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A Discourse on the Malaysian Geographical Indications Act

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Article	Abstract
<p>Keywords: Geographical Indications; Malaysia; Regional Comprehensive Economic Partnership.</p> <p>Article History Received: Mar 4, 2023; Reviewed: Jul 20, 2023; Accepted: Jul 30, 2023; Published: Jul 31, 2023.</p> <p>DOI: 10.28946/slrev.Vol7.Iss2.2741.pp368-383</p>	<p>The Malaysian Parliament approved three Bills on Intellectual Property rights. One of it is the Geographical Indications Bill 2021, repealing the Geographical Indications Act 2000 (the Old Act). The new Bill received royal assent on 16 March 2022 and came into operation on 18 March 2022, known as the Geographical Indications Act 2022 (the New Act). The revisions made in the New Act were essential to harmonise intellectual property standards in Malaysia and facilitate the country's accession to the Marrakesh Treaty. These amendments ensure that Malaysia adheres to the World Trade Organization's Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) and fulfils its obligations under the Regional Comprehensive Economic Partnership (RCEP). The purpose of this paper is to examine the salient features introduced by the provisions of the New Act and to examine how the enhanced provisions attempt to realign intellectual property standards in Malaysia concerning Malaysia's broader obligations under the Regional Comprehensive Economic Partnership which have come into effect in Malaysia on 18 March 2022. The methodology employed in this research is doctrinal, especially focusing on the interpretation and analysis of the statutory provisions. In light of the changes in the New Act, New Regulations and the New Guidelines, the paper concludes by forwarding several recommended best practices to be considered by registered proprietors in the country.</p>

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INTRODUCTION

A geographical indication is a distinctive indicator, often consisting of one or more words, that identifies certain goods as originating from a specific nation or territory.¹ Goods are often associated with specific qualities, reputations, or distinctive features closely tied to their geographical origin. Traditionally, the meaning of geographical indications included two interpretations: the indication of source and the appellations of origins.² Over the years, it has commonly been

¹ Calboli, Irene, and Wee Loon Ng-Loy, *Geographical Indications at the Crossroads of Trade, Development, and Culture* (Cambridge University Press, 2017).

² Article 2 of the "Lisbon Agreement provides for the protection of appellations of origin, that is, the "geographical denomination of a country, region, or locality, which serves to designate a product originating

understood to refer to the source of a particular product.³ For example, geographical indications in Malaysia include "Sarawak pepper", which is produced in Sarawak, "Sabah Tea" from Sabah, and even other non-agricultural products such as handcrafts from Terengganu and *Batik* from Sabah. These products are well known with a strong specificity and are protected under the laws in Malaysia. Although there is, to some extent, an overlap between the law of trademarks and the law of passing off, some of the characteristics that set geographical indications apart from trademarks are that they do not serve to identify a commercial enterprise as the manufacturing source of the goods.⁴ Instead, the geographical indications provide information to consumers on the important attributes of the products, which may then be useful for decision-making in purchasing. For example, in the case of *Maestro Swiss Chocolate Sdn Bhd & Ors v Chocosuisse Union Des Fabricants Suisses De Chocolate & 2 Ors*, it was held that the word "Swiss" used with chocolates denoted chocolates which have been manufactured in Switzerland. If the defendants were to use "Maestro Swiss" in Malaysia, it would lead the local consumers to believe that their Maestro Swiss chocolates were manufactured in Switzerland.⁵ This highlights that geographical indications cannot be created but can only be accepted and recognised from its origin or region.

At an international level, geographical indications are protected under the Madrid and Lisbon Agreements administered by the World Intellectual Property Organization and the Paris Convention. Significant advancement was made when geographical indications received protection under the TRIPS Agreement in 1994. Article 22.1 of the TRIPS Agreement provides a comprehensive definition of geographical indications. It states that geographical indications identify a product as originating in the territory of a member country or a specific region or locality within that territory. The identification is made on the basis that the product possesses specific qualities, reputation, or other characteristics that are essentially linked to its geographical origin.⁶

There are other provisions of the TRIPS Agreement that regulate geographical indications. Article 22.2 "requires members to provide legal means to prevent misleading the public as to the origin of the goods, which can constitute an act of unfair competition."⁷ Article 23 of the

therein, the quality or characteristics of which are due exclusively or essentially to the geographic environment, including natural and human factors." Available at:

https://www.wipo.int/treaties/en/registration/lisbon/summary_lisbon.html; See also: Blakeney, Michael. *The Protection of Geographical Indications: Law and Practice*. Edward Elgar Intellectual Property Law and Practice, 2014.

³ C. Niranjan Rao, "Geographical Indication in Indian Context: A Case Study of Darjeeling Tea," *Economic and Political Weekly* Vol. 40, no. 42 (2005).; Dev Gangjee, *Relocating the Law of Geographical Indications* (Cambridge University Press, 2012).

⁴ Pek San Tay, "Intellectual Property Law in Malaysia," in *Sweet & Maxwell*, 2021, 265.

⁵ Pek San Tay.

⁶ Antony Taubman, Hannu Wager, and Jayashree Watal, *A Handbook on the WTO TRIPS Agreement* (Cambridge University Press, 2020).

