Recent developments in Australia in the field of Geographical Indications
Key points

Background on Australian system of GI protection

Australian normative framework

Australian experience with GI protection in Australia

Data-driven economic study
Australian system of protection

Two types of registration

- Certification marks
- *Sui generis* system protecting wine and grape products

Other means

- Common law tort of passing off
- Consumer protection laws
Objections, generics and composite terms

Transparency in Publishing
- Understanding application, registration and objection processes
- Interested parties are given notice and have standing

Due Process
- Process for objection
- No automatic protection

Safeguard Public Domain and prior TM rights
- Generic terms should not be protected
- Prior trade mark rights
Generic Terms

Registration helps:
- Protect against misuse
- Prevent a term from falling into the common language
- Traders to know where they have freedom to act

Protection of generic terms fundamentally inconsistent with IP principles:
- Anti-competitive
- Reduction of choice

Clear and transparent objection process:
- Generic or descriptive components of composite terms should not be protected
- Composite term in full should only have protection
Prior Rights

Exclusive rights afforded by the TRIPS Agreement

Uncertainty may result in reduced business confidence

Trade mark system provides protection for prior rights and a transparent registration system

TRIPs consistent administrative systems subject domestic and foreign GIs to the same set of rules
Australian Grape and Wine Authority Act (AGWA Act)

*Sui generis* system for protection of wine GIs was introduced in 1994

Implemented the Australia-European Community Agreement on Trade in Wine (Wine Agreement)

Established the Register of Protected Geographical Indications and Other Terms

Amended many times since enactment
Register of Protected GIs & Other Terms

<table>
<thead>
<tr>
<th>Includes:</th>
<th>Examples of wine GIs on the Register:</th>
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<tbody>
<tr>
<td>Australian wine GIs</td>
<td>• Champagne</td>
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<tr>
<td>non-Australian wine GIs;</td>
<td>• Barossa Valley</td>
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<tr>
<td>and translations of non-Australian wine GIs.</td>
<td>• Rutherglen</td>
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Certification Trade Marks

Administered by IP Australia and assessed by the Australian Competition and Consumer Commission

Indicate that the goods meet standards including those of quality, composition or geographical origin

Certification mark standards can replicate the GI’s country of origin specification

Both the trade mark registration and the associated standards are open to third party objections

Currently approximately 650 registered or pending certification trade marks on the Trade Mark Register, covering a wide range of certification schemes
Examples

SCOTCH WHISKY
Certification mark no 677876 for cheese
Certification mark no 1532781 for spirits and spirit based beverages

DARJEELING
Certification mark no 888055 for wine
Certification mark no 998592 for tea

TEQUILA
Certification mark no 1377413 for Alcoholic beverages made from the agave tequilana weber blue variety

PARMA
Certification mark no 815585 for ham
Dual Protection

Some wine GIs are protected in Australia under both the AGWA and as registered certification trade marks.

Examples of dual protection:

- **RECIOTO DI SOAVE**
  - Trade Mark No. 888055

- **PRENEES**
  - Trade Mark No. 1045175
Additional Protection for GIs

**Passing off**
- Goodwill/ reputation
- Misrepresentation
- Damage (likely damage)

**Australian Consumer Law**
- Misleading or deceptive conduct (likely to mislead or deceive)
- False or misleading representations
Implementing legislation in Australia had to be amended over the years since the first Wine Agreement.

AGWA Act now provides reasonable (but limited) exceptions for use that is not likely to mislead but is:

- A common name of a type or style of wine; or
- A name of a variety of grape
- Use of common English words in a way that is not misleading

Requires publication for objections to new GIs – on grounds of prior trade mark rights; generic terms and grape varieties.
ORANGE

- Australian GI
- Colour
- Type of fruit
- County in California, USA
- Town in South East France
- French GI “Vin de pays de la Principauté d’Orange
- Styles of wine
Economic Significance and Potential Impact

Research into the economic significance of GIs and the potential impact on Australian producers

Developed by the Office of the Chief Economist at IP Australia

Two separate pieces of work:
- Data set of trade marks with geonames (GeoName Database)
- Economic impact on the Australian economy

Both projects are ongoing and continue in the OCE’s forward work agenda
Data Set of Trade Marks with Geonames

Two data sets
- Australian trade marks
- Geographical locations

Matching the data sets is complex and involved
- Number of indicators to help determine likelihood of association

Over one million trade marks (as at 2014) originating from Australia contained a geoname and collocation indicator
- Example: Light & light

End users will have control over the selection criteria

Expected publication is at the end of 2017
Economic Impact on the Australian Economy

- Uses consumer choice-based methods
- Starts with extensive market research to understand GI-related products, prices and market share across the economy
- Viable alternative names are confirmed through market investigation
- Discrete Choice Experiments conducted with over 1,000 surveys to determine consumer preferences for names
- ‘What-if scenarios’ are modelled through a decision support system to understand how preferences for names and labels impact a product’s market share
Thank you
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