

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

**Fourth Session**  
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### **NOTES ON THE DRAFT NEW INSTRUMENT CONCERNING THE INTERNATIONAL REGISTRATION OF GEOGRAPHICAL INDICATIONS AND APPELLATIONS OF ORIGIN**

*Document prepared by the Secretariat*

1. The Annex as contained in the present document contains Notes on the Draft New Instrument Concerning the International Registration of Geographical Indications and Appellations of Origin contained in document LI/WG/DEV/4/2. Where a provision appears not to require explanation, no note has been provided.

[Annex follows]

## NOTES ON THE DRAFT NEW INSTRUMENT CONCERNING THE INTERNATIONAL REGISTRATION OF GEOGRAPHICAL INDICATIONS AND APPELLATIONS OF ORIGIN

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## **NOTES ON ARTICLE 1: SPECIAL UNION**

1.01 The brackets contained in the proposed text have been inserted to reflect the existence of the following alternatives: (i) the Contracting Parties to the new instrument constitute a new Special Union should a decision be taken that the proposed new instrument would actually take the form of a new treaty or protocol, or (ii) the Contracting Parties referred to above are instead considered as members of the same Special Union as the States party to the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (hereinafter referred to as “the Lisbon Agreement”), should a decision be taken that the proposed new instrument would actually be a revised version of the Lisbon Agreement.

1.02 Along the lines of the provisions contained under Article 15 of the Singapore Treaty on the Law of Trademarks, an obligation to comply with the Paris Convention has been inserted in subparagraph (2) to reflect some of the comments made at the third session of the Lisbon Working Group on the Development of the Lisbon System (Appellations of Origin) (hereinafter as referred as “the Lisbon Working Group”). In other terms, under the new instrument Contracting Parties are required, even if not bound by the Paris Convention, to comply with the provisions of the Paris Convention in respect of the subject matter covered by the new instrument.

## **NOTES ON ARTICLE 2: ABBREVIATED EXPRESSIONS**

2.01 Following the example of the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (hereinafter referred to as “the Geneva Act”), Article 2 explains a certain number of abbreviated expressions and defines several terms used throughout the draft new instrument. While several abbreviated expressions and definitions contained under Article 2 are similar to those contained under the Regulations of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (hereinafter referred to as “the Lisbon Regulations”), others have been added whenever it appeared necessary as in the case of the provisions below.

2.02 Items (vii) and (viii): while Article 3 deals with the definitions that may apply in respect of geographical indications and appellations of origin, items (vii) and (viii) of Article 2 aim to make it clear that appellations of origin form a special category of geographical indications.

2.03 Item (xi): the term “Contracting Party” instead of “countries”, has been used throughout the text of the draft new instrument in order to cover both contracting States and contracting intergovernmental organizations.

2.04 Item (xv): the term “competent authority” also applies to the authority jointly designated by two Contracting Parties sharing the same geographical area of origin.

2.05 Item (xvi): as it is proposed that the new instrument be open both to States and to certain types of intergovernmental organizations, the accession criteria for intergovernmental organizations have been set out in Article 29(1)(ii).

### **NOTES ON ARTICLE 3: PROTECTION OF GEOGRAPHICAL INDICATIONS AND APPELLATIONS OF ORIGIN REGISTERED AT THE INTERNATIONAL BUREAU**

3.01 Article 3 defines the object of protection under the new instrument, namely geographical indications and appellations of origin. As regards the basis of protection, reference is made to document LI/WG/DEV/3/2, Annex II, Draft Provisions A and B, as discussed by the Working Group at its third session.

3.02 Article 3(3) clarifies the scope of the term “legal instrument” and aims to reflect the gist of paragraph 19 of the Summary by the Chair (document LI/WG/DEV/2/4), as adopted by the Working Group at its second session, i.e., the view that Article 1(2) of the Lisbon Agreement and Rule 5 of its Regulations allow for flexibility as regards the legal means by which recognition and protection should take place in the country of origin, as long as the legislation by which these legal means are established meet the requirements of Articles 2 and 3 of the Lisbon Agreement. Consequently, recognition and protection may be determined by *sui generis* legislation or other legislation and the actual grant of protection to individual appellations of origin or geographical indications under such legislation may, as reflected in Article 3(2) (which borrows wording from Rule 5(2)(a)(vi) of the Lisbon Regulations), occur by virtue of a legislative or administrative act, a judicial decision or registration.

