

**International Registration of AOs and GIs**  
in the light of the  
Draft Revised Lisbon Agreement

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# Geographical Indications (GI) and Appellations of Origin (AO)

## WIPO's Role

- Administration of several **international agreements** relevant for the protection of GIs/AOs
- Forum for discussion of possible ways to improve the **international protection** of GIs/AOs
  - *Standing Committee on the Law of Trademarks, Industrial Designs and GIs*
  - *Working Group on the Development of the Lisbon System*
- Provision of **technical assistance**

## Technical Assistance

- Drafting Legislation
- Protection under International Treaties
- Application Criteria for Establishment GI or AO
- Monitoring and Enforcement Procedures

# Distinctive Signs

- Distinctive Signs for **Individual** Use
  - Trademarks (goods & services)
  
- Distinctive Signs for **Collective** Use
  - Collective marks
  - Certification marks
  - Geographical indications
  - Appellations of origin
  - Indications of source

## Subject-Matter of Protection (GIs and AOs)

### Indication of a Connection between Characteristics of Products and their Geographical Origin

- Informs consumers of the **typicality** of the products derived from this connection (non-generic characteristics)
- Represents the **reputation** derived from this uniqueness (collective goodwill)
- **Value-added**

# International Registration in WIPO

Lisbon System – GIs?

Madrid System – GIs?

## Madrid and Lisbon – Corresponding Features

- **Aim:** to facilitate international protection through a **single notification** and **registration procedure**
- **Participation:** any country party to the **Paris Convention** may accede
- Administered by **WIPO** – **International Register**
- **Coverage** - not limited to specific kinds of goods

# Lisbon Union: 27 Member States

## **Africa (6)**

Algeria  
Burkina Faso  
Congo  
Gabon  
Togo  
Tunisia

## **Asia (3)**

Iran (Islamic Rep. of)  
Israel  
Korea (DPR of)

## **America (6)**

Costa Rica  
Cuba  
Haiti  
Mexico  
Nicaragua  
Peru

## **Europe (12)**

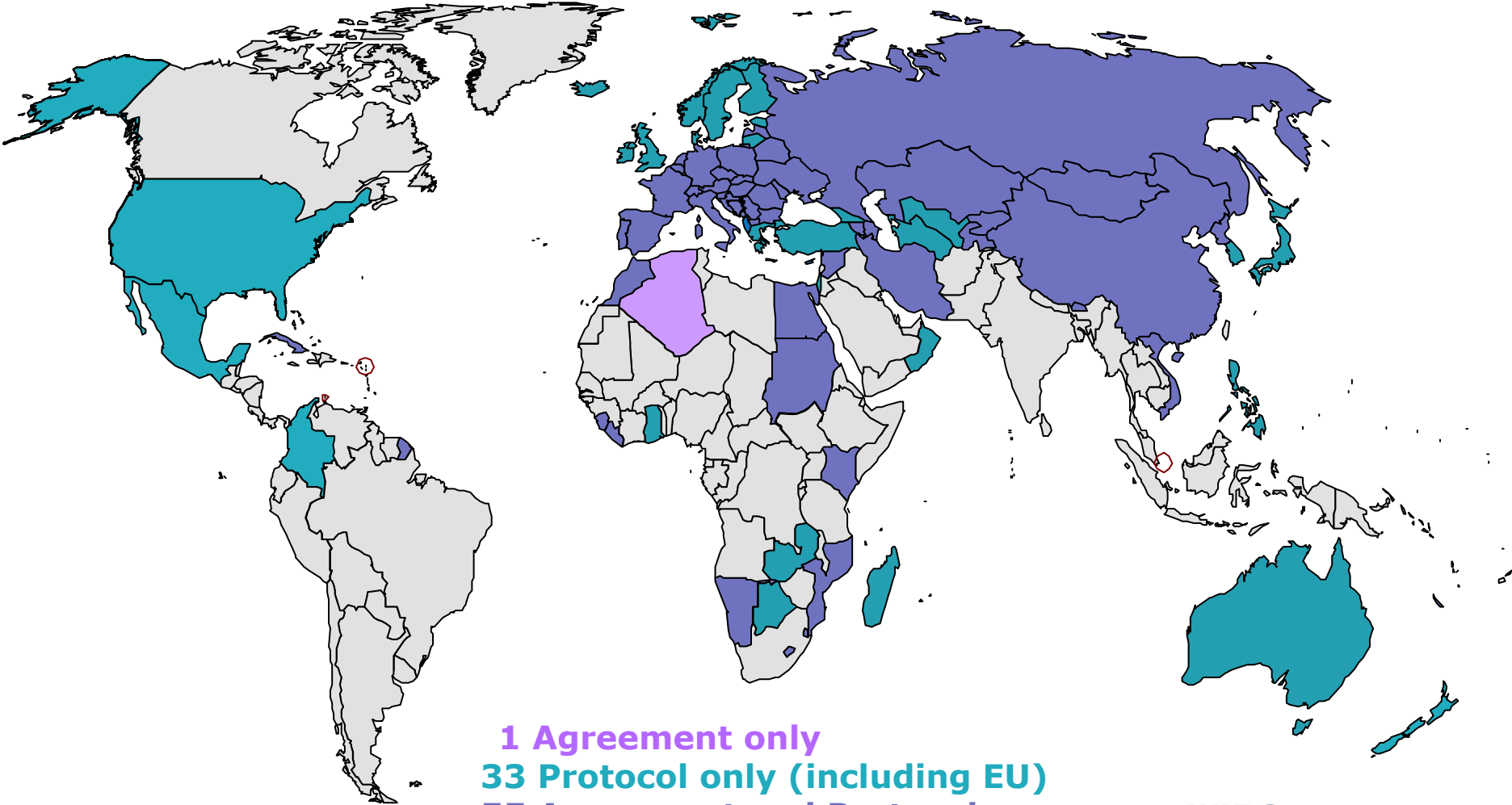
Bulgaria  
Czech Rep.  
France  
Georgia  
Hungary  
Italy  
Moldova  
Montenegro  
Portugal  
Serbia  
Slovakia  
The FYR of Macedonia



