**EU-NZ Free Trade Agreement:  
Reform of Geographical Indications Law in New Zealand**

**Discussion Paper**

Diagram

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**November 2022**

How to have your say

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The Ministry of Business, Innovation and Employment (**MBIE**) seeks written submissions on the issues raised in this document by **5pm on** **28 February 2023**.

Your submission may respond to any or all of these issues. Where possible, please include evidence to support your views, for example references to independent research, facts and figures, or relevant examples.

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The information provided in submissions will be used to inform MBIE’s policy development process, and will inform advice to Ministers on reforming the *Geographical Indications (Wine and Spirits) Registration Act 2006* as part of the process of meeting New Zealand obligations under the proposed EU-NZ Free Trade Agreement. We may contact submitters directly if we require clarification of any matters in submissions.

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List of Acronyms

|  |  |
| --- | --- |
| **CPTPP** | Comprehensive and Progressive Agreement for the Trans-Pacific Partnership |
| **Customs** | New Zealand Customs Service |
| **EU** | European Union |
| **EU-NZ FTA** | European Union New Zealand Free Trade Agreement |
| **FTA** | Free Trade Agreement |
| **GI(s)** | Geographical indication(s) |
| **GIs Act** | Geographical Indications (Wine and Spirits) Registration Act 2006 |
| **IP** | Intellectual Property |
| **IPONZ** | Intellectual Property Office of New Zealand |
| **MBIE** | Ministry of Business, Innovation and Employment |
| **MFAT** | Ministry of Foreign Affairs and Trade |
| **NZ-UK FTA** | New Zealand United Kingdom Free Trade Agreement |
| **TRIPS** | World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property Rights |

# Introduction

## 1.1 Changing New Zealand’s geographical indications legislation to implement free trade agreement obligations

### Why are we consulting?

1. The obligations New Zealand has agreed to in the free trade agreement with the European Union (**EU**) (referred to in this document as EU-NZ FTA) has created a regulatory gap with what currently exists in the *Geographical Indications (Wines and Spirits) Registration Act 2006* (the **GIs Act**). We need to amend the GIs Act to meet these obligations.
2. This discussion document seeks your views on how we do this. The discussion paper also asks for your views on whether there are any problems with the GIs Act that should be addressed as part of implementing the EU-NZ FTA.

### Context

1. On 30 June 2022 New Zealand concluded trade negotiations with the EU and its 27 Member States. The agreement will deepen our partnership with the EU, deliver significant economic gains and reinforce high standards in areas that matter to New Zealand. It will create new opportunities and cut costs for businesses through more favourable access to the EU, and play an important role in the Government’s Trade Recovery Strategy.
2. We expect the EU-NZ FTA will be signed in 2023 and could be ratified and enter into force in 2024, subject to the domestic procedures of each Party (see paragraph 38 for consultation and implementation timetable). The Ministry of Foreign Affairs and Trade (**MFAT**) has published the text of the draft agreement, including the Intellectual Property (**IP**) Chapter, on its [website](https://www.mfat.govt.nz/en/trade/free-trade-agreements/free-trade-agreements-concluded-but-not-in-force/new-zealand-european-union-free-trade-agreement/resources/nz-eu-free-trade-agreement-by-chapter/). This discussion document relates to the geographical indications (**GIs**) component of the IP Chapter of the EU-NZ FTA (the definition of GIs is below in paragraphs 13 and 14).
3. Under the EU-NZ FTA New Zealand has agreed to protect around 2,000 names as GIs for food, wine, spirts and other beverages to a standard above that currently provided to registered wine and spirits GIs under the GIs Act. To protect the EU GIs the following regulatory gaps will require legislative amendments concerning:
   1. the types of products for which GIs can be registered under the GIs Act
   2. the standard of protection for GIs
   3. the enforcement measures available to prevent GIs being misused or infringed.

More detail on these is provided later in the document.

1. The EU-NZ FTA requires New Zealand to have made the regulatory amendments providing protection to the agreed list of EU GIs before ratification in 2024. This provides just enough time to consult on how we amend the GIs Act. However, this also provides an opportunity to review aspects of the GIs Act to:
   1. understand whether New Zealand businesses/organisations need the registration regime for wine and spirits to be extended to other types of GIs (eg food, other beverages like beer, or handicrafts)
   2. ensure the registration and enforcement regime is meeting the needs of wine and spirits producers for protecting their GIs.
2. The GIs obligations under the EU-NZ FTA were agreed to following consultation by MFAT with domestic food and beverage producers, importers, retailers, Treaty partners and trade partners who were identified as being most affected. We expect this discussion document to be of most interest to these groups.

### Purpose

1. The purpose of this discussion paper is to obtain information from:
   1. Treaty partners, who we know from prior engagement with MFAT, have an interest in exploring how GIs could provide protection for mātauranga Māori domestically and internationally
   2. food and beverage producers to better understand if the scope of the registration regime under the GIs Act should be extended
   3. the public more broadly to understand what opportunities an extended GIs registration regime would provide to New Zealand.
2. It also seeks views on whether there are any problems with the current regime under the GIs Act that we should look to address.
3. Your submission will help inform decisions made by the Government to reform the GIs Act to meet New Zealand’s obligations regarding the protection of EU GIs under the EU-NZ FTA and whether the scope of registration regime under the GIs Act should be extended.
4. Although the obligations only become legally binding once New Zealand has signed and ratified the EU-NZ FTA (expected to be mid 2024), we are consulting now because the timeframes for implementation are tight. This will ensure the public has had an opportunity to express their views on reforming the GIs Act.

### Objectives for reforming the GIs Act

1. Our objectives for reforming the GIs Act are to:
   1. make the changes necessary to meet New Zealand’s new GIs obligations for EU GIs
   2. ensure that domestically registered GIs receive the same protection as that required for EU GIs under the EU-NZ FTA
   3. ensure the registration regime provides efficient and effective protection for all registered GIs including:
      * ensuring enforcement procedures permit effective action to be taken against any act of infringement
      * providing expeditious remedies that constitute a deterrent to further infringements
   4. ensure domestic producers who have developed, and are using, GIs are able to effectively protect them against misuse in New Zealand.