3.03 Article 3(4) deals with the case of trans-border areas and introduces an option for countries sharing the territory of the geographical area of origin to register a geographical indication or appellation of origin jointly.

3.04 Article 3(5) provides definitions for geographical indications and appellations of origin under the new instrument. The provisions of subparagraphs (a) and (b) should be read in conjunction with those of subparagraph (c).

3.05 The definition of geographical indication contained under subparagraph (a) is based on the definition contained under Article 22.1 of the Agreement on Trade Related Aspects of Intellectual Property Rights (hereinafter referred to as “the TRIPS Agreement”).

3.06 The definition of appellation of origin under subparagraph (b) is basically modeled after the definition provided under Article 2 of the Lisbon Agreement, except for the fact that (i) it also extends to traditional non geographical denominations provided they are traditionally known as designating a product originating in a given geographical area, and also because (ii) the option has been introduced that “natural” and “human” factors can be alternative requirements for the registration of a given denomination as an appellation of origin. The element of “reputation” as contained in Article 2(2) of the Lisbon Agreement has been retained in the definition through the use of the terms “a geographical denomination known as the designation of a product”.

3.07 The provisions under subparagraph (c) have been drafted to take into account the statement made at the 1958 Diplomatic Conference that the definitions of the Agreement would not preclude the use of national definitions that would be broader or more precise. In parallel, the provisions under subparagraph (d) have been inserted to prevent the use of any stricter or narrower definition than those contained in the Agreement as a basis for refusal of international registrations of other Contracting Parties.

#### **NOTES ON ARTICLE 4: PROTECTION BY VIRTUE OF OTHER TEXTS**

4.01 The provisions under Article 4 confirm that the new instrument, which would set up a centralized procedure for obtaining in each Contracting Party the protection which that party affords to appellations of origin or geographical indications, would not itself be an obstacle to the possibility of enjoying any other protection that may be afforded to geographical indications or appellations of origin under the law of a Contracting Party or by virtue of other international conventions. Obviously, such other protection should not diminish or interfere with the enjoyment of the rights afforded by the new instrument.

#### **NOTES ON ARTICLE 5: FILING INTERNATIONAL APPLICATIONS**

5.01 Articles 5(1) and 5(2) determine that international registration takes place at the International Bureau of WIPO and that international applications are filed in the name of the beneficiaries of the geographical indication or appellation of origin in question. However, where the existing Lisbon system determines that the international application should be filed by the competent authority of the Contracting Party in whose territory the geographical area of origin is situated, Article 5(2) hinges, instead, on the legislative or administrative act, judicial decision or registration by virtue of which protection was granted to the geographical indication or appellation of origin in question for determining who has standing to file an international application for the same.

5.02 Article 5(3) indicates that an international application may, as an alternative, be presented directly to the International Bureau by the beneficiaries of the geographical indication or appellation of origin or by a federation or association representing them. This option was included in view of the conclusion of the Chair of the Working Group, as reflected in of paragraph 176, final sentence, of the Report of the second session of the Working Group (document LI/WG/DEV/2/5) concerning a suggestion made in response to the Survey on the Lisbon System.

5.03 While Articles 5(4) and (5) refer to the Regulations under the new instrument for the mandatory and optional particulars in respect of international applications, Articles 5(6) and (7) specify the minimum requirements, in terms of the content of an international application, for the determination of the date of the international registration.

#### **NOTES ON ARTICLE 6: INTERNATIONAL REGISTRATION**

6.01 Article 6 addresses the issue, that a geographical indication or appellation of origin that is the subject of an international application under Article 5 may be protected under a legal instrument applying in the geographical area of origin presenting the international application on the basis of a definition that contains other elements than the definitions of Article 3(5)(a) or (b). The provisions presented in Article 6 are based on the premise that an internationally registered geographical indication or appellation of origin, in order to be protectable in all Contracting Parties, should, at least, meet the definition requirements of Article 3(5)(a).

