

6 October 2023

Switzerland's experience in implementing the Geneva Act of the Lisbon Agreement

Erik Thévenod-Mottet

Advisor for Geographical indications

Swiss Federal Institute of Intellectual Property

www.ipi.ch / erik.thevenod@ipi.ch

Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications

Main novelties:

- Extension to geographical indications (GIs), in addition to appellations of origin (AOs)
- Participation of intergovernmental organizations
- Options for compatibility with different legal systems

Establishment of a dual international register

- Lisbon Agreement (AOs)
- Geneva Act (AOs and GIs)

Appellations of Origin and Geographical Indications

- AOs are a sub-category of GIs
- An AO implies a higher level of intensity for the link between the product and its geographical origin
- Diversity of national legislations: only AOs, or only GIs, or both
- Level / standard of protection
- Terminology
- Issues of equivalence

Appellations of Origin and Geographical Indications



Appellations of Origin and Geographical Indications



Appellations of Origin

- Formalization in French law: early 20th century
- Basis for the Lisbon Agreement (1958, as incorporated in the Geneva Act)

Any denomination protected in the Contracting Party of Origin consisting of or containing the name of a geographical area, or another denomination known as referring to such area, which serves to designate a good as originating in that geographical area, where the quality or characteristics of the good are due exclusively or essentially to the geographical environment, including natural and human factors, and which has given the good its reputation.

Geographical Indications

- Formalization in EU law in 1992, incorporated in the WTO TRIPS Agreement (1996)

Indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.

Slightly different concepts

Appellations of origin	Geographical indications
Denomination	Indication
Quality or characteristics + reputation	Quality, reputation or other characteristic
Due exclusively or essentially	Essentially attributable
Geographical origin	Geographical environment, including natural and human factors
Strong material connection	At least one step of production

EU definitions

Geographical Indication

A name which identifies a product:

- (a) originating in a specific place, region or country;
- (b) whose given quality, reputation or other characteristic is essentially attributable to its geographical origin;
- (c) and **at least one of the production steps** of which take place in the defined geographical area.

Designation (= Appellation) of Origin

A name which identifies a product:

- (a) originating in a specific place, region or, in exceptional cases, a country;
- (b) whose quality or characteristics are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors;
- (c) and the **production steps of which all take place** in the defined geographical area.

Switzerland's interest in participating to the Lisbon system

- First global system of registration for all GIs
- High standard of protection
- Transparent and flexible mechanisms
- Attractiveness for new members

Comparison with other tools

- National procedures
- Bilateral agreements

Process of accession for Switzerland

1. Assessment and preparation of the proposal: 2015-2018
Joint proposal by the IP Office and the Ministry of Agriculture
2. Consultation of other ministries: end 2018
3. Public consultation: mid-2019
4. Consultation of other ministries: end 2019
5. Decision of the government: June 2020
6. Examination and approval by the Parliament: September 2020
- March 2021
7. Facultative referendum (3 months)
8. Ordinance, regulation of fees, examination guidelines
9. Entry into force: 1st December 2021

What is needed?

1. Competent authority (incl. fees)
2. Which domestic GIs can be registered in the Lisbon system
3. How international registrations will take effect in Switzerland
4. Prior rights and flexibilities (regulations)
5. Enforcement

Competent authority

1. Legal and technical capacities
2. Fees
3. Collaboration with other authorities

International registration of Swiss GIs

1. Definition of GIs
2. Definition of applicants
3. Language
4. Procedures

Protection of international registrations in Switzerland

1. Publication
2. Examination
3. Procedures for oppositions
4. Fees
5. No need for notifications of grant of protection
6. Scope of protection

Prior rights / flexibilities (regulations)

1. Coexistence with prior trademarks
2. Grandfathering / phasing out
3. Procedures
4. Fees
5. No additional requirements (incl. “optional mandatory” content of applications)

Garantie à l'égard des marques antérieures

- L'Acte de Genève laisse ouverte la possibilité de coexistence entre l'enregistrement international et la marque antérieure déposée ou enregistrée de bonne foi, **pour autant que la législation de la partie contractante le prévoie**
- Si la coexistence est possible, l'Acte de Genève garantit **automatiquement** cette **coexistence**, sans nécessiter de décision. Le titulaire de marque peut néanmoins émettre une opposition pour obtenir une telle décision formelle (= «**refus partiel**»)
- L'Acte de Genève impose aux Parties contractantes de prévoir une **procédure d'opposition** fondée sur une marque antérieure déposée ou enregistrée de bonne foi contre l'enregistrement international (= «**refus total**»).