## 1.2 What are geographical indications?

1. A GI is an indication, usually a name, which identifies that a product comes from a particular area. It has to also indicate that a product has a particular quality, reputation or other characteristic that is essentially attributable to it coming from that area.[[1]](#footnote-1) A GI links the characteristics of the product to the geographical area in a way that distinguishes the product from similar products originating in other areas.
2. The link must arise from the natural and human elements unique to the area and the method of production. Unique elements could include soil conditions, climate characteristics, production traditions, or the product’s reputation associated with the area. Although it is not a requirement, many GIs include a geographical name.
3. The names of some of New Zealand’s major wine growing regions have been registered as GIs under the GIs Act. Names such as ‘Central Otago’ and ‘Marlborough’ identify wines that originate from those regions and, as a result, have particular characteristics distinguishing them from wines from other regions.
4. Similarly, foreign names such as ‘Scotch Whisky’ and ‘Pisco’ have been registered under the GIs Act for spirits and, therefore, are protected in New Zealand. This protection prevents people labelling and selling, for example, whisky as ‘Scotch Whisky’ where it is not from Scotland and does not meet the other specific requirements set out as part of the registration.[[2]](#footnote-2)
5. Generally common names that are used by producers and traders to identify or describe a particular type of product (eg ‘cheddar’ for cheese), plant variety (eg ‘pinot noir’ for grapes) or animal breed (eg ‘Hereford’ for cattle) cannot be GIs. This is because common names cannot distinguish a product produced in one area from those produced in other areas.
6. GI protection defines where and (often in the case of EU GIs) how a product must be produced before a particular GI can be attached or attributed to that product. GI protection does not, however, give any person an exclusive right to authorise who may produce or sell the products covered by the GI. Any person who produces or trades in products that meet the defined requirements can use the applicable GI in trade in relation to those products.[[3]](#footnote-3)
7. GIs can create value for local/rural communities and create employment opportunities, especially for products that are deeply rooted in tradition, culture and geography. A product’s reputation in the minds of consumers attributed to its geographical origin is the key driver for the success of a GI in domestic and international markets.
8. The mere existence or registration of a GI does not guarantee benefits for producers. Investment in marketing and building reputation in the product is needed to persuade consumers to pay a premium for products labelled with the GI. Producers may also face increased compliance costs to meet prescriptive production and packaging requirements.

## 1.3 International obligations

1. Under Article 22 of the World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property Rights (**TRIPS**) New Zealand is required to provide minimum standards for the protection of GIs. This does not require a standalone system for registering GIs (our GIs framework is supported through four mechanisms outlined in paragraph 24 below).
2. Article 23 of the TRIPS Agreement requires Member States to provide protection for wine and spirts GIs that is stronger than the minimum provided under Article 22. The GIs Act provides this stronger protection for wine and spirit GIs. It does so through a standalone registration system administered by the Intellectual Property Office of New Zealand (**IPONZ**).[[4]](#footnote-4)
3. Other free trade agreements, including the Comprehensive and Progressive Agreement for Trans-Pacific Partnership (**CPTPP**)[[5]](#footnote-5) and the Regional Comprehensive Economic Partnership[[6]](#footnote-6), also set extensive obligations regarding the protection and enforcement of IP rights, including for GIs. In these agreements, the obligations largely concern the procedures for protecting GIs, rather than the standard of protection to be given to GIs.

## 1.4 New Zealand’s current regulatory framework

### Overview

1. New Zealand gives effect to its international obligations for the protection of GIs through four different mechanisms, namely:
   1. the GIs Act (for wines and spirits only)
   2. the common law tort of passing off (**passing off**)
   3. the *Fair Trading* *Act 1986* (the **Fair Trading Act**)
   4. the *Trade Marks Act 2002* (the **Trade Marks Act**).
2. The GIs Act only protects indications that have been registered as GIs. The other mechanisms can be used to protect GIs for products other than wines and spirits. Wine and spirits GIs do not need to be registered under the GIs Act, as they can also be protected from misuse under the mechanisms in (b), (c) and (d). However, to get the higher level of protection given under the TRIPS agreement a wine or spirit producer would need to register a GI under the GIs Act.

### The GIs Act

1. The GIs Act was amended in 2017 and provides a regime for the registration of GIs for wines and spirits. Examples of wine GIs that have been registered include ‘Marlborough’, ‘Central Otago’, ‘Champagne’ and ‘Napa Valley’. Spirits GIs that have been registered include ‘Pisco’, ‘Cognac’ and ‘Scotch Whisky’.
2. Any person may use a GI to identify a wine or spirit so long as it meets the criteria of the GIs Act and complies with any conditions of registration. They do not need a licence to use the GI. For example any wine producer in Marlborough can use the GI ‘Marlborough’ on their product label provided the wine meets the prescribed requirements.
3. The purposes of the GIs Act[[7]](#footnote-7) are to:
   1. contribute to the development growth and innovation of the wine and spirits industries by providing a suitable legal framework for the registration of GIs
   2. provide a sound trading and marketing environment that facilitates the trade in wine and spirits
   3. protect the interests of consumers by providing assurance that a wine or spirit using a registered GI is authentic
   4. be consistent with the rights and obligations under the TRIPS Agreement.
4. The main drivers for implementing the GIs Act were to:
   1. assist in safeguarding market access for New Zealand wine in the EU market
   2. support the New Zealand wine industry to register GIs in key export markets, including the EU and China.
5. This document deals with parts of the GIs Act that will require amendment to implement the EU-NZ FTA obligations and discusses options for achieving this consistent with the objectives in paragraph 12. As we need to amend the GIs Act, it presents an opportunity to consult on whether other amendments should be made to the GIs Act to support the objectives.

### Passing Off

1. The common law tort of passing off protects the underlying goodwill that traders have established with customers. This enables a business to prevent others from using names and visual characteristics of a product or its packaging that consumers associate with that business.
2. This was successfully used by French wine producers before the GIs Act was enacted to prevent the sale in New Zealand of Australian sparkling wine labelled ‘Champagne’.[[8]](#footnote-8)

### The Fair Trading Act

1. The Fair Trading Act prohibits a business from engaging in conduct that is likely to mislead or deceive consumers. This includes making false or misleading representations about the quality or origin of goods. French wine producers also successfully used the Fair Trading Act to prevent the sale in New Zealand of Australian sparkling wine labelled ‘Champagne’.

### The Trade Marks Act

1. GIs can be registered under the Trade Marks Act as certification or collective trade marks. If a GI is registered as a trade mark a person can only use the GI if they have obtained a license from the trade mark owner. The licensee will only be allowed to use the mark if they comply with the conditions imposed by the trade mark owner and pay any licensee fee imposed by the owner. The name ‘Tequila’ has been registered as a certification trade mark on spirits.[[9]](#footnote-9)

1.5 What have we agreed to in the EU-NZ FTA?

1. New Zealand has agreed to protect a list of around 2,000 names nominated as GIs by the EU.[[10]](#footnote-10) Once the EU-NZ FTA enters into force, these names would only be able to be used in trade by the EU producers.[[11]](#footnote-11)
2. It would not be possible for New Zealand producers and retailers to label their products using these GIs in trade, including on products for export. Nor would it be possible to import products for sale labelled with the EU GIs unless the product concerned originated from the relevant EU region to which the GI relates and complied with applicable product specification.
3. The EU-NZ FTA sets out the standard of protection for EU GIs, which is higher than the current standard provided for wine and spirit GIs under the GIs Act.[[12]](#footnote-12) New Zealand has also agreed to:
   1. provide enforcement for the EU GIs, ex officio or on request of an interested person, in accordance with its laws and regulations by appropriate administrative and judicial steps. This means a government agency would be responsible for enforcing these GIs.
   2. the EU requesting protection for up to an additional 30 names as GIs every three years after the FTA enters into force.
   3. extend border protection measures that apply to the export and import of suspected pirated copyright works and counterfeit trade marked goods to goods that have registered GIs.

