

GEOGRAPHICAL INDICATIONS

Introduction

Darjeeling tea, Tequila, Cognac, Parmigiano-Reggiano, and Gruyere cheese are not only names of products, these are some of the most well-known geographical indications (“GI”) in the world. A GI distinguishes products identified by the GI as originating from a particular location from other products which do not originate from that location. Each product bearing a GI possesses its own reputation and specific characteristics attributable to its geographical origin. For instance, there are many sparkling wines produced around the world, however, the *Champagne* name may only be used on a label if the grapes and the wines are produced under strict regulations in the French region of Champagne, 90 miles northeast of Paris.

Economic values of GIs

GI products often bring significant economic and cultural value to their geographical origin. Promoting and preserving origin-linked products can foster social and economic development in a particular region. Some examples of local GIs in Malaysia include, *Malaysian Durian Musang King, Harumanis, Sabah Tea, Bario Rice* and *Sarawak Pepper*, to name a few. By registering these GIs, GI products with good quality and unique characteristics may gain not only local but worldwide recognition in the domestic and international markets, potentially enhancing brand value for the producers, attracting tourists to the region in return, creating job opportunities, and thus, bringing economic potential to the territories.

How do I obtain protection for a GI?

GIs are recognised in Malaysia as a distinct type of intellectual property right under the Geographical Indications Act 2000 (“GI Act”). The GI Act defines a GI as “*an indication which identifies any goods as originating in a country or territory, or a region or locality in that country or territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to their geographical origin*”. The GI Act provides protection to goods following the name of the place in which the goods are produced. This

If you have any related questions/queries please do not hesitate to contact us:

E: general@shinassociates.com.my | T: +603 2201 5584

Shin Associates is a Malaysian-based law firm that is passionately driven to provide comprehensive legal advisory services of integrity and commercial edge, across national boundaries and on international platforms.

This material has been prepared for general informational purposes only and is not intended to be relied upon as legal or other professional advice.

protection is generally applicable to goods such as natural or agricultural products or any product of handicraft or industry. The GI Act excludes protection for GIs which (i) do not fall within the definition of a GI under the GI Act; (ii) are contrary to public order or morality; or (iii) are not, or have ceased to be protected, or have fallen into disuse, in their country or territory of origin.

Although there is a registration system for GIs, registration is not compulsory, and protection will still be available to GIs regardless of whether the GI has been registered under the GI Act or otherwise. However, registered GIs enjoy certain benefits, e.g. a certificate of registration issued under the GI Act is prima facie evidence of the facts stated in the certificate, and of the validity of the registration. The GI Act also provides that once a GI is registered, only producers carrying on their activity in the geographical area specified in the Register of GIs shall have the right to use the registered GI in the course of trade. Producers are only allowed to use a GI for a product specified in the Register and produced in accordance with the standards prescribed in the Register. A GI's protection in Malaysia is territorial, and accordingly, for extraterritorial protection, the GI may need to be registered with the respective country's authorities, subject to that country's laws.

In addition to the above, the right to a GI may also be acquired through the registration of a 'collective mark' or 'certification mark' under Section 72 and Section 73 of the Trademarks Act 2019 ("TMA") respectively. A 'collective mark' is a sign distinguishing the goods or services of members of an association which is a proprietor of the 'collective mark' from those of other undertakings, whereas, a 'certification mark' is a sign indicating that the goods and services in connection with which the sign shall be used are certified by the proprietor of the mark in respect of the origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics. This also offers a certain degree of protection to GIs. The sections in the TMA provide that a 'collective mark' or a 'certification mark' which consists of a GI may be registered as a 'collective mark' or a 'certification mark' (as the case may be), to designate the geographical origin of the goods or services, subject to certain restrictions set out in the TMA.

If you have any related questions/queries please do not hesitate to contact us:

E: general@shinassociates.com.my | T: +603 2201 5584

Shin Associates is a Malaysian-based law firm that is passionately driven to provide comprehensive legal advisory services of integrity and commercial edge, across national boundaries and on international platforms.

This material has been prepared for general informational purposes only and is not intended to be relied upon as legal or other professional advice.

Who can apply for registration of a GI?

The following persons are entitled to file an application for the registration of a GI:

- (a) a person who is carrying on an activity as a producer in the geographical area specified in the GI registration application with respect to the goods specified in the application, and includes a group or groups of such person;
- (b) a competent authority; or
- (c) a trade organization or association.

A GI is granted 10 years of protection once it is registered, and upon application, is renewable for a period which shall not exceed 10 years for each renewal. GIs can be renewed for an unlimited number of successive 10-year periods.

Differences between GIs and Trademarks

Registered GIs may be used by any producers who are carrying on an activity in that area of origin and producing goods in accordance with a specified standard, as opposed to trademarks, which are a limited individual ownership concept whereby the owner thereof has the exclusive right to use the mark and the exclusive right to allow others to use the mark by way of a licence.

Registered GIs generally consist of the name of a geographical area or region while trademarks usually comprise of a unique sign created by the owner of a particular brand of goods and/or services to differentiate and distinguish their brand from other brand owners.

The TMA explicitly states that a trademark application will be refused if the trademark contains or consists of recognised GIs. This is following the principle that an applicant cannot be allowed to obtain a monopoly over the usage of such geographic name to prevent other legitimate users from using the same.

If you have any related questions/queries please do not hesitate to contact us:

E: general@shinassociates.com.my | T: +603 2201 5584

Shin Associates is a Malaysian-based law firm that is passionately driven to provide comprehensive legal advisory services of integrity and commercial edge, across national boundaries and on international platforms.

This material has been prepared for general informational purposes only and is not intended to be relied upon as legal or other professional advice.

Points to note

It is imperative that producers of goods ensure that they do not misuse GIs (e.g. by making false representations to the public to indicate that such goods are associated with a particular location, where such goods have not been produced in that location), in order to prevent any action being taken against them. In June 2020, the Intellectual Property Corporation of Malaysia (“MyIPO”) explained that the usage of the name *Harumanis* was to be limited to the variety of mangoes grown in the state of Perlis, having been registered in 2011 in accordance with the GI Act. MyIPO further stated that action may be taken against mango farm operators who misuse the word *Harumanis* on mangoes which have been produced outside of Perlis. It should be noted that the court is empowered to grant an injunction against any unlawful use of a GI and may also award any damages or other legal remedy pursuant to the GI Act.

If you have any related questions/queries please do not hesitate to contact us:

E: general@shinassociates.com.my | T: +603 2201 5584

Shin Associates is a Malaysian-based law firm that is passionately driven to provide comprehensive legal advisory services of integrity and commercial edge, across national boundaries and on international platforms.

This material has been prepared for general informational purposes only and is not intended to be relied upon as legal or other professional advice.