mailto:cgir@inpi.gov.br)

Website: <http://www.inpi.gov.br>


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<sup>12</sup> Cf. the Spanish version <<http://www.temasactuales.com/assets/pdf/gratis/MERCOSURres26-03.pdf>>

# ANNEXES

## I. Standard application form

Protocolo



### PEDIDO DE REGISTRO DE INDICAÇÃO GEOGRÁFICA

**IDENTIFICAÇÃO DO PEDIDO**

Arquivamento	Número do Pedido	Data
		Dia    Mês    Ano

**DADOS REFERENTES AO DEPOSITANTE**

CGC / N° INPI  
 Nome ou Razão Social  
 Endereço  
 Bairro  
 Município  
 UF    CEP    Cód. País    Telefone

**DADOS REFERENTES À INDICAÇÃO GEOGRÁFICA**

Espécie 1	Apresentação 1	Natureza 1
1 - Indicação de Procedência	1 - Nominativa	1 - De Produto
2 - Denominação de Origem	2 - Mista	2 - De Serviço
	3 - Figurativa	

Etiqueta

Nome da Área Geográfica

Delimitação da Área Geográfica

Produto ou Serviço

Continua em anexo

Continua em anexo

Modelo / (folha 1/2)

**INDICAÇÃO GEOGRÁFICA ESTRANGEIRA**

Indicação Geográfica Estrangeira já reconhecida no país de origem?  SIM     NÃO

**DOCUMENTOS ANEXADOS COMUNS ÀS ESPÉCIES DE INDICAÇÃO GEOGRÁFICA**

Guia de recolhimento     Procuração     Etiquetas figurativa     Ficha para busca

Cópia oficial documento de concessão ou declaração do direito sobre a indicação geográfica     Documento comprobatório do legítimo interesse do depositante     Outros (especificar)

**DOCUMENTOS ANEXADOS ESPECÍFICOS ÀS INDICAÇÕES DE PROCEDÊNCIA**

Elementos que comprovem ter a área geográfica se tornado conhecida como indicação de procedência do produto ou da prestação do serviço     Elementos que comprovem estarem os produtores ou prestadores de serviços estabelecidos na área geográfica     Elementos que comprovem estarem os produtores ou prestadores de serviço exercendo efetivamente atividades de produção ou de prestação de serviços, na área geográfica

**DOCUMENTOS ANEXADOS ESPECÍFICOS ÀS DENOMINAÇÕES DE ORIGEM**

Elementos que comprovem estarem os produtores ou prestadores de serviços estabelecidos na área geográfica     Elementos que comprovem estarem os produtores ou prestadores de serviço exercendo efetivamente atividades de produção ou de prestação de serviços, na área geográfica     Características e qualidades físicas do produto ou do serviço     Descrição do processo ou método de obtenção do produto ou do serviço

**DADOS REFERENTES AO PROCURADOR**

Nome  
 UF    Telefone  
 Delegacia/Representação para contato

**DECLARO, SOB AS PENAS DA LEI, SEREM VERDADEIRAS AS INFORMAÇÕES PRESTADAS**

Local/Data \_\_\_\_\_ Assinatura/Carimbo \_\_\_\_\_

**USO EXCLUSIVO DO INPI**

Código de Figura 1 [ ] [ ] [ ] [ ] [ ] Código de Figura 2 [ ] [ ] [ ] [ ] [ ] Código de Figura 3 [ ] [ ] [ ] [ ] [ ]

Modelo / (folha 2/2)

II. Table of fees

TABELA DE RETRIBUIÇÕES PELOS SERVIÇOS DO INPI (valores em Reais)

SERVIÇOS DA DIRETORIA DE CONTRATOS DE TECNOLOGIA E OUTROS REGISTROS - DIRTEC (REGISTRO DE INDICAÇÕES GEOGRÁFICAS)			
Código	Descrição do Serviço	Retribuição 1	Retribuição 2 (*)
600	Pedido de Registro de Reconhecimento de Indicação de Procedência	500,00	-
601	Pedido de Registro de Reconhecimento de Denominação de Origem	1.800,00	-
602	Manifestação de Terceiros contra o Pedido de Registro de Reconhecimento de Indicação Geográfica	200,00	-
604	Cumprimento de Exigência	100,00	40,00
605	Pedido de Reconsideração	400,00	-
607	Pedido de Devolução de Prazo por impedimento do interessado	100,00	-
608	Pedido de Devolução de Prazo por falha do INPI	Isento	Isento
609	Certidão de Busca	70,00	-
610	Certidão de Atos Relativos aos Processos	70,00	-
611	Cópia Oficial até 10 (dez) páginas R\$ 150,00	150,00	-
	Acima de 10 (dez) páginas, deve-se somar R\$ 0,30 por página. Após a avaliação final da retribuição, deve-se utilizar o código de serviço 800, "Complementação de Retribuição", para o pagamento integral do serviço.		
614	Desistência, Renúncia ou Retirada	Isento	Isento
615	Comprovação de Recolhimento de Retribuição (inclusive quando em cumprimento de exigência)	Isento	Isento
616	Expedição de Certificado de Registro requerida no prazo ordinário	1.000,00	-
617	Expedição de Certificado de Registro requerida no prazo extraordinário	2.000,00	-
618	Outras Petições	100,00	40,00
619	Pedido de Retificação por erro de publicação na RPI	Isento	Isento
620	Alteração de Nome, Razão Social, Sede e/ou Endereço	50,00	20,00
621	Expedição de segunda via de Certificado de Registro de Indicação Geográfica	120,00	-
824-2	Cópia reprográfica simples	6,00	-
	Retribuição normal de R\$ 6,00 para até 4 (quatro) páginas. Acima deste total, deve-se somar um valor adicional de R\$ 0,20 por página. Após a avaliação final da retribuição, deve-se utilizar o serviço 800, "Complementação de Retribuição" para o pagamento total do serviço.		
825-2	Cópia reprográfica autenticada	12,00	-
	Retribuição normal de R\$ 12,00 para até 4 (quatro) páginas. Acima deste total, deve-se somar um valor adicional de R\$ 0,40 por página. Após a avaliação final da retribuição, deve-se utilizar o serviço 800, "Complementação de Retribuição" para o pagamento total do serviço.		

SERVIÇOS DE ADMINISTRAÇÃO GERAL			
Código	Descrição do Serviço	Retribuição 1	Retribuição 2 (*)
800	Complemento de Retribuição Utilize este serviço para complementar qualquer retribuição feita à menor ou que precise ser atualizada, acrescida de outras taxas, quando for o caso. Por exemplo, quando a	Variável	-

	complementação for proveniente de uma exigência deve-se recolher o valor do cumprimento de exigência cabível, utilizando-se uma guia para cada um dos serviços. É necessário informar o número da Guia de Recolhimento inicial ou preliminar ("Nosso Número").		
801	Restituição de Retribuição Utilize este serviço para solicitar a restituição para qualquer retribuição indevida ou feita à maior. É necessário informar o número da Guia de Recolhimento inicial ou preliminar ("Nosso Número").	25,00	-
802	Remessa de taxas oficiais para um depósito de pedido de patente internacional nos termos do Tratado de Cooperação em Matéria de Patentes (PCT)	Variável	-
821	Outras Petições	60,00	-

IMPRESSOS, PUBLICAÇÕES E CÓPIAS REPROGRÁFICAS		
Código	Descrição do Serviço	Retribuição
803	Revista da Propriedade Industrial (Papel) - exemplar avulso	35,00
804	Revista da Propriedade Industrial (CD-ROM) - exemplar avulso	18,00
809	Fornulários em blocos com 100 (cem) folhas - Marcas e Patentes	17,00
810	Fornulários em blocos com 100 (cem) folhas - Transferência de Tecnologia	17,00
812	Lei da Propriedade Industrial (9.279 / 96)	7,00

(\*) Retribuição 2: redução de até 60% no valor de retribuição a ser obtida por: pessoas naturais; microempresas, empresas de pequeno porte e cooperativas assim definidas em Lei; instituições de ensino e pesquisa; entidades sem fins lucrativos, bem como por órgãos públicos, quando se referirem a atos próprios, conforme estipulado na Resolução INPI nº 211, de 14 de maio de 2009.

# PROTECTING GEOGRAPHICAL NAMES IN THE RUSSIAN FEDERATION

by Federico Desimoni<sup>13</sup>

## Introduction

In 1992, the Russian Federation passed a specific law providing protection for Geographical Indications (GIs): the Law of September 23, 1992 No. 3520-I, subsequently amended by the Federal Law No. 166-FL on December 11, 2002.<sup>14</sup> In 2008, the overall legislation on intellectual property was reformed to meet international standards.<sup>15</sup> A new chapter (Part IV) was introduced in the Civil Code of the Russian Federation (CC RF). Part IV of the Civil Code is a comprehensive piece of intellectual property legislation.<sup>16</sup> Chapter 76 § 3, Art. 1516-1537 on GIs is the focus of this part.<sup>17</sup>

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13 Mr. Federico Desimoni is a legal advisor in food law acting in Parma and a legal affairs manager for the Consorzio of Parma Ham. The author would like to thank Mr. Maurizio Ferri for desk manager Intellectual Property Rights – DESK MOSCA Istituto Nazionale per il Commercio Estero, as well as Alberto Volpato Counsellor for Health, Consumers, Agriculture Delegation of the European Union to Russia, and Irina Kireeva, NCTM O'Connor European Lawyers for the cooperation and for all the information provided.

14 *“The protection of industrial property right in the Russian Federation” guideline for Italian operator*, pp. 6-8, published (Italian and Russian version) by Intellectual Property Rights – DESK MOSCA Istituto Nazionale per il Commercio Estero.

15 *“WTO Negotiations with Respect to Geographical Indications and Russia’s Position on the Protection of Appellation of Origin”*, Irina Kereeva and Paolo Vergano, Review of Central and East European Law 2004 No. 4, XXX-XXX, with reference to p 19-22.

16 The Civil Code contains the copyright law proper in chapters 70 (authors’ rights) and 71 (neighboring rights); chapter 69 contains general provisions also applicable to copyright. Other chapters deal with patent law (chapter 72), the protection of breeders’ rights (ch. 73), of integrated circuits (mask works; ch. 74), of trade secrets (know-how; ch. 75), and also of trademarks, brands, and geographical indications (ch. 76). Chapter 77 details rules for technological applications, in particular those developed on a federal budget. A provision for the protection of domain names was removed from the draft before it was adopted. For a more exhaustive analysis of the new legislation see *“Trademarks throughout the world”* by Edward J. Fenessy and International Contributors, 2011 Thomson Reuters/West, 5/2011 chapter 133.

17 An English version of the Part IV of the Code is available online at: [www.rupto.ru/en\\_site/policy\\_law/policy\\_law.html](http://www.rupto.ru/en_site/policy_law/policy_law.html)

## 1. Definition

According to Part IV of the Civil Code (Art. 1516 § 1), a product’s appellation of origin (PAO)<sup>18</sup> is a designation which constitutes or contains a modern or historical, official or unofficial, full or abbreviated name of a country, city or rural settlement, locality, or other geographical places, as well as a name derived from such designation, which – as the result of its use – has become known with regard to a given product, the special characteristics of which are exclusively or mainly determined by the natural conditions and/or human factors of the geographical area concerned. This is in line with the GI definition of the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS). According to paragraph 2, a term consisting of or containing a geographical name that has become common in the Russian Federation as the generic designation of a given product cannot be registered. This rule also applies to foreign PAOs.

## 2. Trademarks to Protect Geographical Names

The Russian Law recognizes the exclusive right over trademarks<sup>19</sup> and provides the possibility for associations to register collective marks (provided that it is a complex mark; in other words the collective mark must be composed of a name and an additional element, such as a design). In such a case, a collective mark can contain a geographical name. However, following the aforementioned reform of the Civil Code, applications for trademarks containing geographical names cannot be accepted without a disclaimer on the geographical name itself.<sup>20</sup> In legal terms, this means that the trademark owner will not have any exclusive right on the geographical name.

