

**Diplomatic Conference for the Adoption of a New Act
of the Lisbon Agreement for the Protection of Appellation of Origin
and Their International Registration:**

Draft oriGIn paper

(09 April 2015)

Background

The reform of the Lisbon Agreement was launched by WIPO in 2009. During the 6 years of discussions, both Lisbon contracting and non-contracting Parties - as well as observer NGOs - had the chance to actively participate in the 10 sessions of the WIPO Working Group on the Development of the Lisbon System. Both texts submitted to the Diplomatic Conference – the Basic Proposal for the New Act of the Lisbon Agreement¹ and the Basic Proposal for the Regulations under the New Act² – represent solid and equilibrated documents.

From the point of view of oriGIn, the major advancements of such reform are as follows:

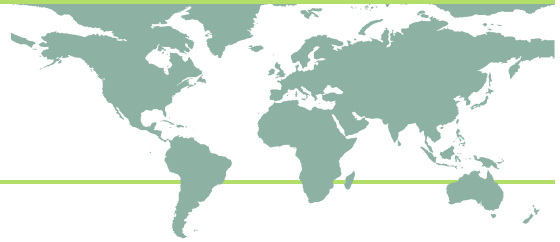
- The formal introduction of Geographical Indications (GIs) under the Agreement scope of application. The concept of Appellations of Origin (AO) remains unchanged (see art. 2 of the Basic Proposal for the New Act).
- A solid level of protection maintained and strengthened for AO and GIs (see articles 11-18 of the Basic Proposal for the New Act).
- An attempt to clarify the invalidation procedure (see art. 19 the Basic Proposal for the New Act).
- The possibility for Intergovernmental Organizations to join the Agreement (see art. 22.1.iii the Basic Proposal for the New Act).
- The possibility for AO/GIs beneficiaries to file an application for international registration under the Agreement, if the national law so allows (see art. 5.3 the Basic Proposal for the New Act).

Controversial issues

A few issues though remain controversial:

¹ Available at http://www.wipo.int/edocs/mdocs/mdocs/en/li_dc/li_dc_3.pdf

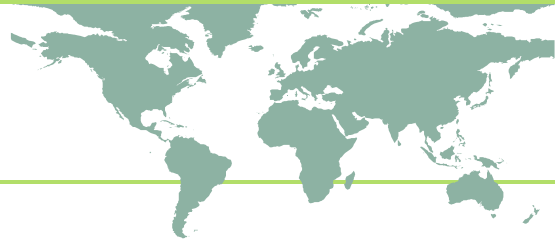
² Available at http://www.wipo.int/edocs/mdocs/mdocs/en/li_dc/li_dc_4.pdf



- a. The scope of protection of AO/GIs and the relation with previously registered trade marks: see in particular articles 11 to 14 the Basic Proposal for the New Act. While the current Lisbon Agreement contracting Parties aim at a high and ambitious level of protection, some non-contracting Parties would like to have the option to provide a level of protection compatible with their national legal framework. The latter group also asks that the recognition of an AO/GI does not shield it from becoming generic in a given jurisdictions as well as no specific provision on coexistence between AO/GIs and previously registered trade marks.
- b. Other legal effects of international registrations: see in particular articles 16 and 17 of the Basic Proposal for the New Act (concerning the negotiations between 2 contracting Parties on the withdrawal of a refusal to protect an AO/GI registered via the Lisbon Agreement) as well as art. 19.2 (issue of grounds for invalidating in a given Country an AO/GI previously protected within such jurisdiction via the Lisbon Agreement).
- c. Fees: see in particular art. 7 and art. 8.3 of the Basic Proposal for the New Act (as well as Rule 8 of the Basic Proposal for the Regulations under the New Act).
- d. Other issues: See in particular Rule 5.3 of the Basic Proposal for the Regulations (concerning the mandatory or optional nature of elaborating on the link between the AO/GI and its geographical environment in the application for international registration) and Rule 5.4 of the Basic Proposal for the Regulations (concerning the declaration of intention to use in respect of a registered AO/GI).

oriGIn position

While some WIPO members currently not part of the Lisbon Agreement do not seem interested in finding any genuine compromise, other potential new Lisbon contracting Parties showed during the Working group sessions a serious interest vis-à-vis the New Act. In light of this, and with the objective to come-up with an attractive treaty, it is crucial to analyses the above-mentioned controversial issues and assess whether some compromises might be considered acceptable by oriGIn.



