

# FROM LISBON TO GENEVA: THE OUTCOME OF THE LISBON SYSTEM REVISION

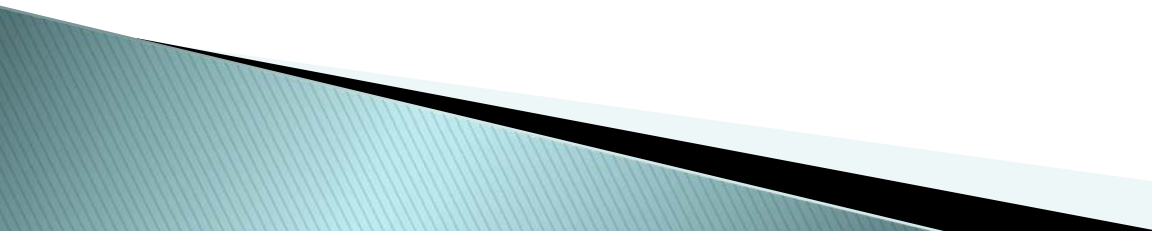
WORLDWIDE SYMPOSIUM ON GEOGRAPHICAL INDICATIONS  
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DE TULLIO  PARTNERS  
INTELLECTUAL PROPERTY ATTORNEYS

# Agenda

- *The revision of the Lisbon System*
  - *A compromise between different interests*
  - *Critical aspects of the revision*
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  - *Advantages for Producers of quality products*
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# The revision of the Lisbon System

- On May 21<sup>th</sup>, 2015, in Geneva, the conclusion of the Diplomatic Conference regarding the revision of the Lisbon Agreement for the international protection and registration of Appellations of Origin led to the Adoption of the **Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications**.
- After several years of working groups for the new Agreement, 13 participants signed the Geneva Act of Lisbon Agreement on Appellations of Origin and Geographical Indications.
- The aim of the revision of the Lisbon Agreement was to create a larger system - being able to attract more countries than the original agreement - for the strengthening and extension of the protection of Appellations of Origin and Geographical Indications registered in the countries of origin or at regional level.

## A compromise between different interests

- The Diplomatic Conference has seen the active participation of all the delegations, both Lisbon Member States and Observers, who suggested proposals, compromises and alternatives in order to reach a text agreed between members.
- During the meetings, two different orientations have emerged:
  - one aimed at reaching the maximum level of protection for appellations and indications;
  - one seeking to limit their scope of protection in order to safeguard the local markets from the overwhelming strength of AOs and GIs.

The interests of producers of AOs and GIs, and their consumers, have been taken into consideration. However, the strength granted to AOs and GIs is balanced by the rules that safeguard prior existing rights in each Contracting Party.

## Critical points

- Protection against becoming generic (Art. 12): this article ensures that registrations under the New Act cannot become generic as long as appellations of origin and geographical indications continue to be protected in the Contracting Party of origin. Such article was subject of an intense discussion during the Working Sessions;
- Protection for prior trademark rights (Art.13): the balance has been found in a system of co-existence between earlier trademark and subsequent AOs and GIs, that may lead to a limitation of trademark rights to the effect that, in certain circumstances, such TM rights may not entitle its owner to prevent a registered AO or GI from being granted protection or used.

## Examples of different views: Art. 11

Speaking of goods different from the ones directly protected through AOs and GIs, the acts of undue exploitation of reputation should have been expressly punished.

**VS**

The possibility for a State to protect GIs and AOs against any use for products that are not of the same nature, if such use may indicate or suggest a link between these products and the AO/GI Right Holder, and it is likely to infringe the latter's rights.

## Examples of different views: Art. 13

States should be left free to rule the conflicts between GI and national marks on the basis of their own national law. These situations should have not been governed by a rule under an International Agreement.

**The matter is that trademarks recalling AOs or GIs, as well as *de facto* trademarks, could be overwhelmed by the registration of GIs and AOs.**

**VS**

Previous registered marks should be protected in a broader way, on the basis of a priority based both on use and on registration (and in good faith). The co-existence of both the rights is not excluded.