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18 This can also be translated as “designation of the place of oriGIn of a good, for which protection is accorded”. The acronym PAO is not an official one and will be used throughout the chapter to simplify the reading.

19 *“WTO Negotiations with Respect to Geographical Indications and Russia’s Position on the Protection of Appellation of Origin”*, p. 18.

20 In the case of Parma Ham, the Consortium (association of Parma Ham producers) owns two collective marks in the Russian Federation, PROSCIUTTO DI PARMA and its symbol, and PARMA and its symbol, both registered with the disclaimer on the name PARMA.

### 3. Who Can Apply for a PAO?

The right to the use of a PAO is obtained from the Federal Service for Intellectual Property, Patents and Trademarks (Rospatent) at the request of a producer and in accordance with the standard national procedure.<sup>21</sup> An exclusive right to use a PAO can also arise from an international treaty ratified by the Russian Federation.

The Russian law on GIs is based on the principle of “joint titles”. This should not be interpreted as a single title on a given GI available for all producers of a given area, but rather as the sum of individual titles on the same GI, which each producer in a given geographic area is entitled to request.<sup>22</sup> (Art. 1518 § 2). Under the Russian system, each relevant producer must prove that his goods meet the requirements established by the law and, for foreign GIs, provide also a title certifying the ownership of the right at issue. In this respect, foreign GI beneficiaries (legal entities such as GI groups or inter-branch organizations)<sup>23</sup> may face problems. In countries with *sui generis* laws, such as the European Union (EU), there is no specific owner of the geographical name, but rather beneficiaries with the right to use the name. Such laws provide a single collective right open to all producers in a given geographical area respecting the code of conduct, and not a sum of individual rights. Consequently, in such cases no producer would be able to provide a legal title proving its “ownership” over the right at issue in the country of origin. The same problem might also arise in countries using certification marks to protect geographical names, because the “owner” of a mark is usually an external independent entity (the certifier) and not the producers themselves. However, in practice this problem can be overcome (see later in this chapter *Case Study: The Registration of “Prosciutto di Parma” as a PAO in the Russian Federation*).

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21 Rospatent is assigned a central role in this system. The main tasks of this body include looking after the national registration of intellectual property rights (IPRs) - including GIs - as well as dealing with the resolution of administrative disputes and the enforcement of IPRs “*The protection of industrial property right in the Russian Federation*,” p. 8.

22 “*The protection of industrial property right in the Russian Federation*”, p. 24.

23 For the case of geographical indications, often the procedures for the PAO protection and registration are carried out by producers associations.

### 4. Filing Procedures and Costs

In accordance with Art. 1522 of the Civil Code, a PAO application shall be filed with Rospatent. An application must relate to only one appellation and shall contain:

1. An official request of registration and grant of exclusive rights (or exclusively a request of grant of exclusive rights in the case of an already registered PAO), indicating the applicant name and his legal or actual residence;
2. The claimed sign;
3. The kind of goods with respect to which the PAO is requested;
4. An indication of the place of origin or production of the goods (the borders of the geographical area), as well as the natural conditions and/or human factors which determine the specific properties of the goods;
5. A description of the specific properties of the goods.

For foreign GIs, the application must be accompanied by a document certifying the right of the applicant in the country of origin. For European PDOs and PGIs, a copy of the corresponding national and EU certificates can be used (as published in the respective official journals), including an updated copy of the product specification (see *Case Study: The Registration of “Prosciutto di Parma” as a PAO in the Russian Federation and Annex I*). The application must be accompanied by a document certifying the payment of the corresponding fee.

The application must be in Russian. If the documents accompanying the application are submitted in a foreign language, the application must be accompanied by the translation in Russian.

The filing date of the application is the date of receipt of the aforementioned documents by the federal executive authority for intellectual property. If the documents are not all filed at the same time, the filing date of the last document will be considered.

The registration of a PAO in the Russian Federation requires at least 6 months. The minimum fee necessary for registration of a PAO by a foreign holder is 22,000 roubles (about 550 Euros). The legal protection resulting from the registration of a PAO is valid for ten years and can be renewed an unlimited number of times for

additional ten-year periods. The fees for the renewal of the PAO certificate are, in the case of a foreign holder, 15,000 roubles (about 375 Euros).<sup>24</sup>

## 5. Legal Assistance

In accordance with Art. 1248 of the Civil Code, the proceedings with the federal executive authority for intellectual property shall be exercised directly by the applicant, or through an attorney, who must be registered by the federal authority. Citizens permanently residing outside the territory of the Russian Federation and foreign legal entities shall exercise proceedings with Rospatent through attorneys registered by the federal authority, unless otherwise provided for by an international treaty of the Russian Federation. According to the bilateral agreements concluded between the Russian Federation and Armenia, Azerbaijan, Belarus, Kazakhstan, Kyrgyzstan, Moldova, Tajikistan, Turkmenistan, Ukraine and Uzbekistan, the applicants from these countries have the right to file applications directly with the patent office.

If an applicant, a right holder or any another interested person exercises proceedings with Rospatent directly or through a representative not registered by federal authority, they shall be committed - at the request of the federal authority - to provide an address within the territory of the Russian Federation for correspondence. The terms of reference of an attorney or another representative shall be confirmed by a power of attorney issued by the applicant, the right holder or any other interested person.<sup>25</sup>

For the purposes of the registration of a PAO, together with the letter of attorney given to the specialized agent, the following elements are needed: documents certifying the *status* of the applicant (legal or physical person) and the applicant head office/nationality (taken from the trade register, statutes of the association, or a copy of the passport). All the official documents and letters of attorney must have an *apostil* and official translation in Russian, together with a notarized

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24 “*The protection of industrial property right in the Russian Federation*” p. 24.

25 There is a list of specialized agents on Rospatent’s website: [http://www.fips.ru/sitedocs/patpov\\_en.htm](http://www.fips.ru/sitedocs/patpov_en.htm).

authentication of the translator’s signature.<sup>26</sup> The only exception may be the power of attorney, which in certain cases can be simply signed without any legalization or notarization.<sup>27</sup>

## 6. Registration Procedure

According to Art. 1523 of the Civil Code, the examination of PAO application is carried out by Rospatent. During the examination and before the decision is made, the applicant has the right to supplement, clarify, or correct the application. Likewise, the federal executive authority has the right to invite the applicant to submit further documents. These must be submitted by the applicant within two months from the receipt of the notification. Upon request of the applicant, this time limit may be extended, provided that the request has been received prior to the expiration of the time limit. If the applicant fails to comply with the time limit or to reply to the notification to submit further documents, the application is considered withdrawn.

An application can be withdrawn by the applicant at any stage of the examination. If the application is rejected, the decision can be appealed by the applicant by filing an appeal with the Chamber for Patent Disputes within three months from the date of receipt of the decision, as provided for in Art. 1528.

If the application is accepted, Rospatent records the official registration of the PAO in the State Register. The PAO is entered in this Register along with the information concerning the right holder, an indication and description of the specific properties of the goods as well as other relevant information relating to the registration and the exclusive right. The renewal of the term and any other subsequent change will be recorded in the Register as well.

The last step of the PAO registration procedure is the issuance of a Certificate of Exclusive Right, issued by Rospatent within one month from the date of receipt of a document certifying the payment of the fees. In case of failure to submit this document, the certificate will not be issued.

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26 “*The protection of industrial property right in the Russian Federation*” p. 24.

27 This condition has to be verified with Attorney in charge of the procedure.

The certificate is valid for ten years from the filing date of the application and can be renewed at the request of the right holder, following the conditions set forth in Art. 1531. For foreign PAOs, like for the first application, the right holder must submit a document proving his right over the GI at issue in the country of origin. A request for the renewal of the PAO certificate must be filed during the last year of its validity. Upon request of the right holder, a six-month grace period can be granted, provided that an additional fee is paid.

The condition for termination of the legal protection of a PAO and the validity of a certificate are established in Art. 1536. To formalize the cancellation of a PAO expired and not renewed, a decision by the federal executive authority for intellectual property is required.

## 7. Effects of Registration and Use

Following Art. 1519, producers have the exclusive right to use a PAO in accordance with Article 1229 of the Civil Code in any manner not contrary to law. Illegal uses of a PAO are considered:

1. On goods, labels, or the packaging of goods which are produced, offered for sale, sold, shown at exhibitions and fairs, or in another manner allowing their circulation within the territory of the Russian Federation; as well as on goods, labels, or the packaging of goods which are stored or transported with the above-mentioned purposed, or are imported into the territory of the Russian Federation;
2. On letterheads, invoices, and in other documentation or printed publications connected with circulation of the goods the Russian Federation;
3. In the sale of goods, in announcements, in advertising, or commercial banners;
4. On the Internet, including as a domain name.

It is considered an illegal use of the PAO even if the real place of origin is indicated or the protected name is used in translation or in connection with such words as “kind”, “type”, “imitation”, and the like. Likewise, the use of a similar name for any goods that is capable of misleading consumers with respect to the place of origin and the special properties of goods is also considered an illegal use of the PAO. Goods, labels, and packaging of goods on which PAOs (including confusingly similar PAOs) used illegally are considered counterfeiting.

Alienating or granting another person the right to use a PAO is not allowed by the Law.

## 8. Legal Protection and Enforcement

Intellectual Property Rights (IPRs) are enforced by the means provided for in the Code (Art. 1250), taking into account the substance of the infringed right and the consequences of the infringement. The means of enforcement are applied at the request of the right holders (no *ex officio* protection). The good faith or absence of fault of an infringer does not exempt him from the obligation to terminate the infringement nor excludes the application of enforcement and provisional measures.

The enforcement of the rights deriving from PAOs can be exercised through a claim in which the right holder must request the following:

1. The recognition of the existence and validity of the right vis-à-vis the person who denies it, or in another manner does not recognize it;
2. Preventing further actions which might infringe the right;
3. The payment of damages from the person who has infringed the right holder’s exclusive rights;
4. The seizure of the goods at issue;
5. The publication of the judicial decision concerning the infringement, with the indication of the right holder.

In case of an infringement, the right holder can request, instead of damages, the payment of compensation in the form of a lump sum. Such compensation can be requested for each violation or for the overall infringement. The amount of the compensation is determined by a national court according to the Code, based on the nature of the infringement and other circumstances of the case, taking into due account the principles of reasonability and justice.

Specific provisions concerning the enforcement of PAOs are provided for in Art. 1519 point 3 and Art. 1537. The first article specifies that persons who do not have the proper certificate shall not use the PAO, even if the real place of origin is indicated, the appellation is used in translation or in connection with such words such as “kind”, “type”, “imitation” and the like, or when the use of a similar name is capable of misleading the consumer with respect to the place of

origin and the special properties of the goods (illegal use of a PAO). This article explicitly emphasized that goods, labels, and packaging on which PAOs (including confusingly similar PAOs) are used illegally must be considered counterfeiting.

Article 1537 establishes rules concerning the liability for the illegal use of a PAO. The article recognizes the possibility for right holders to request the removal from trade and the destruction of counterfeited goods, labels, and packaging on which the name corresponding to a PAO or a sign confusingly similar to it have been used. This is done at the expense of the infringing party.

If the use of a PAO has the potential to mislead the consumer with regard to the product or its producer, in consideration of a previously registered trademark, the registration of that PAO can be appealed and revoked within five years of the date of official publication of the PAO registration.

## 9. Disputes and Litigations

As specified in Art. 1248, disputes concerning IPRs are settled before the judicial authorities. On the other hand, actions aimed at enforcing IPRs are dealt with by administrative authorities (Paragraph 2 of Article 11).

The Arbitration Chamber for controversies on intellectual property at Rospatent has jurisdiction over the administrative settlement of controversies regarding the registration of PAOs and the early termination of the legal protection. An attempt to settle of the controversy through administrative channels is mandatory. Rospatent decisions are definitive at the administrative level, but can be appealed before a national court.