- a. **We believe that a solid level of protection should be provided for both AO and GIs, which should cover as well the use of protected names on products of a different kind. Moreover, as legal certainty and predictability for producers and consumers should be pursued, contracting Parties should not have the option to choose to protect AO and GIs registered via the Agreement with a low standard compared to the general one provided by the Agreement itself. A lower standard could be acceptable only for the protection of names used with respect of products which are not of the same kind. In light of the above:**

- We propose the following amendments to art. 11:

Article 11 Protection in Respect of Registered Appellations of Origin and Geographical Indications

(1) [Content of Protection] Subject to the provisions of this Act, each Contracting Party shall extend to a registered appellation of origin, or a registered geographical indication, protection against:

(a) any use of the appellation of origin or the geographical indication

(i) in respect of goods of the same kind as those to which the appellation of origin, or the geographical indication, applies not originating in the geographical area of origin or not complying with any other applicable requirements for using the appellation of origin, or the geographical indication; or

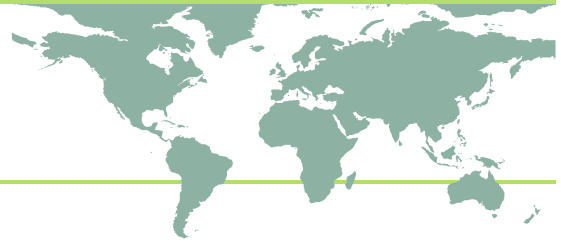
ALTERNATIVE A

(ii) which would amount to its misuse, imitation or evocation, ~~;~~

or (iii) which would be detrimental to, or exploit unduly, its reputation,

ALTERNATIVE B

~~(ii) in respect of goods that are not of the same kind as those to which the appellation of origin or geographical indication applies, if such use would indicate or suggest a~~



~~connection between those goods and the beneficiaries, and is likely to damage the interests of the beneficiaries;~~

even if the appellation of origin or the geographical indication is used with minor differences; if the true origin of the goods is indicated; or if the appellation of origin, or the geographical indication, is used in translated form or accompanied by terms such as “style”, “kind”, “type”, “make”, “imitation”, “method”, “as produced in”, “like”, “similar”, or the like ;

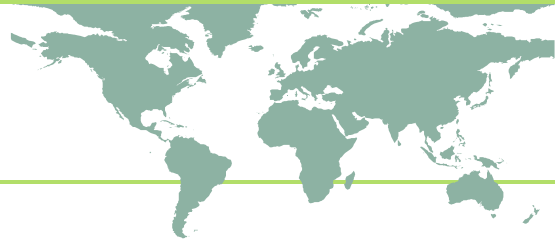
(b) any other practice liable to mislead the consumer as to the true origin, provenance or nature of the goods.

(c~~ii~~) any use of the appellation of origin or the geographical indication in respect of goods that are not of the same kind as those to which the appellation of origin or geographical indication applies, if such use would indicate or suggest a connection between those goods and the beneficiaries, and is likely to damage the interests of the beneficiaries or which would be detrimental to, or exploit unduly, its reputation;

A and B are not alternatives as they cover different situations: Alternative A refers to specific misuses of the protected name on goods of the same type; Alternative B refers to the use of the protected name on goods of a different type. It is crucial that protection is provided vis-à-vis both situations. In doing so, on the one hand, the protection with respect of goods of the same kind is strengthened and updated to cover “modern” infringing practices. On the other hand, the protection with respect of product that are not of the same kind is introduced in the Agreement (art.11.1.c).