6.02 Some Contracting Parties may only provide protection in respect of “geographical indications”, while others may provide protection in respect of “geographical indications” and “appellations of origin”. Articles 6 and 9 have been constructed so as to take into account that some Contracting Parties may provide more extensive protection to appellations of origin than to other geographical indications. Reference is made in this regard to document LI/WG/DEV/3/2, Annex II, Draft Provisions D and E, as discussed by the Working Group at

its third session. In particular, Article 6(4) addresses the question as to how Contracting Parties, which do not apply a distinction between appellations of origin and geographical indications and which have established the same level of protection in respect of both, should protect international registrations of appellations of origin. As “appellations of origin” are defined as a specific category of geographical indications under Article 2(viii) of the new instrument, it is suggested that the above-mentioned Contracting Parties should protect internationally registered appellations of origin as geographical indications. No specific provision is required in respect of the reverse situation, i.e., the situation in Contracting Parties with a national or regional system that parallels the distinction between geographical indications and appellations of origin.

#### **NOTES ON ARTICLE 7: FEES**

7.01 The articles of the new instrument have been distributed into eight different Chapters for ease of reference. In that respect, for the sake of consistency and to make the proposed Chapter II concerning the international application and the international registration as complete as possible, a stand-alone article concerning the registration fee and the other fees to be eventually paid for has been included in a new Article 7. As far as the nature and the amount of such fees are concerned, reference is made to the Regulations under the new instrument.

#### **NOTES ON ARTICLE 8: DATE OF EFFECT OF INTERNATIONAL REGISTRATION**

8.01 This article lists three possible different dates of effect of an international registration: (i) in case a declaration under subparagraph (1)(b) has been made, (ii) in the absence of such a declaration and (iii) in the case of a withdrawal of a refusal.

#### **NOTES ON ARTICLE 9: CONTENT OF PROTECTION**

9.01 Two different levels of protection, one for geographical indications and one for appellations of origin, are proposed under Article 9. Reference is made in this regard to document LI/WG/DEV/3/2, Annex II, Draft Provisions D and E, as discussed by the Working Group at its third session.

9.02 Subparagraph (1) refers to the national laws of Contracting Parties as far as the scope of protection in the case of internationally registered geographical indications is concerned.

9.03 Subparagraph (2) specifies the minimum level of protection that shall be granted to an appellation of origin registered under the new instrument, in particular in cases of direct or indirect use, or in case of use of the registered appellation of origin as a trademark, or its registration as a trademark.

9.04 Subparagraph (3) refers to the national laws of Contracting Parties for dealing with use of an appellation of origin by a producer or other person from the geographical area of production using the appellation of origin unlawfully.

9.05 Subparagraph (4) establishes a presumption of unlawful use in case of use of the registered geographical indication or appellation of origin on products of the same kind.

9.06 Subparagraphs (5) and (6) propose a solution to the issue of homonymous appellations of origin and geographical indications.

#### **NOTES ON ARTICLE 10: PRESUMPTION THAT A PROTECTED GEOGRAPHICAL INDICATION OR APPELLATION OF ORIGIN CANNOT BECOME GENERIC**

10.01 Article 10 establishes the presumption that an appellation of origin or geographical indication registered under the new instrument may not become generic under certain conditions. It is for each Contracting Party to decide whether this presumption will be rebuttable under its law or not.

#### **NOTES ON ARTICLE 11: PERIOD OF VALIDITY OF REGISTRATION**

11.01 Article 11 defines the period of validity of a registration effected under the new instrument.

#### **NOTES ON ARTICLES 12, 13 AND 14: USE UNDER A PRIOR TRADEMARK; USE UNDER ANOTHER LEGITIMATE PRIOR RIGHT, SUCH AS A TRADE NAME; USE AS A GENERIC**

12.01 These articles address the issue of prior use – either as a generic or under a prior trademark right or any other legitimate prior right – of a geographical indication or appellation of origin registered under the new instrument.

12.02 Article 12 has been introduced to safeguard prior rights to use a trademark for a sign that corresponds to an internationally registered geographical indication or appellation of origin, except when the earlier trademark has been acquired in bad faith. In parallel, it is proposed to add additional wording so as to leave open the possibility for right holders of prior trademarks and holders of the right to use the appellation of origin or geographical indication to negotiate the modalities of a possible termination of the use of the prior trademark.