The experience shows that, for the purposes of fighting against the production, importation, storage and distribution of fake products, the initiatives that are by far the most effective are based on administrative procedures against physical and legal entities and, in some cases, criminal procedures against the subjects that had a role in committing such practices.<sup>28</sup>

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<sup>28</sup> “The protection of industrial property right in the Russian Federation”, p. 25.

## 10. Sanctions and Fines

In compliance with Art. 14.10 of the Russian Federation’s administrative infringements code, the following sanctions can be imposed: up to 2,000 roubles (about 50 Euros) for individuals, 20,000 roubles (about 500 Euros) for legal representatives and managers and 40,000 roubles (about 1,000 Euros) for legal entities.

In accordance with Article 180 of the Russian Federation’s Criminal Code, with respect to repeated or aggravated commercialization of fake products, physical persons or legal representatives of legal entities can be sentenced, *inter alia*, to fines of up to 200,000 roubles (about 5,000 Euros) or to community work for a maximum period of two years. For the adoption of such measures, interested parties can refer to the police.<sup>29</sup>

On top of this, the seizure of fake products is provided. To obtain the adoption of these measures, interested parties can refer to the customs authorities, consumer rights protection organizations or to the local branches of the police.

## 11. Case Study: The Registration of “Prosciutto di Parma” as a PAO in the Russian Federation

Before the reform of the Russian Civil Code, the appellation “Prosciutto di Parma” (protected as Protected Designation of Origin, PDO at the EU level) was first registered in the Russian Federation as a collective mark. The “Consorzio del Prosciutto di Parma” was the owner of the collective marks “PROSCUITTO DI PARMA” and “PARMA” with their respective symbols. Both were registered with the disclaimer on the name PARMA. After the new law entered into force, the “Consorzio” decided to register “Prosciutto di Parma” as a PAO.

Given the obligation for foreign legal entities to exercise proceedings with Rospatent through attorneys registered by the federal authority, the first step for the “Consorzio” was to find an attorney in Russia. The second step was to file at Rospatent, through the Russian representative, the application for the registration of the corresponding PAO (see Annex I).

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<sup>29</sup> *Id.* p. 26



The application contained the following documents:

- EU Regulation no. 510/06 (official journal copy);
- EU Regulation with which the PDO “Prosciutto di Parma” was registered (EU Reg. 1107/96, official journal copy);
- The PDO certificate;
- The product specification;
- Single document (summary of specification) published in the EU official journal;
- The names and data of “Prosciutto di Parma” producers associated with the “Consorzio”.

Following this, Rospatent requested the “Consorzio del Prosciutto di Parma” additional information as well as the relevant producers’ joint-applications. The “Consorzio” then explained the reasons why this requests was not compatible with the EU system. In this regard, it was pointed out that under the legal system in force in the EU, a GI can be requested only by a collective organization. This system, in fact, is founded on a single collective right open to all relevant producers, and not on a sum of individual rights. On these bases, the “Consorzio” demonstrated that the producers did not have the possibility to show any individual legal title over the PDO “Prosciutto di Parma” (as members of the Consorzio respecting the rules laid down in the productive specification, they only have the right to use the PDO). As a result, the “Consorzio” proved that it was the only subject entitled to apply for a PAO in Russian Federation. After this, the request of relevant producers’ joint-applications was withdrawn by Rospatent.

Following the observation phase, the “Consorzio” received from Rospatent the official filing receipt and then the final decision. After completing the procedure, the very last document the “Consorzio” received was the certificate of registration.

Following the filing of the application, the time frame is as follows:

- The official filing receipt is issued within 1 or 2 months from the filing date;
- The official action is issued within 12-14 months from the filing date;
- In the “Prosciutto di Parma” case, the application was filed on July 23, 2009, the Official filing receipt was issued on August 19, 2009, the final decision was made in June 2010, the PAO was registered on August 3, 2010, and the certificate of registration was issued on August 25, 2010.

## ANNEXES

### I. Application for registration as a PAO of “Prosciutto di Parma”

Our Ref.: 2406-824884/DIA  
PLEASE QUOTE OUR REF!

**APPLICATION**  
for official registration of the product designation of origin and for granting of the exclusive right of use of this designation in the Russian Federation

(220) DATE OF RECEIPT	ENTRY N°	(210) REGISTRATION N°
To the federal service for intellectual property, patents and trademarks, Berezkhovskaja nab, 30, ed. I, Moscow, G-59, GSP-5, 123995  <b>APPLICATION</b>  With the presentation of the application and the documents listed below, I (we) ask you to register the indicated trademark as product designation of origin and to grant the exclusive right on this designation.		(750) ADDRESS FOR CORRESPONDENCE  --  <i>(full postal address, name or business name of the addressee)</i>
(731) APPLICANT(S)  Consorzio del Prosciutto di Parma Via Marco dell'Arpa 8/b, 43100 Parma, Italy		OGRN <sup>1</sup> (OGRNIP <sup>2</sup> )  Country CODE according to VOIS ST. 3  IT
(740) REPRESENTATIVE 0113 MEDVEDEV V.N.  telephone: 937-57-81, 937-61-16      telex:		0834 RYBCHAK V.V.  fax: 937-61-04, 937-61-23
(540) DESIGNATION FOR WHICH THE APPLICATION IS BEING MADE  <b>PROSCIUTTO DI PARMA</b>		
DESCRIPTION OF THE PRODUCT  Cured ham, ham.		

#### DESCRIPTION OF THE MAIN CHARACTERISTICS OF THE PRODUCT

<sup>1</sup> N.d.T.: unique state registration number

<sup>2</sup> N.d.T.: unique state registration number of the sole-proprietor business

## DESCRIPTION OF THE MAIN CHARACTERISTICS OF THE PRODUCT

Air-cured ham whose main characteristics are defined by the analytical parameters for measurement of water and salt content and of protein scission.

The product is identified by the trademark fire-branded on the rind.

Rounded external shape; the outer parts (feet) and all the external irregularities that could impair the appearance of the product are removed and a maximum of 6 centimetres of meat are left beyond the femur head.

Weight: as a rule, from eight to ten kilograms, but not less than seven.

Cut colour: even colour from pink to red, veined with pure white fat.

Fragrance and flavour: not very salty, refined, delicate and sweet taste, with a marked and characteristic aroma.

It can be sold whole, de-boned and packaged in pieces of various weights and shapes, or sliced and packaged.

The main characteristics of the product are ascribable to the unique conditions of the place of production and to the particular skill of the local population. In particular, the local population of northern and central Italy has been farming large pigs for late slaughter for a very long time, which has allowed the development of a particular ham production technology. For ham production, particular conditions relating to the breed of pig, the type of diet of the animal and the farming and slaughtering conditions, must be met. The raw material, which is therefore fresh hind legs of pork, undergoes a particular process that involves the addition of just sea salt and takes at least 12 months, including the following stages: sectioning; refrigeration; cleaning; salting; curing; washing and drying; first curing; final process of "sugnaturo"<sup>1</sup> (using pork fat); curing; slicing and packaging. The geographical location of the place of production ensures unique ecological, climatic and environmental conditions thanks to the Versilia sea wind that subsides as it passes through the olive groves and pine forests of the Val di Magra, becomes dry as it crosses the passes of the Apennines, picks up a chestnut aroma and reaches the area of production for the curing of the "Prosciutto di Parma", to give the ham its particular sweet flavour.

## PLACE OF ORIGIN (PRODUCTION) OF THE PRODUCT (GEOGRAPHICAL BOUNDARIES OF THE PRODUCTION AREA)

It is produced in a delimited area of the province of Parma, which includes the areas in the province of Parma (Emilia-Romagna region, Italy) located within a boundary of 5 kilometres to the south of the Via Emilia at an altitude not exceeding 900 metres, delimited by the Enza torrent to the east and the Stirone to the west.

List of enclosed documents:	no. of sheets
x document certifying payment of the relevant duty for a total of 10000 rubles	1
x Russian translation of the documents enclosed with the application	11
<input type="checkbox"/> letter of attorney certifying the task assigned to the representative	TO FOLLOW
x document certifying the right of the applicant on the product designation of origin that is the subject of the application (authenticated copy of European Community Council Regulation no. 510/2006 "PROSCIUTTO DI PARMA" with relevant English translation)	12

### Signature

Patent agent of the Russian Federation, reg. no. 834  
[N.d.T.: illegible signature]

Rybchak V.V.  
23 July 2009

Signature(s) of the applicant(s) and of his/her/their representative; date of signature  
(In the event of signature on behalf of a legal person, authenticated signature of the manager with company stamp)

## II. Summary of the relevant Russian Legislation

- Civil Code Part IV dated December 18, 2006, effective January 1, 2008;
- The Federal Law No. 231-FZ dated December 18, 2006, "Making Part IV of the Civil Code of the Russian Federation effective", effective December 22, 2006 except for Articles 4-12, 14-6, points 1-12, 14-16 of Article 17, and Articles 18-35, which became effective January 1, 2008;
- Administrative regulations on registration of agreements providing exclusive rights to inventions, utility models, industrial designs, trademarks and service marks, protected software, database, topologies of integrated microcircuits, as well as agreements of commercial concession for the usage of the intellectual property objects that are protected in accordance with Patent Law of the Russian Federation, accepted on October 29, 2009, no. 321;
- Regulation of making, filing and consideration of a trademark/service mark registration (approved by Rospatent Order dated March 5, 2003, No. 32, registered in the Ministry of Justice of the Russian Federation on March 25, 2003, Registration No. 4322);
- Federal Law of July 29, 2004 No. 98-FZ "On the Trade Secret";
- Customs Union Customs Code (Annex to the Agreement on the Customs Code Customs Union, adopted by the decision of the Interstate Council of Eurasian Economic Community of November 27, 2009 N. 17);
- Federal Law of July 26, 2006 No. 135-FZ "On Protection of Competition";
- Code of administrative violations of the Russian Federation of December 30, 2001 N. 195-FZ (code of administrative offenses FR);
- Criminal Code of the Russian Federation of June 13, 1996 no. 63-FZ (Penal Code FR).

## III. Useful Contact Information

- Rospatent – Federal service on intellectual property, patent and trade marks: [http://www.rupto.ru/en\\_site/about.html](http://www.rupto.ru/en_site/about.html) (English version). Contact information: 30-1 Berezhevskaya nab. Moscow G-59, GSP-5 123995 Russian Federation Fax: (499) 240-61-79 <http://www.rupto.ru> E-mail: [rospatent@rupto.ru](mailto:rospatent@rupto.ru);
- FIPS – ROSPATENT, FEDERAL INSTITUTE OF INDUSTRIAL PROPERTY Post address: bld. 30-1, Berezhevskaya nab., Moscow, G-59, GSP-5, Russia, 123995 - [http://www.rupto.ru/en\\_site/contacts.html](http://www.rupto.ru/en_site/contacts.html) FAX: (499) 243-33-37, (495) 234-30-58

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INTERNET DB: Phone: (499) 240-01-74 E-mail: [Adminm@fips.ru](mailto:Adminm@fips.ru) [Support@fips.ru](mailto:Support@fips.ru);

- **Supreme Arbitration Court of the Russian Federation** – <http://www.arbitr.ru/eng/> (English version);
- **Arbitration Court of Moscow City** – <http://msk.arbitr.ru/>;
- **Federal Antimonopoly Service** – <http://fas.gov.ru/>;
- **Federal Customs Service of Russia** – <http://www.customs.ru/en/>;
- **Ministry of Industry and Trade of the Russian Federation** – <http://www.minprom.gov.ru/eng/>;
- **Delegation of the European Union to Russia** - Kadashevskaya nab. 14/1 109017 Moscow, Russia:
  - » Alberto Volpato Counsellor for Health, Consumers, Agriculture  
Tel: +7.495.721 2017 Fax: +7.495.721 2020 – E-mail: [Alberto.Volpato@ec.europa.eu](mailto:Alberto.Volpato@ec.europa.eu);
  - » **IPR DESK MOSCA - Istituto Nazionale per il Commercio Estero** – Krasnopresnenskaja nab. 12, 123610 Mosca, Responsabile Desk: Maurizio Ferri - E-mail: [iprdesk.mosca@ice.it](mailto:iprdesk.mosca@ice.it).

