

Working Group on the Development of the Lisbon System (Appellations of Origin)

Sixth Session
Geneva, December 3 to 7, 2012

REPORT

prepared by the Secretariat

1. The Working Group on the Development of the Lisbon System (Appellations of Origin) (hereinafter referred to as “the Working Group”) met in Geneva, from December 3 to 7, 2012.
2. The following Contracting Parties of the Lisbon Union were represented at the session: Algeria, Czech Republic, France, Georgia, Hungary, Iran (Islamic Republic of), Italy, Mexico, Peru, Portugal, Serbia, the Former Yugoslav Republic of Macedonia (12).
3. The following States were represented as observers: Australia, Benin, Burundi, Chile, Colombia, Germany, Iraq, Libya, Madagascar, Philippines, Romania, Russian Federation, Saudi Arabia, Slovenia, Spain, Sri Lanka, Switzerland, Thailand, Turkey, United States of America (20).
4. Representatives of the following international intergovernmental organizations (IGOs) took part in the session in an observer capacity: African Regional Intellectual Property Organization (ARIPO), European Union (EU), International Vine and Wine Office (IWO) (3).
5. Representatives of the following international non-governmental organizations (NGOs) took part in the session in an observer capacity: Brazilian Association of Intellectual Property (ABPI), Centre for International Intellectual Property Studies (CEIPI), International Trademark Association (INTA), MARQUES (Association of European Trademark Owners), Organization for an International Geographical Indications Network (oriGIn) (5).

¹. Modifications compared to document LI/WG/DEV/6/7 PROV.2, based on communications from delegations and representatives that participated in the meeting have been introduced in paragraphs 48, 113, 136, 252.

6. The list of participants is contained in Annex II.

AGENDA ITEM 1: OPENING OF THE SESSION

7. The Director General of WIPO, Mr. Francis Gurry, opened the session and reported on some developments in the operation of the Lisbon system.

8. First, he reported that continuous progress had been made in expanding the use of e-mail for the communication of international applications and notifications under the Lisbon procedures and added that, to date, the competent authorities of 21 member States had agreed to use e-mail as the principal means of communication under the Lisbon procedures, which also represented a great saving in productivity and a great saving in the use of paper, in particular.

9. Second, he pointed out that in the course of 2012, new registrations had been recorded for appellations of origin from Peru (3), Serbia, Mexico and Italy, and that two further applications had been recently received and were still in processing, one from France and the other from Italy.

10. The Director General said that, as agreed at the previous meeting of the Working Group, the International Bureau had established an electronic forum to facilitate discussions in between Working Group sessions and enable member States to communicate various proposals and suggestions. He observed that it was not the most active forum on the Internet for the time being, while also pointing out that the first submission had been recently received and that it had been published. Hopefully, it would become a more active forum for discussion of the questions facing the Working Group.

11. The Director General recalled that when the Lisbon Union Assembly met in September 2009 to establish the mandate of the Working Group, three objectives had been articulated for the work of the Working Group:

- (i) to endeavor to extend the Lisbon system to geographical indications;
- (ii) to establish the possibility for intergovernmental organizations to participate in the Lisbon system; and
- (iii) to try to modernize the Lisbon system, taking into account how appellations of origin and geographical indications were protected in various jurisdictions without losing sight of the principles and objectives of the Agreement.

12. He went on to say that three years had passed since then and that it was very pleasing to see that, in those three years, despite the fact that one was dealing with an extremely difficult subject internationally, significant progress had been made.

13. The Director General emphasized the importance of the work and said that it was very promising that the Working Group had moved into treaty drafting mode. Solving the question of an International Register that would enjoy widespread acceptance around the world would be an enormous step forward. He therefore strongly encouraged the members of the Working Group to work with that objective in mind to take the work forward.

14. The Director General stressed that one of the fundamental questions that was confronting the members of the Working Group was how they would express the results of the substantive discussions, and whether that would be through a new treaty or a protocol, or whether that would instead take the form of a revision of the existing Lisbon Agreement. In that regard, the Director General recalled that for both forms precedents existed in WIPO in respect of the revision and modernization of an international registration system, for the purpose of attracting a

broader membership and introducing the possibility for intergovernmental organizations to participate, one form in the case of the Madrid system and the other in the case of the Hague system. In the case of the Madrid system the route chosen had been a protocol to the Madrid Agreement, whereas in the case of the Hague system the route chosen had been a Revised Act of the Hague Agreement. The time had come for the Working Group to make a choice as to the way to go in respect of the Lisbon system. Opting for a protocol or a new treaty would require a big effort, as all WIPO Members would have to agree to the convening of a diplomatic conference. A diplomatic conference for the conclusion of a Revised Lisbon Agreement, however, could take place on the basis of a decision of the Lisbon Union Assembly. The Director General further indicated that another central question to the work of the Working Group was the extremely difficult question of the relationship between appellations of origin and geographical indications and how that would be expressed in the revision of the Agreement. Obviously, such strategic decision would influence the whole draft of the instrument. Also in that regard, the Secretariat needed clear guidance from the Working Group.

15. Lastly, the Director General suggested that the Working Group start thinking about a timetable for going forward and a roadmap for the completion of the work.

AGENDA ITEM 2: ELECTION OF A CHAIR AND TWO VICE-CHAIRS

16. Mr. Mihály Ficsor (Hungary) was unanimously elected as Chair of the Working Group, Mr. Alberto Monjarás Osorio (Mexico) and Mr. Behzad Saberi Ansari (Iran (Islamic Republic of)) were unanimously elected as Vice-Chairs.

17. Mr. Matthijs Geuze (WIPO) acted as Secretary to the Working Group.

AGENDA ITEM 3: ADOPTION OF THE AGENDA

18. The Working Group adopted the draft agenda (document LI/WG/DEV/6/1 Prov.) without any modification.

AGENDA ITEM 4: REPORT OF THE FIFTH SESSION OF THE WORKING GROUP ON THE DEVELOPMENT OF THE LISBON SYSTEM (APPELLATIONS OF ORIGIN)

19. The Working Group took note of the adoption, on November 16, 2012, of the report of the Fifth session of the Working Group, as contained in document LI/WG/DEV/5/7, in accordance with the procedure established at the Fifth session of the Working Group.

AGENDA ITEM 5: DRAFT NEW INSTRUMENT CONCERNING THE INTERNATIONAL REGISTRATION OF GEOGRAPHICAL INDICATIONS AND APPELLATIONS OF ORIGIN AND DRAFT REGULATIONS UNDER THE DRAFT NEW INSTRUMENT

20. Discussions were based on documents LI/WG/DEV/6/2, LI/WG/DEV/6/3, LI/WG/DEV/6/4 and LI/WG/DEV/6/5.

21. The Chair drew the attention to paragraphs 1 to 9 of document LI/WG/DEV/6/2 and invited the Secretariat to introduce the documents.

22. The Secretariat limited itself to the crucial issue that was dealt with in the introductory part of document LI/WG/DEV/6/2, namely the choice to be made as to what kind of instrument the Working Group would want to work towards. The Secretariat recalled that, at the previous

meeting, it had been clarified for the first time that the Working Group had a two-fold mandate, namely to prepare a revision of the Lisbon Agreement that would involve the refinement of its current legal framework and the inclusion of the possibility of accession by intergovernmental organizations, but also the establishment of an international registration system for geographical indications. Those two elements had been separated by the Working Group at its previous meeting, which was very much related to the question as to whether the establishment of an international registration system for geographical indications fell within the mandate of the Working Group. The Working Group had decided that the answer to that question was yes and the Assembly had meanwhile endorsed that view. However, the choice still had to be made whether geographical indications could be added to the Lisbon Agreement or whether it would be necessary to deal with the establishment of an international registration and protection system for geographical indications in a separate instrument, either a protocol or a new treaty. The Secretariat highlighted the importance of such choice in order to know whether it would be the Lisbon Union Assembly or the General Assembly that could convene a diplomatic conference or whether the Lisbon Union Assembly could only deal with a diplomatic conference for the conclusion of a Revised Act of the Lisbon Agreement, and that it would be the General Assembly of WIPO that would have to decide on a diplomatic conference for the conclusion of a treaty establishing an international registration system for geographical indications. That was the reason why the Secretariat had presented the Draft New Instrument (DNI) as it appeared in document LI/WG/DEV/6/2. The Secretariat went on to say that, as, at the end of the day, whatever the choice that would be made by the Working Group, the results could still be combined in a single instrument, the important question was to decide whether one would go for a Revised Act of the Lisbon Agreement plus a protocol, or for an entirely new treaty. At the same time, the issue as to whether there should be one or two registers, one for appellations of origin and the other for geographical indications, or one single register for both, would also have to be resolved. In that connection, the Secretariat said that it had to borne in mind that international registrations would be governed by different national laws as applying in the countries that would be party to the system and drew the attention to Rule 2 of the Regulations to the Draft Protocol, as contained in document LI/WG/DEV/6/3, Annex II, Option A, which suggested the creation of a single register in which the International Bureau would clarify, per Contracting Party, in respect of each international registration, whether the registered appellation of origin or geographical indication was protected as an appellation of origin or as a geographical indication. In that regard, the Secretariat recalled that some countries in the world distinguished between appellations of origin and geographical indications in their law, while other countries did not apply such a distinction and only provided for the protection of geographical indications.

23. The Chair opened the floor for general comments and added that he would be most grateful if delegations could indicate in those general statements whether and to what extent they were satisfied with the structure of the DNI and where their preferences would lie with respect to the relationship between the Revised Lisbon Agreement and any new instrument on geographical indications, and whether there should be a single register for both titles or two separate ones.

GENERAL STATEMENTS

24. The Delegation of Mexico expressed its preference for a single instrument covering both appellations of origin and geographical indications, while also indicating that the Delegation of Mexico would continue to work and make every effort to attain the objective the Working Group had set for itself.

25. The Delegation of Italy was pleased to see that an effort had been made to simplify and reduce the complexity of the DNI, and further indicated that it liked the overall approach of providing appellations of origin and geographical indications the same high level of protection. The Delegation also expressed its preference for a unique instrument combining appellations of origin and geographical indications.
26. The Delegation of Iran (Islamic Republic of) said that its preference would be for a single instrument protecting both appellations of origin and geographical indications.
27. The Delegation of Serbia recalled that at the previous session the strongest emphasis had been put on the definition of appellations of origin and geographical indications and their respective scope of protection. The Delegation further recalled that several options had been presented given the complexity of those issues. The Delegation was of the view that the revised versions of the DNI and Draft Regulations (DR) under consideration fully reflected the comments and suggestions made at the previous session and therefore represented a positive advance, in particular as regards the concept of single level of protection for both appellations of origin and geographical indications thereby becoming a good basis for further discussions leading towards the modernization of the Lisbon system. The Delegation added that it strongly supported further work on the revision of the Lisbon Agreement with the objective of making the system more attractive for users and prospective new members while preserving the basic principles of the Agreement and their compatibility with the TRIPS provisions.
28. The Delegation of Peru welcomed the various options that had been introduced in the revised DNI under consideration and which had to be taken into account when considering what the structure of a possible Revised Lisbon Agreement, or a totally different new instrument, should be. On that specific matter, the Delegation of Peru reiterated its preference for a single instrument containing both appellations of origin and geographical indications, as the Delegation was of the view that a separate treaty would involve extra costs for countries and the relevant authorities.
29. The Delegation of Algeria stressed the importance of appellations of origin for Algeria as they were an asset enabling the protection of both a geographical territory and a specific know-how, which in turn enhanced the country's sovereignty and the country's desire to allow all producers, craftsmen, and handicrafts to flourish. Lastly, the Delegation expressed its preference for Option B of document LI/WG/DEV/6/2, namely having a separate treaty that would separate appellations of origin and geographical indications. The Delegation added that its preference was based on the fact that Algeria had legislation separating appellations of origin from geographical indications and that it would be difficult for the Delegation to embark in a discussion connecting the two issues. The Delegation added, nonetheless, that such position was expressed at a preliminary phase and that the Delegation could obviously consider changing its position in the light of proposals or positions expressed by other delegations in the course of the discussions.
30. The Delegation of the Former Yugoslav Republic of Macedonia expressed its preference for a single document covering both appellations of origin and geographical indications.
31. The Delegation of Georgia indicated its flexibility as regards the choice of the legal instrument given that the substantive provisions were the same. The Delegation specified that Georgia had a legal framework for both appellations of origin and geographical indications and that the same legal protection was accorded to both. Lastly, the Delegation of Georgia expressed its support for the adoption of an international register for geographical indications, and more preferably for a single register for both appellations of origin and geographical indications.

32. The Delegation of Portugal expressed its preference for a single instrument for both appellations of origin and geographical indications.

33. The Delegation of Switzerland expressed its preference for a single instrument that would cover the registration of both appellations of origin and geographical indications. With regard to the form that such instrument would take, the Delegation was of the view that one of the options that had previously been put on the table had been forgotten, namely a revision of the Lisbon Agreement to protect appellations of origin and geographical indications in the same instrument. As regards the other points, in case a single instrument giving the same protection to appellations of origin and geographical indications, the Delegation was of the view that a single register indicating what would be an appellation of origin and what would be a geographical indication, would be sufficient. The Delegation expressed the view that the Lisbon system had to remain simple and cautioned that that would not be the case if one were to multiply the number of instruments and acts.

34. The Representative of CEIPI expressed his organization's preference for a single instrument, the main reason being that the subject-matter under discussion was already complex enough in itself. The Representative of CEIPI was of the view that a single instrument could perfectly well be a Revised Lisbon Agreement that would also include geographical indications, as that would be the most straightforward and perhaps the most elegant solution. With regard to the possible protocol, the Representative of CEIPI was not sure that the precedent of the Madrid system was actually very relevant given that the nature of the proposed protocol under consideration was not at all the same as the one under the Madrid system. He added that at the beginning of the exercise that had led to the Madrid Conference of 1989 there had been discussions about two possible separate protocols, one to attract new countries into the system and the other to take the future community trademarks into account. He further indicated that, at the time, the decision had been taken to merge those two protocols into one text while still keeping the name protocol. He pointed out that the present situation was not at all the same since something quite different was being proposed. In short, the Representative of CEIPI expressed its clear preference for one single text, preferably a Revised Act of the Lisbon Agreement, and for one single register.

35. The Representative of CEIPI further indicated that, from the procedural point of view, one should differentiate two aspects: (i) who would convene the diplomatic conference, i.e., the Assembly of the Lisbon Union in the case of a Revised Act of the Lisbon Agreement or the General Assembly of WIPO in the case of a separate new treaty; and (ii) who would be entitled to vote in the diplomatic conference, which would be determined by the Rules of Procedure of the Diplomatic Conference. If one opted for a Revised Act of the Lisbon Agreement, the member States of the Lisbon Union would adopt the Rules of Procedure, but nothing would prevent them from being generous by giving voting rights to countries or organizations that would not be members of the Lisbon Union. In that regard, referring to the Diplomatic Conference that had led to the Geneva Act of the Hague Agreement, he recalled the participation of the United States of America in the exercise and the importance of its vote in respect of the final result.

36. The Delegation of France expressed the view that the DNI and DR had become a lot clearer from the point of view of the Working Group's objectives and would enable participants to work towards a straightforward and understandable text; they had, thus, also become more attractive for potential Contracting Parties. The Delegation further indicated that it, nevertheless, still did not have a clear understanding of the two options proposed in Annex II, namely the options of a protocol and a new treaty. The terminology used differed from the classical terminology used in international public law. Would members of the Revised Lisbon Agreement also need to become members of the Protocol in order to get their geographical indications registered and protected?

37. The Delegation of Romania indicated its preference for a single instrument that would be practical and simple, while also expressing its full support for the statements made by the Delegation of Switzerland and by the Representative of CEIPI.

38. The Chair noted that all delegations that had expressed themselves had welcomed the revised draft working documents prepared by the Secretariat which had been simplified and which provided for a single and high level of protection for both appellations of origin and geographical indications. He added that all delegations had also confirmed their commitment to the review exercise and their wish to further work towards a revision of the Lisbon system and the establishment of an international registration system for geographical indications. In addition, it had been pointed out and confirmed that the substantive provisions of the various draft new instruments did not really differ from one another, except for the definition of the subject-matter of protection. As regards the legal form of the DNI, the Chair noted that repeated calls had been made for a single instrument to cover both appellations of origin and geographical indications. He added that some delegations had indicated that in their view such a single instrument would constitute a revision of the Lisbon Agreement extending the current Lisbon system to geographical indications, so that such Revised Lisbon Agreement would cover both appellations of origin and geographical indications. In that regard, the Chair noted that it had also been stressed that, in such a case, the Assembly of the Lisbon Union would be empowered to convene a diplomatic conference which, in turn, did not necessarily mean that in a diplomatic conference convened by a Lisbon Union Assembly only current members of the Lisbon Agreement would have the right to vote, since the Rules of Procedure that would be adopted could provide otherwise. In that respect, the Chair said that the prevailing view had been that the single DNI should establish a single register for both appellations of origin and geographical indications, which was also based on the assumption that the register would indicate whether a certain denomination was protected in a Contracting Party as an appellation of origin or as a geographical indication. The Chair went on to say that the arguments put forward in such an approach had basically stressed the need to have a system as simple as possible and the need to avoid institutional complications. He noted, however, that one delegation had indicated its preference for a separate treaty, thereby keeping geographical indications separated from appellations of origin, which might also result in two separate registers for those two titles. The Chair added that that delegation had nonetheless indicated flexibility in that regard.

39. The Secretariat fully agreed with the comments made by the Representative of CEIPI about the distinction between calling a diplomatic conference and having voting rights at such conference. In that regard, the Secretariat pointed out that if the Working Group would recommend the Lisbon Union Assembly to call a diplomatic conference for the adoption of a Revised Act of the Lisbon Agreement, the Rules of Procedure adopted at the Conference would in turn determine who would have a right to vote. Referring to the views expressed by several delegations that there should be a single register covering both appellations of origin and geographical indications, while also clarifying that the register in question would indicate whether a particular denomination or indication would be protected as an appellation of origin or as a geographical indication in a particular country, the Secretariat underlined that that was precisely how an international register differed from a national register. If one considered the case of an application coming from a country that distinguished between appellations of origin and geographical indications in its national law, which filed an application for the international registration of an appellation of origin, it could be presumed that that country would also want to have the appellation of origin protected, as a geographical indication, in a country that did not apply such a distinction but only provided for the protection of geographical indications. The Secretariat further indicated that the reverse situation was also true, namely in the case of an application coming from a country that only provided for the protection of geographical indications, whenever the product applied for would inherently meet the definition requirements

of an appellation of origin, the country in question might wish the geographical indication to be protected as an appellation of origin in countries that would distinguish between appellations of origin and geographical indications in their law. Finally, the Secretariat sought clarification from the Delegation of France on the question the Delegation had raised.

40. Referring to Option A of Annex II, which indicated that the Protocol supplemented the Revised Lisbon Agreement, the Delegation of France wondered who could actually accede to the Protocol and, in particular, whether it would only be those members who were already party to the Revised Lisbon Agreement or whether accession would be possible for all WIPO members.

41. The Secretariat indicated that the presentation of the DNI was such that Option A and Option B of Annex II were the same in substance. As to who could accede to the instruments, the Secretariat pointed out that the final provisions of both instruments (Article 10 and Article 27, respectively) indicated that “any State or intergovernmental organization” could accede.

42. The Representative of CEIPI shared the perplexity of the Delegation of France with regard to the proposal in Annex II, as it would allow a country to accede to the Protocol without acceding to the Revised Lisbon Agreement, which would not work in his view. In any event, the Representative of CEIPI did not support the protocol approach.

43. The Chair said that Options A and B only differed in respect of the legal technique used to transfer substantive provisions from the Revised Lisbon Agreement into the new Treaty on geographical indications, namely by reference or by reproduction with the necessary adaptations. In addition, he wondered why the proposed instrument should be called a “Protocol Supplementing the Revised Lisbon Agreement” if the membership would not be limited to that of the Revised Lisbon Agreement. In conclusion, the Chair suggested moving away from the issue, on the assumption that the Working Group should work towards a single instrument in the form of an Act revising the Lisbon Agreement that would cover both appellations of origin and geographical indications.

DISCUSSION OF CHAPTER III (EFFECTS OF INTERNATIONAL REGISTRATION) AND ARTICLE 2 (SUBJECT-MATTER) OF THE DRAFT REVISED LISBON AGREEMENT AND THE DRAFT TREATY ON GEOGRAPHICAL INDICATIONS

44. Referring to the titles of Article 9 and Article 10, the Delegation of France inquired about the difference between “Protection of Registered Appellations of Origin” and “Protection Accorded by International Registration”. In that regard, the Delegation suggested that perhaps Article 9 should only deal with the obligations of member States to avoid any ambiguity between those two articles. As underlined in previous sessions, the Delegation had a question mark over the scope of Article 9(2) which clearly defined an obligation of result rather than an obligation of means for member States. In that regard, the Delegation expressed concern about the complexity that such provision might generate for those States which only had trademark legislation, and wondered how they would be able to find in their trademark legislation adequate provisions that would confer the level of protection prescribed under Article 10. With regard to the content of protection under Article 10(1)(a), the Delegation said that to be able to take a position on that Article it would be useful to have a brief explanation of the difference between items (i) and (ii) since reference was made to “like products” under (i), whereas a reference to “comparable products” was made under (ii). In any event, the Delegation expressed a clear preference for Option A under (ii) as it was more general and straightforward contrary to Option B under (ii) which required proof of the likelihood of confusion. As regards items (iii) and (iv), which reproduced provisions that also applied under EU Regulations, she said that, in France, the complexity of these provisions had caused difficulties in terms of implementation. With respect to Article 10(1)(b), which incorporated wording from the TRIPS Agreement and

EU Regulations, the Delegation sought further clarification about the meaning of “shall refuse or invalidate the registration of a trademark which contains or consists of a registered appellation of origin with respect to products not originating in the geographical area of origin”. The Delegation was of the view that such wording, for products not originating in the geographical area of origin, could perhaps be improved, because an appellation of origin was not only used to designate origin, but also to highlight other factors; for example, to prevent that producers from the geographical area of origin would not respect the traditional methods required to have the right to use the appellation of origin. As regards Article 10(4) on “homonymy”, even though the Delegation was of the view that it was important to have such a provision in the new instrument, it sought further clarification on the meaning of “Each Contracting Party shall determine what protection it shall provide in respect of such appellations of origin”, and more specifically what was the type of protection referred to in that provision.

45. Referring to Article 10(1)(a), the Delegation of the European Union sought clarification as to whether item (i) referred to the use of the geographical indication in relation to the same kind of products as those covered by the geographical indication, and item (ii) to similar products. In that regard, the Delegation was of the view that Option B would lead to the surprising situation in which the protection conferred against the use of the geographical indication for the same kind of products would be smaller than the protection granted against the use of the geographical indication in relation to similar products. Indeed, item (i) under Option B referred to the situation in which the use would be detrimental or likely to exploit the reputation, while item (ii) under Option B only required a mere likelihood of confusion to grant protection.

46. The Delegation of Italy supported the request for clarification made by the Delegation of France as regards the relationship between Articles 9 and 10. As regards Article 10(1)(a), the Delegation expressed its preference for Option A in both item (i) and item (ii). Lastly, in light of its previous requests to include the concept of evocation in the new instrument, the Delegation requested that the brackets in Option A under item (i) be removed.

47. As regards Article 10(1)(a), the Delegation of Peru expressed its preference for Option A under item (i), with the exception of the terms between brackets “or evocation” due to the fact that the concept of evocation did not exist under the Andean Community legislation on intellectual property, which was also part of Peruvian law. Referring to the provisions under item (ii), the Delegation suggested removing the terms between the two first brackets so that the text would read “any commercial use of the appellation of origin in relation to a related or linked product, where such use” would “result in a likelihood of confusion” as per Option B. As regards Article 10(4), the Delegation of Peru was of the view that the issue of homonymy should not be included in the Revised Lisbon Agreement, as it had already been regulated under the TRIPS Agreement.