**The matter is that earlier trademarks should prevail.**

## Critical points

- The new system foreseen by the revised Lisbon Agreement seems to be very similar to the Madrid system for the international trademarks:
  - ✓ the application shall be filed before a single international office, and then goes through the exam of the other national offices. Then, the GI or the AO is protected in those designated countries that do not have refused the extension.
  - ✓ The fundamental difference is that, while all the countries belonging to the Madrid system have similar systems of trademark registration, or otherwise recognize the trademark as an IP right with its own identity, some countries do not recognize the protection of GIs, nor in some cases the identity of GIs as a right in itself.
- Now each Contracting Party is able to ratify the Lisbon agreement **regardless of whether it has specific national laws for the protection of GIs**, if protection is provided by different means, such as the national trademark system (as certification, collective or "ordinary" TMs).



# Advantages for producers of quality products

## ➤ A broader scope of protection:

- ✓ The Geneva Act now applies to Geographical Indications, then opening up to many more typical products. Just as AOs, GIs require a qualitative link between the product and its place of origin. Therefore, the Geneva Act offers an **increased protection** to those whose products are already covered by GIs.
- ✓ Possibility for Members to file multiple joint applications in case of a geographic area of origin consisting of a **trans-border area**, or a part thereof.

# Advantages for producers of quality products

- **A widespread protection:** since GIs products are marketed globally, the new Geneva system may be a tool for getting simultaneous protection in multiple jurisdictions, through this new coordinated system of international protection.
- **A reward for the efforts made:** keeping the production linked to a specific territory can sometimes be difficult in terms of labor and costs. The broad protection offered by the Geneva Act represents a reward.



## Advantages for consumers

- **A guarantee of quality:** GIs and AOs allow international consumers to identify and purchase high-quality products that has been produced and processed in the state of origin, on the basis of certain controlled specifications and quality standards. Through the AO and GI system, consumers are informed about a product's geographical origin and its quality, characteristic or reputation deriving from the relationship with the place of origin;
- **An easy way for traceability:** by virtue of the strong link with the territory, AOs and GIs help in discovering the origin of a certain product;
- **Food safety:** guarantee against food fraud and counterfeiting



# The effects of the revision 1

- **KAŠKAVAL BALKAN**: a type of cheese derived from ewe's milk, produced in Bulgaria.

<b>(678) KAŠKAVAL BALKAN</b>	
Number	678
Date	24.03.1980
Holder	1. Dържавно-stopansko obedinenie "Mlečna promišlenost", 9, boulevard Al. Stambolijski, Sofia
Appellation	<b>KAŠKAVAL BALKAN</b>
Publication	N° 13 : 07/1981
Country of Origin	BG
Nice Classification	29
Product	Cheese
Area of Production	The entire territory of the People's Republic of Bulgaria
Refusal	<u>BA</u> - 19.06.2014 <u>CZ</u> - 18.09.1981 <u>SK</u> - 18.09.1981 <u>ME</u> - 17.05.2000 <u>RS</u> - 17.05.2000 <u>MD</u> - 01.04.2002 <u>MK</u> - 30.09.2011

- The Appellation has been refused by several Members, BA, CZ, SK, ME, RS, MD, MK

# The effects of the revision 1

- The grounds for refusal were the following:  
*the term BALKAN is the name of the Balkan Peninsula, where there are many countries, as well as the name of a mountain range touching Bulgaria and Serbia.*
- This circumstance would fit within **Art. 2(2)** and **Art. 5(4)** of the Geneva Act:
  - ✓ These Articles allow applications for an AO or a GI referring to a trans-border geographical area, or a part thereof, if the Contracting Parties concerned file a joint-application through a commonly designated Authority.

## The effects of the revision 2

- The Geneva Act broadens the scope of protection provided by the current Lisbon Agreement to cover also **Geographical Indications**.

Therefore, it will be possible to register more products, such as:

- ✓ Arancia rossa di Sicilia (Italian PGI, *oranges*)
- ✓ Szentesi paprika (Hungarian PGI, *spices*)
- ✓ Capão de Freamunde (Portugal PGI, *fresh meat*)



**THANK YOU FOR YOUR ATTENTION!**

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