Enforcement

1. Trademarks registration
2. Authorities in charge of repressing the frauds
3. Civil and criminal procedures

New provisions in the Law on the Protection of TMs and Indications of Source

Chapter 3 International Registration of Geographical Indications

Art. 50c International register for appellations of origin and geographical indications

1 The international registration of appellations of origin and geographical indications is governed by the Geneva Act of 20 May 2015 of the Lisbon Agreement for the Protection of Appellations of Origin and Geographical Indications (Geneva Act) and by the provisions of this Chapter.

2 The IPI is responsible for administering the Geneva Act for Switzerland in the following areas:

- a. the international registration of appellations of origin and geographical indications whose geographical area of origin lies on Swiss territory (Art. 50d);
- b. the effects of the international registration of appellations of origin and geographical indications whose protection on Swiss territory has been requested (Art. 50e).

New provisions in the Law on the Protection of TMs and Indications of Source

Art. 50d International registration of appellations of origin and geographical indications whose geographical area of origin lies on Swiss territory

1 An application for the international registration or the amendment of the international registration of an appellation of origin or geographical indication whose geographical area of origin lies on Swiss territory may be filed with the IPI by:

- a. the group that registered the appellation of origin or geographical indication registered under Article 16 AgricA or Article 50b of this Act, or, where that group no longer exists, by a representative group that has assumed the role of protecting this appellation of origin or geographical indication;
- b. the Swiss canton that protects a wine with an *appellation d'origine contrôlée* under Article 63 AgricA;
- c. the umbrella organisation of an economic sector for which the Federal Council has enacted an ordinance based on Article 50 paragraph 2;
- d. the proprietor of a trade mark that constitutes an appellation of origin or geographical indication as defined in Article 2 of the Geneva Act, provided the appellation of origin or geographical indication is neither protected under Article 16 or 63 AgricA nor under Article 50 paragraph 2 or 50b of this Act.

2 The Federal Council shall regulate the details of the procedure.

New provisions in the Law on the Protection of TMs and Indications of Source

Art. 50e Effects of the international registration of appellations of origin and geographical indications whose protection on Swiss territory has been requested

