

4 Absolute grounds – Geographical indications

Trade mark containing a Geographical Indication (GI)

1. Introduction

Section 20(1) of the Trade Marks Act 2002 (“the Act”) prevents the registration of trade marks that contain geographical indications (“GIs”) in certain circumstances.

Where a trade mark contains a GI, the examiner will consider whether to object under section 20(1) of the Act. For the examiner to object, all the criteria in either section 20(1)(a), section 20(1)(b) or section 20(1)(c) must be met.

If the GI in the trade mark is registered in New Zealand, section 20(1)(a) is relevant and only two criteria must be met:

1. The trade mark specification includes goods covered by the GI that do not originate in the place the GI relates to; and
2. The use of the trade mark is considered likely to deceive or confuse.

If the GI in the trade mark is not registered in New Zealand yet, either section 20(1)(b) or section 20(1)(c) is relevant, and three criteria must be met:

1. The trade mark specification includes goods covered by the GI that do not originate in the place the GI relates to; and
2. The use of the trade mark is considered likely to deceive or confuse; and
3. The deemed date of registration of the GI is earlier than the deemed date of registration of the trade mark.

Under section 20(1) of the Act, a trade mark that contains:

- a registered GI, or
- a GI that is the subject of a pending application made in good faith, with priority over the trade mark,

may be registered, but only if it relates to a wine or spirit that originates from the relevant geographical area.

1. GI Register search

When an examiner receives a trade mark application in class 32 and/or class 33 that contains a geographical location, the examiner will search the GI Register to see if the location is already registered as a GI or subject to an application for a GI.

If the examiner finds a registered GI or pending application for a GI with an earlier priority date than the trade mark application, the examiner will raise an objection under s 20.

2. Trade mark contains a GI

For a trade mark to “contain” a GI for the purposes of section 20(1), the trade mark must contain or include the whole of the GI.

A trade mark that contains only part of a GI, or an acronym or abbreviation for the GI, will not be caught by section 20(1).

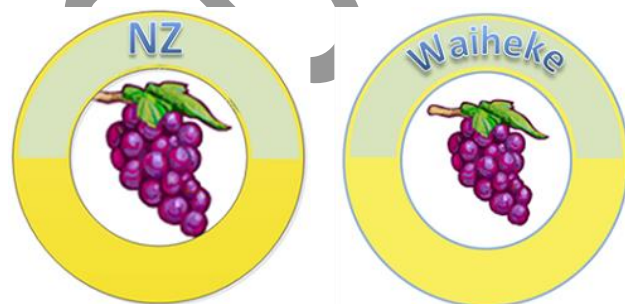
~~Examples~~ Example 1

~~These two trade marks contain GIs:~~ This trade mark contains two GIs:



This is because both “Marlborough” and “New Zealand” are registered New Zealand GIs.

However, these these two trade marks do not contain GIs:



While “New Zealand” is a GI, the acronym “NZ” is not. While “Waiheke Island” is a GI, “Waiheke” alone is not.

~~While Waiheke Island is a GI, Waiheke alone is not.~~

Example 2

This trade mark contains a GI:



This is because “Aceto Balsamico di Modena” is a registered European Union Free Trade Agreement (EU FTA) GI.

However, these two trade marks do not contain GIs:



While “Aceto Balsamico di Modena” is a GI, “Aceto” and “Balsamico” on their own are not.

3. Trade mark specification includes goods covered by the GI

Once the examiner has established that the trade mark contains a GI, the examiner must consider whether the trade mark specification includes goods covered by the GI that do not originate in the place the GI relates to.

To be caught by section 20(1) of the Act, a trade mark specification must include the wines, spirits, or other goods that the GI in the trade mark is for.

Where the trade mark specification includes a broad goods term in a class the GI relates to, the broad nature of the specification term may influence the decision on whether the trade mark specification includes the goods that the GI is for.

2.1 Wine or spirit from the place under the GI

For a trade mark to relate to a wine or spirit that originates in the place of geographical origin to which the GI relates, the specification of goods should clearly indicate that the goods are from that region.

2.1.1 Trade mark specification includes the good covered by the GI

To be caught by section 20, a trade mark specification must include the wine or spirit that the GI is for.

Where a trade mark applicant files a broad goods claim in either class 32 or class 33, the broad nature of the specification will influence the decision on whether the trade mark specification includes the goods that the GI is for.

