

Review of the Lisbon System: oriGIn Comments

November 2012

Introduction

The Organization for an International Geographical Indications Network¹ (oriGIn) is an international network of geographical indications, representing 350 associations and over two-million producers from some 40 countries. oriGIn advocates for a more effective legal protection and enforcement of GIs at the national, regional and international level and promotes the recognition of the fundamental role of origin products in sustainable development.

oriGIn is accredited as observer at the World Intellectual Property Organization (WIPO) and has been actively participating in the Working Group on the Development of the Lisbon System (Appellations of Origin) since its establishment in 2009.

oriGIn Comments to the Draft New Instrument on Appellations of Origin and Geographical Indications (LI/WG/DEV/6/2)

A. From a general view point:

- We welcome the progress made with respect to the overall approach of the exercise, in particular with respect to a single and ambitious level of protection provided for both Appellations of Origin (hereinafter AO) and Geographical Indications (hereinafter GIs).
- To some extent the wording has been simplified and the complexity reduced, but further progress can be made in this respect (see below, comments on specific articles).
- We understand that a two-fold mandate was given to the Secretariat. However, while the introduction of the concept of GI in the Lisbon System is extremely positive, we do not believe that neither a Protocol nor a new Treaty is justified to achieve this goal. In light of the fact that a single and ambitious level of protection for both AO and GIs has been agreed upon, we do not see any obstacles to introducing the concept of GI in the revised Lisbon Agreement itself. This is one of the major reforms to make the Lisbon System more attractive to new Contracting Parties. We understand that some GIs have

¹ www.origin-gi.com

de facto been registered under the current Lisbon Agreement and that no refusal was expressed by Contracting Parties on the basis of the definition. Introducing the concept of GI in the revised Lisbon Agreement would rather reflect a need of transparency, legal certainty and predictability. In this respect, resorting to a Protocol/new Treaty does not appear to be justified. Beside a revised Lisbon Agreement providing a strong level of protection for both AO and GIs, the idea of a Protocol/new Treaty should rather be explored to achieve a different objective, such as providing additional elements of flexibility. In any event, should the idea of a Protocol/new Treaty be confirmed, we would support the Protocol solution, which would allow to maintain a unique Treaty (supplemented by the Protocol).

- While a few flexibilities for developing countries have been introduced (such as art. 8 of the Draft New Instrument concerning fees and art. 9 of the Draft Regulation concerning an extra year to notify a refusal), we believe that further progress can be made in this area. We have to take into account that – if one of the objectives of this exercise is to allow Intergovernmental Organisations to join the revised Agreement – we must anticipate the fact that the amount of AO and GIs registered under Lisbon might increase exponentially.

B. With respect to specific articles/items:

- The definition of AO is unnecessary complex. Starting by “appellation of origin means”, like in the current Lisbon Agreement, would help reduce the complexity. With respect to need to cover AO consisting of non geographical names, the wording “traditional geographical and non geographical names” would be more appropriate in our view, rather than the proposed “and appellation of origin that may consist of denomination which is not, *strictu sensu*, geographical...” (art 2.1c of the Draft Instrument). The same article mentions “protected appellations of origin” (art. 2.2), while later in the text the wording “registered appellations of origin” is used (for instance art. 14). More consistency is needed in this respect.
- Current art. 5 should be placed after the articles dealing with the protection conferred by virtue of the Agreement (current art. 9 and 10).

- As for protection (current art. 9 and 10), we believe that the formulation of art. 3 of the current Lisbon Agreement should be kept (with the addition of the concept of evocation), complemented by language as close as possible to the TRIPs Agreement. For products different from the ones with respect to which the AO (and GI) is (are) requested, the experience of the EU Regulations on geographical indications can be useful. As a result, we suggest to provide for a single article titled “Content of Protection” as follows:

(1) Protection should be ensured against:

- (i) the use of any means in the designation or presentation of a product that indicates or suggests that the product 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 product.
- (ii) Any use which constitutes an act of unfair competition within the meaning of Article 10*bis* of the Paris Convention (1967).
- (iii) any usurpation, imitation or evocation, even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as “kind”, “type”, “make”, “imitation”, or the like.
- (iv) any direct or indirect commercial use in respect of products not covered by the registration, in so far as those products are comparable to the ones for which the registration applies or in so far as using the name exploits the reputation of the appellation of origin (or of the geographical indication).

(2) The registration of a trademark the use of which would breach an appellation of origin (or a geographical indication) protected in a Contracting Party shall be refused or invalidated, ex officio if the national legislation so permits or at the request of an interested party, with respect to an appellation of origin (or a geographical indication) not having this origin, if the application for the registration of the trademark is submitted after the international registration of the appellation of origin (or the geographical indication).

Trademarks registered in breach of paragraph 2 shall be invalidated.

- Art.13 (Prior Rights) should be merged with art. 17 (Prior Use). The new consolidated article should reflect TRIPs provisions (simply referring to them as in the Draft New Instrument is not enough). Art. 5.6 of the current Lisbon Agreement should be kept, but the case of conflict with previously registered trademarks should be clarified. The possible coexistence between an AO (and a GI) and an earlier trademark should be dealt with in this article, but it cannot be the result of the simple withdrawal of a refusal by a

Contracting Party. Clear limits should be set out in this respect, to be consistent with the TRIPs Agreement. We suggest the following formulation:

(1) If an appellation of origin (or a geographical indication), which has been granted protection in a given Contracting Party following its international registration², has already been used by third parties in that country from a date prior to such notification, the competent Authority of the said Contracting Party shall have the right to grant to such third parties a period not exceeding two years to terminate such use, on condition that it advise the International Bureau accordingly during the three months following the expiration of the period of one year provided for in the Regulation.

(2) If an appellation of origin (or a geographical indication), which has been granted protection in a given Contracting Party following its international registration³, conflicts with a trademark which has been applied for, registered or established by use in good faith within the territory of the said Contracting Party before the application of the TRIPs provisions in the Contracting Party, before the application of this Agreement in the Contracting Party⁴, or before the appellation of origin (or the geographical indication) is protected in its country of origin, the continuation of the use of such a trademark and its validity shall not be prejudiced, provided that:

option A) the use of such a trademark is not misleading as to the geographical origin of the product or the trademark was not registered in breach of the absolute grounds for refusal according to the legislation in force in that Contracting Party.

Option B) no grounds for its invalidity or revocation exist according to the legislation in force in that Contracting Party.

- Art. 18 (Notification of Grant of protection) should be moved before art. 15 (Refusals).

² This would cover as well the case of the protection of an AO (and a GI) in a given Contracting Party following a refusal and the subsequent withdrawal of such refusal.

³ *Ibidem.*

⁴ For non WTO Members.