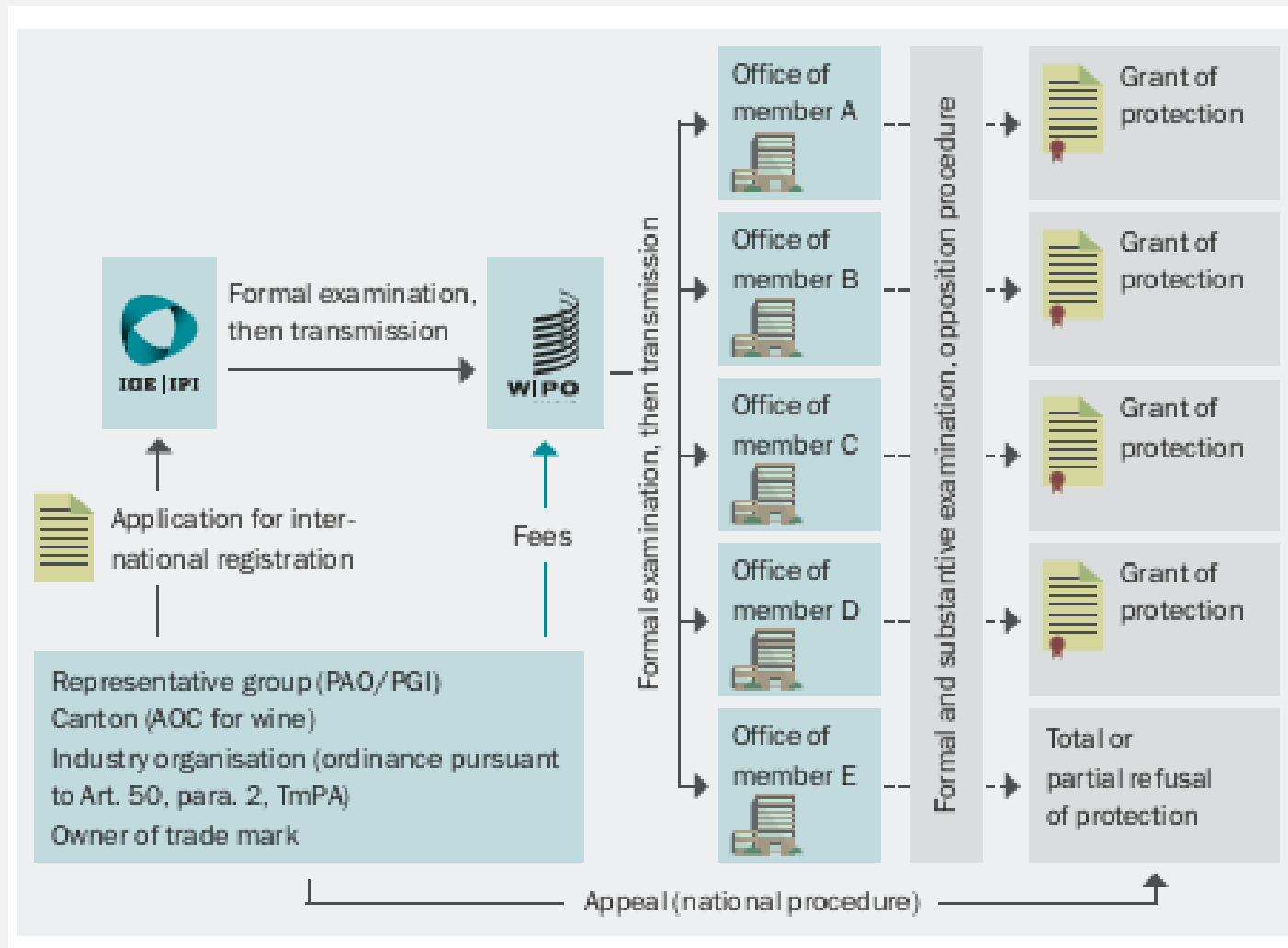
- 1 The effects of the international registration of an appellation of origin or geographical indication whose protection on Swiss territory has been requested may be refused on the following grounds in particular:
 - a. The denomination or indication does not correspond to the definitions in Article 2 of the Geneva Act.
 - b. The protection based on international registration is contrary to the law, public policy or morality.
 - c. The protection based on international registration infringes an earlier trade mark that has been registered in good faith for an identical or comparable product.
- 2 The IPI decides ex officio whether a ground under paragraph 1 letter a or b applies.
- 3 A third party may raise any of the grounds under paragraph 1 with the IPI.
- 4 In addition, a third party may request the transitional period under Article 17 of the Geneva Act to be granted, in order to terminate the earlier use in good faith of a denomination or indication that is the subject of international registration.
- 5 A trade mark that has been filed or registered in good faith before the denomination or indication that is the subject of international registration has been protected on Swiss territory and whose use for an identical or comparable product would be contrary to Article 11 of the Geneva Act, can nevertheless continue to be used provided there are no grounds for nullity or forfeiture under this Act. Its registration may be extended under the same conditions.
- 6 Article 50b paragraphs 6 and 7 apply by analogy.
- 7 The Federal Council shall regulate the details of the procedure.

New provisions in the Law on the Protection of TMs and Indications of Source

Art. 50f Fees

The IPI may by ordinance provide that the applicant is charged fees for:

- a. the processing of an application for the international registration of appellations of origin and geographical indications whose geographical area of origin lies on Swiss territory, or an application for the amendment of the said registration (Art. 50d para. 1);
- b. the substantive examination of the international registration of an appellation of origin or geographical indication whose protection on Swiss territory is requested (Art. 50e para. 2);
- c. the processing of a request to deny the effects of the international registration of an appellation of origin or geographical indication on Swiss territory (Art. 50e para. 3);
- d. the processing of a request to grant a transitional period (Art. 50e para. 4).



