



STATE ADMINISTRATION
FOR INDUSTRY AND COMMERCE



Seeking Protection Abroad: The Madrid and Lisbon Systems

*Worldwide Symposium
on Geographical Indications*

Yangzhou, Jiangsu Province, June 29 to July 1, 2017

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Presentation

- **Why seeking protection abroad ?**
- **Why to use the Madrid System?**
- **Why to use the Lisbon System?**

Experience shows that GI Protection Schemes may have...

Positive economic effects

- production, price
- profitability,
- income distribution
- tourism

Positive effects for preserving traditions

- quality
- traditional know-how



Positive effects on jobs

- direct & indirect jobs
- job qualification
- rural exodus

Positive effects for Environment

- Biodiversity
- Environment preservation
- Landscape

How to get protection of your GIs abroad ?



Variety of means to protect geographical indications

- *Sui generis* legislation



- Trademark system (collective/certification marks)



- Administrative systems (labelling, etc.)

- Legislation on unfair competition

How to get protection of GIs abroad ?

■ Direct applications in third countries

Individual application

■ Bilateral or Pluri-lateral Agreements

Under such agreements two or more States or trading partners agree to protect each other's GIs (standard of protection + often GI-list)

■ Multilateral Agreements

- **TRIPS Agreement (WTO)**

Protection of GIs

- **Madrid Protocol/Agreement (WIPO)**

Registration of CTM/Coll.TM

- **Lisbon Agreement and Geneva Act (WIPO)**

Protection and registration of AOs and GIs under the Geneva Act

The Madrid System

- ***Madrid Agreement Concerning the International Registration of Mark (1891)***
- ***Protocol Relating to the Madrid Agreement (1989)***

The Madrid System in a Nutshell...

- To facilitate the **registration** of trademarks at an international level
- To facilitate the **management** of trademarks after registration

The Madrid System in a Nutshell...

- **One registration covering multiple territories**
- **Fixed time limit for refusal – 12 or 18 months**
- **WIPO examines only for formalities**
- **Expand protection to new export markets (subsequent designations)**
- **Centralized management of portfolio**

How the Madrid System Works

The International Trademark Registration Process



Madrid System and GIs (CTM / Coll-TM)

- ***Rule 9(4)(x) of the Common Regulations expressly provides for registration of collective or certification marks***

Example of Certification Marks protected under the Madrid System



龙井茶
Longjing Tea



NAPA VALLEY



WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

Madrid System : Key Figures (2016)

Description	Number
International registrations (2016)	44,726
Active international registrations (2016)	641,587
Active collective or certification marks Under the Madrid System* (29.06.2017)	1,233

* Including but not limited to collective and certification marks identifying quality products linked to origin

Keep Updated on the Madrid System

■ Visit the Madrid Website www.wipo.int/madrid/en

■ Subscribe to [Madrid Notices](#), our regular legal and news updates

■ Sign up for [Madrid Highlights](#)



The Lisbon System

- ***Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (1958)***
- ***Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications (2015)***

The Lisbon Agreement in a Nutshell...

- Established to facilitate the international protection of appellations of origin (AOs) through a **single registration procedure** (*“simple and accessible”*)
- Administered by WIPO, which keeps the **International Register of Appellations of Origin**

The Lisbon Agreement in a Nutshell...

■ Indefinite protection in **all Contracting Parties**

- *exception: refusal, invalidation, enunciation of protection, and*
- *as long as the AO is protected in the Contracting Party of Origin*

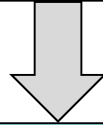
■ **High level protection** of the registered AOs in the other Lisbon countries

*(against any **usurpation** or **imitation**)*

■ Protection of registered AOs **against becoming generic** in the other Lisbon countries

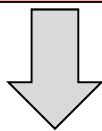
■ Provides standing for taking **legal action**

Application for an International Registration
(by Competent Authority of the Country of Origin)

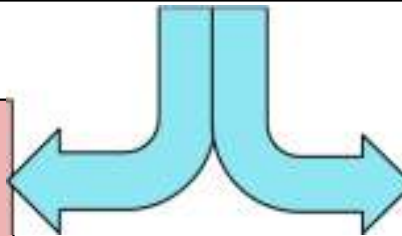


Registration in the International Registry and Publication (WIPO)
&
Notification of the Registration to all Contracting Parties (WIPO)

Refusal of Protection
(total/partial)
(one year)

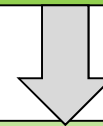


Withdrawal of Refusal
(total/partial)
or
Notification of Protection

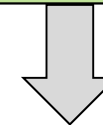


12 months

Notification of Grant of Protection
(optional)

