



**WIPO | LISBON**

The International System  
of Appellations of Origin

# The Geneva Act of the Lisbon Agreement and Recent Work in WIPO on GIs

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**GIs in a Fast Changing World**  
oriGIn  
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# Revision of the Lisbon System

## Main Objectives

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

# Summary



- Freedom as to type of legislation?
- Distinction GI and AO obligatory?
- Non-geographical GI/AO covered?
- Can trans-border GI/AO be registered?
- Obligation to protect a registered GI/AO with the same name as another GI/AO?
- Does the treaty prescribe who should file the application?
- Automatic transformation of existing Lisbon registrations?
- Does the treaty limit the possible grounds for refusal or invalidation?
- Will there be procedures for interested parties to present a refusal?
- Level of protection the same for all GI/AO?
- The same in respect of any kind of use?
- Safeguards for prior rights?

# Article 2 of the Geneva Act

## AO

- Denomination Protected in the Contracting Party of Origin
- Referring to a Geographical Area **or Known as doing so**
- Designating a Good as Originating Therein
- Quality or Characteristics
- **Reputation**
- **Due to the Geographical Environment, including Natural and Human Factors**

## GI

- Indication Protected in the Contracting Party of Origin
- Referring to a Geographical Area **or Known as doing so**
- Identifying a Good as Originating Therein
- Quality, Reputation or Other Characteristic
- **Attributable to its Geographical Origin**

# Means of Protection in Contracting Parties

- Freedom as to the type of legislation under which a Contracting Party protects AOs/GIs registered under Lisbon (Art.10 Geneva Act)
- In Contracting Parties that provide protection only in respect of GIs, AOs registered under the Geneva Act are to be protected as GIs, if they meet the GI definition (Art.9 Geneva Act)
- Safeguards for protection under other instruments (Art.10, Art.31)

## Entitlement to File (Art.5)

- Applications are filed by the Competent Authority of the Contracting Party of Origin on behalf of:
  - ✓ the beneficiaries; or
  - ✓ a natural person or legal entity having legal standing under the law of the Contracting Party of Origin to assert the rights of the beneficiaries or other rights in the AO or GI
  
- Direct filings by right holders  
(but only if the Contracting Party of Origin has made a declaration allowing for such direct filings)

# Mandatory Content Application

- Rule 5(2) – similar to current Lisbon Agreement
- Rule 5(5) – indication as to whether the Contracting Party of Origin specified any disclaimer when granting protection in respect of the AO or GI

# Geographical Areas with the Same Name

- No examination of applications for AOs and GIs by WIPO on the basis of substantive grounds
- It is for each Contracting Party to decide, on the basis of its own legal system and practice, whether or not an AO or GI registered under Lisbon may coexist with another AO or GI already protected in its territory
- For goods from a trans-border geographical area, adjacent Contracting Parties can register:
  - a jointly established AO or GI; or
  - individual, separate AOs/GIs for goods from a geographical area of origin consisting of their own part of the trans-border area

# Conditions for Protection in Certain Contracting Parties

- A Contracting Party may make protection in its territory dependent on any of the following conditions:
  - Information in the application of a connection between the quality, reputation or other characteristic(s) with the geographical area of origin (Rule 5(3))
  - Signature by person having legal standing to assert the rights conferred by the AO/GI (Rule 5(4))
  - Declaration of intention to use (Rule 5(4))
  - Payment of an individual fee (Art.7(4))

# Effect of international registration

## ➤ Geneva Act

- extension of protection to other Contracting Parties (fees)
- adaptation of existing Lisbon registrations upon accession of their country of origin to the Geneva Act (fees)
- indefinite (except when no longer protected in the Contracting Party of Origin)

## ➤ Except in a Contracting Party that ...

- issued a refusal (within the prescribed time-limit), or in respect of which protection has been (or must be considered) renounced
- invalidated the effect of the international registration in its territory

# Grounds of refusal under Lisbon

- ❑ Any Contracting Party has the **right to refuse** protection on its territory
- ❑ Refusals can be based on “**any situation of fact or law** that would prevent the grant of protection on the whole or part of the territory of the Lisbon Union”  
(Records of the Lisbon Diplomatic Conference, 1958)

## Procedural Right (Art.15(3))

- ❑ Each Contracting Party shall provide a reasonable opportunity, for anyone whose interests would be affected by an international registration, to request the Competent Authority to notify a refusal

# Level of Protection in the Geneva Act (1)

- Legal means to prevent use in respect of goods **of the same kind** as those to which the AO or GI applies:
  - ✓ **not originating** in the geographical area of origin or **not complying** with any other applicable requirements (Art.11(1)(a)(i))
  - ✓ also in case of use amounting to their **imitation**, even when used with delocalizing terms (Art.11(2))
- Legal means to prevent any other practice **liable to mislead consumers** as to the true origin, provenance or nature of the goods (Art.11(1)(b))
- Registration of **later trademarks** is to be refused or invalidated, if their use would result in one of the situations covered by para (1) (Art.11(3))

# Level of Protection in the Geneva Act (2)

- Legal means to prevent use in respect of goods **not of the same kind** as those to which the AO or GI applies **or services**:
- ✓ if such use **would indicate or suggest a connection** between those goods or services and the beneficiaries of the AO or GI, and would be likely to **damage** their interests, or,
- ✓ **where applicable**, because of the reputation of the AO or GI in the Contracting Party concerned, such use would be **likely to impair or dilute in an unfair manner, or take unfair advantage of, that reputation** (Art.11(1)(a)(ii))
- ✓ also in case of use amounting to their **imitation**, even when used with delocalizing terms (Art.11(2))

# Safeguards in the Geneva Act (1)

- Prior trademark rights, personal names and plant variety or animal breed denominations (Art.13)
- Other rights and uses can be safeguarded by a Contracting Party by means of a declaration of refusal (Art.15) or invalidation of the effects of the international registration in its territory (Art.19)
- Option for a Contracting Party to put in place a **transitional period** for terminating use not covered by a right safeguarded under Art.13 (Art.17)

# Safeguards in the Geneva Act (2)

- Protection of the GI/AO against becoming generic (Art.12)
- But no obligation to provide protection on the basis of a term that is already generic  
(Agreed Statements to Art.11(2) and Art. 12)

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