

EU-NZ Free Trade Agreement: Reform of Geographical Indications Law in New Zealand – Discussion Paper

Your name and organisation

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Responses to questions

	Section	Question
1	<i>Registration of geographical indications</i>	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?
2	<i>Registration of geographical indications</i>	Is the inability to register these names under the GIs Act causing any problems and, if so, what?
3	<i>Registration of geographical indications</i>	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?
		<p>IPTA considers that there are advantages in extending the current regime to include GIs for food and beverages other than wine and spirits. Although GIs for food and beverages other than wine and spirits may currently be registrable in New Zealand as collective or certification trade marks under the <i>Trade Marks Act 2002</i> (“Trade Marks Act”) or protectable under the <i>Fair Trading Act 1986</i> (“Fair Trading Act”) and the common law tort of passing off, a specific GI regime is able to be adapted to more accurately achieve the objectives of GI protection (namely, protect the connection between a geographical area and characteristics of a product that are essentially attributable to its connection with that geographical area). For example, the requirement under the <i>Trade Marks Act</i> for there to be an “owner” of a registered trade mark can be problematic in the context of a GI, which is a collective right often without a clearly identifiable owner. Further benefits include providing a strong incentive for producers to invest in marketing and building up a reputation in a registered GI in circumstances where there are safeguards to prevent that reputation from being exploited as well as providing greater transparency to consumers as to the source of food and beverages that is labelled with a GI.</p>
4	<i>Location of enforcement provisions</i>	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?
		<p>IPTA agrees that it is preferable to adopt sui generis legislation to address the infringement of a registered GI and is therefore in favour of Option iii and providing specific procedures and provisions for the infringement of a GI in the GIs Act. Specifically, the enforcement of trade mark rights under the <i>Trade Marks Act</i> or <i>Fair Trading Act</i> are typically contingent on consumer confusion whereas enforcement of a GI right is more likely to concern strict liability or otherwise risk undermining the GI right. Balancing against this are the interests in common food names in which all traders should have a right to use and specific provision for ensuring such use may be required.</p>

	Section	Question
5	<i>Civil enforcement</i>	Which option do you prefer for the court(s) to hear and determine the infringement of a registered GI, and why?
		IPTA considers that the High Court is the appropriate forum to hear and determine infringement proceedings in relation to registered GIs and therefore prefers Option iii (consistent with the approach adopted in the <i>Trade Marks Act</i>).
6	<i>Civil enforcement</i>	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?
		<p>IPTA considers that limiting the right to initiate civil action for enforcement of GIs to “<i>interested persons</i>”, which is defined in paragraph 18 of the Discussion Paper as “<i>any person who produces or trades in products that meet the defined requirements</i>”, is insufficient. However, paragraphs 78 and 79 of the Discussion Paper refer to “<i>any person who has an interest in preventing or stopping a GI from being infringed (an interested person)</i>”, which suggests that Option iii is intended to have broader application.</p> <p>Having considered Options i, ii and iii, IPTA suggests adopting an alternative test (which is an amendment to Option iii), such that the class of persons who may initiate civil action for the enforcement of GIs comprise any person who is potentially appreciably disadvantaged in a legal or practical sense by the alleged infringement of the GI (ie a similar test to the “<i>aggrieved person</i>” test in the context of the right to revoke a registered trade mark – see <i>Ritz Hotel Ltd v Charles of the Ritz Ltd</i> 12 IPR 417), which would include any person who produces or trades in products that meet the defined requirements.</p>
7	<i>Civil enforcement</i>	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?
		IPTA considers that the remedies available under the Trade Mark Act for infringement of a trade mark are also appropriate to address infringement of a GI, in order to achieve the intended objectives of the GI regime. Caution should be exercised in relation to the application of any aggravated damages provision to ensure that conduct caught by such provisions is clearly wilful and inadvertent infringers should not be captured by this provision. Consideration should also be given to safe harbour provisions which permit imported goods from falling foul of the prohibitions where the importer has taken reasonable steps to determine whether the product may be imported under the relevant name.
8	<i>Civil enforcement</i>	What other remedies (other than those provided under the Trade Marks Act) should be adopted for addressing the infringement of a GI and why?
		IPTA considers that orders relating to remedial advertising (similar to the powers granted under s42 of the Fair Trading Act) could also be a useful remedy for the infringement of a GI, in order to address consumer protection considerations.
9	<i>Border protection measures</i>	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?

	Section	Question
		IPTA agrees that border protection measures (similar to those available under the Trade Marks Act) should be available for registered GIs.
10	<i>Border protection measures</i>	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?
		IPTA considers that the definition of those persons entitled to lodge a customs notice would need to be changed in the context of a registered GI (as discussed in response to Question 11).
11	<i>Border protection measures</i>	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?
		IPTA is of the view that Option ii is the preferred option, however the onus should be on the person lodging the notice to satisfy Customs that they have a justifiable interest in the registered GI (eg they produce, trade in or import goods labelled with the registered GI).
12	<i>Administrative enforcement</i>	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?
		IPTA considers that the agency responsible for providing administrative enforcement of GIs should have the same investigative powers that are currently available to the Commerce Commission under the Fair Trading Act, in order to satisfy the obligations imposed on New Zealand by the EU-NZ FTA to protect EU GIs and to ensure that domestically registered GIs receive the same protection.
13	<i>Administrative enforcement</i>	What remedies should the courts be able to grant arising from administrative enforcement of GIs and why?
		IPTA considers that the same remedies that are available for civil enforcement of GIs should be available in the context of administrative enforcement of GIs.
14	<i>Other issues</i> Official GI logo	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?
		IPTA supports the optional use by producers of an official logo on their labels and packaging verifying that a GI has been registered, but considers that mandatory requirements would place an unreasonable compliance burden on producers.
15	<i>Other issues</i> Enduring GIs	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.

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16	<i>Other issues</i> Enduring GIs	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?
17	<i>Other issues</i> Costs	How might the costs to administer the GIs Act be recovered and from whom?
		<p>IPTA considers that it is unreasonable to expect that local producers will bear the costs to administer the GIs Act, in circumstances where the EU-NZ FTA requires that EU GIs must be protected, including providing administrative enforcement, at no cost to the EU or its producers. It is noted that at paragraph 12 of the Discussion Paper one of the objectives for reforming the GIs Act is stated to be to “ensure that domestically registered GIs receive the same protection as that required for EU GIs under the EU-NZ FTA”.</p> <p>Although this approach will require departure from the current government policy of fully recovering costs associated with the administration of intellectual property statutes from the beneficiaries of those regimes, IPTA considers that the economic benefits (including more favourable access to the EU) that are expected to arise as a result of entering into the EU-NZ FTA justify government investment in administering (or partially administering) the GIs Act.</p>
18	<i>Other issues</i>	Are there any other problems with the current GIs Act or proposed new GIs registration regime? What changes, if any, should be considered?