

THE GEOGRAPHICAL INDICATIONS BILL
(No. .XIV of 2002)

Explanatory Memorandum

1. The object of this Bill is to give effect to the obligations undertaken by Mauritius under the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) in the context of the World Trade Organisation (WTO).

2. The Bill provides for -
 - (a) a definition of the concept of geographical indications and the principles regulating registration, opposition procedure, and the criteria thereof;
 - (b) a system of protection of geographical indications in the context of the obligations undertaken by Mauritius under the TRIPS Agreement;
 - (c) the concurrent use of homonymous indications for wine and spirits;
 - (d) the regulation of enforcement and infringement of such provisions; and
 - (e) the imposition of criminal sanctions in cases of infringement.

.....May 2002

J. K. Cuttaree
Minister of Industry & International Trade

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A BILL

To provide for the protection of geographical indications and related matters

ENACTED by the Parliament of Mauritius, as follows -

PART I - PRELIMINARY

1. Short title

This Act may be cited as the Geographical Indications Act 2002.

2. Interpretation

In this Act -

"Controller" means the Controller of the Industrial Property appointed under section 3 of the Patents, Industrial Designs and Trademarks Act 2002;

"geographical indication" means an indication which identifies a product 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 product is essentially attributable to its geographical origin;

"legal practitioner" has the same meaning as in the Law Practitioners Act;

"Minister" means the Minister to whom the responsibility for the subject of international trade is assigned;

"Paris Convention" means the Paris Convention for the Protection of Industrial Property of 1883;

"producer" means -

- (a) any producer of agricultural products or any other person exploiting natural products;
- (b) any manufacturer of products of handicraft or industry;

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

"Register" means the Register of Geographical Indications;

"Tribunal" means the Tribunal set up under section 9 of the Patents, Industrial Design and Trademarks Act 2002.

PART II - PROTECTION OF GEOGRAPHICAL INDICATIONS

3. Unfair practice

(1) The use of -

- (a) any means in the designation or presentation of a product that indicates or suggests that the product in question originates 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 product;
- (b) a geographical indication -
 - (i) identifying wines for wines, or any such product as may be prescribed, not originating in the place indicated by the geographical indication in question; or
 - (ii) identifying spirits for spirits, or any such product as may be prescribed, not originating in the place indicated by the geographical indication in question;

even where the true origin of the products is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like, shall be unlawful.

(2) Any act referred to in subsection (1) shall amount to an act of unfair practice and may give rise to a claim in damages.

(3) Any proceeding under subsection (2) shall be initiated in accordance with the Protection Against Unfair Practices (Industrial Property Rights) Act 2002.

(4) Any person may institute court proceedings to prevent the use as described in subsection (1) and the court may, in addition to issuing an injunction, award damages and grant any other remedy or relief as it may deem fit.

4. Availability of protection

(1) The protection afforded under this Act shall be available in respect of a geographical indication-

- (a) irrespective of whether it has been registered; or
- (b) which, although literally true as to the territory, region or locality in which the products originate, falsely represents to the public that the products originate in another territory.

(2) The registration of any geographical indication under Part III of this Act shall, in any proceedings under this Act, raise a presumption that such indication is a geographical indication within the meaning of section 2 of this Act.

5. Homonymous geographical indications for wines

(1) In the case of homonymous geographical indications for wines, protection shall, subject to section 4 (1) (b), be granted to each indication.

(2) The Controller shall, in cases of permitted concurrent use of such indications, 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.

6. Exclusion from protection

Any -

- (a) indication which does not correspond to the definition in section 2 of this Act;
- (b) indication which is contrary to public order or morality; or
- (c) geographical indication which is not or ceases to be protected in their country of origin, or which has fallen into disuse in that country,

shall not be protected.

7. Offences

Any person who, knowingly and with intent to deceive, performs any of the acts referred to in section 3, shall commit an offence and shall, on conviction, be liable to a fine of not more than Rs 250,000 and to imprisonment for a term of not more than 5 years.

PART III - REGISTRATION OF GEOGRAPHICAL INDICATIONS

8. Application for registration

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

(2) Any person carrying on an activity as a producer in the geographical area specified in the application, with respect to the product specified in the application, shall have the right to file an application for registration.

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

9. Contents of application

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

- (a) the name, address and nationality of the person 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 products for which the geographical indication applies; and
- (e) the quality, reputation or other characteristic of the products for which the geographical indication is used.

(2) The application shall be subject to the payment of a prescribed fee.

10. Registration

(1) The Controller shall examine the application to ascertain whether it complies with the requirements of sections 8 and 9 and any prescribed regulations.

(2) Where the Controller finds that the conditions referred to in sections 8 and 9 have been fulfilled, he shall cause the application to be published in the prescribed manner.

(3) Any interested person may, within the prescribed period and in the prescribed manner, give notice to the Controller of opposition to the registration of the geographical indication on the grounds that one or more of the requirements of sections 6, 8 and 9 have not been fulfilled.

