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Act 602

Geographical Indications Act 2000

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GEOGRAPHICAL INDICATIONS ACT 2000

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GEOGRAPHICAL INDICATIONS ACT 2000

An Act to provide for the protection of geographical indications and for matters connected therewith.

ENACTED by the Parliament of Malaysia as follows:

PART I

PRELIMINARY

Short title and commencement

1. (1) This Act may be cited as the Geographical Indications Act 2000.

(2) This Act shall come into operation on a date to be appointed by the Minister by notification in the *Gazette*.

Interpretation

2. In this Act, unless the context otherwise requires

"competent authority" means any government or statutory body carrying out the functions of, on behalf of, or sanctioned by, the Government;

"Court" means the High Court;

"geographical indication" means an indication which identifies any goods as originating in a country or territory, or a region or

locality in that country or territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to their geographical origin;

"goods" means any natural or agricultural product or any product of handicraft or industry;

"interested person" means any of the persons specified in section 11;

"Minister" means the Minister responsible for trade marks;

"Paris Convention" means the Paris Convention for the Protection of Industrial Property of 20 March 1883, as revised or amended from time to time;

"producer" means

(a) any producer of agricultural products; (b) any person exploiting natural products;

(c) any manufacturer of products of handicraft or industry; or

(d) any trader dealing in any of the products mentioned in paragraphs (a), (b) or (c);

"protectable geographical indication" means a geographical indication which does not fall within any of the categories of geographical indications specified in section 4;

"Register" means the Register of Geographical Indications kept under this Act;

"Registrar", "Deputy Registrar" and "Assistant Registrar" mean respectively the Registrar of Geographical Indications, the Deputy Registrar of Geographical Indications and the Assistant Registrar of Geographical Indications, as the case may be, appointed under section 8.

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PART II

PROTECTION OF GEOGRAPHICAL INDICATIONS

Protection of geographical indications

3. Protection under this Act shall be given to a geographical indication

(a) regardless whether or not the geographical indication is registered under this Act; and

(b) as against another geographical indication which, although literally true as to the country, territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another country, territory, region or locality.

Exclusion from protection

4. Notwithstanding section 3, the following shall not be protected as geographical indications:

(a) geographical indications that do not correspond to the meaning of "geographical indication" as defined in section 2;

(b) geographical indications which are contrary to public order or morality;

(c) geographical indications which are not or have ceased to be protected in their country or territory of origin; or

(d) geographical indications which have fallen into disuse in their country or territory of origin.

Institution of proceedings for injunction and damages

5. (1) Any interested person may institute proceedings in the Court to prevent, in respect of geographical indications

(a) the use in the course of trade of any means in the designation or presentation of any goods that indicates or suggests, in a manner which misleads the public as to the geographical

origin of the goods, that the goods in question originate in a geographical area other than the true place of origin;

- (b) any use in the course of trade which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention as set out in the Schedule;
- (c) any use in the course of trade of a geographical indication which, although literally true as to the country, territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another country, territory, region or locality; or
- (d) any use in the course of trade of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or a geographical indication identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the wines or spirits is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style" or "imitation".

(2) The Court may grant an injunction to prevent any unlawful use of the geographical indication and award any damages and any other legal remedy or relief as it deems fit.

Failure to take action

6. (1) No action under section 5 shall be brought against a person for the use of a trade mark which contains or consists of a geographical indication after the expiry of five years

(a) from the date such use by that person or his predecessor in title has become generally known in Malaysia; or

(b) from the date of registration of the trade mark by that person under the Trade Marks Act 1976 [Act 175],

whichever is earlier.

(2) Subsection (1) shall not apply where the trade mark was used or registered in bad faith.

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Homonymous geographical indications for wines

7. (1) In the case of homonymous geographical indications for wines, protection shall be accorded to each indication.

(2) The Registrar, in cases of *bona fide* concurrent use of homonymous geographical indications, shall determine the practical conditions under which the homonymous geographical indications in question will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that the public are not misled.

PART III

ADMINISTRATION

Registrar, Deputy Registrars and Assistant Registrars

8. (1) The Minister may appoint a Registrar of Geographical Indications who shall be conferred with powers and functions for the proper administration of this Act.

(2) The Minister may appoint such number of Deputy Registrars of Geographical Indications and Assistant Registrars of Geographical Indications as may be necessary for carrying out the provisions of this Act.