⁷ Article 22.2 Protection of Geographical Indications 2. In respect of geographical indications, "Members shall provide the legal means for interested parties to prevent: (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; and (b) any use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention (1967)." Available at:

TRIPS Agreement provides a higher level of protection “for wine and spirits in which it prohibits the use of geographical indication in connection with products not originating from the designated geographical region, regardless of whether the true origin is indicated or it is used in conjunction with words such as kind or type, style, imitation or the like.”⁸ In order to comply with Articles 22-24 of the TRIPS Agreement, Malaysia enacted the Geographical Indications Act 2000, which is now replaced by the Geographical Indications Act 2022. Correspondingly, Section 2 of the Geographical Indications Act 2000 provided that a “geographical indication to be an indication which identifies any goods as originating in a country or territory, or a region or locality in that country or territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to their geographical origin.” The New Act has retained this interpretation.⁹ It has been stated that the amendments introduced in the New Act were needed to align intellectual property standards in Malaysia and pave the way for the country to access the Marrakesh Treaty. Meeting standards under the TRIPS agreement and complying with the obligations under the Regional Comprehensive Economic Partnership (‘the RCEP’), which came into effect on January 1, 2022.¹⁰ The purpose of this study is to examine the salient provisions introduced by the New Act and how the enhanced provisions in the New Act attempt to realign intellectual property standards in Malaysia concerning Malaysia's broader obligations under the RCEP, which came into effect in Malaysia on 18 March 2022. In the forthcoming analysis, the discussion examines the existing legal framework to protect geographical indications in Malaysia via the Geographical Indications Act 2022. While examining the statutory provisions, the study focuses on the components of the RCEP and its influence on drafting the New Act's provisions. The paper employs a doctrinal approach to the statutory provisions with an analysis provided on the best practices to be followed subsequently.

RESEARCH METHOD

A comparative study will be conducted to contextualise Malaysia's legal framework within the broader international context. This involves analysing the intellectual property standards of other RCEP member countries and countries with similar geographical indications legislation. The purpose is to identify common practices, divergent approaches, and potential areas of improvement. Data collection will involve accessing legal texts, official government publications,

file:///C:/Users/MU071008/Downloads/_book_edcoll_9789004180659_Bej.9789004145672.i-910_030-preview.pdf

⁸ Article 23 Additional Protection for Geographical Indications for Wines and Spirits Article 23.1 “*Additional Protection for Geographical Indications for Wines and Spirits*): Each Member shall .provide the legal means for interested parties to prevent use of a geographical indication 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.”

Available at: https://www.wto.org/english/res_e/publications_e/ai17_e/trips_art23_jur.pdf

⁹ Section 2: "Geographical indication" means “*an indication which may contain one or more words which identifies any goods as originating in a country or territory, or a region or locality in that country or territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to their geographical origin.*” Geographical Indications Act 2022 [Act 836]

¹⁰ “Proposed Amendments Needed for RCEP Ratification to Be Tabled in Parliament next Month Says Azmin,” 2022, <https://www.malaymail.com/news/malaysia/2021/11/25/proposed-amendments-needed-for-rcep-ratification-to-be-tabled-in-parliament/2023578>.

and relevant intellectual property databases to gather information on geographical indications, trademark registrations, and relevant case law. This data will help substantiate the analysis's findings and support the recommendations for best practices. A critical part of the study involves interpreting the Geographical Indications Act 2022 statutory provisions, along with any associated regulations and guidelines. The research will assess these provisions' legal language, intents, and potential implications to understand how they impact intellectual property standards and obligations under the RCEP.

Based on the analysis and interpretation findings, the research will conclude by presenting recommended best practices for registered proprietors in Malaysia. These best practices will guide intellectual property holders in aligning their practices with the updated legal framework and international standards. Throughout the research, potential limitations and ethical considerations will be acknowledged. This includes possible biases in the doctrinal analysis and ensuring that all data sources are appropriately cited and utilised within the scope of fair use. By employing this doctrinal methodology, the research seeks to offer valuable insights into the impact of the Geographical Indications Act 2022 on intellectual property standards in Malaysia and provide practical recommendations for stakeholders in the field.

ANALYSIS AND DISCUSSION

Malaysia's Obligations Towards Various Treaties and Its Impact on the Law of Geographical Indications

Malaysia is a member of the Paris Convention for the Protection of Industrial Property 1883 (the Paris Convention), the TRIPS Agreement and most recently to the RCEP.¹¹ The Paris Convention applies to industrial property in its widest sense and includes geographical indications. The Paris Convention, revised in Stockholm on 14 July 1967 and amended on 2 October 1979, came into force on 1 January 1989. Some of the relevant provisions for geographical indications include Article 9, which addresses the usage of “Marks, Trade Names, Seizure, or Importation of Goods Unlawfully Bearing a Mark on Trade Names”,¹² and Article 10, which provides that in “direct or indirect use of a false indication of the source of the goods or the identity of the producer, manufacturer, or a merchant, the prohibition of their importation would apply.”¹³ Under Article 10*bis*, the countries are bound to assure nationals of such countries effective protection against unfair competition.¹⁴ These include indications or allegations the use of which

¹¹ “RCEP Agreement Enters into Force,” <https://asean.org/>, 2022.

