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Geographical Indications (Amendment) Bill

Bill No. 4/2020.

Read the first time on 6 January 2020.

A BILL

i n t i t u l e d

An Act to amend the Geographical Indications Act 2014 (Act 19 of 2014).

Be it enacted by the President with the advice and consent of the Parliament of Singapore, as follows:

Short title and commencement

1. This Act is the Geographical Indications (Amendment) Act 2020 and comes into operation on a date that the Minister appoints by notification in the *Gazette*.

5 **Amendment of section 2**

2. Section 2 of the Geographical Indications Act 2014 (called in this Act the principal Act) is amended —

(a) by inserting, immediately after the definition of “use”, the following definition:

10 ““variant”, in relation to a geographical indication, means a variant of the indication constituting the geographical indication, and includes any translation, transliteration or other variation of the indication;”; and

15 (b) by renumbering the section as subsection (1) of that section, and by inserting immediately thereafter the following subsections:

 “(2) There may be 2 or more variants constituting the same geographical indication.

20 (3) A geographical indication, and each variant constituting the geographical indication (if any), may contain 2 or more words.”.

Amendment of section 39

25 3. Section 39 of the principal Act is amended by inserting, immediately after subsection (1), the following subsection:

30 “(1A) If a person desires to register any variant constituting a geographical indication and the geographical indication is the subject of an application for registration, the person may include that variant either in that application, or in a different application for registration.”.

Amendment of section 41

4. Section 41 of the principal Act is amended by inserting, immediately after subsection (7), the following subsection:

“(7A) To avoid doubt —

- (a) a reference to a geographical indication in this section includes a variant constituting a geographical indication; and 5
- (b) a refusal of registration under this section of any variant constituting a geographical indication does not prevent the registration of any other variant constituting the geographical indication, if that other variant satisfies the requirements of this Act.”. 10

Amendment of section 46

5. Section 46 of the principal Act is amended —

- (a) by deleting the words “Any person may” in subsection (1) and substituting the words “Subject to subsection (3A), any person may”; 15
- (b) by deleting the words “under section 45” in subsection (1) and substituting the words “of a geographical indication under section 45 but before the registration of the geographical indication under section 48”; 20
- (c) by inserting, immediately after the words “request that a qualification, of” in subsection (1), the words “any of”; and
- (d) by inserting, immediately after subsection (3), the following subsection: 25
 - “(3A) A request under subsection (1) may not be made if the request —
 - (a) is for a qualification of all the rights conferred under this Act in respect of a registered geographical indication to be entered in the register — 30

(i) in relation to any name contained in the geographical indication that is the subject of the application for registration; or

5 (ii) in relation to any term which may be a possible translation of the geographical indication that is the subject of the application for registration; and

10 (b) is made on the ground that one or more of the exceptions mentioned in section 11(a), (b) or (c) or 15 applies to that name or term.”.

Amendment of section 48

15 **6.** Section 48(1) of the principal Act is amended —

(a) by inserting, immediately after the words “registration of a geographical indication”, the words “, or of 2 or more variants constituting the same geographical indication,”;

20 (b) by inserting, immediately after the words “all opposition proceedings” in paragraph (b), the words “in respect of the geographical indication, or in respect of any of those variants,”; and

25 (c) by deleting the words “shall register the geographical indication” and substituting the words “must register the geographical indication, or each variant that is unopposed or in respect of which opposition proceedings are withdrawn or decided in favour of the applicant, as the case may be”.

New section 48A

30 **7.** The principal Act is amended by inserting, immediately after section 48, the following section:

“Application for limitation of scope to be entered in register

48A.—(1) Subject to subsection (4), any person may, at any time after the registration of a geographical indication under section 48, apply to the Court for an order that a limitation of the scope of any of the rights conferred under this Act in respect of a registered geographical indication be entered in the register —

- (a) in relation to any name contained in the registered geographical indication; or
- (b) in relation to any term which may be a possible translation of the registered geographical indication.

(2) The application under subsection (1) may only be made on either or both of the following grounds:

- (a) that one or more of the exceptions mentioned in Part III applies;
- (b) that the term mentioned in subsection (1)(b) is not a translation of the registered geographical indication.

