

**Council for Trade-Related Aspects
of Intellectual Property Rights**

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**REVIEW UNDER ARTICLE 24.2 OF THE APPLICATION OF THE
PROVISIONS OF THE SECTION OF THE TRIPS AGREEMENT
ON GEOGRAPHICAL INDICATIONS**

Responses to the Checklist of Questions¹

Addendum

ICELAND

The present document represents the responses to the Checklist which the Secretariat has received from Iceland by means of a communication from its Permanent Mission, dated 4 February 1999.

RESPONSES TO THE QUESTIONS IN DOCUMENT IP/C/13²

A. GENERAL

1. *Is protection for geographical indications provided through unfair competition law, e.g., passing off, false designation of origin; through a formal procedure for notification/registration before protection is available; or through both? Does the recognition of a geographical indication require registration?*

The protection of geographical indications is provided through provisions in the Icelandic Competition Act, No. 8 of 9 July 1993. There is no formal procedure for notification or registration before protection is available. Registration is not required for recognition of a geographical indication.

2. *Is there one single regime of protection of geographical indications for all products? If not, identify the different regimes.*

The Icelandic Competition Act provides the general protection of geographical indications, i.e. prohibition against unfair competition and misleading advertising. A single regime of geographical protection does not exist. However, the general clause in Article 11 of The Icelandic Food Act, No. 93 of 28 June 1995, stipulates that foodstuffs must not be sold under circumstances which can result in the consumer being misled concerning the origin of the product, nature, sort, composition, quantity, characteristics or effect.

¹ Documents IP/C/13 and IP/C/13/Add.1.

² The Permanent Mission of Iceland has informed the Secretariat that the responses to the questions in document IP/C/13/Add. 1 will be submitted shortly.

Article 14.1.2 of the Icelandic Trademark Act also provides for a protection for geographical indications and in paragraph 3 of Article 14 there is a special provision regarding wines and spirits.

3. *Do(es) the regime(s) of protection of geographical indications also extend to services?*

The protection ensured through the Acts mentioned in the preceding answers applies to all kinds of marketing practices incompatible with good marketing practices; the protection extends also to services.

4. *What provisions of law or regulations are directed to the recognition of geographical indications required by Articles 22.2 and 23.1 of the TRIPS Agreement? Citations to laws should be provided and, if the texts of the laws have not been notified to the WTO, copies should be provided pursuant to Article 63.2.*

Article 21 of the Icelandic Competition Act, No. 8 of 9 July 1993, provides for a protection against misleading advertising. This provision includes the use of geographical indications calculated to mislead.

In Article 29, paragraph 3, there is a special provision which prohibits the sale of goods of foreign origin, if the goods have been marked with the Icelandic flag, Iceland's coat of arms or other similar markings of national origin.

According to Article 11 of The Icelandic Food Act, No. 93 of 28 June 1995, foodstuffs must not be sold under circumstances which can result in the consumer being misled concerning the origin of the product.

In respect of trademarks, the provisions in Article 14.1.2 and 14.3 of the Trademark Act are in compliance with Articles 22.2 and 23.1 of the TRIPS Agreement.

5. *If the required recognition of geographical indications is not provided through statutes or regulations, please explain, in detail, the mechanism or mechanisms through which the protection required is provided.*

The protection is provided through the provisions of the Acts mentioned in the preceding answers.

6. *Please provide a few examples of domestic geographical indications protected in accordance with the means discussed above and indicate the means by which such protection is provided.*

There are no cases.

7. *Is the higher level of protection required for wines and spirits under Article 23.2 of the TRIPS Agreement provided for any other product? If so, please specify such products and the law under which they are protected.*

The higher level of protection for wines and spirits is not provided for any other product.

B. DEFINITION AND CRITERIA FOR RECOGNITION

8. *How are geographical indications defined?*

Geographical indications are not specially defined. The Icelandic Competition Act and the Food Act provide for a general prohibition against acts which can mislead the public. This would include all kinds of misleading information about the geographical origin of the product or service.

9. *Would such a definition comprise geographical indications identifying products of a certain quality or reputation which are indirectly linked to a specific region?*

The protection applies to all kinds of misleading information, it will probably cover such indirect links to specific regions.

10. *In determining whether recognition should be given a geographical indication, what criteria are considered?*

In determining whether recognition should be given a geographical indication, the main criterion is whether the geographical indication is known as a geographical indication by the public.

11. *Is there any human creativity involved in the making of specific products under protection by the system of geographical indications? If so, how much? And do these products involve any human factors?*

There does not have to be any human creativity involved in the making of geographical indication whose use could be prohibited under the Competition Act or other Acts mentioned in response to previous questions.