#### IV. Law Firms and Legal Advisors

- **EVGENY B. ALEZANDROV & NATALIA STEPANOVA:**  
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# GEOGRAPHICAL INDICATIONS IN INDIA

by Richard Mendelson<sup>30</sup>

## Introduction

In 1999, India established a *sui generis* system for the recognition of GIs to fulfill its international obligations under Article 22.2 of the Agreement on Trade Related Aspect of Intellectual Property Rights (TRIPs Agreement), which calls for all members of the World Trade Organization to provide the “legal means” for protecting GIs. The principal legal document is The Geographical Indications of Goods (Registration and Protection) Act of 1999 (the “GI Act”).<sup>31</sup> In March 2002, the government passed rules to implement the GI Act, known as The Geographical Indications of Goods (Registration and Protection) Rules, 2002 (the “GI Rules”). Both the GI Act and the GI Rules took effect in September 2003. The stated objectives of the GI Act are to “protect consumers from deception, add to the economic prosperity of the producers of such goods and also promote goods bearing Indian geographical indications in the export market.”<sup>32</sup>

Prior to the passage of the GI Act, there were no specific laws in India dealing with GIs, and the concerned parties relied on the doctrine of “passing off” and general trademark law, including reliance on certification marks, to address the rights to geographic terms and related issues of infringement. As an example, Darjeeling was registered as a certification mark in 1998 under the old Trade and

Merchandise Mark Act of 1958. The GI Act defines a GI,<sup>33</sup> provides a mechanism for the registration of GIs, establishes a GI registry in Chennai,<sup>34</sup> elaborates the concept of registered proprietor and authorized users,<sup>35</sup> and imposes strict penalties, both civil and criminal, for infringement of registered GIs.

One of the world’s most famous GIs, Darjeeling tea, was the first registered GI in India. Since that time, 146 GIs have been registered for Indian products<sup>36</sup>, and another five foreign GIs have been registered there, including Napa Valley for wine, which I handled in conjunction with the law firm of K&S Partners.<sup>37</sup> The breakdown of these GIs into agricultural products, handicrafts, manufactured products and foodstuffs follows.

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30 Special thanks to Rajendra Kumar, Latha Nair and Bharadwaj Jaishankar of K&S Partners in Gurgaon, India, for reviewing and commenting on this article in advance of its publication.

31 Act 49 of 1999. The GI Act is available online at [http://ipindia.nic.in/girindia/GI\\_Act.pdf](http://ipindia.nic.in/girindia/GI_Act.pdf) (accessed May 31, 2011).

32 *Id.* at Statement of Objects and Reasons.

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33 *Id.* at Section 2(e). “Geographical indication, in relation to goods, means an indication which identifies such goods ... as originating, or manufactured in the territory of country, or a region or locality in that territory, where a given quality, reputation or other characteristic of such goods is essentially attributable to its geographical origin and in case where such goods are manufactured goods one of the activities of either the production or of processing or preparation of the goods concerned takes place in such territory, region or locality, as the case may be.” This definition is quite expansive and includes non-agricultural products.

34 The Controller-General of Patents, Designs and Trademarks is the Registrar of GIs. *Id.* at Section 3(1).

35 The Registrar maintains a two-part registry. Part A contains the names of all registered GIs, and Part B lists the authorized users of each GI. Under the GI Act, an entity seeking registration as an authorized user must submit a separate application to the GI Registry. The registered proprietor of the GI is required to give his consent to the registration of the authorized user. The concept of an authorized user is akin to that of a trademark licensee. But a GI, unlike a trademark, is a public right. I can envision a future dispute between a user which meets the product and processing requirements of the GI and a registered proprietor which refuses to consent to that party’s application as an authorized user (e.g., if the user has refused to join the producer’s association or to pay the association’s dues). No such case has yet arisen to my knowledge.

36 As of May 12, 2011.

37 See [www.knspartners.com](http://www.knspartners.com).

**Table 1.** Distribution of Registered GIs in India from 2003 – May 12, 2011

<u>Product Category</u>	<u>No. of Registered GIs</u>
Handicrafts	97
Agricultural Products	39
Manufactured Products	12*
Foodstuff	3
<b>Total GIs registered</b>	<b>151</b>

\* The five foreign GIs are all for “manufactured” products – Peruvian Pisco (Peru), Scotch Whisky (United Kingdom), Prosciutto di Parma (Italy), Napa Valley (United States) and Champagne (France).

One author has estimated that there are as many as 5,000 products from India that could be registered as GIs.<sup>38</sup> So far, products from only 18 of India’s 28 states have been registered as GIs. Karnataka in southern India has the largest number of registered GIs (29), followed by Tamil Nadu (18) and Kerala (18), also in southern India, and Andhra Pradesh (17) in central India. Some of India’s largest states, whose products are based on traditional knowledge and have long traditions and histories tied to particular cultures and communities, have only a handful of registered GIs. If these products can be registered and then marketed and promoted successfully, GIs will prove to be a powerful engine for rural development in the country.

For this reason, government bodies in India like the GI Registry, the Department of Industrial Policy and Promotion, statutory bodies like the Textile Committee and the Tea Board of India, the UNCTAD India Programme, among others have undertaken campaigns to enhance the awareness of GIs among both producers and consumers. These awareness-building initiatives and the large market potential for both domestic and imported GI products in India make GI registration

38 Sujit Ray and Shefalika Ghosh Samaddar, “GI-GIS: A Methodology of DSS for Potential Geographical Indication in India,” presented at the Geospatial World Forum, Hyderabad, India, January 18-21, 2011, available at <http://www.geospatialworldforum.org/2011/proceeding/pdf/Sujit.pdf> (accessed May 31, 2011).

especially attractive. This is particularly true of foreign GIs, which are woefully underrepresented among the registered GIs, because these foreign products often have greater potential for widespread commercialization than domestic goods. Indeed, many, if not most, domestic GIs are only known locally and are not yet sufficiently well organized or well funded to pursue GI recognition and commercialization in other parts of the country, not to mention internationally.

In this chapter, I first review the advantages of and preconditions for GI registration, then I summarize the registration process. Finally, I present a case study based on my first-hand experience with the registration of a foreign GI in India, namely, Napa Valley for wines.

## 1. Why Register a GI in India

GIs offer Indian producers an opportunity to recognize and market a premium product under their exclusive control. Inside India, GIs are regarded as an important way to help the farmers, artisans and crafts persons, who possess the knowledge and skills to produce the GI’s distinctive products, to harness significant commercial benefits. A GI thus can be an important engine for economic development and human empowerment. Darjeeling tea is one of the most successful GIs in this respect.

GIs, however, do not sell themselves. Their success ultimately depends on the scope and effectiveness of marketing and promotional efforts by the producers and everyone else in the supply chain. Without the development of consumer recognition of the product’s quality and value, the GI will literally die on the vine.

For foreign GI holders, GI registration in India can play an important role in accessing this large market and avoiding usurpation. It is surprising that so few foreign GI holders have recognized this unique opportunity to date.

The GI application process requires considerable preparation. The “best practice” is to register the GI before it has become a commercial success, but often the organization, funding and perceived need for protection do not exist at this stage. For foreign GIs, there is no requirement that the GI product be sold in India to register it as a GI there. GI Rule 25 states as follows:

Statement of user in applications: An application to register a geographical indication or as an authorized user shall, contain a statement of the period during which, and the person whom it has been used in respect of the goods mentioned in the application. The applicant shall file an affidavit testifying to such user with exhibits showing the geographical indication as used, the volume of sales under that geographical indication, the definite territory of the country, region or locality in the country to which the geographical indication relates and such other particulars as the Registrar on perusal of the application may call for from the applicants. There is no reference in this rule to use in India, only use in the country of origin.

Several pre-registration steps are required. First, a registered proprietor – defined in the GI Act as “any association of persons or of producer[s] or any organization for the time being entered in the register as the proprietor of a geographical indication”<sup>39</sup> – must be formed if one does not already exist. For important commodities like tea, coffee and spices, commodity boards have been established inside India as autonomous bodies, functioning under the Ministry of Commerce and Industry (e.g., the Tea Board, The Coffee Board and the Spices Board). For lesser known commodities, an association representing the interests of producers might have to be established in order to apply for GI registration and promote and protect the registered product. There also are examples of associations not comprised of producers that have applied for GI registration, including a private temple trust that registered Tirupathi Laddu, a *Prasad* (offering to God), and Reliance Limited, a petroleum company, that attempted to register Jamnagar Petrol.

Second, the GI applicant must ensure that the GI name, which need not be geographic and, in fact, might comprise a symbol, is available for use.<sup>40</sup> A local law firm specializing in intellectual property rights can conduct a search of

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39 *Id.* at Section 2(n).

40 A GI cannot be registered in India if its use would likely deceive or confuse consumers; would otherwise not be entitled to protection in a court or is contrary to any law; if the GI comprises or contains scandalous or obscene matter or matter likely to hurt religious susceptibilities of any class or section of the citizens of India; or includes generic names or indications that are not (or no longer) protected in their country of origin or have fallen into disuse there, or although literally true as to origin, falsely represents to consumers that the goods originate elsewhere. *Id.* at Section 9.

prior uses of the name or symbol for the same or other products, including as trademarks.<sup>41</sup> The sooner the GI application is filed and the GI is registered, the less opportunity there will be for prior competing (or possibly deceptive) uses of the same name or symbol in the market.

Third, the producers must proffer evidence of the GI’s uniqueness and distinctiveness, establishing a linkage between the product and its place of origin. The due diligence and research required to meet this evidentiary burden, and the associated investment of time, money and technical expertise, are significant.

Fourth, the producers must establish an inspection system to ensure that the quality, reputation and other special characteristics of the product are maintained. Without an effective quality control and enforcement system, the integrity of the GI and the value added associated with it cannot be guaranteed to the trade or consumers.<sup>42</sup>

Registration of a GI in India is not mandatory. However, Section 20(1) of the GI Act states that “no person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered geographical indication.” The registration thus provides the registered proprietor and the authorized users with the right to initiate civil or criminal action against the infringer. Civil relief can take the form of an injunction and, at the option of the rights holder, either damages or accounts of profits, along with the destruction or erasure of the infringing labels. As an example, the Delhi High Court in the case of *Scotch Whisky Association & Ors. V. Golden Bottling Limited*, 2006(32)

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41 Law firms in India that provide this service include but are not limited to K&S Partners, [www.knspartners.com](http://www.knspartners.com); Lail & Sethi Advocates, [www.IndiaIP.com](http://www.IndiaIP.com); and Lail, Lahiri & Salhotra, [www.lls.in](http://www.lls.in).

42 One criticism often leveled at GIs is that quality control requirements to ensure product standardization can stifle innovation and experimentation, hinder technological development and reduce the producers’ flexibility in responding to consumer preferences. However, there is nothing in the GI regulations that prohibits changes to the production or design standards over time so long as the quality, reputation and other characteristics of the goods are maintained. Indeed, GIs should provide a way to upgrade skills, enhance product quality and diversify designs (e.g., for handloom products) while incorporating technological advances.

PTC 656 (Del), imposed a permanent injunction prohibiting defendant's use of the word "Scot" as part of its brand name because of the impression that the brand gives to the unwary consumer of whisky that the product originates in Scotland or is Scotch Whisky. Criminal relief for selling goods to which a false GI is applied includes forfeiture of the goods to the government, imprisonment and/or fines. Even if the party alleging infringement were to bring an action for passing off instead of relying on GI Act's specific civil and criminal remedies,<sup>43</sup> the GI registration would serve as *prima facie* evidence of the validity of the GI.<sup>44</sup>

Additionally, the Intellectual Property Rights (Imported Goods) Enforcement Rules of 2007, which took effect in May 2007, allow a registered proprietor (right holder) of a patent, trademark, copyright, design or GI to register with the customs office in order to prohibit the importation of goods infringing any of these IP rights.