13.01 Under Article 13, a similar good faith requirement has been extended to use under any legitimate prior right.

14.01 Under Article 14, if prior use as a generic is not advanced as a ground for refusal, continued use as a generic can be prevented.

#### **NOTES ON ARTICLE 15: LEGAL PROCEEDINGS**

15.01 The provisions under this article largely reproduce those contained under Article 8 of the Lisbon Agreement.

#### **NOTES ON ARTICLE 16: NOTIFICATION OF INTERNATIONAL REGISTRATION**

16.01 Article 16 sets out the obligation for the International Bureau to publish and notify any new registration under the new instrument to all the Contracting Parties.



#### **NOTES ON ARTICLE 17: POSSIBLE SUBSEQUENT NOTIFICATIONS**

17.01 Article 17 enumerates the possible notifications that may be issued by Contracting Parties upon receipt of the initial notification of registration referred to in Article 16, some of them within defined time limits.

#### **NOTES ON ARTICLE 18: PRIOR USE AS A GENERIC; PERIOD GRANTED**

18.01 A phasing out period of time for terminating prior use is limited to prior use of a registered geographical indication or appellation of origin as a generic under the new instrument. Only in exceptional cases such period should be longer than five years.

18.02 Subparagraph (4) clarifies that similar provisions shall apply for terminating prior use in case a refusal is withdrawn or in case a statement of grant of protection is issued following an initial refusal.

#### **NOTES ON ARTICLE 19: REFUSAL**

19.01 Article 19 concerns the procedure for issuing refusals following the receipt of a notification of international registration and introduces, in particular, the possibility for interested parties to file petitions for the competent authority to issue a declaration of refusal. Reference is made to document LI/WG/DEV/3/2, Annex II, Draft Provision G.

19.02 In respect of subparagraph 5, the Working Group might wish to address the question as to whether the provision should also specify that interested parties would, alternatively, have the opportunity to resort to arbitration or mediation.

#### **NOTES ON ARTICLE 20: WITHDRAWAL OF REFUSALS**

20.01 In order to cover all the possible notifications by Contracting Parties following the notification of an international registration under Chapter IV of the new instrument and their subsequent recording in the International Register, a specific provision concerning the withdrawal of a refusal or a statement of grant of protection following a refusal, whichever may apply, has been inserted in Article 20.

20.02 The possibility to negotiate the withdrawal of a refusal is explicitly mentioned in subparagraph (2).

#### **NOTES ON ARTICLE 21: INVALIDATION**

21.01 Article 21 deals with invalidation of the effect of an international registration in a Contracting Party. Invalidation, which occurs after effect has been given to an international registration (and may result, for example, from a court decision in infringement proceedings), is to be distinguished from refusal of the effects of an international registration where those effects have never been recognized.

21.02 Before an invalidation is pronounced under Article 21, the holder of such international registration must have been granted an opportunity to defend his rights, which in turn implies that he must first be informed that his registration is being challenged in a given Contracting Party.

#### **NOTES ON ARTICLE 22: MODIFICATIONS; ENTRIES IN THE INTERNATIONAL REGISTER**

22.01 A specific provision addressing the issue of modifications of international registrations and other entries in the International Register has been incorporated in the new instrument.

#### **NOTES ON ARTICLE 23: ASSEMBLY OF THE SPECIAL UNION**

23.01 The brackets contained in subparagraphs (1) and (2) have been inserted to signal the existence of the following alternatives: (i) a new Assembly consisting of the Contracting Parties to the new instrument is established, or (ii) these Contracting Parties shall instead be members of the same Assembly as the States party to the Lisbon Agreement.

23.02 The provisions under Article 23 are based to a great extent on those contained under Article 9 of the Lisbon Agreement. However, whenever it appeared necessary, as in the case of the intergovernmental organizations' voting rights, such provisions have been supplemented by those contained in Article 21 of the Geneva Act.

#### **NOTES ON ARTICLE 24: INTERNATIONAL BUREAU**

24.01 The provisions under this article largely reproduce those contained in Article 10 of the Lisbon Agreement.

#### **NOTES ON ARTICLE 25: REGULATIONS**

25.01 This article makes an express reference to the Regulations and defines the procedure for the amendment of certain provisions to the Regulations.

