

ACT 659
GEOGRAPHICAL INDICATIONS ACT, 2003

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ACT 659
GEOGRAPHICAL INDICATIONS ACT, 20031(1)

AN ACT to provide for the protection of geographical indications and to provide for related matters.

Protection of Geographical Indications

1. Civil proceedings

(1) An interested person may institute proceedings in the High Court to prevent, in respect of a geographical indication,

- (a) the use of the means in the designation or presentation of goods which indicates or suggests that the goods in question originate in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the goods;
- (b) the use which constitutes an act of unfair competition within the meaning of the Protection Against Unfair Competition Act, 2000 (Act 589); or
- (c) the use of the geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as “kind”, “style”, “imitation” or the like.

(2) In proceedings under subsection (1) the Court may, in addition to issuing an injunction, award damages and grant any other remedy or relief.

2. Availability of protection regardless of registration and presumption

(1) Protection under this Act is available

- (a) regardless of whether a geographical indication is registered, and
- (b) against a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory.

(2) Registration of a geographical indication under sections 6 to 17 raises a presumption that the indication is a geographical indication within the meaning of section 22.

3. Homonymous geographical indications for wines

(1) In the case of homonymous geographical indications for wines or any other products, protection shall be accorded to each indication, subject to section 2 (1) (b).

(2) The Registrar shall in cases of permitted concurrent use of indications under subsection (1), determine the practical conditions under which the homonymous indications in question will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled.

4. Exclusion from protection

The following shall not be protected as geographical indications:

- (a) indications which do not correspond to the definition in section 22,
- (b) indications which are contrary to public order or morality, and
- (c) indications which are not or cease to be protected in their country of origin, or which have fallen into disuse in that country.

5. Offences

(1) A person who knowingly

- (a) uses any means in the designation or presentation of goods that indicates or suggests that the goods in question originate in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the goods,
- (b) does anything which constitutes an act of unfair competition within the meaning of the Protection Against Unfair Competition Act, 2000 (Act 589), or
- (c) uses a geographical indication which identifies wines for wines not originating in the place indicated by the geographical indication in question or identifies spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as “kind”, “style”, “imitation” or the like,

commits an offence and is liable on summary conviction to a fine not exceeding two thousand penalty units or to a term of imprisonment not exceeding two years or to both the fine and the imprisonment.

(2) Where a person is convicted of an offence under this section, the goods and things of any kind by means of or in relation to the offence is committed are liable at the discretion of the Court, to be forfeited to the Republic.

Registration of Geographical Indications

6. Application for registration

(1) An application for the registration of a geographical indication shall be filed with the Registrar.

(2) An application may be filed by

- (a) a person or group of persons carrying on an activity as a producer in a geographical area specified in the application, with respect to the goods specified in the application,
- (b) a group of consumers, or
- (c) a competent authority.

(3) Where an applicant’s ordinary residence or principal place of business is outside the country, the applicant shall be represented by a legal practitioner resident and practising in this country.

7. Contents of application

(1) An application for the registration of a geographical indication shall specify

- (a) the name, address and nationality of the 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 areas to which the geographical indication applies,
 - (d) the goods to which the geographical indication applies, and
 - (e) the quality, reputation or other characteristic of the goods for which the geographical indication is used.
- (2) The application is subject to the payment of the prescribed fee.

8. Examination of application

(1) The Registrar shall examine the application to ascertain whether it complies with the requirements of sections 4, 6 and 7.

(2) The Registrar shall, on being satisfied that the application fulfils the requirements of this Act, publish the application in the prescribed manner.

9. Opposition to registration

(1) An interested person or competent authority may within the prescribed period and in the prescribed manner give notice to the Registrar of an opposition to the registration of a geographical indication on the ground that one or more of the requirements of sections 4, 6 and 7 are not fulfilled.

(2) The Registrar shall send a copy of the notice to the applicant within the prescribed period and in the prescribed manner.

(3) The applicant shall within the prescribed period and in the prescribed manner, send to the Registrar a counter-statement of the grounds on which the applicant relies for the application.

(4) Where the applicant fails to send a counter-statement under subsection (3), the applicant shall be deemed to have abandoned the application.

(5) If the applicant sends a counter-statement, the Registrar shall on receipt of the counter-statement send a copy of the counter-statement to the person giving the notice of opposition within the prescribed period.

(6) The Registrar, after hearing the parties, if either or both wish to be heard and considering the merits of the case, shall decide whether the geographical indication should be registered.

10. Registration

(1) Where the Registrar finds that the conditions referred to in section 8 (1) are fulfilled and the registration of the geographical indication

- (a) has not been opposed within the prescribed time limit, or
- (b) has been opposed and the opposition has been decided in the applicant's favour and no appeal has been filed within the prescribed time,

the Registrar shall register the geographical indication, publish a reference to the registration in the *Gazette* and issue to the applicant a certificate of registration.

(2) Where the Registrar is satisfied that the geographical indication is not registrable the Registrar shall refuse the application.

11. Right of use

Only producers carrying on the activity in the geographical area specified in the register provided for under section 13 shall have the right to use a registered geographical indication in the course of trade, with respect to products specified in the register, provided that the products possess the quality, reputation or other characteristic specified in the register.