Examples

A trade mark covering “alcoholic beverages” in class 33 will include the goods that a GI for “wine” covers, because “wine” is a subset of “alcoholic beverages”.

A trade mark covering “non-alcoholic beverages” in class 32 will include the goods that a GI for “wine” covers, because “de-alcoholised wine” is a subset of “non-alcoholic beverages” but is nonetheless wine.

- A trade mark covering “alcoholic beverages” in class 33 will include the goods that a GI for “wine” covers, because “wine” is a subset of “alcoholic beverages”.
- A trade mark covering “non-alcoholic beverages” in class 32 will include the goods that a GI for “wine” covers, because “de-alcoholised wine” is a subset of “non-alcoholic beverages” but is nonetheless wine.
- A trade mark covering “dairy products” in class 29 will include the goods that a GI for “cheeses” covers, because “cheese” is a subset of “dairy products”.

The following claims for goods are likely to be considered as follows: tables below include further illustrative examples.

<u>Class 29 goods term</u>	<u>GI goods</u>	<u>Specification covers the GI goods?</u>
<u>Dairy products</u>	<u>Cheeses</u>	<u>Yes</u>
<u>Butter</u>	<u>Cheeses</u>	<u>No</u>
<u>Milk products</u>	<u>Cheeses</u>	<u>Yes</u>
<u>Meat products</u>	<u>Cheeses</u>	<u>No</u>
<u>Meat products</u>	<u>Meats</u>	<u>Yes</u>
<u>Sausages</u>	<u>Meats</u>	<u>Yes</u>
<u>Preserved fruit</u>	<u>Olives</u>	<u>Yes</u>
<u>Pickles</u>	<u>Olives</u>	<u>Yes</u>
<u>Pickled cucumbers</u>	<u>Olives</u>	<u>No</u>
<u>Preserved fungi</u>	<u>Processed fruit and nuts</u>	<u>No</u>

<u>Frozen berries</u>	<u>Processed fruit and nuts</u>	<u>Yes</u>
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<u>Class 30 goods term</u>	<u>GI goods</u>	<u>Specification covers the GI goods?</u>
<u>Marzipan</u>	<u>Confectionery</u>	<u>Yes</u>
<u>Sauces</u>	<u>Vinegar</u>	<u>Yes</u>
<u>Condiments</u>	<u>Vinegar</u>	<u>Yes</u>
<u>Soy sauce</u>	<u>Vinegar</u>	<u>No</u>
<u>Rice</u>	<u>Cereals</u>	<u>Yes</u>
<u>Foodstuffs made primarily from grains</u>	<u>Cereals</u>	<u>Yes</u>
<u>Sugar</u>	<u>Honey</u>	<u>No</u>
<u>Molasses</u>	<u>Honey</u>	<u>No</u>
<u>Bee products</u>	<u>Honey</u>	<u>Yes</u>
<u>Natural sweeteners</u>	<u>Honey</u>	<u>Yes</u>

<u>Class 31 goods term</u>	<u>GI goods</u>	<u>Specification covers the GI goods?</u>
<u>Live seafood</u>	<u>Fresh fish, molluscs, and crustaceans and products derived therefrom</u>	<u>Yes</u>
<u>Fish meal for animal consumption</u>	<u>Fresh fish, molluscs, and crustaceans and products derived therefrom</u>	<u>Yes</u>
<u>Fresh strawberries</u>	<u>Fresh fruits and nuts</u>	<u>Yes</u>
<u>Seeds for growing fruits</u>	<u>Fresh fruits and nuts</u>	<u>Yes</u>
<u>Fresh spinach</u>	<u>Fresh fruits and nuts</u>	<u>No</u>
<u>Grass seeds</u>	<u>Fresh fruits and nuts</u>	<u>No</u>
<u>Agricultural products</u>	<u>Fresh fruits and nuts</u>	<u>Yes</u>
<u>Horticultural products</u>	<u>Fresh fruits and nuts</u>	<u>Yes</u>