¹² Article 9: “Marks, Trade Names: Seizure, on Importation, etc., of Goods Unlawfully Bearing a Mark or Trade Name.” Paris Convention for the Protection of Industrial Property of March 20, 1883, Available at: https://www.wipo.int/wipolex/en/text/288514#P203_33504

¹³ Article 10: “*False Indications: Seizure, on Importation, etc., of Goods, Bearing False Indications as to their Source or the Identity of the Producer.*” Paris Convention for the Protection of Industrial Property of March 20, 1883, Available at: https://www.wipo.int/wipolex/en/text/288514#P203_33504

¹⁴ Article 10*bis*: “*Unfair Competition: (1) The countries of the Union are bound to assure nationals of such country's effective protection against unfair competition. (2) Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition. (3) The following in particular shall be prohibited: (i) all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor; (ii) false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor. (iii) indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the*

in the course of trade is liable to mislead the public regarding the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity of the goods.¹⁵ Thus, Article 10bis requires member countries to have laws which protect against unfair competition. Likewise, as has been highlighted earlier, the relevant provisions that protect geographical indications under the TRIPS Agreement are found in Article 22.1 of the TRIPS Agreement. The TRIPS Agreement proposes three models of protection. Firstly, focusing on unfair competition or passing off; secondly, protection under trademarks; thirdly, protection of geographical indications through collective marks.

The Preamble to the RCEP Agreement provides that the basic objective of the Agreement is to broaden and deepen the Association of South East Asian Nations (ASEAN)'s engagement with Australia, China, Japan, Korea, India and New Zealand as agreed at Phnom Penh, Cambodia on 20 November 2012 which endorsed the Guiding Principles and Objectives for Negotiating the Regional Comprehensive Economic Partnership.¹⁶ Article 1.1 establishes the Regional Comprehensive Economic Partnership as a Free Trade Area.¹⁷ This is also consistent with Article XXIV of the General Agreement on Tariffs and Trade 1994 ('the GATT 1994'), which established the Regional Comprehensive Economic Partnership as a free trade area under the provisions of this RCEP Agreement.¹⁸ The RCEP came into force on 1 January 2022. It has been pointed out that the RCEP participating countries account for about 30% of the global GDP and 30% of the world population, and more than 27% of the global merchandise trade. The objective of the RCEP Agreement, as stated in Article 1.3, is to:

“Establish a modern, comprehensive, high-quality, and mutually beneficial economic partnership framework to facilitate the expansion of regional trade and investment and contribute to global economic growth and development, taking into account the stage of development and economic needs of the Parties, especially of Least Developed Country Parties.”¹⁹

goods.” Paris Convention for the Protection of Industrial Property of March 20, 1883, Available at: https://www.wipo.int/wipolex/en/text/288514#P203_33504

¹⁵ Article 10bis (3), the Paris Convention. Paris Convention for the Protection of Industrial Property of March 20, 1883, Available at: https://www.wipo.int/wipolex/en/text/288514#P203_33504

¹⁶ Summary of the Regional Comprehensive Economic Partnership Agreement, accessed on March 25, 2022 <https://rcepsec.org/wp-content/uploads/2020/11/Summary-of-the-RCEP-Agreement.pdf>

¹⁷ Article 1.1: “*Establishment of the Regional Comprehensive Economic Partnership as a Free Trade Area the Parties, consistent with Article XXIV of GATT 1994 and Article V of GATS, hereby establish the Regional Comprehensive Economic Partnership as a free trade area under the provisions of this Agreement.*”

¹⁸ Regional Comprehensive Economic Partnership (RCEP) Article 4. “*Paragraph 6 of Article XXIV establishes the procedure to be followed when a Member forming a customs union proposes to increase a bound rate of duty.*” Available at: https://api.dtn.go.th/rcep/RCEP2_EN/Online/files/basic-html/page12.html

¹⁹ Regional Comprehensive Economic Partnership (RCEP) Article 1.3: “*Objectives The objectives of this Agreement are to: (a) establish a modern, comprehensive, high-quality, and mutually beneficial economic partnership framework to facilitate the expansion of regional trade and investment and contribute to global economic growth and development, taking into account the stage of development and economic needs of the Parties especially of Least Developed Country Parties; (b) progressively liberalise and facilitate trade in goods among the Parties through, inter alia, progressive elimination of tariff and non-tariff barriers on substantially all trade in goods among the Parties; (c) progressively liberalise trade in services among the Parties with substantial sectoral coverage to achieve substantial elimination of restrictions and discriminatory measures with respect to trade in services among the Parties; and (d) create a liberal, facilitative, and competitive investment environment in the region, that will enhance investment opportunities and the promotion, protection, facilitation, and liberalisation of investment among the Parties.*” Available at: https://api.dtn.go.th/rcep/RCEP2_EN/Online/files/basic-html/page12.html

It is considered relevant to times as the national treatment of internal taxation and regulation is in accordance with the national treatment of the other parties' goods in accordance with Article III of GATT 1994. To this end, Article III of GATT 1994 is incorporated into and made part of this RCEP Agreement, *mutatis mutandis*.²⁰ The key features of this RCEP agreement are that it is modern, comprehensive, high-quality and mutually beneficial. It is considered modern since RCEP Agreement will complement the World Trade Organization Agreement in areas where the Parties have agreed to update or go beyond its provisions and comprehensive-ness in terms of its coverage consisting of 20 chapters and annexes and over 14,000 pages.

The above paragraph discusses Malaysia's obligations under various international treaties, namely the Paris Convention for the Protection of Industrial Property, the TRIPS Agreement, and the Regional Comprehensive Economic Partnership (RCEP), and their impact on the law of geographical indications in the country. Relevant provisions, such as Article 9 and Article 10, address the unlawful use of marks and false indications of the source of goods. Article 10bis further obligates member countries to provide effective protection against unfair competition, including indications or allegations that may mislead the public about the nature or characteristics of goods. These provisions are crucial in safeguarding geographical indications and preventing deceptive trade practices.