25.02 Subparagraph (2) has been drafted along the lines of the corresponding provisions of the Singapore Treaty and the Patent Cooperation Treaty which require the same threshold of a three-fourths majority.

25.03 Subparagraph (3) establishes the superiority of the provisions under the new instrument over those contained in the Regulations so that, in the event of conflict between the two sets of provisions, the provisions of the new instrument shall prevail.

#### **NOTES ON ARTICLE 26: FINANCES**

26.01 The provisions under this article reproduce those contained in the Geneva Act.

#### **NOTES ON ARTICLE 27: REVISION**

27.01 This provision, which confirms the standard rule that a treaty may be revised by a conference of the Contracting Parties, has been drafted along the lines of the provisions contained in the Singapore Treaty and the Geneva Act.

#### **NOTES ON ARTICLE 28: AMENDMENT OF CERTAIN ARTICLES BY THE ASSEMBLY**

28.01 The provisions under this article are largely derived from those contained in the Geneva Act.

#### **NOTES ON ARTICLE 29: BECOMING PARTY TO THIS AGREEMENT**

29.01 The provisions of this article have been drafted along the lines of Article 27 of the Geneva Act, in particular as far as the modalities for the accession of intergovernmental organizations are concerned. Specific accession criteria have been defined both for States and intergovernmental organizations under subparagraph (1).

#### **NOTES ON ARTICLE 30: EFFECTIVE DATE OF RATIFICATIONS AND ACCESSIONS**

30.01 This provision has been drafted along the lines of Article 28 of the Geneva Act to reflect the fact that both States and Intergovernmental Organizations may accede to the new instrument.

30.02 The first sentence of subparagraph (4), which deals with the effects of accession, has been drafted along the lines of Article 14(2)(b) and 14(2)(c) of the Lisbon Agreement. A possibility to extend the time periods referred to in Article 19(1)(b) and Article 18(1) of the draft new instrument has been introduced in the last part of subparagraph (4), Group.

#### **NOTES ON ARTICLE 31: PROHIBITION OF RESERVATIONS**

31.01 This article, which excludes any reservation to the new instrument, has been drafted along the lines of Article 29 of the Geneva Act.

#### **NOTES ON ARTICLE 32: APPLICATION OF THE LISBON AGREEMENT**

32.01 Subparagraph (1) deals with relations between States that are party both to the new instrument and the Lisbon Agreement. The principle set out is that the new instrument alone applies to the relations between those States. Thus, with respect to persons who derive their right to file an international application from a country bound both by the new instrument and the Lisbon Agreement and who wish to obtain protection in other States party both to the new instrument and the Lisbon Agreement, only the provisions of the new instrument will be applicable.

32.02 Subparagraph (2) deals with relations between States party both to the new instrument and to the Lisbon Agreement, on the one hand, and States party only to the Lisbon Agreement without being at the same time party to the new instrument, on the other.

**NOTES ON ARTICLE 33: DENUNCIATION OF THIS AGREEMENT**

33.01 This is a usual provision. To enable those who have organized their activities as a function of the accession of a Contracting Party to the new instrument to carry out the necessary adjustments in the event of that Contracting Party denouncing the Agreement, a minimum period of one year is provided in subparagraph (2) for a denunciation to take effect. Additionally, subparagraph (2) ensures that the new instrument will continue to apply to any international application that is pending and to any international registration that is in force with respect to the Contracting Party that has denounced the Agreement at the time the denunciation takes effect.

**NOTES ON ARTICLE 34: LANGUAGES OF THIS AGREEMENT; SIGNATURE**

34.01 Article 34 provides, in particular, that the new instrument is to be signed in a single original in the six official languages of the United Nations and that all those texts will be equally authentic.

**NOTES ON ARTICLE 35: DEPOSITARY**

35.01 Article 35 states that the Director General is the depositary of the new instrument. The nature of the duties of the depositary of a treaty is defined, and a list of those duties is given, in Articles 76 and 77 of the Vienna Convention on the Law of Treaties. Those duties consist, in particular, in keeping the original text of the new instrument, in establishing certified copies of the original text and in receiving the instruments of ratification or accession that are deposited.

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