

## International Registration of AOs and GIs

The Draft Revised Lisbon Agreement

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## International Registration in WIPO

Lisbon System – GIs?

Madrid System – GIs?

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## Madrid and Lisbon – Corresponding Features

- **Aim:** to facilitate international protection through a **single notification** and **registration procedure**
- **Participation:** any country party to the **Paris Convention** may accede
- Administered by **WIPO** – **International Register**
- **Coverage** - not limited to specific kinds of goods

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## Lisbon Union: 28 Member States

### Africa (6)

Algeria  
Burkina Faso  
Congo  
Gabon  
Togo  
Tunisia

### Asia (3)

Iran (Islamic Rep. of)  
Israel  
Korea (DPR of)

### America (6)

Costa Rica  
Cuba  
Haiti  
Mexico  
Nicaragua  
Peru

### Europe (13)

Bosnia and Herzegovina  
Bulgaria  
Czech Rep.  
France  
Georgia  
Hungary  
Italy  
Moldova  
Montenegro  
Portugal  
Serbia  
Slovakia  
The FYR of Macedonia

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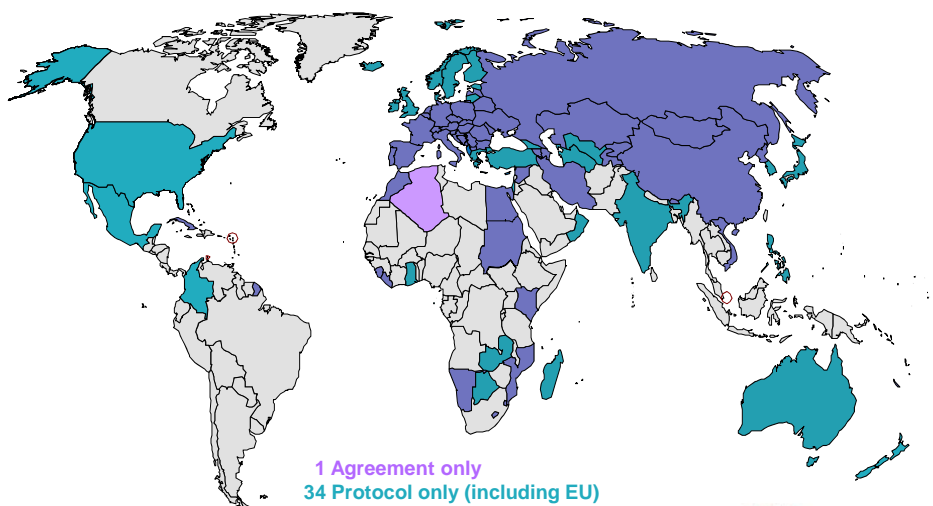
## 921 registrations – 816 in force

■ France	509	■ Portugal	7
■ Czech Rep.	76	■ Tunisia	7
■ Bulgaria	51	■ Korea (DPR of)	6
■ Italy	33	■ Slovakia	6
■ Georgia	28	■ Iran (Islamic Rep. of)	5
■ Hungary	28	■ FYR of Macedonia	4
■ Cuba	19	■ Serbia	3
■ Mexico	14	■ Montenegro	2
■ Peru	8	■ Costa Rica	1
■ Algeria	7	■ Israel	1
		■ Moldova	1