(4) The Controller shall send a copy of such notice of opposition to the applicant and, within the prescribed period and in the prescribed manner, the applicant shall send to the Controller and the opponent, a counter-statement of the grounds on which he relies for his application.

(5) Where, after a period of 1 month, the applicant does not send his counter-statement, his application shall lapse.

(6) Where the applicant sends a counter-statement, the Controller shall, after hearing the parties, decide whether the geographical indication shall be registered.

(7) Where the Controller finds that the conditions referred to in subsection (1) have been fulfilled, and either-

- (a) the registration of the geographical indication has not been opposed within the prescribed time limit; or
- (b) the registration of the geographical indication has been opposed and the opposition has been decided in the applicant's favour,

he shall -

- (i) register the geographical indication;
- (ii) publish a reference to the registration; and
- (iii) issue a certificate of registration to the applicant.

11. Right of use

No person, other than a producer carrying on an activity in the geographical area specified in the Register, shall have the right to use a registered geographical indication in the course of trade with respect to the products specified in the Register, and which possess the quality, reputation or other characteristics specified in the Register.

12. Cancellation and rectification of registration

(1) Any interested person may, subject to section 6, apply to the Tribunal for -

- (a) the cancellation of the registration of a geographical indication on the ground that it does not qualify for protection;
- (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) 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) In any proceedings under this section, notice of the request for cancellation or rectification shall be -

- (a) served on the person who filed the application for registration of the geographical indication or his successor in title; and
- (b) given to all persons having the right to use the geographical indication under section 11,

in such manner as may be prescribed.

(3) Any person referred to in subsection (2) or any other person having an interest in the matter may, within a period which shall be specified by the Tribunal in the said notice and publication, apply to join in the proceedings.

(4) The Registrar of the Tribunal shall notify the Controller of the decision of the Tribunal or the decision on any appeal therefrom and the Controller shall record and publish a reference thereto as soon as possible.

13. Register

(1) The Controller shall maintain a Register in which he shall record all matters required by this Act to be recorded.

(2) The Register may be consulted by any person, and any person may obtain extracts therefrom, on payment of the prescribed fee.

(3) Any publication provided for under this Act shall be published by the Controller in the prescribed manner.

14. Correction of errors

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

15. Extension of Time

(1) Where the Controller is satisfied that the circumstances so justify, he may, upon receiving a written request, extend the time for doing any act or taking any proceeding under this Act and thereafter serve notice to any party concerned and upon such terms as he may determine.

(2) Notwithstanding that the time for doing the act or taking the proceeding has expired, the Controller, may, on good cause shown, grant an extension of time.

16. Exercise of discretionary powers

The Controller shall, before exercising any discretionary power vested in him by this Act, which adversely affects any party to a proceeding before him, afford that party an opportunity to be heard.

17. Competence of Tribunal

(1) The Tribunal shall have jurisdiction in cases of dispute relating to the interpretation of this Act and in matters which, under the Patents, Industrial Designs and Trademarks Act 2002, are referred to it.

(2) Any decision taken by the Controller under this Act, in particular the registration of a geographical indication, may be the subject of an appeal by any interested party to the Tribunal.

PART IV - SPECIAL PROVISIONS CONCERNING MARKS, EXCEPTIONS

18. Misleading marks

Notwithstanding any other enactment, the Controller shall, on his own motion or at the request of an interested party, refuse, or invalidate, the registration of a trademark which contains or consists of a geographical indication with respect to products not originating in the territory indicated, where the use of the indication in the trademark for such products in Mauritius is of such a nature as 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 wines which contains or consists of a geographical indication identifying wines or of a trademark for spirits which contains or consists of a geographical indication identifying spirits shall be refused or invalidated by the Controller on his own motion or at the request of an interested party with respect to such wines or spirits not having this origin.

20. Exceptions regarding prior use

(1) Nothing in this Act shall prevent the continued and similar use of a particular geographical indication of another country identifying wines or spirits in connection with products or services, by any national or resident of Mauritius who has used that geographical indication in a continuous manner with regard to the same or related products or services in the territory of Mauritius either -

- (a) for at least 10 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 either -

- (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 a trademark, or the right to use a trademark, on the basis that such a trademark 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 products or services for which the relevant indication is identical with the term customary in common language, as the common name for such products or services in Mauritius 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 Mauritius as at 1 January, 1995.

(4) Any request for relief made under Part II of this Act in connection with the use or registration of a trademark must be presented within 5 years after the adverse use of the protected indication has become generally known in Mauritius or after the date of registration of the trademark in Mauritius, provided that 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 Mauritius and provided that the geographical indication is not used or registered in bad faith.

(5) This Act shall in no way 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 V - REGULATIONS

21. Regulations

The Minister may make regulations prescribing any matter that are required or permitted to give effect to this Act.

PART VI - COMMENCEMENT

22. Commencement

This Act shall come into force on a date to be fixed by Proclamation.