Impact of the ECEP and the Geographical Indications Act 2021

According to the Media Release by the Ministry of International Trade and Industry on 21 January 2022, the Instrument of Ratification by Malaysia was successfully submitted to the ASEAN secretariat on 17 January 2022. It came into effect on 18 March 2022.²¹ This is per the requirement in Article 20.6 of the RCEP Agreement, which stipulates that the Agreement will enter into force after 60 days of submitting the Instrument of Ratification.²² As such, Malaysia has joined the other eleven signatory countries that have completed the ratification process, including Singapore, China, Japan, Brunei Darussalam, Cambodia, Lao PDR, Thailand, Viet Nam, Australia, New Zealand and South Korea.²³ The RCEP is accepted to be the largest trading group of members in the world and is set to become a new centre of gravity for global trade. Malaysia is accepted to be the largest beneficiary among the ASEAN members, and the country is expected to gain from the RCEP membership and consider the RCEP as a vital tool to recover from the disruptions and losses caused by the Covid-19 pandemic.²⁴ Therefore, the

²⁰ Article III: National Treatment on Internet Taxation and Regulation. https://www.wto.org/english/res_e/booksp_e/gatt_ai_e/art3_e.pdf

²¹ "Ministry of International Trade and Industry," *Media Release*, n.d.

²² Article 20.6: "Entry into Force 1. This Agreement shall be subject to ratification, acceptance, or approval by each signatory State following its applicable 20-3 legal procedures. The instrument of ratification, acceptance, or approval of a signatory State shall be deposited with the Depositary. 2. This Agreement shall enter into force for those signatory States that have deposited their instrument of ratification, acceptance, or approval 60 days after the date on which at least six signatory States, which are Member States of ASEAN and three signatory States other than the Member States of ASEAN have deposited their instrument of ratification, acceptance, or approval with the Depositary. 3. After the date of entry into force of this Agreement, this Agreement shall enter into force for any other signatory State 60 days after the date on which it has deposited its instrument of ratification, acceptance, or approval with the Depositary". Chapter 20, Final Provisions, RCEP. Available at: <https://www.dfat.gov.au/sites/default/files/rcep-chapter-20.pdf>

²³ "RCEP Agreement Member Countries," n.d., <https://www.dfat.gov.au/sites/default/files/rcep-chapter-20.pdf>.

²⁴ "RCEP: World's Largest Trade Deal Comes into Effect in Malaysia," *Business Standards*, 2022, <https://www.business-standard.com/article/international/rcep-world-s-largest-trade-deal-comes-into-effect-in->

ECEP and the Geographical Indications Act 2021 have profoundly impacted Malaysia's intellectual property landscape. As a member of the ECEP, Malaysia has broadened and deepened its engagement with ASEAN countries and major economies like Australia, China, Japan, Korea, India, and New Zealand. The ECEP's establishment as a Free Trade Area has facilitated regional trade and investment expansion, contributing to Malaysia's economic growth. Concurrently, the Geographical Indications Act 2021 has brought significant changes to intellectual property protection, aligning Malaysia's standards with international obligations under the ECEP, the Paris Convention, and the TRIPS Agreement. The Act's provisions enhance the recognition and safeguarding of geographical indications, fostering consumer trust in products from specific regions. The combined impact of the ECEP and the Geographical Indications Act 2021 positions Malaysia as a key player in the global intellectual property while bolstering its economic ties with regional and international partners.

Chapter 11 (Section D) of the RCEP and Geographical Indications

A more relevant chapter in the RCEP for this paper is Chapter 11 on intellectual property. Chapter 11 promotes protecting and enforcing intellectual property rights within the region. It is aimed at contributing to the following:

“Promotion of technological innovation and the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and enforcement of intellectual property rights provide confidence to right holders and users.”

Meanwhile, Article 11.2 covers many aspects, including copyright, trademarks, industrial designs, patents and geographical indications.

Specifically, Article 11.29 of the RCEP requires that 'each Party shall ensure its laws and regulations are adequate and effective means to protect geographical indications, and each party recognises that such protection may be provided through a trademark system, a sui generis system, or other legal means, provided that all requirements under the TRIPS Agreement are fulfilled'. Article 11.30 requires Domestic Administrative Procedures for the Protection of Geographical Indications to be implemented. The following sections examine to what extent the New Act has achieved the above policies.

Application for Registration of Geographical Indications

The application process for registering geographical indications is spelt out clearly under the New Act. Part IV contains the provisions for the Registration of Geographical Indications, with Chapter 1 devoted to the application for registration of geographical indications. Under section 8(1) of the New Act, “any person may apply for registration of a geographical indication of any goods in the form as determined by the Registrar together with payment of the prescribed fee.” Section 8(5) provides that for purposes of subsection (1), a person means “(a) any person who is carrying on an activity as a producer in the geographical area concerning the goods and

malaysia-122031800548_1.html. “RCEP Agreement Member Countries,” n.d., <https://www.dfat.gov.au/sites/default/files/rcep-chapter-20.pdf>.

²⁴ “RCEP: World’s Largest Trade Deal Comes into Effect in Malaysia,” *Business Standards*, 2022, https://www.business-standard.com/article/international/rcep-world-s-largest-trade-deal-comes-into-effect-in-malaysia-122031800548_1.html.

includes an association of such persons; or (b) a competent authority.” Such competent authority includes:

“(a) government or statutory body carrying out the functions of, on behalf of, or sanctioned by, the Government of Malaysia or the Government of a State; (b) government other than the Government of Malaysia; or (c) authority which is competent to certify the goods, and has the responsibility for the geographical indication in question.”

