



The Law Society of Singapore
39 South Bridge Road S(058673)
t: +65 6538 2500 f: + 65 6533 5700
www.lawsociety.org.sg

Sender's Fax: 6533 5700

Sender's DID: 6530 0206

Sender's Email: represent@lawsoc.org.sg

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Your Ref:

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Intellectual Property Office of Singapore
51 Bras Basah Road #04-01
Manulife Centre
Singapore 189554

**BY EMAIL (GI_Constult@
ipos.gov.sg) & POST**

Attn: Ms Lili Soh

Dear Sirs

**PUBLIC CONSULTATION ON PROPOSED AMENDMENTS TO THE
GEOGRAPHICAL INDICATIONS ACT AND TRADE MARKS ACT**

1 We refer to your email dated 1 November 2013.

2 The request for comments was referred to the Intellectual Property Practice Committee (the "Committee").

3 Please find the Committee's comments set out in Annex A for your consideration.

4 The Council of the Law Society has considered the comments provided and shares the views of the Committee.

Yours faithfully,

Michelle Woodworth Cordeiro
Director, Representation and Law Reform Department

Encl.

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ANNEX A

PUBLIC CONSULTATION ON CHANGES TO BE MADE TO THE GEOGRAPHICAL INDICATIONS ACT AND TRADE MARKS ACT TO ENHANCE SINGAPORE'S REGIME FOR THE PROTECTION OF GEOGRAPHICAL INDICATIONS

RESPONSE FROM LAW SOCIETY OF SINGAPORE

Question 1: Do you have any views / comments on the proposed establishment of a GI registry or proposed three-step process?

No comment.

Question 2: Do you have any views / comments on the proposed higher level of protection for registered GIs for agricultural products and foodstuff?

No comment.

Question 3: In relation to paragraph 3.6, do you have any views on the additional protection for registered GIs, such as considering the registration to be prima facie evidence of the validity of the GI registration in legal proceedings, and improved border enforcement measures?

As with the border enforcement measures for trade marks, we envisage difficulty in utilizing the border enforcement provisions in practice because of the amount and nature of information required to be provided to the authorities.

Question 4: In relation to paragraphs 4.1 to 4.6, do you have any views on the application process, including the kind of persons that are allowed to file for registration of a GI, and on the proposed disclaimer process?

A. Who can apply

Based on the proposed legislation, any of the following may file an application:

- a person who is carrying on an activity as a producer in the geographical area specified in the application with respect to the goods specified in the application, and includes a group or groups of such person;
- a competent authority; or
- a trade organization or association.

We understand that the criteria used by some of the other countries are as follows:

- India – persons entitled to file: association of persons or producers or any organization or authority which represents the interest of producers of the concerned goods;
- EU – application may only be made by a group of producers or processors or, in exceptional cases, natural or legal persons
- China - applicants for the registration of geographical indications of agricultural products shall be excellent professional cooperative economic organizations of farmers and industrial associations determined by the local people's government at or above the county level in accordance with the following conditions:
 - (i) having the capability for supervising and administering the geographical indications of agricultural products and the products thereof;
 - (ii) having the capability for providing guidance for the production, processing and marketing of agricultural products with geographical indications; and
 - (iii) having the capability for bearing civil liabilities independently.

We propose adopting a combination of the above and propose the following replacement for Section 33:

"The following persons shall be entitled to file an application for registration of a geographical indication:

(a) An association of producers or processors or traders of the goods specified in the application; or

(b) An organization, association or authority which represents the interest of producers, processors or traders of the goods specified in the application:

provided that it:

- (i) has the capability to supervise and administer the use of the geographical indication in respect of the goods specified in the application;*
- (ii) has the capability to provide guidance for the production, processing and marketing of the goods specified in the application; and*
- (iii) has the capability to bear civil liabilities independently or collectively."*