# 914 registrations – 809 in force

■ France	509	■ Portugal	7
■ Czech Rep.	76	■ Tunisia	7
■ Bulgaria	51	■ Korea (DPR of)	6
■ Italy	33	■ Slovakia	6
■ Hungary	28	■ Iran (Islamic Rep. of)	5
■ Georgia	21	■ FYR of Macedonia	4
■ Cuba	19	■ Serbia	3
■ Mexico	14	■ Montenegro	2
■ Peru	8	■ Costa Rica	1
■ Algeria	7	■ Israel	1
		■ Moldova	1
Registered since 1995:	179		
- of which since 2003:	64		

# Madrid Union



**1 Agreement only**  
**33 Protocol only (including EU)**  
**55 Agreement and Protocol**

**89 Members**



Certification Trade Mark



**PARMIGIANO  
REGGIANO**



WIPO  
WORLD  
INTELLECTUAL PROPERTY  
ORGANIZATION

Résultats de la recherche dans Lisbonne - Microsoft Internet Explorer

File Edit View Favorites Tools Help

[Récapitulation des résultats]  
**Résultats de la recherche dans LISBON pour:**  
AP/parmigiano : 1 document  
*document 1 à 1 sur 1 :*

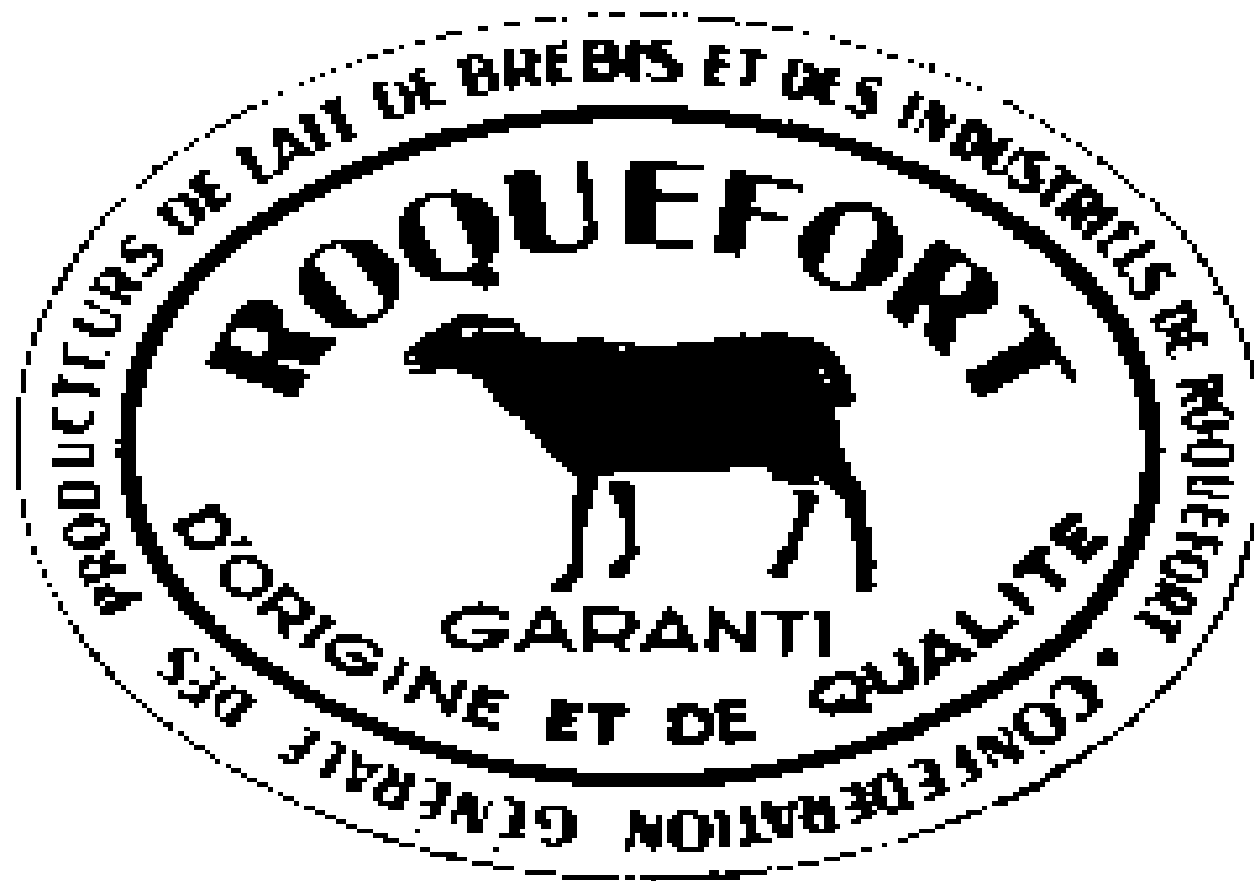
Affiner l'interrogation

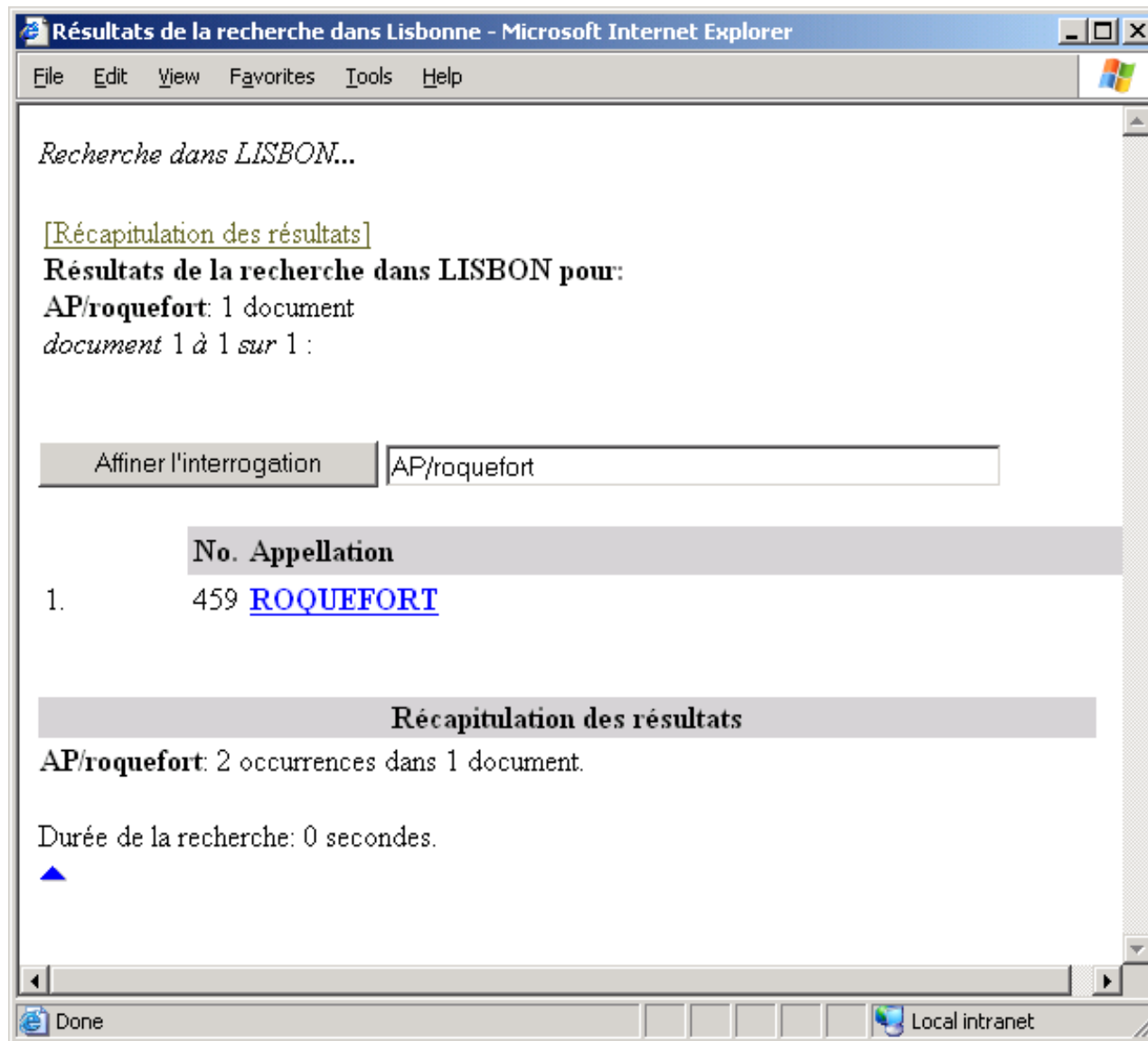
No.	Appellation
1.	513 <a href="#">PARMIGIANO-REGGIANO</a>