48. Referring to Article 10(1)(a), the Delegation of Switzerland expressed its preference for Option A under item (i). In that regard, the Delegation wondered whether that provision could not be drafted in more general terms, so as to prevent any use of the appellation of origin that would not be in conformity with the geographical origin requirement and any other condition determining the use of the appellation of origin, for example by referring to “any use of the appellation of origin in relation to a like product which is not in conformity to the requirements governing the use of the appellation of origin”. As regards item (ii), the Delegation wondered whether it would be useful to limit the protection to use on “a comparable, similar, related or linked product” and instead would prefer that a more general formulation be used so that the provision would apply to any other product using the appellation of origin incorrectly and not only to similar products. With regard to Article 10(3), the Delegation questioned the pertinence of saying that “Each Contracting Party shall be free to decide how to regulate the use of a registered appellation of origin by a person from the geographical area of origin entitled to use the appellation of origin in relation to a like product, that, while originating in the area, does not have the quality or characteristics of the products designated by the appellation of origin”. The

Delegation was of the view that such provision was contradictory to the aim of protection, as it was not only the geographical origin that mattered, but also the quality and nature of the product. The Delegation, therefore, expressed the view that the Contracting Parties should not be free to decide in that regard, but that such use should simply not be allowed. With regard to Article 10(4), the Delegation said that it was flexible as to whether a specific provision on homonymy would be incorporated in the Revised Lisbon Agreement or not. However, if the decision was taken to regulate homonymy in the Revised Lisbon Agreement, then specific provisions should be incorporated to that effect, rather than a mere reference to the TRIPS Agreement.

49. While expressing its preference for Option A under item (i) of Article 10(1)(a), the Delegation of Romania was of the view that the notions of “imitation”, “copy” or “evocation”, could actually fall under the single notion of “usurpation”. The Delegation went on to say that the phrase “would amount to usurpation, imitation, [or evocation]” was not sufficient and that more precision was needed. As regards Option B which read “would be [likely to be] detrimental to or [likely to] exploit unduly the reputation of the appellation of origin”, it was the Delegation’s understanding from the text that there was a reputation requirement as far as appellations of origin were concerned and therefore wondered what about would happen to those products which did not yet have a wide reputation.

50. The Representative of oriGIn pointed out that the full text of their contribution was also available on the electronic forum which had been recently established by WIPO. In particular, he said that, in their view, Articles 9 and 10 could be merged into a single article for the sake of simplification, while adding that, since one was now aiming at a single and high level of protection for appellations of origin and geographical indications, oriGIn would like to see the current Article 3 of the Lisbon Agreement reproduced as much as possible in the Revised Lisbon Agreement. This implied a clear preference for Option A under item (i) of Article 10(1)(a). The Representative of oriGIn was also of the view that Article 10 should be complemented as much as possible with language from the TRIPS Agreement, probably in a different paragraph which should deal with the relation between appellations of origin and geographical indications protected under the new instrument and trademarks applied for after protection to an appellation of origin or a geographical indication had been granted.

51. The Representative of CEIPI noted that, in Article 2, the word “product” was used and, in that regard, also referred to Note 2.04, which explained that the term “product” was used in Annex I, because that was the word which was used in the present English text of the Lisbon Agreement, whereas the term “good” was used in the two draft texts which appeared in Annex II, because that was the language used in the TRIPS Agreement. He went on to say that, in his opinion, for the sake of simplicity, the terminology used in the DNI should be harmonized and therefore suggested using the term “goods” instead of “products” in both Annexes, all the more since it was envisaged to have a single text for the next session which would cover both appellations of origin and geographical indications. Secondly, he said that he failed to understand the reason why the word “and” appeared within square brackets in the fourth line of Article 2(1)(a), as that gave the wrong impression that that word could be omitted. As regards Article 2(2), the Representative of CEIPI wondered whether the adjective “protected” was at all necessary because the text clearly referred to appellations of origin covered by the DNI. Then, as regards Article 10, he perceived a certain difficulty in the translation of the word “similar” in French, and noted in particular that it had not always been translated into “*similaire*” in the French version of the provision. In particular, he pointed out that, in item (i) of Article 10(1)(a), “like product” had been translated by “*produit similaire*” in French. However, the term “similar” in the last line of item (i) and in item (ii) of Article 10(1)(a) had been translated by “*analogue*” in the French version of the text. He suggested that the French translation of “similar” be harmonized throughout Article 10. Referring to Option B of Article 11, which read “Protection under Article 10(6) shall shield a denomination”, he pointed out that there was no paragraph (6) in Article 10 and that the correct reference should be to Article 10(5). Lastly, he

wondered whether the two paragraphs of Article 13 could not be combined into a single one, reading “Contracting Parties shall apply the provisions of the TRIPS Agreement relating to prior trademark rights and those relating to other prior rights.”

52. As regards Article 10(1)(b), the Representative of MARQUES supported the comments of the French and Swiss Delegations as to the importance of having a more precise definition of the extent of the scope of the protection. He said that the expression “products not originating in the geographical area of origin” did not seem to differ from the protection usually provided to indications of source or indications of provenance. In that respect, since the specificity of an appellation of origin resulted from a combination of the geographical element and a specific quality, it would appear to be necessary that the provision not only refer to products originating in a certain geographical area, but also to their compliance with the specifications set for the appellation of origin. He pointed out that Trademark Offices used to consider it sufficient for the description of goods in trademark applications to specify the geographical area of origin mentioned, but, nowadays, in those cases where the trademark application concerned products protected by an appellation of origin, also required the description of the goods in the trademark application to refer to the product specifications of the appellation of origin concerned. He therefore suggested that the part of the Article which read “with respect to products not originating in the geographical area of origin” be replaced by “with respect to products not complying with the requirements of the said appellation of origin”. As regards the structure of the DNI, he suggested that Article 5 be placed closer to Articles 9 and 10, in order to have all the provisions dealing with protection together.

53. Referring to item (i) of Article 10(1)(a), the Representative of INTA sought clarification on the concept of “like product” and, in that regard, pointed out that if the idea was to cover identical goods in (i) and similar goods in (ii) it might be clearer to speak directly of identical and similar goods. She also sought explanation of the difference between “any direct or indirect use” in Article 10(1)(a)(i) and “commercial use” in Article 10(1)(a)(ii), and of the reason for establishing such different regimes. Regarding the scope of protection, the Representative of INTA was of the view that the use of trademark-like language would help in bringing more certainty and predictability into the new instrument, since trademark concepts were very well-established, with which Courts and trademark authorities were very familiar, whereas the concepts of “usurpation and imitation”, or “evocation”, were much less clear. As regards “evocation” in particular, the Representative of INTA wondered whether such concept was actually required and what it really added to the text. She therefore suggested greater clarity in that regard or to leave those concepts out of the new instrument altogether. Then, moving on to Article 10(1)(b), which dealt with the relationship with trademarks and their possible invalidation, she reiterated INTA’s position that the priority principle should be expressly included in the provision, so as to make it clear beyond any doubt that only later trademarks could be invalidated on the basis of prior geographical indications and certainly not trademarks with an earlier priority, without prejudice of course to the possible application of any other grounds for refusal or invalidation that might exist in respect of such trademarks. She was of the view that a mere reference to the TRIPS Agreement would not make that clear enough and emphasized once again that the need to respect the priority principle was not only a matter of compliance with the TRIPS Agreement, but also one of the fundamental human rights guarantees on the protection of private property, such as those established under the European Convention on Human Rights.

54. The Delegation of France sought clarification on Option A of Article 11, which seemed to take up the current wording of the English translation of Article 6 of the Lisbon Agreement, as the French version of Article 11 of the DNI read “*ne peut pas être réputée avoir acquis un caractère générique*” and should read, in accordance with the original French text of Article 6 of the Lisbon Agreement, “*ne peut être considérée comme devenue générique*”. The Delegation of France expressed concern in this regard, as Option A of Article 11 did not appear to give the same strong protection as Article 6 of the Lisbon Agreement. Referring to Option B of

Article 11, the Delegation was of the view that the addition of an explicit reference to “grape, plant or animal variety” went into too much detail and did not appear to be necessary. Lastly, the Delegation shared the views expressed by the Representative of MARQUES and suggested that Article 5 be incorporated in Chapter III so that all the protection-related issues be dealt with in the same place.

55. Referring to Article 2(1)(c) which stated that “an appellation of origin may consist of a denomination which is not, *stricto sensu*, geographical”, the Representative of oriGIn was of the view that the proposed wording was not clear enough and therefore suggested that the text refer instead to “traditional geographical and non-geographical names”. He also wondered why Article 2(2) referred to “protected appellations of origin” while other provisions referred to “registered appellations of origin” and called for greater consistency in that regard. As regards prior rights, he was of the view that a mere reference to the TRIPS Agreement in Article 13 was not sufficient and that it would be advisable to draft a more elaborate text as regards the possibility of coexistence of an earlier trademark and a subsequent geographical indication, along the lines of the corresponding provision of the TRIPS Agreement. It was not enough to only hint at the possibility of coexistence in Article 17(3). Lastly, he fully supported the statement made by the Representative of MARQUES on Article 10(1)(b) in respect of product specifications.

56. As regards Article 11, the Delegation of Iran (Islamic Republic of) sought clarification on the phrase “deemed to have become” while also expressing its preference for Option A. The Delegation shared the views expressed by other delegations as to the necessity to incorporate the TRIPS provisions in full rather than by mere reference, in particular, but not only, because, there still were countries, like Iran (Islamic Republic of), that were not members of the WTO.

57. As regards Article 11, the Delegation of Italy indicated that, even though it was still considering the two options, it nonetheless had a slight preference for Option A. The Delegation further indicated that it agreed with the previous interventions concerning the necessity to incorporate the provisions of the TRIPS Agreement in full. With respect to Article 12, the Delegation was of the opinion that the current formulation was a bit negative and therefore suggested using language that would be closer to the language of Article 7 of the Lisbon Agreement.

58. The Delegation of Peru also supported the incorporation of the provisions of the TRIPS Agreement in full rather than by mere reference. As regards Article 10(4), the Delegation requested that the entire provision be put between brackets, so as to reflect its views that homonymy should not be dealt with in the new instrument.

59. The Chair noted that there had been repeated requests for reproducing the text of the provisions of the TRIPS Agreement referred to in the new instrument, in full, rather than by mere reference. He pointed out, nonetheless, that a *verbatim* reproduction of the provisions of the TRIPS Agreement could not take place because of the different structure and context of the TRIPS Agreement compared to as the DNI. In other words, adaptations would have to be made and would inevitably raise the question as to whether these were meant to indicate a departure from the provisions of the TRIPS Agreement or not. Another issue in this connection concerned the evolving international interpretation of the provisions of the TRIPS Agreement; in that regard, he said that it might not be advisable to detach the new instrument from the evolving interpretation of the TRIPS provisions by reproducing them in full instead of simply referring to the relevant TRIPS provisions. The absence of a link between the two international instruments might lead to divergent interpretations, even on the basis of quite similar text.

60. The Chair indicated that another important matter that had been raised was whether the protection envisaged in Article 10(1)(b) should extend not only to products which did not only originate in an area outside the geographical area of the protected appellation of origin, but also

to products that came from the same region but did not comply with the product specifications or the requirements concerning the product to which the protection of the appellation of origin applied. He also pointed out that the language used in Article 10(1)(b) came from the TRIPS Agreement. Referring to Article 11, the Chair indicated that the provision was a *verbatim* reproduction of the current English version of Article 6 of the Lisbon Agreement. The Chair also noted that a number of comments had been made on the issue of homonymy (Article 10(4)) and that one delegation in particular had expressed strong feelings about the issue, namely the Delegation of Peru. He went on to say that clarification had been sought with respect to the use of the words “like product” and “comparable product” and that several comments had been made on the way Article 10 should be structured. He also noted that concern had been expressed by several delegations that the wording of Article 9(2) would leave too much room for maneuver in implementing the new instrument and that specific questions had been raised on how that would work in countries where protection was provided through trademark-based legislation. The Chair noted that most of the delegations that had indicated their preference with respect to the various options contained in Article 10(1)(a) had spoken in favor of Option A, both with respect to items (i) and (ii), except for the Delegation of Peru which had indicated its preference for Option B under Article 10(1)(a)(ii). With respect to Article 11, he noted that those delegations that had indicated their preference had spoken in favor of Option A, with some reservations concerning the language used therein and in particular the expression “cannot be deemed to have become generic”. The Chair invited the Secretariat to further clarify the way in which the draft new instrument would deal with earlier rights and with earlier trademark rights, in particular. The Chair also noted that the Representative of CEIPI had suggested using the term “good(s)” instead of “product(s)” in the new instrument, so as to bring the text closer to the terminology of the TRIPS Agreement. As regards Article 12, he recalled the suggestion made to bring its language closer to Article 7 of the Lisbon Agreement, and also referred to the suggestion made by another delegation to merge the two paragraphs of Article 13 into one, so as to avoid any confusion or unnecessary repetitions.

61. The Secretariat pointed out that the first provision after the abbreviated expressions in Article 1 of the DNI, dealt with the subject matter itself, namely appellations of origin and, in the case of Annex II, geographical indications. The Secretariat recalled that the previous drafts, which had been discussed in June 2012, did not follow the same structure. In effect, the previous draft dealt with “subject matter” in the same article as the article that required protection of international registrations and the reason for that had been that the Secretariat had wanted to stick as much as possible to the current structure of the Lisbon Agreement. Article 1 of the Lisbon Agreement established the requirements for member States to protect appellations of origin recognized and protected as such in the country of origin and registered at the International Bureau. Right after that provision, Article 2 provided a definition of appellations of origin and of country of origin, and only after that provision an Article on the content of protection could be found. However, on the basis of the discussions at the previous meeting, a new structure was proposed, putting the provisions on definitions upfront. The Secretariat went on to say that the provision that corresponded to Article 1(2) of the Lisbon Agreement could now be found in Article 9(1) of the DNI. On the basis of the discussions at the previous session, provisions corresponding to Articles 1(2) and 3 of the Lisbon Agreement were now presented together in Articles 9 and 10, while provisions corresponding to Article 2 of the Lisbon Agreement were now put upfront.

62. Then, the Secretariat highlighted another aspect of the provision of Article 9, which could also be found in the Article 1(2) of the current Lisbon Agreement, namely the requirement that one could only register an appellation of origin under the Lisbon Agreement if the appellation of origin had already been recognized and protected as such in the country of origin. In this regard, the Secretariat recalled the discussions that had taken place on the term “as such” – “*à ce titre*” in French – which had led to the conclusion of the Working Group, at the time, that the new instrument would have to clarify that a country was free to protect appellations of origin under the Lisbon Agreement in the way it wanted, as long as the substantive requirements of

the Agreement were met. The Secretariat went on to say that many contributions to the Survey had requested that the words “as such” be deleted in the future instrument or at least to clarify in a footnote that there were no restrictions as regards the form of protection. Referring to the comments made at the present session, that it might not be possible under each and every type of legislation to meet these substantive requirements, the Secretariat indicated that in such cases the country concerned would simply not be able to accede. In any event, Article 9(2) simply reflected what had been agreed by the Working Group at one of its previous meetings and, in fact, dealt with an issue that had been one of the main reasons to embark upon a review of the Lisbon Agreement. In that regard, the Secretariat pointed out that, whenever the International Bureau sought to promote the Lisbon Agreement, the first reaction from countries often was that they could not accede to the Lisbon Agreement because they did not have *sui generis* legislation on appellations of origin in place. However, at the same time, it often appeared that there actually was another type of protection in the country that would allow their accession to the Lisbon Agreement. In this connection, the Secretariat wished to recall again that, when the Lisbon Agreement was concluded at the Diplomatic Conference of 1958, the basic proposal on the table did not contain a definition of appellations of origin and that it was only at the Conference that some delegations had indicated that a definition was necessary in order to allow participation in the Lisbon system of countries that had other national systems than the *sui generis* system for appellations of origin existing in countries such as, for example, France, without requiring them to replace their own system by that *sui generis* system. Moreover, under Article 5(3) of the Lisbon Agreement – a provision that would also apply under the DNI, by virtue of its Article 15(1)(c) – a country that had refused an appellation of origin registered under the Lisbon system was nevertheless obliged to provide any other protection that might be available in respect of the appellation of origin in question. In other words, if a country would issue a refusal because it would be of the opinion that the product in question did not meet the definition of an appellation of origin, but it would have a law with two definitions, one for appellations of origin and the other for geographical indications, and the product in question did meet the definition of a geographical indication, the country would be obliged to provide protection to that product as a geographical indication.

63. Referring to the comment made by some delegations that Article 5 of the DNI should be moved to Chapter III, the Secretariat said that such amendment would certainly be possible, but wondered whether the provision of Article 5 that required compliance with the provisions of the Paris Convention would also have to be moved to Chapter III. Following the example of the Geneva Act of the Hague Agreement, that provision should perhaps not be moved to Chapter III. As regards the question concerning the use of the terms “like products” in Article 10(1)(a)(i), the Secretariat indicated that the expression “like products” had been used because it seemed to be the most appropriate way to refer to a product that did not meet the requirements of an appellation of origin. The Secretariat went on to say that if a reference were made to “identical products” that terminology would suggest that a product actually met the requirements of the appellation of origin. Therefore, the notion of “like product” appeared to be more appropriate, as it referred to a product which belonged to the same category/kind of product, without being the same. The Secretariat further indicated that the expression “comparable products” was not an invention of the International Bureau, while also adding that the words in brackets in Article 10(a)(ii), namely “comparable”, “similar”, “related” or “linked” were all words that had been proposed in response to the Survey two years ago. Hence, all the proposed words had been inserted in the DNI because the Secretariat was not in a position to make a choice in that regard. It was for the Working Group to decide which term had best be used. Referring to Article 10(1)(b), the Secretariat indicated that the relationship between appellations of origin and trademarks was dealt with in Article 10, following the example of the TRIPS Agreement, which also dealt with protection against use by others and protection against registration of a trademark in the same article. Referring to the comments made concerning the references to the TRIPS Agreement in Article 13, the Secretariat clarified that such references had been made because previous discussions in the Working Group had shown that earlier drafts introducing the relevant provisions of the TRIPS Agreement had required some form of

adaptation and could be interpreted as departing from the original TRIPS provisions. The Secretariat agreed with the suggestion made by the Delegation of Peru to put Article 10(4) between brackets as it was of the view that such option was better than to delete paragraph (4) altogether. The absence of a provision dealing with homonymy would not solve the problem, as the provisions on scope of protection would also apply to two homonymous appellations and both would have to be protected. The Secretariat said that it did not quite understand the comments on Article 10(1)(a)(i) and (ii) that had been made by the Delegation of the European Union and sought further clarification in that respect. As regards the comments made by the Representative of CEIPI about the use of the word “good” instead of “product”, the Secretariat had no objection in that respect. The Secretariat further indicated that the suggestion to merge Article 13(1) and 13(2) into one provision could certainly be considered. With respect to the request for explanation on the difference between Article 10(1)(a)(i) and (ii), where one provision referred to “direct or indirect use” in brackets, while the other provision talked about “commercial use”, the Secretariat clarified that once again that was a mere reflection of the proposals that had been made in the responses to the Survey. Referring to Option A of Article 11, the Secretariat confirmed that the words “cannot be deemed to have become generic” were contained in the current English translation of the Lisbon Agreement. In that regard, the Secretariat added that two years ago a number of translation errors had been discovered in the official English and Spanish translations of the Lisbon Agreement and that proposals for correction had been circulated to all Lisbon member States for their approval. The Secretariat recalled that some delegations had taken the opportunity to propose other corrections as well, but, at the time, no objection had been raised concerning the wording of Article 6 in the English translation of the Lisbon Agreement. As regards the suggestion made by the Representative of oriGIn with respect to Article 2, namely to use the terms “traditional geographical or non-geographical names”, the Secretariat said that the wording proposed in Article 2(1)(c) appeared to be the broadest possible way of saying that an appellation of origin could also cover names that were not geographical, while still directing the public towards a particular geographical area. The Secretariat further agreed that the word “protected” in Article 2(2) could be deleted and clarified that “registered appellations of origin” in Article 9 meant appellations of origin registered under the new instrument, given the fact that the word “registered” was defined in Article 1 as meaning “entered in the International Register in accordance with this Act”. On the contrary, Article 2, which dealt with subject-matter and not with registrations under the Agreement, laid down what “protected appellations of origin” aimed to do. The Secretariat then referred to the comments made that the protection should not only be available against products that did not originate in the geographical area of origin but also that were not in conformity with the product specifications. In that regard, the Secretariat pointed out that the DNI separated those two things and said that if a product, rightly put on the market by someone that came from the geographical area of origin, did not meet the product requirements of the appellation of origin or the geographical indication, that was an issue to be dealt by the country itself, as indicated by the wording “how to regulate such use is up to each country to decide”.

64. The Delegation of France reiterated that Option A of Article 11 of the DNI was based on the wording of Article 6 of the Lisbon Agreement and, therefore, in the French version, the word “*réputée*” had to be replaced by “*considérée*”. The Delegation also sought further clarification on the meaning of Article 9(2) and whether, for purposes of opening up the Lisbon system to different types of national legislations, the wording used there under was intended to provide Contracting Parties with an absolute freedom in the choice of legislation not only with respect to the protection of its national appellations of origin but also with respect to internationally-registered appellations of origin. The Delegation’s understanding was that there would be some liberty in the choice of the legislation that countries would implement with regard to their own appellations of origin but not with regard to internationally registered appellations of

origin. Referring to Article 13, and more particularly to the notion of “other prior rights”, the Delegation pointed out that in reality there were situations that were characterized not by rights but by *de facto* situations and therefore suggested clarifying what “other prior rights” actually referred to.

65. As regards Article 9(2), the Chair said that any reference to “registered appellations of origin” contained in the new instrument had to be read in conjunction with Article 1(x), which defined “registered” as “entered in the International Register in accordance with this Act”. Article 9(2) did not mean that Contracting Parties would be obliged to have a registration system in place to provide protection to appellations of origin. The expression “registered appellations of origin” clearly meant registered in the International Register under the DNI. The Chair went on to say that in his view the decisive provision was contained in the second part of Article 9(2), which clearly stated that the type of legislation chosen had to meet the substantive requirements of the new instrument.

66. Referring to Article 10(4), the Delegation of Peru renewed its request to put the text between square brackets as it was of the view that such a provision was not necessary in the DNI. With regard to the comment made by the Secretariat that the removal of such provision would not actually remove the possibility of having two homonymous appellations of origin being put forward for registration, either as appellations of origin or geographical indications, the Delegation requested to be provided with an actual example of homonymy recorded in the International Register, and, noting that the current Lisbon Agreement did not include any provision dealing with homonymy, also wondered what was actually the need for including such provision in the future DNI.

67. The Chair confirmed that the provision contained in Article 10(4) would be square bracketed in the next revised version of the DNI.

68. Referring to Article 10(1), the Delegation of the European Union clarified its earlier comments in that regard by indicating that it was of the view that there was a lack of consistency between items (i) and (ii) of Article 10(1)(a). More specifically, starting from the premise that the products are split into two groups, namely “like products” and “similar products” as referred to those in items (i) and (ii) respectively, the Delegation pointed out that if one referred to Option B of item (i) one could still see that protection was granted not against any use but only against a qualified use, which is to say a “detrimental” use or a use which “exploits unduly the reputation”. Meanwhile, if one referred to Option B of item (ii), which only applied to similar products, one could notice that protection was granted against any use that “would result in a likelihood of confusion”. The Delegation was therefore of the view that the threshold was higher under (i) than under (ii).