12. *Are there any other intellectual property rights involved, such as patents for example?*

Other intellectual property rights may be involved in cases where the geographical indication is applied for as a trademark according to the Icelandic Trademarks Act.

13. *What authority, if any, may define the geographic region or area for which rights are claimed and on what basis is such definition made?*

There is no authority which generally "defines" the geographic region or area for which rights are claimed. Principally, it is the Court which decides whether the use of a geographical indication is misleading according to the Acts mentioned in the answers to the preceding questions. However, the Competition Authorities may, in their decisions concerning misleading geographical indication, have to define a geographic region.

14. *Does your legislation contain criteria for homonymous geographical indications for wines?*

The interpretation of the Icelandic Competition Act and Food Act is always based on a specific judgement of how a homonymous geographical indication is able to mislead the public as to the origin of wine.

15. *Does your national legislation provide for recognition and protection of geographical indications or appellations of origin of foreign countries?*

The proceedings relating to the use of a misleading geographical indication as mentioned in response to previous questions apply to all indications no matter the origin.

16. *Is there any specific prohibition in the legislation/regulations/rules/procedures covering geographical indications not protected in the country of origin? If so, please specify the relevant statutory provision.*

There are no specific provisions concerning the protection of geographical indications which are not protected in their country of origin.

C. PROCEDURE FOR RECOGNITION

17. *With respect to any formal system for recognition of geographical indications, must the applicant be a governmental organization or can a private entity own the rights to a geographical indication?*

There is no formal system for recognition of geographical indications.

18/19. *What are the competent authorities where the protection of a geographical indication can be obtained? Do the procedures which lead to the recognition of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

The protection of geographical indications can be obtained through the procedures laid down in the Icelandic Competition Act.

20. *What, if any, fees are involved in the application and maintenance of rights in a geographical indication?*

There are no fees involved.

21/22/23/24. *If criteria must be set out in an application for recognition of a geographical indication, are those criteria purely geographic in nature? What other criteria, if any, must be set out in an application for recognition of a geographical indication? What information must be supplied in an application for rights in a geographical indication? Must the goods or services with respect to which a geographical indication is claimed be set out?*

No criteria or information are to be set out in this context (cf. the reply to the previous questions).

25/26/27. *What mechanisms are provided to oppose the recognition of a geographical indication? How is an investigation conducted after such a complaint? Who can oppose the recognition of a geographical indication? If your national legislation provides for recognition and protection of geographical indications or appellations of origin of foreign countries, what is the procedure that has to be followed in order to obtain such recognition and consequent protection?*

The protection of geographical indications in Iceland is not based on a system of recognition but rather on prohibition against misleading use of a geographical indication. The recognition of a geographical indication is in this context based on procedure before the Competition Authorities or a normal court procedure where the defendant has the possibility of opposing the claim that his indication is misleading.

D. MAINTENANCE

28. *How long does recognition for a geographical indication continue?*

There is no prescribed time-limit.

29. *If recognition of a geographical indication must be renewed or reaffirmed, what information must be provided in order to effect such a renewal or reaffirmation? Specify any fees involved in renewal or reaffirmation.*

There is no such specific system for renewal or reaffirmal of the protection of geographical indications.

30. *Must a geographical indication be used in order to maintain rights? If so, how is such use determined?*

There are no requirements of use in this context.

31. *Is there a specified limit for non-use before rights in a geographical indication cease and, if so, what is that limit?*

There are no provisions on specified limits for non-use in this context.

32. *Who monitors the use of geographical indications to determine if the criteria identified in the application continue to be met?*

There are no specific provisions laid down in this context.

33. *If a government entity is responsible for monitoring the use of geographical indications, what are its procedures for doing so?*

There are no specific provisions laid down in this context.

34. *Are there means by which interested parties may request termination of a geographical indication based on non-use or failure to maintain the criteria identified in the application? Describe the procedure.*

There are no such means.

35. *Do the procedures which lead to forfeiture of a geographical indication take place ex officio or must they be based on the initiative of an entity or person?*

Actions against misleading use of a geographical indication can be initiated both by the Icelandic authorities and by other entities or persons having a "legal interest" in the matter.

E. SCOPE OF RIGHTS AND USE

36. *May anyone who meets the criteria submitted to obtain recognition of a geographical indication use that geographical indication after recognition is given or must additional criteria or procedures be followed by that party before use is permitted?*

If someone is entitled to use a geographical indication which is not misleading, no additional criteria are required.

37. *Who makes the determination regarding use of a geographical indication by particular parties, the entity responsible for the recognition or the entity that obtained the recognition?*

This issue is decided in the particular proceeding before the Competition Authorities or by the Court.

38. *Are there fees involved in receiving authorization to use a particular geographical indication and, if so, what are those fees and how are they established?*

There are no fees involved in this context.