**Récapitulation des résultats**  
AP/parmigiano: 2 occurrences dans 1 document.  
Durée de la recherche: 0.07 secondes.  
▲

Local intranet

ACTUAL PROPERTY  
ATION





## Legal Effect (1)

### Effect of international registration

- **Lisbon**: extension of protection to countries other than the country of origin (fee)
- **Madrid**: extension of protection to countries other than the country of origin, as designated (fees)
- **Lisbon**: indefinite (in principle)
- **Madrid**: renewable every 10 years (fees)

### Except in a country that ...

- issued a refusal (within the prescribed time-limit)  
or
- invalidated the effect of the international registration in its territory



## Legal Effect (2)

### Required Scope of Protection

- **Lisbon**: Protection against any usurpation or imitation, even if the true origin is indicated or if the AO is used in translated form or accompanied by terms such as “kind”, “type”, etc.
- **Madrid**: Same protection as marks registered under the national/regional system of the designated CP

### Except in a country that ...

- issued a refusal (within the prescribed time-limit) or
- invalidated the effect of the international registration in its territory



**BON SYSTEM**

at the Lisbon System  
 on Agreement  
 on System Review  
 itings  
 etin



1 of 1

## (1) PLZEŇ / PILSEN PILS / PILSENER / PILSNER

**BON EXPRESS**

rch Appellations of  
 in

**RELATED LINKS**

graphical Indications  
 e Studies  
 IO Lex  
 okshop  
 webpage on GIs

Number	<b>1</b>
Date	22.11.1967
Holder	The organisations that produce, in this region, the said products
Appellation	<b>PLZEŇ PILSEN PILS PILSENER PILSNER</b>
Publication	N° <b>1</b> : 03/1968
Country of Origin	CZ
Nice Classification	32
Product	Beer
Area of Production	City of Plzeň (Pilsen)
Refusal	<a href="#">FR</a> - 10.04.1969 <a href="#">ME</a> - 17.05.2000 <a href="#">RS</a> - 17.05.2000 <a href="#">PE</a> - 16.06.2006 <a href="#">IR</a> - 10.12.2007 <a href="#">MK</a> - 30.09.2011
Withdrawal	<a href="#">MX</a> - 22.05.1980 (Date of the initial refusal: 11.06.1969)
Legal basis	Executive Order N° 12.594/66-01/31 of November 3, 1966 of the Ministry of Food Processing Industry
Notification Article 5(2):	No longer applicable