69. The Delegation of the Russian Federation indicated that it was looking at the possibility of acceding to the Lisbon Agreement which could also be supported by the fact that, in the summer of 2012, Russia had become a member of the WTO, which in turn meant that it had to abide by the provisions of the TRIPS Agreement concerning the protection of geographical indications. The Delegation pointed out that its national legislation had provisions dealing with the protection of appellations of origin of goods that were very similar to the protection granted under the Lisbon Agreement. The Delegation further indicated that when new requirements came up on the protection of geographical indications following its accession to the TRIPS Agreement, the Russian Federation thought about the measures it would be necessary to adopt to provide protection for that new group of products. The Delegation added that in 2008 several amendments had been made to its national legislation as regards appellations of origin of goods and the determination of a definition of appellation of origin. The latter had actually been broadened so as to include a definition drafted more or less along the lines of Article 2(1)(c) which stated that a denomination did not “*stricto sensu*” have to be geographical, provided all the other conditions of subparagraph (a) are fulfilled. The Delegation nonetheless indicated that

such new wording did not yet allow it to say whether under its current national legislation national competent authorities could fully provide protection for geographical and non geographical names. Upon noting that several questions had been raised with respect to the references made to the TRIPS Agreement in Article 13, the Delegation sought clarification as to whether it would be correct to assume that all the Contracting Parties to the Lisbon Agreement also had to be members of the WTO and, therefore, required to fulfill the TRIPS obligations in their respective territories. On the contrary, if the accession to the new agreement would not be limited to WTO members, the Delegation expressed the view that any reference to the TRIPS Agreement should be avoided in Article 13.

70. As regards the question raised by the Delegation of the Russian Federation about the relationship of the DNI with the TRIPS Agreement, the Chair said that his understanding was that even countries or IGOs that were not yet members of the WTO could accede to the DNI, subject to the undertaking that in respect of certain matters covered by the relevant articles of the DNI, they would apply provisions as stipulated in the TRIPS Agreement. In other words, by ratifying the new instrument or by acceding to it, newly acceding countries would accept that, in the context of the DNI, certain provisions of the TRIPS Agreement would have to be applied by them. Moreover, a similar obligation to comply with the Paris Convention also existed under Article 5(3) of the DNI and the only difference between the two situations under consideration was that the TRIPS Agreement was not administered by WIPO. The Chair further indicated that a similar technique had also been used in other treaties administered by WIPO, where references were made to the Contracting Parties' obligation to comply with the provisions of the Paris Convention even in cases where the Contracting Parties were not members of the Paris Convention.

71. Referring to the earlier explanations given by the Chair regarding the evolving nature of the interpretation of the TRIPS Agreement, the Delegation of Iran (Islamic Republic of) indicated that that was precisely the reason that prevented it from accepting any reference to the TRIPS Agreement in the DNI. The Delegation went on to say that, as was also the case for the other countries who were not members of the TRIPS Agreement, Iran (Islamic Republic of) could certainly accede to a treaty which referred to the provisions contained in a separate instrument such as the TRIPS Agreement and undertake to be bound by them, only as much as those provisions would be completely defined in the new Treaty and spelled out in full.

72. The Representative of oriGIn clarified that the actual objective of his proposal to merge Articles 13 and 17 was certainly not to impose an obligation of coexistence. Instead, the purpose of his proposal was to clearly define the conditions under which coexistence could be allowed by member States. Otherwise, if complete freedom was left to a member State to simply withdraw an opposition so as to "*de facto*" allow coexistence, that might amount to a violation of the Treaty in his view. As regards Article 10(1)(b) and the comments made on the necessity to include the possibility to refuse a trademark application not respecting the product specifications in addition to the possibility to refuse a trademark application for products not originating in the geographical area, the Representative of oriGIn stressed the importance of such addition as that would make it clear that geographical indications and appellations of origin were not merely indications of source. He went on to say that if such addition implied going further than the TRIPS Agreement that would be perfectly possible because the TRIPS Agreement did allow countries to ensure stronger protection.

73. With respect to Option A of Article 11, the Representative of CEIPI said that the linguistic difficulty raised by the Delegation of France resulted from the fact that the French translation under consideration was a translation of the English version of the DNI, which in turn differed from the authentic French text of the Lisbon Agreement. In that regard, the Representative of CEIPI was of the view that the English text itself had to be harmonized with the official French text, because although the English text was used as the basis for discussions at the present session, the French text was the only authentic text.

74. In a preliminary attempt to summarize the discussions held that far, the Chair first noted that there had been a suggestion to move Article 5 to Chapter III. He further indicated that there seemed to be a consensus on replacing the word “product” by “good” throughout the DNI and also referred to the interesting debate on how the provisions of the TRIPS Agreement should be incorporated in the DNI, either through a simple reference or through the reproduction of those provisions in full. Referring to the suggestion to merge the two paragraphs of Article 13, the Chair pointed out that in that case an amendment to Article 10(1)(b) would be necessary as it contained a specific reference to Article 13(1). He also recalled that there had been discussions on the terms used in Article 10(1) and in particular whether the terms “like products” were appropriate or not, given that the Secretariat had explained that “identical product” might mean a product with the same characteristics as the one protected under the appellation of origin. The question was whether the Working Group shared this interpretation of the term “identical product”.

75. As regards Article 2(2), the Delegation of France expressed concern over the use of the plural in the definition and the reference to “denominations” instead of “denomination”, which, in the Delegation’s view generated a difficulty concerning the establishment of a link between reputation and denomination. In other words, the Delegation expressed the view that it was no longer clear what gave the product its reputation and, for example, whether it was the denomination, the human or natural factor, or something else. Referring to the absence of the term “geographical” before “denominations” in Article 2(1)(a), the Delegation sought clarification as to what the actual scope of Article 2(1)(c) was in that case, as it was not clear whether the denomination was necessarily geographical, and more specifically inquired as to what was the meaning of “provided all the other conditions of subparagraph (a) are fulfilled”, and what those conditions were. The Delegation also sought further clarification on the expression “delimited jointly” in Article 2(2), and whether the term “jointly” was used because of the principles that are to be implemented to operate a common delimitation, or whether the term was used because of a common legal instrument underpinning such delimitation. As regards Article 2(1), the Delegation recalled that the cumulative nature of natural and human factors was still an essential issue for France, and was therefore of the view that the current appellation of origin definition contained in the Lisbon Agreement should be kept in the DNI, all the more since the insertion of a definition of geographical indication in the DNI would nonetheless allow those denominations that do not fulfill the cumulative requirements to still be protected as geographical indications under the new instrument.

76. Referring to Article 2(1)(c), the Chair asked the Delegation of France to confirm that it was not questioning the understanding that protection as an appellation of origin would also be available for indications that were strictly speaking not geographical but which had obtained some kind of geographical connotation but that the Delegation’s concern was that, since subparagraph (a) did not explicitly refer to ‘geographical’ denominations, subparagraph (c) could create confusion.

77. As regards Article 2(1)(a), the Delegation of Peru suggested that the term “geographical” be put before “denominations” to make things clear and added, that in that context, the specification contained in Article 2(1)(c) would make perfect sense. In the Spanish version of the DNI, the Delegation suggested replacing the terms “*producto originario*” by “*producto proveniente de*”, product proceeding from, given the fact that in Spanish the terms “*originario de*” could be confused with the Spanish term “*oriundo*”, which was closer to the notion of being native from rather than to proceed from. With respect to the last sentence of Article 2(1)(a), the Delegation sought an explanation of what was being referred to by “reputation”, and in any event suggested finding another term in the Spanish version of the DNI because the Spanish translation of reputation, which is to say “*notoriedad*”, might be confused with the notion of “notoriety” under trademark law, which had a very special connotation. The Delegation was of the view that Article 2(1)(c) had to be more specific because it referred to an appellation of origin that could consist of a non-geographical denomination provided all other conditions were

fulfilled. In that regard, the Delegation suggested transposing the text contained in Note 2.02 of document LI/WG/DEV/6/4 which read “international protection as an appellation of origin, is also available for indications that are strictly speaking not geographical, but which have obtained a geographical connotation”.

78. Referring to the comment made by the Delegation of Peru that the term “reputation”, or “*notoriedad*” in the Spanish version of the DNI, would also have a trademark connotation, the Chair pointed out that the term “reputation” was already used in Article 2(2) of the current Lisbon Agreement. In other words, it was already part of the terminology of the Lisbon Agreement and was regarded as a major pre-condition for protecting appellations of origin under the Lisbon Agreement.

79. Referring to Article 2(1)(a) and the expression “traditionally known to be”, the Delegation of Hungary wondered why that terminology had been inserted into the definition as it did not appear in the current definition of the Lisbon Agreement.

80. The Delegation of Peru agreed that in Article 2(2) of the Lisbon Agreement, a reference was indeed made to reputation, or “*notoriedad*” in the Spanish version of the Agreement, but still expressed the view that since one was in the process of revising the Lisbon Agreement for purposes of improving it, and to expand it to other potential members, the clarification of certain terms might be worthwhile.

81. Referring to Article 2, the Delegation of Switzerland requested that the current definition of the Lisbon Agreement, which referred to both natural and human factors, be maintained in the DNI without any footnote. Moreover, the Delegation was of the view that the term “traditionally known” in Article 2(1)(a) had to be deleted as it would only create confusion. Lastly, the Delegation suggested that Article 2(1)(c) be deleted as well because the word “geographical” no longer appeared before “denomination” in Article 2(1)(a).

82. The Chair noted that there basically were two alternatives on the table concerning the way in which Article 2(1) could be formulated. The first was to insert the word “geographical” before “denominations” in Article 2(1)(a) so that the Act would concern, as a general rule, geographical denominations, while also keeping subparagraph (c) of Article 2(1). In short, that would help clarify that protection would also be available for denominations “that were strictly speaking not geographical, but which had obtained a geographical connotation”. The other alternative was to keep the current text in Article 2(1)(a) which referred to “denominations” in general, and to delete subparagraph (c) of Article 2(1).

83. With regard to Article 2(1), the Delegation of the European Union suggested that the formulation used there under be further aligned with the language of the TRIPS Agreement as it was of the view that the current wording went beyond what the TRIPS Agreement contained, which in turn could hamper the practical implementation of the new instrument. The Delegation therefore proposed that the first paragraph of Article 2(1) be amended so as to read “This Act concerns denominations which serve to designate a product as originating in a geographical area situated in a Contracting Party, where the quality, characteristics, or reputation of the product, are exclusively or essentially attributable to the geographical environment”. The Delegation further expressed the view that if the current wording of Article 2(1)(a) was kept, subparagraph (c) of Article 2(1) would not appear to be necessary. Referring to the alternatives proposed by the Chair, the Delegation indicated its preference for the first proposal, namely to add the term “geographical” in subparagraph (a) of Article 2(1), while also keeping subparagraph (c). As regards Article 2(2), the Delegation was of the view that it was not consistent with the remainder of the text and was therefore wondering whether it would be preferable to delimit the geographical area in paragraph (2) instead of paragraph (1) of Article 2.

84. The Delegation of Italy expressed doubts about the inclusion of the terms “traditionally known to be” in Article 2(1). As regards Article 2(1)(c), the Delegation agreed with the proposal made by the Delegation of Peru. Lastly, the Delegation was of the view that paragraph 2 of Article 2 should remain under Article 2.

85. The Delegation of Iran (Islamic Republic of) was satisfied with the current drafting of Article 2(1) and was also of the view that subparagraph (c) had to be kept. The Delegation sought further clarification regarding Article 2(2) which read “area delimited jointly by the adjacent Contracting Parties in whose territories such geographical area of origin is situated”. In that regard, the Delegation more specifically asked whether the protection of appellations of origin for such products was conditional to both countries across the border being parties to the new instrument or whether it was sufficient for only one of the countries to be a party to the new instrument.

86. As regards Article 2(1), the Representative of CEIPI said that he was opposed to the inclusion of the terms “traditionally known to be” in that paragraph. With regard to Article 5, and its possible inclusion in Chapter III, he said that he had no objection to that modification but added that in such case the title of Chapter III would have to be amended to refer to the Content of Protection and not just to the Effects of International Registration. With regard to Article 14, he wondered whether it wouldn't be possible to combine the two options and to begin with Option B so that the text would read “Each Contracting Party shall provide effective legal remedies for the protection of registered appellations of origin. In particular, each Contracting Party shall ensure that legal proceedings...”

87. The Chair first noted that the expression “traditionally known to be” in Article 2(1)(a) had not received any support and also indicated that views had differed on the structure of Article 2(1) and not on the substance. There was consensus on the principle that denominations that were strictly speaking not geographical, but which had obtained a geographical connotation, also deserved protection. In that regard, he indicated that there were two ways of expressing that principle in the provisions of the DNI, which were either to keep subparagraph (a) as currently drafted without any reference to the denominations being geographical and delete paragraph (c) of Article 2(1), or to refer in subparagraph (a) to “geographical” denominations and keep subparagraph (c) as currently drafted. In addition, the Chair noted that there had been somewhat conflicting views on whether the definition of the subject matter in Article 2 should follow very closely the current Article 2 of the Lisbon Agreement, or whether the definition should be brought closer to the one contained in the TRIPS Agreement. In that regard, he pointed out that the Delegation of the European Union had advocated the latter approach, while the Delegation of France and some other Contracting Countries of the current Lisbon Agreement had advocated a Lisbon-like approach in that regard.

88. The Secretariat sought further clarification on the comment made by the Delegation of France concerning the change from the singular to the plural in Article 2(1)(a), and its possible effect on the interpretation of the word “*notoriété*” or “reputation” in English.

89. The Delegation of France pointed out that the previous definition, in the earlier version of the draft new instrument, referred to “a denomination which has given the product its reputation”, while the current text referred to denominations including human and natural factors “which have given the product its reputation”. In that regard, the Delegation indicated that the issue under consideration was whether “reputation” should be linked to “denominations” or to “human and natural factors”. In other words, the Delegation observed that there was a problem with the use of the plural which did not exist until then because the earlier text used the singular form. In that regard, the Delegation clarified that it was a denomination or an appellation which had given its reputation to the product rather than the human and natural factors. In conclusion, the Delegation suggested adding a comma to help clarify what the “which” was referring back to in the French version of the new instrument.

90. The Secretariat pointed out that the current Article 2(2) of the Lisbon Agreement read “which has given the product its reputation” and that it was preceded by the words “the appellation of origin which has given the product its reputation”. The Secretariat further indicated that an appellation of origin was defined in Article 2(1) of the Lisbon Agreement as being “the geographical denomination [...] which serves to designate a product originating therein, the quality or characteristics...” Clearly, the definition of appellation of origin in Article 2 of the Lisbon Agreement comprised both the denomination and the quality or characteristics. The Secretariat agreed that in the text under consideration it was not clear whether the term “which” referred back to denominations or to the quality or characteristics, but also expressed the view that at the end of the day it did not matter because “which” would then refer back to both, which should be the case in any event. Referring to the sentence between brackets “traditionally known to be”, the Secretariat recalled that such terminology had been suggested at the previous meeting by the Delegation of Iran (Islamic Republic of) as attested to by paragraph 112 of the Report of the previous meeting. In that connection, the Secretariat invited the Delegation of Iran (Islamic Republic of) to shed some further light on their proposal. As regards the reference to “other conditions” in Article 2(1)(c), the Secretariat indicated that this referred to all the conditions in Article 2(1) other than that the denomination had to be geographical. Article 2(1)(c) made it clear that a denomination could be implicitly or explicitly geographical. As regards the question concerning the use of the terms “jointly delimited” in Article 2(2), the Secretariat pointed out that the question was related to the notion of geographical area of origin, which was referred to in Article 2(1)(a), but which should also become an element of Article 2(2). In that regard, the Secretariat pointed out that one had to go to Article 1(xi), which stated that “geographical area of origin” referred to “a geographical area as referred to in Article 2(1)”. Meanwhile, Article 1(xii) stated that “a trans-border geographical area of origin” referred to “a geographical area of origin” as referred to in Article 2(2). In that regard, the Secretariat clarified that it was up to the country of origin to decide how to determine the geographical area of origin. The current definition of the Lisbon Agreement did not specify anything in that respect, and it was only in the Lisbon Regulations that an obligation to provide a delimitation of the geographical area of origin could be found. The Secretariat pointed out that that was also the case in the draft regulations under this consideration. The Secretariat went on to say that the obligation to delimit the area could not be found in the DNI, with the exception of Article 2(2), and that the question was therefore for the Working Group to decide whether the delimitation should be part of the DNI or whether it should be left in the Regulations as a mandatory requirement for an application and a registration of an appellation of origin. The Secretariat noted the various suggestions to delete footnote 2, but also specified that the footnote appeared between brackets, so as to indicate that there still was a difference of view in the Working Group as to whether the “natural [and] human factors” should be cumulative or alternative requirements. Referring to the comments made by the Delegation of Peru about the use of the term “reputation” in the English version of the DNI, or “*notoriedad*” in the corresponding Spanish version, the Secretariat indicated that the current text of the Lisbon Agreement also used the word “*reputation*” or “*notoriedad*”. With respect to the suggestion made by the Delegation of the European Union to bring the definition provisions in Article 2(1)(a) more in line with the TRIPS Agreement definition for geographical indications, the Secretariat invited the other members of the Working Group to provide their views in that respect. The same applied to the suggested replacement of the words “due to” by “attributable to” which featured in the TRIPS Agreement. In response to the question raised by the Delegation of Iran (Islamic Republic of) on Article 2(2), namely whether adjacent countries sharing a trans-border area would both have to be Contracting Parties to the DNI in order to be able to register the trans-border appellation of origin under the new instrument, the Secretariat said that the answer was yes. The Secretariat pointed out, however, that if only one of the two countries was a Contracting Party to the DNI, then of course, that country still had the possibility to register the appellation for that part of the trans-border area situated in its territory. As regards Article 14, the Secretariat was of the view that the two options A and B should be kept in the final text, and further clarified that Option A basically reflected the provisions of Article 8 of

the current Lisbon Agreement in a slightly modified way. The Secretariat added that, since the provision dealing with “legal proceedings” had led to numerous comments at previous meetings in the sense that the provision would need to be modernized and that it lacked clarity in many respects, Option B had been added as an alternative to address the issue in a different way.

91. As regards its suggestion to use the phrase “traditionally known to be” in Article 2(1)(a), the Delegation of Iran (Islamic Republic of) first recalled that what mattered in the new instrument was to protect the products that had acquired a long-standing reputation because of their geographical origin. The Delegation went on to say that, without the phrase “traditionally known to be”, the language of Article 2(1)(a) could be interpreted as meaning that in each and every case a fact-finding mission would have to be conducted to establish whether the quality or characteristics of the products are actually due to the geographical environment. Hence, the Delegation was of the view that it should be enough to simply take into account the fact that the quality or characteristics of the product are traditionally known to be exclusively or essentially due to the geographical environment. The Delegation indicated that another possibility would be to delete the terms “traditionally known to be”, and to go along with the suggestion of the Delegation of the European Union to insert the word “reputation” after “characteristics” in Article 2(1)(a) so that the provision would read “the quality, characteristics, or reputation of the product...”

92. On the basis of Article 2 of the current text of the Lisbon Agreement, which did not include the expression “traditionally known to be”, it was the understanding of the Chair that the registration and protection of an appellation of origin in the other Contracting Countries was not subject to the conduct of a fact-finding mission to factually check whether all the requirements had been met in the country of origin. The Chair further indicated that his understanding was that Contracting Countries acted on the basis of mutual trust and that, whenever an appellation of origin was protected in a given Contracting Country of the Lisbon Agreement, there was a presumption that the Contracting Party had assessed the criteria for protection properly. Moreover, he recalled that the other Contracting Countries could always issue a declaration of refusal of protection of any given international registration, and he therefore failed to see how the expression “traditionally known to be” would bring any added value to the current practice under the Lisbon Agreement. The Chair asked the Delegation of Iran (Islamic Republic of) whether a clarification in the notes, or in an agreed statement, or a footnote to the DNI, that Contracting Parties worked on the basis of mutual trust and that no fact-finding missions would need to be conducted to assess the basis for protection of any given appellation on the national level, would meet their concerns.

93. The Delegation of Iran (Islamic Republic of) said that it could go along with the Chair’s suggestion to include a formal clarification in an agreed statement, in the notes or in a footnote.

94. As a general observation, the Chair noted that there seemed to be two schools as far as the definition provisions were concerned. One school sought to keep the text as close as possible to the current version of Article 2 of the Lisbon Agreement, while the other school preferred to bring it closer to the language contained in the TRIPS Agreement. In that regard, the Chair recalled that another, separate, instrument for the protection of geographical indications had been proposed, even though the prevailing view now seemed to be to move towards a single instrument covering both appellations of origin and geographical indications. In any event, the Chair pointed out that the language used in the current draft instrument for the protection of geographical indications was very close to the language of the TRIPS Agreement and therefore wondered whether it would be appropriate to have both definitions, for appellations of origin and geographical indications, drafted along the lines of the TRIPS

Agreement. In other words, he did not see the need to bring the definition of appellations of origin closer to the one contained in the TRIPS Agreement since, in any event, a definition of geographical indications following the definition of the TRIPS Agreement would also be included in the DNI.

95. The Delegation of Switzerland expressed the view that the appellation of origin definition should be drafted along the lines of the current Lisbon Agreement. As regards Article 2(2) concerning trans-border appellations of origin, and Article 6(5) dealing with applications concerning trans-border areas, the Delegation was of the view that the necessity for two adjacent States to agree on the appellation of origin concerning a trans-border geographical area might present some difficulties as there might be cases where States would not be able to come to an agreement, which in turn would mean that there would be no protection under the Lisbon system. The Delegation was therefore of the view that individual applications should also be permitted and suggested replacing the terms “in a trans-border geographical area delimited jointly by the adjacent Contracting Parties” by “in a trans-border geographical area that can be delimited jointly by the adjacent Contracting Parties” in Article 2(2).

96. The Chair indicated that Article 2(2) should be read in conjunction with Article 6(5) which basically gave two options to the Contracting Parties sharing a trans-border geographical area of origin, namely to file each an application referring to the part of the trans-border area situated in its territory, or to act as a single Contracting Party of Origin by filing an application jointly through a commonly designated Competent Authority. The Chair said that when one compared the provisions of Article 6(5) with those of Article 2(2), one could wonder whether the requirement that the area should be delimited jointly, should apply in all cases. The Chair was of the view that such requirement should only apply in the case of Article 6(5)(a)(ii) where the Contracting Parties acted as a single Contracting Party of Origin. In the case of Article 6(5)(a)(i), when each Contracting Party filed a separate application, the Chair could not see the need to agree on the trans-border geographical area jointly or to delimit it jointly, because each Contracting party could delimit that area on its own with respect to the part which fell in its territory. In that regard, the Chair suggested amending Article 2(2) so that the provision would read “appellations of origin may serve to designate products originating in a trans-border geographical area of adjacent Contracting Parties in whose territories such geographical area of origin is situated”. He added that the issue as to whether a joint delimitation of the territory would be required or not could be clarified in the Regulations only with respect to Article 6(5)(a)(ii).

97. The Delegation of the Russian Federation sought further clarification on the options proposed under Article 14. The Delegation noted that Option A established an obligation to ensure that the procedures could be brought by the public Prosecutor, another public authority, or any interested party, whether a natural person or a legal entity. However, the Delegation also noted that item (i) under Option A indicated that “another public authority” could bring the legal proceedings “where the applicable law so provides”, which in turn gave the impression that the Contracting Parties were obliged to provide the possibility to bring legal proceedings both to the public Prosecutor or another public authority on one side, but also to “any interested party whether a natural person or a legal entity”, on the other. The Delegation asked the Secretariat whether that was indeed the case. The Delegation also noted that the formulation under Article 8 of the current Lisbon Agreement was different, and that the reference to national legislation did not appear in paragraphs (1) or (2) of Article 8 but in the “*chapeau*” of that article, which enabled the Contracting Parties to decide whether it would be the public Prosecutor or the Competent Authority that would initiate the legal proceedings, or whether such possibility would be given to “any interested party, whether a natural person or a legal entity”. The Delegation pointed out that the Russian legislation did not give the possibility to initiate legal proceedings to the public Prosecutor or to another public authority. Instead, interested parties, whether natural persons or legal entities, which used an appellation of origin or which had rights over an appellation of origin, were the only entities that could bring such legal proceedings. The

Delegation therefore expressed the view that a more general approach would be preferable and that a reference to the national legislation should be included in a “*chapeau*”, following the model of Article 8 of the current Lisbon Agreement, because that would enable Contracting Parties to provide either both possibilities under items (i) and (ii) in Option A of Article 14, or only one of the two possibilities, depending on what was actually possible under their national legislation. As regards Options A and B, the Delegation was of the view that both provisions were complementary to one another and therefore could both remain in Article 14.

98. The Delegation of France reiterated its preference for two separate definitions, one for appellations of origin based on the Lisbon Agreement, and one for geographical indications based on the TRIPS Agreement.

