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## WIPONATIONALSEMINA RONTHEPROTECTION OF TRADEMARKSANDGEOGR APHICALINDICATIONS

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INTERNATIONALFRAMEW ORKFORTHEPROTECTI ONOFTRADEMARKSAND  
GEOGRAPHICALINDICAT IONS

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INTERNATIONAL FRAMEWORK FOR THE PROTECTION OF  
TRADEMARKS AND GEOGRAPHICAL INDICATIONS

## 1. General

1. There are, in principle, several alternative ways for obtaining protection of trademarks and geographical indications abroad. Bearing in mind that all intellectual property rights are strictly territorial rights, the most plausible way would be to apply trademarks in each and every relevant country (as far as geographical indications are concerned, the story is more complex). In any case, this would be a very demanding and cumbersome procedure, a fact that was recognized and dealt with already more than a century ago.

2. It is then no wonder that one of the very first two agreements concluded under provision of Article 19 of the Paris Convention was the agreement introducing significantly facilitated procedure of international registration of trademarks, the Madrid Agreement Concerning the International Registration of Marks ("Madrid Agreement") of 1891. More recently, the Protocol Relating to that Agreement ("Madrid Protocol"), was concluded in 1989. Madrid Agreement and Madrid Protocol are nowadays popularly known as the Madrid system.

## 2. The Madrid System

### Introduction

3. Let us repeat that the system of international registration of marks is governed by two treaties: the Madrid Agreement Concerning the International Registration of Marks, which dates from 1891, and the Protocol Relating to the Madrid Agreement, which was adopted in 1989, entered into force on December 1, 1995, and came into operation on April 1, 1996. Common Regulations under the Agreement and Protocol also came into force on that date. The system is administered by the International Bureau of WIPO, which maintains the International Register and publishes the *WIPO Gazette of International Marks*.

4. Any State which is a party to the Paris Convention for the Protection of Industrial Property may become a party to the Agreement or the Protocol or both. In addition, an intergovernmental organization may become a party to the Protocol (but not the Agreement) where the following conditions are fulfilled: at least one of the Member States of the organization is a party to the Paris Convention and the organization maintains a regional office for the purposes of registering marks with effect in the territory of the organization.

5. States party to the Agreement and/or the Protocol and organizations party to the Protocol are referred to collectively as Contracting Parties. A list of the Contracting Parties is given on a separate sheet. Together, they constitute the Madrid Union, which is a Special Union under Article 19 of the Paris Convention.

6. Every member of the Madrid Union is a member of its Assembly. Among the most important tasks of the Assembly are the adoption of the program and budget of the Union and the adoption and modification of the implementing regulations, including the fixing of fees connected with the use of the Madrid system.

## Objectives

7. The objectives of the system are two-fold. Firstly, it facilitates the obtaining of protection for marks (trademarks and service marks). The registration of a mark in the International Register produces, in the Contracting Parties designated by the applicant, the effects described below. Further Contracting Parties may be designated subsequently. Secondly, since an international registration is equivalent to a bundle of national registrations, the subsequent management of that protection is made much easier. There is only one registration to renew, and changes such as a change in ownership or in the name or address of the holder, or a limitation of the list of goods and services, can be recorded in the International Register through a single simple procedural step. On the other hand, if it is desired to transfer the registration for only some of the designated Contracting Parties, or for only some of the goods or services, or to limit the list of goods and services with respect to only some of the designated Contracting Parties, the system is flexible enough to accommodate this.

## Who May Use the System?

8. An application for international registration (an "international application") may be filed only by a natural person or a legal entity which has a real and effective industrial or commercial establishment in, or is domiciled in, or is national of, a country which is party to the Madrid Agreement or the Madrid Protocol, or who has such an establishment in, or is domiciled in, the territory of an intergovernmental organization which is a party to the Protocol, or is national of a Member State of such an organization.

9. The Madrid system of international registration cannot be used by a person or legal entity which does not have the necessary connection, through the establishment, domicile or nationality, with a member of the Madrid Union. Nor can it be used to protect a mark outside the Madrid Union.