## 1.6 Timeline

1. The table below provides an indicative timeline towards implementation, assuming the FTA is signed in 2023 and enters into force in 2024. As noted in paragraph 4, these indicative timeframes are subject to the domestic processes of both the EU and New Zealand.

| **Indicative Date** | **Step** |
| --- | --- |
| 28 February 2023 | Submissions close (see section 5 ‘Next steps’ at the end of this document). |
| Q2 2023 | Cabinet policy approvals for reforming the GIs Act obtained and drafting of amendments commence. |
| June - September 2023 | * FTA signed and tabled in Parliament. * Parliamentary treaty examination process begins. |
| September - November 2023 | General Elections. |
| Q1 2024 | FTA implementation Bill, including GIs Act reforms, introduced into Parliament. |
| February – August 2024 | Development of any related regulations to support implementation of GIs Act reforms. This is likely to involve further public consultation. |
| Q3– Q4 2024 | * FTA implementation Bill enacted. * EU-NZ FTA ratified. * New GIs Act and EU-NZ FTA enters into force. |

## 1.7 Protection for traditional knowledge

1. The Waitangi Tribunal, in its report *Ko Aotearoa Tēnei,* observed that there is debate around whether a broader GIs registration regime than what is provided under the GIs Act would offer a possible solution for the protection of traditional knowledge. Although GIs can, like trade marks, be a tool for economic development for Māori, the Tribunal considered that GIs can only indirectly protect the kaitiaki interest in mātauranga Māori and taonga works.[[13]](#footnote-13)
2. The proposals in this document, to reform the GIs registration regime for EU-NZ FTA GIs, are not intended to resolve issues regarding rights, interests, duties and responsibilities regarding mātauranga Māori, taonga works, taonga species, products derived from taonga species and other taonga. These issues are being considered through the Te Pae Tawhiti, the whole of government work programme led by Te Puni Kōkiri.
3. The period for implementing EU-NZ FTA obligations may mean we need to revisit the GIs Act at a later date to align with Te Pae Tawhiti. The GIs Act reform needed to implement the EU-NZ FTA will be considered within the Te Pae Tawhiti work to ensure conversations between Māori and the Crown on the Te Pae Tawhiti work programme are not prejudiced.
4. We will be building upon previous Māori engagement by MFAT during EU-NZ FTA negotiations around the protection of GIs, and Te Pae Tawhiti engagement from early 2023, through a series of hui with interested individuals, bodies and iwi.

## 1.8 We are seeking your feedback on

|  |  |
| --- | --- |
| **2 EXTENDING THE SCOPE OF THE REGISTRATION REGIME FOR GEOGRAPHICAL INDICATIONS** | |
| 2.2 | Whether the registration regime for wine and spirits GIs should be extended to other products? |
| **3 ENFORCEMENT OF GEOGRAPHICAL INDICATIONS** | |
| 3.5 | How should civil enforcement action be provided? |
| 3.6 | How should administrative enforcement action be provided? |
| **4 OTHER ISSUES** | |
| 4.1 | Whether New Zealand should have a GIs logo to indicate a product is protected by a GI (as the EU do)? |
| 4.2 | Feedback on the use of New Zealand’s enduring GIs for spirits. |
| 4.3 | Options for cost recovery for administering the regime following entry into force of the EU-NZ FTA. |
| 4.4 | Are there any other issues with the GIs Act? |

# Extending the Scope of the Registration Regime for Geographical Indications

## 2.1 Background

1. Currently the GIs Act only provides for wine and spirits GIs to be registered. As discussed above in paragraph 29, the decision to implement the GIs regime was to assist in safeguarding market access for New Zealand wine in the EU market and facilitate the wine industry registering their GIs overseas.
2. Many countries that provide a registration regime for GIs protection will only allow foreign GIs to be registered if they are formally recognised as GIs in their country of origin. Because certain New Zealand wine GIs have been registered under the GIs Act, the EU has agreed to protect those GIs in the EU under the EU-NZ FTA to the same standard New Zealand has agreed to protect EU GIs. Furthermore, New Zealand has agreed to a reciprocal arrangement with the EU that up to 30 GIs can be added to the register of the other party every three years. We want to understand what value, if any, this may provide New Zealand producers who either export into the EU or plan to.
3. Although the large majority of the EU GIs that New Zealand has agreed to protect are for wine and spirits, some are for food and other beverages (eg beer). Expanding our regime to protect other types of EU GIs is an opportunity to review the effectiveness of our domestic measures to determine if there is sufficient demand to extend the scope of the registration regime under the GIs Act to protect GIs used for other products. Any extension would not necessarily need to be confined to GIs for food and beverages.

## 2.2 Discussion

1. We are interested in hearing about any economic and social benefits for New Zealand in permitting local (and foreign) producers of products other than wines or spirits to register their GIs under the GIs Act. This includes understanding whether expanding the scope of the registration regime to other products would:
   1. contribute to the development and continued growth of, and innovation in, other industries in New Zealand
   2. provide a sound trading and marketing environment that facilitates trade in those products
   3. protect the interest of New Zealand consumers
   4. support the protection of mātauranga Māori, taonga works, taonga species, products derived from taonga species and other taonga.
2. There would be costs to the Government, including opportunity costs, to extend the scope of registration regime under the GIs Act to other products. It will be important to establish that the benefits for doing so exceed these costs.
3. If submissions indicate there is a good case for extending the registration regime, we will seek Cabinet approval to consult further on the details of an extended regime.

|  |  |
| --- | --- |
|  | Are there products other than wines and spirits being produced in New Zealand that are labelled with a name that indicates the products have a characteristic that is essentially attributable to its geographical origin? Are any of these products being exported and, if so, to where, and what export revenues do these products generate for New Zealand producers? |
|  | Is the inability to register these names under the GIs Act creating any barriers and, if so, what? |
|  | What would be the advantages (or disadvantages) of extending the current registration regime to include GIs for food and beverages other than wine and spirits? |

# Enforcement of Geographical Indications

## 3.1 Background

1. This section deals with the enforcement of registered GIs under the proposed new GIs regime. Enforcement is taking action to address misuse of registered GIs (ie infringement of GIs).
2. Civil enforcement refers to the ability to take legal action through the courts against infringement of a GI. Administrative enforcement refers to legal action through the courts that a government enforcement agency, such as the Commerce Commission, may take to address infringement of a registered GI.