<u>Trade mark class 32 item</u>	<u>Class 32 goods term</u>	<u>GI goods</u>	<u>Trade mark includes the GI good?</u>	<u>Specification covers the GI goods?</u>
	<u>Non-alcoholic beverages</u>	<u>Wines</u>		<u>Yes</u>
	<u>Alcohol free / de-alcoholised wine</u>	<u>Wines</u>		<u>Yes</u>
	<u>Fruit juice</u>	<u>Wines</u>		<u>No</u>
	<u>Grape juice</u>	<u>Wines</u>		<u>No</u>
	<u>Beer</u>	<u>Wines</u>		<u>No</u>
	<u>Non-alcoholic beverages</u>	<u>Spirits</u>		<u>Yes</u>
	<u>Non-alcoholic spirits</u>	<u>Spirits</u>		<u>Yes</u>
	<u>Beer</u>	<u>Spirits</u>		<u>No</u>
	<u>Non-alcoholic beverages</u>	<u>Beer</u>		<u>Yes</u>

<u>Lagers</u>	<u>Beer</u>	<u>Yes</u>
<u>Ale</u>	<u>Beer</u>	<u>Yes</u>

<u>Trade mark class 33 item</u> <u>Class 33</u> <u>goods term</u>	<u>GI goods</u>	<u>Trade mark includes the GI</u> <u>good?</u> <u>Specification covers the GI</u> <u>goods?</u>
<u>Alcoholic beverages</u>	<u>Wines</u>	<u>Yes</u>
<u>Low alcohol wine</u>	<u>Wines</u>	<u>Yes</u>
<u>Cider</u>	<u>Wines</u>	<u>No</u>
<u>Spirits</u>	<u>Wines</u>	<u>No</u>
<u>Alcoholic beverages</u>	<u>Spirits</u>	<u>Yes</u>
<u>Wine</u>	<u>Spirits</u>	<u>No</u>
<u>Vodka</u>	<u>Spirits</u>	<u>Yes</u>
<u>Fruit brandies</u>	<u>Spirits</u>	<u>Yes</u>
<u>Liqueurs</u>	<u>Spirits</u>	<u>No</u> <u>Yes</u>

2.1.2 Unqualified goods do not clearly originate in place of geographic origin

Where the goods in the trade mark specification include the goods that the GI is for, without a qualification stating that they originate in the place to which the GI relates, the examiner will raise a section 20 objection.

For example, if a GI relates to “wine”, and a trade mark containing that GI is in class 33 for unqualified “wine” or unqualified “alcoholic beverages”, the goods covered by the trade mark do not indicate that they originate in the place of geographic origin to which the GI relates. Therefore, the examiner will raise a section 20 objection.

4. Use of the trade mark is likely to deceive or confuse

Where the trade mark contains a GI, and the trade mark specification includes goods covered by the GI that do not originate in the place the GI relates to, examiners must consider whether the use of the trade mark is likely to deceive or confuse.

Where the trade mark contains a GI, confusion or deception will be considered likely if the trade mark specification includes goods covered by the GI that do not:

- originate in the place the GI relates to, and/or
- comply with the other requirements of the GI, such as the means of production of the goods.

4.1 Trade mark contains a registered GI

Use of the trade mark will be considered likely to deceive or confuse and the examiner will raise a section 20(1) objection if:

1. The trade mark contains a GI that is registered in New Zealand; and
2. The trade mark specification includes goods that the GI is for; and
3. It is not clear that those goods originate in the place the GI relates to and meet the other criteria for that GI (if any).

If the GI contained in the trade mark is registered in New Zealand, examiners do not need to consider the deemed dates of registration of the GI and the trade mark.¹

Example 1

- The mark contains a GI that is registered in New Zealand for “wines”.
- The trade mark application is in class 33 for “alcoholic beverages; wine”.

In this situation it is not clear that the “alcoholic beverages” and “wine” covered by the trade mark originate in the place the GI relates to and meet the other criteria for that GI. Therefore, the examiner will raise a section 20(1) objection that applies to the entire class 33 specification.

Example 2

- The mark contains a GI that is registered in New Zealand for “cheeses”.
- The trade mark application is in class 29 for “dairy products; cheese; yoghurt; butter; meat products”.

In this situation it is not clear that the “dairy products” and “cheese” covered by the trade mark originate in the place the GI relates to and comply with the other requirements for that GI. Therefore, the examiner will raise a section 20(1) objection in relation to the “dairy products” and “cheese” terms in the trade mark specification.

4.2 Trade mark contains a GI that is not registered yet

Where the trade mark contains a GI that is not registered in New Zealand yet, the deemed dates of registration of the GI and the trade mark must also be considered.