(3) The application must be made to the Court in the prescribed manner, and must include a statement of the grounds for the application and any other matter that may be prescribed.

(4) An application under subsection (1) may not be made if the application —

- (a) is for an order that a limitation of the scope of all the rights conferred under this Act in respect of a registered geographical indication be entered in the register —
 - (i) in relation to any name contained in the registered geographical indication; or
 - (ii) in relation to any term which may be a possible translation of the registered geographical indication and which is registered as a variant constituting the registered geographical indication; and

(b) is made on the ground that one or more of the exceptions mentioned in section 11(a), (b) or (c) or 15 applies to that name or term.

5 (5) The Court, if satisfied that either or both of the grounds mentioned in subsection (2) is made out, must order the Registrar to cause to be entered in the register a limitation of the scope of the rights conferred under this Act in relation to any of the following that is applicable:

10 (a) any name contained in the registered geographical indication;

(b) any term which is not a translation of the registered geographical indication;

(c) any term which is a translation of the registered geographical indication.

15 (6) Where a registered geographical indication is subject to a limitation of the scope of rights under subsection (5), the rights of an interested party in respect of the geographical indication are restricted accordingly.

20 (7) The Minister may make rules as to the entry in the register of a limitation of the scope of rights under subsection (5).”.

Amendment of section 52

8. Section 52 of the principal Act is amended —

25 (a) by inserting, immediately after the words “may be cancelled” in subsection (4)(a), the words “by the Registrar”; and

(b) by inserting, immediately after subsection (8), the following subsection:

“(9) To avoid doubt —

30 (a) a reference to a geographical indication in this section includes a variant constituting a geographical indication; and

(b) a cancellation of the registration under this section of any variant constituting a geographical indication does not affect the registration of any other variant constituting the geographical indication.”.

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Transitional provisions

9.—(1) Section 4 applies to or in relation to any application for registration of a geographical indication, whether made before, on or after the date of commencement of that section.

(2) Despite section 5, section 46 of the principal Act as in force immediately before the date of commencement of section 5 continues to apply to or in relation to any request that a qualification be entered in the register in respect of a geographical indication, made before the date of commencement of section 5.

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(3) Section 6 applies to or in relation to any application for registration of a geographical indication, whether made before, on or after the date of commencement of that section.

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(4) Section 7 applies to or in relation to any registered geographical indication, whether the geographical indication is registered before, on or after the date of commencement of that section.

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(5) Section 8 applies to or in relation to any application for the cancellation of the registration of a geographical indication, or of a variant constituting a geographical indication, whether made before, on or after the date of commencement of that section.

EXPLANATORY STATEMENT

This Bill seeks to amend the Geographical Indications Act 2014 (Act 19 of 2014) (called the GI Act) for the following main purposes:

- (a) to provide that a qualification of the rights conferred under the GI Act in respect of a registered geographical indication —
 - (i) may only be requested before a geographical indication is registered; and
 - (ii) may not be made if the qualification of rights would render the registration of a name contained in a geographical indication, or a term which may be a possible translation of a geographical indication, nugatory;
- (b) to provide that, after a geographical indication is registered, a person may apply to the High Court for an order that a limitation of the scope of any of the rights conferred under the GI Act in respect of a registered geographical indication be entered in the register;
- (c) to clarify that the grounds for refusal of registration apply in respect of a variant, and that a variant that falls within any of the applicable grounds for refusal of registration may be cancelled.

Clause 1 relates to the short title and commencement.

Clause 2 amends section 2 to introduce the following definitional provisions:

- (a) “variant” is defined as a variant of the indication constituting a geographical indication, and includes any translation, transliteration or other variation of the indication. As an illustration, in the case of a geographical indication known as “Apples of Singapore”, the terms “Lion City Apples” (being a variation) and “Epal Singapura” (being a translation) are variants of the geographical indication. To provide another illustration, in the case of a geographical indication known as “乌敏橙”, the terms “Ubin Orange” (being a translation) and “Wu Min Cheng” (being a transliteration) are variants of the geographical indication;
- (b) the new subsection (2) clarifies that 2 or more variants may constitute the same geographical indication;
- (c) the new subsection (3) clarifies that a geographical indication (and each variant, if any) may contain 2 or more words.