# Lisbon Union Assembly (September 2009)

- Mandated the WG on the Development of the Lisbon System to
  - look for improvements of the Lisbon system so that it might attract a wider membership, while preserving the principles and objectives of the Lisbon Agreement

# Two-fold Mandate

## 1. Revision of the Lisbon Agreement

- Refinement and Modernization of the Legal Framework
- Accession Possibility for IGOs (e.g., EU, OAPI)

## 2. Ensure its applicability to AOs and GIs

# WG on the Development of the Lisbon System

- ❑ Revision of the Lisbon Agreement
- ❑ The provisions of the **Draft Revised Lisbon Agreement** concern:
  - Definitions for GIs and AOs
  - Procedures for international applications and registration
  - Scope of protection
  - Prior rights and prior use
  - Applications for trans-border GIs and AOs
  - Accession criteria for IGOs  
(e.g., EU, OAPI)
- ❑ Conference on dispute settlement within the Lisbon system

# Prospects

- Results 6th Session of the WG: December 3 to 7, 2012  
([http://www.wipo.int/edocs/mdocs/mdocs/en/li\\_wg\\_dev\\_6/li\\_wg\\_dev\\_6\\_6.doc](http://www.wipo.int/edocs/mdocs/mdocs/en/li_wg_dev_6/li_wg_dev_6_6.doc))
  - Revised Lisbon Agreement on AOs and GIs
  - Scope of protection
  - Relationship between TMs and AOs/GIs
  
- Diplomatic Conference: within the 2014/15 biennium?

## Scope of Protection

- Protection against:
  - (i) any use of the AO or the GI
    - in respect of goods **of the same kind** as those to which the AO or the GI applies not originating in the geographical area of origin **or** not complying with **any** other applicable requirements for using the AO or the GI **[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 AO or the GI is used in translated form or accompanied by terms such as “style”, etc.;
    - (ii) any **other** practice liable to mislead the consumer as to the true origin, provenance, nature, quality or characteristics of the goods.
    - **[Presumption** of unlawful use in case of use for goods of the same kind] *(compare Art. 16.1 and Art. 23.1 TRIPS)*

# Registration of TMs

**Two Options** will be discussed at the 7th session of the WG (subject to the provisions on prior trademark rights):

B Shall be refused or invalidated in respect of a trademark which contains or consists of an AO or GI, **when it corresponds to one of the uses covered by the scope of protection**

A (i) Shall be refused or invalidated in respect of a trademark which contains or consists of an AO or GI **with respect to goods not originating in the geographical area of origin**  
(ii) May be refused or invalidated in respect of a trademark which contains or consists of an AO or GI **with respect to goods that, while originating in the geographical area of origin, do not comply with any other applicable requirements for using the AO or the GI**



# Prior Trademark Rights

Article 13(1) of the Draft Revised Lisbon Agreement to be discussed at the 7th session of the WG :

- (1<sup>st</sup> sentence) In case a denomination constituting an AO, or an indication constituting a GI, registered under this Act, conflicts with a prior right in a trademark applied for or registered, or, where possible, acquired through use, in good faith in a Contracting Party (CP), each such CP shall respect such prior trademark right.
- (2<sup>nd</sup> sentence) Taking into account the legitimate interests of the owner of the prior trademark as well as those of the beneficiaries of the rights in the AO or the GI, the CP, if not notifying a refusal [...] or invalidating the effects of the international registration concerned, [...], shall, in any event, not prejudice the eligibility for, or the validity of, the registration of the trademark or the right to use the trademark, on the basis that such a trademark is identical with, or similar to, the denomination or the indication.

# Prior Use

Article 17(1) of the Draft Revised Lisbon Agreement to be discussed at the 7th session of the WG :

- ❑ Without prejudice to the possibility of refusal [...], where a denomination constituting an AO [...], or an indication constituting a GI [...], was, prior to the date of the international registration, in use in a CP by a third party as a **generic term**, the CP may grant to the third party a defined period **to terminate such use**. [...]
- ❑ Prior use under a trademark or other legitimate right cannot be the subject of such phasing-out (because such uses are **safeguarded under Art. 13**).
- ❑ However, if **a term contained in a prior trademark has been disclaimed in the trademark registration because of the generic nature of the term in the CP concerned**, use of such a term is not covered by the legitimate prior right. Consequently, the term would be subject to the phasing-out provision, if it corresponds to a protected AO or a GI.

THANK YOU

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