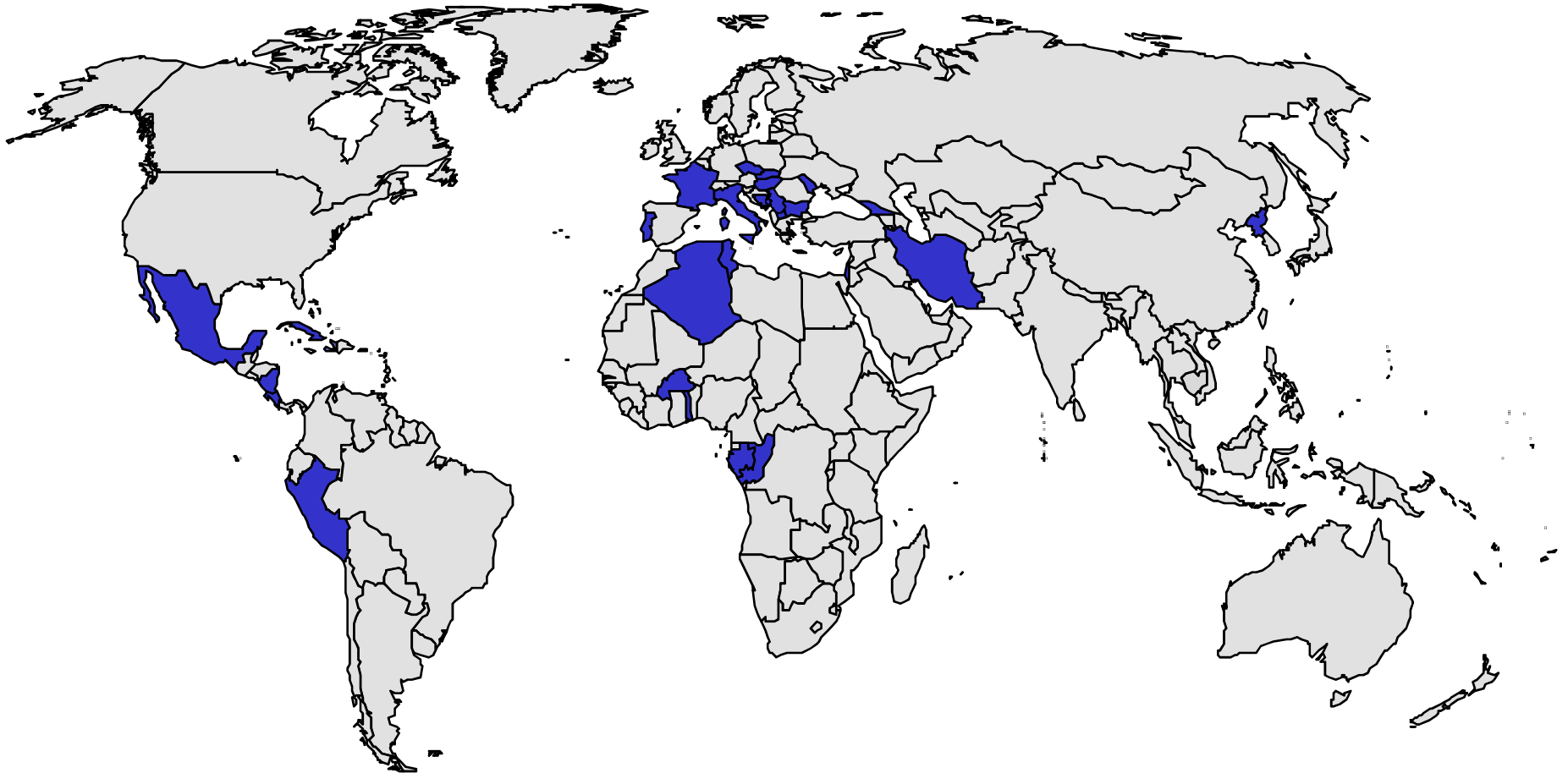


Transitional Period
(2 years)



Invalidation
or
Renunciation

States Party to the Lisbon Agreement (28 Contracting Parties)



Lisbon Union: 28 Member States

Europe (13)

Bosnia and Herzegovina

Bulgaria

Czech Rep.