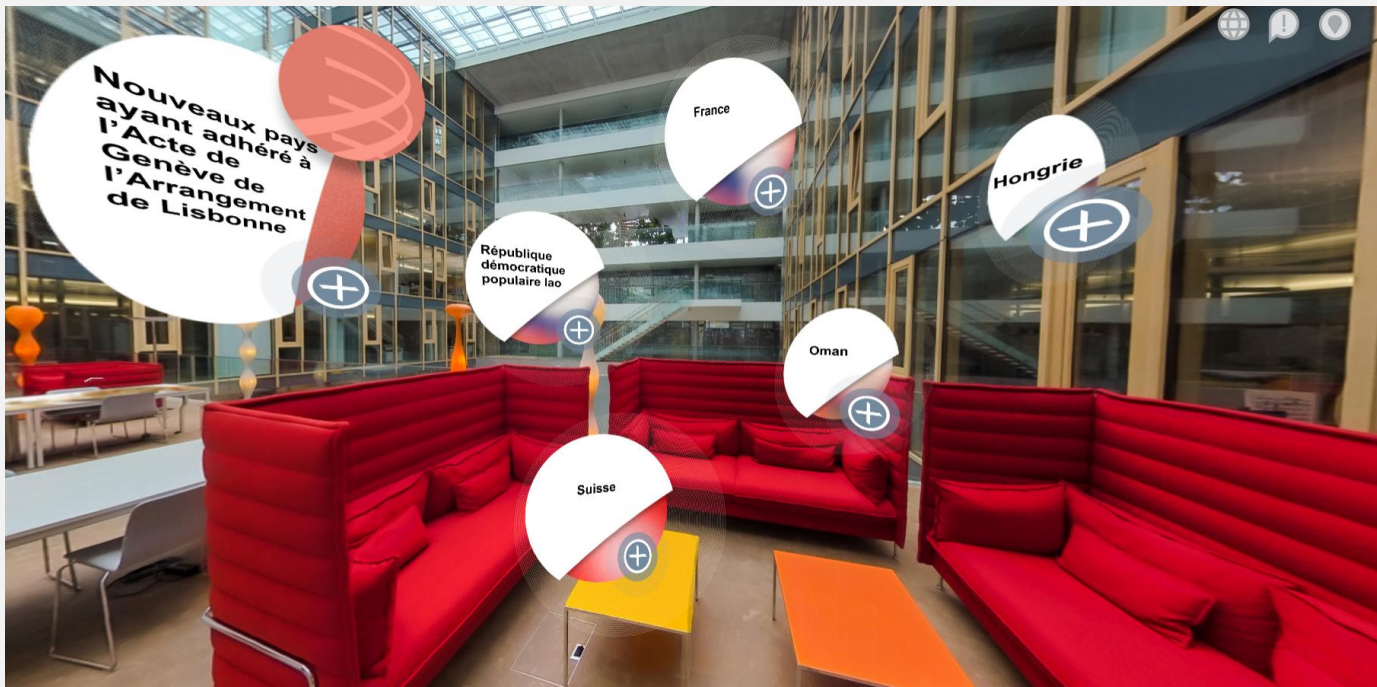
Conclusions

- Law on the Protection of Trademarks and Indications of Source: a legislative amendment that is as light as possible and as detailed as required
- Mirroring the provisions implementing the Madrid system for TMs
- Demand-driven procedures
- Sensitive question of fees
- A regular and reasonable flow of international registrations will help the national implementation!

All documents are available on <https://www.ejpd.admin.ch/ejpd/en/home/latest-news/mm.msg-id-79355.html>

Le système de Lisbonne: un élément de la stratégie de protection

- Utiliser les flexibilités à bon escient
- Prévoir les difficultés (oppositions, procédures nationales)
- Négociations bilatérales
- Nouveaux membres



À LA UNE



Exposition virtuelle sur les indications géographiques

Du 6 septembre 2021 au 6 mars 2022

Cette exposition offre aux visiteurs l'occasion de découvrir les activités de l'OMPI dans le domaine des indications géographiques, ainsi que des exemples d'indications géographiques des États membres.

[Visitez l'exposition](#)