## The International Application

10. A mark may be the subject of an international application only if it has already been registered (or, where the international application is governed exclusively by the Protocol, if registration has been applied for) in the Trademark Office of the Contracting Party with which the applicant has the necessary connection, as described in paragraph 6, above, to be able to file an international application. This Office is referred to as the Office of origin.

11. An international application must be presented to the International Bureau through the Office of origin. An international application which is presented direct to the International Bureau by the applicant will not be considered as such and will be returned to the sender.

12. The international application must contain, *inter alia*, a reproduction of the mark (which must be identical with that in the basic registration or basic application) and a list of the goods and services for which protection is sought, classified in accordance with the International Classification of Goods and Services (Nice Classification).

13. An international application may claim priority under Article 4 of the Paris Convention, whether from the application with the Office of origin or from a prior application filed with the Office of another country party to the Paris Convention or with the Office of a Member of the World Trade Organization.

14. An international application must designate the Contracting Parties in which the mark is to be protected. Where the Contracting Party whose Office is the Office of origin is a party to the Agreement but not the Protocol, only other States which are also party to the Agreement may be designated. Where the Contracting Party whose Office is the Office of origin is a party to the Protocol but not the Agreement, only other Contracting Parties which are also party to the Protocol may be designated. Where the Contracting Party whose Office is the Office of origin is a party to both the Agreement and the Protocol, any other Contracting Party may be designated.

15. The Contracting Party whose Office is the Office of origin cannot be designated in an international application; nor can it be designated subsequently.

16. The designation of a given Contracting Party is made under that treaty (Agreement or Protocol) which is common to the designated Contracting Party and the Contracting Party whose Office is the Office of origin. Where both Contracting Parties are party to both the Agreement and the Protocol, it is the Agreement which governs the designation; this follows from the so-called "safeguard" clause, Article 9 *sexies* of the Protocol.

17. There are therefore three kinds of international application:

an international application *governed exclusively by the Agreement*; this means that all the designations are made under the Agreement;

an international application *governed exclusively by the Protocol*; this means that all the designations are made under the Protocol;

an international application *governed by both the Agreement and the Protocol*; this means that some of the designations are made under the Agreement and some under the Protocol.

18. If the international application is governed exclusively by the Agreement, it must be in French. If it is governed exclusively by the Protocol or by both the Agreement and the Protocol, it may be in either English or French; the Office of origin may however restrict the applicant's choice to one of these languages.

19. The international application is subject to the payment of the following fees:

a basic fee;

a complementary fee in respect of each designated Contracting Party for which no individual fee is payable;

an individual fee in respect of any Contracting Party which is designated under the Protocol and has declared that it wishes to receive such a fee; (the amount of the individual fee is determined by each Contracting Party; it may not be higher than the amount that would be payable for the registration of a mark in the Office of that Contracting Party; the amount of the respective individual fees are published in the Gazette);

a supplementary fee in respect of each class of goods and services beyond the third; no supplementary fee is payable however where *all* the designations are ones in respect of which an individual fee has to be paid.

20. These fees may be paid direct to the International Bureau or, where the Office of origin accepts to collect and forwards such fees, through that Office .
21. The Office of origin must certify that the mark is the same as that in the basic registration or basic application, that any indications such as a description of the mark or a claim to color as a distinctive feature of the mark are the same as those contained in the basic registration or basic application, and that the goods and services indicated in the international application are covered by the list of goods and services in the basic registration or basic application.
22. The Office of origin must also certify the date on which it received the request to present the international application. This date is important; provided the application is received by the International Bureau within two months of that date (and provided that certain crucial elements are not missing), it is that date that will be the date of the international registration.
23. The International Bureau checks that the international application complies with the requirements of the Agreement or Protocol and the Common Regulations, including requirements relating to the indication of goods and services and their classification, and that the required fees have been paid. The Office of origin and the applicant are informed of any irregularities; these must be remedied within three months, otherwise the application will be considered abandoned.
24. Where the international application complies with the applicable requirements, the mark is recorded in the International Register and published in the Gazette. The International Bureau then notifies each Contracting Party in which protection has been requested.