99. The Delegations of Peru and Italy also supported the idea of having an appellation of origin definition drafted along the lines of the current Lisbon Agreement, and a definition for geographical indications drafted along the lines of the TRIPS Agreement.

100. The Representative of oriGIn reaffirmed his support for two separate definitions, namely an appellation of origin definition that would reflect as much as possible the current Lisbon definition, and a geographical indication definition that would be drafted along the lines of the TRIPS Agreement.

101. The Delegation of Romania expressed its support for an appellation of origin definition drafted along the lines of the Lisbon Agreement, but also indicated that it did not see the necessity to simply mirror the TRIPS Agreement as regards the geographical indication definition and suggested that the DNI have its own definition.

102. Referring to Article 2(2) and Article 6(5)(a)(i) and (ii), the Delegation of Chile was of the view that, since those provisions recognized expressly that an appellation of origin or a geographical indication could be used by two countries, it would be important to have a provision on the possibility of protecting homonymous appellations as the one proposed in Article 10(4).

103. As regards Article 11, the Delegation of the European Union was of the view that it would be more appropriate to simply lay down that “a registered geographical indication or appellation of origin may not become generic”, which would also require a slight amendment to the title of Article 11. With respect to Article 13, the Delegation said that it would prefer that the principle of coexistence between a prior trademark and a later appellation of origin or geographical indication be written in full in the DNI, rather than through a mere reference to the TRIPS Agreement. The Delegation further indicated that since the TRIPS Agreement brought little clarity to the issue of other possible prior rights, it seemed appropriate to have an explicit provision addressing those other prior rights in the DNI.

104. The Chair noted that the prevailing view of the Working Group was that, as far as the definition of appellation of origin was concerned, the current definition of the Lisbon Agreement should be followed as closely as possible, with a few adaptations that would perhaps clarify certain issues and also reflect established practice under the Lisbon Agreement. The Chair added that two separate definitions for appellations of origin and geographical indications would thus be kept in the DNI. The former would be based on the current definition of the Lisbon Agreement and the latter would be based on the definition under the TRIPS Agreement. He recalled that there had been an agreement to remove the terms “traditionally known to be” from Article 2(1)(a), and that instead there would be a footnote clarifying how the protection criteria would be assessed under the DNI to address the concerns expressed by the Delegation of Iran (Islamic Republic of). As regards Article 2(1), the Chair indicated that there might be two alternative versions in the revised DNI. The first possibility would be to include the adjective “geographical” in subparagraph (a) of Article 2(1), so that the provision would concern

geographical denominations as a general rule, while also keeping subparagraph (c) of Article 2(1) slightly redrafted along the lines suggested by the Delegation of Peru so as to include the language contained in paragraph 2.02 of the Notes to the DNI. The alternative version of Article 2(1)(a) would involve leaving subparagraph (a) as currently drafted without any reference to “geographical” denominations, and deleting subparagraph (c) of Article 2(1). As regards Article 2(2), the Chair noted that the provision should only refer to appellations of origin instead of “protected appellations of origin”, and that the words “delimited jointly by” would also be left out so that the text would simply refer to “the trans-border geographical area of the adjacent Contracting Parties”, and the Regulations would specify in which case joint delimitation would be a requirement. The Chair noted the general support to move paragraphs (1) and (2) of Article 5 to Chapter III, which might in turn require an adaptation of the title of Chapter III. It was the understanding of the Chair that the obligation to comply with the Paris Convention could perhaps be addressed under the general provisions of Chapter I of the DNI. With respect to Article 11, the Chair noted the preference of the Working Group for Option A. The Chair indicated that there had been suggestions to bring the English version closer to the authentic French text of the Lisbon Agreement. As regards Article 14, the Chair noted the support for merging Options A and B, and further indicated that the drafting suggestions made by the Delegation of the Russian Federation would also be accommodated in an appropriate manner.

105. The Secretariat recalled that the brackets contained in Article 10 reflected the various proposals contained in the contributions that countries had made to the Survey that had been conducted two years ago. The Secretariat further expressed the view that all those proposals tried to capture basically two things, first that protection had to be provided against any use of the appellation of origin or the geographical indication in respect of a like product that did not originate from the geographical area of origin, and second that protection had to be provided against any use of the reputation of the appellation of origin or the geographical indication that could be detrimental to the function of the appellation of origin or the geographical indication to designate the product for which protection had been granted. In that regard, the Secretariat suggested keeping the language of the “*chapeau*” of Article 10(1)(a), followed by sub-item (i) that would focus on the use of the denomination constituting the appellation of origin in respect of a product that did not originate from the geographical area of origin, while sub-item (ii) would focus on any use likely to be detrimental to the capability of the appellation of origin to designate the product in respect of which protection had been granted, the underlying assumption being that the appellation of origin in question would have a certain reputation that others would be trying to abuse or take undue advantage of. The provisions under sub-item (ii) would also cover the case in which someone from within the geographical area of origin would be putting a product on the market that would not meet the production requirements.

106. As regards Article 10(1), the Delegation of the European Union suggested to merge sub-items (i) and (ii) into one single subparagraph, and to combine the wording of Options A and B, so that the text would be more in line with the current wording of the corresponding EU Regulations. The amended text would then read “the registered appellation of origin will be granted protection against any direct or indirect use of the appellation of origin in relation to comparable products, which would amount to usurpation, imitation or evocation of the appellation of origin, and/or would be detrimental to or exploit unduly the reputation of the appellation of origin”. In other words, the Delegation did not feel that the splitting of the text into two kinds of products, identical products or comparable products, would be useful at the end of the day. The Delegation therefore suggested to only use the terms “comparable products” in sub-items (i) and (ii), as these would also cover those products which were identical to those covered by the appellation of origin in question.

107. Referring to the relationship between the TRIPS Agreement and the DNI under consideration, the Chair recalled that some delegations were opposed to a mere incorporation by reference of the provisions of the TRIPS Agreement in the DNI, as in the case of Article 13 and some other provisions of the DNI. In that regard, he referred to the concerns expressed by

other delegations about the type of obligations that the Contracting Parties to the DNI, that would not be members of the WTO, would have under the DNI. To accommodate those concerns, the Chair recalled the suggestion to reproduce the relevant provisions of the TRIPS Agreement and to incorporate them in full in the DNI, with the necessary adaptations. He nonetheless expressed the view that such a suggestion might raise a number of technical problems, and therefore proposed as a possible way out in the case of Article 13, and for those other provisions of the DNI where reference was made to the provisions of the TRIPS Agreement, to instead refer to the relevant TRIPS provisions more specifically, by their numbers, either in the text of the provisions themselves, or in a footnote listing those provisions and identifying them by the number of the articles in question. The Chair was of the view that his proposal would perhaps help define more clearly the provisions that should be applied by Contracting Parties to the DNI. He then pointed out a number of difficulties, such as the necessity to first agree on the articles of the TRIPS Agreement that would be included in the proposed list, or the fact that the provisions of the TRIPS Agreement could be amended over time, which in turn would have an effect on the articles contained in the list. The Chair said that another difficulty was how to deal with those further amendments in respect of those Contracting Parties of the DNI that were not members of the WTO. In that regard, the Chair said that the footnote to the subparagraph concerning the TRIPS Agreement under the abbreviated expressions in Article 1 of the DNI, could perhaps be supplemented by a clarification that those Contracting Parties that were not members of the WTO would only be obliged to apply the provisions of the TRIPS Agreement that were in force when they ratified the DNI. The Chair clarified that such principle would not prevent them from applying the TRIPS provisions that would be amended after their ratification or accession if they wished to do so or if they acceded to the WTO later on.

108. The Delegation of Iran (Islamic Republic of) said that, as a matter of principle, it could not go along with the suggestion made by the Chair. Referring to the comment made by the Chair about the existence of references to other Conventions in the DNI, for example the Paris Convention, the Delegation referred to paragraph 58 of the Report of the previous session of the Working Group, which reflected that his Delegation had also expressed concern about the references to the Paris Convention, even though Iran (Islamic Republic of) was party to the Paris Convention. The Delegation therefore suggested to extract the relevant provisions of the TRIPS Agreement, and to add them to the DNI as an annex or a footnote. The Delegation concluded by saying that, as a matter of principle, it was opposed to the incorporation of the provisions of another treaty that had no structural relation with the new instrument it was planning to accede to.

109. The Delegation of Switzerland was of the view that, if the issues related to prior trade mark rights and other prior rights would be settled along the lines of the TRIPS Agreement, the obligations of the Contracting Parties in that respect should be clearly spelled out in the DNI rather than through a mere reference to the TRIPS Agreement. As regards the suggestion made by the Chair, the Delegation was not convinced that greater clarity or legal certainty would be achieved with the mere introduction of a clause stating that the only version of the TRIPS Agreement that would apply to a Contracting Party would be the one in force at the time of its accession to the DNI.

110. The Delegation of France expressed support for the comments made by previous delegations but clarified that a mere reproduction of the provisions and exceptions under the TRIPS Agreement could not be an end in itself, because the Working Group had particular ambitions for the new instrument and some of the TRIPS provisions did not go along the same lines. The Delegation was of the view that an inventory of the exceptions that the Secretariat had envisaged in the relevant notes to the DNI should first be made, as the notes mentioned certain exceptions which could not be qualified as "rights" as such, and the Delegation wondered whether the members of the Working Group were fully aware of the implications of

merely taking up the provisions of TRIPS Agreement in the DNI, and instead suggested that the Working Group come up with its own exceptions, as there were some TRIPS provisions that were not compatible with the Lisbon Agreement in the first place.

111. The Representative of INTA shared the views expressed by other delegations insofar as that she did not consider general TRIPS references as being sufficient neither in their present form in the DNI under consideration, nor in the form of a list included in an annex or a footnote. It would be necessary to include appropriate substantive provisions that would guarantee that prior trademark rights would be respected and protected, which was not the case under the present wording of the DNI. The Representative further expressed the view that the concerns voiced by the Chair and the Secretariat, that there could be divergent interpretations of the relevant provisions of the TRIPS Agreement, could be resolved by a combination of substantive provisions and specific language that would govern the relationship between the DNI and the TRIPS Agreement, for example by means of “without prejudice” type of terminology.

112. The Chair pointed out that various non-papers prepared by the Delegation of the European Union, the Delegation of Switzerland and the Secretariat, respectively, had been submitted to the members of the Working Group for their consideration. The text of these non-papers is contained in Annex III.

113. The Delegation of Switzerland indicated that the objective and the guiding thread of its proposal, prepared in conjunction with other delegations, were to simplify and clarify the provisions of Articles 10 and 11 of the DNI. In that regard, the Delegation was of the view that it would be simpler to differentiate between use for “comparable products” under item (i), and use for “non-comparable products” under item (ii), and then to take as a sole criterion the correspondence between the product and the conditions for the legal use of the appellation of origin on the product, in the case of comparable products. The Delegation further indicated that it had tried to simplify the provision that applied to any use that would be accompanied by terms such as kind, type, make and so forth, by linking such provision to the four points describing the acts that had to be banned. The Delegation added that it had deliberately left square brackets in (i), leaving it to the Working Group to decide whether terms such as usurpation or imitation should be kept in the DNI, as was the case under the current Lisbon Agreement. With regard to paragraphs (2) and (3) of Article 10 of the DNI, the Delegation was of the view that it would be preferable to delete those provisions. The Delegation was also of the view that paragraph (5) of Article 10 was superfluous and, as regards Article 11, the Delegation expressed a preference for Option A, not only because it was clearer, but also because it corresponded to the current formulation of the Lisbon Agreement. The Delegation suggested nonetheless considering the possibility of replacing the terms “be deemed to have become generic” by “cannot become generic”, for the sake of clarity.

114. Referring to Article 10(1)(b) of the Swiss proposal, which read “Contracting Parties shall refuse or invalidate the registration of a trademark which contains or consists of a registered appellation of origin with respect to products not meeting the requirements attached to this appellation of origin”, the Chair wondered how the Competent Authorities of the Contracting Parties, in the case of a trademark registration or invalidation procedures for example, would be in a position to check whether a certain product for which the trademark had been registered, did actually meet the requirements of a quite detailed list of product specifications. The Chair further indicated that the Swiss proposal would also require amendments to certain trademark acts, because a trademark incorporating an appellation of origin was not regarded as an absolute ground for refusal or a ground for invalidation. The Chair went on to say that, to the best of his knowledge, trademark registration procedures normally did not extend to the examination of the product itself. Moreover, he wondered who would check whether the quality

of a product which met the requirements at the date of registration would not deteriorate over time, and whether that could be considered as a ground for invalidation of the trademark. The Chair then sought clarification as to how the product specifications or requirements would be “attached” to an appellation of origin.

115. Referring to the question raised by the Chair, the Delegation of the European Union indicated that, whenever the Office for Harmonization in the Internal Market (OHIM) had to deal with trademark applications for goods in respect of which a list of specifications or requirements existed, as in the case of wines or cheese for example, OHIM was not involved in the examination of the compliance of the goods with the actual requirements. The Delegation nonetheless pointed out that any lack of compliance in that regard might lead to a request for cancellation of the trademark and would also allow the competent Regulatory Council to issue, for example, a request for cancellation on the basis that the trademark was misleading or the registration had been made in bad faith.

116. The Delegation of Switzerland agreed that further reflection was required on how to take into account the requirements for the use of the appellation of origin, which were not only limited to the geographical origin of the product. Use of the appellation of origin should not be permitted if the product would originate from the required geographical area of origin but did not meet the other conditions for the use of the appellation of origin.

117. The Delegation of France supported the proposal of the Delegation of Switzerland to which it had also contributed and further specified that the objective of the proposal had been to require a link not only with the geographical origin but also with the product specifications related to the appellation of origin, which could be found in the application for registration. In that regard, the Delegation went on to say that the proposed wording could perhaps be aligned with the provisions of Rule 7. As regards the implementation of the suggested provision, the Delegation was of the view that, as was already the case under the TRIPS Agreement – which contained provisions banning the registration of trademarks that comprised a geographical indication and did not originate in the geographical area mentioned in the specifications related to the geographical indication – the proposed text was simply going a bit further given that intellectual property offices already had the obligation not to register a product having a geographical origin different from the one mentioned in the specifications pertaining to the geographical indication. The Delegation further noted that the technique of limiting the products designated in the trademark registration on that basis was often used in the European Union or in other countries, such as the United States of America. The Delegation sought clarification as regards the scope of Article 10(a)(ii) in the non-paper prepared by the Secretariat (see Annex III) when read in conjunction with the corresponding Note 2. The Delegation indicated that its understanding of Note 2 was that an appellation of origin was protected when an identical or even a slightly different term was used; however, noting that Note 2 only applied to paragraph (ii) of Article 10(a), the Delegation asked whether that limitation implied that it would not apply to paragraph (i) of Article 10(a), and that it would therefore be possible to use geographical names derived from the appellation of origin whenever a given product would originate in the geographical area concerned. Should that interpretation be correct, the Delegation said that the proposed text, along with the corresponding Note 2, would actually be reducing the protection which existed under the Lisbon Agreement.

118. The Delegation of Peru said that, as a general rule, in Peru no one could register trademarks that would include a registered appellation of origin even, if the applicants would qualify as authorized users or producers. The objective was to prevent any abusive or misleading use of the appellation of origin given that, for trademark registration purposes, the intellectual property office was not in a position to verify whether the products for which the trademark registration was sought did actually comply with the technical requirements concerning the protected appellation of origin.

119. Referring to the practice in Hungary, the Chair said that, if trademark registrations were applied for in respect of a sign that would only consist of the geographical name of an appellation of origin or a geographical indication, the Intellectual Property Office would not register it, because it would be regarded as not distinctive and only refer to the geographical origin of the goods. However, in the case of a sign that would include the name of the geographical area as one of its elements, the Intellectual Property Office would register the trademark, provided the list of goods would be limited to the products originating in the area to which the appellation of origin or geographical indication applied. The Chair also pointed out that, in Hungary, the Intellectual Property Office did not check whether the product to which the trademark applied was in conformity with the product specifications, and added that he still could not see how such verification would be conducted in practice in a trial concerning the invalidation of a trademark, for example. He pointed out that Article 10(3) of the DNI left that question to the Contracting Parties.

120. The Representative of MARQUES said that there were many jurisdictions which did not necessarily check whether the products to which the trademark applied complied with any product specification or not. In other words, the Intellectual Property Office would simply register the trademark for those products complying with the product specifications, for example, sparkling wines complying with the specifications of the appellation of origin "*Champagne*". He then indicated that there could be jurisdictions in which cease and desist injunctions would not be granted, for example, against the holder of a trademark for wines coming from the Champagne region but which did not comply with the product specifications for the use of the appellation "*Champagne*", because such holder would still be protected by his trademark right, and the only alternative would be to initiate a procedure to cancel his trademark registration. Referring to the comment made by the Chair that he did not see how compliance with the product and the product specifications could be checked, the Representative of MARQUES indicated that in the case of a cease and desist procedure, there was a traceability mechanism in some countries, which allowed all the production stages of any given product to be checked. In that regard, he pointed out that OHIM no longer accepted that the product merely came from a specific geographical area but also required that it complied with the product specifications.

121. The Delegation of the former Yugoslav Republic of Macedonia indicated that, if a trademark would only consist of a geographical term, it would be refused as it would not be regarded as being sufficiently distinctive. On the contrary, a trademark that would contain other elements besides the geographical term would be registered, as long as the products or services covered by the trademark would indeed originate in the geographical area indicated in the trademark.

122. The Delegation of Switzerland said that besides the limitation of the list of products as a function of their provenance, it was also possible to limit the list of products by incorporating a reference to the appellation of origin, as it was already the case in some countries. The Delegation added that a specific reference to the appellation of origin was a way of limiting the list of products in a broader manner and noted that such practice, which did not require the conduct of a detailed investigation, was already followed by various countries, as it seemed to offer some sort of preliminary protection and allow some control over the scope of protection of the trademark.

123. The Chair said that the issue whether trademark applicants should be allowed to define the list of goods along the lines proposed by the Delegation of Switzerland should be distinguished from the issue whether the Intellectual Property Offices of the Contracting Parties would be under an obligation to check whether the product in question did indeed meet the requirements contained in the product specifications.

124. As regards the practicability of the amendment suggested by the Delegation of Switzerland in Article 10(1)(b), the Representative of INTA said that it seemed problematic from a practitioners' perspective in so far as the provision in question operated in a registration context and not in a use context. In that regard, she added that the issue would not so much be the prohibition to use a trademark for products not meeting the product specifications, but rather how the list of goods or services covered by the trademark should be drafted in practice. She indicated that at the European Union level that was quite straightforward, as Article 7(1)(j) of the Community Trademark Regulation stated that a trademark for wines with a geographical indication could only be registered for wines with the same origin as the geographical indication and did not require that the full list of product specifications be reproduced. She went on to say that the conditions for production were normally not dealt with in trademark registration proceedings; the same applied in respect of other regulatory requirements, such as labeling requirements. She was of the view that the original wording of Article 10(1)(b), which was closer to article 23(2) of the TRIPS Agreement, appeared to be more appropriate and straightforward from a practitioner's perspective.

125. Referring to the non-paper submitted by the Secretariat, the Representative of CEIPI sought an explanation as to the reason why items (iii) and (iv) of Article 10(1)(a) of the original version of the DNI had not been taken up in the new document distributed by the Secretariat.

126. Referring to the non-paper it had submitted, the Secretariat indicated that Article 10(1)(a)(i) was meant to cover only the use of the appellation of origin as such in respect of a product that would originate outside of the geographical area of origin. In other words, it did not deal with the situation of products that were produced in the geographical area of origin and, in that regard, the Secretariat recalled that the notion of geographical area of origin was explained in Article 2(1) of the DNI. The Secretariat pointed out that Article 10(1)(a)(ii) addressed other situations, such as the use of variations of the appellation of origin or the use of the appellation of origin with terms such as like, kind, type, style, or the like. The Secretariat added that all uses of that kind would be illegal if they would appear to be detrimental to the distinctive function of the appellation of origin for that particular product. In response to the question raised by the Delegation of France, the Secretariat clarified that Note 2 did not apply to sub-paragraph (i) of Article 10(1)(a). The Secretariat indicated that if one referred back to the Records of the Diplomatic Conference where the Lisbon Agreement was concluded, one would come across an explanation indicating that usurpation had the same meaning as counterfeiting. Lastly, in response to the question raised by the Representative of CEIPI concerning the absence of sub-items (iii) and (iv) in the Secretariat's non-paper, the Secretariat indicated that they had been deliberately left out because it seemed preferable to limit the discussion, for the time being, to the two main issues to be dealt with in Article 10(1).

127. The Delegation of France was of the view that the proposal made by the Secretariat actually diminished the protection which existed in the current Lisbon Agreement, which not only dealt with usurpation but also with imitation. The Delegation further indicated that "imitation" not only meant using the same name but also using the name as an adjective. For instance, France not only protected the term "*Bourgogne*" but also the adjective "*Bourguignon*" and the same applied to "*Champagne*" and "*Champenois*". In that regard, the Delegation was of the view that protection should not only concern the use of the same, identical name. Referring to what the Secretariat had said as regards sub-item (i), namely that it could only cover cases in which the denomination would be used for products that did not originate from the geographical area of origin, the Delegation expressed the view that such provision would not cover the case of products originating in the geographical area of origin but that would not have been produced according to the product specifications, and was therefore not in a position to accept the wording proposed by the Secretariat in that regard. The Delegation pointed out that under the current Lisbon Agreement there was an absolute ban on any use of the appellation of origin that would amount to a usurpation or imitation of such appellation of origin, whereas, under the proposed wording such prohibition would be subject to the proof that the use would be

“detrimental to the capability of the appellation of origin to designate the product in respect of which it was granted protection”.

128. The Delegation of Iran (Islamic Republic of) sought further clarification on the second part of Note 2 of the non-paper submitted by the Secretariat, which dealt with “uses of the appellation of origin by someone from within the geographical area of origin...”, and in particular wondered whether that should not actually fall within the national jurisdiction of the Contracting Parties themselves.

129. The Secretariat clarified that the use referred to in the second part of Note 2 was covered under sub-item (ii), while also pointing out that paragraph 3 of Article 10 of the DNI did leave that question to national law.

130. The Representative of oriGIn was also of the view that the non-paper presented by the Secretariat seemed to weaken quite significantly the protection given to appellations of origin under the current Lisbon Agreement, whereas the non-paper submitted by the Delegation of Switzerland did keep the strong protection accorded by Article 3 of the current Lisbon Agreement and also clarified all the various possible situations that had been discussed until now, including the case of trademarks. He concluded by saying that he fully supported the proposal made by the Delegation of Switzerland.

131. Referring to the non-paper from the Delegation of European Union, the Chair noted that subparagraph (i) of Article 10(1)(a) contained some new words and therefore invited the Delegation of the European Union to further clarify the meaning of the expression “in respect of products not covered by the registration”.

132. The Delegation of the European Union indicated that the idea behind the proposed wording was to grant protection in respect of products, other than those which were already protected under the appellation of origin in question, but which came from the same geographical area or were similar. For example, in the case of an appellation of origin for a specific cheese, a product such as milk would be considered a comparable product. In other words, the objective was to set aside the products which were already protected by the appellation of origin and to grant effective protection with regard to those products that were similar to those covered by the appellation of origin.

133. The Chair asked the Delegation of the European Union what would be the solution for a cheese that would come from an area outside the geographical area of the appellation of origin. In other words, which provision would apply in respect of an identical product that would not originate from the geographical area of the appellation of origin.

134. Since the intention was to grant protection both to identical and comparable products, the Delegation of the European Union agreed that more explicit wording would be necessary and suggested that the provision read “any direct or indirect use of the appellation of origin in respect of identical or comparable products not covered by the registration...”

135. The Delegation of Italy said that it fully supported the proposal made by the Delegation of Switzerland, to which it had also contributed. In particular, the Delegation was of the view that the first part of the Swiss proposal was much clearer than the language which appeared in the DNI, and in that respect recalled that the objective of the overall exercise was to simplify the new Lisbon instrument.

