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**Council for Trade-Related Aspects
of Intellectual Property Rights**

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REVIEW OF LEGISLATION ON ENFORCEMENT

Questions Posed by New Zealand

By means of a communication from the Permanent Delegation of New Zealand, dated 9 October 1997, the Secretariat has received the following questions for the European Communities and their Member States.

THE EUROPEAN COMMUNITIES AND THEIR MEMBER STATES

European Communities

Table 2 of Document IP/C/W/75 (14 July 1997), identifies for each Member State of the European Communities a number of agencies under the heading "Filing of Complaint". We would be grateful to know whether this means that these agencies self-initiate complaints, or whether they are responsible only to receive complaints? In each case, could the European Communities please specify whether private parties or the authorities are responsible for initiating action to enforce protection of geographical indications.

Germany

The following questions relate to Germany's responses¹ to the Checklist of Issues on Enforcement:

Preliminary Remarks (page 1): Can Germany confirm whether the Trade Mark Law is the only one among those listed which relates to protection of wine geographical indications (GIs)?

Response 9: Could Germany clarify to what extent administrative action is applicable to enforcement of wine geographical indications. Response 9 advises that (in relation to civil protection) "proceedings relating to violation of an intellectual property right are not carried out as administrative proceedings" (except to seize items at the border). And response 18 says that in general customs authorities may only act (to seize articles) on the request of the right holder (rather than on their own initiative). However, response 21 and subsequent replies indicate that all intellectual property rights are also protected by criminal proceedings, including indications of geographical origin. Does this imply that administrative action is used to enforce protection through criminal proceedings?

¹IP/N/6/DEU/1

Response 22: This notes that criminal prosecution of IPR violations occurs only upon request, unless:

- (a) the prosecution authorities deem that ex officio prosecution is justified in view of the particular public interest; or
- (b) the offender acts by way of trade.

Could Germany please specify further:

- (i) the circumstances, if any, in which ex officio prosecution would be deemed justified in the case of wine geographical indications;
- (ii) what action "by way of trade" covers. In the latter case, would ex officio prosecution be automatic?

In addition, we would be grateful if Germany could advise whether, in the absence of (a) and (b), a request alone is sufficient to initiate a criminal prosecution.

Response 24: Could Germany indicate when the possibility of two years' imprisonment or a fine for unlawful use of a geographical indication (as a result of criminal prosecution) is applicable and when civil penalties apply.

Italy

The following questions relate to Italy's responses² to the Checklist of Issues on Enforcement:

Response 9: There is no response to this question on administrative procedures and remedies. We would be grateful if Italy could complete this part of the checklist for enforcement of protection of wine geographical indications.

Response 15: We would be grateful if Italy could confirm whether or not prohibition on release into free circulation by the Customs authorities applies to wine bearing misleading geographical indications.

Response 21: We would be grateful if Italy could clarify whether any of the provisions listed in this reply apply criminal procedures and penalties relating to misleading wine geographical indications.

Spain

The following questions relate to Spain's responses³ to the Checklist of Issues on Enforcement:

Response 14: Could Spain advise whether the practice of Customs officers informing the Department upon detecting goods presumed to be counterfeit or pirated, for which action has been granted, has any applicability to wine bearing misleading geographical indications, and if so, identify the relevant legislation and describe the practice followed.

²IP/N/6/ITA/1

³IP/N/6/ESP/1

Response 15: We would be grateful if Spain could clarify whether or not action may be requested in the case of wine bearing misleading geographical indications.

United Kingdom

The following questions relate to the United Kingdom's responses⁴ to the Checklist of Issues on Enforcement:

Introductory Remarks (pages 1-2): Is it correct to assume from these Introductory Remarks that the Common Law of "passing off" is the legal mechanism for protection of wine geographical indications?

Response 9: This states that "in the UK, administrative remedies for IPRs can be considered to be non-existent as a practical matter". Can the UK confirm that this statement covers wine geographical indications? Could the UK also please explain the relationship of this statement to the reference in table 2 of document IP/C/W/75 of 14 July 1997 to the Wine Standard Board and local authorities in the column headed "Filing of Complaint"? Do those bodies receive complaints initiated by private parties or are they responsible for ex officio enforcement of wine geographical indications?

Response 15(1): This notes that in relation to infringement of IPRs the only specific provisions for Customs to suspend the release of goods are in respect of counterfeit trademarked and pirated goods. Does this mean that there are no specific provisions which enforce protection of wine geographical indications at the border?

Response 21: This notes that an offence under section 92 of the Trade Marks Act 1994 cannot be committed unless "the goods in question are goods for which the mark is registered or unless the trademark has such a reputation in the United Kingdom that its unauthorized use would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the trademark". How is this provision enforced, and would it envisage any state enforcement to prevent misleading use of a wine geographical indication?

⁴IP/N/6/GBR/1