



Promoting Intellectual
Property Rights in the
ASEAN Region

HOW TO REGISTER YOUR GI IN THE ASEAN REGION AND ABROAD

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Registration of GIs in the ASEAN region

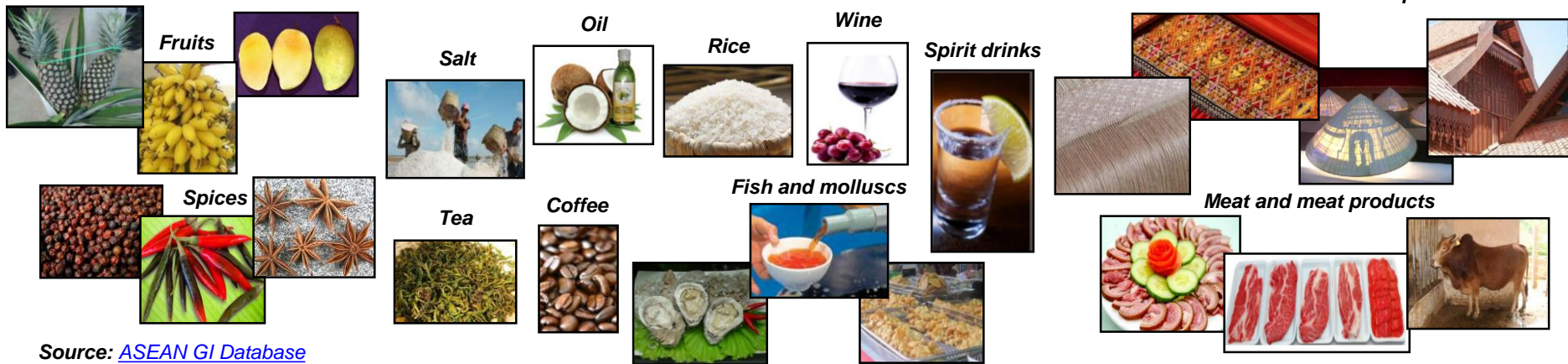
REGISTRATION OF GIs IN THE ASEAN REGION: Overview

- **Territorial nature of IPR: 10 ASEAN countries – 10 GI protection systems!**
- **At national level (direct application):**
 - **Protect as GIs only:** KH, ID, LA, TH (*sui generis* system); MM (*sui generis* system under TM law)
 - **Protect as marks only:** BN, PH (trade marks system)
 - **Protect as GIs or as marks:** MY, SG, VN (both *sui generis* and trade mark systems)
- **In other ASEAN countries and abroad:**
 - **Protect through direct registration** in each target country
 - **Protect via bilateral or multilateral agreements** (e.g. EVFTA, EUSFTA, Lisbon Agreement, etc.)

REGISTRATION OF GIs IN THE ASEAN REGION: Eligible for protection

WHAT CAN BE PROTECTED?

- **GI DEFINITION:** Name / symbol / sign / indication used to distinguish goods originating in a specific geographical area, which quality, reputation or other characteristics are essentially attributable to its geographical origin.
- **Agricultural products, food, wines, spirit drinks, handicrafts & industrial products**



REGISTRATION OF GIs IN THE ASEAN REGION: NON eligible for protection

WHAT CANNOT BE PROTECTED? (depending on the ASEAN country)

- **Generic names** in the concerned ASEAN country
- **Name likely to mislead the public** as to the true identity, characteristics, nature, quality, reputation, place of origin, production process of goods and/or their use
- **GI contrary to** laws and regulations, morality, public order, etc.
- **GI identical with or similar to a protected mark or an applied mark**, if the use of the GI is likely to cause confusion as to the origin of goods
- Name of a **plant variety or an animal breed**
- GIs of foreign countries that **are not or no longer protected / used**
- Indication that **does not fall within the meaning of “GI”**

SPECIAL CASES: Multi-component GIs, homonymous GIs, GIs in translation, prior TMs (depending on the ASEAN country)

REGISTRATION OF GIs IN THE ASEAN REGION: Available types of rights

DIRECT APPLICATION – Registration options:

- As a **Geographical Indication** (KH, ID, LA, MM, TH, MY, SG, VN)
- As a **Collective Mark** (BN, MY, PH, SG, VN)
- As a **Certification Mark** (BN, MY, SG, VN)

Seek for professional advice to choose the best tool for your products

SOME KEY DIFFERENCES...

