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The New Geographical Indications Act 2022: Key Changes

Introduction

What is a geographical indication ("**GI**")? A GI is essentially a sign or geographical term used on products for the purposes of indicating the place of origin. The use of a GI would also serve as indication of the good qualities and characteristics of the said products which are attributable to that place of origin. Examples of GI include Sarawak Pepper, Darjeeling Tea, Sabah Tea, Balsamic Vinegar of Modena, Gruyere Cheese, Colombian Coffee and Scotch Whisky.

GIs in Malaysia were initially protected by the Geographical Indications Act 2000 ("**previous Act**"). However, a new Geographical Indications Act 2022 ("**new GI Act**"), which effectively repeals the previous Act, came into operation on 18 March 2022. This new GI Act seeks to provide a wider scope of protection to GI proprietors and more clarity in relation to the examination procedure for the registration of GIs.

Significant Changes Introduced by the New GI Act

We will now highlight the new and significant changes introduced by the new GI Act.

Eligibility for registration of a GI

According to Section 8(5) of the new GI Act, the following may apply for the registration of a GI:

- (a) Any person who is carrying on an activity as a producer (which includes manufacturers and traders) in the geographical area with regards to the goods (it includes an association of such persons); or
- (b) A competent authority.

Under the previous Act, the definition of "persons" who may apply for protection of GI in Malaysia included "*trade organisation or association*". However, under the new GI Act, "trade organisation or association" has been removed from the definition of "*persons*".

It is pertinent to note that the term "**competent authority**" refers and / or includes the following:

- (a) Any government or statutory body that carries out the functions of, on behalf of, or sanctioned by, the Malaysian Government or the Government of a State;

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- (b) Any government other than the Government of Malaysia; or
- (c) Any authority which is competent to certify the goods;

and has the responsibility for the GI in question.

Compared to the previous GI Act, the definition of "competent authority" under the new GI Act now includes "*governments other than the Malaysian Government*" and that the competent authority needs to have "responsibility for the GI in question".

Examination and opposition procedures for GI applications

(i) Examinations and oppositions

The new GI Act also provides more clarity and provisions on the application procedure, in that GI applications will be subjected to examinations and oppositions, and for examination purposes, the Registrar shall carry out a search for any earlier GIs or earlier trademarks as is deemed necessary. If one wishes to register any variant of a GI which is the subject of an application for registration, such registration shall be made in a different application.

(ii) Provisional refusals

In the event the GI application does not fulfil any of the registration requirements, the Registrar will issue a provisional refusal by way of a written notice to the applicant on the grounds of provisional refusal. The applicant will be given an opportunity, within a specified period, to overcome the said provisional refusal by way of the following:

- (a) A written submission or hearing;
- (b) Amending the application to meet any condition, amendment, modification or limitation as the Registrar thinks fit to impose; or
- (c) Furnish additional information or evidence.

If the applicant fails to respond to the Registrar within the specified period, the said GI application shall be deemed withdrawn. Alternatively, if the applicant's response does not satisfy the Registrar, the Registrar may refuse the said application. The applicant may then request for the Registrar's written grounds of refusal and appeal against the said refusal to the High Court.

(iii) Acceptance of a GI application

Similar to the acceptance procedure for trademarks, if a GI application is accepted for registration, a notice of acceptance shall be issued by the Registrar requiring the applicant to pay the prescribed fee

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within a specified period. Once payment is made, the acceptance of the application will be published in the Intellectual Property Official Journal. However, after the acceptance of a GI application but before the registration of GI, if the Registrar is satisfied that the application has been accepted in error, the Registrar may revoke the acceptance and proceed as if the application for the GI had not been accepted. Alternatively, he may reissue a new acceptance subject to any additional or different condition or limitation.