France

Georgia

Hungary

Italy

Moldova

Montenegro

Portugal

Serbia

Slovakia

The FYR of Macedonia

Asia (3)

Islamic Rep. of Iran

Israel

DPR of Korea

America (6)

Costa Rica

Cuba

Haiti

Mexico

Nicaragua

Peru

Africa (6)

Algeria

Burkina Faso

Congo

Gabon

Togo

Tunisia

1063 registrations – 958 in force

■ Algeria	7	■ <i>Mexico</i>	15
■ Bulgaria	51	■ Montenegro	2
■ Costa Rica	1	■ Peru	8
■ Cuba	20	■ Portugal	7
■ FYR of Macedonia	5	■ Rep. of Moldova	1
■ France	509	■ DPR of Korea	6
■ Georgia	28	■ Czech Rep.	76
■ Hungary	28	■ Serbia	3
■ Iran (Islamic Rep.)	32	■ Slovakia	8
■ Israel	1	■ Tunisia	7
■ Italy	143		

(May, 2017)

Examples of Appellations of Origins (AO) in the Lisbon Registry



TEQUILA
(669 / Mexico)



CAFE VERACRUZ
(840 / Mexico)



BANANO DE COSTA RICA
(900 / Costa Rica)



PROSCIUTTO DI PARMA
(843 / Italy)



**SAROUGH HANDMADE
CARPET (956 / Iran)**



CHULUCANAS (869 / Peru)



HEREND (737 / Hungary)

Registered Appellations of Origin

The LISBON EXPRESS database

The screenshot shows the 'Lisbon Search' page in a Microsoft Internet Explorer browser. The address bar displays 'http://www.wipo.int/ipd/en/search/lisbon/search-struct.jsp'. The page features the WIPO LISBON logo and the text 'The International System of Appellations of Origin'. A navigation menu includes 'ABOUT WIPO', 'IP SERVICES', 'PROGRAM ACTIVITIES', 'RESOURCES', and 'NEWS & EVENTS'. The main content area is titled 'Search Appellations of Origin (Lisbon Express)'. It contains a 'Structured Search' form with a search box and a 'Search' button. Below the search box are several search criteria, each with a dropdown menu set to 'AND' and an input field: 'Number', 'Appellation', 'Country of Origin', 'Area of Production', 'Product', 'Category', 'Nice Classification', and 'Holder'. A 'SHORTCUTS' section on the right lists links for 'Help', 'Simple Search', 'ST 3 (Country codes) PDF', 'Feedback', and 'Lisbon Web site'. The browser's taskbar at the bottom shows the Start button and several open applications, including 'Lisbon Search - Micro...'.

The AO Bulletin



The Bulletin “Appellations of origin” is the official publication of the Lisbon System. It is issued by WIPO for the publication of new registrations and other recordings in the International Register as well as information concerning changes in the legal framework of the Lisbon System. In addition, the Bulletin contains statistical information concerning registered appellations of origin.

More information on the Lisbon System:
www.wipo.int/lisbon/en/



**The Geneva Act of the Lisbon Agreement
on Appellations of Origin
and Geographical Indications
of May 20, 2015**

Origin of the Revision

*Improve the Lisbon System to make it **more attractive** for users and prospective new Members, while **preserving the principles and objectives** of the Lisbon Agreement.*

(See LI/A/25/3, paragraph 19(i))

Variety of means to protect geographical indications

■ *Sui generis* legislation



■ Trademark system (collective/certification marks)



■ Administrative systems (labelling, etc.)

■ Legislation on unfair competition

The **New** Features of the Geneva Act

- **Enhanced recognition of the different means of protection** of AOs and GIs at national and regional level (*sui generis, trademarks, etc.*)
- Allow the accession of **intergovernmental organizations** that administer regional systems for the registration of GIs (*e.g. EU, OAPI*)
- Inclusion of **geographical indications** in the scope of protection (*TRIPS definition*)

The **New** Features of the Geneva Act

- **Flexibility** as to the **type of legislation** under which a Contracting Party protects registered AOs/GIs (*sui generis, trademarks, etc.*) (**Art.10**)
- **Direct filings** by “right holders” (**Art.5**)
- Possibility to request an **intention to use** (*declaration based requirement*) (**Rule 5.4**)
- New definition of the **scope of protection** (**Art.11**)

The **New** Features of the Geneva Act

- Opportunity for **interested Parties to request the refusal of protection** (*Art.15*)
- **Safeguards** to:
 - prior trademarks rights (*Art. 13.1*)
 - personal names used in business (*Art.13.2*)
 - plant variety or animal breed denominations (*Art 13.3*) and
 - generic terms (*agreed statements, Rule 5.5*)

**The Madrid and Lisbon Systems
are also two complementary
ways of protection for origin
products brands**

Lisbon - Madrid: Complementary protection

Lisbon Registration

LIS - 1059
CHIANTI CLASSICO



LIS - 459
ROQUEFORT



Madrid Registration

MM - 902976
Coll-TM (logo)

MM - 877636
Col-TM

MM - 477479
Coll-TM (logo)

Concluding Remarks

- Valuable intellectual property rights
 - multifunctional
- Means for product differentiation and identification
- Need for
 - active marketing and promotion
 - positive protection nationally and abroad in accordance with existing mechanisms and specific needs and requirements of all stakeholders

→ MADRID & LISBON SYSTEMS

Thank you!

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