Registered since 1995: 186  
 - of which since 2003: 71

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## Madrid Union



1 Agreement only  
 34 Protocol only (including EU)  
 55 Agreement and Protocol  
**90 Members**

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Certification Trade Mark

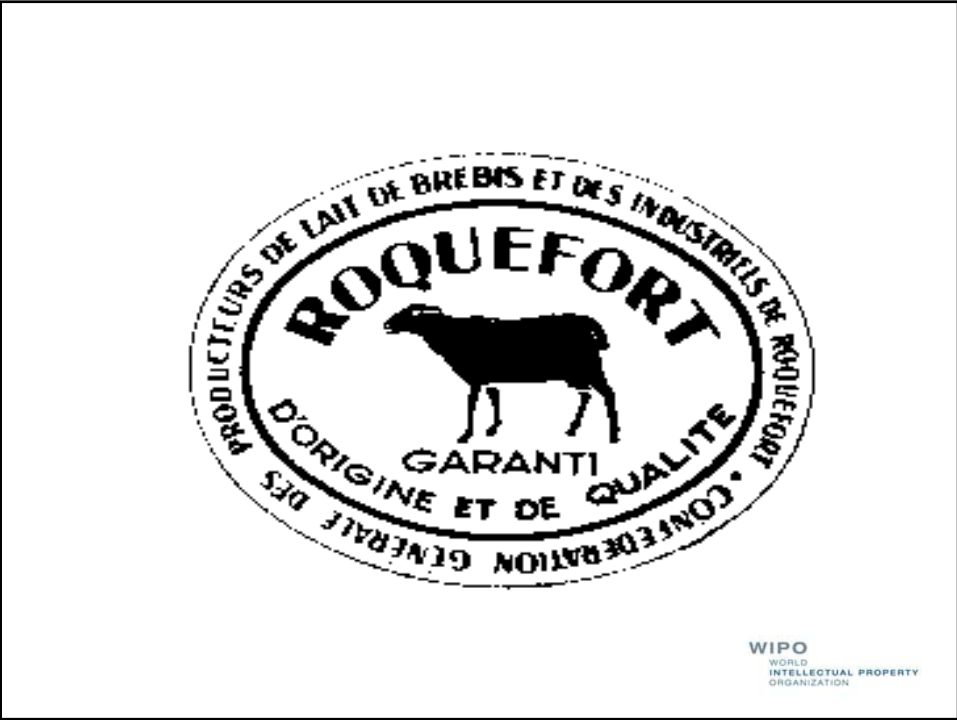
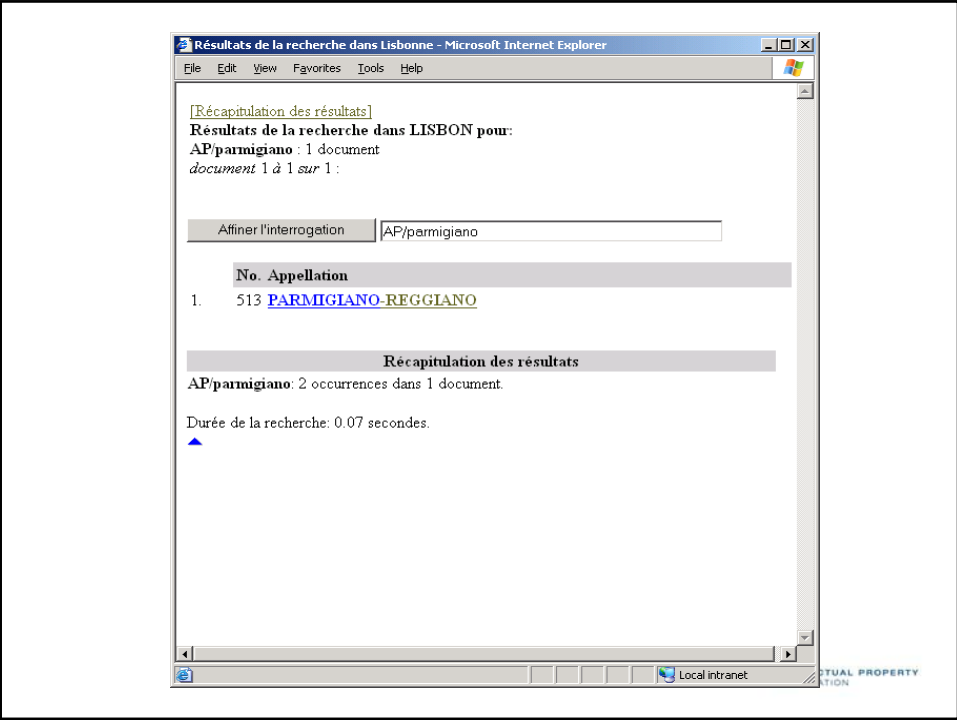
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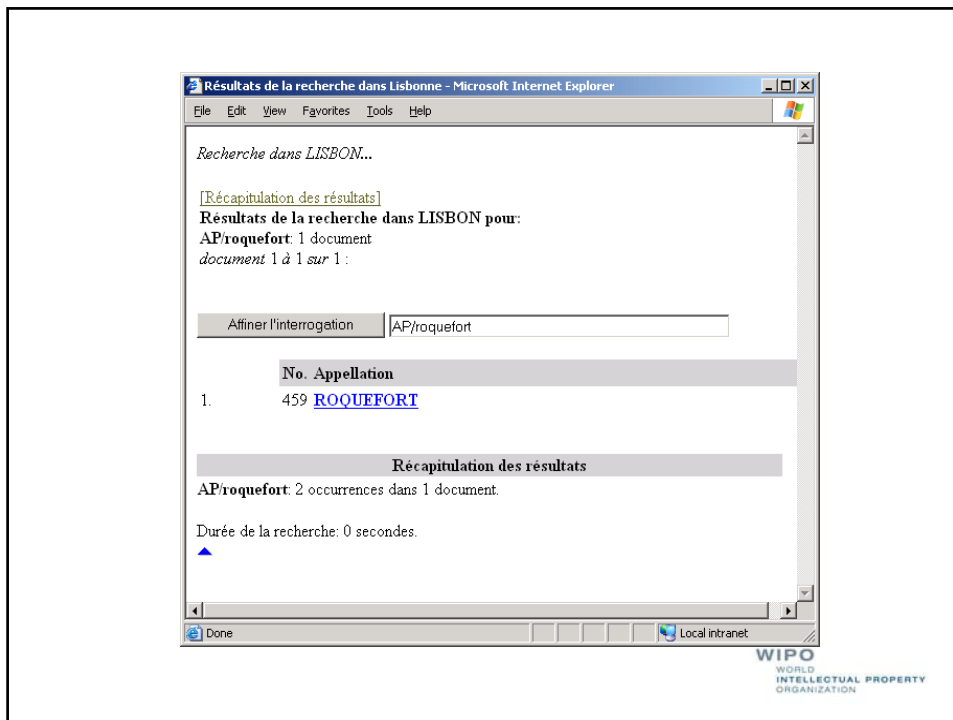