## 3.2 Status quo

1. The GIs Act states anyone who infringes a registered GI contravenes section 9 of the Fair Trading Act.[[14]](#footnote-14) This means the Fair Trading Act’s provisions concerning enforcement and remedies apply.
2. The Fair Trading Act enables any person, including the Commerce Commission, (the **plaintiff**) to take court action to address a contravention of the Act, including a registered GI. Where the court determines that the alleged infringer (the **defendant**) has infringed a GI, it may grant an injunction restraining the defendant from further infringement.[[15]](#footnote-15) The court may also order the defendant pay the amount of loss or damage the plaintiff suffered from the infringement.

## 3.3 Why review the enforcement provisions?

1. The enforcement provisions under the GIs Act to address infringement of a registered GI through the Fair Trading Act are unique and not found in any of the other intellectual property statutes (such as the *Patents Act 2013* and the Trade Marks Act).
2. The enforcement provisions of the Fair Trading Act for infringement of a registered GI have not been reviewed since the GIs Act was enacted in 2006. We are unaware of any enforcement action (including by the Commerce Commission) being taken through the courts under the Fair Trading Act to address an infringement of a registered GI since the GIs Act was implemented in 2017. This prevents us measuring the effectiveness of the enforcement provisions for addressing any infringement of a registered GI.
3. The small number of registered GIs (currently 27) for wine and spirits may be a contributing factor to the absence of anyone taking enforcement action. However, the outcome of the EU-NZ FTA requiring us to protect 2,133 EU GIs across a wide range of food and beverages, some of which are being used as common descriptive names for a particular type of product (eg ‘feta’ and ‘port’) will increase the risk that a registered GI, particularly a EU GI, will be infringed. It is important therefore that our enforcement provisions are sufficiently effective and efficient to ensure the integrity of the regime.
4. We can look to information on the effectiveness of the enforcement provisions for registered trade marks where there is more enforcement activity. The Trade Marks Act also provides a wider range of remedies to address infringements and in recent years new enforcement measures have been implemented to improve the effectiveness of enforcement action and to deter future infringements. These are discussed below.

## 3.4 International requirements related to enforcement

1. The EU-NZ FTA requires New Zealand to provide two forms of enforcement measures:
   1. civil enforcement – the legal means for interested persons to prevent the infringement of an EU GI[[16]](#footnote-16)
   2. administrative enforcement – the legal means for an agency, with or without receipt of a request from an interested person, to prevent the infringement of an EU GI by using “appropriate administrative and judicial steps”.[[17]](#footnote-17)
2. The EU-NZ FTA (similar to other FTAs) includes a section setting out general obligations related to the enforcement of intellectual property rights, including GIs. These are:
   1. ensuring enforcement procedures permit effective action to be taken against any act of infringement
   2. providing expeditious remedies that constitute a deterrent to further infringements
   3. providing for courts to order certain remedies to address infringement, including:
      * injunctions to restrain or prevent a person from infringing
      * either compensation for any injury suffered by the infringement or the profits the infringer made from their infringing actions
      * in relation to trade marks infringement additional (eg punitive) damages, delivery and disposal of infringing goods, and erasure or removal of infringing trade marks from goods.
   4. border protection measures enabling suspected infringing goods to be detained at the border by the New Zealand Customs Service (**Customs**).
3. The following issues are considered in this section of the discussion paper:
   1. how should civil enforcement action through the courts be provided for?
   2. which court should hear proceedings for infringement of a registered GI?
   3. who should be able to take legal action through the courts?
   4. what remedies should the courts be able to order?
   5. what should be the procedures for implementing border protection measures?
   6. who should be able to lodge a Customs notice?
   7. how administrative enforcement should be provided for and in particular:
      * what investigative powers should be available?
      * what remedies should the courts be able to order?

## 3.5 Providing for civil enforcement action

### How should civil enforcement action through the courts be provided for?

#### Background

1. The infringement of a GI is a contravention of the Fair Trading Act and the enforcement and remedies of that Act apply. The approach of deeming an infringement of a registered GI as a contravention of another statue is unique in IP statutes.
2. When the registration regime was small (27 registered GIs), it made sense to use the enforcement provisions of another Act. With the significant change in the number of GIs registered, and an increased likelihood of enforcement action being taken, it is timely to review where the enforcement provisions for addressing the infringement of a registered GI should be found. We consider there are three options:
   1. Option i (in the Fair Trading Act - *status quo*): continue to provide that infringement of a GI is deemed a breach of the Fair Trading Act and apply the provisions of that Act
   2. Option ii (in the Trade Marks Act): provide that infringement of a GI is deemed an infringement of a trade mark under the Trade Marks Act and the provisions of that Act apply
   3. Option iii (in the GIs Act – *preferred option*): provide specific procedures and provisions for the infringement of a GI in the GIs Act.

#### Option i: Infringement of a GI is a breach of the Fair Trading Act (*status quo*)

1. The remedies available under the Fair Trading Act are limited compared to the remedies available for the infringement of a trade mark under the Trade Marks Act. For example, the Fair Trading Act does not provide for the erasure or removal of the infringing GI from a product or its packaging, nor for the delivery up and disposal of infringing goods. Other remedies available under the Trade Marks Act include the ability of the courts to order the infringer to pay the plaintiff the profits the infringer obtained through the infringing activity and/or order the infringer to pay additional damages as a deterrent to future infringements.
2. If these additional remedies were considered appropriate, they could be added into the Fair Trading Act specifically for addressing the infringement of a GI. However, given this Act has substantial enforcement provisions already, it may unnecessarily make the Act more complex and difficult to find and understand how registered GIs are enforced.

#### Option ii: Infringement of a GI is deemed an infringement under the Trade Marks Act

1. Under this option an infringement of a registered GI would be deemed an infringement of a registered trade mark under section 89 of the Trade Marks Act and the enforcement provisions would apply.
2. The advantage of this option is that all the remedies available to address an infringement of a trade mark would also be available to address any infringement of a GI, including the ability of the courts to order:
   1. account of profits of the infringer
   2. payment of additional damages (eg punitive damages for wilful infringement) to deter future infringements
   3. erasure or removal of infringing GI from products and their packaging
   4. delivery up and disposal of infringing goods.
3. Like option i, including the remedies in the Trade Marks Act may make it more difficult for anyone wanting to take legal action to find and understand the enforcement provisions.

#### Option iii: Specific infringement provisions in the new GI legislation (*preferred option*)

1. Under this option there would be specific procedures and provisions for addressing an infringement of a GI in the new GIs Act. This is our preferred approach and one that is consistent with the approaches taken in other IP statutes, including the *Copyright Act 1994* (the **Copyright Act**), the *Patents Act 2013* (the **Patents Act**) and the Trade Marks Act. It is also an approach that we consider would make it easier for anyone to find and understand how registered GIs can be enforced.
2. This option has the added advantage of enabling enforcement provisions to be more easily tailored for providing effective enforcement of registered GIs.

