



Tonga

# **PROTECTION OF GEOGRAPHICAL INDICATIONS ACT**

**Chapter 30.16**

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# PROTECTION OF GEOGRAPHICAL INDICATIONS ACT

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# PROTECTION OF GEOGRAPHICAL INDICATIONS ACT

## AN ACT TO MAKE PROVISION FOR THE PROTECTION OF GEOGRAPHICAL INDICATIONS<sup>1</sup>

Commencement [<sup>2</sup>]

### PART I - PRELIMINARY

#### 1 Short title and commencement

- (1) This Act may be cited as the Protection of Geographical Indications Act.
- (2) This Act shall come into operation on a date to be proclaimed by His Majesty in Council.

#### 2 Act binds the Crown

This Act binds the Crown.

#### 3 Interpretation

In this Act, unless the context otherwise requires —

“**Court**” means the Supreme Court of Tonga;

“**geographical area**” means the territory of the country, or region or locality in that territory as the case may be which constitutes the geographical origin of the goods;

“**geographical indication**” means an indication which identifies a good as originating in the territory of a country, 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;

“**good**” means any natural or agricultural product or any product of handicraft or industry;

“**Minister**” means the Minister responsible for commerce;<sup>3</sup>

“**producer**” means —

- (a) any producer of agricultural products or any other person exploiting natural products;
- (b) any manufacturer of products of handicraft, or industry; and
- (c) any trader dealing in the said products;

“**register**” means the Register of Geographical Indications maintained under section 14;

“**Registrar**” means the Registrar of Industrial Property holding office in terms of section 37 of the Industrial Property Act.<sup>4</sup>

## **PART II - PROTECTION OF GEOGRAPHICAL INDICATIONS**

### **4 Civil proceedings**

Any interested person and any interested group of producers or consumers may institute proceedings in the Court to prevent, in respect of geographical indications —

- (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 the Protection of Unfair Competition Act; or
- (c) any use in 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,

and in proceedings under this section, the Court may, in addition to issuing an injunction, award damages and grant any other civil remedy or relief as it shall deem fit.

## **5 Scope of Protection**

Protection under this Act shall be available —

- (a) regardless of whether a geographical indication has been registered provided, however, that registration of a geographical indication under Part III of this Act shall, in any proceedings under this Act, raise a presumption that such indication is a geographical indication; and
- (b) against a geographical indication which, although laterally 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.

## **6 Homonymous geographical indications for wines**

In the case of homonymous geographical indications for wines, protection shall be accorded to each subject to paragraph (b) of section 5. In cases of permitted concurrent use of such indications, the Registrar 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.

## **7 Exclusion from Protection**

The following shall not be protected as geographical indications —

- (a) indications which do not correspond to the definition of “geographical indication”;
- (b) indications which are contrary to public order or morality;
- (c) geographical indications which are not or cease to be protected in their country of origin, or which have fallen into disuse in that country.

## **8 Penalty**

Any person who intentionally performs any act in contravention of this Act commits an offence, and is liable upon conviction to a fine not exceeding \$5,000 or to imprisonment for a term not exceeding 5 years or to both.

## **PART III - REGISTRATION OF GEOGRAPHICAL INDICATIONS**

### **9 Application for registration**

- (1) The application for registration of a geographical indication shall be filed with the Registrar.
- (2) Any natural person, competent authority or legal entity carrying on an activity as a producer in the geographical area specified in the application, with respect to the goods specified in the application, as well as groups of such persons shall have the right to file an application.

### **10 Contents of Application**

The application shall specify —

- (a) the name, address and nationality of the natural person or legal entity filing the application, and the capacity in which the applicant is applying for registration;
- (b) the geographical indication for which registration is sought;
- (c) the geographical area to which the geographical indication applies;
- (d) the goods for which the geographical indication applies; and
- (e) the quality, reputation or other characteristic of the goods for which the geographical indication is used;

and shall be subject to the payment of the prescribed fee.

### **11 Processing of application**

- (1) The Registrar shall examine whether the application complies with the requirements of sections 7, 9(2) and 10 and the regulations pertaining thereto.
- (2)
  - (a) Where the Registrar finds that the conditions referred to in subsection (1) hereof are fulfilled, he shall cause the application, as accepted, to be published in the Gazette.
  - (b) Any interested person or competent authority may, within the prescribed period and in the prescribed manner, give notice to the Registrar of opposition to the registration of the geographical indication on the grounds that one or more of the requirements of sections 7, 9(2) and 10 are not fulfilled.
  - (c) The Registrar shall send a copy of such a notice to the applicant, and, within the prescribed period and in the prescribed manner, the applicant shall send to the Registrar a statement to the opposition to his

application; if he does not do so, he shall be deemed to have abandoned the application.

- (d) If the applicant sends a counter-statement, the Registrar shall furnish a copy thereof to the person giving notice of opposition and, after hearing the parties, if either or both wish to be heard, and considering the merits of the case, shall decide whether the geographical indication should be registered.

- (3) Where the Registrar finds that the conditions referred to in subsection (1) are fulfilled, and either —

- (a) the registration of the geographical indication has not been opposed within the prescribed time limit; or  
(b) the registration of the geographical indication has been opposed and the outcome has been decided in the applicant's favour,

he shall register the geographical indication, publish a reference to the registration and issue to the applicant a certificate of registration.

