

Important information for Applicants for Class 33 Trade Mark Registrations (which include wines)

THE AUSTRALIAN WINE AND BRANDY CORPORATION IS A STATUTORY AUTHORITY OF THE COMMONWEALTH OF AUSTRALIA, ESTABLISHED UNDER THE AUSTRALIAN WINE AND BRANDY CORPORATION ACT 1980.

The Australian Wine and Brandy Corporation (AWBC) has wide ranging powers and functions related to the promotion of Australian wine in both domestic and export markets and the regulation of the Australian wine industry. These functions include:

- the issue of export licences and permits for export shipments of Australian wines;
- a comprehensive Label Integrity Program to ensure truth-in-labelling of Australian wine; and
- extensive “trade-practices” like powers over the false or misleading description of wines imported, exported or sold on the Australian market.

The AWBC is also responsible for administering any Australian wine law established as a result of international wine trade agreements.

The EU/ Australia Wine Agreement

The current EU/Australia Wine Agreement was signed by the Australian Government,

acting on behalf of the Australian wine sector, in 1994. Australia and the member States of the European Union (the EU) agreed, on the basis of non-discrimination and reciprocity, to facilitate and promote trade in wine. It was agreed to mutually protect all registered wine names (geographical indications, traditional expressions, ancillary protected expressions) including some names that may have been, or are likely to be included in a trade mark. The agreement, and the legislation that was subsequently introduced in Australia, have major implications on the registration of trade marks in Class 33, when the goods to be covered include wines.

The EU/Australia Wine Agreement has been renegotiated, and although the Agreement has been initialled, the terms are not yet public. It is expected that the new agreement will be implemented in late 2008.

The Australian Wine and Brandy Corporation Act 1980

The Australian Wine and Brandy Corporation Act 1980 (the AWBC Act) and the Australian Wine and Brandy Corporation

Regulations 1981 (the AWBC Regulations) were amended to implement the EU/Australia Wine Agreement. The AWBC Regulations identify certain wine names and establish their conditions of use. Trade mark applicants should study the AWBC Act, and the AWBC Regulations, prior to lodging an application for registration of a trade mark in Class 33 which is to be used on wines.

This pamphlet summarises some of the relevant provisions of this legislation. However, before choosing and applying for a trade mark, or designing a label under which a wine will be imported, exported or sold on the Australian market, applicants should make themselves aware of all the conditions included in the AWBC Act and the AWBC Regulations.

Powers to Declare Conditions of Use in Relation to Registered Geographical Indications or Other Wine Names

The AWBC Act empowers the AWBC to determine conditions of use for registered geographical indications and other identified wine names. These conditions of use are recorded in the Register of Protected Names and may affect Class 33 trade mark applications. The conditions will apply to any trade mark applied for in respect of wines, if the mark includes the particular geographical indication or other identified wine name.

False or Misleading Description or Presentation of Wine

Substantial penalties of up to two years jail and/or a \$66,000 fine may be incurred for false or misleading description or presentation of wine. This may involve improper use of a registered geographical indication or other wine name appearing on the Register of Protected Names.

The Geographical Indications Committee

The Geographical Indications Committee (GIC) of the Australian Wine and Brandy Corporation was created in January 1994. It determines the names and boundaries of Australia's geographical indications. Criteria for making these determinations are set out in AWBC Regulations.

As part of the determination of geographical indications, the application is advertised to allow other persons to object on the basis of prior trade marks rights. If the grounds are made out, the GIC cannot determine the geographical indication without the consent of the trade mark owner.

Following the publication of a Final Determination of the GIC, names are entered into the Register of Protected Names and protected from that date, in Australia and internationally.

Register of Protected Names

The Australian Register of Protected Names was created in 1993 as part of the amendments to the AWBC Act. It enables Australia to protect certain wine related names and expressions including those contained in the EU/Australia Wine Agreement and any other prescribed trading agreements that may be entered into in the future.