#### Examination by the Office of a Designated Contracting Party; Refusal of Protection

25. The Office of a designated Contracting Party examines the international registration in exactly the same way as an application filed directly. If grounds for objection are found during the *ex officio* examination, or if an opposition is filed, the Office has the right to declare that protection cannot be granted to the mark in that Contracting Party.
26. Any provisional refusal must be notified to the International Bureau by the Office of the Contracting Party concerned within the time limits specified in the Agreement or Protocol. This time limit is generally 12 months. A Contracting Party may however declare that, when it is designated under the Protocol, this time limit shall be replaced by 18 months. A Contracting Party that has made this declaration may further declare that a provisional refusal based on an opposition may be notified even after the expiry of this 18-month period.
27. The provisional refusal is recorded in the International Register and published in the Gazette and a copy is transmitted to the holder of the international registration.
28. Any procedure subsequent to the refusal, such as review, appeal or response to an opposition, is carried out directly between the holder and the Office concerned, without any involvement on the part of the International Bureau. The Office must however send a statement to the International Bureau once all the procedures before that Office have been completed, indicating that the provisional refusal is confirmed or is totally or partially

withdrawn. This statement is also recorded in the International Register and published in the Gazette.

29. Where an Office finds no reason for refusing protection, it may, before the expiry of the applicable time limit for provisional refusal, issue a statement of grant of protection. Such statement is recorded in the International Register and published in the Gazette and a copy is transmitted to the holder of the international registration. An Office is however not obliged to issue a positive decision on registration and no legal consequences result if it does not do so.

#### Effects of the International Registration

30. From the date of the international registration (or, in the case of a Contracting Party designated subsequently, from the date of that designation), the protection of the mark in each of the designated Contracting Parties is the same as if the mark had been the subject of an application for registration filed directly with the Office of that Contracting Party. If no provisional refusal is notified to the International Bureau within the relevant time limit, or if any such refusal is subsequently withdrawn, the protection of the mark in each designated Contracting Party is the same as if it had been registered by the Office of that Contracting Party.

31. An international registration is therefore equivalent to a bundle of national registrations. Although it is a single registration, protection may be refused by some of the designated Contracting Parties, or the protection may be limited or renounced with respect to only some of the designated Contracting Parties. Likewise an international registration may be transferred to a new owner with respect to only some of the designated Contracting Parties. An international registration may also be invalidated (for example, for non-use) with respect to one or more of the designated Contracting Parties. Moreover, any action for infringement of an international registration must be brought separately in each of the Contracting Parties concerned.

32. This is in contrast to a unitary regional right such as the Community trademark, which cannot be refused, limited or transferred with effect for only a part of the territory covered by the right, and which may be enforced by a single legal action covering infringement occurring anywhere in that territory.

#### Dependence on the Basic Mark

33. For a period of five years from the date of its registration, an international registration remains dependent on the mark registered or applied for in the Office of origin. If, and to the extent that, the basic registration ceases to have effect, whether through cancellation following a decision of the Office of origin or a court, through voluntary cancellation or through non-renewal, within this five-year period, the international registration will no longer be protected. Similarly, where the international registration was based on an application in the Office of origin, it will be canceled if, and to the extent that, that application is refused or withdrawn within the five-year period, or if, and to the extent that, the registration resulting from that application ceases to have effect within that period.

34. The Office of origin is required to notify the International Bureau of facts and decisions concerning such ceasing of effect or refusal and, where appropriate, to request the cancellation (to the extent applicable) of the international registration. The cancellation is published in the Gazette and notified to the designated Contracting Parties. Such

cancellations are relatively infrequent; only about 190 were recorded during 2001, many of which related to only some of the goods and services covered by the international registration.

35. If, within three months of such cancellation, the holder files an application for registration with the Office of a Contracting Party that had been designated under the Protocol, that application will be treated as if it had been filed on the date of the international registration or (as the case may be) the subsequent designation of the Contracting Party concerned. This option is not available in the case of a Contracting Party designated under the Agreement.