136. In response to a question raised by the Representative of CEIPI concerning Article 10(1)(a)(iii), the Delegation of Switzerland said that owing to the evolution of the international protection for appellations of origin and geographical indications, it seemed appropriate to spell out the scope of protection, especially when referring to comparable, similar, or even totally different products.

137. In an attempt to summarize the discussions, the Chair indicated that the first issue was to determine whether provisions on the content of protection should specify or not whether they were dealing with identical or comparable products, or whether the text should simply refer to products in general. He then referred to the issue as to whether an additional grant of protection against products originating from the geographical area of origin which did not comply with other requirements, would in turn mean that all Contracting Parties would be under the obligation to establish a list of product specifications. In any event, the Chair agreed that there was an interest in granting such protection and wondered whether an attempt could be made to somehow combine the elements of the non-paper from the Delegation of the European Union with those of the non-paper submitted by the Delegation of Switzerland.

138. In light of the divergent comments on Article 10(1)(b) of the DNI, the Chair wondered whether an optional provision that would allow Contracting Parties to refuse or invalidate the registration of a trademark with respect to products originating in the geographical area of origin but not complying with other requirements, could be envisaged in that regard. He then suggested putting Articles 10(2) and 10(4) of the DNI between brackets in view of the comments made, while also taking note of the suggestion to delete Article 10(5), subject to the changes proposed with respect to Article 11. Referring to Article 10(1)(a), the Chair was of the view that the “*chapeau*” contained therein could remain, given that all the non-papers had been drafted on that basis.

139. Referring to the “*chapeau*” of Article 10(1)(a), the Delegation of Hungary sought clarification as to whether that provision only referred to commercial acts, given that a reference to “commercial use” was only made in subparagraph (ii) of Article 10(1)(a) and not in subparagraph (i) of the same provision.

140. Referring to the “*chapeau*” of Article 10(1)(a), the Delegation of Chile sought clarification as regards the meaning of the terms “at least the following acts” and wondered whether the Working Group could be provided with a concrete example to better understand what type of act would be additional to everything that had already been listed in subparagraphs (i) to (iv).

141. The Delegation of Switzerland expressed the view that, if subparagraphs (i) to (iv) were to be kept in Article 10(1)(a), the words “at least” in the “*chapeau*” were not necessary. The Delegation went on to say that its understanding was that member States could always go further in their national legislation, since the provisions of Article 10(1)(a) were only intended to provide for a minimum level of protection in all countries.

142. The Chair drew the participants’ attention to Article 5(1) of the DNI, where the freedom to provide more extensive protection was already provided for. Noting that Article 5(1) set out a general rule which covered the whole instrument, he agreed that the words “at least” could perhaps be removed from the “*chapeau*” in Article 10(1)(a) and therefore suggested that the amended “*chapeau*” read “Subject to the provisions of this Act, each Contracting Party shall, from the date of international registration, extend to a registered appellation of origin, protection against the following acts:..” Referring to subparagraph (i) of Article 10(1)(a), in an attempt to reflect the wording suggested in the non-papers from the Delegation of the European Union and from the Delegation of Switzerland and the various considerations expressed in that regard, the Chair suggested that the provision read. “Any direct or indirect use of the appellation of origin in respect of products identical with, or comparable to, the products designated by the appellation of origin, not originating from the geographical area of origin, or where applicable, not complying

with other requirements for using the appellation of origin". Such text could be followed by two further sub-items drafted along the lines proposed by the Delegation of the European Union, namely "which would amount to usurpation, imitation or [evocation] of the appellation of origin" or "which would be detrimental to or exploit unduly the reputation of the appellation of origin". The Chair said that paragraph (ii) of Article 10(1)(a) of the DNI, which would remain unchanged, would be followed by two more subparagraphs (iii) and (iv) in square brackets drafted along the lines of subparagraphs (iii) and (iv) of the proposal from the Delegation of Switzerland, which were identical to subparagraphs (ii) and (iii) in the non-paper from the Delegation of the European Union. After that, the Chair suggested to include some wording drafted along the lines suggested in the Swiss non-paper which would read "The protection according to subparagraphs (i) to (iii) applies even if the true origin of the product is indicated or if the appellation of origin is used in translated form or accompanied by terms such as [kind, type, make, imitation], [style], [method], [like] or the like". He then suggested to keep paragraph (b) of Article 10(1) in the form put forward in the working document submitted by the Secretariat, but to supplement it with another sentence that would read "Without prejudice to Article 13(1), Contracting Parties may refuse or invalidate the registration of a trademark which contains or consists of a registered appellation of origin with respect to products that, while originating from the geographical area of origin, do not comply with other requirements for using the appellation of origin". Such provision would be followed by paragraph (2) of the original working document, while paragraph (3) would be deleted as requested by a number of delegations. In addition, paragraph (4) would be put into square brackets and paragraph (5) would be deleted. In respect of Article 11, the Chair suggested to use the title contained in the Swiss non-paper, which read "Shield Against Becoming a Generic Term or Name", and also to keep the wording of Option A, namely "A denomination protected as a registered appellation of origin in a Contracting Party, cannot [be deemed to have] become generic". In that case Option B would be deleted and the text of the former Option A would no longer appear in square brackets. The Chair concluded by saying that a revised version of Article 10 reflecting all his proposals would be distributed to the members of the Working Group for the sake of clarity.

143. The Representative of CEIPI suggested that his proposal to use "goods" instead of "products" throughout the text of the DNI should remain open. As regards Article 11, he suggested replacing the word "deemed" by "considered".

144. Referring to the second hyphen under Article 10(1)(a)(i) of its non-paper, the Delegation of the European Union clarified that the sentence which read "even if the true origin of the product, is indicated [...] or the like", had to become a separate paragraph to cover the situations referred to in both hyphens in its proposed version for Article 10(1)(a)(i).

145. As regards the concern expressed by the Delegation of Hungary with respect to the nature of the acts referred to in the "*chapeau*" of Article 10(1)(a) of the DNI, the Chair said that his understanding was that the text was indeed referring to commercial uses; however, for the sake of clarity, he suggested using the terms "any other commercial use" in subparagraph (ii).

146. The Delegation of Italy noted that in the latest proposal made by the Chair in respect of Article 10, the reference to any commercial use of the appellation of origin in relation to a non-comparable product could no longer be found. In that regard, the Delegation would prefer that subparagraph (ii) of Article 10(1) of the Swiss proposal be kept in the revised version of Article 10 to be submitted by the Secretariat.

147. Referring to Article 10(1)(a)(i) of the non-paper of the Delegation of the European Union, the Delegation of Chile first sought further clarification regarding the meaning of the notion of "indirect use", and also asked what was the criterion used in the European Union to determine whether a product was comparable to another. Referring back to the example given by the

Delegation of the European Union in that respect, the Delegation was not convinced that milk would be comparable to cheese and, therefore, suggested that the rather subjective notion of “comparable” product be left out of the text.

148. The Delegation of Iran (Islamic Republic of) also supported the proposal made by the Delegation of Switzerland as regards Article 10(1)(a)(ii). Referring back to the comment made by the Chair as regards the nature of the acts referred to in the “*chapeau*” of Article 10(1)(a) of the DNI, the Delegation was not convinced that the text should only refer to commercial uses. In that regard, the Delegation was of the view that it was important to also prohibit the non-commercial use of a product that could be detrimental to the reputation of the original product protected by an appellation of origin.

149. Referring to Article 10(1)(a)(ii) of the non-paper submitted by the Delegation of Switzerland, which seemed to apply only to non-comparable products, the Chair sought a confirmation from the Delegation of Switzerland in that regard. In other words, he asked whether that provision actually meant that it would not be applicable to comparable or identical products, or whether the Delegation of Switzerland was of the view that the case of comparable products was already dealt with under subparagraph (i) of Article 10(1)(a).

150. For clarification purposes, the Delegation of Switzerland said that an explicit reference to “commercial use” could also be made in subparagraph (i) of Article 10(1)(a) of the proposal contained in its non-paper, so as to clarify that the text sought to avoid misuse in a commercial context. Referring to subparagraph (i), the Delegation agreed that perhaps the use of the term “comparable” was not the most appropriate, but that the objective was to give protection against any use in respect of the same product and, for example, to protect a cheese protected by an appellation of origin against the use of such appellation of origin on another cheese. Subparagraph (ii) was intended to provide protection against uses on other types of products, namely other non-comparable products.

151. With respect to the non-paper submitted by the Delegation of Switzerland, the Delegation of Peru expressed a few reservations regarding the use of the terms “direct or indirect use”, as well as the use of the term “evocation”, as indicated previously. With regard to the notions of comparable and non-comparable products, the Delegation preferred that different terms be used in Spanish, namely “*identico*” and “*relacionado*”. Lastly, the Delegation reiterated its request to replace the term “*notoriedad*” by “*reputación*” in the Spanish version of the DNI to avoid any confusion with trademark law.

152. In relation to the discussion on the use of the words comparable or non-comparable, the Secretariat referred to subparagraph (ii) of Article 10(1)(a), which specified that protection would be granted against use which “would be likely to be detrimental to or to exploit unduly the reputation of the appellation of origin”, and wondered whether the use of the term “non comparable” would be needed at all and, instead, suggested deleting it so that the provisions of subparagraph (ii) would also apply to comparable products.

153. The Chair expressed the view that the objective of subparagraph (ii) of Article 10(1)(a) was to provide protection to non-comparable products, and added that in such case there would be a need to show that “such use would be likely to be detrimental to or to exploit unduly the reputation”. He went on to say that, on the contrary, in the case of comparable products, protection would be ensured even in the absence of proof of damage to the reputation.

154. The Delegation of Iran (Islamic Republic of) reiterated its concern that protection should be conferred both against commercial and non-commercial uses. By way of illustration, the Delegation gave the example of a charity event that would be giving away for free a product that would be detrimental to a product protected by an appellation of origin registered under the Lisbon Agreement.

155. The Delegation of Chile said that it still did not fully grasp what the criterion for comparability would be in the case of “comparable” products, and added that such lack of clarity made it difficult to fully understand the extent of the scope of protection granted to the geographical indication or to the appellation of origin.

156. When resuming the discussion the following day (Wednesday, December 5, 2012), the Chair indicated that a possible compromise text for Articles 10 and 11 had been distributed to the members of the Working Group, in the form of a non-paper from the Chair (see Annex III).

157. Referring to Article 10(1)(a)(i) of the non-paper prepared by the Chair, the Representative of CEIPI wondered whether the terms “where applicable” could not be deleted so that the text would read “not originating in the geographical area of origin or not complying with any other applicable requirements”. In his view, the expression “where applicable” was too broad and should be more specific. He further suggested that a similar amendment be made in item (ii) of Article 10(1)(b). As regards the footnote to Article 10(3), he was of the view that the expression “may not” in the first line was rather ambiguous, as it could equally mean “has the right not to do something” or “has no right to do something”, which were quite different notions. For the sake of clarity, he suggested that the text read “It is understood that a Contracting Party has the right not to accord protection”.

158. As a general comment, the Delegation of Peru observed that the new text implied a grant of protection prior to the submission of detailed information regarding the concerned products that would help determine, for example, whether they came from the geographical area of origin and whether or not they complied with the requirements of the appellation of origin. In that regard, the Delegation sought clarification as to whether in such cases the national offices would be expected to act “*ex officio*” or only upon request from the parties, as it would be very difficult for the national offices to determine whether a product complied with the requirements of the appellation of origin or not.

159. The Chair pointed out that the new version of Article 14 that had been agreed upon would make it clear that any interested party would always have the possibility to take legal action against any unlawful use of the appellation of origin. He went on to say that subparagraph (1)(a) of Article 10 referred to actions that could be taken against any unlawful use of the appellation of origin and clarified in that regard that, unless the national legislation provided for the involvement of the Competent Authority itself, it would be up to any interested party, either the beneficiary of protection or any other entity having the right to assert the rights following from the protection of the appellation of origin, to take action against any use covered by Article 10(1)(a).

160. The Delegation of Switzerland noted that the new text proposed by the Chair, which no longer made a distinction between “like products” and “other products” in subparagraphs (i) and (ii) of Article 10(1)(a), created some confusion. The Delegation therefore suggested that the distinction between subparagraphs (i) and (ii) be reintroduced in the text. In that regard, the Delegation was of the view that an alternative terminology could be used and that it could be based on the one contained in Article 10(2) which referred to “goods of the same kind”. In that connection, the Delegation suggested using for instance the terms “same kind of goods” in subparagraph (i) and “goods of a different kind” in subparagraph (ii). The Delegation further indicated that another possibility would be to refer to “the product to which the appellation of origin applies” as was the case in Rule 5(2)(a)(iv) of the draft regulations under the DNI, as that type of terminology would allow to better define the scope of protection in respect of those categories of products. As previously indicated, the Delegation was of the view that there was a need to go beyond a mere reference to the origin of the product and to include, instead, a general reference to the requirements for the use of the appellation of origin. The Delegation pointed out that its proposal had also sought to take into account the needs of those countries which protected geographical indications through the trademark system, and therefore

wondered whether it would be appropriate to still refer to usurpation and imitation in the new instrument. In respect of those countries which protected their appellations of origin or geographical indications under the trademark system, the Delegation was of the view that it would be preferable to use more objective criteria, so as to define the protection in a way that would better correspond to the level of protection or to the protection criteria in those countries which used specific protection systems for appellations of origin or geographical indications. In that regard, the Delegation suggested putting the terms usurpation, imitation and evocation between square brackets, as suggested in its non-paper.

161. Referring to Article 10(1)(b) of the non-paper submitted by the Chair, the Representative of INTA reiterated her position that other requirements such as general regulatory matters were generally not a matter for trademark registration proceedings but rather a matter for regulating use. In that regard, she said that, even if the provisions of subparagraph (ii) of Article 10(1)(b) were merely optional, they could still lead to practical problems and confusion and therefore suggested deleting subparagraph (ii), without prejudice to the fact that it would always be possible to refuse or invalidate misleading trademarks. As regards subparagraph (i) of Article 10(1)(b), she suggested including some language that would clearly indicate to which kind of product the provision actually applied. In this regard, she suggested including language such as “with respect to goods of the same kind as those protected by the registered appellation of origin but not originating in the geographical area of origin”, as she was of the view that the current wording seemed to erroneously imply that the provision would also apply to entirely different kinds of goods. The Representative suggested that the priority principle be expressly included in Article 10(1)(b), so as to make it clear that the provision would not apply to trademarks with an earlier priority than the registration of the international appellation of origin. In respect of Article 10(2), she suggested adding some language to make it entirely clear to what kind of product the presumption applied and, in that regard, proposed that the terms “but not originating from the geographical area of origin” be added at the end of the sentence, as she was of the view that otherwise the provision might also apply to a situation where the product did originate in the geographical area of origin.

162. The Delegation of France first noted the positive aspects of the new text submitted by the Chair, as it clarified a number of things with regard to the definition of “commercial use”, as well as the uncertainty with regard to the use of the terms “direct” or “indirect”, while also removing the reference to “comparable” products. The Delegation recalled that there should be general protection not just in relation to similar or like products but also in relation to any unlawful use or any use that may damage the reputation of the appellation of origin. As regards subparagraph (ii) of Article 10(1)(a), the Delegation reiterated its concern regarding the scope of that broad provision which introduced more doubt and could potentially discourage new members from acceding to the new instrument. In that regard, the Delegation pointed out that the terms “usurpation” and “imitation” had been used for a long time and that one had to be very careful before replacing those terms by a reference to the notion of “counterfeit”. The Delegation further pointed out that under trademark law, the term “counterfeit” had a very restrictive meaning and was perhaps not applicable in the case of appellations of origin. As regards Article 10(2) which dealt with the presumption of unlawful use in case of use by third parties, the Delegation pointed out that Article 16 of the TRIPS Agreement conferred protection against any risk of confusion and established a presumption of a risk of confusion in the case of any unauthorized use of the trademark in respect of identical products. The Delegation noted, however, that the provision under consideration established another presumption of unlawful use and had to verify with the French Ministry of Justice whether such presumption would be contrary to the French “presumption of innocence until proving guilty”, before taking a position on that matter.

163. With respect to Article 14 of the DNI, the Delegation of Peru said that its understanding was that, subject to the applicable domestic law, the legal proceedings could be initiated either by the interested parties or by public authorities. However, the Delegation wondered what

would happen for those countries in which both entities, public or private, could initiate such proceedings, and more specifically wondered whether the public authorities would be under the obligation to initiate legal proceedings “*ex officio*” in that case, which would in turn imply that the public authority would have the capability to conduct a full investigation to determine whether the requirements to use an appellation of origin are met. The Delegation expressed great concern in that regard and therefore suggested that the obligation to initiate legal proceedings against those goods not originating in the geographical area of origin or not complying with other requirements for using the appellation of origin, be placed in square brackets.

164. The Delegation of Romania indicated that the terms “usurpation”, “imitation” or “evocation” were not equivalent, while also adding that it was of the view that the term “usurpation” did incorporate the notion of “imitation”, contrary to the term “evocation”, and therefore suggested using the word “usurpation” only.

165. The Delegation of Italy said that it would be ready to consider the reintroduction of a distinction between products of the same kind and products of a different kind in Article 10(1). Referring to the suggestion to remove the terms “usurpation”, “imitation” or “evocation”, the Delegation said that one had to be extremely careful in that respect, since those terms were used in the current Lisbon Agreement.

166. The Delegation of the United States of America noted that Article 10(1)(b) did not entirely reproduce the language of Article 22 of the TRIPS Agreement and, more specifically, did not capture the fundamental concept of “misleading the public”. The Delegation therefore suggested that the provisions of Article 22 of the TRIPS Agreement be more accurately captured in the new instrument.

167. The Secretariat referred to the suggestion made by the Delegation of Peru to use the word “*reputación*” instead of “*notoriedad*” in the Spanish version of the DNI, in spite of the fact that Article 2(2) of the current Spanish version of the Lisbon Agreement also referred to “*notoriedad*”. In that regard, the Secretariat recalled that the only authentic text of the Lisbon Agreement was the French text which used the word “*notoriété*” instead of “reputation” and further indicated that such term had been translated into Spanish as “*notoriedad*” and into English as “reputation”. In other words, since the two notions appeared in the current Lisbon Agreement, the Secretariat had decided to follow the English, French and Spanish versions of the Agreement for purposes of drafting the different linguistic versions of the DNI. The Secretariat concluded by saying that the Delegation of Peru’s suggestion to use the word “*reputación*” instead of “*notoriedad*” in the Spanish version of the DNI could certainly be accommodated, subject to the agreement of the other Spanish-speaking countries.

168. Referring to Article 10(3) of the text proposed by the Chair, the Delegation of Peru renewed its request to either delete that provision on homonymy altogether, or to leave it between square brackets. As regards the comment made by the Secretariat that the deletion of such provision would not prevent the registration of two homonymous appellations of origin or geographical indications, the Delegation in turn asked what would be the necessity of keeping Article 10(3) if such possibility already existed in practice.

169. As regards Article 10(1)(a) of the text submitted by the Chair, for the sake of simplification, the Delegation of Italy suggested deleting the terms “the following acts” at the end of the sentence so that the text would stop after the term “against”. With respect to Article 10(1)(a)(ii), the Delegation suggested a slight amendment so that the provision would read “any other practice liable to mislead the consumer as to the true origin, the nature, the quality, the provenance or the essential qualities of the goods”. Noting that the concepts of imitation, usurpation or evocation, did not appear in subparagraph (i) of Article 10(1)(b), the

Delegation requested that those concepts be introduced in that provision. In that regard, the Delegation suggested that the sentence “shall refuse or invalidate the registration of a trademark” be followed by the terms ‘which corresponds to one of the situations covered by Article 10(1)(a)(i)’.

170. The Chair noted that a very similar provision could be found in the Community Trademark Regulation, namely “trademarks which contain or consist of a designation of origin when they correspond to one of the situations covered by Article 13 of the EC regulation on foodstuffs”. The Chair pointed out that a priority principle was also set out in that provision.

171. The Delegation of Italy clarified that the idea was to reflect in paragraph (b) of Article 10(1) that a refusal or an invalidation should apply not only with respect to those goods not originating in the geographical area of origin but also in all the cases set out in subparagraph (i) of Article 10(1)(a), namely in cases of usurpation, imitation or evocation of a geographical indication, or whenever the use would be detrimental to, or exploit unduly, the reputation of the geographical indication.

172. The Delegation of Romania supported the Delegation of Peru’s request to use “*reputación*” instead of “*notoriedad*” in the Spanish version of the DNI, while also requesting that the term “*réputation*” be used in the French version instead of “*notoriété*”, as both terms were not equivalent from its point of view.

173. The Delegation of Switzerland pointed out that, even though the notions of “usurpation, imitation and evocation” might be reflected in some national legislations, they might still be alien to other legislations or other systems of protection. Hence, the Delegation’s suggestion to replace those notions by a criterion that would be objective and that would help avoid having to prove “usurpation, imitation or evocation”. In light of the comments heard thus far, the Delegation said that an alternative solution might be to keep the distinction between goods of the same kind and goods of a different kind, and to keep the concepts of “usurpation, imitation and evocation” for products of the same kind that would not meet the basic requirements of the appellation of origin. The Delegation further indicated that, since the reference to the geographical origin was included in the relevant product requirements, it did not see the need to differentiate the geographical origin from the other requirements and therefore the sole reference to “appellation of origin” would already cover all the applicable requirements. The Delegation therefore suggested that the provision of Article 10(1)(a)(i) read “Any use or any usurpation, imitation or evocation of the appellation of origin in relation to the same kind of goods, which do not meet the requirements applicable to the appellation of origin”. As regards the degree of protection that would apply to products of a different nature, the Delegation suggested that the provision read “Any use, usurpation or imitation of the appellation of origin in relation to other kinds of goods where such use would be likely to be detrimental to the reputation of the appellation of origin or mislead the consumer as to the true origin of the product”.

174. The Representative of CEIPI said that it would be preferable to see the new proposals made by the Delegation of Switzerland in writing to better understand all their implications. As regards the use of the words “*réputation*” or “*notoriété*” in the French and Spanish versions, he pointed out that the French version of the TRIPS Agreement referred to “reputation”, and expressed the view that it would be preferable to replace “*notoriété*” by “*réputation*” in the DNI to be more in line with all the requirements concerning the appellation of origin, be they geographical or other. As regards the comment made by the Delegation of Romania that the concept of “imitation” might be covered by the concept of “usurpation”, he expressed the view that it would be dangerous to remove “imitation” from the DNI, as it also appeared in the current Lisbon Agreement. As regards the concept of “evocation”, he asked those delegations who wished to introduce that concept in the DNI to provide a concrete example of a case of evocation to better understand what the term “evocation” actually covered.

175. The Representative of ABPI agreed that the word “imitation” had to be kept in the DNI. As regards subparagraph (i) of Article 10(1)(a), for the sake of conciliation, he suggested that the text be slightly amended so as to read “its reputation or its notoriety”, instead of “its reputation”.

176. The Representative of INTA observed that the proposal made by the Delegation of Switzerland appeared to put “use” as an alternative to “usurpation, imitation, or evocation”; however, her understanding was that it was the use itself which had to amount to a usurpation, imitation or evocation, and therefore suggested that the sentence for example read “any use amounting to a usurpation, imitation or evocation”. She also expressed her concerns as regards the introduction of the concept of ‘evocation’ as it was difficult to understand what the concept covered.

177. With respect to the term “evocation”, the Delegation of Italy reiterated its strong interest in keeping that term in Article 10 of the DNI, as it greatly differed from the concepts of “imitation” or “usurpation”. The concept of “evocation” designated the use of a term that recalled or evoked the name of an appellation of origin even if it had been substantially changed, thereby potentially damaging its reputation.