The Register is made up of eight parts:
(a) geographical indications in relation to wines manufactured in Australia and the conditions (if any) applicable to those indications;

(b) traditional expressions in relation to wines manufactured in Australia and the conditions (if any) applicable to those expressions;

(c) geographical indications in relation to wines manufactured in an agreement country and the conditions (if any) applicable to those indications;

(d) traditional expressions in relation to wines manufactured in an agreement country and the conditions (if any) applicable to those expressions;

(e) words or expressions, other than geographical expressions or traditional expressions in relation to wines manufactured in an agreement country and the conditions (if any) applicable to those words or expressions (these are known as ancillary protected expressions);

(f) the names of varieties of grapes for use in the manufacture of wines in Australia and the conditions (if any) applicable to the description of wines manufactured in Australia from grapes of those varieties;

(g) geographical indications in relation to wines manufactured in foreign countries that are not agreement countries and the conditions (if any) applicable to those indications; and

(h) traditional expressions in relation to wines manufactured in foreign countries that are not agreement countries and the conditions (if any) applicable to those traditional expressions.

The Register of Protected Names is located at the offices of the AWBC:

Industry House
Cnr Hackney and Botanic Roads
Adelaide South Australia 5000.

The Register is available for inspection during business hours, and is also available on the internet at the Wine Australia website

www.wineaustralia.com.

Further information can be obtained by writing to the Registrar of Protected Names. Postal, fax, phone and email details are available at www.wineaustralia.com.

Advice for Applicants for Registration of Class 33 Trade Marks

It is an offence to use either the name of a country or a registered protected name in a false or misleading way on wine labels. Before filing an application for registration of a trade mark in Class 33 which includes wines in the specification of goods, applicants should ascertain whether any name included in the representation of the trade mark is a registered protected name. A geographical name on its own is generally not registrable under the Trade Marks Act. If it appears as part of a registrable trade mark, a condition of use may be required to ensure the appearance of the name in the mark will not be misleading as to the product's geographical origin.

Some geographical names are already or likely to become registered protected names and subject to further conditions of use. Before filing, applicants should check whether the mark applied for contains or consists of a:

- geographical name - which may be refused or made subject to conditions of use;
- registered geographical indication - a name already determined for use by Australia and entered in the Register of Protected Names;
- registered geographical indication in respect of the Member States of the European Union or any other countries with whom an agreement on trade in wine

has been negotiated;

- name considered likely to be the subject of a future determination by the Geographical Indications Committee of the Australian Wine and Brandy Corporation and subsequently entered into the Register of Protected Names;
- registered traditional expression or registered ancillary protected expression for use by Australia appearing in the Register of Protected Names;
- registered traditional expression or registered ancillary protected expression for use by the Member States of the European Union or any other countries with whom an agreement on trade in wine has been negotiated;
- name that could be considered a translation of a registered geographical indication, a registered traditional expression or a registered ancillary protected expression appearing in the Register of Protected Names; and
- word or expression that so resembles a registered geographical indication, a registered traditional expression or a registered ancillary protected expression appearing in the Register of Protected Names that it is likely to be mistaken for the registered geographical indication, registered traditional expression or registered ancillary protected expression.

may assist the progress of an application if just those words, rather than the whole wine label, are lodged as the representation of the trade mark.

Registration of a trade mark can be complex and anyone applying for a trade mark specifying wines in Class 33 should seek professional help from a registered patent or trade mark attorney or a solicitor experienced in trade mark matters.

NOTE: *Staff of the Australian Wine and Brandy Corporation and of IP Australia are able to give information on matters of a formal nature only. They are not authorised to give advice on matters of a legal nature such as the registrability of marks (other than through examiner reports), validity of registration, or Infringement. This type of advice should be sought from a registered patent attorney or trade mark agent or a solicitor experienced in trade mark matters.*

Where the name or address of a winery is included in the representation of a trade mark applied for in respect of wines, the name or address should not be used in a way likely to mislead as to the country, region or locality in which the wine originated. Where the trade mark itself consists of words which are registrable, it