39. *If there is a dispute regarding use of a geographical indication by a particular party, what procedures are followed to resolve it?*

The normal procedures under the Icelandic Competition Act would apply.

40. *Must individual authorized users of a geographical indication use that geographical indication continually to retain their right to use it and, if so, how is their use determined and how long will disuse be permitted?*

There are no specific provisions in this respect.

41. *If there is a dispute over continuity of use by a particular party, how is it resolved?*

Such conflicts are resolved through the normal procedures under the Competition Act.

42. *Does the regime for protection of geographical indications allow geographical indications to be licensed and, if so, what conditions are imposed on such licenses? If such conditions are not met, what is the effect on the geographical indication?*

There are no licensing provisions concerning geographical indications.

43. *How is "grandfathered use" of a geographical indication, under Article 24.4 of the TRIPS Agreement, applied in your country?*

There are no provisions in this respect, but the "grandfather use" will be considered by the competent authorities if claimed by one of the parties.

F. RELATIONSHIP TO TRADEMARKS

44. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.1 of the TRIPS Agreement are not nullified and impaired?*

According to the Icelandic Trademark Act, a trademark that consists solely of a geographical indication cannot be registered except if it has acquired distinctiveness through use (Articles 13 and 14). Many figurative marks which contain geographical indications as an element can, however, be registered, if the applicant resides in the region or if the products originate from the region. Such trademark registration will not be affected by a subsequent recognition of a geographical indication.

45. *What steps are taken to ensure that, in recognizing a geographical indication, the obligations of Article 16.2 and 16.3 of the TRIPS Agreement are not nullified and impaired?*

Reference is made to the answer to question No. 44 above.

46. *What procedures are foreseen in case of a conflict of a geographical indication with a trademark?*

The procedures are the normal procedures which apply in case of any trademark conflict, i.e. both administrative procedures and normal civil procedures before the courts of law. According to Article 22 of the Icelandic Trademark Act, interested parties can oppose the registration of a trademark. The opposition shall be filed to the Patent Office. In Chapter III of the Icelandic Trademark Act, there are provisions concerning cancellation of registration. A trademark which has been registered contrary to the Act may be cancelled by verdict of a Court.

G. ENFORCEMENT

47. *How are rights in the geographical indication enforced? Are provisions available under unfair competition law? Trademark law? Other laws? Provide citations to the laws and, if they have not been notified under Article 63.2 of the TRIPS Agreement, please provide copies.*

The grounds for refusal are laid down in Articles 13 and 14 of the Trademark Act. According to Article 22 of the Icelandic Trademark Act, interested parties can oppose the registration of a trademark. The opposition shall be filed to the Patent Office. In Chapter III of the Icelandic Trademark Act, there are provisions concerning cancellation of registration. A trademark which has been registered contrary to the Act may be cancelled by verdict of a Court.

According to Article 21 of the Competition Act, misleading information, including geographical indications, are prohibited. In Chapter 13 of the Competition Act, there are provisions concerning the enforcement procedure and sanctions applicable.

48. *Who has the right to enforce a geographical indication?*

The Icelandic authorities (The Patent Office) ensure ex officio as a part of the examination procedure and opposition procedure from third parties that geographical indications are not registered as trademarks.

The Competition authorities can bring actions against the users of misleading information regarding geographical indications.

Furthermore, any person or entity is entitled to enforce a geographical indication (cf. the Icelandic Trademarks Act and the Competition Act.)

49. *What judicial or administrative bodies have jurisdiction over enforcement actions related to geographical indications? Are there fees involved and, if so, what are those fees?*

Measures in this respect can be taken by courts of law and by the Competition Authorities.

50. *Must the public be notified of the existence of a geographical indication and, if so, how and how often?*

There are no provisions on notifying the public about the existence of geographical indications.

51. *Is unauthorized use of a geographical indication subject to criminal action and, if so, describe the procedures. If the law has not been notified pursuant to Article 63.2 of the TRIPS Agreement, please provide a copy.*

The sanctions against violations of the Competition Act are fines, punitive custody or imprisonment for up to four years in serious cases. Deprivation of rights in accordance with Article 68 of the General Penal Act may be adjudged and fines be adjudged concurrently with custody or imprisonment, if the conditions set in Article 49 of the General Penal Act are fulfilled.

H. INTERNATIONAL AGREEMENTS

52. *Is your government party to an international, including bilateral or plurilateral, agreement for the notification and/or registration of geographical indications? If so, please name the international agreement and explain the relationship between it and your national legislation.*

Iceland is not party to any agreement with specific aim of protecting geographical indications, but Iceland is party to the Madrid Protocol, the Paris Convention and of course the TRIPS Agreement.

53. *What other international agreements, if any, have been entered into? What do those agreements provide?*

Iceland is not party to any other agreements in this field.
