

COMMENTS ON THE KENYA DRAFT GEOGRAPHICAL INDICATIONS BILL

Introduction

The provisions of the Draft Geographical Indications Bill 2007 appear to meet the minimum protection required by Article 22 and Article 23 of the TRIPS agreement. The minimum requirements of the TRIPS agreement are compared with the provisions of the Draft Bill below.

About INTA:

Founded in 1878, INTA is the world's oldest and largest brand owners association. With a membership of over 7,200 companies, INTA represents over 31,000 trademark professionals in diverse capacities: multinational corporations, businesses of all sizes, law firms and other professionals, academic institutions, and not-for-profit organizations from 190 countries. The mission of INTA is to encourage and support best practices and excellence in the field of trademarks and intellectual property, and protection of rights for brand owners and consumers, as well as foster economic growth and innovation through awareness of the importance and development of brands. INTA is dedicated to the support and advancement of trademarks and related intellectual property rights as elements of fair and effective national and international commerce. To achieve this goal, INTA recently unveiled its new Strategic Plan. The 2018-2021 Strategic plan is articulated around the following areas namely: 1) Promote the value of Trademarks and Brands, 2) Reinforce Consumer Trust and 3) Embrace Innovation and Change.

1. Article 22(1) of the TRIPS Agreement provides as follows:

“Geographical indications are, for the purposes of this Agreement, indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin”

A comparable provision in the Draft Bill is clause 2(f), which defines geographical indications as follows:

“Geographical Indication” in relation to goods or services, means a description or presentation used to indicate the geographical origin, in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristics

of goods or services are exclusively or essentially attributable to geographical environment, including natural factors, human factors or both"

The provision in the Draft Bill appears to go beyond the minimum protection required by TRIPS, in that it:

- (i) Extends to goods or services; and
- (ii) A given quality, reputation or other characteristics of goods or services may be exclusively or essentially attributable to geographical environment, including natural factors, human factors or both.

The provision in the Draft Bill also goes beyond protection granted by Council Regulation EC No. 510/2008 on the protection of Geographical Indications and Designations of Origin for Agricultural Products and Foodstuffs, as it explicitly does not cover services.

2. Article 22(2) and 22(4) of the TRIPS Agreement provides as follows:

"In respect of geographical indications, Members shall provide the legal means for interested parties to prevent: (a) the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good; (b) any use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention (1967) . . . The protection under paragraphs 1, 2 and 3 shall be applicable against a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory"

A comparable provision in the Draft Bill is clause 4(b), which provides that:

"Protection under this Act shall be available . . . (b) against a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory"

In addition, clause 19 of the Draft Bill provides as follows:

"Any interested person and any interested group of producers or consumers may institute proceedings in the Tribunal to prevent, in respect of geographical indications, (a) the use of any means in the designation or presentation of goods that indicate or suggest that the goods in question originate in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the goods; (b) any use which constitutes an act of unfair competition within the meaning of Article 1 Obis of the Paris Convention"

The provisions in the Draft Bill appear to meet the minimum protection required by TRIPS.

3. Article 22(3) of the TRIPS Agreement provides as follows:

“A Member shall, e if its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in that Member is of such a nature as to mislead the public as to the true place of origin”

A comparable provision in the Draft Bill is clause 21, which provides that:

“The Registrar of Trade Marks may, on his own motion or at the request of an interested party, after hearing all the parties concerned, refuse or invalidate the registration of a trade mark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trade mark for such goods in Kenya is of such a nature as to mislead the public as to the true place of origin”

The provision in the Draft Bill appears to meet the minimum protection required by TRIPS.

4. Article 23 of the TRIPS Agreement provides as follows:

“1. Each Member shall provide the legal means for interested parties to prevent use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like.

2. The registration of a trademark for wines which contains or consists of a geographical indication identifying wines or for spirits which contains or consists of a geographical indication identifying spirits shall be refused or invalidated, ex officio if a Member's legislation so permits or at the request of an interested party, with respect to such wines or spirits not having this origin.