The new and important features introduced by section 8 have now widened the application of the interested person. Section 2 interprets an interested person concerning goods identified by a geographical indication to refer to a producer of the goods, a trader of the goods, or an association of such producers, an association of such traders or an association of such producers and traders.²⁵

This is wider than the repealed Act. Sections 11 and 11 A of the Old Act only extended to a 'person who is carrying on an activity as a producer in the geographical area specified in the application concerning the goods specified in the application, and included a group or groups of such person; (b) a competent authority; or (c) a trade organisation or association' whereas a competent authority meant any government or statutory body carrying out the functions of, on behalf of, or sanctioned by, the Government. Thus, the notable changes are wider and narrower at the same time. While the permissibility for registration is wider in that now the requirement allows foreign governments to apply for registration, it is narrower than the previous requirement, such that a competent authority must now be responsible for the geographical indication in question.

Therefore, an application to register geographical indications is a crucial legal process that seeks to protect unique products from specific geographical regions. Geographical indications play a significant role in safeguarding these products' reputation, quality, and authenticity, ultimately benefiting both producers and consumers. The application process involves submitting comprehensive documentation, evidence, and proof of the association between the product and its geographical origin. The legal analysis of such applications involves meticulous scrutiny by relevant authorities or intellectual property offices. Evaluating the application's compliance with the Geographical Indications Act and relevant international treaties, such as the Paris Convention and the TRIPS Agreement, is vital to ensure conformity with existing legal standards. During the analysis, authorities assess whether the geographical indication meets the criteria set forth by the law, such as demonstrating the unique qualities or characteristics attributed to the product's geographical origin. Authorities also consider potential conflicts with existing geographical indications or trademarks to prevent confusion or unfair competition. Upon successful registration, the geographical indication obtains legal protection, preventing unauthorised use or misuse by others. This exclusive right empowers the registered proprietors to enforce their rights against infringers and maintain the distinct identity of the geographical indication in the marketplace. Overall, a sound legal analysis of an application for registering geographical indications ensures the proper protection and promotion of traditional products and enhances the economic and cultural significance of the regions associated with these valuable assets.

²⁵ Section 8(1) Geographical Indications Act 2022.

The Grounds for Refusal of Registration

The registration for geographical indications can only be sought concerning goods falling within the categories of goods as laid down in section 9 of the New Act and the categories of goods as set out in the guidelines or practice direction under section 95. It is for the Registrar to issue guidelines or practice directions, and any person specified in the provisions of the Act shall comply with the guidelines and practice directions. These guidelines issued by the Registrar shall be published in the Intellectual Property Official Journal and effective from the date specified in the guidelines or practice directions.

The Old Act does not contain such similar provisions. However, it states that protection shall be given to a geographical indication regardless of whether or not the geographical indication is registered under the Act and as long as the application is filed in the manner prescribed within section 12, which includes:

“(a) the name, address and nationality of the natural person or legal entity applying, 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; (e) the quality, reputation or other characteristic of the goods for which the geographical indication is used; and (f) any other particulars as may be prescribed.”

The application in the New Act is subjected to various substantive examinations and oppositions, and the duration of protection for a geographical indication is ten years. For registration, the geographical indication shall be registered as at the date of filing of the application for registration of the geographical indication, and the date shall be deemed for the Act to be the date of registration. However, unlike the previous procedures in the Old Act where the Registrar was required to send a notice in the prescribed manner to the registered proprietor of the date of expiry of the registration, the onus is now on the registered proprietor who may, on or before such date, renew the registration of a geographical indication in the manner as determined by the Registrar together with payment of the prescribed fee. Renewal can be sought while following the procedures in section 11 of the New Act.

The grounds for refusal are now in Chapter 2 (sections 10 and 11) of the New Act. These new provisions provide that the Registrar can refuse to register a geographical indication on the following grounds:

“(i) ‘The geographical indication does not fall within the meaning of “geographical indication” as defined in section 2; (ii) The geographical indication identifies goods that do not fall within any of the categories of goods as determined by the Registrar; (iii) The geographical indication consists exclusively of an indication which is identical with the term customary in the common language as the common name of any goods in Malaysia if registration is sought in relation to the goods; (iv) The geographical indication is contrary to public order or morality; (v) The geographical indication is not or has ceased to be protected in its country or territory of origin; (vi) The goods does not originate from the country, region or locality indicated in the application for the registration of geographical indication; (vii) The geographical indication in relation to the goods is of such a nature which may mislead the public as to the true place of origin of the goods; (viii) There exists a likelihood of confusion on the part of the public because the geographical indication is identical with or similar to, and has the same geographical origin as, an earlier geographical indication.”

The Registrar is, however, given the discretion to register a geographical indication if there exists a likelihood of confusion on the part of the public because the geographical indication is identical with or similar to a trademark if the trademark fulfils any of the following conditions:

“(i) The trademark is a registered trademark or protected international registration designating Malaysia, and taking into account, where appropriate, the priorities claimed in respect of the trademark under the

Trademarks Act 2019 where: i) the application for the registration of the trademark was made in good faith; or ii) the trademark was registered in good faith, under the Trademarks Act 2019 or any previous written law relating to trademarks before the date of application for registration of the geographical indication in Malaysia; or, (ii) The trademark has been used in good faith in Malaysia in the course of the trade before the date of application for registration of the geographical indication in Malaysia.”