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|  | Do you agree with our preferred option (Option iii) of providing provisions for the enforcement of GIs within the GIs Act? If not, where should these provisions be and why? |

### Which court should hear proceedings for infringement of a registered GI?

#### Background

1. There appear to be two feasible forums concerning who should hear and determine infringement proceedings for registered GIs - either the District Court or High Court. Another possibility considered, but discarded, would be for the GIs Act to specify the Disputes Tribunal as the venue for enforcing GIs. This option was discarded because the *Disputes Tribunal Act 1988* excludes the Tribunal considering disputes involving intellectual property rights. Some issues associated with determining IP-related disputes, particularly in regard to infringement, are considered too complex for the Tribunal to resolve.
2. However, nothing should prevent parties to an infringement of a registered GI using alternative dispute resolution services (such as mediation) or reaching a settlement without requiring a determination of any court or tribunal.
3. This would mean that there are three options for the new GIs Act:
   1. Option i: not specify which court is to be used (ie it would be either the District Court or the High Court depending on the amount the plaintiff seeks from the defendant by way of compensation for the injury)[[18]](#footnote-18)
   2. Option ii: specify the District Court
   3. Option iii: specify the High Court.

#### Discussion

1. The approach of specifying the High Court would be consistent with the approach taken in the Trade Marks Act and the Patents Act. However, it is worth noting that the Copyright Act does not specify a court for copyright infringements, therefore the plaintiff has some discretion over which court to use.
2. The main advantage of Option i (the approach of not specifying a court in the legislation) is it would, like the Copyright Act, allow the plaintiff to determine which court to commence infringement proceedings in.
3. We would like to better understand what factors plaintiffs might consider when choosing which court to bring proceedings for the infringement of a GI.

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|  | Which option do you prefer for the court(s) to hear and determine the infringement of a registered GI, and why? |

### Who should be able to take legal action through the courts?

#### Background

1. The EU-NZ FTA specifies New Zealand must provide the legal means for an interested person to prevent infringement of a EU GI.[[19]](#footnote-19) Other international agreements require New Zealand to make available to “right holders”[[20]](#footnote-20) civil judicial procedures concerning the enforcement of any IP right, including GIs.
2. As a general rule, the intellectual property statutes provide only for right holders to take legal action to enforce their IP rights. However, registered GIs, being a collective right, do not have an identifiable owner, but do have “interested persons” who for the purposes of the GIs Act are able to take legal action.
3. The Fair Trading Act allows any person to take legal action against anyone contravening section 9 and by default anyone can take legal action to enforce a registered GI.
4. We are considering three options regarding who should be able to take legal action to enforce a registered GI:
   1. Option i: any person, whether a legal or natural person (*status quo*)
   2. Option ii: the person in whose name the GI is registered (the **registrant**)[[21]](#footnote-21)
   3. Option iii: any person who has an interest in preventing or stopping a GI from being infringed (an **interested person**), eg an individual producer who uses the GI or a producer body who may oversee the use of the GI (*preferred option*).

#### Discussion

1. Options i and iii are similar in approach, in that any person who considers that they have been injured (eg suffered damage to their business) by infringement of a registered GI would be someone who has an interest in preventing or stopping that infringement. However, option i would also allow anyone not injured to take legal action. This enables a potential business competitor to abuse the infringement proceedings by, for example, initiating court action to harass and deter competition from another producer or business. [[22]](#footnote-22)
2. Option ii of limiting who can commence proceedings to registrants has the advantage of clearly specifying who is responsible for commencing legal proceedings to stop or prevent someone from infringing a GI. However, its key disadvantage is that there will no “registrant” for the 2,133 EU GIs that have to be registered under the new GIs Act. EU producers with an interest in EU GIs protected under the EU-NZ FTA would, therefore, not be able to take legal proceedings against the infringement of their GIs in contravention of the EU-NZ FTA.[[23]](#footnote-23) This means that they would have to rely on a government agency taking administrative enforcement action on their behalf.
3. Option iii is our preferred option as it gives the plaintiff the discretion to determine which is the appropriate forum to commence legal action.

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|  | Do you agree with our preferred option (Option iii) to limit persons who may initiate civil action for the enforcement of GIs to “interested persons”? If not, who do you think should be able to take legal action and why? |

### What remedies should the courts be able to order?

#### Background

1. The Fair Trading Act provides for the courts to order an injunction restraining the defendant from further infringing the GI and/or order them to pay the plaintiff the amount of loss or damage they suffered as a consequence of them infringing the GI. However, as also discussed above, the Trade Marks Act provides for other remedies that may be useful to remedy an infringement. They include:
   1. account of profits of the infringer
   2. payment of additional damages (eg punitive damages for wilful infringement) to deter future infringements
   3. erasure or removal of infringing GI from products and their packaging
   4. delivery up and disposal of infringing goods.

#### Discussion

1. Because GIs are a collective right, it may not be possible to establish who has been injured and, therefore, who the defendant should be ordered by the courts to pay compensation to. In a worse case situation, the only remedy that courts may be able to order is an injunction restraining defendant from further infringing a registered GI. This is unlikely to be an effective deterrent.
2. We consider that, if the GIs Act was to provide a greater range of potential remedies, it would give the courts more flexibility to effectively and efficiently address any infringement of a registered GI and assist in deterring future infringements of registered GIs. This would align with the general obligations found in our international trade agreements for intellectual property rights (paragraph 58).

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|  | What would be the advantages (or disadvantages) of providing the same remedies to address an infringement of a GI as are provided under the Trade Marks Act for the infringement of a trade mark? |
|  | What other remedies (other than those provided for under the Trade Marks Act) should be adopted for addressing the infringement of a GI and why? |

### What should be the procedures for implementing border protection measures?

1. Procedures for lodging a Customs notice in respect of trade marks and copyright are provided for in the Trade Marks Act and the Copyright Act. They enable Customs to temporarily detain suspected infringing goods for a short period of time (3 or 10 working days depending on whether the right holder has filed a notice with Customs) to allow a right holder to initiate court proceedings against the importer or exporter, for infringing a copyright or a registered trade mark.[[24]](#footnote-24)
2. If court proceedings are not initiated within this time, Customs must release the goods to their intended destination. Although these procedures may be initiated by Customs without a notice from a right holder, they are predicated on Customs receiving a notice from a rights holder to allow Customs to detain the suspected infringing goods longer than three working days.
3. The EU-NZ FTA requires border protection measures to also be available for registered GIs. We are wanting your views on what procedures are needed for lodging and dealing with Customs notices under the new GI legislation.
4. GIs are very similar to trademarks, in that, like trade marks, GIs will appear on the labels or packaging of a product. This suggests that the procedures related to the lodging of Customs notices for trade marks are likely to work well for GIs.[[25]](#footnote-25)
5. The alternative would be to develop new procedures for dealing with Customs notices related to GIs. However, any such new procedures would probably not differ much from the procedures connected with trade marks related notices. Any differences may well mean increased costs and complexity for Customs and businesses filing notices with them in implementing the different procedures for GIs.
6. This suggests the only viable approach is to adapt the existing procedures relating to trade marks Customs notices for use with GIs. This is therefore our preferred approach to meeting EU-NZ FTA obligations to provide border protection measures for GIs.