B. "First in time, first in right" rule

We also note from paragraph 4.9 of the Consultation Paper that the GI Registry will follow the "first in time, first in right" rule, where a new application for registration cannot override a prior right, such as a prior GI or trade mark, that is already existing. This is notwithstanding that multiple parties may fulfil the eligibility criteria for filing the GI application. The proposed legislation does not appear to require the applicant of the GI to be the same entity that is the registered proprietor of a GI in the country or territory of origin. What happens when another eligible applicant wishes to challenge the earlier application or registration based on the way the quality, reputation or characteristic of the goods are represented, which may not necessarily amount to fraud or misrepresentation? Similarly, there appears to be no grounds for challenging the applicant's right to be granted the certificate of registration based on the fact that it may not be the rightful holder of the GI in the country or territory of origin.

Alternatively, reference should be made to the proof of protection in the country of origin to determine the rightful holder of the GI registration.

C. Interested party

The draft legislation provides that any interested party (as defined in Section 2) may bring an action against a third party for certain uses of the registered GI. We are concerned that such interested parties are not sufficiently "protected" or notified when a registered GI is revoked or cancelled, or lapsed due to non-renewal. This is especially so if such interested parties' attempt to register the GI was thwarted by an earlier applicant of the same GI. Perhaps, IPOS can look into having a "register of interested parties" (akin to registration of trade mark licensees) for each registered GI, such interested parties to be notified in the event of any amendment, revocation, cancellation or lapse of the GI registration.

We also propose that the definition of "interested party" be amended to include a processor of the goods and an association of such processors, so as to be consistent with our proposed Section 33.

D. Translations

We note from paragraph 4.4 of the Consultation Paper that Singapore will protect translations of registered GIs on a case-by-case basis and applicants will not be required to specify which translations of the GI they wish to protect. We disagree with this for the following reasons:

- (i) Section 50(2)(a)(ii) as drafted prohibits the use of the registered geographical indication in another language. That is, all translations are protected and not that translations are protected on a case-by-case basis.
- (ii) Section 50(2)(a) prohibits the use of a registered GI where the goods do not originate from the place indicated by the registered GI. The prohibition is against the use of the registered GI as a whole, and does not even extend to phrases/words which may be similar to the registered GI. It would be inconsistent then to protect the translations.
- (iii) By protecting all possible translations of the registered GI, the protection for translations may be wider than protection afforded to the registered GI in the original language.
- (iv) If all possible translations are protected, there would be uncertainty as to the scope of protection of the registered GI. This uncertainty also appears to be recognized by IPOS as suggested in paragraph 4.15 of the Consultation Paper.
- (v) Although the proposed registration system allows the registrant to disclaim translations which it does not intend to protect, this is not practical since a GI can be translated into numerous languages and each translation can have numerous permutations.
- (vi) If third parties are allowed to oppose "any possible translation" of the GI in question, it could potentially result in the applicant having to deal with oppositions for various translations which it has no interest or intention in protecting.

For the reasons mentioned above, we suggest the following:

- (i) Translations of registered GIs not be protected and Section 50(2)(a)(ii) be deleted.
- (ii) If the applicant wants to protect the GI in any other language, that version of the GI should be registered as a separate GI. Such version of the GI should also have been protected and recognized in the country or territory of origin.
- (iii) It should also not be necessary for the applicant to specify that any particular term is not a translation of the GI and Section 35(2) should be deleted.
- (iv) A third party should not be allowed to oppose a GI based on a possible translation.

E. Disclaimers

We take the view that disclaimers should not be necessary. If the protection of a registered GI is limited to the GI as registered and not similar variations (based on Section 50), then there is no need for individual elements to be disclaimed. Section 35 should thus be deleted. Disclaimers of translations should also not be necessary based on our proposal set out at (B) above.

F. Prior Identical Trade Mark

Section 37(8) purports to give the Registrar the discretion to waive an objection based on a prior identical trade mark. We take the view that the Registrar should not be given such a wide discretion in allowing the registration of a geographical indication if there is an identical prior trade mark. In the trade mark regime, identical marks are only allowed where there is honest concurrent use.

Question 5: Do you have any views / comments on the proposed grounds for refusal of registration, set out in paragraphs 4.8 and 4.9?