Use of the trade mark will be considered likely to deceive or confuse and the examiner will raise a section 20(1) objection if:

1. The trade mark contains a GI that is the subject of:
 - a. an application to register a New Zealand GI or a foreign GI, or
 - b. a proposed registration of an EU FTA GI; and
2. The trade mark specification includes goods that the GI is for; and
3. It is not clear that those goods originate in the place the GI relates to and meet the other criteria for that GI; and
4. The deemed date of registration of the GI is earlier than the deemed date of registration of the trade mark.

The deemed dates of registration of pending GIs are calculated as follows.

<u>Pending GI type</u>	<u>Deemed date of registration of the GI</u>
<u>Application to register a New Zealand GI</u>	<u>Date of the application for registration²</u>

<u>Application to register a foreign GI</u>	<u>Date of the application for registration³</u>
<u>Proposed registration of an EU FTA GI</u>	<u>Date on which the Registrar gives public notice of the proposed registration⁴</u>

2.2 Confusion or deception

Under section 20, examiners also need to consider whether the use of the trade mark under examination is likely to deceive or confuse. If a trade mark contains a registered GI, or a GI that is the subject of an application with priority over the trade mark, and the goods in the trade mark specification include those covered by the GI and do not originate from the place to which the GI relates, confusion or deception is likely.

3-5. Overcoming an s section 20(1) objection

If the trade mark meets all of the criteria set out in section 20(1), the examiner will object to the trade mark under section 20 of the Act.

To overcome a section 20 objection, ~~an~~ The applicant may elect to amend the specification be able to overcome the section 20(1) objection in one of the ways outlined below.

5.1 Restricting the specification terms covered by the GI to goods that originate in the GI place and meet the criteria for the GI

The applicant may be able to overcome the section 20(1) objection by limiting the goods covered by the GI that are in the trade mark specification. To overcome the objection, the specification must indicate clearly that those goods originate in the place the GI relates to and meet the other criteria for the GI.

5.1.1. Recommended wording for specification amendments designed to overcome a section 20(1) objection

Applicants can use the Office's recommended wording, as shown in the tables below. These tables recommend wording according to the type of GI that appears in the trade mark and whether that GI is registered in New Zealand.

All the recommended wordings below indicate clearly that the goods originate in the place the GI relates to and meet the other criteria for the GI (if any).

Table 1: Enduring New Zealand GIs

<u>Acceptable specification format</u>	<u>Examples</u>
<u>[wines or spirits] made in New Zealand</u>	<u>wines made in New Zealand</u>

<u>[wines or spirits] made in the North Island of New Zealand</u>	<u>spirits made in the South Island of New Zealand</u>
<u>[wines or spirits] made in the South Island of New Zealand</u>	
<u>[wines or spirits]; all the aforesaid made in New Zealand</u>	<u>wines; all the aforesaid made in New Zealand</u>
<u>[wines or spirits]; all the aforesaid made in the North Island of New Zealand</u>	<u>alcoholic beverages including wines and spirits; all the aforesaid made in the North Island of New Zealand</u>
<u>[wines or spirits]; all the aforesaid made in the South Island of New Zealand</u>	
<u>“New Zealand” (GI) [wines or spirits]</u>	<u>“New Zealand” (GI) wines</u>
<u>“North Island” (GI) [wines or spirits]</u>	<u>“South Island” (GI) wine</u>
<u>“South Island” (GI) [wines or spirits]</u>	

Table 2: Registered New Zealand GIs (other than enduring GIs)

Acceptable specification format	Examples
<u>“[GI name]” (GI) [wines or spirits]</u>	<u>“Waiheke Island” (GI) wines</u> <u>“Bannockburn” (GI) wine</u>

Table 3: Registered foreign GIs

Acceptable specification format	Examples
<u>“[GI name]” (GI) [wines or spirits]</u>	<u>“Napa Valley” (GI) wines</u> <u>“Pisco” (GI) spirits</u> <u>“Scotch Whisky” (GI) spirits</u>

Table 4: Application to register a foreign GI

Acceptable specification format	Examples
<u>[wines or spirits]; all the aforesaid complying with the specifications of the geographical indication “[GI name]” protected in [country of origin]</u>	<u>Whisky; all the aforesaid complying with the specifications of the geographical indication “Single Malt Welsh Whisky” protected in the United Kingdom</u> <u>Wines; all the aforesaid complying with the specifications of the geographical indication “Barossa Valley” protected in Australia</u>