**PARMIGIANO  
REGGIANO**



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## Lisbon Union Assembly (September 2009)

- Mandated the WG on the Development of the Lisbon System to
  - look for improvements of the Lisbon system so that it might attract a wider membership, while preserving the principles and objectives of the Lisbon Agreement

## Two-fold Mandate

### 1. Revision of the Lisbon Agreement

- Refinement and Modernization of the Legal Framework
- Accession Possibility for IGOs (e.g., EU, OAPI)

### 2. Ensure its applicability to AOs and GIs

## WG on the Development of the Lisbon System

- ❑ The provisions of the **Draft Revised Lisbon Agreement** concern:
  - Definitions for GIs and AOs
  - Procedures for international applications, refusals, modifications, etc.
  - Scope of protection
  - How to deal with prior rights and prior use
  - Option for registration of trans-border GIs and AOs
  - Option for direct filings by beneficiaries
  - Accession criteria for IGOs (e.g., EU, OAPI)
- ❑ Conference on dispute settlement within the Lisbon system

## Prospects

### ■ Results 6th and 7th Session of the WG ([http://www.wipo.int/lisbon/en/news/2013/news\\_0005.html](http://www.wipo.int/lisbon/en/news/2013/news_0005.html))

- Revised Lisbon Agreement on AOs and GIs
- Scope of protection
- Relationship between TMs and AOs/GIs

### ■ Recommendation to conclude the treaty in 2015



The screenshot shows a web browser window displaying the WIPO Lisbon Express Search results. The address bar shows the URL: <http://www.wipo.int/cgi-lis/guest?fetch5?ENG+LISBON+17-00+41354778-KEY+256+0+1+F-ENG+1+1+1+25+SEP-0/HITNUJ>. The page title is "WIPO Lisbon Express Search For:". The search results are displayed in a table format.

<b>(1) PLZEŇ / PILSEN PILS / PILSENER / PILSNER</b>	
Number	1
Date	22.11.1967
Holder	The organisations that produce, in this region, the said products
Appellation	<b>PLZEŇ PILSENER PILS PILSENER PILSNER</b>
Publication	N° 1 : 03/1968
Country of Origin	CZ
Nice Classification	32
Product	Beer
Area of Production	City of Plzeň (Pilsen)
Refusal	<a href="#">FR</a> - 10.04.1969 <a href="#">ME</a> - 17.05.2000 <a href="#">RS</a> - 17.05.2000 <a href="#">PE</a> - 16.06.2006 <a href="#">IR</a> - 10.12.2007 <a href="#">MK</a> - 30.09.2011
Withdrawal	<a href="#">MX</a> - 22.05.1980 (Date of the initial refusal: 11.06.1969)
Legal basis	Executive Order N° 12.594/66-01/31 of November 3, 1966 of the Ministry of Food Processing Industry
Notification Article 5(2)	No. Inoner applicable



## Scope of Protection

- ❑ Protection against:
  - (i) any use of the AO or the GI
    - in respect of goods **of the same kind** not originating in the geographical area of origin **or** not complying with **any** other applicable requirements for using the AO or the GI, **or**
    - ❑ - which would be detrimental to, or exploit unduly, its reputation
    - ❑ **even if** the true origin of the goods is indicated or if the AO or the GI is used in translated form or accompanied by terms such as "style", etc.
  - (ii) any **other** practice liable to mislead the consumer as to the true origin, provenance, nature, quality or characteristics of the goods.
- ❑ Prior trademarks shall be refused or invalidated if they contain or consist of an AO or GI, **when their use would amount to an infringement of the AO or GI**

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## Prior Trademark Rights

- ❑ Can be used by a Contracting Party as a ground for refusal
- ❑ However, if the AO or GI is not refused on the basis that it conflicts with a prior trademark applied for or registered, or acquired through use, in good faith in a Contracting Party, the two may coexist in the Contracting Party's territory
- ❑ "[taking into account] [provided that] the legitimate interests of [the owner of the trademark as well as those of] the beneficiaries of the rights in respect of the appellation of origin or the geographical indication [are taken into account] and provided that the public is not misled"

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## Prior Use of an AO or GI as a Generic Term

- ❑ Can be used by a Contracting Party as a ground for refusal
- ❑ However, if the AO or GI is not refused on that basis, use of the AO or GI as a generic term will amount to infringement
- ❑ Nevertheless, the Contracting Party may set a phasing-out period **for terminating the infringing use**
- ❑ Prior use under a trademark cannot be the subject of such phasing-out if use of the prior trademark is **safeguarded**.
- ❑ Question: would use **as a generic term contained in a prior trademark** be covered by the safeguard for the prior trademark or be subject to the phasing-out provision?

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THANK YOU

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