GIs

- **Link the product's quality and characteristics to its origin**
- Need to prove the link between the quality of the product and its geographical origin – **Relevance to the origin of the product**
- **Open right for all operators** of the geographical location
- **Non-transferable right**
- **Specific registration procedure** and included in a **specific Register**
- **Indefinite or renewable protection**

CERTIFICATION / COLLECTIVE MARK

- Link the product to the owner of the mark
- No need to prove the relation between the quality of the product and its geographical origin
- Right for the registered proprietor of the mark
- Transferable right
- Registration procedure based on the TM procedure and included in the TM register
- Only renewable protection

**WORTH REGISTERING AS A GI
UNDER A SUI GENERIS SYSTEM!!!**

REGISTRATION OF GIs IN THE ASEAN REGION: Submission of the GI application

WHO?

- **Applicant** (depending on the ASEAN country):

- **Legal entity:** association, cooperative or any other group representing producers who benefit, produce or commercialize the GI
- **Natural person:** producer
- **Government authorities,** agencies or public bodies
- **Consumers' groups**

Examples VN:

- ✓ Phú Quốc Fish Sauce Producing Association (Phú Quốc Fish Sauce GI)
- ✓ People's Committee of Dak Lak Province (Buôn Ma Thuật coffee GI)

- **To register a GI in another ASEAN country:**

1. The GI **MUST** be registered in the country of origin
2. A **legal representative** in the country of registration or an address for service (depending on the ASEAN country)

REGISTRATION OF GIs IN THE ASEAN REGION: Submission of the GI application (II)

WHAT?

- **Application form**
- **Supporting documents** (depending on the ASEAN country):
 - **GI Technical Specifications - KEY DOCUMENT**: name to be protected; characteristics of the product; geographical area; production & processing method; link between the quality, reputation or other characteristics and the geographical origin; traceability & controls, etc.
 - **Map of the geographical area**
 - **Representation of the GI** (labelling, images, etc.)
 - **Additional information** (depending on the ASEAN country)
- **Payment of fees** (From 16\$ up to 750\$ depending on the ASEAN country)

HOW?

- **English or local language** (Translation of certain documents required in some ASEAN countries)

WHERE?

- **At receiving office.** Online applications possible in some ASEAN countries

REGISTRATION OF GIs IN THE ASEAN REGION: Registration & Rights of registered GIs

REGISTRATION PROCESS:

1. Formal examination
2. Substantive examination
3. Publication (for opposition purposes)
4. Opposition
5. Registration (GI certificate by some ASEAN countries)

DURATION OF THE REGISTRATION PROCESS

From 6 months to 12 months
(depending on the ASEAN country)

CONFERRED RIGHTS TO REGISTERED GIs

- Use the GI on the compliant products (authorization required in some ASEAN countries)
- Use the national logos (available in some ASEAN countries)
- Indefinite protection OR for 10 years (10-year terms renewal) (depending on the ASEAN country)
- Take action against infringements, such as:
 - Use in goods that do not comply with the GI criteria
 - Use in goods that did not originate in the place of the GI, if it misleads the public as to the geographical origin of goods
 - Use to take advantage of the GI's reputation or to mislead the public about the origin of goods
 - Use in translation or with expressions such as “type”, “style”, etc. (in some ASEAN countries)
 - Any other use which constitutes an act of unfair competition

ENFORCEMENT:

- *Ex officio*
 - *Ex parte*
 - Both
- (depending on the ASEAN country)



Registration of GIs in the EU

REGISTRATION OF GIs IN THE EU: Main aspects

WHAT CAN BE PROTECTED IN THE EU?

- Agricultural products, foodstuffs, wines, aromatised wines, spirit drinks.

WHAT CANNOT BE PROTECTED IN THE EU?

- **Handicraft and industrial products:** Under consideration at present!!!
- **Generic names**
- Name of a **plant variety or an animal breed**
- Name containing or consisting of a **GI legally on the market before the GI applied for registration**
- **GI which may conflict with an already protected trade mark**, where in light of a trade marks' reputation and renown, protection could mislead the consumer as to the true identity of the product
- Foreign GIs **not protected or no longer protected** in their country of origin

SPECIAL CASES: Homonymous GIs, prior TMs, prior GI names (specific rules)

TYPE OF RIGHT TO APPLY FOR:

- GI registration only (*sui generis* system)
- The logo of the GI and related TMs can be registered as EUTM or as national TM in EU Member States

REGISTRATION OF GIs IN THE EU: Submission of the GI application

WHO?

- **Applicant group:** Any association (in any legal form) of producers or processors of the products
- **Single natural or legal person** (specific conditions)

WHAT?