(2) [Use in a Trademark]

Without prejudice to Article 13(1), a Contracting Party shall, ex officio if its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a later trademark if use of the trademark would result in one of the situations covered by paragraph (1).

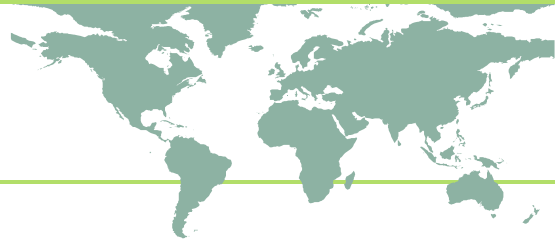


(3) ~~[Declaration Concerning the Content of Protection]~~

For the sake of legal certainty and predictability, which are crucial in international trade, alternatives A, B, C and D should be deleted. Some flexibility has been already provided by lowering the standard for the protection of AO and GIs used with respect of goods that are not of the same kind (see new article 11.1.c).

- As contracting Parties have the chance to refuse an AO/GI application for international registration based on a previously registered trade mark, and given the fact that the WTO jurisprudence considered coexistence a valid limited exception to the rights conferred by a trade mark, in art. 13 we prefer Alternative A.
- b. On the issue of negotiations between 2 contracting Parties on the withdrawal of a refusal to protect an AO/GI registered via the Lisbon Agreement, we believe that:
- States are free to carry out such negotiations in any event. Moreover, the current Lisbon Agreement practice shows that some refusals are not based on solid legal grounds. So art. 16 should remain as it is proposed in the Basic Proposal for the New Act.
 - On the title of art. 17.2, for the sake of coherence with art. 13 and with the formulation of art. 17.2 itself, we propose the following amendments:

(2) [Cancellation of, or coexistence with, previously registered or acquired trademarks] Where a Contracting Party that has refused the effects of an international registration under Article 15 on the ground of use under a prior trademark or other right, as referred to in Article 13, notifies the withdrawal of that refusal under Article 16 or a grant of protection under Article 18, the resulting protection of the appellation of origin or geographical indication shall not prejudice that right or its use, unless the protection was granted following the cancellation, non-renewal, revocation or invalidation of the right .



- On the issue of grounds for invalidating in a given Country an AO/GI previously protected within such jurisdiction via the Lisbon Agreement, we believe that, for the sake of legal certainty and predictability, the grounds of invalidation should be as detailed as possible. This is however a point where a compromise would be acceptable.
- c. Fees: Individual fees – both for the substantial examination of the international registration and its periodical renewal (see art. 7.5 of the Basic Proposal for the New Act) question the very nature of AO/GIs. However, should certain important markets like Russia and India express their interest to join provided that a compromise is found in this respect, such option could be explored provided that: 1. A formulation is found in order not to link the very existence of a AO/GI to the payment of a fee; 2. Such fees remain low in general and specific provisions are provided for least-developed countries.
- d. Other issues: On the issue of the mandatory or optional nature of elaborating on the link between the AO/GI and its geographical environment in the application for international registration we believe the approach should remain flexible. Although the essence of AO/GI is in their link with the geographical environment, this provision could remain optional. Contracting parties should be made aware though that under Agreement, contracting Parties have the possibility to refuse the protection of a given AO/GI, if the name contained in the international application does not match the definition of AO/GIs (as provided in the Agreement itself). As a result, providing information on the very nature of AO/GIs registered under the Agreement would increase the chances of obtaining the protection in a large number of contracting Parties, which is the very objective of an international registry such the one established by the Lisbon Agreement. Likewise, with respect to the declaration of intention to use in respect of a registered AO/GI, a flexible approach could be adopted, again if potential contracting Parties requesting it are serious in joining the new Agreement.