Finally, GIs may be protected in India through bilateral agreements. For instance, the European Union is presently negotiating a free trade Agreement with India. GIs are part of those talks.<sup>45</sup>

GIs are vitally important in combating counterfeiting at home. But this also requires vigilance and action, both commercial and legal, by the producers, the producers' association or the government body that oversees the product. Without ongoing protection, the GI could become generic and undermine efforts to prosecute infringement and unfair competition claims at home and abroad.

## 2. GI Registration Procedure

Section 11(1) and 11(2) of the GI Act and Section 32(1) of the GI Rules set forth the requirements for applying for a GI in India. While there is no requirement that applicants engage the assistance of legal or scientific experts, they often do so because the documentation requirements are extensive, and the review process

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43 Section 23(2) of the GI Act specifies that "Nothing in this section shall be deemed to affect right of action in respect of an unregistered geographical indication."

44 Id. at Section 23(1).

45 See <http://ec.europa.eu/trade/creating-opportunities/bilateral-relations/countries/india>.

is rigorous. The application must be in writing in the prescribed format (the application form is available at [http://ipindia.nic.in/girindia/ApplicationForms/GI\\_1.pdf](http://ipindia.nic.in/girindia/ApplicationForms/GI_1.pdf) and attached in Annex I), signed by the applicant or his agent and accompanied by a Statement of Case and the application fee, which is presently 5000 Rupees (around U.S. \$110). The application must be sent to the Geographical Indications Registry, Intellectual Property Office Building, Industrial Estate, G.S.T. Road, Guindy, Chennai – 600 032, phone 044-22502091, 93 or 98, fax 044-22502090, email [gir-ipo.nic.in](mailto:gir-ipo.nic.in), website [www.ipindia.gov.in](http://www.ipindia.gov.in).

As noted previously, any association of persons or producers or any organization or authority established under the law is eligible to apply for GI registration. The applicant must affirm in an affidavit that it represents the interests of the association of persons or producers.

The applicant must explain how the GI designates the origin of goods whose quality, reputation and/or other characteristics are due exclusively or essentially to the geographical environment, with its inherent natural and human factors. In addition, the applicant must show that the production, processing or preparation of the goods takes place in that geographical location. The application must include a map of the territory and details concerning the GI name – whether it is comprised of words or figurative elements or both. Generally, the GI Registry requests product samples, although this is not a formal requirement.

The industry standards for the production, exploitation or manufacture of the goods must be presented along with a detailed description of the human creativity and skills involved and the uniqueness of the geographical environment. In addition, the applicant must describe the mechanism – usually an inspection system – that ensures that the standards, quality, integrity and consistency or other special characteristics of the GI goods are maintained by the producers or manufacturers.

Upon receipt of a GI application, examiners at the GI Registry scrutinize the application to ensure that it is complete. If not, the applicant is notified of the deficiencies and is given one month to rectify them. When all of the application requirements are met, a Consultative Group of technical experts, chaired by the Registrar of GIs, reviews the application in detail and issues an Examination Report. Based on the content of that report and the applicant's responses to

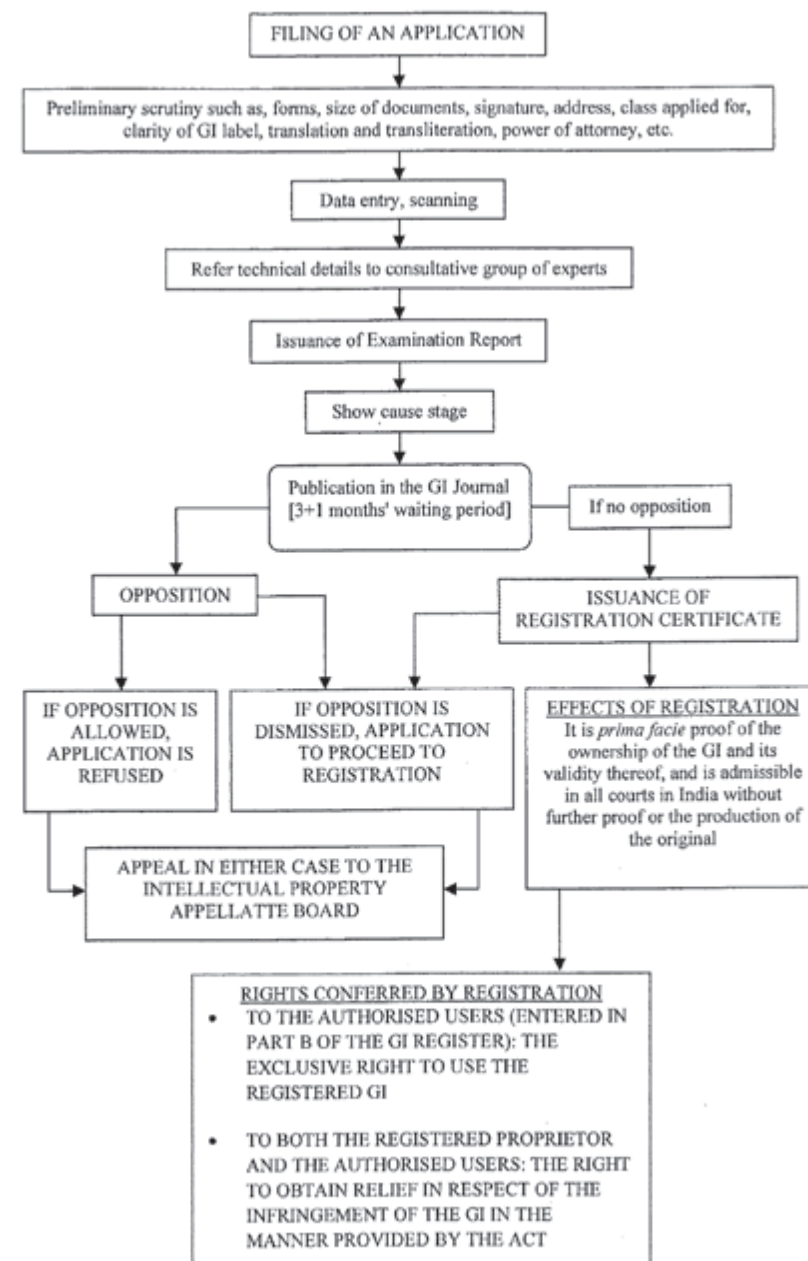
any questions that are raised, the Registrar may refuse the application, accept it absolutely or conditionally (the latter would lead to requests for modification and/or supplementation) and/or schedule a hearing. Even after a hearing, the Registrar may withdraw an application.

Within three months of acceptance, the GI application is published in the *Geographical Indications Journal*, which is published bi-monthly in Hindi and English. It also is posted to the GI Registry's website. Any person can file a notice of opposition within three months. Neither the GI Act nor the GI Rules state the allowable grounds for opposition, although the failure to comply with Section 11 of the GI Act typically would be pleaded. The appeal is heard by the Intellectual Property Appellate Board (IPAB).

If and when the application is finally approved, the Registrar registers it and the applicant receives a certificate with the seal of the GI Registry. Even then, an aggrieved party may file an appeal within three months, which is heard by the IPAB.

The schematic diagram in Table 2 below, provided by the GI Registrar, summarizes the typical GI registration procedure, although there is nothing that prevents the GI Registry from departing from this procedure.

Table 2. GI Prosecution Flow Chart



Source: GI Registry, Chennai, India.



A registered GI is valid for 10 years and can be renewed by payment of the renewal fee (presently, 3000 Rupees or around U.S. \$67). The GI is public property that belongs to the producers; it cannot be transmitted, assigned or mortgaged. The IPAB or the GI Registrar has the power to remove the GI or an authorized user from the Register.

### 3. Case Study - Napa Valley

In November, 2008, the Napa Valley Vintners (NVV), a non-profit trade association consisting of over 300 winery members (the members' names were listed on the application), applied for GI status for Napa Valley wines (class 33). In the Statement of Case accompanying the application, the association described the Native American derivation of the name (Napa means "land of plenty") and the historical origin of Napa Valley wines dating back to the 1860s. The area's renown was traced from that point forward, and documents were submitted attesting to the area's reputation and distinctive wines.

For the section of the application on the uniqueness of the wines and the natural and human factors contributing to it, NVV relied on much of the same material that had been submitted to the Alcohol and Tobacco Tax and Trade Bureau (TTB) of the U.S. Treasury Department in the early 1980s in support of the establishment of Napa Valley as an American Viticultural Area (AVA). An AVA is a specific type of appellation of origin for wine; it is defined under U.S. regulations as "a delimited grape growing region distinguishable by geographical features."<sup>46</sup> TTB establishes AVAs based on their local or national name recognition, historical or current evidence linking the name to the proposed boundary and evidence of viticultural distinctiveness.<sup>47</sup> The evidence establishing the distinctive viticultural characteristics of this area included climate, geography, geology and soils; that evidence was submitted to the GI Registry along with the map showing the boundaries of the Napa Valley that had been approved by TTB when the AVA was established in 1983.

With respect to the human factors that distinguish Napa Valley, NVV presented information concerning the viticultural and enological "best practices" in the

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46 27 Code of Federal Regulations Section 4.25(e)(1).

47 *Id.* at Section 9.3.

appellation. However, unlike the controlled appellations of many Old World winegrowing regions, neither the U.S. government nor NVV "controls" these practices in the sense of mandating particular grape varieties, yields, farming practices, winemaking materials and methods, or the like. That is not to say that grape growers and winemakers are left entirely to their own devices. TTB, along with state and local governments, have adopted detailed regulations on allowable and prohibited viticultural and enological practices, but these regulations apply across the board and not on an appellation-specific basis.

With respect to the quality control and inspection mechanisms that define the right to use the Napa Valley designation on wines, NVV cited in detail the provisions of the U.S. Code of Federal Regulations concerning the use of appellations of origin, including AVAs, recordkeeping requirements, government inspections and government enforcement mechanisms, including the seizure of wine that has been illegally produced or labeled and the requirement that TTB pre-approve every wine label before that wine is sold in commerce.

On February 18, 2009, NVV received an Examination Report in the form of a letter from the GI Registry requesting additional information in support of the application. We were asked, among other things, to provide details on the specification and characteristics of the GI goods, to submit certified copies of the GI map with latitudinal and longitudinal coordinates and to explain in further detail the inspection structure that regulates the use of the Napa Valley GI in the United States. We also were notified that a Technical Committee hearing would be held in India on the Napa Valley GI application covering the following points: proof of origin (historical records), method of production, area map, uniqueness, inspection body and quality control mechanism, along with any other information considered relevant by the Committee.

We asked that the hearing be held in Delhi to coincide with my upcoming trip there, and the committee consented. The hearing was held on March 5, 2009 before the seven members of the Technical Committee, including scientists, lawyers and the Registrar himself.

To prepare for the hearing, I reviewed the questions that had been posed during the Technical Committee hearing on the Champagne application. They included details

on the origin of the name, the vineyard plantings (varietal and clonal selections, yield, age of vines, diseases, harvesting technique and timing), the winemaking process (colors of Champagne, product consistency, yeasts used in fermentation, the process of disgorgement) and the market for Champagne in India.

At the hearing, I delivered a Power Point presentation summarizing the history and main features of the Napa Valley and its wines. The questions that followed were mainly straightforward, concerning details of grapegrowing and winemaking in the Napa Valley. Sometimes the questions strayed rather far afield, like the significance of and local reaction to climate change and the use of pesticides in the vineyard. One question totally surprised me. I was asked about who performs the manual labor in the vineyards and how the wine industry assures their welfare. I could not fathom why that question was being asked, until I later learned that India takes great pride in the role of GIs in human empowerment and the advancement of social welfare. I explained the importance of Hispanic workers in our vineyards and the steps taken by NVV and the larger Napa Valley community to provide affordable housing, health care, schools and other services for these workers.