Please see our comments at Question 4 on the absence of grounds for an interested party to challenge an applicant's representation of the quality, reputation or characteristic of the goods specified, or to challenge the applicant's right to be the registered proprietor of the GI in Singapore.

We also note that Section 45(1)(b) empowers the Registrar to revoke the acceptance of a GI registration if the Registrar is satisfied that, in the special circumstances of the case, the GI should not be registered. This appears to be outside the grounds of refusal provided in Section 37 and we are of the view that the Registrar should not be given such a wide discretion to disallow the registration of a GI.

In paragraph 4.11 of the Consultation Paper, it is stated that the Registrar may approach proprietors of prior registered trade marks to ascertain if they would consent to the registration of a GI. We disagree that the Registrar should take on such a role as the Registrar should be a neutral party and not be seen as an agent for the GI applicant. Further, the Registrar is not in a position to negotiate and should not negotiate on behalf of the GI applicant. The GI owner should be left to his own means to overcome the Registrar's objection of registration due to a citation. It is odd that the Registrar should assist the GI applicant to overcome an objection the Registrar himself raised.

Question 6: In relation to paragraph 4.10, do you have any views on the proposed treatment of homonymous GIs?

No comment.

Question 7: Do you have any views /comments on the proposed publication and opposition process, including the proposed expedited timeline?

There does not appear to be any proposed expedited timeline. Kindly clarify.

Question 8: In relation to paragraphs 4.14 to 4.17, do you have any views on the proposed disclaimer request process, or the proposed alternative which allows for the possible translation and specific elements to be opposed as well? Out of the two options, which option would you prefer and why?

We are not in favour of either option and propose that Section 42 be deleted.

In light of our comments at question 4, we take the view that there should not be a request for disclaimer process.

On the alternative of allowing oppositions in relation to any translation, please also see our comments at Question 4. We take the view that such an opposition procedure is not feasible. The GI applicant may have to spend money defending translations of its GI which it has no intention to protect. Given that the protection of GI is limited to the GI in its entirety (see section 50), we take the view that there should not be any need for a right to oppose specific elements in a GI.

Question 9: Do you have any views / comments on the duration of protection of a registered GI and associated renewal process?

No comment.

Question 10: In relation to paragraph 4.20, do you have any views on the proposed grounds for cancellation or process for cancellation?

No comment.

Question 11: Do you have any views / comments on the proposed declaration from the Courts mechanism as elaborated in paragraph 4.21?

We do not see the need for this provision. Apart from that, there is no equivalent in the Trade Marks Act.

Question 12: Do you have any views / comments on the proposed exceptions?

The reference to "that date" in Section 57(1)(b) is unclear.

We note that, unlike Section 37(4), Sections 57(2) and (3) do not refer to the existence of a "likelihood of confusion on the part of the public". We have thus concluded that Sections 57(2) and (3) were included primarily to provide protection to prior identical or similar trade mark owners which could not block the GI registration and those that were in use but not registered. Otherwise, Sections 57(2) and (3) would seem redundant since the GI should not have been registered in the face of the prior trade marks or well-known trademarks. If this understanding is wrong, some clarification from IPOS on the rationale behind the inclusion of Sections 57(2) and (3) would be appreciated.

Question 13: Do you have any views / comments on the proposed changes to the Trade Marks Act?

We note that Section 37(7) provides that a GI will be registered where the proprietor of an earlier trade mark consents to the registration. For consistency, we suggest that a similar provision be included in the Trade Marks Act in cases where the consent of a GI registration owner is obtained.

We also propose that the phrase "and irrespective of the language the geographical indication is expressed in that trade mark" in Section 8A be removed for the reasons set out in question (4) above.

Question 14: Do you have any views / comments on the proposed staged implementation process?

No comment.

Question 15: In relation to how the enhanced GI protection scheme will interact with existing GIs, do you have any views / comments on the proposed co-existence?

No comment. We understand that existing GIs can be registered under the proposed registration system.