(3) The Deputy Registrars and Assistant Registrars may exercise any of the functions and powers of the Registrar under this Act.

(4) The Registrar shall have a seal of such device as may be approved by the Minister and the impressions of such seal shall be judicially noticed and admitted in evidence.

Geographical indications offices

9. (1) A Central Geographical Indications Office and such number of branch offices of the Central Geographical Indications Office as may be necessary for the purposes of this Act shall be established.

(2) Any application or other document required or permitted to be filed at the Central Geographical Indications Office may be

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filed at any branch office of the Central Geographical Indications Office and such application or other document shall be deemed to have been filed at the Central Geographical Indications Office.

Register of Geographical Indications

10. (1) The Registrar shall keep and maintain a register called the Register of Geographical Indications in which all particulars as the Registrar deems appropriate shall be recorded.

(2) The Register shall be kept in such form and on such material as may be prescribed.

(3) The Register shall be open to the inspection of the public at such times and in accordance with such conditions as may be prescribed.

(4) A certified true copy or extract of any entry in the Register sealed with the seal of the Registrar shall be given to any person requiring the copy or extract on payment of the prescribed fee.

PART IV

REGISTRATION OF GEOGRAPHICAL INDICATIONS

Persons who may apply for registration

11. (1) The following persons shall be entitled to file an application for registration of a geographical indication:

- (a) a person who is carrying on an activity as a producer in the geographical area specified in the application with respect to the goods specified in the application, and includes a group or groups of such person;
- (b) a competent authority; or
- (c) a trade organisation or association.

(2) Where the applicant's ordinary residence or principal place of business is outside Malaysia, he shall appoint, to act on his behalf, an agent who

(a) is domiciled or resident in Malaysia;

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- (b) is constituted under the laws of Malaysia; or
- (c) carries on business or practice principally in Malaysia.

Application for registration

12. (1) An application for the registration of a geographical indication shall be filed with the Registrar in the prescribed manner and shall specify

(a) the name, address and nationality of the natural person or legal entity filing the application, and the capacity in which the applicant is applying for registration;

(b) the geographical indication for which registration is sought;

(c) the geographical area to which the geographical indication applies;

(d) the goods for which the geographical indication applies;

(e) the quality, reputation or other characteristic of the goods for which the geographical indication is used; and

(f) any other particulars as may be prescribed.

(2) An application under subsection (1) shall be accompanied by the prescribed fee.

Application for registration to be advertised

13. If the Registrar is satisfied after examining the application for registration, that the application has complied with the requirements of sections 11 and 12 and that the geographical indication sought to be registered is not contrary to public order and morality, the Registrar shall cause the application to be advertised in a manner as may be prescribed.

Opposition to application for registration

14. (1) Any interested person may, within two months from the date of advertisement of an application for registration, give notice to the Registrar and the applicant of his intention to oppose the

application on the grounds that the geographical indication sought to be registered by the applicant

- (a) does not fall within the meaning of the definition of "geographical indication" under this Act;
- (b) is contrary to public order or morality;
- (c) is not or has ceased to be protected in its country of Origin; or
- (d) has fallen into disuse in its country of origin.

(2) The notice shall be given in writing in the prescribed manner and shall include a statement of the grounds of opposition.

Reply by applicant

15. (1) The applicant shall within two months after the receipt of the notice of opposition send a reply to the Registrar and the opponent, in the prescribed manner, of the grounds for his application for registration.

(2) If the applicant fails to reply to the opposition within the period specified in subsection (1) or, if the period has been extended by the Registrar, within the additional period, the applicant shall be deemed to have abandoned his application for registration.

Filing of documentary evidence in support

16. (1) Where the applicant submits a reply under subsection 15(1), the opponent and applicant shall file documentary evidence in support of the opposition or the application for registration, as the case may be, with the Registrar.

(2) Any documentary evidence to be filed by the opponent or applicant under subsection (1) shall be filed within the prescribed time and in the prescribed manner.

(3) Where the applicant files the documentary evidence in support of his application for registration, the opponent may be given an opportunity, within the prescribed time, to submit to the Registrar and applicant evidence in reply to be adduced in the prescribed manner.