Following the hearing, we responded to the February Examination Report. Subsequently, in June 2009, we received another Examination Report from the GI Registry requesting, among other things, assurances that NVV represents the interests of producers in the Napa Valley. NVV explained that it is an association of wineries and that another trade association, the Napa Valley Grapegrowers Association, represents the interests of the over 700 grape growers in the Napa Valley. The Registry asked for a “No Objection Letter” from the Napa Valley Grapegrowers Association, which we supplied, supporting NVV’s application for registration of the Napa Valley GI. The GI Registry also asked for further details on the mechanisms to ensure the standards, quality and integrity of Napa Valley wines.

On May 31, 2010, the GI Registry published its acceptance of the Napa Valley GI in the *Geographical Indications Journal*, issue number 34. That 11-page notice contained all the pertinent details supporting the GI registration. In accordance with Section 14(1) of the GI Act, the public was given three months (extendible by one month on request) to oppose NVV’s application. No opposition was filed, and on October 22, 2010, NVV received the registration certificate for the Napa

Valley GI. The registration is valid for 10 years commencing from the date of filing of the GI application.

In summary, it is important to note that not all GI applications involve a hearing, nor do they all take two years to approve. For example, the Cognac GI was registered without a technical committee hearing or an examination report. The average approval time for a GI registration is one to two years unless it is opposed.

## ANNEXES

### I. Model application form

THE GEOGRAPHICAL INDICATIONS OF GOODS (REGISTRATION AND PROTECTION) ACT, 1999	
<p><i>( To be filled in triplicate alongwith the Statement of Case accompanied by five additional representation of the Geographical indication)</i></p> <p>One representation to be fixed within the space and five others to be send separately</p> <p style="text-align: center;">FORM GI-1</p>	
<b>A</b>	Application for the registration of a geographical indication in Part A of the Register Section 11 (1), Rule 23(2) Fee: Rs.5,000 ( See entry No.1A of the First Schedule)
<b>B</b>	Application for the registration of a geographical Indication in Part A of the Register from a convention country Section 11(1), 84(1), Rule 23(3) Fee : Rs.5,000 ( See entry No.1 B of the First Schedule)
<p>1. Application is hereby made by for the registration in Part A of the Register of the accompanying geographical indication furnishing the following particulars : -</p> <ul style="list-style-type: none"> <li>- Name of the Applicant :</li> <li>- Address :</li> <li>- List of association of persons/producers/organization/authority:</li> <li>- Type of goods:</li> <li>- Specification:</li> <li>- Name of the geographical indication [and particulars]</li> <li>- Description of the goods :</li> <li>- Geographical area of production and map :</li> <li>- Proof of origin [Historical records] :</li> <li>- Method of Production :</li> <li>- Uniqueness :</li> <li>- Inspection Body :</li> <li>- Other:</li> </ul> <p>Along with the Statement of Case in Class<sup>b</sup> ..... in respect of <sup>c</sup>..... in the name(s) of<sup>d</sup> ..... whose address is ..... Who claims to represent the interest of the producers of the said goods to which the geographical indication relates and which is in continuous use since in respect of the said goods.</p> <p>2. The Application shall include such other particulars called for in rule 32(1) in the Statement of Case.</p> <p>3. All communications relating to this application may be sent to the following address in India.</p> <p>4. In the case of an application from a convention country the following additional particulars shall also be furnished.</p> <ul style="list-style-type: none"> <li>(a) Designation of the country of origin of the Geographical Indication.</li> <li>(b) Evidence as to the existing protection of the Geographical Indication in its country of origin, such as the title and the date of the relevant legislative or administrative provisions, the judicial decisions or the date and number of the registration, and copies. of such documentation.</li> </ul> <p style="text-align: right;">*SIGNATURE NAME OF THE SIGNATORY</p>	

(IN BLOCK LETTERS)

<b>C</b>	Application for the registration of a geographical indication In Part A of the Register for goods falling in different classes Section 11 (3), Rule 23(5) Fee: Rs.5,000 for each class ( See entry No.1C of the First Schedule)
<b>D</b>	A single application for the registration of a geographical Indication in Part A of the Register for goods falling in different classes from a convention country Section 11(3), rule 23(4) Fee : Rs.5,000 for each class ( See entry No.ID of the First Schedule)
<p>1. Application is hereby made by for the registration in Part A of the Register of the accompanying geographical indication furnishing the following particulars : -</p> <ul style="list-style-type: none"> <li>- Name of the Applicant :</li> <li>- Address :</li> <li>- List of association of persons/producers/organization/authority:</li> <li>- Type of goods:</li> <li>- Specification:</li> <li>- Name of the geographical indication [and particulars]</li> <li>- Description of the goods :</li> <li>- Geographical area of production and map :</li> <li>- Proof of origin [Historical records] :</li> <li>- Method of Production :</li> <li>- Uniqueness :</li> <li>- Inspection Body :</li> <li>- Other:</li> </ul> <p>along with the Statement of Case in Class</p> <ul style="list-style-type: none"> <li>i) Class<sup>b</sup> ..... in respect of <sup>c</sup>.....</li> <li>ii) Class<sup>b</sup> ..... in respect of <sup>c</sup>.....</li> <li>iii) Class<sup>b</sup> ..... in respect of <sup>c</sup>.....</li> </ul> <p>In the name(s) of<sup>d</sup> ..... Whose address is ..... Who claim (s) to represent the interest of the producers of the goods to which the geographical indication relates and which geographical indication is used continuously since ..... in respect of the said goods.</p> <p>2. The Application shall include such other particulars called for in rule 32(1) in the Statement of Case.</p> <p>3. All communications relating to this application may be sent to the following address in India.</p> <p>4. In the case of an application from a convention country the following additional particulars shall also be furnished.</p> <ul style="list-style-type: none"> <li>a. Designation of the country of origin of the Geographical Indication.</li> <li>b. Evidence as to the existing protection of the Geographical Indication in its country of origin, such as the title and the date of the relevant legislative or administrative provisions, the judicial decisions or the date and number of the registration, and copies. of such documentation.</li> </ul>	

\*SIGNATURE  
NAME OF THE SIGNATORY (IN BLOCK LETTERS)

*For instruction please see overleaf*

G1-1A to 1D

The Registrar of Geographical Indications,

The office of Geographical Indications Registry.

- (a) Strike out whichever is not applicable.
- (b) The Registrars' direction may be obtained if the class of the goods is not known.
- (c) Here specify the goods. Only goods included in one and the same class to be specified.
- (d) Insert legibly the full name, description (occupation and calling and nationality of the applicant). In the case of a body corporate or firm the country of incorporation or the registration, if any, as the case may be, should be stated, See rule 15.
- (e) Signature of the applicant or his agent.

## GEOGRAPHICAL INDICATIONS IN CHINA

by Giorgio Bocedi<sup>48</sup>

### Introduction

Following the World Trade Organization (WTO) membership in 2001, China has strengthened its Intellectual Property legal framework to comply with the Agreement on Trade Related Aspect of Intellectual Property Rights (TRIPS).

As for Geographical Indications (GIs), China has three main systems of protection: a *sui generis* system, as provided for under Decree no. 78 on “*Provisions for the Protection of Products of Geographical Indication*” of 7 June 2005, adopted and managed by the General Administration of Quality Supervision, Inspection and Quarantine (AQSIQ); a trademark regime, as provided for under the “*Trademark Law of the People’s Republic of China*”, the “*Regulations for the Implementation of the Trademark Law of the People’s Republic of China*”, the “*Measures for the Registration and Administration of Collective Marks and Certification Marks*” and the “*Measures for the Administration of Special Signs of Geographical Indication Products*”, under the supervision of the State Administration for Industry and Commerce (SAIC); and a third system, focused mainly on raw agricultural products, as provided for under the “*Measures for the Administration of Geographical Indications of Agricultural Products*” of 25 December 2007 and the “*Rules for the Use of Geographical Indications of Agricultural Products*”. The third system is managed by the Center for Agricultural Food Quality and Safety of the Ministry of Agriculture (MOA). In this context, it is worth recalling that the Trademark Law was adopted by a legislative body (i.e. the Standing Committee of the National People’s Congress), while the “*Provisions on the Protection of Geographical Indication Products*” and the “*Measures for the Administration of Geographical Indications of Agricultural Products*” are both ministerial rules.

48 Legal adviser and founder of GB Avvocati, law firm in intellectual property and food law, Reggio Emilia, Italy.

As of June 2009, 932 GIs have been recognized by AQSIQ under the *sui generis* system<sup>49</sup>, including handicrafts and traditional Chinese medicines in addition to agricultural products and foodstuffs.<sup>50</sup> At the international level, through the so-called the “10 plus 10” pilot project with the European Union (EU) launched in 2007, both countries filed applications for the protection of 10 agricultural GIs in the partner’s jurisdiction.<sup>51</sup>

On top of the three parallel protection systems, other laws in China touch upon GIs: the “*Law against Unfair Competition*” and the “*Law on Product Quality*” prohibit providing misleading information as to the the origin of a product, while the “*Law on the Protection of Consumers Rights and Interests*” provides that consumers have the right to obtain true information regarding the origin of commodities and that business operators must provide authentic information.<sup>52</sup>

## 1. The *Sui Generis* System

AQSIQ is a ministerial administration office under the direct supervision of the Council of State. It is in charge, *inter alia*, of national quality, food safety of imported and exported goods, certification and accreditation.

In 1999, AQSIQ promulgated the “*Provisions for the Protection of Designations of Origin Products*” to protect the expertise and interests of all stakeholders and promote rural development. In 2005, such rules were repealed by the aforementioned Decree no. 78 on “*Provisions for the Protection of Products of Geographical Indication*” of 7 June 2005 (Decree 78/05). Such Decree - entered into force on 15 July 2005 - focuses on the control of products’ quality and the

49 Marsha A. Echols, *Geographical Indications for Food Products*, 2008 Kluwer Law International BV, The Netherlands, p. 126.

50 Guihong Wang, *Application of geographical indication systems in China: Jinhua ham case study*, Case study on quality products linked to geographical origin in Asia carried out for FAO, p. 8. Cf. <http://www.foodquality-origin.org/>

51 June 2011, OriGIn Montly Report; cf. OriGIn (Organization for an International Geographical Indications Network) web site <http://www.origin-gi.com/>

52 Wang Xiaobing, Irina Kireeva, *Q&A Manual China Legislation on Geographical Indications*, 2011, p. 7; cf. [http://ipr2.org/storage/Q&A\\_Manual\\_Chinese\\_legislation\\_on\\_GIs1012.pdf](http://ipr2.org/storage/Q&A_Manual_Chinese_legislation_on_GIs1012.pdf)

fight against counterfeiting. GIs should meet precise requirements as provided for in their respective product specification.

According to the definition provided for in Article 2 of the Decree, a GI is the geographical name used to designate a product that originates from a particular geographical area and with quality, reputation, or other characteristics substantially attributable to the natural and human factors of such geographical area. The GIs include: (i) those grown or cultivated in the region; and (ii) those made, wholly or partially, of the raw materials from the region and produced or processed with the particular techniques in the region. The GI definition applies to any kind of goods (agricultural products, handicrafts, wines, spirits, etc.) but does not include services. It seems that non-geographical names cannot be registered.

### 1.1 Registration Procedure

#### *a) Responsible authority*

The registration procedure is subject to two levels of examination. A preliminary examination is carried out by the local competent authority. The application is then submitted to AQSIQ for the formal examination and the approval.

#### *b) Subjects entitled to apply for protection*

An application for the protection of a GI can be filed by an organization designated by the Government (at or above the county level) or by an association or an enterprise appointed by the Government upon consultation with the departments concerned (Article 8, Decree 78/05).