36. After the expiry of the period of five years mentioned in paragraph 31, the international registration becomes independent of the basic registration or basic application.

#### Replacement of a National or Regional Registration by an International Registration

37. An international registration is deemed to replace a national or regional registration for the same mark and the same goods and services recorded in the name of the same person in a designated Contracting Party. The effect of replacement is that, if the national or regional registration is not renewed, the holder of the international registration may continue to benefit from the earlier rights acquired by reason of that national or regional registration. Although replacement takes place automatically, the holder of the international registration may request the Office of the Contracting Party in which the national or regional registration is recorded to take note in its register of the international registration.

#### Subsequent Designation

38. The effects of an international registration can be extended to a Contracting Party not covered by the international application by filing a subsequent designation. Thus the holder of an international registration can expand the geographical scope of the protection of his mark in line with his business needs. Moreover a subsequent designation may be made in order to extend the protection of the mark to a Contracting Party which was not a party to the Agreement or Protocol at the time of the international application. The principles that determine whether such a designation can be made, and whether it is governed by the Agreement or by the Protocol, are as described in paragraphs 14 and 15, above.

#### Changes in the International Register; Cancellation; Licenses

39. A change in the name or address of the holder or his representative may be recorded in the International Register on request.

40. Likewise a change in the ownership of an international registration may be recorded, in respect of all or some of the goods and services and all or some of the designated Contracting Parties. A person may not however be recorded as the holder of an international registration in respect of a given Contracting Party if he would not be entitled (in accordance with the principles set out in paragraphs 14 and 15, above), to designate that Contracting Party in an international application. Thus, for example, a person who does not have a connection with a country which is a party to the Agreement may not be recorded as the holder of an international registration in respect of a designated Contracting Party which is a party only to the Agreement.

41. The following may also be recorded in the International Register:

a *limitation* of the list of goods and services in respect of all or some of the designated Contracting Parties;

a *renunciation* in respect of some of the designated Contracting Parties for all the goods and services;

a *cancellation* of the international registration in respect of all the designated Contracting Parties for all or some of the goods and services;

a *license* granted in respect of all or some of the designated Contracting Parties, and for all or some of the goods and services.

42. Information concerning such changes, cancellation and licenses is published in the Gazette and notified to the designated Contracting Parties.

43. No change may be made in the mark that is the subject of an international registration, either on renewal or at any other time. Nor may the list of goods and services be changed in a way that would extend the scope of protection.

#### Duration of Registration; Renewal

44. An international registration is effective for 10 years. It may be renewed for further periods of 10 years on payment of the prescribed fees. The International Bureau sends a reminder to the holder and to his representative (if any) six months before renewal is due.

45. The international registration may be renewed in respect of all the designated Contracting Parties or in respect of only some of them. It may not however be renewed in respect of only some of the goods and services recorded in the International Register; if therefore the holder wishes, at the time of renewal, to remove some of the goods and services from the international registration, he must separately request cancellation in respect of those goods and services.

#### Advantages of the System

46. International registration has several advantages for the owner of the mark. After registering the mark, or filing an application for registration, with the Office of origin, he has only to file one application, in one language, and pay one fee instead of filing separately in the trademark Offices of the various Contracting Parties in different languages and paying a separate fee in each Office. Moreover, the holder does not have to wait for the Office of each Contracting Party in which protection is sought to take a positive decision to register the mark; if no refusal is notified by an Office within the applicable time limit, the mark is protected in the Contracting Party concerned. In some cases, the holder does not even have to wait the expiry of this time limit in order to know that the mark is protected in a Contracting Party, since he may, before the expiry of the time limit, receive a statement of grant of protection from the Office of that Contracting Party.

47. A further important advantage is that changes subsequent to registration, such as a change in the name or address of the holder, or a change (total or partial) in ownership or a limitation of the list of goods and services may be recorded with effect for several designated



Contracting Parties through a single simple procedural step and the payment of a single fee. Moreover, there is only one expiry date and only one registration to renew.

