

CHAPTER 320

GEOGRAPHICAL INDICATIONS

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CHAPTER 320

GEOGRAPHICAL INDICATIONS

An Act to provide for the protection of geographical indications in order to fulfill the obligations of Barbados under the Agreement on Trade-Related Aspects of Intellectual Property Rights of the World Trade Organisation and related matters. 1998-22

[19th February, 2001] Commence-
ment
2001/22

Citation

1. This Act may be cited as the *Geographical Indications Act*. Short title.

Interpretation

2. In this Act,

Definitions.

"Court" means the High Court;

"Director" means the Registrar of Corporate Affairs and Intellectual Property;

"geographical indication" means an indication that identifies 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 its geographical origin;

"producer" means

- (a) any producer of agricultural products or any other person using natural products for the production of other goods;
- (b) any industry or manufacturer of products of handicraft; and

- (c) any trader dealing in the products mentioned in paragraphs (a) and (b);

"Register" means the Register of Geographical Indications.

PART I

Protection of Geographical Indications

Application
of Act.

3. (1) Protection under this Act is accorded to geographical indications whether or not they are registered.

(2) Notwithstanding subsection (1), geographical indications which, although literally true as to the territory, region or locality in which the goods originate, falsely represent to the public that the goods originate in another territory are not protected by this Act.

(3) For the purposes of this section, registration of a geographical indication under Part II raises the presumption that the geographical indication is a geographical indication within the meaning of section 2.

Homony-
mous
geographical
indications
for wines.

4. (1) Subject to section 3(2), in the case of homonymous geographical indications for wines, protection shall be accorded to each indication.

(2) The Director shall, in cases of permitted concurrent use of homonymous geographical indications, determine the practical conditions under which such indications will be differentiated from each other.

(3) For the purposes of subsection (2), the Director shall have regard to the need

- (a) to ensure equitable treatment of the producers concerned; and
(b) to ensure that consumers are not misled.

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

- (a) indications that do not correspond to the definition of "geographical indication" in section 2;
- (b) indications that offend public order or morality;
- (c) geographical indications that are not or cease to be protected in their country of origin, or that have fallen into disuse in that country.

6. (1) No person shall

- (a) in the designation or presentation of goods, by any means, indicate or suggest that the goods originate in a geographical area other than the true place of origin in a manner that misleads the public as to the geographical origin of the goods;
 - (b) use 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;
 - (c) engage in conduct which constitutes an act of unfair competition, being an act of competition contrary to honest practices in industrial or commercial matters and including
 - (i) all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor;
 - (ii) false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor;
- Prohibition against improper use of geographical indications.

(iii) indications or allegations, the use of which in the course of trade, is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.

(2) A person who contravenes subsection (1) is guilty of an offence and is liable on summary conviction to a fine of \$10 000 or to imprisonment for 2 years or to both such fine and imprisonment.

Civil
remedies.

7. (1) Any interested person may institute proceedings in the Court to prevent, in respect of geographical indications, any act referred to in section 6(1).

(2) The Court may, in proceedings under subsection (1), in addition to granting an injunction, award damages and grant any other remedy or relief the Court thinks fit.

PART II

Registration of Geographical Indications

Application
for
registration.

8. (1) The following may make an application to the Director for the registration of a geographical indication

- (a) persons carrying on an activity as producers in the geographical area specified in the application, with respect to the goods specified in the application;
- (b) consumers and groups of consumers; or
- (c) any marketing organisation incorporated under the *Companies Act* or established under any enactment.

Cap. 308.

(2) Where an applicant's ordinary residence or principal place of business is outside Barbados, he shall be represented by an attorney-at-law who is resident and practising as an attorney-at-law in Barbados.

(3) An application for the registration of a geographical indication shall specify

- (a) the name, address and nationality of the person making the application, and the capacity in which the applicant is applying for registration;
- (b) the geographical indication for which registration is sought;
- (c) the geographical areas to which the geographical indication applies;
- (d) the goods to which the geographical indication applies;
- (e) the quality, reputation or other characteristic of the goods in respect of which the geographical indication is used,

and shall be accompanied by the prescribed fee.

9. (1) The Director shall examine every application to ascertain whether it complies with the requirements of sections 5(b) and 8 and the regulations.

Examination
and
publication
of
applications.

(2) Where the Director is satisfied that the application complies with the requirements of sections 5(b) and 8 and that the regulations referred to in subsection (1) are fulfilled, he shall cause the application to be published in the prescribed manner.

10. (1) Any interested person may, within the prescribed period and in the prescribed manner, give notice to the Director of an objection to the registration of the geographical indication referred to in section 8 on the grounds that it does not comply with the requirements of section 5 or 8, or the regulations.

Objections
to
registration.

(2) The Director shall send a copy of the notice referred to in subsection (1) to the applicant.

(3) Upon receipt of the copy of the notice referred to in subsection (2), the applicant shall, within the prescribed period and in the prescribed manner, send to the Director a counter-statement of the grounds on which the applicant relies for his application; and if he does not do so, he shall be deemed to have abandoned the application.