The New Act now clarifies that for purposes of the refusal of registration, a reference to a geographical indication includes a variant of the geographical indication; and that it does not prevent the registration of any other variant of the geographical indication if that variant satisfies the requirements of this Act. According to section 2 of the New Act, a variant refers to 'any variant of a geographical indication constituting the geographical indication and includes any translation, transliteration or other variation of the indication. Therefore, the New Act has put in place the process in compliance with what is required in Article 11.30 of the RCEP, with reasonable procedures and formalities stipulated.

The grounds for refusal of registration are crucial considerations in registering intellectual property, such as trademarks, patents, or geographical indications. These grounds typically involve legal requirements and criteria that must be met for successful registration. Common grounds for refusal may include the lack of distinctiveness, similarity to existing registered marks, deceptive or misleading characteristics, and failure to meet statutory requirements. By upholding these grounds, intellectual property offices ensure registered rights' integrity and exclusivity, protecting consumers and rights holders from potential conflicts and misuses. A thorough examination of applications against these grounds is essential to maintain the integrity and effectiveness of the intellectual property registration system.

Opposition Procedures and Cancellations

Subparagraph 1(e) of Article 11.30 of the RCEP Agreement mandates a Party to publish all applications to protect geographical indications. At the same time, those applications must be made available for opposition which means that a Party shall also provide for opposition procedures. For that purpose, a Party shall provide procedures that allow at least interested persons to oppose the protection of a geographical indication and that allow for any such protection to be refused, at least on the ground that the geographical indication is a term customary in common language as the common name for the relevant good in the territory of that party.

A main change introduced in the New Act is that opposition can now be brought on any of the extensive grounds of refusal of registration. As a comparison, the Old Act was silent on the issue of whether additional grounds of opposition could be adduced. However, it is now clearly stated that under section 16 (12), 'where an appeal is made to the Court against the decision of the Registrar under subsection (11) (a) the appeal shall be made in the prescribed manner; (b) the Court shall, where necessary, hear the parties and the Registrar; (c) any party may, either in the prescribed manner or by leave of the Court, file any additional evidence for the consideration of the Court; and (d) the opponent shall not introduce any additional ground of opposition to the registration of geographical indication for the consideration of the Court except by leave of the Court.'²⁶ This means that an opponent shall not introduce any additional ground of opposition to the registration of geographical indication for the consideration of the

²⁶ Section 16 (12), Geographical Indications Act 2022.

Court except by leave of the Court. The New Act has ensured the above requirement is addressed, such applications are published for opposition, and procedures for opposing geographical indications that are the subject of applications have been included.

Procedures: Examinations of Application and Opposition

The registration process has undergone extensive change with much-needed clarity introduced by the New Act. In order to determine the compliance of registration under section 8 of the New Act, the Registrar shall 'search for any earlier geographical indication or earlier trademark to such an extent as the Registrar considers necessary'. Suppose the application for geographical indication registration does not fulfil any of the requirements for registration. In that case, the Registrar shall inform the applicant of the grounds of provisional refusal by way of a written notice. At the same time, the applicant shall be allowed to address the provisional refusal within the period as the Registrar may specify in the written notice.

Under section 12(3) of the New Act, an applicant whose application to register the geographical indication is provisionally rejected may make a representation by way of a written submission or hearing and amend the application for registration of the geographical indication to meet any condition, amendment, modification or limitation as the Registrar deems fit to impose or furnish additional or any other information or evidence.²⁷ The applicant's failure to respond to the Registrar's notice within the specified period would render his application for the registration of the geographical indication deemed withdrawn. Responding to the written notice does not guarantee registration approval. If satisfied with the response, the Registrar may still accept the application. The applicant may subsequently apply for the written grounds of refusal in the manner determined by the Registrar, together with the payment of a prescribed fee. An appeal can thus be made to the Court against that decision of the Registrar. Suppose an application for registration of a geographical Indication is accepted for the registration of a geographical indication under subsections 12(6) or (9). In that case, the Registrar shall issue a notice of acceptance to the applicant requiring the applicant to make payment of the prescribed fee within the period specified in such notice. However, if an applicant fails to make payment, the application for the registration of the geographical indication shall be deemed to be withdrawn.²⁸

Effects of Registered Geographical Indications

Article 11.30 of the RCEP Agreement provides a Party's obligations in providing domestic administrative procedures. In this regard, Article 11.33 of the RCEP Agreement focuses on the date of protection of a geographical indication, where the date shall commence no earlier than the filing date of the application for the protection in that party or the registration date in that party, as applicable. The New Act has maintained this requirement as found in the Old Act, where a geographical indication shall be registered as at the date of filing of the application for registration of the geographical indication, and the date shall be deemed for the purposes of the date of registration.

Such a date is crucial as the registered proprietor acquires various rights from the registration date of a geographical indication. This includes the right to use the geographical

²⁷ section 12(3), Geographical Indications Act 2022.

²⁸ Subsections 12(6) or (9) Geographical Indications Act 2022.

indication and to authorise other persons to use the geographical indication. The right to use includes making, importing, exporting, offering for sale, selling or using the geographical indication concerning the goods for which the geographical indication is registered. As a result, a producer carrying on an activity has the right to use the registered geographical indication during trade. Nevertheless, the producer has to ensure that the right is exercised regarding the goods according to the quality, reputation or characteristic specified in the Register.