- **Product specification – KEY DOCUMENT:** Name to be protected in the used language; description of the product; geographical area; evidence that the product originates in the defined area; method of obtaining the product; link between the quality, reputation or characteristics of the product and the geographical origin; name, address and tasks of the bodies that verify the compliance with the product specification; labelling rules.
- **Single document:** Summary of the product specification on a defined [Form](#)
- **Accompanying information:** Name and address of the applicant group; type of GI proposed for registration; country in which the product originates; proof of protection in the country of origin

HOW?

- Any of the 23 EU official languages

WHERE?

- Sent directly to the European Commission or via the authorities of the third country concerned

REGISTRATION OF GIs IN THE EU: Registration of the GI

REGISTRATION PROCESS:

1. **Reception and date of submission**
2. **Scrutiny of the application:**
 - **Agricultural products, foodstuffs and spirit drinks:** Maximum 6 months for examination
 - **Wines and aromatised wines:** No specified deadline for examination
3. **Publication of the application**
4. **Opposition:**
 - **Agricultural products, foodstuffs and spirit drinks:** 3 months for notice of opposition + 2 months for reasoned statement of opposition
 - **Wines and aromatised wines:** 2 months for duly substantiated statement
5. **Registration:** Inclusion in the official EU GIs register ([eAmbrosia](#))

DURATION OF THE REGISTRATION PROCESS

Around 18 months (regardless the type of good)

REGISTRATION OF GIs IN THE EU: Rights of registered GIs

RIGHTS CONFERRED TO REGISTERED GIs

- **Use the GI** on the compliant products
- **Cannot become generic in the EU**
- **Use the EU logos** (voluntary for foreign GIs)
- **Indefinite protection**
- **Take action against infringements**, such as:
 - **any direct or indirect commercial use** on comparable products not covered by the registration or to exploit the reputation of the protected name (also as ingredients or after transformation).
 - **misuse, imitation or evocation**, even if the true origin is indicated or if used in translation or accompanied by expressions such as 'style', 'type', etc.(also as ingredients).
 - **other false or misleading indication** on the inner or outer packaging, advertising material, documents, and packing of the product liable to convey a false impression as to its origin, nature, qualities, etc.;
 - **any other practice liable to mislead the consumer** as to the true origin of the product



ENFORCEMENT:
Ex officio by
EU Member States
and
Ex parte at the request
of concerned GI holders

International registration of GIs

INTERNATIONAL PROTECTION OF GIs: Means to protect your GI abroad

- **Direct application:** In each target country under national laws and regulations
- **Bilateral or plurilateral agreements:** Two or more States or trading partners agree to protect each other's GIs (standard of protection + often GI-list). Eg. EVFTA, EUSFTA, etc.
- **Multilateral agreements:**
 - **TRIPS Agreement (WTO):** Protection of GIs
 - **Madrid Protocol/Agreement (WIPO):** Registration of TMs
 - **Lisbon System (WIPO):** International protection of **Appellations of Origin (AOs) and Geographical Indications (GIs)** (Lisbon Agreement & Geneva Act)
 - **36 contracting parties, covering 55 countries** (Africa, Asia, Europe, Latin America & the Caribbean)
 - **For any type of product** (agricultural and foodstuffs, natural, artisanal and even industrial goods)
 - **A single registration procedure** with WIPO
 - **In one language** and with **only one set of fees**
 - **Protection in several countries** based on the **only legally binding international register**
 - For more info: [Lisbon homepage](#)

Conclusions

REGISTRATION OF GIs IN THE ASEAN REGION AND ABROAD: Conclusions

- **Registering your GI confers a powerful legal right** to develop and protect high-quality products from a specific geographical origin
- **Applicants must comply with the laws and regulations of each jurisdiction** to register their GI in ASEAN countries, in the EU or internationally
- **For registration of products that may qualify as GIs in your country, please contact the IP Office in your country for further information.**
- **ASEAN GIs may be protected in the EU**, through direct application or via bilateral agreements. In any case, the ASEAN GI **MUST** already be registered in its country of origin – Find out more on requirements for registration and forms in the [EU website](#)
- **International protection of ASEAN GIs is possible through the Lisbon System (WIPO)**: The ASEAN GI **MUST** already be registered in its country of origin **AND** the country of origin must be a contracting party of the Lisbon System (Lisbon Agreement or Geneva Act) – Find out more in the [Lisbon homepage](#)



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Questions and comments are welcome!



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