(4) Where the applicant sends a counter-statement, the Director shall furnish a copy thereof to the objector and, after hearing the parties, if either or both wish to be heard, and considering the merits of the case, the Director shall decide whether the geographical indication should be registered.

Registration. **11.** (1) Where the Director is satisfied that the requirements referred to in section 8 have been complied with and either

- (a) there has been no objection to the registration of the geographical indication within the prescribed period; or
- (b) there has been an objection to the registration of the geographical indication and the objection has been decided in the applicant's favour,

the Director shall register the geographical indication, issue to the applicant a certificate of registration and publish a notice of the registration.

(2) Where, as the result of an objection made under this section or for any other reason, the Director is satisfied that the application for registration of a geographical indication does not comply with the requirements of section 5 or 8 or the regulations the Director shall refuse the application.

Right of use.

12. Only producers of products possessing the quality, reputation or other characteristic specified in the Register and who are carrying on their activity in the geographical area specified in the Register may use a registered geographical indication, in the course of trade, with respect to such products.

Register.

13. (1) The Director shall maintain a Register in which he shall record all matters required by this Act to be recorded.

(2) The Register shall be open for inspection by the public during normal working hours, and any person may obtain extracts therefrom or make copies of such extracts in the manner and under the conditions prescribed.

- 14.** (1) Any interested person may apply to the Court for
- (a) the cancellation of the registration of a geographical indication on the grounds that it does not comply with section 5; or
 - (b) the rectification of the registration of a geographical indication on the grounds
 - (i) that the geographical area specified in the registration does not correspond to the geographical indication; or
 - (ii) that the indication of the products in respect of which the geographical indication is intended to apply or the indication of the quality, reputation or other characteristic of such products is missing or is unsatisfactory.
- (2) In any proceedings under this section, notice of the request for cancellation or rectification
- (a) shall be served on the person who filed the application for registration of the geographical indication or his successor in title; and
 - (b) shall, by a publication in the prescribed manner, be given 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 such period as the Court specifies in the notice and publication referred to in that subsection, apply to be joined in the proceedings.
- (4) The Registrar of the Supreme Court shall notify the Director of the decision of the Court or the decision on any appeal therefrom and the Director shall record it and publish a notice of the decision as soon as possible.

Cancellation and rectification of registration.

15. The Director may, subject to the regulations, correct any error of translation or transcription, clerical error or mistake in any application or document filed with the Director or in any matter recorded pursuant to this Act or the regulations.

Correction of errors.

Extension of
time.

16. Where the Director is satisfied that the circumstances justify it, he may, upon receiving a written request, extend the time for doing any act or taking any proceedings under this Act or the regulations, upon notice to parties concerned and upon such terms as he may direct notwithstanding that the time for doing the Act or taking the proceedings has expired.

Discretion-
ary powers.

17. The Director shall, before exercising any discretionary power vested in him by this Act in a manner that is likely to adversely affect any party to proceedings before him, give that party an opportunity to be heard.

Publication.

18. The Director shall publish in the *Official Gazette* and in a newspaper published daily in Barbados everything required to be published under this Act.

Jurisdiction
of Court.

19. (1) The Court has jurisdiction in cases of disputes relating to the application of this Act and in matters which, under this Act, are to be referred to the Court.

(2) Any party aggrieved by a decision of the Director may, within 2 months after the date of the decision, appeal against the decision to a Judge in chambers.

PART III

Special Provisions Concerning Marks: Exceptions

Misleading
marks.

20. The Director shall, on his own motion or at the request of an interested party, refuse or invalidate the registration of a trademark that 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 Barbados is of such a nature as to mislead the public as to the true place of origin.

21. The registration of

- (a) a trademark for wines that contains or consists of a geographical indication identifying wines; or
- (b) a trademark for spirits that contains or consists of a geographical indication identifying spirits,

Marks conflicting with a geographical indication for wines and spirits.

shall be refused or invalidated by the Director on his own motion or at the request of an interested party, with respect to such wines or spirits that do not originate in the territory indicated.

22. (1) Nothing in this Act shall prevent continued and similar use in Barbados of a particular geographical indication of another country identifying wines or spirits in connection with goods or services by citizens, permanent residents or immigrants of Barbados who have used that geographical indication in a continuous manner with regard to the same or related goods or services in Barbados

Exceptions regarding prior users.

- (a) for a period of at least 10 years immediately preceding 15th April, 1994; or
- (b) in good faith prior to 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 19th February, 2001; 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 with, 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 with the term customarily used in common language as the common name for such goods or services in Barbados.

(4) Any request for relief made under Part I of this Act in connection with the use or registration of a trademark must be presented within 5 years after the adverse use of the protected geographical indication has become generally known in Barbados or after the date of registration of the trademark in Barbados.

(5) Subsection (4) applies only where the trademark has been published by the date of registration of the trademark in Barbados, where that date is earlier than the date on which the adverse use became generally known in Barbados and provided that the geographical indication is not used or registered in bad faith.

(6) This Act does not affect 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 a manner that is likely to mislead the public.

PART IV

Miscellaneous

Regulations.

23. The Minister may make regulations

- (a) prescribing anything that is required by this Act to be prescribed; or
- (b) that are necessary for giving effect to this Act.