#### *c) The application*

##### *i) Application for registration*

According to Article 10 of Decree 78/05, an application for the protection of a GI must be accompanied by the following documents:

- The local government’s proposal concerning the delimitation of the relevant geographical area;
- The local government’s document authorizing the organization requesting the GI at issue or designating an association or enterprise as an applicant;

- Documents proving that the name at issue is a GI, including: a description of the name, class, delimitation of the geographical area and the characteristics of the product; a description of the physical, chemical or sensory characteristics of the product and their relationship with the natural and human factors of the geographical area; technical specifications (including the product processing techniques, safety and hygiene requirements, technical requirements of the processing equipment); a description of the reputation, production, sales and history of the product; and a request of protection for the GI;
- The GI technical standards.

A standard application form is not available.

#### *ii) Examination, publication and opposition, approval (Articles 13 to 16)*

The application shall be submitted to the local competent authority that will prepare preliminary a opinion and forward the relevant documents to AQSIQ. The General Administration will then carry out a formal examination (in this respect, it appoints an expert panel for technical examinations). If AQSIQ considers that the application fails to meet the requirements of the legislation, it notifies the applicant. On the other hand, if AQSIQ considers that the requirements are met, the application is published for opposition by third parties, to be lodged within two months. If no opposition is raised or some are raised but rejected, AQSIQ publishes a notice of approval. Protection can then be considered granted to the GI at issue.

#### *d) Product specification*

According to Article 17 of Decree 78/05, separate national and/or regional standards or regulations are formulated for GIs according to the product's class, geographical area, reputation, production and sales. These standards or regulations correspond to the product's specification of the EU legislation on GIs. However, the standards or regulations are issued by the State or the local competent authorities and not, as in the EU, by producers' groups.<sup>53</sup>

#### *e) Application of foreign GIs*

Article 26 of Decree 78/05 provides that AQSIQ is responsible of the

<sup>53</sup> Cf. e.g. Council Regulation (EC) No 510/06 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, Articles 4 and 5.

applications concerning foreign GIs. Furthermore, it provides that specific provisions for the registration of foreign GIs and their protection in China will be established separately. As of September 2011, these provisions were not published. Two foreign GIs have been registered by AQSIQ (“Cognac” and “Scotch Whisky”)<sup>54</sup>.

#### *f) Fees*

According to the Decree 78/05, no fees are required for GI applications in China.

## 1.2 Users

According to Article 20 of Decree 78/05, exclusively qualified operators can use a protected GI. To be qualified, an operator must (i) be based within the defined geographical area and (ii) submit an application before the local AQSIQ bureau with the following documents:

- An request to be allowed to use the GI name;
- A certificate issued by the competent authorities of the local government proving that the products concerned originate from the relevant geographical area;
- An inspection report issued by the relevant quality inspection department.

In addition to this, the request is subject to two supplementary levels of examination, first by the local competent authority and then by AQSIQ. Should the operator comply with the requirements, AQSIQ will authorize it to use the GI and publish its decision in the relevant publication. The operator is then legitimately entitled to use the GI on its products. No fees are required for such procedure.

The use of GIs is subject to supervision and controls. If a registered user fails to observe the relevant standards and administrative regulations, AQSIQ will terminate its authorization to use the GI and publish its decision in the relevant publication (Articles 5 and 23).

<sup>54</sup> See <http://www.chinalawinsight.com/2012/01/articles/intellectual-property/protecting-foreign-geographic-indications-in-china/>

## Logo

A GI logo is provided under the *sui generis* system, which consists of the sentence “geographical indication protection product of the People’s Republic of China” in Chinese, the words “People’s Republic of China” in English, the GI name, the map of China and the abbreviation “PGI” on it:



### 1.4 Protection

#### a) Scope of protection

Article 21 of Decree 78/05 prohibits:

- Unauthorized uses of registered GIs and counterfeiting;
- The use of GIs in violation of the production standards; and
- The use of names that are similar to the registered GIs and are likely to cause misidentification, as well as the use of words or logos that are likely to mislead consumers.

According to the above-mentioned provision, it seems that an *ex officio* protection is available.<sup>55</sup>

#### b) Duration

The legislation in force establishes no term for the registration of a GI.

55 O’Connor and Company - Insight Consulting, *Geographical indications and TRIPs: 10 Years Later...A roadmap for EU GI holders to gain protection in other WTO Members*, Part II, p. 358. [http://trade.ec.europa.eu/doclib/docs/2007/june/tradoc\\_135089.pdf](http://trade.ec.europa.eu/doclib/docs/2007/june/tradoc_135089.pdf)

## 2. The Trademark System

The trademark system provides the option of registering a GI as a collective mark or as a certification mark. This option is available for both goods and services.

According to Article 16, paragraph 2, GIs are signs identifying the place of origin of the goods in respect of which they are used, when the good’s specific quality, reputation or other characteristics are mainly linked to the natural or cultural factors of the relevant geographical area. According to Article 3, paragraphs 2 and 3 of the Trademark Law, collective marks are signs which are registered in the name of associations or other organizations, with the objective to be used by their members in their commercial activities and show the affiliation to the corresponding association or other organization; on the other hand, certification marks are signs used by entities or individuals to certify the origin, material, mode of manufacture, quality or other characteristics of their goods or services. Certification marks are not controlled by the producers, but rather by independent organizations in charge of supervising that the goods and services on which those signs are used respect the quality characteristics as identified in the regulation governing the use of the certification mark. A regulation governing the use of the sign is a requirement for both collective and certification marks.

According to article 8 of the “*Measures for the Registration and Administration of Collective Marks and Certification Marks*” (Measures for Collective and Certification Marks), a GI in respect of which an application for the registration as a collective mark or as a certification mark is filed can be the GI name itself, or any other visual signs capable of indicating that the goods at issue originate from the relevant geographical area (which is not required to be equivalent to the name or to have the same boundaries of an administrative division).

### 2.1 Registration Procedure

The application for the registration of a GI as a collective or certification mark shall be lodged before the Chinese Trademark Office, operating under the State Administration for Industry and Commerce.

According to the Measures for Collective and Certification Marks, an application for the registration of a GI as a collective mark must be filed by a company,

an association, or any other organization composed of members based in the geographical area indicated by the GI. The applicant must provide documents certifying its legal status and indicating the names and addresses of its members. The applicant must also submit detailed information demonstrating its capacity to supervise and ensure the respect of the specific GI characteristics (Art. 4).

Likewise, for certification marks the applicant must provide documents certifying its legal status and submit detailed information demonstrating its capacity to supervise and ensure the respect of the specific GI characteristics (Art. 5).

#### *a) Application for registration*

##### *i) Application*

According to Article 7 of the Measures for Collective and Certification trademarks, an application for registration of a GI as a collective or certification mark must be accompanied by the following information:

- the given quality, reputation or any other characteristic of the goods identified by the GI;
- the correlation between the given quality, reputation or any other characteristic of the goods and the natural and human factors of the relevant geographical area;
- the boundaries of the relevant geographical area.

##### *ii) Examination, publication and opposition, registration*

The application must be lodged before the Trademark Office by the applicant or his/her agent directly or sent by mail. If the application is submitted by a foreigner, it must be lodged to the Trademark Office by his/her agent.

The Chinese language must be used in applying for trademark registration or handling other trademark matters. If a certificate, certifying document or any other evidence submitted in accordance with the provisions of the Trademark Law and these Regulations is presented in a foreign language, a Chinese translation is required. Furthermore, when a trademark is, or consists of, foreign words, their Chinese meaning must be indicated (Articles 8 and 13.6 of the Regulations for the Implementation of the Trademark Law). When the application formalities are completed and the various documents are provided, the Trademark Office accepts the application and notifies the applicant in

writing. If there is a need for further information or amendments, the Trademark Office notifies the applicant (within 30 days from the date of receipt of the notification, Article 18 of the Regulation for the Implementations of the Trademark Law).

When a collective or certification mark has been applied for in conformity with the relevant provisions of the Trademark Law, the Trademark Office must analyze the dossier and, if the conditions are met, preliminarily approve the mark and publish it. When a requested collective or certification mark is not in conformity with the relevant provisions of the Trademark Law, or it is identical or similar to the previously registered trademarks (including preliminarily approved trademark), the Trademark Office refuses the application and notifies the applicant in writing. The applicant can - within 15 days from the receipt of the notice - file a request for review with the Trademark Review and Adjudication Board, which takes a decision and notifies the applicant in writing. Any interested party not satisfied with the decision of the Trademark Review and Adjudication Board has the opportunity - within 30 days from the receipt of the notice - to start legal proceedings in a national court (Articles 27, 28 and 32 of the Trademark Law).

Where an opposition is filed against a collective or certification mark which, after examination, has been preliminarily approved and published, the Trademark Office must hear both the opponent and the applicant. Following investigation and verification, the Office takes a decision. The opponent and the applicant, within 15 days from the receipt of the notification, can apply for reexamination. In such a case, the Trademark Review and Adjudication Board will take a decision and notify both the opponent and the applicant in writing. Any interested party not satisfied with such decision has the opportunity - within 30 days from the receipt of the notice - to start legal proceedings in a national court, which must notify the other party to give it a chance to be a third party to the litigation (Article 33 of the Trademark Law).

If the opposition cannot be established, the registration is approved, a certificate of trademark registration is issued and the collective or certification mark is published; if the opposition is established, the registration is not approved (Article 34 of the Trademark Law).



*b) Regulation governing the use of the collective and certification marks*

According to Article 13, paragraph 5 of the Measures for Collective and Certification Trademarks, an applicant for the registration of a GI as collective mark or as a certification mark must submit a regulation governing the use of the relevant mark.

The regulation governing the use of a collective mark must include:

- The purpose of using the collective mark;
- The quality of the goods to which the collective mark applies;
- The procedures to use the collective mark;
- The rights and obligations entailed in the use of the collective mark;
- The members' liability for their breach of the regulation;
- The system of registrant's inspection and supervision of the goods to which the collective mark applies (Article 10).

The regulation governing the use of a certification mark must include:

- The purpose of using the certification mark;
- The particular quality of the goods certified by the certification mark;
- The requirements to use the certification mark;
- The procedure to use the certification mark;
- The rights and obligation entailed in the use of the certification mark;
- The user's liability for breach of the regulation;
- The system of the registrant's inspection and supervision of the goods to which the certification mark applies (Article 11).

*c) Applying for the registration of foreign GIs*

According to Article 17 of the Trademark Law, any foreign person or foreign enterprise intending to apply for the registration of a trademark in China shall file an application in accordance with any agreement concluded between the People's Republic of China and the country to which the applicant belongs, in accordance with international treaties to which both countries are parties, or on the basis of the principles of reciprocity.

Any foreign person or enterprise applying for the registration of a GI as a collective mark or as a certification mark shall provide documents certifying that

the GI at issue is under the applicant's name in the country of origin (Article 6, paragraph 2 of Measures for Collective and Certification Marks).<sup>56</sup>

*d) Fees*

The fee for each application corresponds to 3,000 RMB Yuan. If an applicant intends to get the registration of the trademark in different classes, an application must be submitted for each class according to the classification and pay the corresponding fee for each application.

## 2.2 Users

Where a GI is registered as a collective mark, any natural person, legal person or other organization whose goods satisfy the conditions of the regulation governing the use of the mark can request the membership to the company, association or any other organization which registered the GI as a collective mark. The latter accepts the membership in accordance with its statutes. To authorize the use of a collective mark, the organization which registered it issues a license (Art. 19 of Measures for Collective and Certification Marks). If a natural person, legal person or other organization satisfies the conditions of the regulation governing the use of the collective mark can legitimately use the GI, and the organization which registered it is not entitled to prohibit such use (Art. 6 of the Regulations of the Trademark Law).

Where a GI is registered as a certification mark, any natural person, legal person or other organization whose goods satisfy the conditions of the regulation governing the use of the mark can request its use (Article 6 of the Regulations of the Trademark Law). To authorize the use of a certification mark, the organization in control of it issues a license (Art. 19 of Measures for Collective and Certification Marks).

Concerning fees, it cannot be excluded that the owner of the certification or collective mark requires the payment of a fee.

