

COMMONWEALTH OF INDEPENDENT STATES

Agreement on Measures for the Prevention and Repression of the Use of False Trademarks and Geographical Indications* **(of June 4, 1999)**

The States party to this Agreement, represented by their Governments, hereinafter referred to as “the Parties”,

Having regard to the Agreement on Measures for the Protection of Industrial Property and the Establishment of an Inter-State Council for the Protection of Industrial Property, of March 12, 1993, to the Treaty on the Implementation of a Concerted Anti-Monopoly Policy, of December 23, 1993, and to the Agreement on Cooperation in the Repression of Offenses in the Field of Intellectual Property, of March 6, 1998,

Recognizing the great importance of joint measures to ensure protection for the rights of consumers and producers against the marketing of goods bearing false trademarks or geographical indications,

Guided by the generally accepted norms of international law,

Attaching great importance to the development of trade relations between the Parties,

With the objective of coordinating joint actions to prevent and repress the use of false trademarks and geographical indications and also acts of unfair competition,

Have agreed as follows:

Article 1

For the purposes of this Agreement

“goods” means articles meeting any social need and manufactured for trade, that is to say having a value determined by the process of their exchange for other goods;

“trademark” means any sign serving to distinguish the products of a natural or legal person from similar products of other natural or legal persons;

“geographical indication” means any indication serving to identify a product as originating from a territory, region or locality of one of the Parties in those cases where the quality, reputation or other characteristic of the product is determined to a large extent by such geographical origin;

“false trademark” means any trademark used by a third party in violation of the rights of the owner of a trademark or comprising a false indication of the origin of goods or any other information or element liable to mislead the consumer;

“legal remedies” means all those measures for the prevention and repression of the use of false trademarks and geographical indications adopted and applied by the Parties in accordance with their legal systems;

“interested party” means any natural or legal person involved in the manufacture, preparation, selling or consumption of goods and who is located in the locality falsely indicated as being the place of origin of the goods, in the administrative district to which such locality belongs, in the country falsely indicated as being the origin or in the country in which is used the false geographical indication of the origin of the goods or the false trademark.

Article 2

The Parties shall cooperate in

- the establishment and repression of acts concerning the use of false trademarks and geographical indications;
- the prevention of the entry of products bearing false trademarks or geographical indications across their customs frontiers into the territory of another Party.

Article 3

The Parties shall harmonize the measures to prevent and repress the use of false trademarks and geographical indications on the basis of joint actions and obligations freely entered into.

Article 4

With regard to geographical indications, the Parties shall provide legal remedies to interested parties for the purpose of prohibiting

- (a) the use in the designation or presentation of goods of any element that identifies (or suggests an association with) a place of origin other than the true place of origin of the goods and which is liable to mislead consumers as to the geographical origin of the goods;
- (b) any act that may be held an act of unfair competition within the meaning of Article 10*bis* of the Paris Convention for the Protection of Industrial Property¹.

Article 5

Under the requirements of their national legislation or on a reasoned request by an interested party, the Parties shall refuse or invalidate the registration of a trademark or the assignment of rights in a trademark where it is constituted by a geographical indication or contains a geographical indication if the use of such geographical indication in the trademark for products that do not originate in the designated territory of a Party is such as to mislead consumers as to the true place of origin of the goods.

Article 6

The legal remedies referred to in Articles 4 and 5 of this Agreement shall also apply to geographical indications which, although literally correct in respect of the territory, region

or locality from which the goods originate, give consumers a wrong impression of the territorial origin of the goods.

Article 7

The Parties shall provide legal remedies to prohibit the use of geographical indications that identify wines or spirits for wines or spirits that do not effectively originate in the place shown by the geographical indication, including those cases in which such geographical indications are used in translation or are accompanied by reference to the true place of origin or by words such as “kind”, “type”, “style”, “imitation” or other similar term.

Article 8

Registration for wines or spirits of a trademark which is constituted by a geographical indication or which contains such indication shall be refused or invalidated, if the legislation of the Party so provides, or at the request of an interested party, in relation to wines and spirits not entitled to that geographical origin.

