

1999 GEOGRAPHICAL INDICATIONS ACT 13

COMMONWEALTH OF DOMINICA

ARRANGEMENT OF SECTIONS

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I asent



V.L. SHAW
President

26th November, 1999

AN ACT TO PROVIDE FOR THE PROTECTION OF GEO-
GRAPHICAL INDICATIONS AND FOR MATTERS
RELATED THERETO

(Gazetted 2nd December, 1999)

BE IT ENACTED by the Parliament of the Commonwealth of
Dominica as follows :

PART I
PRELIMINARY

1. This Act may be cited as the - Short title.
PROTECTION OF GEOGRAPHICAL INDICATIONS ACT 1999.

2. In this Act, unless the context otherwise requires - Interpretation.
“Court” means the High Court;
“geographical indication” means an indication which identifies any
goods 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 their geo-
graphical origin;

“goods” means any natural or agricultural product or any product of handicraft or industry;

“Journal” means the Journal of Intellectual Property created under Act No. 8 of 1999. section 5(d) of the Patents Act, 1999;

“Minister” means the Minister responsible for geographical indications;

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

“producer” means -

- (i) the producer of any agricultural product or any other person exploiting natural products;
- (ii) the manufacturer of any product of handicraft or industry; or
- (iii) any trader dealing in the said products;

“Register” means the Register of Geographical Indications referred to in section 18; and

“Registrar” means the Registrar of Companies and Intellectual Property.

PART II

PROTECTION OF GEOGRAPHICAL INDICATIONS

Protection
regardless of
registration.

3. Protection under this Act shall be available -

- (a) regardless of whether or not a geographical indication has been registered provided, however, that the registration of a 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; 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.

4. (1) In the case of homonymous geographical indications for wines, protection shall be accorded to each indication subject to section 3 (b). Homonymous indications for wines.

(2) The Registrar shall, in the case 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.

5. The following shall not be protected as geographical indications - Exclusion from protection.

- (a) indications which are not geographical indications as defined in section 2;
- (b) indications which are contrary to public order or morality; and
- (c) geographical indications which are not, or cease to be, protected in their country of origin, or which have fallen into disuse in that country.

PART III

REGISTRATION OF GEOGRAPHICAL INDICATIONS

6. The following persons may file an application with the Registrar in the prescribed form for the registration of a geographical indication - Application.

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

7. (1) The application 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; Contents of Application.

- (b) the geographical indication for which registration is sought;
- (c) the geographical area 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 shall be accompanied by the prescribed application fee.

**Examination
of application.**

8. (1) The Registrar shall examine the application to determine whether it complies with the requirements of sections 5(b), 6 and 7 and the Regulations pertaining thereto.

(2) Where the Registrar finds that the requirements referred to in subsection (1) hereof are fulfilled, he shall accept the application and cause it, as accepted, to be published in the Journal in the prescribed manner.

**Opposition to
registration.**

9. (1) Any interested person or competent authority may, within the prescribed period and in the prescribed manner, give notice to the Registrar of opposition to the registration of the geographical indication on the ground that one or more of the requirements of sections 5(b), 6 and 7 are not fulfilled.

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

(3) The applicant shall, if he does not file a counter-statement, be deemed to have abandoned the application.

(4) Where the applicant files a counter-statement, the Registrar shall furnish a copy thereof to the person giving notice of opposition and, after hearing the parties, if they wish to be heard, and considering the merits of the case, shall decide whether the geographical indication should be registered.

10. (1) Where the Registrar finds that the requirements referred to in sections 5(b), 6 and 7 are fulfilled, and - Registration of geographical indication.

- (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 register the geographical indication, publish a reference to the registration in the Journal, and issue to the applicant a certificate of registration.

(2) Where the requirements for registration have not been fulfilled, the Registrar shall refuse the application.

11. Only producers carrying on their 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, provided that such products possess the quality, reputation or other characteristic specified in the Register. Right of use.

12. (1) The Court may, on the application of any interested person - Invalidation or rectification of registration.

- (a) invalidate the registration of a geographical indication on the ground that the geographical indication is excluded from protection under section 5; or

- (b) rectify the registration of a geographical indication on the ground that the geographical area specified in the registration does not correspond to the geographical indication, or 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 -

- (a) the person referred to in subsection (1) shall serve notice of the application for invalidation or rectifica-

tion on the person who filed the application for registration of the geographical indication or his successor in title; and

- (b) the Registrar shall, by publishing in the Journal the application for invalidation or rectification, give notice to all persons having 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 in the said notice and publication, apply to join in the proceedings.

Proceedings for unlawful use of geographical indications.

13. Any interested person or interested group of persons may institute proceedings in the Court to prevent, in respect of any geographical indication -

- (a) the use of any means in the designation or presentation of any 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) any use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention; or
- (c) the use of a 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", "type", "style", "imitation" or the like.

(2) In proceedings under this section, the Court may, in addition to issuing an injunction, award damages and grant any other civil remedy or relief as it shall consider appropriate.