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<sup>56</sup> The list of foreign GIs registered in China as collective or certification trademark is available only in Chinese on the web site of the Trademark Office under the State Administration for Industry and Commerce <http://www.saic.gov.cn>

## 2.3 Logo

On 30 January, 2007 the “*Measures for the Administration of Special Signs of Geographical Indication Products*” entered into force in China. According to Article 1, the Measures were adopted in order to strengthen the protection of GIs, maintain the legitimate rights and interests of GI beneficiaries, regulate the use of special signs on local products and promote the development of GIs.

The special sign available under the trademark system consists of the expressions “Trademark Office of the State Administration for Industry and Commerce”, both in Chinese and English, “Chinese Geographical Indications” in Chinese, the acronym “GI”, and the symbols of wheat and of the Temple of Heaven:



This logo must be used together with the corresponding GI, following the guidelines promulgated by the Trademark Office of the State Administration for Industry and Commerce. Legal users of registered GIs can use the logo on commodities, packages or containers, advertising campaigns, exhibitions and other commercial activities. No charges are to be paid for the use of the logo.

## 2.4 Protection

### a) Scope of protection

The registration of a GI as a certification or collective mark grants the owner and users *ius excludendi alios* concerning the registered GI with respect to the goods for which the use of the mark has been approved.

According to Article 52 of the Trademark Law, the following acts shall be considered infringements of the GI registered as certification or collective mark:

- Using a trademark that is identical or similar to a registered trademark with respect to identical or similar goods, without authorization from the trademark owner;
- Selling goods bearing a counterfeited registered trademark;
- Counterfeiting, or reproducing without authorization representations of the registered trademark, or selling such representations without authorization;
- Replacing, without the consent of the trademark owner, the registered trademark and reselling the goods bearing the replaced trademark; and
- Causing prejudice to the exclusive right to use a registered trademark.

Additional protection is provided for well-known trademarks. Article 14, paragraph 2 of the Trademark Law establishes that when an application is filed for the registration of a trademark that is a reproduction, imitation or translation of a well-known trademark, misleads the public and is likely to create prejudice against the interests of the well-known mark’s registrant, it shall be rejected and its use shall be prohibited, including in cases where the trademark is applied for with respect to non-identical or dissimilar goods.

According to the obligation arising from Article 23, paragraph 1 of TRIPS that provides for additional protection for GIs identifying wines or spirits, Article 13 of the Measures for Collective and Certification Marks prohibits the use of a registered GI for wines or spirits as a collective mark or a certification mark to identify wines or spirits not originating in the place indicated by the GI at issue, even when the true origin of the goods is indicated or the GI is used in translation or accompanied by expressions such as “kind,” “type,” “style,” “imitation” or the like.

Finally, it deserves to be mentioned that, like in the case of several national legislations on collective and certifications marks, and according to the exception granted by Article 17 of TRIPS, Article 49 of the Regulations of the Trademark Law allows third parties the so-called “fair use” of the, *inter alia*, geographical name registered as a collective or certification mark in China.

### b) Duration

The period of validity of a registered trademark is 10 years. The renewal of the registration requires the payment of an additional fee, corresponding to 2,000 RMB Yuan.

### 3. The GIs for Agricultural Products

The “*Measures for the Administration of Geographical Indications of Agricultural Products*” (Measures for GIs of agricultural products), which were approved on 25 December 2007 and entered into force on 1 February 2008, established a *sui generis* system exclusively intended for agricultural products.

The definition of GIs for agricultural products refers to special agricultural product indications that are named after territorial denomination and are meant to indicate that a given agricultural product is from a specific geographical area and that its quality and major characteristics mainly derive from the natural and ecological environment as well as cultural and historical factors of the geographical area at issue. Such a definition seems to be very similar to the concept of Protected Designation of Origin (PDO) provided for in the EU Regulations 510/2006. However, it is to be noted that, according to Article 7 of the Measures for GIs of Agricultural Products, the GI shall be composed of the name of the geographic area and the general name of the agricultural product.

The measures for GIs of agricultural products apply to primary products sourced from agriculture, namely plants, animals, microorganisms and the products thereof obtained in agricultural activities (Art. 2).

#### 3.1 Registration Procedure

##### *a) Authority responsible for registration*

The Authority responsible for the registration of agricultural products GIs is the MOA, while the Agricultural Product Quality Safety Center (APQSC) under the MOA is in charge of the examination and expert appraisal of them. Like in the *sui generis* system, the registration procedure is subject to two levels of examination: applications cannot be submitted directly to the MOA and the APQSC, but must be first sent to the local authority (i.e. the administrative department of agriculture under the provincial level government).

##### *b) Subjects entitled to apply for registration*

Applicants for the registration of a GI for an agricultural product must be professional cooperatives, organizations of farmers and industrial associations

determined by the local authority at or above the county level, in accordance with the following conditions:

- Having the capability for supervising and administering the GIs of agricultural products and the products thereof;
- Having the capability for providing guidance concerning the production, processing and marketing of agricultural products with GI; and
- Having an independent legal capability and civil responsibility (Article 8).

##### *c) Application for registration*

##### *Application*

According to Article 9 of the Measures for GIs of agricultural products, the application for registration of a GI must be accompanied by the following documents:

- An application form;
- A certificate concerning the applicant legal status;
- A description on the typical characteristics of the product and a corresponding product quality appraisal report;
- The environment conditions of the producing area, the technical norms of production and the technical norms on products' quality safety;
- A document determining the territorial scope, and a distribution map of its producing area;
- A sample or a picture of the product; and
- Other necessary descriptive or evidentiary material.

No standard application form is available.

##### *Examination, publication and opposition, registration (Articles 10 to 12)*

The application must be submitted to the local competent authority which, within 45 working days, carries out the preliminary examination and propose its preliminary opinion. If the application satisfies the relevant requirements, the local competent authority files the application material together with the preliminary examination opinion to the APQSC. If the application does not satisfy the relevant requirements, the local competent authority notifies its opinion to the applicant within 10 working days.

The APQSC, within 20 working days from the date when it receives the application documents and the preliminary opinion, examines the application,

proposes its opinion and sets-up an experts committee for appraisal. If the expert committee is in favor of the application, the APQSC shall publish an announcement concerning the application approval, which can be opposed by third parties within 20 days. If any objection is lodged, the APQSC shall organize an expert committee to review the objection, and, in case that the latter is not in favor of the application, the MOA is responsible to take a decision on the registration, and to notify the reasons to the applicant in written form. If no objections are received or they are dismissed, the MOA registers the GI and publishes it an official announcement.

The Certificate of the People's Republic of China on the registration of a GI of an agricultural product is then issued by the MOA and the relevant technical norms and standards for the products concerned are made public.

#### *d) Quality control tracing system*

The producers of agricultural products with GIs must establish a quality control tracing system. Holders of certificates of the registration of GIs of agricultural products and users of such indications are responsible for the quality and credibility of the agricultural products concerned (Article 19).

#### *e) Application for registration of foreign GIs*

According to Article 24 of the Measures for GIs of Agricultural Products, the MOA accepts applications for the registration of GIs of agricultural products from foreign countries and protects them in the People's Republic of China. There is a project to detail specific measures for foreign GI applications in an independent instrument.

#### *f) Fees*

No fee shall be charged for the registration of GIs of agricultural products.

### 3.2 Users

According to Article 15 of the Measures for GIs of Agricultural Products, a company/organization or individual can submit an application as long as it satisfies the following conditions:

- The agricultural good produced or traded originates from the relevant geographical area;

- It has obtained the corresponding qualification for producing or trading the agricultural product at issue;
- It is capable of carrying out production and trading activities in strict accordance with the prescribed quality and technical norms; and
- It has the capacity for the market development of the agricultural product at issue.

Following the registration, to use a GI, interested parties must conclude an agreement with the GI certificate holder. Such an agreement must indicate the quantities to be produced and the scope of the GI use, as well as the relevant responsibilities and obligations. In this respect, the certificate holder of a GI of agricultural products cannot charge fees. Meanwhile, a GI user is entitled to:

- Use the GI on his/its products and the packages thereof; or
- Use the GI for publicity or to participate in exhibitions or sales fairs (Article 16).

Moreover, the user must accept the supervision and examination of the GI certificate holder, guarantee the quality and credibility of the agricultural product covered by the GI, and correctly and legally use the GI (Article 17).

### 3.3 Logo

Article 14 of the Measures for GIs of Agricultural Products provides for a logo, consisting of a combination of a symbol and the GI name itself (which cannot be used separately). The logo contains the name "Ministry of Agriculture of the P.R.C." both in Chinese and English, as well as the words "agro-product Geographical Indications," again in Chinese and English, in addition to the symbols of wheat, the earth, the sun and the moon:



### 3.4 Protection

#### *a) Scope of protection*

Article 20 of the Measures for GIs of Agricultural Products establishes that no company/organization or individual is entitled to counterfeit or falsely use any GIs of agricultural products or any registration certificates.

#### *b) Duration*

According to Article 13 of the Measures for GIs of Agricultural Products, the registration certificate of a GI is not limited in time. The certificate holder is required to file an application for modification in accordance with the prescribed procedure under any of the following circumstances: the registration certificate holder or the legal representative changes or the GI territorial scope or corresponding natural and ecological environment changes.

## ANNEXES

### I. Relevant Regulatory Framework

- Provisions for the Protection of Products of Geographical Indication;<sup>57</sup>
- Trademark Law of the People's Republic of China;<sup>58</sup>
- Regulations for the Implementation of the Trademark Law of the People's Republic of China;<sup>59</sup>
- Measures for the Registration and Administration of Collective Marks and Certification Marks;<sup>60</sup>
- Measures for the Administration of Special Signs of Geographical Indication Products;<sup>61</sup>
- Measures for the Administration of Geographical Indications of Agricultural Products;<sup>62</sup>
- Rules for the Use of Geographical Indications of Agricultural Products.<sup>63</sup>

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57 Cf. the Chinese version [http://english.aqsiq.gov.cn/LawsandRegulations/RelatedLawsandRegs/200708/t20070817\\_36280.htm](http://english.aqsiq.gov.cn/LawsandRegulations/RelatedLawsandRegs/200708/t20070817_36280.htm) and the English version <http://www.wipo.int/wipolex/en/details.jsp?id=6348>

58 Cf. both Chinese and English versions <http://www.wipo.int/wipolex/en/details.jsp?id=5003>

59 Cf. both Chinese and English versions <http://www.wipo.int/wipolex/en/details.jsp?id=856>

60 Cf. the English version [http://www.chinaipr.gov.cn/lawsarticle/laws/lawsar/trademark/200604/233093\\_1.html](http://www.chinaipr.gov.cn/lawsarticle/laws/lawsar/trademark/200604/233093_1.html)

61 Cf. both Chinese and English versions <http://www.wipo.int/wipolex/en/details.jsp?id=6577>

62 Cf. both Chinese and English versions <http://www.wipo.int/wipolex/en/details.jsp?id=6578>

63 Cf. Chinese version [http://www.moa.gov.cn/zwllm/nybz/200808/t20080825\\_1168527.htm](http://www.moa.gov.cn/zwllm/nybz/200808/t20080825_1168527.htm)

## II. Contact Information

- General Administration of Quality Supervision, Inspection and Quarantine (AQSIQ):  
No. 9, Madian East Road  
Haidian District  
Beijing, China  
Postal code: 100088  
People's Republic of China  
Website: <http://english.aqsii.gov.cn/>  
E-mail: [webmaster@aqsiq.gov.cn](mailto:webmaster@aqsiq.gov.cn)
- Trademark Office under the State Administration for Industry and Commerce:  
No. 8, Sanlihedonglu  
Xicheng District  
Beijing, China  
Postal code: 100820  
Telephone: (8610) 68027820, 86-10-68052266  
Fax: (8610) 68013623  
Website: <http://ww.ctmo.gov.cn> or <http://ww.saic.gov.cn>
- Ministry of Agriculture:  
Center for Agricultural food Quality and Safety  
No. 11 Nongzhanguan Nanli  
Chaoyang District  
Beijing, China  
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