178. Referring to the question raised by the Delegation of Peru as to whether it would be necessary to have a provision on homonymy in the DNI, the Secretariat clarified that the main reason was that there were quite a few countries in the world which allowed for coexistence of homonymous appellations of origin and homonymous geographical indications. Moreover, the Secretariat was of the view that it seemed useful to have a provision regulating how countries could deal with two or more homonymous appellations of origin or geographical indications registered under the DNI. With that objective in mind, the Secretariat further indicated that it had looked into the TRIPS Agreement which contained two provisions dealing with that matter, and pointed out that one of the provisions dealt very specifically with the matter but was limited to wines, while the other dealt more broadly with the issue of two geographical denominations or indications which happened to be the same. The Secretariat further specified that the second provision it had referred to was Article 22.4 of the TRIPS Agreement which was reflected in the footnote to Article 10(3) of the non-paper. The Secretariat pointed out that it was a text which would allow countries to refuse to protect one of the two homonymous appellations of origin if that appellation would “falsely represent to the public that the goods originate in other territory”. In any event, as previously indicated, under the Lisbon system, the International Bureau did not have the authority to refuse appellations of origin applied for under the Lisbon Agreement on substantive grounds. Consequently, if a country submitted an application relating to a homonymous appellation of origin similar to a previously registered appellation of origin, the International Bureau would not have the authority to refuse the later appellation and would have to register it if the formal requirements were met. The appellation in question would be subsequently sent to the other countries of the Union who would then have the right either to refuse it, or to allow for coexistence, subject to what was prescribed under their national law. The Secretariat recalled that in light of the concerns expressed by the Delegation of Peru in that regard, paragraph (3) of Article 10 had been put in square brackets in the text submitted by the Chair.

179. When the Working Group reverted to Articles 10 and 11 of the DNI on the morning of Thursday, December 6, 2012, on the basis of a new version of the Chair’s non paper concerning Articles 10 and 11, which had been distributed on the afternoon of December 5, 2012, the Chair suggested that this text be taken as the basis for future work.

180. The Delegation of Switzerland expressed its satisfaction as regards the new version of the non-paper submitted by the Chair, while also requesting that the expression “would amount to usurpation, imitation or evocation” in subparagraph (i) of Article 10(1)(a) be put between square brackets as it was of the view that further discussions would have to take place regarding the use of those terms.

181. The Delegation of the European Union agreed to use the proposed provision as a basis for future work but added that Article 10 would have to make it clear that prior trademark rights which had been acquired before the registration of an appellation of origin would be safeguarded, and would not be cancelled because of the later registration of the appellation of origin.

DISCUSSION OF CHAPTER I: INTRODUCTORY AND GENERAL PROVISIONS

182. Referring to Article 1(vi) of the French version of the DNI, the Representative of CEIPI said that the reference to the TRIPS Agreement should be slightly amended so as to replace the last word “*révisé*” by the word “*amendé*” because the TRIPS Agreement had been amended and not revised in 2005. As regards Article 4, he noted that the English word “status” had been translated as “*situation juridique*”, which sounded rather odd; a different translation should be proposed. As regards Article 5(3), he said that even though it was true that for a long period of time industrial property agreements and treaties that were concluded under WIPO’s aegis had only been made accessible to member States of the Paris Union, he also pointed out that the practice had changed in recent years to open up those treaties to all the WIPO Member States. However, he was of the view that Article 5(3) should remain in the DNI so as to ensure that those members who were not members of the Paris Convention did apply the provisions of the Paris Convention. In that regard he said that in his view Article 5(3) had to remain in Chapter I of the DNI even if it would ultimately be decided to move Article 5(2) to Chapter III. The Representative of CEIPI said that he had very serious doubts with regard to Option B of Article 5(3) as it was erroneous in some respects and also dangerous. In that regard, he pointed out that the reference to Article 4 on the right of priority was not correct as such priority right did not apply to geographical indications or appellations of origin. Moreover, he pointed out that the pertinence of some of the provisions under Article 6 and the following articles was sometimes rather questionable as in the case of service marks. He expressed the view that Article 5*bis* should also apply to Contracting Parties protecting appellations of origin through certification trademarks and therefore suggested referring to that article in the provision under consideration. Finally, he concluded by saying that it would be better to follow the precedent of existing treaties and to adopt Option A.

183. Referring to the use of the phrase “protection established under this Act” in paragraphs (1) and (2) of Article 5, the Delegation of Hungary wondered whether that expression was appropriate, given that the protection had to be provided by the Contracting Parties themselves. The Delegation then sought clarification as to why Article 5(2) was not in line with the current Article 4 of the Lisbon Agreement as it contained no reference to national legislation or court decisions.

184. The Delegation of Algeria first noted that Article 2(2) dealing with trans-border appellations of origin was linked to Article 6(5) of the DNI, and also expressed the view that Article 2(2) would be a relatively problematic provision for countries that had not come to an agreement as regards the delimitation of a given trans-border region. In that regard, the Delegation pointed out that even if there were many similarities between countries in the North-African region, between countries of the Maghreb, there were also many differences. The Delegation therefore sought further clarification as to what was the reason for having provisions such as Article 2(2) and Article 6(5) in the DNI, and what would be the consequences for those countries which did not have, or which did not foresee of having, any provision in their internal legislation concerning trans-border areas.

185. In response to the comments made by the Delegation of Algeria, the Chair pointed out that following the clarification of a certain number of points the members of the Working Group had agreed to adapt the text of Article 2(2). The Chair first noted that according to subparagraph (i) of Article 6(5)(a) of the DNI, the Contracting Parties would be free to act

independently so that each Contracting Party, in whose territory the trans-border area would be situated, would be free to file an application on its own for the part of the trans-border area situated in its territory. He went on to say that, on the contrary, if the Contracting Parties concerned wished to file a single joint application, they would be free to do that under subparagraph (ii) of Article 6(5)(a), and pointed out that only in that case would they be required to present the application jointly, to act through a commonly designated Competent Authority, and to delimit the territory jointly. The Chair went on to say that for purposes of reflecting such understanding in the DNI, the members of the Working Group had agreed to delete the words “delimited jointly by” and “Protected” from Article 2 so that the amended text would read “Appellations of origin may serve to designate products originating in a trans-border geographical area of adjacent Contracting Parties in whose territories such geographical area of origin is situated”. He added that Article 5(6) would still apply but that it would be made clear in the Regulations to the DNI that, should the Contracting Parties sharing a trans-border area wish to apply jointly, they would also have to delimit the geographical area jointly and act through a commonly designated Competent Authority.

186. The Delegation of Algeria said that it still had difficulties in fully grasping the concept of trans-border area and, for example, sought further clarification as to who would have the authority to decide whether a particular geographical area would qualify as a trans-border area or not. In other words its concern was not so much the application procedure for products from a trans-border area, but the concept of trans-border area itself.

187. The Chair indicated that a trans-border area was an area situated in the territory of more than one Contracting Party or, in other words, an area which extended beyond the borders of one Contracting Party. He added that there was no obligation to commonly agree on the limits of a trans-border area since each Contracting Party could act on its own and file an application with respect to that part of the trans-border geographical area that fell within its territory. He pointed out that such application would be processed and registered just like any other appellation of origin by the International Bureau. The Chair pointed out, however, that the DNI was only aiming at giving the Contracting Parties concerned the possibility, as a procedural option, to register the appellation of origin jointly.

188. As regards the amended version of Article 2(2) that had been referred to by the Chair, the Delegation of Algeria requested that such provision, as well as the related provision under Article 6(5), be left between square brackets in the revised DNI.

189. The Delegation of Iran (Islamic Republic of) wondered whether the Delegation of Algeria would agree to confine the use of brackets only to Article 2(2), but not to Article 6(5)(a)(ii) which was an entirely optional provision which did not oblige the Contracting Parties to act jointly.

190. The Delegation of Italy sought clarification as to whether it had already been decided to work on the basis of a single instrument or on the basis of two instruments, namely a treaty and a protocol, or whether that question was still open.

191. The Chair recalled that the Working Group had agreed that the aim would be to have a single draft instrument covering both appellations of origin and geographical indications. He nonetheless pointed out that one still had to agree on how the international register would be structured under such a single DNI, with respect to geographical indications and appellations of origin registered under the DNI and with respect to those appellations of origin already registered under the current Lisbon Agreement.

192. The Delegation of Algeria confirmed that it wished to keep square brackets around Articles 2(2) and 6(5)(a)(ii), to be able to come back to the issue of trans-border appellations of origin at the next session.

193. The Delegation of Romania supported the views expressed by the Delegation of Algeria and said that it also wished to revert to the issue of trans-border appellations of origin at the next session.

194. As regards Article 5(3), the Delegation of Iran (Islamic Republic of) expressed the view that a mere reference to the relevant provisions of the Paris Convention was not sufficient, all the more since all the Contracting Parties would not necessarily be members of the Paris Convention, and therefore suggested that the relevant provisions be reproduced in full in Article 5(3) to perfectly understand what the obligations of the Contracting Parties would be under the DNI.

195. As previously mentioned by the Representative of CEIPI, the Chair pointed out that in order to allow for the accession of WIPO Member States who were not yet parties to the Paris Convention, provisions such as the one in Article 5(3) had become the standard drafting practice in previously adopted WIPO legal instruments. In light of the fact that the Paris Convention constituted such a fundamental basis for industrial property matters at the global level, the Chair suggested either to keep Article 5(3) as currently drafted, or to prevent those WIPO Member States that were not yet parties to the Paris Convention from acceding to the DNI.

196. Referring to Chapter I of the DNI, the Delegation of Peru said that it maintained its reservations concerning Article 1(xiii) and Article 1(xvi), because Peruvian legislation, which in turn was based on the Andean Community legislation, did not give any indication as to whether international organizations could be considered as holders of the right to use appellations of origin, and therefore requested that those provisions be kept between square brackets.

197. The Chair recalled that since the very beginning the mandate of the Working Group included a revision of the Lisbon Agreement that would provide for the possibility of accession by competent intergovernmental organizations. He therefore had some difficulties with the comments made by the Delegation of Peru as they concerned the mandate given to the Working Group by the Assembly of the Lisbon Union. In that regard, the Chair suggested taking note in the Report that the Peruvian legislation did not currently envisage the possibility of providing protection for appellations of origin registered in the name of an intergovernmental organization, instead of putting the relevant provisions in square brackets.

DISCUSSION OF CHAPTER II: APPLICATION AND INTERNATIONAL REGISTRATION

198. The Delegation of Hungary sought clarification in respect of Article 7(3)(iv) which read “the description of the product to which the appellation of origin applies”. More specifically, the Delegation wondered why the terms “description of the product” were used in the provision in question even though Rule 8(1)(iv) of the current text of the Regulations under the Lisbon Agreement did not incorporate any reference to a product description.

199. The Representative of INTA suggested that the wording in the second line of Article 6(3)(ii) be slightly amended so as to read “a legal entity which has legal standing to assert the rights of such beneficiaries referred to in subparagraph (i), or other rights in the appellation of origin, [...]”. He clarified that the reason for the suggested amendment was that in most legislations that provided for certification marks in respect of geographical indications, the holder of the certification mark did not have the right to use the certification mark himself and could not be considered as representing the holders of the right to use, or “beneficiaries”, either. In other words, the provision would be incomplete if it did not also cover “other rights” such as the right of ownership in the certification mark. He also noted that the term “beneficiaries” appeared for the first time in Article 6(3)(ii) and wondered whether the introduction of that new term in the provision in question would be appropriate as it had not been addressed or defined

before. In that regard, he said that a possibility would be for example to say “a legal entity which has legal standing to assert the rights of the persons referred to in subparagraph (i), hereinafter referred to as beneficiaries [...]”, or something along those lines. As regards Article 7, he also considered it excessive to include the description of the product or the goods as one of the filing date requirements.

200. As regards Article 8(3) which provided that “Reduced fees may be established by the Assembly in respect of international registrations of appellations of origin from developing countries”, the Representative of CEIPI said that, even though he fully supported the idea behind the proposal, he was of the view that the insertion of Article 8(3) in the DNI would be superfluous and even dangerous. He further specified that it would be superfluous in his view because the Assembly already had the right to amend the Regulations in any event, and by way of consequence the fees as they were part of the Regulations. Besides, he also referred to some precedents in other WIPO treaties where, without any reference in the Treaty itself, the competent Assembly had decided to grant reduced fees, or had decided that the fees would be reduced for applicants from developing countries or other categories of applicants. In that regard he referred more particularly to the PCT, the Madrid Agreement, the Madrid Protocol and the Hague Agreement. He also considered that the insertion of Article 8(3) in the DNI would be potentially dangerous because it could be interpreted as a limitation of the competence of the Assembly. In that regard he noted that Article 8(3) only referred to “developing countries” without mentioning “least developed countries” as a separate category, for example, and also wondered what would happen if the Assembly decided to grant fee reductions to other categories of Contracting Parties, or to special categories of applicants. In that respect, he pointed out that one could argue that Article 8(3) would not allow the Assembly to do so because the provision only referred to “developing countries”.

201. Referring to subparagraph (ii) of Article 6(3), the Delegation of France sought further clarification as regards the phrase “assert the rights of such beneficiaries”, and in particular wondered whether that meant, for example, assert the rights to use the appellation of origin, and also wondered whether the term “beneficiaries” was linked to subparagraph (i) of Article 6(3). The Delegation also suggested that Article 7(3)(ii) be somehow linked to subparagraph (ii) of Article 6(3) and said that it shared the concerns expressed by other participants as regards the use of “description of the product” in subparagraph (iv) of Article 7(3).

202. The Delegation of Peru suggested that Article 6(3) be slightly amended so as to read “Subject to paragraph (4), the application for the international registration of an appellation of origin shall be filed by the Competent Authority on its own behalf, or in the name of...” to take due account of the fact that under certain legislations, the Competent Authority could, on its own behalf, submit an application for the international registration of an appellation of origin.

203. Noting that the Competent Authority would qualify as a “legal entity” under subparagraph (ii) of Article 6(3), the Chair wondered whether it would be really necessary to spell out specifically that the Competent Authority could act on its own behalf, as requested by the Delegation of Peru.

204. The Delegation of Peru agreed with the comment made by the Chair that the Competent Authority would qualify as a legal entity, but it was the understanding of the Delegation that the “legal entity” mentioned in subparagraph (ii) of Article 6(3) referred to a different legal entity, namely a regulatory council or an association of producers. The Delegation therefore sought further clarification from the Secretariat in that regard.

205. Referring to Article 6(3), the Delegation of Italy did not understand where the confusion between Competent Authority and legal entity came from, given that the notion of legal entity was sufficiently defined in the footnote. In any event, for the sake of greater clarity, the Delegation suggested to replace the terms “shall be filed by the Competent Authority” by “shall

be filed through the Competent Authority”, and to delete the terms “in the name of” in Article 6(3). The Delegation also suggested that the word “beneficiaries” be replaced by “users” in subparagraph (ii) of Article 6(3). Lastly, the Delegation expressed its disagreement as regards the contents of Article 6(4) as it was of the view that the application should be filed only through the Competent Authority and not directly to the International Bureau.

206. The Chair pointed out that Article 6(4) which started with the phrase “If the legislation of the Contracting Party of Origin so permits” was purely optional. Moreover, as regards the amendment suggested by the Delegation of Italy, he was of the view that there was a difference between an application filed by the Competent Authority, in the name of certain persons, and an application filed by those persons through a Competent Authority. He added that in his view the difference was that in the second case the Competent Authority would have no discretionary power to decide whether or not it would forward the application to the International Bureau, whereas the first case left full discretion to the Competent Authorities of the Contracting Parties to decide whether or not to file an application for international registration in respect of a particular appellation of origin. The Chair therefore said that he preferred to stick to the current language of Article 6(3) which better conveyed the intended meaning of the provision in question.

207. The Delegation of Georgia noted that the footnote in subparagraph (ii) of Article 6(3) did not refer to state bodies, public authorities, or Government agencies, among the list of entities that would qualify as legal entities. The Delegation added that the incorporation of those public entities in the footnote would be of paramount importance for them because under Georgian legislation a Government agency would also qualify as a legal entity.

208. The Chair noted the concern expressed by the Delegation of Georgia and said that the footnote could certainly be amended so as to include text indicating that a legal entity could also be a State or any other public body, without excluding the Competent Authority itself. In that regard, the Chair suggested that the text be amended so as to read “The term legal entity refers to any association, corporation, [...] trust, or other public authority, not excluding the Competent Authority itself”.

209. Referring to the requirement to provide a description of the products in subparagraph (iv) of Article 7(3), the Secretariat said that the reason was basically that, in addition to the current mandatory requirement to indicate “the product to which the appellation applies” under Rule 5, an optional requirement to provide a more detailed description of the product had recently been introduced in the Regulations under the Lisbon Agreement. The Secretariat indicated however that if the preference of the Working Group was to delete the requirement to provide a description of the product in Article 7 that could certainly be done.

210. The Chair said that he also had some difficulties in understanding why a detailed description of the product, instead of a mere identification of the product, would be necessary to establish a date of filing or a date of international registration. He pointed out that there were two questions; one was whether the provision of a product description should be a mandatory requirement and, if so, the other issue was whether it should also be a requirement for purposes of establishing a date of filing.

211. As regards subparagraph (ii) of Article 6(3), the Secretariat confirmed that the term “beneficiaries” referred to the natural and legal persons referred to in subparagraph (i) of Article 6(3). If the current provision was not clear for some delegations, the Secretariat said that another possibility would be to use the word “beneficiaries” also in subparagraph (i), so that the provision would read “the beneficiaries, namely the natural and legal persons...”, which would in turn allow to keep subparagraph (ii) as currently drafted. Referring to subparagraph (ii) of Article 6(3), the Secretariat took note of the comments made by the Delegation of France with respect to the expression “a legal entity which has legal standing to assert the rights”, as well as

the suggestion made by the Representative of INTA to add a phrase to clarify that it would not only be legal entities that would have legal standing to assert the right to use referred to in subparagraph (i), but also legal entities that would have legal standing to assert other type of rights in the appellation of origin. Referring to the question raised by the Delegation of Peru as to whether an application could be filed by the Competent Authority in its own right, the Secretariat pointed out that Article 5(1) of the Lisbon Agreement read “The registration of appellations of origin shall be effected with the International Bureau, at the request of the Authorities of the countries of the Special Union, in the name of any natural persons or legal entities...” The Secretariat suggested that the text be amended along the lines of the suggestions made by the Delegation of Georgia and the Chair.

212. The Delegation of Iran (Islamic Republic of) suggested that the text of the DNI be cleared up from all the footnotes, as it was not that common to have so many footnotes in international treaties and conventions. The Delegation therefore suggested starting by moving the definition of legal entity in the footnote of subparagraph (ii) of Article 6(3) to the definitions section under Article 1.

213. As regards the comment made by the Representative of CEIPI on Article 8(3), the Secretariat confirmed that in the context of Madrid, the PCT, and Hague, the Assembly had introduced fee reductions for least developed countries only, through an amendment of the Regulations in which the fees were incorporated. However, as suggested at the previous session of the Working Group, the Secretariat had included a provision for reduced fees for developing countries in general.

214. The Delegation of Algeria sought further clarification as regards the suggestion to deal with the reduced fees for developing countries in the Regulations instead of the DNI itself.

215. The Chair indicated that it would be preferable not to address the issue related to reduced fees at the treaty level, as that might lead to “*à contrario*” conclusions or to an unintended limitation of the powers of the Assembly in that regard. The Chair added that it therefore seemed preferable to incorporate in the Regulations the provision dealing with fee reductions for applicants from developing countries, including least developed countries.

216. The Delegation of Algeria expressed a preference for keeping the reference to reduced fees in the body of the Treaty as it was currently the case under Article 8(3) of the DNI.

217. The Delegation of Iran (Islamic Republic of) also expressed its preference for keeping Article 8(3) in the DNI, and to avoid any ambiguity, suggested replacing the term “may” by “shall” so that the provision would not be interpreted as limiting the powers of Assembly.

218. The Delegation of the Russian Federation asked whether the reference to “the description of the product to which the appellation of origin applies” would be deleted from subparagraph (iv) of Article 7(3). However, the Delegation was of the view that those terms were not superfluous in light of the current requirement to indicate “the product to which the appellation of origin applies” under Rule 5(2)(iv) of the Regulations, which implicitly involved some sort of description of the product in question.

219. The Chair clarified that the text of subparagraph (iv) of Article 7(3) would be identical to the text of Rule 5(2)(iv) of the current Lisbon Regulations and would read “the product to which the appellation of origin applies”. He added that the issue as to whether a detailed description of the product, in addition to the name or identification of the product, should also be part of the mandatory contents of the applications or should remain optional, would be discussed at a later stage.

220. The Delegation of Italy requested some clarification in respect of the reference to “a group of producers representing the beneficiaries” in subparagraph (ii) of Article 6(3). The Delegation noted that the text in subparagraph (ii) first referred to “a legal entity which has legal standing to assert the rights”, and then gave several examples of such legal entities. In that regard, the Delegation asked whether “a group of producers” would fall under the same category of legal entity which had legal standing to assert the rights, or whether it would constitute a separate category of filers or applicants.

221. Referring to Article 8(3), the Chair said that the principle of having a fee reduction for developing countries had not been questioned, but that legitimate concerns had been expressed as to the way in which such provision should be expressed. In that regard, to avoid any overly restrictive interpretation of that provision, the Chair suggested a few amendments to Article 8(3). First the subtitle between brackets should indicate “Fee Reductions” instead of “Developing Countries”, the remainder of the text would then read “Reduced fees may be established by the Assembly in respect of international registrations of appellations of origin, in particular those from developing countries”, to make it clear that developing countries would be a priority target group for fee reductions.

222. The Delegation of Italy wondered whether it would not be easier to simply replace “may” by “shall” in the current version of Article 8(3) as suggested by the Delegation of Iran (Islamic Republic of).

223. The Delegation of Peru shared the views expressed by other delegations that the provision of Article 8(3) should remain in the DNI and also supported the suggestion to replace “may” by “shall”.

224. Upon expressing its support for replacing “may” by “shall”, the Delegation of Algeria sought further clarification as regards the suggestion made by the Chair to insert the terms “in particular those from developing countries” in Article 8(3), and asked to which other group of countries the text would be referring in that case.

225. In response to the question raised by the Delegation of Algeria, the Chair said that the text could for example refer to small and medium-sized enterprises, or to agricultural producers living in areas with a low level of economic development. The Chair pointed out that the proposed wording would guarantee that applicants from developing countries would get a fee reduction, without tying the hands of the Assembly as regards the possible introduction of fee reductions for other groups of applicants. He said that the word “shall” would replace the word “may” in the revised version of Article 8(3) so that the text would read “Reduced fees shall be established by the Assembly in respect of international registrations of appellations of origin, in particular those from developing countries”.

226. The Delegation of France said that it would reserve its position on the matter for the time being, as the proposed replacement of “may” by “shall” would involve the transformation of an optional proposal into a mandatory one.

227. In response to the request for clarification made by the Delegation of Italy concerning the sentence “or a group of producers representing the beneficiaries referred to in subparagraph (i)” in Article 6(3)(ii), the Secretariat clarified that such group of producers was not covered by the immediately preceding text, namely “a legal entity which has legal standing to assert the rights of such beneficiaries”, and indicated that, on the contrary, it constituted a separate category.

CHAPTER IV: REFUSAL AND OTHER ACTIONS IN RESPECT OF INTERNATIONAL REGISTRATION

228. With regard to Article 17, the Delegation of France noticed a dual evolution in comparison to Article 5(6) of the Lisbon Agreement. In particular, the Delegation wished to know why the number of cases in which a phasing out period could be granted had been reduced and why such cases had been limited to generic terms or to “the customary name of a grape, plant or animal variety” for example, as the Delegation was of the view that such provision was a bit limitative, and for example did not include the possibility of granting a phasing out period to a prior trademark. As regards the length of the phasing out period for a previous trademark, the Delegation agreed that the current phasing out period of two years was too short to allow prior right holders to adapt to the new economic situation. In that regard the Delegation noted that the length of such phasing out periods was now dealt with in Rule 14(2) of the Regulations which only pointed to desirable periods, which was not very satisfactory from the Delegation’s point of view as the text only stated that the duration of the period granted should not be less than five years or longer than 15 years, which could in turn be interpreted as meaning that longer delays of 20 or 30 years, for example, could also be envisaged by the Contracting Parties. With respect to Article 17(3) on coexistence, the Delegation understood that the withdrawal of refusal would establish a situation of coexistence, but wondered whether Article 13 did not do the same because it enabled the preservation of prior rights as well as the subsequent registration of an appellation of origin. As regards invalidation, the Delegation was fully aware that Article 19 was a reflection of what was contained in the current Lisbon Regulations. Referring to the context in which such Regulations had been adopted, the Delegation pointed out that at the time the relevant provisions had been adopted as a response to situations that had arisen in certain Contracting Parties to the Lisbon Agreement where the competent national jurisdiction had taken some liberties as regards the invalidation of the protection granted to several appellations of origin. Referring to Article 19 of the DNI, the Delegation expressed the view that the provision related to invalidation had been provided for in very general terms and therefore requested that the text be amended to avoid creating too many legal uncertainties for holders of registered appellations of origin. The Delegation requested, in particular, that the grounds for invalidation be limited to extreme cases, as it would find it very difficult to understand that only ten years after the registration of a given appellation of origin a Contracting Party would suddenly realize that what had been registered as an appellation of origin was not really an appellation.