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(4) After considering the documentary evidence filed by the opponent and applicant, and after giving both parties an opportunity to make submissions, the Registrar shall decide whether

(a) to refuse to register the geographical indication; (b) to register the geographical indication; or

(c) to register the geographical indication subject to such conditions, amendments, modifications or limitations as he may think fit.

(5) The Registrar shall within two months after making a decision under subsection (4) prepare his grounds of decision in writing.

(6) Any person aggrieved by the decision of the Registrar under subsection (4) may appeal to the Court.

Failure to file documentary evidence

17. (1) Where the applicant fails to file the documentary evidence as required under subsection 16(1), the Registrar shall be entitled to treat the application for registration as abandoned.

(2) Where the opponent fails to file the documentary evidence as required under subsection 16(1), the Registrar shall be entitled to treat the opposition as abandoned and shall register the application and issue to the applicant a certificate of registration in the prescribed form.

Appeal to Court

18. (1) In any appeal under subsection 16(6), the Court may, after hearing the parties, make an order for

(a) the geographical indication to be registered;

(b) the geographical indication to be registered subject to any modification which shall not in any manner substantially affect the identity of the geographical indication; or

(c) the geographical indication not to be registered.

(2) Where the Court makes an order under paragraph (1)(a) or (b), the Registrar shall register the geographical indication as required and issue to the applicant a certificate of registration in the prescribed form.

Registration of geographical indication

19. Where the Registrar is satisfied that the application for registration of a geographical indication complies with the requirement of sections 14 and 15 and that the geographical indication sought to be registered is not contrary to public order or morality and

(a) no opposition has been filed under section 14; or

(b) the Registrar has made a decision under paragraph 16(4)(b) or (c) and no appeal has been filed against that decision,

the Registrar shall register the geographical indication and issue to the applicant a certificate of registration in the prescribed form.

Presumption where geographical indication is registered

20. (1) A geographical indication registered under this Act shall, in any proceedings, raise a presumption that such indication is a geographical indication within the meaning of section 2.

(2) A certificate of registration issued under this Act shall be *prima facie* evidence of the facts stated in the certificate and of the validity of the registration.

Right of use

21. (1) In the case of registered geographical indications, only producers carrying on their activity in the geographical area specified in the Register shall have the right to use a registered geographical indication in the course of trade.

(2) The right of use shall be in respect of the products specified in the Register in accordance to the quality, reputation or characteristic specified in the Register.

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PART V

OTHER POWERS OF THE REGISTRAR

Cancellation and rectification of registration

22. (1) The Registrar may, on the request of any interested person and upon payment of the prescribed fee

- (a) cancel the registration of a geographical indication on the ground that the geographical indication does not qualify for protection as such having regard to section 4; or
- (b) rectify the registration of a geographical indication on the ground that the geographical area specified in the registration does not correspond to the geographical indication, or that the indication of the products for which the geographical indication is used or the indication of the quality, reputation or other characteristic of such products is missing or unsatisfactory.

(2) The persons who request for the cancellation or rectification of the registration of the geographical indication under subsection (1) shall give notice to the applicant who filed the application for registration of the geographical indication or his successor in title.

(3) The Registrar shall, in a manner to be prescribed, notify all persons having the right to use the geographical indication under section 21.

(4) The persons referred to in subsection (3) and any other interested persons may, within a period which shall be specified by the Registrar, apply to the Registrar to join in any proceedings which may be held by the Registrar to determine whether or not the registration of the geographical indication should be cancelled or rectified.

(5) The Registrar shall within two months after making a decision under subsection (1) prepare his grounds of decision in writing.

(6) Any person aggrieved by the decision of the Registrar under subsection (1) may appeal to the Court.

Correction of errors

23. The Registrar may correct any error of translation or transcription, clerical error or mistake in any application or document filed with the Registrar or in any matter recorded pursuant to this Act or the regulations made under this Act.

Extension of time

24. Where by this Act or any regulations made under this Act, a time is specified within which an act or thing is to be done, the Registrar may, upon receiving a written request so to do and if he is satisfied that the circumstances justify it, extend the time either before or after its expiration, upon payment of the prescribed fee.

Power to award costs

25. (1) In all proceedings before the Registrar under this Act, the Registrar shall have power to award to any party such costs as he may consider reasonable.

(2) Costs awarded by the Registrar may in default of payment be recovered in a court of competent jurisdiction by the party to whom the costs were awarded as if they were debts due to such party.