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|  | Do you agree on basing the border protection measures for GIs on the Trade Marks Act? If not, what other measures should be adopted instead? |
|  | If the border protection measures based on the Trade Marks Act were to be adopted for GIs, what changes (if any) should be made to those measures and why? |

### Who should be able to lodge a Customs notice?

1. The Trade Marks Act and the Copyright Act provide for the trade mark and copyright owners, and in certain situations licensees, to lodge notices with Customs to detain goods that infringe a trade mark or copyright. There appear to be two viable options for who should be able to lodge a notice with Customs in respect of detaining suspected GI infringing goods:
   1. Option i: permit anyone to lodge a Customs notice
   2. Option ii: permit only interested persons, who may be a producer who uses the GI, a producer body or registrant to lodge a Customs notice (*preferred option*).
2. Providing that any person can lodge a Customs notice would appear to have disadvantages as stated above regarding who should be permitted to commence civil enforcement. For this reason we prefer option ii.

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|  | Do you agree with the preferred option of limiting persons who may lodge a notice with Customs to those persons who have an interest in the GI concerned? If not, who should be able to and why? |

## 3.6 Providing administrative enforcement for GIs

### Status quo

1. As discussed above in paragraphs 51 and 52, any action to address the infringement of a registered GI needs to be taken under the Fair Trading Act. Although the government has not made the Commerce Commission responsible for enforcing registered GIs, the Fair Trading Act provisions do not prevent it from taking action to enforce a registered GI (as an infringement of a registered GI is deemed to be a contravention of section 9 of the Fair Trading Act).[[26]](#footnote-26),[[27]](#footnote-27)

### EU-NZ FTA requirement

1. The GIs commitments in the EU-NZ FTA requires New Zealand to provide for the enforcement of the EU GIs listed in the agreement, with or without receiving a request of an interested person, “in accordance with its laws and regulations by appropriate administrative and judicial steps”.[[28]](#footnote-28) The EU-NZ FTA does not define who would be an “interested person” or what are appropriate administrative and judicial steps. New Zealand is free to determine the appropriate method of implementing the obligation within our legal system and practice.[[29]](#footnote-29)
2. The obligation to provide administrative enforcement for GIs can only be met in two ways. Either a new enforcement agency would need to be created for this responsibility or an existing agency would need its roles and functions expanded to include the administrative enforcement of GIs.
3. There does not appear to be evidence of regular or ongoing infringement of GIs by producers, wholesalers, or retailers, and the like, or that infringement of GIs would become common after entry into force of the EU-NZ FTA. Accordingly, there appears to be no justification for the expense of setting up and maintaining a new agency solely for the purpose of providing administrative enforcement of GIs. Therefore, it is more likely that the function will be given to an existing agency.
4. This section of the discussion paper explores what appropriate administrative and judicial steps might be to enforce GIs. We are not consulting on the issue of who should be responsible for providing administrative enforcement. This will be a decision for Cabinet to make following interagency consultations around who would be best placed to take on this role.

### Providing appropriate administrative and judicial steps

1. For the purpose of this discussion paper administrative and judicial steps concern:
   1. how an agency (who is responsible for enforcing GIs) would gather relevant information and evidence that a person has contravened the restrictions concerning the use of a registered GI
   2. the remedies the courts may order to address infringement of a GI and provide a deterrent against others misusing registered GIs in the future.
2. The Fair Trading Act is an example of a statute that provides both administrative and judicial steps. It provides a useful starting point for what administrative and judicial steps could address the infringement of a registered GI.

### What investigative powers should be available?

1. The Fair Trading Act provides for the Commerce Commission to gather appropriate information and evidence by the following means:
   1. warranted search power[[30]](#footnote-30) to search any place specified in the warrant where there are reasonable grounds to believe that a search is necessary for the purpose of gathering, obtaining or recovering evidence of:
      * conduct that constitutes a contravention of the Fair Trading Act or
      * the nature or extent of any conduct that constitutes a contravention of the Fair Trading Act
   2. the power to require a person to supply information or documents or give evidence either orally or in writing.[[31]](#footnote-31)
2. The Commerce Commission may also authorise an employee to monitor and enforce compliance with any consumer information standards, product safety standards, unsafe goods notices, suspension of supply notices, or services safety notices that apply to any relevant goods.[[32]](#footnote-32) This enables the employee to enter retail places that the public can access to inspect, photograph and purchase goods being offered for sale, and require persons in charge of the place to provide certain information regarding the supply and dispatch of goods.
3. We consider that any agency responsible for the administrative enforcement of registered GIs should have access to a similar range of investigative powers that are currently available to the Commerce Commission under the Fair Trading Act.

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|  | What would be the advantages (or disadvantages) of providing the same investigative powers currently available to the Commerce Commission under the Fair Trading Act to the agency responsible for providing the administrative enforcement of GIs? Are there any other investigative powers that should be provided instead? |

### What remedies should the courts be able to order?

1. The Fair Trading Act sets out a number of different types of remedies that courts may order, including:
   1. injunctions, and interim injunctions, restraining a person from engaging in a particular conduct
   2. payment of compensation for any injury, loss or damage to another person.
2. However, as discussed above regarding civil enforcement of GIs, there are other remedies, especially those available for the infringement of a registered trade mark, that are likely to be useful to address a contravention of the restrictions on the use of a GI including:
   1. payment of additional damages[[33]](#footnote-33), as the justice of the case requires and, in particular, to reflect:
      * the flagrancy of the infringement and
      * any benefit accruing to the defendant by reason of the infringement
   2. erasure or remove of an infringing sign[[34]](#footnote-34)
   3. delivery and disposal of infringing goods, as the court may direct.[[35]](#footnote-35)
3. We consider that in providing judicial steps for the enforcement of GIs, the same remedies that are made available for civil enforcement action as described above should be available for the administrative enforcement of GIs.
4. We also consider the courts should have the ability to order a person who has infringed a GI to pay to the Crown the profits of any infringing activity, as an alternative to paying damages to lawful GI users, as a deterrent to any future misuse of the GI. This is because GIs are essentially a collective right.
5. It may be difficult for the agency undertaking administrative enforcement to, for example, gather evidence of any damage that has occurred from infringing activity. The ability for the courts to determine that the defendant pay damages would rely on evidence being provided setting out:
   1. who are the producers who have been injured by the infringement of a registered GI
   2. the extent, if any, that those producers have been injured and therefore should be compensated for that injury.
6. Without this evidence, it would be difficult for the courts to order the defendant to pay an amount in damages to affected producers. This could leave the only remedy that the courts can order for misuse of a GI to be an injunction preventing that person from using the GIs. An injunction, on its own, may provide little deterrent to GIs being infringed, especially if infringers can keep the profits from their infringing actions or are not required to pay compensation to injured users of the GI.