Clause 3 amends section 39 (which sets out the procedure for an application for registration of a geographical indication) to clarify that, where a person intends for a variant constituting a geographical indication to be registered and the geographical indication is the subject of an application for registration, the

person may include the variant in an application for registration, whether it is the same or a different application for registration of the geographical indication in question.

Clause 4 inserts a new subsection (7A) in section 41 (which sets out grounds for refusal of registration of a geographical indication) to clarify that, where 2 or more variants constitute the same geographical indication, any of the variants constituting the geographical indication must not be registered if the variant falls within an applicable ground for refusal of registration specified in that section. To avoid doubt, a refusal of registration of a variant does not prevent any other variant of the geographical indication from being registered if that other variant satisfies the requirements of the GI Act.

The new subsection (7A) does not represent a substantive change of position, but expressly sets out the requirement that each variant (which is sought to be registered) must satisfy the requirements of the GI Act in order to be registered.

Clause 5 amends section 46 to provide that a request to enter a qualification of any of the rights conferred under the GI Act in respect of a registered geographical indication in the register may only be made in respect of a geographical indication before the geographical indication is registered under section 48.

In addition, a new subsection (3A) is inserted in section 46 to provide that a request may not be made if the qualification of rights would render registration of a name contained in a geographical indication or a term which may be a possible translation of a geographical indication nugatory. In particular, the request may not be made if the request is for a qualification of *all* the rights conferred under the GI Act on a registered geographical indication to be entered in the register in relation to the name or term on the ground that one or more of the exceptions mentioned in section 11(a), (b) or (c) or 15 applies to that name or term. In such a case, instead of making a request to enter a qualification of rights in the register under section 46, notice of opposition to the registration of the geographical indication or variant constituting the geographical indication under section 45 should be given.

Clause 6 amends section 48 to provide that, where 2 or more variants constitute the same geographical indication, the Registrar of Geographical Indications must register a variant if the application for registration of the variant —

- (a) is accepted under section 43(6); and
- (b) is unopposed, or in respect of which opposition proceedings are withdrawn or decided in favour of the applicant for registration of the variant.

This is so even though one or more other variants of the geographical indication is subject to opposition proceedings or is refused registration. This amendment

clarifies that each variant must satisfy the requirements of the GI Act in order to be registered, and does not reflect a substantive change of position.

Clause 7 inserts a new section 48A to provide that, after the date of registration of a geographical indication, any person may apply to the High Court for an order that a limitation of the scope of the rights conferred under the GI Act in respect of a registered geographical indication be entered in the register in relation to any name contained in the registered geographical indication, or in relation to any term which may be a possible translation of the registered geographical indication. The application may only be made on the ground that one or more of the exceptions under Part III applies, or (in the case of a term which may be a possible translation of the registered geographical indication) that the term is not a translation of the geographical indication.

The application under the new section 48A may not be made if the effect of the order that a limitation of scope be entered in the register is to render registration of the name or term nugatory. In particular, the application may not be made if the application for an order that a limitation of the scope of *all* the rights conferred under the GI Act in respect of a registered geographical indication be entered in the register is made on the ground that one or more of the exceptions mentioned in section 11(a), (b) or (c) or 15 applies to that name or term. In such a case, instead of making an application for an order to enter a limitation of scope in the register under the new section 48A, an application for cancellation of the geographical indication or variant constituting the geographical indication under section 52 should be made.

Clause 8 amends section 52 (which sets out the circumstances in which the registration of a geographical indication may be cancelled) to clarify that, where 2 or more variants constitute the same geographical indication, the registration of any of the variants may be cancelled if any applicable ground set out in the section is satisfied in respect of the variant. These amendments do not reflect a substantive change of position but clarify that an application may be made for the cancellation of only one (or more) of the variants registered under the GI Act. Cancellation of the registration of a variant constituting a geographical indication does not affect any rights in respect of the registration of any other variant constituting that geographical indication.

Clause 9 contains transitional provisions.

EXPENDITURE OF PUBLIC MONEY

This Bill will not involve the Government in any extra financial expenditure.