229. The Delegation of Switzerland had the same queries about invalidation and was of the view that the present exercise was a good opportunity to question that notion which had been included in the Lisbon system through the Regulations. In that regard, the Delegation shared the views expressed by the Delegation of France that the possibility to pronounce invalidation had to be very strictly limited in order for it not to become an indefinite period of refusal, which would lead to an unstable protection from the legal standpoint.

230. The Delegation of Italy also sought further explanations on the relationship between Article 13 and Article 17(3).

231. The Delegation of the European Union sought clarification as regards the final part of Article 17(3). Upon noting that a situation of withdrawal of the refusal as a consequence of a cancellation, revocation or invalidation of the prior right had been foreseen in paragraph (3), the Delegation wondered why the situation of non-renewal of the prior right had not been included as well.

232. The Representative of CEIPI suggested that subtitles be added to the paragraphs of Article 19. Referring to the French version of Article 15(2), he suggested that the term “*demande*” be replaced by “*requête*” as the provision in question did not refer to the kind of “*demande*” defined under Article 1(ix) of the DNI.

233. The Delegation of Algeria wished to know what the objective of Article 15(1)(c) was.

234. The Representative of INTA noted that, unlike the current Lisbon Agreement, Article 15 no longer referred to the one year period and that the notification of refusal was now dealt with in Rule 9(1) of the Draft Regulations. In that regard, she expressed the view that the provision was important enough to be kept in the Treaty itself. In respect of Article 15(2), she pleaded for the introduction of a more robust language guaranteeing the rights of owners of prior trademarks to introduce an opposition. She then pointed out that the reference to “Negotiations” in Article 16(2) might depend on the context and, in particular, that there might be a context in which such negotiations would not really be appropriate such as, for example, where a refusal would be based on third party rights and the designated country would actually be obliged to issue a refusal under its national law. She also recalled the previous discussions on whether that reference would actually be necessary because negotiations between countries would always be possible under the general rules of public international law. As regards Article 17(1), she said that INTA’s understanding was that phasing out should never be applied to prior trademark rights obtained in good faith under any circumstances. She further expressed the view that the coexistence rule that was established under Article 17(3) for a very specific scenario was perhaps an issue that would have to be discussed in further detail once, and if, the Working Group would be provided with more substantive proposals in respect of Article 13 concerning the general relationship between prior rights and appellations of origin. As regards Article 19(1) she said that it might be recommendable to tie the obligation to give “an opportunity to the concerned beneficiaries to defend their rights” to the legal entity defined as the holder in the International Register, because it would otherwise be hardly operational in some cases, as the Contracting Party would not know whom to give that opportunity to, all the more since the International Register currently incorporated registrations where only the producers in the region were listed, without any indication of a specific legal entity.

235. As regards Article 15, the Delegation of Italy was of the view that the time within which the Competent Authority would have to submit the refusal was important enough to be specified in the Article itself and not in the Regulations. With respect to Article 15(2), the Delegation was of the view that the title of the provision, namely “Obligation to Provide Opportunity for Interested Parties”, was not very clear and therefore suggested replacing it by “Observations from Third Parties”, for example.

236. In response to the question raised by the Delegation of France as regards Article 17(1), the Secretariat clarified that the provision was also dealing with trademarks to the extent that trademarks incorporated generic terms, whereas, in respect of other trademarks which did not include generic terms, Article 17(3) would apply. The Secretariat further indicated that Article 17(3) was based on the assumption that prior trademark rights and other prior rights would in any event be safeguarded under the DNI and agreed that it would have perhaps been preferable to explicitly refer to Article 13 in Article 17(3). In other words, the Secretariat clarified that in the context of the system established by the DNI, the phasing out period should not apply to prior rights as those were safeguarded. The Secretariat recalled that since there were countries which provided for coexistence of earlier rights and appellations of origin or geographical indications, they had to reflect that situation in the DNI. In parallel, the Secretariat pointed out that the case of those countries which did not provide for coexistence also had to be accommodated in the DNI and that was the reason why Article 13 did not specify which of the two situations would be chosen in the DNI, as both had to be accommodated. The Secretariat further indicated that Article 17(3) regulated the situation of a country which allowed for coexistence.

237. Referring to the question as to why the provision of Rule 14(2) did not specify the phasing out period clearly, the Secretariat said that it was difficult for the Secretariat to propose just any period of time in the text the necessary input from the Working Group. In that regard, the Secretariat said that, since a very diverse input had been given at previous meetings in that respect, an indicative range of five to fifteen years appeared in Rule 14(2). Referring to the question from Algeria as regards Article 15(1)(c), the Secretariat pointed out that the provision in question simply copied the last part of Article 5(3) of the Lisbon Agreement and that the provision meant that if a country had a law that would provide protection as a geographical indication or as an indication of source to an appellation of origin that would have been refused because it did not qualify as an appellation of origin in the eyes of the refusing country, then, the country in question would be obliged to provide that alternative protection. In response to the comment made by the European Union as regards Article 17(3), the Secretariat clarified that the same provision would apply in the case of non-renewal of a trademark and expressed the view that the word “cancellation” could be understood as referring to a trademark that would have not been renewed. Lastly, the Secretariat said that all the comments or drafting suggestions made by delegations would be duly reflected in the next version of the text.

238. In response to a question from the Delegation of Italy, the Secretariat explained that the current practice established in respect of the *Pisco* case, namely the recording of partial withdrawals in the International Register, would be continued. The Secretariat further indicated that, in addition, that possibility was now provided for in Rule 11*bis* of the Lisbon Regulations.

DISCUSSION OF ANNEX II OF DOCUMENT LI/WG/DEV/6/2

239. The Delegation of Peru reiterated its preference for the use of the term “*reputación*” instead of “*notoriedad*” in the Spanish version of Article 1(1).

240. With regard to the definition of geographical indications, the Delegation of Switzerland was of the view that the language of Article 1(1) should more closely follow the wording of the TRIPS Agreement which would in turn allow the deletion of the current footnote. For instance, the Delegation suggested that the phrase “as originating in a geographical area situated in a Contracting Party” be replaced by the TRIPS language in Article 22 which read “as originating in the territory of a member, a region or locality in that territory”.

241. The Representative of INTA shared the views expressed by the Delegation of Switzerland and also suggested to stick to the language of Article 22 of the TRIPS Agreement. She further sought confirmation as to whether the revised version of the DNI that would be submitted at the next session would incorporate both definitions, one for geographical indications and one for appellations of origin, in Article 2 of the DNI dealing with subject-matter.

242. The Chair confirmed that the idea would be to have a single instrument in which both definitions would be incorporated.

243. The Delegation of Italy shared the views expressed by other delegations that the definition of geographical indication should follow as closely as possible the language of Article 22 of the TRIPS Agreement. In addition, the Delegation indicated that subparagraph (c) of Article 1(1) was not necessary as it was of the view that non-geographical indications were already covered under subparagraph (a) of Article 1(1).

DISCUSSION OF CHAPTERS V TO VII OF ANNEX I: ADMINISTRATIVE PROVISIONS, REVISION AND AMENDMENT, FINAL PROVISIONS

244. Referring to Article 24(5) which dealt with the working capital fund, the Representative of CEIPI noted that the first sentence read “The Special Union shall have a working capital fund which shall be constituted by a single payment made by each country of the Special Union”, and wondered whether the term “country” should not be replaced by “member”, as was the case, for example, under the Geneva Act of the Hague agreement, so that intergovernmental organizations that would also be Contracting Parties would also be asked to make a payment and not only the countries. As regards Article 28(1)(ii), he was of the view that intergovernmental organizations should also be allowed to sign the Act and pointed out that such possibility was currently not envisaged in the provisions in question. Lastly, as regards Article 32(2) he wondered why the sentence which appeared in the previous version of the draft and which more or less read “denunciation shall not affect the application of this Act to any application pending and any international registration in force in respect of the denouncing contracting party at the time of the coming into effect of the denunciation”, no longer appeared in Article 32(2).

245. Referring to Article 24(4)(b) which stated that “The amounts of the fees referred to in paragraph 3(i) shall be so fixed that the revenues of the Special Union from fees and other sources shall be at least sufficient to cover all the expenses of the International Bureau concerning the Special Union”, the Representative of INTA wondered whether such provision would be realistic. As regards Article 29, he wondered whether a reference to Article 17(2) should also be included in the penultimate line of paragraph (4). Lastly, he said that he had not been able to find the “periods referred to” in Article 17(1), nor “the procedures specified in the Regulations”, as mentioned in the last sentence of Article 29(4).

DISCUSSION OF THE DRAFT REGULATIONS UNDER THE DRAFT NEW INSTRUMENT

246. As regards Article 31 of the DNI, which defined the relations between the current Lisbon Agreement and the future instrument, the Delegation of France expressed the view that the article would still have to be revised depending on the outcome of the future discussions of the Working Group. The Delegation suggested moving subparagraph (vi) of Rule 5(2) to paragraph (3) of Rule 5 as it was of the view that such requirement should be optional and not mandatory. The Delegation further expressed the view that the submission of those details would actually lead to a significant increase in workload in terms of translation of the data that would need to feature in the Register. Noting that new terminology was used as in the case of “geographical environment of the geographical area of origin”, the Delegation pointed out that the notion of “geographical environment” under European Community law did not necessarily cover both the natural and human factors, and therefore suggested to include a definition of geographical environment in Article 1 of the DNI. As regards Rule 14(2) on the transitional period granted to third parties, the Delegation asked that the terms “should not be” be placed between brackets as it was of the view that Contracting Parties should not be allowed to fix either longer or shorter durations, other than those explicitly referred to in the provision.

247. To accommodate the concerns expressed by the Delegation of France, the Chair suggested replacing the terms “should not be” by “shall not be” in Rule 14(2). As regards the expression “within the relevant time limit referred to in paragraph 1(iv)” in Rule 14(3), the Representative of CEIPI pointed out that “within the relevant time-limit” should read “before the date”. In light of the fact that the Regulations under the new instrument would enter into force at

the same time as the new instrument and that the date of that entry into force could not be known at the time of the adoption of the Regulations, he suggested removing Rule 25 from the Draft Regulations.

248. Referring to Rule 16(1), the Representative of INTA asked whether that rule could be construed as meaning that the Competent Authority of the Contracting Party of Origin could renounce the international registration even where the international registration was applied for by the beneficiaries or the legal entity referred to in Article 6(3). He further pointed out that, even though there were several references to notifications to the beneficiaries in the Draft Regulations, the communication of the addresses of the beneficiaries did not appear to be a mandatory requirement under Rule 5.

249. Referring to the comment made by the Delegation of France with respect to Article 31 of the DNI, the Secretariat agreed that the contents of that provision would have to be decided only once the end results on the structure of the new instrument as such would be known. The Secretariat further indicated that, clearly, there would be a period of time within which there would be two treaties in force, namely the revised Lisbon Agreement and the current Lisbon Agreement. As regards the suggestion made by the Delegation of France to move subparagraph (vi) of Rule 5(2) to paragraph (3) of Rule 5, so that it would become an optional requirement rather than a mandatory one, the Secretariat recalled that the provision in question had been moved to Rule 5(2), as suggested by the Delegation of the European Union at the previous session of the Working Group. The Secretariat further recalled that the provision of subparagraph (vi) had only been recently introduced in the current Lisbon Regulations as a result of a decision taken by the Assembly in 2011 on the recommendation of the Working Group to include the provision in question in the Regulations as an optional requirement. In any event the Secretariat requested further feedback from the participants to the Working Group in that regard, as they would ultimately decide whether the provision should be optional or mandatory. As regards the suggestion made by the Delegation of France to add a definition of geographical environment in the definitions section under Article 1 of the DNI, the Secretariat was of the view that it would be preferable to incorporate that definition in Article 2 because the definition of appellation of origin referred to the geographical environment.

250. Referring to Rule 9(2)(iv) which stated that “in case of a partial refusal based on coexistence with a prior right, subparagraph (ii) shall apply *mutatis mutandis* in respect of such coexistence”, the Delegation of Italy asked the Secretariat to perhaps illustrate with an example what those cases could be, because it failed to understand what a partial refusal would mean under the new instrument. The Delegation further indicated that on the basis of its experience with the Madrid system, a partial refusal only concerned products and the limitation of the list of products. In that regard, the Delegation pointed out that since the DNI did not deal with any classification of goods or any list of goods, a partial refusal in that context seemed to have a completely different meaning as it did not concern the list of products.

251. The Secretariat clarified that Rule 9(2)(iv) was based on the situation which had occurred a few years ago when the appellation of origin *Pisco* had been registered under the Lisbon Agreement by the Delegation of Peru, in 2005. This international registration had resulted in a number of partial refusals. In that regard, the Secretariat recalled that the problem had arisen for a number of Lisbon member States, such as Italy, which already provided protection in respect of *Pisco* from Chile on the basis of a bilateral agreement. The Secretariat pointed out that with the registration of *Pisco* from Peru, the question arose as to whether these Lisbon member States had to refuse the Peruvian registration or not. The legislation of the countries in question allowed for coexistence of homonymous appellations of origin, but there was no specific procedure under the Lisbon Agreement for the notification of situations of coexistence. The solution found at the time was to issue partial refusals, by which these countries acknowledged the protection for the Peruvian appellation of origin *Pisco* under the Lisbon Agreement in their territories, with one exception, i.e., that the protection did not apply with

regard to the use of the Chilean appellation of origin *Pisco* as protected under the bilateral agreement in respect of products originating from Chile.

252. Referring to the issue related to the registration of the appellation of origin *Pisco* by the Peru in 2005, the Delegation of Peru was of the understanding that the agreement signed between the European Union and Chile involved the recognition of the Chilean spirit drink as opposed to the grant of legal protection. The Delegation further specified that the annex to the trade agreement between the European Union and Chile incorporated a clause stating that the Peruvian rights on the appellation of origin *Pisco* would also be recognized.

253. Referring back to Rule 9(2)(iv), the Delegation of Italy asked the Secretariat to reformulate the provision on partial refusal as the current wording was not clear. The Delegation added that it was of the view that a situation of coexistence was the result of partial or limited acceptance rather than a partial refusal.

254. The Secretariat noted that the suggestion made by the Delegation of Italy was basically to move the provision in Rule 9(2)(iv) to Rule 12 of the Regulations which dealt with Grant of Protection. In that regard, the Secretariat pointed out that the text of the DNI was already dealing with both situations, namely an optional grant of protection or an optional partial refusal, under Rules 9 and 12, respectively. However, the Secretariat added that if the Working Group was of the opinion that a situation of coexistence should only result from a notification of grant of protection that could certainly be done.

255. The Delegation of France said that the possibility of moving the provision in Rule 9(2)(iv) to Rule 12 could be envisaged. Before doing so, however, the Delegation pointed out that one would have to re-examine the wording “partial refusal based on coexistence with a prior right” as the situation of coexistence following the withdrawal of a refusal had only been envisaged in Article 17(3) of the DNI. In that regard, the Delegation expressed the view that one was faced with a problem concerning the definition of coexistence, which was only envisaged in one case in the DNI and which seemed to reappear in the Regulations as a basic rule not necessarily linked to the withdrawal of a refusal. Noting that Rule 9 also gave rise to the difficulty concerning the definition of prior rights as in the case of Article 13, the Delegation reiterated its request to start by defining prior rights in the DNI.

256. The Representative of INTA agreed with the Delegation of France that Rule 9(2)(iv) would probably have to be revisited if the provisions of Articles 13 and 17(3) were amended. As regards Rule 9(2)(iv), he suggested replacing the term “subparagraph (ii)” by “item (ii)” in the second line, and also wondered whether the reference to item (ii) was correct and whether the text should not refer to item (i) instead.

FUTURE WORK

257. The Chair pointed out that at the beginning of the session, in the first round of general comments, several delegations had already indicated their preferences with respect to the structure or the form of the DNI, on the basis of the options set out in Annex I and II of the working document submitted by the Secretariat. In particular, he recalled that a majority of delegations, except for one, had expressed their support for a single DNI and therefore invited the participants to re-confirm whether the Secretariat should be invited to produce a single DNI covering both appellations of origin and geographical indications, and providing for the same level of protection for both categories, while maintaining two separate definitions.

258. The Delegation of Iran (Islamic Republic of) confirmed its preference for one single instrument for both geographical indications and appellations of origin with two separate definitions.

259. The Delegation of Italy confirmed its preference for one single instrument with two definitions, for appellations of origin and geographical indications, with the same high level of protection.
260. The Delegation of Switzerland confirmed its preference for a single instrument in the form of a revised version of the Lisbon Agreement, with separate definitions for appellations of origin and geographical indications, which would provide the same high level of protection to both.
261. The Delegation of France also supported the idea of having a single instrument with two definitions, one for appellations of origin and one for geographical indications, providing the same high level of protection to both.
262. The Delegation of Mexico confirmed its preference for a single instrument with two definitions, one for geographical indications and the other for appellations of origin, which would provide the same level of protection to both.
263. The Delegation of Georgia confirmed its preference for a single instrument for both appellations of origin and geographical indications that would provide the same level of protection to both categories.
264. The Delegation of Peru supported the idea of a Revised Lisbon Agreement, in the form of a single instrument regulating both geographical indications and appellations of origin, with different definitions. As regards the level of protection, the Delegation said that it would reserve its comments for later.
265. The Delegation of Portugal reconfirmed its preference for a single DNI, covering both appellations of origin and geographical indications, with two different definitions and the same high level of protection.
266. The Delegation of Spain expressed its preference for a single instrument, with two separate definitions for geographical indications and appellations of origin, which would provide the same level of protection to both categories.
267. The Delegation of the Former Yugoslav Republic of Macedonia expressed its support for a single instrument, with two separate definitions for appellations of origin and geographical indications, with the same level of protection.
268. The Delegation of Romania expressed its support for a single instrument with two definitions and with the same level of protection for both.
269. The Representative of the ABPI supported the idea of having a single instrument, with two separate definitions, and with the same level of protection for appellations of origin and geographical indications.
270. In light of the interventions that were made by several delegations, the Chair invited the Secretariat to provide the Working Group with a single DNI covering both geographical indications and appellations of origin, while also providing for a single high level of protection for both categories. The Chair then invited the participants to provide some guidance to the Secretariat as regards the structure of such new DNI, and noted in particular that the question that might arise in that respect was whether the new single DNI should contain two chapters, one for appellations of origin and one for geographical indications the latter containing the definition of geographical indications and providing for a *mutatis mutandis* application of the substantive provisions relating to appellations of origin or whether the members of the Working Group would like to have a single structure in which the provision defining the subject matter would address appellations of origin and geographical indications in the same article and, with respect to geographical indications, the provision providing for *mutatis mutandis* application of

the substantive provisions relating to appellations of origin would be included either in the definitions provision or in a separate provision.

271. The Delegation of Italy said that, for the sake of simplicity, it would prefer to have in one article both definitions and the same comment would apply to all the substantive provisions that would be more or less the same and that would concern both geographical indications and appellations of origin.

272. The Delegation of Iran (Islamic Republic of) also expressed its preference for a single structure instead of a division into two chapters.

273. Based on a single level of protection, the Delegation of Switzerland said that it expected that the substantive content of the provisions under the DNI would be the same for geographical indications and appellations of origin.

274. The Delegation of France shared the views expressed by the previous delegations.

275. The Delegation of the European Union reiterated its support to the organization of a workshop on dispute settlement in the margin of one of the future sessions of the Working Group some time in 2013, as well as to the preparation by the Secretariat of a factual document on the issue.

AGENDA ITEM 6: OTHER MATTERS

276. No statements were made under this item.

AGENDA ITEM 7: ADOPTION OF THE SUMMARY BY THE CHAIR

280. The Working Group approved the Summary by the Chair as contained in the present document.

281. A draft of the full report of the sixth session of the Working Group will be made available on the WIPO web site for comments by the delegations and representatives that participated in the meeting. Participants will be informed once the draft report is available on the WIPO web site. Participants can submit comments within one month from its publication date, after which a track-changes version of the document, taking into account all the comments received from participants, will be made available on the WIPO web site. The availability of the comments and the track-changes version will also be communicated to participants, together with a deadline for the submission of final comments on that track-changes version. Thereafter, the report, taking into account the final comments, as appropriate, will be published on the WIPO web site without track changes, indicating the date of such final publication. As of that date, the report will be deemed adopted, which will be noted at the next session of the Working Group.

AGENDA ITEM 8: CLOSING OF THE SESSION

282. The Chair closed the session on December 7, 2012.

[Annexes follow]



LI/WG/DEV/6/6
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Working Group on the Development of the Lisbon System (Appellations of Origin)

Sixth Session
Geneva, December 3 to 7, 2012

SUMMARY BY THE CHAIR

adopted by the Working Group

1. The Working Group on the Development of the Lisbon System (Appellations of Origin) (hereinafter referred to as “the Working Group”) met in Geneva, from December 3 to 7, 2012.
2. The following Contracting Parties of the Lisbon Union were represented at the session: Algeria, Czech Republic, France, Georgia, Hungary, Iran (Islamic Republic of), Italy, Mexico, Peru, Portugal, Serbia, the former Yugoslav Republic of Macedonia (12).
3. The following States were represented as observers: Australia, Benin, Burundi, Chile, Colombia, Germany, Iraq, Libya, Madagascar, Philippines, Romania, Russian Federation, Saudi Arabia, Slovenia, Spain, Sri Lanka, Switzerland, Thailand, Turkey, United States of America (20).
4. Representatives of the following international intergovernmental organizations (IGOs) took part in the session in an observer capacity: African Regional Intellectual Property Organization (ARIPO), European Union (EU), International Vine and Wine Office (IWO) (3).
5. Representatives of the following international non-governmental organizations (NGOs) took part in the session in an observer capacity: Brazilian Association of Intellectual Property (ABPI), Centre for International Intellectual Property Studies (CEIPI), International Association for the Protection of Intellectual Property (AIPPI), International Trademark Association (INTA), MARQUES (Association of European Trademark Owners), Organization for an International Geographical Indications Network (oriGIn) (6).

6. The list of participants is contained in document LI/WG/DEV/6/INF/1 Prov. 2*.

AGENDA ITEM 1: OPENING OF THE SESSION

7. The Director General of WIPO, Mr. Francis Gurry, opened the session, recalled the mandate of the Working Group and introduced the draft agenda, as contained in document LI/WG/DEV/6/1 Prov.

AGENDA ITEM 2: ELECTION OF A CHAIR AND TWO VICE-CHAIRS

8. Mr. Mihály Ficsor (Hungary) was unanimously elected as Chair of the Working Group, Mr. Alberto Monjarás Osorio (Mexico) and Mr. Behzad Saberi Ansari (Iran (Islamic Republic of)) were unanimously elected as Vice-Chairs.

9. Mr. Matthijs Geuze (WIPO) acted as Secretary to the Working Group.

AGENDA ITEM 3: ADOPTION OF THE AGENDA

10. The Working Group adopted the draft agenda (document LI/WG/DEV/6/1 Prov.) without modification.

AGENDA ITEM 4: REPORT OF THE FIFTH SESSION OF THE WORKING GROUP ON THE DEVELOPMENT OF THE LISBON SYSTEM (APPELLATIONS OF ORIGIN)

11. The Working Group took note of the adoption, on November 16, 2012, of the Report of the Fifth Session of the Working Group, as contained in document LI/WG/DEV/5/7, in accordance with the procedure established at the fifth session of the Working Group.