Table 5: Registered EU FTA GIs

Acceptable specification format	Examples
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<u>“GI name” (GI) [products covered by the GI]</u>	<u>“Jabugo” (GI) meats</u> <u>“Abondance” (GI) cheeses</u> <u>“Throumpa Thassou” (GI) olives</u> <u>“Lübecker Marzipan” (GI) confectionery</u> <u>“Aceto Balsamico di Modena” (GI) vinegar</u> <u>“Bordeaux” (GI) wines</u> <u>“Irish Whiskey” (GI) spirits</u>
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Table 6: Proposed registration of an EU FTA GI

<u>Acceptable specification format</u> <u>[products covered by the EU FTA GI]; all the aforesaid complying with the specifications of the geographical indication “[GI name]” protected in [country of origin]</u>
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5.1.2 Specification amendments where the trade mark contains more than one GI

Where a trade mark contains two or more GIs, the applicant may not need to reference every GI in an amendment to the specification that is designed to overcome the section 20(1) objection.

This is likely to be possible where the trade mark contains two New Zealand GIs for wines or spirits, one of which is an enduring New Zealand GI, for example. The three enduring New Zealand GIs are “New Zealand”, “North Island” and “South Island”.



In the example above, the mark contains two registered GIs: “Marlborough” and “New Zealand”. The place of geographical origin for the “Marlborough” GI falls within the place of geographical origin for the “New Zealand” GI, and the enduring GI “New Zealand” has no other requirements. In this situation, amending the specification so it references the more specific GI “Marlborough” would overcome the section 20(1) objection, as shown below.

“Marlborough” (GI) wine

Proposed specification amendments for trade marks that contain two or more GIs will be assessed on a case-by-case basis.

Where the trade mark contains more than one GI, the section 20(1) objection will only be withdrawn when the amendment to the trade mark specification means deception or confusion is unlikely in relation to *any* of the GIs that appear in the trade mark.

5.1.3 Where the GI in the trade mark is the subject of an application to register a New Zealand GI

Where the GI in the mark is the subject of an application to register a New Zealand GI, it will not be possible to overcome the section 20(1) objection by amending the specification until the New Zealand GI is registered (should that occur).

If necessary, applicants in this situation can file requests for extensions of time. The Office will consider such requests on a case-by-case basis.

Where a section 20(1) objection has been raised because the mark contains a GI that is the subject of an application to register a New Zealand GI, the onus is on the applicant to monitor the status of the GI application.

If the New Zealand GI ends up being registered, the applicant may be able to overcome the section 20(1) objection by amending the specification using the wording recommended in Table 2 of section 5.1.1 above.

If the application to register the New Zealand GI is not successful, it is the responsibility of the applicant to advise IPONZ once the application for the New Zealand GI has been marked as no longer live on the IPONZ GI register. Upon receipt of this advice, the examiner will withdraw the section 20(1) objection.

3.1 Restricting the specification to wine and/or spirits from the GI

The applicant may elect to qualify the goods included in the trade mark specification so that it is clear that the goods originate within the place to which the GI relates.

The applicant can use the Office's standard wording employed in the examples below.

Example 1: Where a GI is registered

A GI MARLBOROUGH has been registered in respect of "wine" and the trade mark shown below is in class 32 for "de-alcoholised wine; fruit juices; aerated water".



The applicant could amend the specification so that that it is clear that the “de-alcoholised wine” in the specification originates in the place to which the GI relates.

The following qualification to the specification would be acceptable:

“De-alcoholised wine, the aforesaid wine originating within the geographical indication **MARLBOROUGH** registered under the Geographical Indications (Wine and Spirits) Registration Act 2006; fruit juices, aerated water”.

Example 2: Where the GI is registered—(Enduring New Zealand GI)

A trade mark contains an enduring New Zealand GI, for example the trade mark shown below is in class 33 for “wine”.



The applicant could amend the specification so that that it is clear that the “wine” in the specification originates in the place to which the GI relates.

The following qualification to the specification would be acceptable:

“Wine, the aforesaid wine originating within the geographical indication **NEW ZEALAND** registered under the Geographical Indications (Wine and Spirits) Registration Act 2006”.