48. International registration is also to the advantage of Trademark Offices. They do not need to examine for compliance with formal requirements, or classify the goods or services, or publish the marks. Moreover, they are compensated for the work that they perform; the individual fees collected by the International Bureau are transferred to the Contracting Parties in respect of which they have been paid, while the complementary and supplementary fees are distributed annually among the Contracting Parties not receiving individual fees, in proportion of the number of designations made of each of them. For the year 2000, the International Bureau distributed a total of 24.9 million Swiss francs resulting from the complementary and supplementary fees and 33.8 million Swiss francs resulting from individual fees. In addition, if the International Registration Service closes its biennial accounts with a profit, the proceeds are divided among the Contracting Parties.

49. At the end of 2002, 403,916 international registrations were in force. During that year, 22,232 new international registrations were effected, containing 257,703 designations, an average of 11.6 designations per registration. In addition, 25,662 new designations were recorded in respect of existing international registrations. In other words, the designations effected in 2002 were equivalent to more than 344,000 national applications.

### 3. International Protection of Geographical Indications

50. This section describes various alternatives for international protection of geographical indications, because the situation in this respect is not so clear-cut as this being the case with trademarks. Therefore, reference is made to both bilateral and multilateral agreements. Under multilateral agreements, the TRIPS Agreement, though not administered by WIPO, is also discussed.

#### Bilateral Agreements

51. Bilateral international agreements are typically concluded between two countries on the basis of reciprocity in order to increase protection of the countries' respective geographical indications. They may be independent treaties or form part of a wider trade agreement.<sup>1</sup> They may simply provide for a prohibition of use of the other party's geographical indications for goods (usually listed in an annex to the agreement) not having that origin. Or they may go further and provide for the extraterritorial application of the other country's national law concerning the protection of geographical indications. This latter aspect may be important in cases where a given geographical indication does not only indicate the geographical origin of certain goods, but also certain qualities that are due to that origin, such as is the case with protected appellations of origin.

52. Bilateral international agreements may cover a wider range of products or be limited to specific goods only. They have been concluded most frequently between European nations earlier in the 20<sup>th</sup> century. However, they continuously appear to be important with regard to specific economic sectors and, in particular, the wine industry.<sup>2</sup>

<sup>1</sup>E.g., the "Crayfish Agreement" between France and South Africa from the 1930s (see *Symposium on the International Protection of Geographical Indications*, Somerset West, 1999, page 31).

<sup>2</sup>For example, EU - Australia Wine Agreement of 1994.

## Multilateral Agreements

53. An alternative for obtaining international protection for geographical indications is through the conclusion of, and the adherence to, multilateral agreements. The following is a summary of the scope of protection that is provided for geographical indications under the following multilateral treaties: the Paris Convention, the Madrid Agreement on Indications of Source, the Lisbon Agreement, and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement).

### (a) *The Paris Convention*

54. Article 1(2) of the Paris Convention enumerates among the objects of the protection of industrial property indications of source and appellations of origin. More specific provisions concerning indications of source are contained in Articles 10 and 10*ter*.

55. A provision prohibiting the use of a false indication of source appeared as early as in the original text of the Paris Convention of 1883. However, that protection was rather limited, since the prohibition was only applicable where the false indication of source was used in conjunction with a fictitious or non-existing trade name.

56. Article 10 of the Paris Convention in its current version sets forth that, in cases of “direct or indirect use of a false indication of the source of the goods or the identity of the producer, manufacturer or merchant,” Article 9 of the Paris Convention should be applicable. Article 9 provides that goods bearing a false indication of source are subject to seizure upon importation into countries party to the Paris Convention, or within the country where the unlawful affixation of the indication of source occurred or within the country of importation. This seizure shall take place at the request of the public prosecutor, or any other competent authority, or any interested party. However, Article 9(5) and (6) of the Paris Convention allow that countries party to the Paris Convention whose national laws do not permit seizure on importation or inside the country to replace those remedies by either a prohibition of importation or by any other nationally available remedy.

57. Furthermore, Article 10*ter*(2) contains an undertaking of the States party to the Paris Convention to allow federations and associations representing producers and trade circles to bring actions in order to enforce the means of protection envisaged in Articles 9 and 10.