AGENDA ITEM 5: DRAFT NEW INSTRUMENT CONCERNING THE INTERNATIONAL REGISTRATION OF GEOGRAPHICAL INDICATIONS AND APPELLATIONS OF ORIGIN AND DRAFT REGULATIONS UNDER THE DRAFT NEW INSTRUMENT

12. Discussions were based on documents LI/WG/DEV/6/2, LI/WG/DEV/6/3, LI/WG/DEV/6/4 and LI/WG/DEV/6/5. The Working Group examined in detail Chapters I to IV of the Draft New Instrument and also went through the rest of the Draft New Instrument as well as the Draft Regulations, while focusing on issues highlighted by delegations.

13. The Working Group reiterated its general commitment to the two-fold mandate to work: (i) towards a revision of the Lisbon Agreement that would involve a refinement of the current legal framework and the inclusion of the possibility of accession by intergovernmental organizations, while preserving the principles and objectives of the Lisbon Agreement, and (ii) towards the establishment of an international registration system for geographical indications.

14. The Chair noted the wide support expressed for one single Draft New Instrument covering both appellations of origin and geographical indications and incorporating separate definitions for each, and also noted that some delegations had expressed flexibility in that regard. He

* The final list of participants will be made available as an Annex to the report of the session.

further observed that those in favor of a single Draft New Instrument also supported the establishment of a single International Register which would cover both appellations of origin and geographical indications.

15. The Chair also noted the prevailing view in the Working Group that the Draft New Instrument should provide for a single and high level of protection for both appellations of origin and geographical indications.

16. The Chair also noted the renewed plea for clarification of the relationship between the protection of appellations of origin/geographical indications and trademark rights.

17. The Chair noted the comments made on how provisions of other international instruments, such as the Paris Convention or the TRIPS Agreement, should be made applicable under the Draft New Instrument and, in particular, whether this should be achieved by a mere reference to such provisions or whether the substance of such provisions should be taken over in the Draft New Instrument in order to clearly lay down the obligations of the Contracting Parties.

18. Referring to the detailed discussions on Articles 10 and 11 of the Draft Revised Lisbon Agreement contained in Annex I of document LI/WG/DEV/6/2, the Chair clarified that the various non-papers submitted in the course of the discussions on Chapter III would be reflected in the report of the session. He further indicated that the latest version of the non-paper he had submitted, as amended during the discussions (see the Annex to the present document), would be incorporated in the Revised Draft New Instrument that would be prepared by the Secretariat for the next session and would serve as the basis for future discussions on Articles 10 and 11.

Future work

19. The Chair confirmed that two further meetings of the Working Group would be convened in 2013, one before and the other after the session of the Assemblies of the Member States of WIPO in the autumn of 2013.

20. In view of the progress made at the present session, the focus of the next session would be the examination and discussion of a revised version of the Draft New Instrument and Draft Regulations that would be prepared by the Secretariat and distributed well in advance of the next session. In particular, the Secretariat would work along the lines of the guidance provided by the Working Group at the present session and would make sure that all comments and suggestions be duly reflected in those revised versions.

21. As regards the overall structure of the Revised Draft New Instrument and Draft Regulations, the Working Group requested the Secretariat to prepare a Draft Revised Lisbon Agreement that would take the form of a single instrument covering both appellations of origin and geographical indications and providing for a high and single level of protection for both, while maintaining two separate definitions, on the understanding that the same substantive provisions would apply to both appellations of origin and geographical indications.

22. The Chair encouraged participants to submit comments and drafting suggestions to the Secretariat, between Working Group sessions, on the electronic forum that had been established for that purpose, while also recalling that such comments and suggestions would be posted for information purposes only and without prejudice to the role of the Working Group and the formal discussions therein.

23. While referring to paragraph 21 of the Summary by the Chair of the Fifth Session of the Working Group (document LI/WG/DEV/5/6), the Delegation of the European Union expressed the wish that the workshop on dispute settlement within the Lisbon system should be organized as a side event in the margins of one of the sessions of the Working Group in 2013.

AGENDA ITEM 6: OTHER MATTERS

24. No interventions were made under this item.

AGENDA ITEM 7: ADOPTION OF THE SUMMARY BY THE CHAIR

25. The Working Group approved the Summary by the Chair, as contained in the present document.

26. A draft of the full report of the session of the Working Group will be made available on the WIPO web site for comments by the delegations and representatives that participated in the meeting. Participants will be informed once the draft report is available on the WIPO web site. Participants can submit comments within one month from its publication date, after which a track-changes version of the document, taking into account all the comments received from participants, will be made available on the WIPO web site. The availability of the comments and the track-changes version will also be communicated to participants, together with a deadline for the submission of final comments on that track-changes version. Thereafter, the report, taking into account the final comments, as appropriate, will be published on the WIPO web site without track changes, indicating the date of such final publication. As of that date, the report will be deemed adopted, which will be noted at the next session of the Working Group.

AGENDA ITEM 8: CLOSING OF THE SESSION

27. The Chair closed the session on December 7, 2012.

[Annex follows]

Article 10

Protection Accorded by International Registration

(1) *[Content of Protection]* (a) Subject to the provisions of this Act, each Contracting Party shall, from the date of international registration, extend to a registered appellation of origin protection against:

(i) any use of the appellation of origin

- in respect of goods of the same kind as those to which the appellation of origin applies not originating in the geographical area of origin or not complying with any other applicable requirements for using the appellation of origin [which would amount to its usurpation or imitation [or evocation]];

- which would be detrimental to, or exploit unduly, its reputation,

even if the true origin of the goods is indicated or if the appellation of origin 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;

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

[Option A: (b) Without prejudice to Article 13(1), Contracting Parties:

(i) shall refuse or invalidate the registration of a trademark which contains or consists of a registered appellation of origin with respect to goods not originating in the geographical area of origin;

(ii) may refuse or invalidate the registration of a trademark which contains or consists of a registered appellation of origin with respect to goods that, while originating in the geographical area of origin, do not comply with any other applicable requirements for using the appellation of origin.]

[Option B: (b) Without prejudice to Article 13(1), Contracting Parties shall refuse or invalidate the registration of a trademark which contains or consists of a registered appellation of origin when it corresponds to one of the situations covered by subparagraph (a).]

[(2) *[Presumption in Case of Use by Third Parties]* Each Contracting Party shall provide for a presumption of unlawful use under paragraph (1)(a) in case a registered appellation of origin is used in respect of goods of the same kind as those to which the appellation of origin applies.]

[(3) *[Homonymy]* The provisions of this Act do not prevent the international registration of homonymous appellations of origin. Each Contracting Party shall determine what protection it shall provide in respect of such appellations of origin. Such protection shall be subject to practical conditions taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled*.]

* It is understood that a Contracting Party has the right not to accord protection, as stipulated in this Agreement, in respect of an appellation of origin which would, although literally true as to the geographical area in which the goods designated by the appellation of origin originate, falsely represent to the public that the goods originate in another territory.

Article 11

Shield Against Becoming a Generic Term or Name

A denomination protected as a registered appellation of origin in a Contracting Party cannot [be considered to have] become generic as long as the denomination is protected as an appellation of origin in the Contracting Party of Origin.

[Annex II follows]



WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

LI/WG/DEV/6/INF/1 PROV. 2
ORIGINAL: FRANCAIS/ENGLISH
DATE: 7 DÉCEMBRE 2012 / DECEMBER 7, 2012

Groupe de travail sur le développement du système de Lisbonne (appellations d'origine)

Sixième session
Genève, 3 – 7 décembre 2012

Working Group on the Development of the Lisbon System (Appellations of Origin)

Sixth Session
Geneva, December 3 to 7, 2012

DEUXIÈME LISTE PROVISOIRE DES PARTICIPANTS* **SECOND PROVISIONAL LIST OF PARTICIPANTS***

établie par le Secrétariat
prepared by the Secretariat

* Les participants sont priés d'informer le Secrétariat, en modifiant la présente liste provisoire, des modifications qui devraient être prises en considération lors de l'établissement de la liste finale des participants.

² Participants are requested to inform the Secretariat of any changes which should be taken into account in preparing the final list of participants. Changes should be requested by making corrections on the present provisional list.

I. MEMBRES/MEMBERS

(dans l'ordre alphabétique des noms français des États/in the alphabetical order of the names in French of the States)

ALGÉRIE/ALGERIA

Ahlem CHARIKHI (Mme), attachée, Mission permanente, Genève

EX-RÉPUBLIQUE YOUGOSLAVE DE MACÉDOINE/THE FORMER YUGOSLAV REPUBLIC OF MACEDONIA

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Mahmoud KHOUBKAR, Second Secretary, Permanent Mission, Geneva

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PÉROU/PERU

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RÉPUBLIQUE TCHÈQUE/CZECH REPUBLIC

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SERBIE/SERBIA

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II. ÉTATS OBSERVATEURS/OBSERVER STATES

ALLEMAGNE/GERMANY

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Charlemagne DEDEWANOU, attaché, Mission permanente, Genève

BURUNDI

Espérance UWIMANA (Mme), deuxième conseiller, Mission permanente, Genève

CHILI/CHILE

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COLOMBIE/COLOMBIA

Juan Camilo SARETZKI-FORERO, Primer Secretario, Misión Permanente, Ginebra

ESPAGNE/SPAIN

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FÉDÉRATION DE RUSSIE/RUSSIAN FEDERATION

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Svetlana GORLENKO (Ms.), Senior Researcher, Federal Institute of Industrial Property (FIPS), Federal Service for Intellectual Property, Patents and Trademarks (ROSPATENT), Moscow

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Thanaa AL NAEB (Mrs.), Head, Trademark Department, Ministry of Industry and Minerals, Baghdad

LYBIE/LIBYA

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Rahuma SALEM, Head, Scientific Cooperation Department, National Authority for Scientific Research (NASR), Tripoli

MADAGASCAR

Charles RAZAFINDRAZAKA, Attaché, Mission permanente, Genève

PHILIPPINES

Leny B. RAZ (Ms.), Director, Bureau of Trademarks, Intellectual Property Office of Philippines (IPOP), Makati City

Josephine REYNANTE (Ms.), First Secretary, Permanent Mission, Geneva

Maria Asuncion F. INVENTOR (Ms.), Attaché, Permanent Mission, Geneva

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Liliana DRAGNEA (Ms.), Legal Advisor, Legal and International Affairs Department, State Office for Inventions and Trademarks (OSIM), Bucharest

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Alēs ORAŽEM, Under-Secretary, Slovenian Intellectual Property Office (SIPO), Ljubljana

SRI LANKA

Natasha GOONERATNE (Ms.), Second Secretary, Permanent Mission, Geneva

SUISSE/SWITZERLAND

Alexandra GRAZIOLI (Mme), conseillère juridique principale à la Division droit et affaires internationales, Institut fédéral de la propriété intellectuelle (IPI), Berne

Erik THÉVENOD-MOTTET, expert en indications géographiques à la Division droit et affaires internationales, Institut fédéral de la propriété intellectuelle (IPI), Berne

THAÏLANDE/THAILAND

Prachaya PAIROJKULMANEE, Senior Legal Officer, Department of Intellectual Property (DIP), Ministry of Commerce, Nonthaburi

TURQUIE/TURKEY

Fusun ATASAY (Ms.), Division Director, International Affairs Department, Turkish Patent Institute (TPI), Ankara

III. ORGANISATIONS INTERNATIONALES INTERGOUVERNEMENTALES/
INTERNATIONAL INTERGOVERNMENTAL ORGANIZATIONS

OFFICE INTERNATIONAL DE LA VIGNE ET DU VIN (OIV)/INTERNATIONAL VINE AND
WINE OFFICE (IWO)

Tatiana SVINARTCHUK (Mme), chef d'unité économie et droit, Paris

ORGANISATION RÉGIONALE AFRICAINE DE LA PROPRIÉTÉ
INTELLECTUELLE (ARIPO)/AFRICAN REGIONAL INTELLECTUAL PROPERTY
ORGANIZATION (ARIPO)

Kujo MCDAVE, Legal Officer, Harare

UNION EUROPÉENNE (UE)/EUROPEAN UNION (EU)

Óscar MONDÉJAR, Legal Advisor, International Cooperation and Legal Affairs Department, Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), Alicante

Delphine LIDA (Mrs.), Counsellor, Permanent Delegation, Geneva

IV. ORGANISATIONS INTERNATIONALES NON GOUVERNEMENTALES/
INTERNATIONAL NON-GOVERNMENTAL ORGANIZATIONS

Association brésilienne de la propriété intellectuelle (ABPI)/Brazilian Association of Intellectual Property (ABPI)

Carlos Henrique de Carvalho FROES, Counsellor, Rio de Janeiro

Association des propriétaires européens de marques de commerce (MARQUES)/Association of European Trademark Owners (MARQUES)

Miguel Ángel MEDINA, Chair, MARQUES Geographical Indications Team, Madrid

Sébastien VITALI, Member, MARQUES Geographical Indications Team, Vevey

Centre d'études internationales de la propriété intellectuelle (CEIPI)/Centre for International Intellectual Property Studies (CEIPI)

François CURCHOD, chargé de mission, Genolier

International Trademark Association (INTA)

Bruno MACHADO, Geneva Representative, Rolle

Constanze SCHULTE (Mrs.), Member, INTA Geographical Indications Subcommittee, Madrid

Organisation pour un réseau international des indications géographiques (oriGIn)/Organization for an International Geographical Indications Network (oriGIn)

Massimo VITTORI, Managing Director, Geneva

Ida PUZONE (Mrs.), Project Manager, Geneva

V. BUREAU/OFFICERS

Président/Chair: Mihály FICSOR (Hongrie/Hungary)

Vice-présidents/Vice-chairs: Alberto MONJARÁS OSORIO (Mexique/Mexico)

Behzad SABERI (Iran (République islamique d')/Iran (Islamic Republic of))

Secrétaire/Secretary: Matthijs GEUZE (OMPI/WIPO)

VI. SECRÉTARIAT DE L'ORGANISATION MONDIALE DE LA PROPRIÉTÉ
INTELLECTUELLE (OMPI)/SECRETARIAT OF THE WORLD INTELLECTUAL
PROPERTY ORGANIZATION (WIPO)

Francis GURRY, directeur général/Director General

WANG Binying (Mme/Mrs.), vice-directrice générale/Deputy Director General

Matthijs GEUZE, chef du Service d'enregistrement Lisbonne, Secteur des marques et des
dessins et modèles/Head, Lisbon Registry, Brands and Designs Sector

Florence ROJAL (Mlle/Miss), juriste, Service d'enregistrement Lisbonne, Secteur des marques
et des dessins et modèles/Legal Officer, Lisbon Registry, Brands and Designs Sector

[Annex III follows]

NON-PAPERS DISTRIBUTED DURING THE DISCUSSION OF CHAPTER III

Non-Paper Secretariat

Article 10

Protection Accorded by International Registration

(1) *[Content of Protection]* (a) Subject to the provisions of this Act, each Contracting Party shall, from the date of international registration, extend to a registered appellation of origin protection against at least the following acts:

(i) use of the denomination constituting the appellation of origin in respect of a product that does not originate from the geographical area of origin;

(ii) use likely to be detrimental to the capability of the appellation of origin to designate the product in respect of which it was granted protection.

Notes:

1. The term “geographical area of origin” is an abbreviated expression under Article 1(xi), which, for its meaning, refers to Article 2(1).

2. Sub-paragraph (ii) would cover uses of an appellation of origin with delocalizing qualifiers or denominations that are not literally the same, but in which the public will recognize a reference to the appellation of origin; and uses of the appellation of origin by someone from within the geographical area of origin in respect of products that do not have the quality or characteristics referred to in Article 2(1).

Non-Paper European Union

Article 10

Protection Accorded by International Registration

(1) *[Content of Protection]* (a) Subject to the provisions of this Act, each Contracting Party shall, from the date of international registration, extend to a registered appellation of origin protection against at least the following acts:

(i) any direct or indirect use of the appellation of origin in respect of products not covered by the registration in so far as those products are comparable to the products registered under that appellation of origin:

- which would amount to usurpation, imitation or evocation of the appellation of origin; or

- which would be detrimental to or exploit unduly the reputation of the appellation of origin, even if the true origin of the product is indicated or if the appellation of origin 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;

(ii) any other false or misleading indications as to the provenance, origin, nature or essential qualities of a product to which the appellation of origin applies on the inner or outer packaging, advertising material or documents relating to the product, or any packing of the product in a container liable to convey a false impression as to its origin;

(iii) any other practice liable to mislead the consumer as to the true origin of the product.

Non-Papers Switzerland (2 versions on 04/12 and 05/12)

04.12.12

Article 10

Protection Accorded by International Registration

(1) *[Content of Protection]* (a) Subject to the provisions of this Act, each Contracting Party shall, from the date of international registration, extend to a registered appellation of origin protection against at least the following acts:

(i) any direct or indirect use[, being a usurpation, an imitation or an evocation] of the appellation of origin in relation to a comparable product which does not meet the requirements attached to this appellation of origin;

(ii) any commercial use of the appellation of origin in relation to a non comparable product, where such use would be likely to be detrimental to or to exploit unduly the reputation of the appellation of origin;

(iii) any other false or misleading indications as to the provenance, origin, nature or essential qualities of a product to which the appellation of origin applies on the inner or outer packaging, advertising material or documents relating to the product, or any packing of the product in a container liable to convey a false impression as to its origin;

(iv) any other practice liable to mislead the consumer as to the true origin of the product.

The protection according to i) to iv) applies even if the true origin of the product is indicated or if the appellation of origin is used in translated form or accompanied by terms such as "kind", "type", "make", "imitation", "style", "method", "like" or the like;

(b) Without prejudice to Article 13(1), Contracting Parties shall refuse or invalidate the registration of a trademark which contains or consists of a registered appellation of origin with respect to products not meeting the requirements attached to this appellation of origin. [Any Contracting Party may provide in its legislation that, in any of the cases above described in points i) to iv), any use of the appellation of origin by a person who is not entitled to do so according to the international registration is presumed to be unlawful.]

[(4) *[Homonymy]* The provisions of this Act do not prevent the international registration of homonymous appellations of origin. Each Contracting Party shall determine what protection it shall provide in respect of such appellations of origin, subject to the provisions of the TRIPS Agreement.]

Article 11

Shield Against Becoming a Generic Term or Name

[Option A: A denomination protected as a registered appellation of origin in a Contracting Party cannot be deemed to have] become generic, as long as the denomination is protected as an appellation of origin in the Contracting Party of Origin.]

Article 12

Duration of Protection

The effects of an international registration shall cease if a registered appellation of origin ceases to enjoy protection in the territory of the Contracting Party of Origin.

05.12.12

Article 10

Protection Accorded by International Registration

(1) *[Content of Protection]* (a) Subject to the provisions of this Act, each Contracting Party shall, from the date of international registration, extend to a registered appellation of origin protection against:

(i) any use [or any usurpation, imitation [or evocation]] of the appellation of origin in relation to the same kind of goods as those to which the appellation of origin applies, if those goods do not meet the requirements applicable to the appellation of origin;

(ii) any use [or usurpation, imitation [or evocation]] of the appellation of origin in relation to other kinds of goods, where such use would be likely to be detrimental to [or to exploit unduly] the reputation of the appellation of origin or mislead the public as to the true place of origin of the goods;

[(iii) any other false or misleading indications as to the provenance, origin, nature or essential qualities of a good to which the appellation of origin applies on the inner or outer packaging, advertising material or documents relating to the good, or any packing of the good in a container liable to convey a false impression as to its origin]

The protection according to i) to ii) [iii] applies even if the true origin of the good is indicated or if the appellation of origin is used in translated form or accompanied by terms such as “kind”, “type”, “make”, “imitation”, “style”, “method”, “like”, or the like; [and for any evocation which constitutes an act of misleading]

(b) Without prejudice to Article 13(1), Contracting Parties shall refuse or invalidate the registration of a trademark which contains or consists of a registered appellation of origin with respect to goods not meeting the requirements applicable to this appellation of origin.

[...]

Non-Papers by the Chair (2 versions, am and pm on 05/12)

Morning Session

Article 10

Protection Accorded by International Registration

(1) *[Content of Protection]* (a) Subject to the provisions of this Act, each Contracting Party shall, from the date of international registration, extend to a registered appellation of origin protection against the following acts:

(i) any use of the appellation of origin in respect of goods not originating in the geographical area of origin or, where applicable, not complying with other requirements for using the appellation of origin:

- which would amount to its usurpation or imitation [or evocation]; or
- which would be detrimental to, or exploit unduly, its reputation,

even if the true origin of the goods is indicated or if the appellation of origin 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;

(ii) any other practice liable to mislead the consumer as to the true origin of the goods.

(b) Without prejudice to Article 13(1), Contracting Parties:

(i) shall refuse or invalidate the registration of a trademark which contains or consists of a registered appellation of origin with respect to goods not originating in the geographical area of origin;

(ii) may refuse or invalidate the registration of a trademark which contains or consists of a registered appellation of origin with respect to goods that, while originating in the geographical area of origin, do not comply with other requirements for using the appellation of origin.

[(2) *[Presumption in Case of Use by Third Parties]* Each Contracting Party shall provide for a presumption of unlawful use under paragraph (1)(a) in case a registered appellation of origin is used in respect of goods of the same kind as those to which the appellation of origin applies.]

[(3) *[Homonymy]* The provisions of this Act do not prevent the international registration of homonymous appellations of origin. Each Contracting Party shall determine what protection it shall provide in respect of such appellations of origin. Such protection shall be subject to practical conditions taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled³.]

³ It is understood that a Contracting Party may not accord protection, as stipulated in this Agreement, in respect of an appellation of origin which would, although literally true as to the geographical area in which the goods designated by the appellation of origin originate, falsely represent to the public that the goods originate in another territory.

Article 11

Shield Against Becoming a Generic Term or Name

A denomination protected as a registered appellation of origin in a Contracting Party cannot [be considered to have] become generic, as long as the denomination is protected as an appellation of origin in the Contracting Party of Origin.

Afternoon Session

Article 10

Protection Accorded by International Registration

(1) *[Content of Protection]* (a) Subject to the provisions of this Act, each Contracting Party shall, from the date of international registration, extend to a registered appellation of origin protection against:

(i) any use of the appellation of origin

- in respect of goods of the same kind as those to which the appellation of origin applies not originating in the geographical area of origin or not complying with any other applicable requirements for using the appellation of origin which would amount to its usurpation or imitation [or evocation];

- which would be detrimental to, or exploit unduly, its reputation,

even if the true origin of the goods is indicated or if the appellation of origin 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;

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

Option A: (b) Without prejudice to Article 13(1), Contracting Parties:

(i) shall refuse or invalidate the registration of a trademark which contains or consists of a registered appellation of origin with respect to goods not originating in the geographical area of origin;

(ii) may refuse or invalidate the registration of a trademark which contains or consists of a registered appellation of origin with respect to goods that, while originating in the geographical area of origin, do not comply with any other applicable requirements for using the appellation of origin.

Option B: (b) Without prejudice to Article 13(1), Contracting Parties shall refuse or invalidate the registration of a trademark which contains or consists of a registered appellation of origin when it corresponds to one of the situations covered by subparagraph (a).

[(2) *[Presumption in Case of Use by Third Parties]* Each Contracting Party shall provide for a presumption of unlawful use under paragraph (1)(a) in case a registered appellation of origin is used in respect of goods of the same kind as those to which the appellation of origin applies.]

[(3) *[Homonymy]* The provisions of this Act do not prevent the international registration of homonymous appellations of origin. Each Contracting Party shall determine what protection it shall provide in respect of such appellations of origin. Such protection shall be subject to practical conditions taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled⁴.]

Article 11

Shield Against Becoming a Generic Term or Name

A denomination protected as a registered appellation of origin in a Contracting Party cannot [be considered to have] become generic as long as the denomination is protected as an appellation of origin in the Contracting Party of Origin.

[End of Annex III and of document]

⁴ It is understood that a Contracting Party has the right not to accord protection, as stipulated in this Agreement, in respect of an appellation of origin which would, although literally true as to the geographical area in which the goods designated by the appellation of origin originate, falsely represent to the public that the goods originate in another territory.