Article 9

Where identical geographical indications are used for wines and spirits, legal remedies shall be afforded to each geographical indication, subject to the provisions of Article 6 of this Agreement.

To ensure equitable conditions for the producers concerned and to ensure that consumers are not misled, each Party shall lay down those conventional terms that will enable identical geographical indications to be distinguished from each other.

Article 10

To facilitate the application of the legal remedies for the defense of geographical indications, the Parties shall conduct negotiations with a view to establishing a multilateral registration system for geographical indications and for the notification of their protection on the territory of the Parties.

Article 11

The Parties shall incorporate in their national legislation procedural provisions to ensure respect for rights in trademarks and geographical indications, by providing effective remedies against infringement of the rights set out in this Agreement, including urgent measures intended to forestall any infringement and sanctions that constitute dissuasion against any subsequent infringement. Those procedures shall contain safeguards against their abusive use and against the creation of trade barriers.

Article 12

The procedures for enforcing rights in trademarks and geographical indications shall be

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Article 13

The Parties shall afford the holders of rights in a trademark or geographical indication the possibility of taking legal action to defend the rights set out in this Agreement, in accordance with the place of infringement of the rights and in accordance with the national legislation of the Parties.

Article 14

The judicial authorities may order any natural and/or legal person of a Party to make full compensation to an interested party for losses incurred and to pay to him all proceeds he has obtained from trading in the goods bearing a false trademark or geographical indication.

Article 15

The judicial authorities may order any natural and/or legal person of a Party, at the request of an interested party, to reimburse to the latter his legal costs, which may include lawyer's fees; they shall also be empowered to take all necessary measures provided for by the national legislation of that Party.

Article 16

In order to create an effective means of dissuasion against infringement of the rights of holders of trademarks or geographical indications, the judicial authorities of the Parties shall be empowered to order, at the request of an interested party, that those goods which they have ascertained to infringe a right be, without compensation of any kind, removed from trade channels so as to avoid any prejudice to the holder of the right in the trademark or geographical indication, or that they be destroyed if such is not contrary to the national legislation applicable in that Party.

When examining such cases, the Parties shall ensure proportionality between two factors: the nature of the infringement and of the remedies, on the one hand, and the interests of third parties, on the other. In the case of goods bearing an infringing trademark, the simple fact of removing the trademark that has been unlawfully affixed shall not be adequate to permit the introduction of the goods concerned into the trade channels, except under exceptional circumstances to be additionally agreed by the Parties.

Article 17

The judicial authorities shall be empowered to order the interested party on whose request measures have been taken, but who has made abusive use of the procedures for ensuring respect for the rights of the owner of a trademark or a geographical indication to afford to another interested party, on whom has been unjustly imposed an obligation or a prohibition, adequate compensation to make good the prejudice incurred as a result of such abusive use.

The judicial authorities shall also be empowered to order the plaintiff to pay the defendant's costs, which may include appropriate lawyers' fees.

Article 18

The judicial authorities of the Parties shall be empowered to order, at the request of an interested party, the adoption of rapid and effective provisional measures

- (a) to prevent the performance of an act that infringes the right of an owner of a trademark or a geographical indication and, in particular, to prevent introduction into trade channels of goods bearing false trademarks or geographical indications, including goods imported immediately after customs clearance. Such provisions shall not apply to goods acquired or ordered by a consumer before becoming aware or without it being possible for him to have been aware that trade in those goods was carried out unlawfully;
- (b) to safeguard the elements of proof pertinent to the infringement of rights.

Article 19

The judicial authorities shall be empowered to take provisional measures, at the request of an interested party, without the adverse party being heard, in particular in those cases where any delay is likely to cause irreparable prejudice to the holder of the right in the trademark or geographical indication or where there exists a proven risk of destruction of the elements of proof.

Article 20

The judicial authorities shall be empowered to require the plaintiff to prove that he is the holder of rights in the trademark or geographical indication and of the existence or imminence of an infringement to his right, and to order him to deposit sufficient security to protect the rights of the defendant and prevent abuse.