Example 3: Where the GI has been applied for but is not registered

A GI **MARLBOROUGH** has been applied for in respect of “wine” and the trade mark shown below is in class 33 for “wine”.



The applicant could amend the specification so that that it is clear that the “wine” in the specification originates in place to which the GI relates.

Where two or more GIs feature in a trade mark, the applicant need only reference the most specific GI in the qualification to the specification. In this example the most specific GI is Marlborough.

The following qualification to the specification would be acceptable:

“Wine, the aforesaid wine originating within the geographical indication MARLBOROUGH applied for under the Geographical Indications (Wine and Spirits) Registration Act 2006.”

3.25.2 Deleting ~~wine and/or spirits~~the goods covered by the GI from the specification

The applicant may elect to limit the trade mark specification so that it does not include the goods that the GI ~~is for~~covers.

Example 1

A GI MARLBOROUGH has been applied for in respect of “wine” and the trade mark shown below is in class 33 for “wine, vodka, whiskey”. “Marlborough” is a registered GI for “wines”. An application for the trade mark shown below is in class 33 for “wine, vodka, whiskey”. A section 20(1) objection has been raised.



The following limitation to the specification would be acceptable: Amending the specification to the following will overcome the section 20(1) objection:

“Vodka, whiskey.”

Example 2

A GI MARLBOROUGH has been registered in respect of “wine” and the trade mark shown below is in class 32 for “non-alcoholic beverages”. “Marlborough” is a registered GI for “wines”. An application for the trade mark shown below is in class 32 for “non-alcoholic beverages”. A section 20(1) objection has been raised.



The applicant could clarify the goods that fall within the umbrella term “non-alcoholic beverages”, making it clear that the goods specified do not include “de-alcoholised wine”.

The following limitation to the specification would be acceptable: Amending the specification to the following will overcome the section 20(1) objection, for example:

“Grape juice, aerated water.”

3.35.3 Honest concurrent use

Under section 20(2) of the Act, a trade mark containing a GI may proceed to acceptance if a case of honest concurrent use exists that, in the opinion of the Commissioner or the Court, makes it “proper” for the trade mark to be registered, subject to any conditions the Commissioner or the court may see fit to impose.⁵

If a mark contains a GI, but the goods do not originate in the place of geographical origin to which the GI relates to or meet the other criteria for that GI, an applicant may engage the application may proceed to acceptance under section 20(2) of the Act where they the applicant can prove honest and longstanding use of their trade mark, prior to the priority deemed date of registration of the GI.

Responses attempting to demonstrate honest concurrent use will be assessed on a case-by-case basis.

5.3.1 ‘Gruyère’ in the trade mark

Under the New Zealand-European Union Free Trade Agreement, businesses that have been using the term ‘Gruyère’ on cheese products in good faith for a period of at least 5 years before 1 May 2024 may continue to do so, on goods that do not comply with the requirements of the ‘Gruyère’ EU FTA GI. However, this use of the term ‘Gruyère’ must be accompanied by a legible and visible indication of the geographical origin of the goods.

If a section 20(1) objection has been raised because the trade mark includes ‘Gruyère’, examiners may be able to allow the application to proceed under section 20(2) of the Act. The evidence of honest concurrent use provided by the applicant will need to demonstrate that the applicant has been using the term ‘Gruyère’ continuously, for at least 5 years before 1 May 2024, on cheese products that do not comply with the requirements of the ‘Gruyère’ EU FTA GI.

Evidence in relation to the use of ‘Gruyère’ on cheese products will be considered on a case-by-case basis.

Where the examiner considers the evidence is sufficient to establish a case of honest concurrent use, the section 20(1) objection will only be withdrawn if the applicant agrees to enter the following condition on the register:

It is a condition of registration that the mark will always be accompanied by a legible and visible indication of the geographical origin of the goods.

Footnotes

¹ Section 20(1)(a) of the Act applies when the GI contained in the trade mark is registered in New Zealand, and section 20(1)(a) does not require consideration of the respective deemed dates of registration.

² Geographical Indications Registration Act 2006, s 9(1).

³ Geographical Indications Registration Act 2006, s 9(1).

⁴ Geographical Indications Registration Act 2006, s 59.

⁵ Trade Marks Act 2002, s 20(2).

SUPERSEDED