

THE GEOGRAPHICAL INDICATIONS ACT 2014 – AN OVERVIEW

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Introduction

1. In April 2014, the Singapore Parliament passed the Geographical Indications Act 2014 (the “**2014 Act**”) as part of Singapore’s commitments under the European Union-Singapore Free Trade Agreement (“**EUSFTA**”). With the ratification of the EUSFTA in early 2019, certain portions of the Act have finally come into force, replacing the Geographical Indications Act (Cap 117B) (the “**Former Act**”).
2. This Client Note provides an overview of the previous geographical indications (“**GIs**”) regime, before highlighting the main features of the 2014 Act, and how it may impact businesses in Singapore.

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An overview of GIs and the Scope of the Former Act

3. A GI is an indication used in trade to identify a product as originating from a particular territory which gives the product its special quality or reputation. To qualify as a GI, the qualities of the product must be essentially attributable to the place of origin.
4. For example, the word “Roquefort” is a well-known GI for cheese originating from a southern part of France named Roquefort-sur-Soulzon. It is said that Roquefort cheese obtains its unique features and taste as it is made from the milk of native sheep, and aged in the Cambalou caves of the Roquefort-sur-Soulzon region. Therefore, cheese produced elsewhere is not allowed to bear the name Roquefort.
5. Under the Former Act, there was no requirement for GIs to be registered in order to enjoy statutory protection. Instead, all GI goods automatically enjoyed a basic level of protection against misleading usage. Wines and spirits were, however, accorded more protection – in that the related GI could not be used on products which did not come from the indicated place of origin, whether or not such use was misleading. Notably, the Former Act was also silent on border enforcement measures.

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Main Features of the 2014 Act

6. The 2014 Act introduced the following salient changes into the GI regime in Singapore:
 - a. Establishing a register of GIs (the “**GI Registry**”);
 - b. Enhanced protection of registered GIs in Singapore; and
 - c. Improved border enforcement measures for registered GIs.

7. With the introduction of a GI Registry, GIs are now registrable. However, registration is not compulsory. Unregistered GIs will nonetheless continue to enjoy the existing TRIPS level of protection under the 2014 Act. Registered GIs, however, stand to benefit from the plethora of features introduced by the 2014 Act, We elaborate below.

An Overview of the Registration Process

8. To qualify for registration as a GI, the application must first satisfy the following definition provided under s 2 of the 2014 Act:
“Geographical Indication” means any indication used in trade to identify goods as originating from a place, provided that –
 - a. *The place is a qualifying country or a region or locality in a qualifying country; and*
 - b. *A given quality, reputation, or other characteristic of the goods is essentially attributable to that place.*

9. “Qualifying country” is defined as any country or territory which is a member of the WTO, a party to the Paris Convention, or such other country as may designated by the Minister.

10. Similar to the registration process under the Trade Marks Act (“**TMA**”), registration under the 2014 Act is a three-stage process: (a) the application stage; (b) the examination stage; and (c) the publication/pre-grant opposition stage.

11. In relation to the opposition stage, the concepts of absolute and relative grounds for refusal have been adapted from the TMA into the 2014 Act. For example, an application for GI registration will be refused if:
 - a. The GI in question is “*contrary to public policy or morality*”, or “*identical to the common name*” of goods for which registration is sought; or
 - b. There is a “*likelihood of confusion*” on the part of the public because the geographical indication is identical with or similar to an earlier geographical indication.

12. The 2014 Act also acknowledges the keen relationship between the GI and trade mark regime in Singapore. For this reason, an application for GI registration will be refused where a GI is identical with or similar to a well-known trade mark, and registration of the GI is liable to mislead consumers as to the true identity of the goods in question. Similarly, registration of a GI similar to or identical with a trade mark will also be refused if there exists a likelihood of confusion on the public.
13. What is noteworthy is that at the time of writing, GI registration may be sought only in respect of the following categories of goods set out in the Schedule of the 2014 Act:
 - a. Wines, spirits and beers;
 - b. Cheese;
 - c. Seafood, meat and meat products;
 - d. Edible and non-edible oils;
 - e. Fruits, vegetables, spices and condiments;
 - f. Confectionary and baked goods;
 - g. Flowers and part of flowers; and
 - h. Natural gum.

Enhanced level of protection of registered GIs in Singapore

14. All registered GIs will receive the enhanced level of protection previously reserved for only wines and spirits under the Former Act. This means that under the 2014 Act, a registered GI will be protected against unauthorised use on products which do not originate from the indicated place of origin – regardless of whether such use is misleading. Wines and spirits will continue to enjoy this level of protection under the 2014 Act.

Border enforcement and other remedies

15. Consistent with Singapore's robust approach towards infringing goods, Part VI of the 2014 Act arms the proprietors of registered GIs with enhanced border enforcement measures absent in the Former Act. These measures include the detention and inspection of goods suspected to infringe GIs.
16. Notably, the 2014 Act also provides registered proprietors with civil remedies. For example, they may petition the Court to order the delivery up of certain goods, materials and articles to the claimant, or to order the disposal of the same.
17. However, it should be noted that Part VI of the Act is not yet in force. Until these provisions are brought into force, it remains to be seen how exactly these measures will be implemented.

CLIENT NOTE



Term of protection

18. A registered GI receives a 10-year term of protection, which may subsequently be extended for further periods of 10 years each. Non-renewal at the end of each 10-year period will result in its removal from the register.

How this may impact your business

19. In sum, proprietors of GI rights stand to benefit from the enhanced certainty and protection under the new system of GI registration.
20. However, as non-agricultural and non-foodstuff GIs are precluded from registration at the time of writing, holders of these GIs should accordingly take note. However, it bears mentioning that this list of goods in respect of which GIs can be registered may be expanded in time to come.
21. Please do not hesitate to contact us if you have any queries concerning this Client Note.

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