In response to any false usage of registered geographical indications to goods, section 34 of the New Act contains provisions relating to falsely applying registered geographical indications to goods. Section 35 provides for importing, selling, offering for sale, or having in one's possession, custody or control for trade or manufacturing goods with falsely applied geographical indication. As will be shown later, these unscrupulous acts entail penal consequences. In addition, civil remedies are available to an interested person of those registered geographical indications. Section 77 of the New Act allows any interested person of goods identified by a geographical indication to institute Court proceedings against those who falsely used the registered geographical indications.

Registration of Homonymous Geographical Indications

Article 11.32 of the RCEP Agreement addresses the multi-component terms in that an individual component of a multi-component term that is protected as a geographical indication shall not be protected in a Party if that individual component is a term customary in the common language as the common name for the associated well in the territory of that party.²⁹

Previously, homonymous indications were protected under section 7(1) of the Old Act. It provided that homonymous geographical indications were mainly confined to wines, and protection shall be accorded to each indication regardless of whether they are registered. The New Act interprets homonymous geographical indication as a geographical indication that, in part or whole, has the same spelling as, or sounds the same as, a geographical indication for any goods with a different geographical origin. The new provisions on registration of homonymous geographical indication, as laid down in section 11(2) of the New Act, allows the Registrar to register the homonymous geographical indication with practical conditions differentiating the homonymous geographical indication from the earlier geographical indication as determined by the Registrar, taking into account the need to ensure equitable treatment of all the parties concerned and that the public is not misled.

Institution of Court Proceedings for Unlawful Use of Geographical Indications

The New Act provides that any interested person of goods identified by a geographical indication may institute Court proceedings against any person for carrying out an act using a geographical indication. These are:

- “(a) the use in the course of trade of a geographical indication by any means in the designation or presentation of any goods that indicates or suggests, in a manner which misleads the public as to the geographical origin of the goods, that the goods in question originate in a geographical area other than the true place of origin; (b) any use in the course of trade of a geographical indication which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention for the Protection of Industrial Property of 20 March 1883, as revised or amended from time to time; (c) any use in the course of trade of a geographical indication identifying wines for wines not originating in the place indicated by the

²⁹ Article 11.32 of the RCEP Agreement. Available at: RCEP Agreement member countries: Available at: <https://www.dfat.gov.au/sites/default/files/rcep-chapter-20.pdf>

geographical indication in question or a geographical indication identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the wines or spirits is indicated or the geographical indication is used in translation or accompanied by expressions such as kind, type, style, imitation or any similar word or expression.”

In an action under this section, the Court may grant an injunction. In granting an injunction, the Court may attach conditions as it thinks fit. Alternatively, under certain circumstances, award damages or any other relief that the Court thinks fit.

The New Act expressly disallows proceedings to be instituted against certain uses of geographical indications. This is spelt out in Part XIII of the New Act, which, among other things, exempts a court proceeding against the use of a geographical indication that is contrary to public order or morality in Malaysia, not or has ceased to be protected in its country or territory of origin.

Correction and Cancellations

While there are measures for the Registrar to correct any information towards any error or enter any change in the registered proprietor's name, address or description in the Registrar, the Registrar may also perform the same without extending the rights given under the existing registration of the geographical indication.

A registered proprietor may voluntarily request the Registrar to cancel a registered geographical indication regarding any goods. Such an application is to be made in the form as determined by the Registrar, together with payment of the prescribed fee. Likewise, the newly prescribed provisions permit the Court, on the application of any person in the prescribed manner, to cancel the registration of a geographical indication on the following grounds:

“(a) the geographical indication was registered in breach of rules of registration; (b) the registration of the geographical indication was obtained fraudulently or by misrepresentation; (c) the geographical indication has fallen into disuse or has ceased to be protected in its country or territory of origin; (d) there has been a failure by a registered proprietor to maintain, in Malaysia, any commercial activity or interest about the geographical indication, including commercialisation, promotion or market monitoring; (e) in consequence of the failure to maintain any commercial activity or interest about the geographical indication, including commercialisation, promotion or market monitoring in Malaysia by any interested party of goods identified by the registered geographical indication, the geographical indication has become the common name of the goods in Malaysia.”

Offences

A notable feature now offered under the New Act is a series of offences. Section 34(1) provides that falsely applying registered geographical indication to goods without the registered proprietor's consent. The goods are not the genuine goods of the registered proprietor, or person not authorised by the registered proprietor, or a person who does not have the right to use the geographical indication under section 28 will be committing an offence. As indicated earlier, section 35 makes it an offence for importing or selling goods with falsely applied geographical indication. Apart from that, section 36 states submission of false information to the Geographical Indications Office or false entry in the Register to be an offence, whereas section 37 criminalises falsely representing that a geographical indication is a registered geographical indication or making a false representation as to the goods for which a geographical indication is registered. According to section 38(1), the Registrar may summon witnesses for the New Act, receive evidence on oath, and require the production of any document or article.

Therefore, failure to comply with the summons or request made under section 38(1) without a lawful excuse is an offence.

While statutes like the Subordinate Courts Act 1948 and the Courts of Judicature Act 1964 may have already provided for jurisdictions of the courts of different levels, it is the jurisdiction of a Sessions Court to try any of the offences under the New Act.