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|  | What remedies should the courts be able to grant arising from administrative enforcement of GIs and why? |

# Other issues

## 4.1 Use of specific logo for registered GIs to aid consumer recognition of the GI and related product

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1. Producers in the EU who have had their product names protected as GIs are able to use on their labels and packaging an official logo (see below) informing consumers that the product has been produced in accordance with the product specification of the protected GI.
2. We would like to understand whether there would be any benefits for New Zealand producers who have registered a name as a GI to also being permitted to use some kind official logo to clearly indicate to consumers that the product bearing the GI qualifies to do so.

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|  | What would be the advantages (or disadvantages) for the GIs Act to provide for producers to use an official logo on their labels and packaging that verifies the GI has been registered? |

## 4.2 Feedback on use of New Zealand’s enduring GIs for spirits

1. The GIs Act deems the names ‘New Zealand’, ‘North Island’ and ‘South Island’ as enduring GIs for both wines and spirits. We are unaware of any New Zealand spirits producers using these names as a GI. If the names are not being used as GIs, there appears to be little benefit retaining the names as GIs for spirits. Considering five years have passed since the GIs Act was implemented, we are using this discussion paper to gather information from spirits producers about their use of the enduring GIs to get an idea of what, if any, value is being derived.

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|  | Are any of the enduring GIs (ie ‘New Zealand’, ‘North Island’ and ‘South Island’) being used by New Zealand spirits producers? If so, who is using them? Please provide examples of use. |
|  | If the enduring GIs are not being used for spirits, what would be the advantages (or disadvantages) arising from repealing their protection under the GIs Act? |

## 4.3 How will the costs of administering the regime be recovered?

1. Government policy on cost recovery for IPONZ to administer the various intellectual property statutes require its costs to be fully recovered from the beneficiaries of those regimes. Currently it costs a person $5,000 to apply to register a GI. Once a GI is registered, a registration renewal fee of $2,000 must be paid after five years and then a subsequent registration renewal fee of $500 must be paid for every subsequent period of 10 years. Since the GIs Act came into force in 2017 24 GIs (excluding the enduring GIs) have been registered with the majority of applications having been received in 2017. Of the total registrations, 18 are New Zealand wine GIs, four are foreign spirits GIs and two are foreign wine GIs.
2. The EU-NZ FTA requires that 2,133 EU GIs and any future EU GIs (up to an additional 30 GIs every three years) must be protected, including providing administrative enforcement for them, with no fees payable by the EU or its producers. EU producers cannot, for example, be required to pay any registration renewal fees to maintain GIs protection in New Zealand.
3. Under the Government’s cost recovery policy the cost for administering the new GIs Act, which would provide protection for 2,133 EU GIs, would largely fall upon New Zealand wine producers and a small number of foreign producers.
4. We will need to do further work to develop options for recovering the cost of administering a new GIs Act, including recovering the cost of providing administrative enforcement, that would satisfy the principles of equity, efficiency, justifiability and transparency public organisations must consider when making any decisions on setting and administering fees and levies.

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|  | How might the costs to administer the GIs Act be recovered and from whom? |

## 4.4 Are there other issues with the GIs Act?

1. Although this discussion paper covers a range of issues with implementing a new GIs registration regime, including meeting new GIs obligations under the EU-NZ FTA, it is also an opportunity to consider changes to address any other problems with the current GIs Act or the proposed new registration regime.

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|  | Are there any other problems with the current GIs Act or proposed new GIs registration regime? What changes, if any, should be considered? |

# Next Steps

1. Once the consultation has closed we will use the information gathered to make recommendations to the Minister of Commerce and Consumer Affairs on:
   1. changes to the GIs Act needed to implement the EU‑NZ FTA and ensure effective enforcement measures are in place
   2. if we should undertake further consultation on whether the registration regime for wine and spirits GIs should be extended.
2. We expect to be able to make these recommendations in mid-2023. This will keep implementation of EU-NZ FTA on track for expected dates for signature and ratification.
3. Once ratified and in force the changes will be monitored, evaluated, and reviewed in line with good regulatory stewardship principles. However, there are a range of constraints, including:
   1. Monitoring: There are limitations on the availability of data to assess the effectiveness of the changes. This is primarily due to the nature of private legal action and a lack of available data in the public domain related to private parties taking legal action.[[36]](#footnote-36) However, with the introduction of administrative enforcement there is a potential for more data to become available to assist with monitoring the enforcement provisions.
   2. Evaluation: The quality of the evidence on the performance of the revised GIs Act will have “knock on” effects for evaluating the effectiveness of the changes as it will be based on partial data and we may have to rely on some anecdotal evidence.
   3. Review: The obligations under the EU-NZ FTA to protect EU GIs that need to be implemented into the GIs Act can only be reviewed as part of a review of the EU-NZ FTA. Currently, the majority of GIs being protected under the EU-NZ FTA are not being used by EU producers on products exported to New Zealand.[[37]](#footnote-37) A review of the EU-NZ FTA would only occur where both the EU and NZ agreed to undertake such a review.
4. Non-EU-NZ FTA issues raised in this paper will be evaluated on the responses received during this round of consultation and, if more work needs to be done, we will seek appropriate approval to undertake further consultation to review what further changes to the GIs Act should be made.