12. Cancellation and rectification of registration

(1) An interested person or competent authority may apply to the High Court for

- (a) the cancellation of the registration of a geographical indication on the ground that it does not qualify for protection under section 4, or
- (b) the rectification of the registration of a geographical indication on the ground that
 - (i) the geographical area specified in the registration does not correspond to the geographical indication, or
 - (ii) the indication of the products for which the geographical indication is used or the indication of the quality, reputation or other characteristic of the product is missing or unsatisfactory.

(2) In proceedings under this section, notice of the request for cancellation or rectification

- (a) shall be served on the person who filed the application for registration of the geographical indication or that person's successor in title, and
- (b) shall, by a publication in the prescribed manner, be given to all persons who have the right to use the geographical indication under section 11.

(3) The persons referred to in subsection (2) and any other interested person may, within a period which shall be specified by the Court in the notice and publication, apply to be joined in the proceedings.

(4) The registrar of the Court shall notify the Registrar of the decision of the Court or the decision on an appeal from the suit and the Registrar shall record it and publish a reference to the decision in the *Gazette*.

13. Register and publication

(1) The Registrar shall maintain a register in which the Registrar shall record the matters required by this Act to be recorded.

(2) A person may consult or obtain extracts from the register under conditions prescribed by the Regulations.

(3) The Registrar shall publish in the prescribed manner the publications required to be made under this Act.

14. Correction of errors

The Registrar may, subject to the Regulations, correct an error of translation or transcription, clerical error or mistake in an application or a document filed with the Registrar or in a recording pursuant to this Act or the Regulations.

15. Extension of time

(1) The Registrar may on being satisfied that the circumstances justify it, on receiving a written request, extend the time for doing an act or taking a proceeding under this Act after the Registrar has notified the parties concerned and on the terms directed by the Registrar.

(2) The Registrar may grant an extension of time under subsection (1) although the time for doing the act or taking the proceeding has expired.

16. Exercise of discretionary powers

The Registrar shall, in exercising a discretionary power conferred by this Act, comply with article 296 of the Constitution.

17. Appeals

An interested person may appeal to the High Court against a decision taken by the Registrar under this Act, in particular, the registration of a geographical indication.

Special Provisions concerning Marks

18. Misleading marks

The Registrar shall, on the Registrar's own motion or at the request of an interested party, refuse or cancel the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if the use of the indication in the trademarks for the goods in the country is of a nature that misleads or is likely to mislead the public as to the true place of origin.

19. Marks conflicting with a geographical indication for wines and spirits

The registration of a trademark for

- (a) wines which contain or consist of a geographical indication identifying wines, or
- (b) spirits which contain or consist of a geographical indication identifying spirits,

shall be refused or cancelled by the Registrar on the Registrar's own motion or at the request of an interested party, where the wines or spirits do not have the origin claimed.

20. Exceptions

(1) A provision of this Act does not prevent the continued and similar use in this country of a particular geographical indication of another country identifying wines or spirits in connection with goods or services by a national or domiciliary of this country who used that geographical indication in a continuous manner with regard to the same or related goods or services in any part of this country

- (a) for at least ten years preceding April 15, 1994, or
- (b) in good faith preceding that date.

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

- (a) before the date of entry into force of this Act, or
- (b) before the geographical indication is protected in its country of origin,

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

(3) A provision of this Act shall not apply in respect of a geographical indication of a country with respect to goods or services for which the relevant indication is identical with the terms customary in common language as the common name for the goods or services in the country 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 the country as of January 1, 1995.

(4) A request for relief made under this Act in connection with the use or registration of a trademark shall

- (a) be presented within five years after the adverse use of the protected indication has become generally known in the country, or
- (b) after the date of registration of the trademark in the country provided
 - (i) the trademark has been published by that date, if such date is earlier than the date on which the adverse use became generally known in the country, and
 - (ii) the geographical indication is not used or registered in bad faith.

(5) This Act does not prejudice the right of a person to use in the course of trade, that person's name or the name of that person's predecessor in business, except where the name is used in a manner that misleads or is likely to mislead the public.

Regulations and Interpretation

21. Regulations

The Minister may by legislative instrument make Regulations prescribing

- (a) the fees payable under this Act in respect of applications and other matters;
- (b) the details of the requirements and procedures on the filing and examination of applications;
- (c) the details in relation to the consultation of the register;
- (d) the procedure for extracting copies of documents from the register;
- (e) the period and manner of notice of opposition; and
- (f) any other matter required to be prescribed under this Act.

22. Interpretation

In this Act, unless the context otherwise requires,

“geographical indication” means an indication which identifies a good as originating in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to its geographical origin;

“goods” includes a natural or agricultural product or a product of handicraft or industry and Kente;

“Minister” means the Minister responsible for Justice;

“Paris Convention” means the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised;

“producer” means

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

(b) a manufacturer of products of handicraft, or industry; and

(c) a trader dealing in the products of handicraft or industry;

“register” means the Register of Geographical Indications;

“Registrar” means the Registrar-General; and

“Regulations” means the relevant Regulations made under this Act.

Endnotes

1 (Popup - Footnote)

1. This Act was assented to on 31st December, 2003 and notified in the *Gazette* on 31st December, 2003.