## 12 Right of use

Only producers carrying on their activity in the geographical area specified in the register shall have the right to use a registered geographical indication, in the course of trade, with respect to the products specified in the register, provided that such products possess the quality, reputation or other characteristic specified in the Register.

## 13 Cancellation and rectification of registration

- (1) Any interested person may request the Court to order —
- (a) the cancellation of a registration of a geographical indication on the ground that it does not qualify for protection as such having regard to section 7;
- (b) the rectification of a registration of a geographical indication on the ground that the geographical area specified in the registration does not correspond to the geographical indication, or that the indication of the products for which the geographical indication is used or the indication of the quality, reputation or other characteristic of such products is missing or unsatisfactory.
- (2) In any proceedings under this section, notice of the request for cancellation or rectification —
- (a) shall be served on the person who filed the application for registration of the geographical indication or his successor in title; and
- (b) shall, by a publication in the Gazette be given to all persons having the right to use the geographical indication under section 12.

- (3) The persons referred to in subsection (2) and any other interested person may, within a period which shall be specified by the Court in the said notice, apply to join in the proceedings.

#### **14 Registers**

The Registrar shall maintain a Register of Geographical Indications in which all the recordings provided for in this Act shall be entered which may be consulted by any person who may obtain copies of any entry subject to prescribed fees and conditions.

### **PART IV - ADMINISTRATION**

#### **15 Gazetting of publications**

The Registrar shall publish in the Gazette all the publications provided for in this Act.

#### **16 Corrections of mistakes and extension of time**

- (1) The Registrar may, subject to any provision in the regulations, correct any mistake in any application or document filed with his Office or in any recording effected pursuant to this Act, or the regulations.
- (2) If the Registrar is satisfied that the circumstances justify it, he may, upon receiving a written request, extend the time for doing any act or taking any proceeding under this Act and the regulations, upon notice to parties concerned and upon such terms as he may direct. The extension may be granted though the time for doing the act or taking the proceeding has expired.

#### **17 Exercise of discretionary powers**

The Registrar shall give any party to a proceeding before him an opportunity of being heard before exercising adversely to that party any discretionary power vested in him by this Act or the regulations.

#### **18 Jurisdiction of the Court**

The Court shall have jurisdiction in respect of any matter arising under this Act.

**19 Appeals to the Minister**

Any decision taken by the Registrar under this Act may be the subject of an appeal to the Minister by any interested party and such appeal shall be filed within two months of the date of the decision.

**20 Regulations**

- (1) The Minister may, with the consent of Cabinet, issue regulations prescribing details for the implementation of this Act.
- (2) The Regulations may provide for the payment of fees in connection with applications for the registration of geographical indications and matters related thereto.

**PART V - SPECIAL PROVISIONS CONCERNING MARKS AND EXCEPTIONS****21 Misleading trademarks**

The Registrar shall, *ex officio* 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 geographical area indicated, if use of the indication in the trademark for such goods in Tonga is of such a nature as to mislead the public as to the true place of origin.

**22 Trademarks conflicting with a geographical indication for wines and spirits**

The registration of a trademark for wines which contains or consists of a geographical indication identifying wines or of a trademark for spirits 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 wines or spirits not having this origin.

**23 Exceptions regarding prior users**

- (1) Nothing in this Act shall prevent continued and similar use in Tonga of a particular geographical indication of another country identifying wines or spirits in connection with goods or services by any nationals of Tonga or persons domiciled in Tonga who have used that geographical indication in a continuous manner with regard to the same or related goods or services in the territory of Tonga either —
  - (a) for at least 10 years preceding 15 April 1994; or

- (b) in good faith preceding that date.
- (2) Where a trademark has been applied for or registered in good faith, or where rights to a trademark have been acquired through use in good faith either —
- (a) before the date of entry into force of this Act; or
  - (b) before the geographical indication is protected in its country of origin, this Act shall not prejudice the registration of or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication.
- (3) Nothing in this Act shall apply in respect of a geographical indication of any country with respect to goods or services for which the relevant indication is identical with the term customary in common language as the common name for such goods or services in Tonga or in respect of a geographical indication of any other country with respect to products of the wine for which the relevant indication is identical with the customary name of a grape variety existing in Tonga as of January 1, 1995.
- (4) Any request for relief made under Part II of this Act in connection with the use or registration of a trademark must be presented within 5 years after the adverse use of the protected indication has become generally known in Tonga or after the date of registration of the trademark in Tonga, provided that the trademark has been published by that date, if such date is earlier than the date on which the adverse use became generally known in Tonga and provided that the geographical indication is not used or registered in bad faith.
- (5) This Act shall not prejudice the right of any person to use, in the course of trade, that person's name or the name of that person's predecessor in business, except where such name is used in such a manner as to mislead the public.

## ENDNOTES

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<sup>1</sup> Act 17 of 2002, See GS 35/08

Amended by Act 5 of 2012, commencement 30 July 2012

<sup>2</sup> No commencement proclamation found at the date of the preparation of this revised edition

<sup>3</sup> Amended by Act 5 of 2012

<sup>4</sup> Cap. 40.16