# Recap of questions

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|  | Are there products other than wines and spirits being produced in New Zealand that are labelled with a name that indicates the products have a characteristic that is essentially attributable to its geographical origin? Are any of these products being exported and, if so, to where, and what export revenues do these products generate for New Zealand producers? |
|  | Is the inability to register these names under the GIs Act causing any problems and, if so, what? |
|  | What would be the advantages (or disadvantages) of extending the current registration regime to include GIs for food and beverages other than wine and spirits? |
|  | Do you agree with our preferred option (Option iii) of providing provisions for the enforcement of GIs within the GIs Act? If not, where should these provisions be and why? |
|  | Which option do you prefer for the court(s) to hear and determine the infringement of a registered GI, and why? |
|  | Do you agree with our preferred option (Option iii) to limit persons who may initiate civil action for the enforcement of GIs to “interested persons”? If not, who do you thinks should be able to take legal action and why? |
|  | What would be the advantages (or disadvantages) of providing the same remedies to address an infringement of GI as are provided under the Trade Marks Act for the infringement of a trade mark? |
|  | What other remedies (other than those provided under the Trade Marks Act) should be adopted for addressing the infringement of a GI and why? |
|  | Do you agree on basing the border protection measures for GIs on the Trade Marks Act? If not, what other measures should be adopted instead? |
|  | If the border protection measures based on the Trade Marks Act were to be adopted for GIs, what changes (if any) should be made to those measures and why? |
|  | Do you agree with the preferred option of limiting persons who may lodge a notice with Customs to those persons who have an interest in the GI concerned? If not, who should be able to and why? |
|  | What would be the advantages (or disadvantages) of providing the same investigative powers currently available to the Commerce Commission under the Fair Trading Act to the agency responsible for providing administrative enforcement of GIs? Are there any other investigative powers that should be provided instead? |
|  | What remedies should the courts be able to grant arising from administrative enforcement of GIs and why? |
|  | What would be the advantages (or disadvantages) for the GIs Act to provide for producers to use an official logo on their labels and packaging that verifies the GI has been registered? |
|  | Are any of the enduring GIs (ie ‘New Zealand’, ‘North Island’ and ‘South Island’) being used by New Zealand spirits producers? If so, who is using them? Please provide examples of use. |
|  | If the enduring GIs are not being used for spirits, what would be the advantages (or disadvantages) of repealing their protection under the GIs Act? |
|  | How might the costs to administer the GIs Act be recovered and from whom? |
|  | Are there any other problems with the current GIs Act or proposed new GIs registration regime? What changes, if any, should be considered? |

1. Article 22.1 of the World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property Rights. [↑](#footnote-ref-1)
2. These are taken from the United Kingdom Scotch Whisky Regulations 2009. [↑](#footnote-ref-2)
3. These persons are “interested persons” when we discuss later who can bring enforcement action. [↑](#footnote-ref-3)
4. Details of the registration system can be found at [Geographical indications | Intellectual Property Office of New Zealand (iponz.govt.nz)](https://www.iponz.govt.nz/about-ip/geographical-indications/). [↑](#footnote-ref-4)
5. [Comprehensive and Progressive Agreement for Trans-Pacific Partnership (CPTPP) | New Zealand Ministry of Foreign Affairs and Trade (mfat.govt.nz)](https://www.mfat.govt.nz/en/trade/free-trade-agreements/free-trade-agreements-in-force/cptpp/). [↑](#footnote-ref-5)
6. [Regional Comprehensive Economic Partnership (RCEP) | New Zealand Ministry of Foreign Affairs and Trade (mfat.govt.nz)](https://www.mfat.govt.nz/en/trade/free-trade-agreements/free-trade-agreements-in-force/regional-comprehensive-economic-partnership-rcep/). [↑](#footnote-ref-6)
7. Section 3 of the GIs Act. [↑](#footnote-ref-7)
8. *Winesworth Group Ltd v Comité Interprofessionel du Vin de Champagne* [1992] 2 NZLR 327. [↑](#footnote-ref-8)
9. Trade mark registration 1053827. [↑](#footnote-ref-9)
10. The list of GIs can be found at <https://www.mfat.govt.nz/assets/Trade-agreements/EU-NZ-FTA/Chapters/Chapter-18-B-List-of-GIs-Annex.pdf> [↑](#footnote-ref-10)
11. For certain names, such as FETA, PROSECCO, PORT and SHERRY, there will be a transition period after entry into force of the EU-NZ FTA for existing producers to phase out their use of those names. [↑](#footnote-ref-11)
12. Article 18.33 requires the protection of GIs to also apply to use of a GI in transliteration. Transliteration covers the conversion of characters following the phonetics of the original language. [↑](#footnote-ref-12)
13. [Ko Aotearoa Tēnei: A Report into Claims Concerning New Zealand Law and Policy Affecting Māori Culture and Identity, Te Taumata Tuarua (Volume 1) (justice.govt.nz)](https://forms.justice.govt.nz/search/Documents/WT/wt_DOC_68356416/KoAotearoaTeneiTT2Vol1W.pdf)**,** page 92. [↑](#footnote-ref-13)
14. Section 33 of the Fair Trading Act. [↑](#footnote-ref-14)
15. Section 41 of the Fair Trading Act. [↑](#footnote-ref-15)
16. Article 18.33. [↑](#footnote-ref-16)
17. Article 18.36. [↑](#footnote-ref-17)
18. The District Court would be limited to proceedings where the damages sought are less than $350,000. [↑](#footnote-ref-18)
19. Article 18.33. [↑](#footnote-ref-19)
20. A rights holder means the owner of an IP right and in certain circumstances their licensee(s). [↑](#footnote-ref-20)
21. The GIs Act deems the person who applied to register a GI the registrant for the purpose of being responsible for maintaining the registration of the GI, including paying registration renewal fees. In respect of EU GIs to be protected under EU-NZ FTA there is no registrant. [↑](#footnote-ref-21)
22. The court, under its own jurisdiction, has the ability to refuse or decline any application it considers to be vexatious or frivolous. [↑](#footnote-ref-22)
23. Article 18.33. [↑](#footnote-ref-23)
24. <https://www.customs.govt.nz/business/import/import-prohibited-and-restricted-imports/copyright-and-trade-marks/> [↑](#footnote-ref-24)
25. Sections 135 to 157 of the Trade Marks Act. [↑](#footnote-ref-25)
26. Any request to the Commerce Commission to take action against a contravention of the Fair Trading Act would be assessed on the basis of the Commission’s enforcement [guidelines](https://comcom.govt.nz/about-us/our-policies-and-guidelines/investigations-and-enforcement/enforcement-response-guidelines). [↑](#footnote-ref-26)
27. Ordinarily the IP statutes explicitly limit who can undertake enforcement action to IP owners and in certain cases licensees. The Commerce Commission could not, therefore, be made responsible for enforcing other forms of IP rights without further amendment of those statutes. [↑](#footnote-ref-27)
28. Article 18.36. [↑](#footnote-ref-28)
29. Article 18.2.2. [↑](#footnote-ref-29)
30. Section 47 of the Fair Trading Act 1986. [↑](#footnote-ref-30)
31. Section 47G of the Fair Trading Act 1986. [↑](#footnote-ref-31)
32. Section 47K of the Fair Trading Act 1986. [↑](#footnote-ref-32)
33. Section 106 of the Trade Marks Act 2002. [↑](#footnote-ref-33)
34. Section 108 of the Trade Marks Act 2002 [↑](#footnote-ref-34)
35. Section 109 of the Trade Marks Act 2002. [↑](#footnote-ref-35)
36. Often complaints about the infringement of an IP right are settled without parties resorting to court action. [↑](#footnote-ref-36)
37. Many of the EU products for which their GIs are protected are low volume “niche” products produced by small EU producer groups. [↑](#footnote-ref-37)