Security for costs

26. (1) The Registrar may require any person who gives a notice of opposition under section 14, or an applicant who gives a reply to the notice of opposition under section 15, who does not reside or carry on business in Malaysia to give security for costs of the proceedings before the Registrar relating to the opposition or application.

(2) The Registrar may treat the opposition or application as abandoned if the security for costs as required under subsection (1) is not paid.

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(3) The security for costs shall be refundable or be considered as part of the payment of the costs of the proceedings, as the case may be.

PART VI

SPECIAL PROVISIONS

Extent of application

27. (1) This Act shall apply to a protectable geographical indication in existence before the commencement of this Act as it applies to a protectable geographical indication in existence after the commencement of this Act.

(2) In respect of a geographical indication in existence before the commencement of this Act, no suit or proceedings shall be brought under this Act for anything done before the commencement of this Act.

Exception for prior use

28. (1) Nothing in this Act shall prevent continued and similar use in Malaysia of a particular geographical indication of another country identifying wines or spirits in connection with goods or services by any nationals or domiciliaries of Malaysia who have used that geographical indication in a continuous manner with regard to the same or related goods or services in Malaysia either

(a) for at least ten years before 15 April 1994; or

(b) in good faith before 15 April 1994.

(2) Where a trade mark has been applied for or registered in good faith, or where rights to a trade mark have been acquired through use in good faith either

(a) before the commencement of this Act; or

(b) before the geographical indication is protected in its country of origin,

this Act shall not prejudice the registrability or the validity of the registration of the trade mark, or the right to use the trade mark, on the basis that such a trade mark is identical with or similar to a geographical indication.

(3) Nothing in this Act shall apply in respect of a geographical indication of any country with respect to goods or services for which the relevant indication is identical with the term customary in common language as the common name for such goods or services in Malaysia or in respect of a geographical indication of any other country with respect to products of the vine for which the relevant indication is identical with the customary name of a grape variety existing in Malaysia as of 1 January 1995.

Exception for use of personal name

29. This Act shall not prejudice the right of any person to use, in the course of trade, that person's name or the name of that person's predecessor in business, except where such name is used in such a manner as to mislead the public.

PART VII

MISCELLANEOUS

Procedure of appeal

30. The same rules of procedure which apply to appeals to the High Court from a decision of a subordinate court in civil matters shall apply to appeals against a decision of the Registrar under subsections. 16(6) and 22(6).

Decision of Court to be final

31. In any appeal against the decision of the Registrar under subsections 16(6) and 22(6), the decision of the Court shall be final and not be subject to any further appeal.

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Regulations

32. (1) Subject to the provisions of this Act, the Minister may make regulations for the purpose of carrying into effect the provisions of this Act.

(2) In particular and without prejudice to the generality of subsection (1), regulations made under this section may provide for all or any of the following:

- (a) to regulate the procedure to be followed in connection with any proceedings or other matters before the Registrar or the Central Geographical Indications Office under this Act including the service of documents;
- (b) to prescribe the fees to be paid in connection with any proceedings or other matters or in connection with the provision of any service by the Registrar or the Central Geographical Indications office, and to prescribe the amount of such fees and to allow different fees in certain circumstances for certain prescribed cases;
- (c) to prescribe forms and other matters to be used under this Act;
- (d) to regulate the keeping of the Register and to prescribe its form and contents; and to prescribe the conditions and fees for making any extracts of the Register;
- (e) to regulate the mode of giving evidence in any proceedings before the Registrar under this Act and to empower the Registrar to compel the attendance of witnesses and the discovery and production of documents;
- (f) for doing anything required to be done in connection with any proceedings or other matters before the Registrar or the Central Geographical Indications Office;
- (g) to prescribe time limits; and
- (h) to regulate generally matters pertaining to the business of the registration of geographical indications carried on in the Central Geographical Indications Office whether or not specially prescribed under this Act.

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SCHEDULE

[Paragraph 5(1)(b)]

PROVISIONS OF THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL
PROPERTY (1967)

Article 10bis

[Unfair Competition]

(1) The countries of the Union are bound to assure to nationals of such countries effective protection against unfair competition.

(2) Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition.

(3) The following in particular shall be prohibited:

1. all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor;
2. false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor;
3. indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.