Article 21

Where provisional measures referred to in Article 19 of this Agreement have been taken, the defendant shall be advised thereof without delay. At the request of the defendant, a review of the decision taking provisional measures shall be carried out, including his right to be heard.

In those cases where provisional measures are to be withdrawn or cease to be applicable through the fault of the plaintiff, or in those cases where it is subsequently ascertained that there was no infringement or no risk of infringement of an intellectual property right, the judicial authorities may order the plaintiff, at the request of the defendant, to pay to the latter equitable damages to compensate for the prejudice occasioned by the measures concerned, in accordance with the national legislation of the Party where the judicial proceedings take place.

Article 22

The Parties shall implement procedures permitting the holder of rights in a trademark or

geographical indication who has valid reason to suspect the possible import of goods bearing a false trademark or geographical indication to apply in writing to the administrative or judicial authorities concerned for the suspension by the customs authorities of the release of such goods for free circulation.

The Parties may also lay down corresponding procedures for suspension by the customs authorities of the release for free circulation of goods bearing false trademarks or geographical indications that are intended for export out of their territory.

Article 23

The Parties shall provide in their national legislation for penal and administrative liability for the deliberate use of false trademarks or geographical indications committed on a commercial scale. Sanctions shall be appropriate to the level of penalties applicable for offenses of similar gravity. Where appropriate, possible sanctions shall include seizure, confiscation and destruction of goods bearing false trademarks or geographical indications and of the materials and tools that have served to commit the offense.

Article 24

For the purposes of implementing this Agreement, the Parties shall

- communicate to each other prompt information on acts of production and marketing detected by their competent authorities and on alleged attempts to export or import goods bearing false trademarks or geographical indications;
- jointly draw up and implement measures to prevent, detect, repress and impede the acts referred to in the preceding subparagraph of this Article and other offenses related to the protection of trademarks and the right to use geographical indications;
- communicate systematically to each other information on the legislative instruments governing the matters to which this Agreement refers together with the relevant methodological and technical literature;
- communicate systematically to each other information on the trademarks and geographical indications of origin of goods imported into their territory;
- participate in carrying out joint research in the field of industrial property protection, hold seminars and conferences and work together in the training and qualification of personnel.

Article 25

The coordination of the activities of the Parties for the implementation of this Agreement shall be entrusted to the Inter-State Council for the Protection of Industrial Property.

Article 26

Nothing in this Agreement shall affect the provisions of other international treaties to which the Parties are also party.

Article 27

This Agreement may be subject, with the common consent of the Parties, to modifications and additions that will take the form of separate protocols that shall enter into force in accordance with the conditions set out in this Agreement.

Any dispute arising from the application or interpretation of this Agreement shall be settled by consultation and negotiation between the Parties.

Where it is not possible to settle a dispute by negotiation, the Parties shall refer it to the competent international courts, with the written consent of the interested parties.

Article 28

This Agreement shall enter into force on the date of its signature or, for those Parties whose legislation requires the carrying out of a domestic procedure for its entry into force, on the date of the corresponding notification made to the depositary. The Parties shall inform the depositary of the need to carry out such procedure within a period of three months as from the date of signature of this Agreement.

Article 29

This Agreement shall have effect for a period of five years as from the date of its entry into force. On expiry of that period, it shall be automatically extended for a further five-year period, itself renewable, unless otherwise decided by the Parties.

Article 30

Each Party shall be entitled to withdraw from this Agreement or to suspend its participation by communicating a written notification to that effect to the depositary at least six months prior to the date of its withdrawal.

Article 31

This Agreement is open to other States who share its aims and principles and who may accede to it by communicating an instrument of accession to the depositary.

* *Russian title*: Соглашение о мерах по предупреждению и пресечению использования ложных товарных знаков и географических указаний.

Entry into force: June 4, 1999; see also Article 28.

Source: Communication from the the Interstate Council for the Protection of Industrial Property (ICPIP).

Note: Translation by the International Bureau of WIPO.

¹ See *Industrial Property Laws and Treaties*, MULTILATERAL TREATIES—Text 1-016 (*Editor's note*).