3. In the case of homonymous geographical indications for wines, protection shall be accorded to each indication, subject to the provisions of paragraph 4 of Article 22. Each Member shall determine the practical conditions under which the homonymous indications in question will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled.”

A comparable provision in the Draft Bill is clause 19(c), which provides that:

“Any interested person and any interested group of producers or consumers may institute proceedings in the Tribunal to prevent, in respect of geographical indications . . . (c) use

of a geographical indication identifying wines, spirits or other goods 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"

In addition, clause 22 of the Draft Bill provides as follows:

"The registration of a trade mark for wines which contains or consists of a geographical indication identifying wines or of a trade mark for spirits or for other goods which contains or consists of a geographical indication identifying spirits shall be refused or invalidated by the Registrar, ex officio or at the request of an interested party, with respect to such wines or spirits not having this origin"

Furthermore, clause 5 provides as follows:

"In the case of homonymous geographical indications for goods, protection shall be accorded to each indication subject to paragraph (b) of Section 4. The Registrar, in cases of permitted concurrent use of such indications, shall determine the practical conditions under which the homonymous indications in question will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled"

The provisions in the Draft Bill appear to meet the minimum protection required by TRIPS.

The Draft Bill also provides for the maintenance of pre-existing trademark rights.

5. Article 16 (1) of the TRIPS Agreement provides as follows

"1. The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use".

Paragraph 6 of the draft law recognizes several grounds upon which to refuse protection of a geographical indication.

We would recommend that two additional grounds for refusal be added, namely:

1. indications which conflict with a prior applied or registered trademark in Kenya; and
2. indications that in whole or in part are generic in Kenya.

While each of these two issues are touched upon in Part VI of the legislation, given that Part VI deals with exceptions to protection, exceptions are sometimes overlooked or not appropriately applied. Consequently, the better place to put these provisions would be in Paragraph 6.

As it relates to the first additional ground (related to refusals based on prior trademarks), this would keep the legislation consistent with TRIPS article 16(1) providing trademark owners with the exclusive rights to prevent conflicting uses of identical or similar signs and the “first-in-time, first-in-right” principle.

As to the second additional ground (genericness refusals), this is fairly common practice and can be found in the United States, the European Union, Japan and many other countries. If an indication is refused registration because it consists “in part” of a generic term, the indication could be registered provided that the applicant disclaims exclusive rights to that portion of the indication that is generic. (See Paragraph 8 comments, below.)

6. Contents of application (Paragraph 8 of the draft bill)

The draft Paragraph 8 requires applicants to submit a dossier of relevant information in order to initiate the registration process. We recommend the addition of a requirement that the applicant carefully define the requested scope of protection. The applicant should be required to identify any translations for which the applicant is seeking protection.

A good model on this particular point is new the Canadian legislation, which requires that an application include “the indication and, if applicable, a translation of the indication . . . to be entered on the list.”

In the case of a compound GI, the applicant should be required to include an explicit disclaimer with respect to any term for which it is not seeking protection and to identify any terms that are a part of the compound name for which the applicant does not have exclusive right-of-use in its home market. (For example, the EU has asserted that holders of the GI “Mortadella Bologna” do not have exclusive rights to use the term “bologna” yet the language in the regulation would call into question whether this is the case or not in Kenya.) Alternatively, the regulation could make clearer that only the GI in full is protected and not individual elements of the GI.

These elements would enable stakeholders to identify clearly any applications that could affect their commercial interests. The lack of such requirements in certain other countries has already led to commercial upheaval and trade complications.

7. Opposition to registration (Paragraph 9(2)(b) of the draft bill)

As to Paragraph 9(2)(b), it provides for opposition to registration of geographic indications “within the prescribed [it appears that the word “time” might have been omitted here].”

We would recommend that the timeframe should be fixed to make sure that adequate time is provided to interested parties to object. If there is discretion in this regard, then the timeframe may be too short to actually have sufficient time to object.

Conclusion

INTA is pleased to have the opportunity to submit comments to the Draft Geographical Indications bill.

If you have any questions, do not hesitate to revert to Tat-Tienne Louembe, Representative, Africa and the Middle East tlouembe@inta.org