(iv) Grounds for refusal for registration

Unlike the Trademarks Act 2019, the previous GI Act did not specify nor list the grounds for refusal for registration of a GI. Under Section 10 of the new GI Act, a list of grounds for refusal is now provided for, which include the following:

- (a) The GI does not correspond to the meaning of "geographical indication" as defined in Section 2 of the new GI Act;
- (b) The GI identifies goods that do not fall within any of the categories of goods as determined by the Registrar;
- (c) The GI consists exclusively of an indication which is identical with the term customary in the common language as the common name of any goods in Malaysia, if registration is sought in relation to the goods;
- (d) The GI is contrary to public order or morality;
- (e) The GI is not or has ceased to be protected in its country or territory of origin;
- (f) The goods do not originate in the country, region or locality indicated in the application for the registration of GI; or
- (g) The GI in relation to the goods is of such a nature which may mislead the public as to the true place of origin of the goods.

The Registrar shall also refuse to register a GI if there exists a likelihood of confusion on the part of the public due to the GI being identical or similar an earlier GI.

(v) Voluntary cancellation of registered GI by proprietor

Under the new GI Act, registered proprietors can now request for a voluntary cancellation of a registered GI. When registration is voluntarily cancelled, the rights conferred by the registration of the GI on any interested party shall cease to exist with effect from the date of the cancellation of the registration.

(vi) Cancellation of registered GI by Court

Further to the above, under the new Act, any person may apply to the Court for the cancellation of a registered GI on the following grounds:

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- (a) The GI was registered in breach of the grounds for refusal;
- (b) The registration of the GI was obtained fraudulently or by misrepresentation;
- (c) The GI has fallen into disuse or has ceased to be protected in its country or territory or origin;
- (d) The GI was not maintained by the registered proprietor, i.e. there has been a failure by a registered proprietor to maintain, in Malaysia, any commercial activity or interest in relation to the GI, including commercialisation, promotion or market monitoring; or
- (e) Due to the non-use of the registered GI per (d) above, the GI has become a common name of the goods in Malaysia.

Pursuant to the new GI Act, the Court also has the power to cancel a registered GI.

(vii) Opposition procedures

Whilst the opposition procedure for GI under the new GIA Act is very much identical with the procedure in relation to trademarks, the person opposing the registration for a GI can now introduce additional grounds of opposition in opposing the registration of the concerned GI with the leave of the Court.

(viii) Homonymous GI protected

Homonymous GIs are indications that sound, spell or read alike which identify products originating in different places – e.g. wine products in Paris, Illinois, USA and not Paris, France.

In the previous GI Act, protection for homonymous GI was only applicable to wines under Section 7. However, in the new GI Act, the said protection is no longer restricted to wines and now applies to any goods.

(ix) Offences

The previous GI Act did not address criminal enforcement or statutory offences. However, the new GI Act now sets out the following offences:

- (a) Importing / selling goods with falsely applied GI;
- (b) Submission of false information to the GI Officer or making false entries in the Register;
- (c) Falsely representing a GI as a registered GI;
- (d) Falsely representing goods for which a GI is registered; and
- (e) Disobedience to a request made by the Registrar, e.g. refusal to give evidence as a witness or produce any document or article.

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(x) Jurisdiction of Sessions Court

Pursuant to the new GI Act, the Sessions Court shall now have jurisdiction to try any of the offences set out under the new GI Act.

(xi) Privileged communications

The new GI Act also provides for privileged communications between a registered GI agent and his client (i.e. the person who appointed and authorised him). At the same time, the right of lien a solicitor has in relation to the documents and property of a client is now extended to a registered GI agent.

(xii) Transfer of registered GI

Under the new GI Act, a registered proprietor of a GI may file an application to transfer the registration of a GI to another party, so long as the following conditions are complied with:

- (a) Such person is entitled to file such an application; and
- (b) A written consent has been obtained in order for the registered GI to be transferred to such person

(xiii) Transitional matters

As stipulated under Section 100 of the new GI Act, any GI applications under the previous GI Act that are pending resolution before the date of the coming into operation of the new GI Act shall be dealt with under the previous GI Act. However, if the subject GI is already registered, that GI will be treated as a registered GI.

Conclusion

The new GI Act appears to be much more comprehensive and extensive, and serves to provide more procedural clarity and wider protection to GI proprietors.

Should you have any questions in relation to the above changes, please do not hesitate to contact our team below.

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