PART IV
SPECIAL PROVISIONS CONCERNING MARKS;
EXCEPTIONS

14. The Registrar shall, *ex officio* or at the request of any interested party, refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in Dominica is of such a nature as to mislead the public as to the true place of origin of such goods. Misleading marks.

15. 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 Registrar, *ex officio* or on the application of an interested party, with respect to such wines or spirits not having this origin. Marks conflicting with a geographical indication for wine and spirits.

16. (1) Nothing in this Act shall prevent the continued and similar use, in Dominica, of a particular geographical indication of another country identifying wines or spirits in connection with goods or services by any national or domiciliary of Dominica who has used that geographical indication continuously with regard to the same or related goods or services in the territory of Dominica - Exceptions regarding prior users.

(a) for at least ten years preceding the 15th of April, 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 a trademark, or the right to use a trademark, on the basis that such a trademark is identical to, 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 goods or services for which the relevant indication is identical to the term customary in common language as the common name for such goods or services in Dominica, 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 to the customary name of a grape variety existing in Dominica as of the 1st of January, 1995.

(4) Any application for relief made under Part III of this Act in connection with the use or registration of a trademark shall be made within five years after the unlawful use of the protected indication has become generally known in Dominica or after the date of registration of the trademark in Dominica, provided that the trademark has been published by that date, if such date is earlier than the date on which the unlawful use became generally known in Dominica and provided further 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 GENERAL PROVISIONS

Registrar. 17. The Registrar shall perform the functions and exercise the powers conferred on him by this Act and any other enactment.

Register. 18. (1) The Registrar shall maintain a Register of Geographical Indications in which he shall record all matters required by this Act or the Regulations to be recorded.

(2) Any person may, upon payment of the prescribed fees, and in accordance with the prescribed conditions, consult, inspect or make a copy of, or obtain an extract from the Register.

(3) The Register shall be *prima facie* evidence of anything required or authorised by this Act to be registered, and shall be admissible and sufficient evidence of any such thing.

(4) A certificate purporting to be signed by the Registrar and certifying that any entry which he is authorised to make by this Act has or has not been done, shall be *prima facie* evidence, and shall be admissible and sufficient evidence of the matters so certified.

(5) Each of the following, that is to say a copy of -

- (a) an entry in the Register or an extract from the Register which is supplied under subsection (2);
- (b) any document kept in the Companies and Intellectual Property Office, or an extract from any such document, or any matter which has been published under this Act,

which is a certified copy or a certified extract shall be admitted in evidence without production of the original, and such evidence shall be sufficient evidence of the matters stated therein.

(6) In this section, "certified copy" and "certified extract" means a copy or extract certified by the Registrar and sealed with his seal.

19. (1) The Registrar may, of his own volition or upon the written request of any person, correct any clerical error or error of translation or transcription in any application filed under this Act, or in any document filed in pursuance of such application, and the Registrar may also correct any clerical error in the Register. Correction of errors.

(2) Subsection (1) shall not be construed as giving the Registrar the power to correct in the Register, any application or document in a material way.

20. (1) Where the Registrar is satisfied that the circumstances justify it, he may, upon receiving the written request of any interested person, and upon such terms as he may direct, extend the time for doing any act or taking any proceeding under this Act or the Regulations, and shall give written notice to the parties concerned. Extension of time for applications.

(2) The extension may be granted even though the time for doing the act or taking the proceeding has expired.

Exercise of
discretionary
powers.

21. The Registrar shall give any party to a proceeding before him the opportunity of being heard before exercising any discretionary power vested in him by this Act if the exercise thereof might adversely affect that party.

Jurisdiction of
Court.

22. (1) The High Court shall have jurisdiction in cases of dispute relating to the application of this Act and the Regulations and in matters which, under this Act, may be brought before it.

(2) Any person who is aggrieved by a decision of the Registrar under this Act may, within two months of that decision, appeal to the Court.

Offences.

23. (1) Any person who knowingly performs any act referred to in section 13 commits an offence and is liable to a fine of not less than fifteen thousand dollars but not more than forty thousand dollars, or to imprisonment for a term of not less than five years but not more than twelve years, or to both such fine and such imprisonment.

(2) Any person who, knowing the same to be false -

- (a) makes or causes to be made a false entry in the Register;
- (b) makes or causes to be made any document falsely purporting to be a copy of an entry in the Register; or
- (c) produces, tenders or causes to be produced in evidence any such entry or copy thereof,

commits an offence and is liable to a fine of not less than ten thousand dollars, but not more than thirty thousand dollars, or to imprisonment for a term of not less than three years, but not more than ten years, or to both such fine and such imprisonment.

Regulations.

24. The Minister may make Regulations providing for any matter which is to be prescribed under this Act, or for giving effect to the purposes of this Act.

25. (1) This Act shall come into force on such day as the Minister Commencement may, by Order published in the *Gazette*, appoint.

Passed in the House of Assembly this 9th day of September, 1999.

RUTH SIMON (MRS)
Clerk of the House of Assembly (Ag).