### (b) *The Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods*

58. The positions of the founding States of the Paris Convention at the 1883 Paris Diplomatic Conference regarding the protection of indications of source did not allow more than a minimum common position with regard to protection on the multilateral level. As already indicated, the original text did not provide for the prevention of the use of false indications *per se*, but only where such use occurred in connection with the use of a false trade name.

59. Consequently, countries which had greater interest in an improved international protection of indications of source established a special union under the Madrid Agreement

for the Repression of False or Deceptive Indications of Source on Goods (“Madrid Agreement on Indications of Source”).<sup>3</sup>

60. The Madrid Agreement on Indications of Source binds the States which are party to it to prevent not only the use of “false” indications of source, but also the use of indications of source which are “deceptive,” i.e., literally true but nevertheless misleading. This may be the case, for example, where a given geographical name exists in two different countries, but was used as an indication of source only for products originating from that place in one country. Use of that indication of source by producers from the other country cannot be regarded as use of a “false” geographical indication, although consumers may be deceived by such use.

61. Article 4 of the Madrid Agreement on Indications of Source contains a special provision for “regional appellations concerning the source of products of the vine” which constitutes an exception to the rule that, in application of the Agreement, the courts are free to decide whether or not a given indication of source is a generic term. This article is noteworthy, since it constitutes a departure from the general rule that the conditions of protection of an indication of source and, in particular, whether a specific indication of source is considered generic, are to be determined by the country in which protection is sought.

62. However, the application of Article 4 of the Madrid Agreement on Indications of Source is limited to the products of the vine, and the provision is subject to different interpretations. It was also repeatedly noted that the Madrid Agreement on Indications of Source does not significantly increase the level of protection for indications of source already provided under the Paris Convention. Considering also its limited membership, the Madrid Agreement on Indications of Source did not gain great practical significance.

*(c) The Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration*

63. One of the results of the Lisbon Diplomatic Conference of 1958, which had attempted, *inter alia*, to improve the international protection for geographical indications within the framework of the Paris Convention and the Madrid Agreement on Indications of Source, was the adoption of the Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration.<sup>4</sup>

64. The Lisbon Agreement takes the protection of indications of source beyond the level of protection provided under the Paris Convention and the Madrid Agreement on Indications of Source. The main principle of the Lisbon Agreement is that the States which are party to it undertake to protect appellations of origin that are protected “as such” in the country of origin and registered in the international register administered by WIPO (Article 1(2)). That means in practice that it is only applicable to appellations of origin which are already protected on the national level in the country of origin. Once a given appellation of origin is protected in its country of origin, that appellation of origin can be registered in an international register administered by WIPO. After its registration, the appellation of origin is published and

<sup>3</sup>On February 4, 2003, 33 States were party to the Madrid Agreement on Indications of Source.

<sup>4</sup>On February 4, 2003, 20 States were party to the Lisbon Agreement (for a complete list, see <http://www.wipo.int/treaties/docs/english/j-lisbon.doc>). A Working Group on the Modification of the Regulations under the Lisbon Agreement for the Protection of Appellations of Origin and International Registration met from July 10 to 13, 2000, in Geneva (LI/GT/1/1 to 3).

notified to all other States party to the Lisbon Agreement. Since its entry into force on September 25, 1966, 835 appellations of origin have been registered under the Lisbon Agreement, of which 766 are still in force.<sup>5</sup>

65. Following the receipt of a notification of registration, a State that is party to the Lisbon Agreement may declare during a period of one year that it cannot protect the appellation of origin which was the subject of the notification. With respect to those registrations made under the Lisbon Agreement, 62 refusals of protection, concerning 51 international registrations, have been entered in the international register.<sup>6</sup>

66. According to Article 6 of the Lisbon Agreement, an appellation which has been granted protection in one of the countries party to that Agreement pursuant to the procedure under Article 5 cannot, in that country, be deemed to have become generic, as long as it is protected as an appellation of origin in the country of origin.