Best Practices for Registered Proprietors of Geographical Indications

In light of the changes in the New Act, New Regulations and the New Guidelines, below are several recommended best practices to be considered by registered proprietors: (a). In applying a geographical indication, besides the personal details and the capacity in which the applicant is filing for registration, ensure that the categories of goods are accurate and correspond to the applicant's intention. The categories of goods can be found under different Classes in the First Schedule of the New Act. Besides the Classes, the specification of the goods would also need special attention, such as the precise geographical area, physical characteristics, proof of origin, causal link between the geographical area and specific quality, processing techniques and others, for the application to be complete. (b). As mentioned above, the New Act has introduced the registration of variants of geographical indications. For clarity, the Guidelines have provided several examples of what constitutes variants. Therefore, registered proprietors need to know they can consider registering their rights over translations, transliterations, or other variants of the same geographical indication under the New Act. (c). Registered proprietors can also protect their homonymous geographical indications under the New Act, other than wine, as provided under the Old Act. However, registration is allowed only if there are clear differences between the original geographical indication and the homonymous geographical indication, such as the geographical area of the goods, packaging, characteristics, and others. (d). Considering the new and extensive provisions regarding grounds of refusal, registered proprietors must be wary of their geographical indications falling under any circumstances in section 10 of the New Act. Suppose the application is refused under any of the said grounds. In that case, the applicant must either make representations, amend the application, or furnish additional statutory declarations to support the application. (e). Since there is now a publication system for geographical indications known as the Intellectual Property Official Journal (IPOJ), the public can view the latest applications and, if they wish, oppose any of them. This will open the door for more up-to-date information and transparency for all parties, including the registered proprietor, to make informed decisions concerning geographical indications for their purposes. With the additional grounds of opposition against the decision of the Registrar, the applicants should provide all the relevant information from the very beginning of their application to ensure that they are ready for these kinds of outcomes. As for the opposing party, they must ensure that sufficient particulars are available to support their application, such as authority details and the registration number of their previous geographical indication or trademark. As for the appeal process, parties should be aware that no additional evidence can be tendered except with the leave of the Court. (g). The registered geographical indication can now be cancelled on several grounds, such as a breach of Section 10 of the New Act, registration obtained fraudulently or by misrepresentation, ceased to be used in the territory of origin, failure of commercialisation or the geographical indication has become a

common name for goods in Malaysia. The registered proprietor can voluntarily cancel their registered geographical indication based on these grounds if it serves their best interests. (h). Transferring geographical indications is now possible from the registered proprietor to another person. This right gives some flexibility to the registered proprietor in dealing with their rights under the New Act. However, they must ensure that the procedures under 26(1) of the New Act and regulations are adhered to before such transfer occurs to the other person. (i). The procedure under the New Act is also undoubtedly time-sensitive. For example, the provisions about the extension of time to address non-compliance, the applicant's response during the examination, notification of acceptance for publication, etc. Therefore, the registered proprietor or their agent needs to keep track of important timelines to ensure that the geographical indications are constantly valid if that is the intention. (j). Compared to the Old Act, a stark difference is the renewal of the geographical indications. The renewal provisions are more structured and comprehensive. However, it is important to note that previously the Registrar would send a notice to the registered proprietor under the Old Act. Now it is the registered proprietor or agent's responsibility to ensure that their geographical indication continues to be valid and does not expire before renewal is completed. (k). The New Act allows registered proprietors to take civil action against parties that infringe on their rights, including falsely using their registered geographical indications under the circumstances provided for under Sections 34 and 35 of the New Act. Therefore, the registered proprietor can rest assured that there is a way to find recourse if their rights are infringed and prepare the necessary evidence to support their case if the matter proceeds to Court. (l). Other than civil action, the registered proprietor needs to know that criminal action can also be taken under Part IX of the New Act. Previously, there were no offences or criminal jurisdiction provisions under the Old Act. Now the Assistant Controller is empowered to enforce the rights of the registered proprietor if they so wish to lodge a report to the authorities. (m). Part X of the New Act allows the enforcement officers to investigate, arrest suspects and search and seize goods suspected to be the subject matter of an offence under the New Act. Therefore, the registered proprietor needs to cooperate with the enforcement officers in gathering evidence before such action takes place and cooperate with the public prosecutors throughout the criminal proceedings if need be. (n). Finally, the new regime allows the registered proprietor to appoint geographical indication agents. The new registration system encourages a higher level of service and ensures quality is always taken care of in the service to their clients. Therefore, the registered proprietor can take advantage of this system to ensure that all the best practices above are achievable and adhered to.

CONCLUSION

The Intellectual Property Corporation of Malaysia ('MyIPO') carried out a public consultation with the stakeholders for any interested party to make written submissions from 12 November 2021 until 21 November 2021, seeking feedback on the proposed changes to the Old Act. Some of these changes are now reflected in the New Act. It is quite clear that the New Act and several new provisions introduced via the New Act directly respond to Malaysia's commitments towards being a member of the RCEP, especially about the opposition and cancellation of geographical indications that have been put in place. The New Act provides specific provisions on

registration, examination and cancellation and develops and clarifies the ambit of homonymous geographical indications. The extensive provisions on the grounds of refusal for registration and the clarification on the institution of court proceedings is a much-welcomed development to the Old Act. With the introduction of the new offences and the processes on investigation and complaints together with the coming into force of the RCEP on 18 March 2022, the development of the law relating to geographical indications will now afford owners of geographical indications the much-needed protection and contribute to the boosting of the economy as envisaged by the Regional Comprehensive Economic Partnership among the member countries. The New Act has streamlined and aligned Malaysia's domestic procedures and is a direct response to Article 11.29 of the RCEP Agreement, with Malaysia aligning its laws and regulations adequately and effectively to protect geographical indications.

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