67. The scope of protection for internationally registered appellations of origin is broader than the protection for indications of source under the Paris Convention and the Madrid Agreement on Indications of Source. Thus, under Article 3 of the Agreement, not only misleading use of a protected appellation of origin is prohibited, but “any usurpation or imitation [of the protected appellation of origin], even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as “kind,” “type,” “make,” “imitation” or the like.”

(d) *The TRIPS Agreement*

68. Part II, Section 3 of the TRIPS Agreement is dedicated to geographical indications. The general norm of protection is provided by Article 22.2, which reads as follows:

“2. In respect of geographical indications, Members shall provide the legal means for interested parties to prevent:

(a) the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of the origin in a manner which misleads the public as to the geographical origin of the good;

(b) any use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention (1967).”

69. Article 22.2 is supplemented by Article 22.3 and 22.4. Article 22.3 deals specifically with the registration of trademarks containing or consisting of a geographical indication, for goods not originating in the territory indicated, if the use of those trademarks for such goods would be misleading as to the true place of origin of the goods. The remedy that must be available in that situation is refusal or invalidation of the trademark registration, either *ex officio*, if the applicable law so allows, or at the request of an interested party.

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<sup>5</sup>Internationally registered appellations of origin are published in the WIPO periodical *Les appellations d'origine*. Internationally registered appellations of origin are also published on the CD-ROM *Romarin*

<sup>6</sup>LI/GT/1/2, paragraph 7.

70. Article 22.4 stipulates that the protection under Article 22.1 to 22.3 must also be made available in respect of the use of deceptive geographical indications, i.e., geographical indications that are literally true, although they falsely represent to the public that the goods on which they are used originate in a different territory.

71. Article 23.1 provides for additional protection for geographical indications for wines and spirits. It reads as follows:

“Each Member shall provide the legal means for interested parties to prevent use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as “kind,” “type,” “style,” “imitation” or the like.”

Article 23.1 has a footnote with the following wording:

“Notwithstanding the first sentence of Article 42, Members may, with respect to these obligations, instead provide for enforcement by administrative action.”

72. Article 23.1 is supplemented by a paragraph dealing specifically with the registration of trademarks for wines containing or consisting of a geographical indication for wines, and the registration of a trademark for spirits containing or consisting of a geographical indication for spirits, where the wines and spirits in question do not have the indicated geographical origin. Registration of trademarks falling under that provision has to be refused or cancelled, either *ex officio* if the applicable law so allows, or at the request of an interested party.

73. Article 24 contains a number of exceptions to the obligations under Articles 22 and 23. Broadly speaking, there are three categories of exceptions, namely continued and similar use of geographical indications for wines and spirits, prior good faith trademark rights, and generic designations.

74. The first exception (Article 24.4) gives the right to a WTO Member to allow continued and similar use of a particular geographical indication of another Member identifying wines or spirits, in connection with goods or services by any of its nationals or domiciliaries who have used that geographical indication in a continuous manner with regard to the same or related goods or services in the territory of that Member either for at least 10 years preceding April 15, 1994, or in good faith preceding that date.

75. The second exception relates to rights in trademarks (Article 24.5). It basically states measures to implement the Section on geographical indications by a WTO Member shall not prejudice the registration of trademarks identical with or similar to geographical indications, the application for registration of such trademarks, or the right to use such trademarks, if the following conditions are met: An application for the registration of such a trademark has been filed, or the trademark has been registered, or, where the right to the trademark was acquired by use, that trademark has been used, in good faith, in the WTO Member concerned, before the TRIPS Agreement became applicable in that Member, or before the geographical indication in question is protected in its country of origin.

76. The third exception (Article 24.6) is related to geographical indications of a WTO Member which are considered by another WTO Member to be a term customary in common

language as the common name for goods or services or, where the geographical indication is used for products of the wine, it is identical with the customary name of a grape variety existing in the territory of that Member as of the date of entry into force of the TRIPS Agreement.

77. Furthermore, Article 24.3 of the TRIPS Agreement provides that in implementing the Section of the TRIPS Agreement on geographical indications, a WTO Member shall not diminish the protection of geographical indications that existed in that Member immediately prior to the date of entry into force of the WTO Agreement.

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